

tion of braiding or plaiting machinery, wherein all the threads partake of like movements, and all aid in forming the fabric of plaited threads, being well known in the manufacture of braids, it will not be necessary to enter into a long description of the same. *All that will be required to make the invention clear, and enable a workman acquainted with such machinery, readily to perform my invention.*" It would be expected from this, that the specification was about to declare what it is, which would be sufficient to enable a workman to perform the invention; but the sentence is not completed, the patentee merely proceeding to say "which is (m) only applicable to such machines as work with four or more heads or circular tables for actuating a system or series of bobbins," &c. The specification then proceeded to describe the uses of the machinery for making the various fabrics which it was intended to produce, after which it described the drawing annexed. The specification did, in fact, describe the whole of the machinery, including both the old parts, and those claimed by the patentee to be new; but it did not in any part of it point out which of the parts were new, and which of them were old. At the end of the specification the defendant stated, that he made no claim to any of the parts of the apparatus constituting the machine separately, nor combined so far as the same had been before known; but there was nothing in the specification which could enable any person to ascertain to which of the parts of the machinery the disclaimer was intended to apply. It was objected by the counsel for the prosecutor, that the specification was insufficient, because it clearly appeared upon [*188] the face of it that some parts of the machinery described *were old, and there was no part of that document which either pointed out what was the new invention claimed by the patentee, or the old parts which he disclaimed. It was contended for the defendant, that he was at liberty to give evidence to show what was new and what was old; but the cases of *The King v. Wheeler*, (n) and *Neilson v. Harford*, (o) were cited to show that the construction of the specification was for the Court, and not the jury, and that such evidence was not admissible. Lord Denman, C. J., adopted the language of Lord Ellenborough, in the case of *Macfarlane v. Price*, (p) and said, that the alleged improvements were not sufficiently ascertained or described, either by words or by figures, and that it would not be in the wit of man to discover from the specification what was new, or what was old, or what he was warned from doing. His Lordship also held, that parol evidence was not admissible to explain the specification, and show what was new, and he directed the jury to give a verdict for the Crown, which was done accordingly.

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

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

In the case of *The King v. Elsee*, (r) the patent was for a new invented manufacture of lace called French or ground lace. The specification went

(m) These words, "which is," &c., follow immediately after the portion of the specification ending with the words "perform my invention," as given above.

(n) 2 B. & Ald. 345.

(o) 8 M. & W. 806.

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

(q) 3 Mer. 622.

(r) Dav. P. C. 144.

generally to the invention of mixing silk and cotton thread upon the frame. On the part of the prosecutor it was clearly shown that, prior to the patent, *silk and cotton thread had been used together, and inter- [*189] mixed upon the same frame, and the defendant's counsel acknowledged the fact; but said he could prove clearly that the former method of using the silk and cotton thread was quite inadequate to the purpose of making lace, on account of its coarseness, and that the defendant alone had invented the method of intermingling them, so as to unite strength with firmness. Mr. Justice *Buller* said, "It will be to no purpose. The patent claims the exclusive liberty of making lace composed of silk and cotton thread mixed, not of any particular mode of mixing it, and therefore, as it has been clearly proved and admitted that silk and cotton thread were before mixed on the same frame for lace in some mode or other, the patent is clearly void, and the jury must find for the Crown." And a verdict was given for the Crown accordingly.

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

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

In the case of *Huldart v. Grimshaw*, (y) Lord *Ellenborough*, C. J., said, that if a patentee in his specification oversteps his right, and appropriates more than is his own, he cannot avail himself of it. And if he states that which of itself is not new, but old and known to the world, though it was unnecessary for him to do so, yet having done so, he has overstepped *his right, [*190] and has included in his patent that which is not his invention, and his patent would be void.

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

In the case of *Bovill v. Moore*, Lord Chief Justice *Gibbs* laid it down, (a) that if the patentee in his specification had exceeded the limits of what he had invented, and of which he was entitled to the sole privilege, though in other respects there might be no objection to his patent, that would overturn it, for he would not then have registered (enrolled) a specification of his invention, it would be irregular in having exceeded the limits of the invention. And his Lordship afterwards said, that if the patentee had, in his specification, asserted to himself a larger extent of invention than belonged to him: if he stated to himself to have invented that which was well known before, then the specification would be bad, because it would effect to give him, through the means of the patent, a larger privilege than could legally be granted to him. In this case the invention was stated to be of a machine or machines for manufacturing lace,

(s) 6 A. & E. 735.

(u) *Ibid.*

(y) Dav. P. C. 279.

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

(a) Dav. P. C. 398.

(t) Dav. P. C. 203.

(x) 1 Webs. R. 206.

and the specification described the whole machine, without pointing out any particular part or parts of it, as the invention of the patentee. And the Lord Chief Justice held, (c) that if a combination of a certain number of the parts of the machine up to a given point had existed before the date of the patent, and if the patentee's invention sprung from that point, and added other combinations to it, then the specifications stating the whole machine as his invention was bad. And his Lordship left it to the jury to say whether they thought the patentee had in his specification described an invention to a greater extent than the proof went to establish. And his Lordship said, in answer to an observation by a juryman, that even if the patentee had claimed too much inadvertently, and not fraudulently, yet he must answer for his inadvertence. The jury found [*191] a verdict for the defendant, and upon a motion for a new trial, the Court of *Common Pleas approved of the direction given to the jury by the Lord Chief Justice, and refused to grant even a rule *nisi*. (d)

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

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

In *Harmar v. Playne*, (f) a case was stated by the Lord Chancellor for the opinion of the Court of King's Bench, from which it appeared that "by letters patent dated 20th March, 1787, the King granted to John Harmar, the plaintiff, for fourteen years, the sole privilege of making, using, and vending a certain machine by him invented for raising a shag on all sorts of woollen cloths, and cropping or shearing them, which, together, come under the description of dressing woollen cloths; and also for cropping and shearing of fustians, with the usual proviso or condition for avoiding the patent on failure of enrolling a specification. In pursuance of this proviso, Harmar duly enrolled a specification of the said invention, with drawings of the machine in the margin thereof. On the 29th March, 1794, his Majesty granted another patent to Harmar, whereby, after reciting that Harmar had obtained letters patent of the 20th March, 1787, authorizing him to make, use, and vend his invention of a machine for raising a shag on all sorts of woollen cloths, &c., for fourteen years; and further, that he had invented considerable improvements in the said machine, [*192] for which improvements in the said *machine he prayed his Majesty's letters patent for the exclusive enjoyment thereof for fourteen years, pursuant to the statute; the letters patent, therefore, granted to him the sole privilege and authority to make, use and vend his said invention, and have the whole profit thereof. The letters patent also contained a proviso that if Harmar should not particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, by an instrument in writing under his hand and seal, and cause the same to be enrolled in the Court of Chancery, within one calendar month next, and immediately after the date of the said letters patent, then they should become void. In pursuance

(c) Ibid. 413.

(d) 2 Marsh. 211.

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

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

of this proviso, Harmar did, in due time, enrol a specification in Chancery, with drawings of the machine in the margin thereof: the introductory part of which specification was as follows: ‘To all to whom, &c., I, John Harmar, of Sheffield, send greeting, Whereas his Majesty, by his letters patent, dated the 29th day of March, in the thirty-fourth year of his reign, hath granted to me his special license, &c., that I, my executors, administrators and assigns, at all times during the term of years therein expressed, should and lawfully might make, use, and vend the machine by me invented and found out, for raising a shag on all sorts of woollen cloths, &c., and that I should enjoy the whole profit, &c., of the said invention for fourteen years, from the date of the said letters patent, according to the statute, &c. And whereas in the said letters patent there is a proviso or condition, that if I, the said John Harmar, should not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under my hand and seal, and cause the same to be enrolled in the Court of Chancery within one calendar month after the date of the said letters patent, that then the said letters patent, and all liberties, &c., thereby granted, should be void. Now, know ye, that in obedience to the said letters patent, and proviso therein contained, I, the said John Harmar, do, by these presents, particularly describe and ascertain the nature of the said invention, referring to the drawings in the margin of these presents, which I explain as follows.’ The specification then proceeds under different letters of the *alphabet, corresponding [*193] with similar letters on the drawing, to set forth a full description of the whole of the machine; and the specification ends with these words: ‘And I, the said John Harmar, do hereby declare that my said invention is intended to be worked in the manner hereinbefore particularly mentioned.’ *It was admitted by the defendant*, that the improvements for which the second patent was granted are included in the general description of the second or improved machine, as set forth in the specification of the second patent; and *that the second specification does contain a full and proper description of the whole machine in its improved state.* But the second specification does not in any manner point out or describe the improvements upon the former machine by any verbal description, or by any delineation or mark in the drawing; and which drawing is not a representation of the improvements alone, but of the whole machine in its improved state; nor are the improvements in any manner substantively and individually explained by the second specification; nor is the machine in the improved state contradistinguished from the state and condition of it under the former patent by any explanation whatever, nor by any delineation or mark in the drawing. *But what the former machine was, and what were the said improvements thereupon, are ascertainable and appear by referring to the first specification and the drawings thereon, and comparing the second specification and the drawings thereon with the same.* The defendants insisted that the second specification was not a due performance of the condition of the second patent; and the question, therefore, for the opinion of the Court was, whether the proviso or condition in the letters patent of the 29th of March, 1794, had been duly performed by the enrolment of the said specification thereof.”

It was contended for the patentee, that as the second patent and specification referred to the first, and therefore directed a party to the source from which information might be obtained, the second specification was a “sufficient compliance with the condition in the patent. *That the patentee had only an exclusive right to the whole combination for which his (second) patent was granted, and the use of particular parts only would be no breach of his rights; that the description, therefore, of the particular improvements, distinct *from the parts in general use before, would be* [*194]

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

Lord *Ellenborough* also said, "I own I was disposed to think that it was a departure from the terms of the proviso for the patentee merely to tell the inquirer who came to consult the specification, how he might learn what the [*195] invention was, instead of giving him that information directly. But *I feel impressed by the observation of my brother *Le Blanc*, that the trouble and labour of referring to and comparing the former specification with the latter, would be fully as great if the patentee only described in this the precise improvements upon the former machine. Reference must, indeed, often be necessarily made in these cases to matters of general science, or the party must carry a reasonable knowledge of the subject-matter with him in order clearly to comprehend specifications of this nature, though fairly intended to be made. We will, however, consider the case and certify our opinion."

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

The reasons of the Court for their opinion in this case were not given, and therefore it is not quite certain whether they held the specification to be made good by the reference to the prior patent and specification, or whether the second patent was in fact not for the improvements themselves separate and apart from the former machine, but for the new combination of parts, (*h*) in which case the description of the entire machine was correct and proper. If the Court was of opinion that the patent was for the improvements separate and distinct from the previously known parts of the machine, then they must have held that the specification was made good by the reference to the prior patent. And if this be so, it is to be observed, that this case does not, as has

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

been supposed, amount to a decision that parol evidence may be given to show which of the parts of the machinery were new and which were old. The specification must be deemed by the reference to include all that was contained in the former specification, *which is recorded in the same place as the second specification*, and the reference to the former patent and specification shows most clearly that the patentee did not intend in his second specification to claim those parts of the machinery which were comprised in the first, and which were therefore clearly old at the date of the second patent. The former parts then being in effect disclaimed, and it being admitted by the defendant *that the specification did sufficiently describe all parts of the ma- [*196] chinery, the only effect of the decision in *Harmar v. Playne* is, that reference being made to a former specification which is contained amongst the records of the same Court as the second, the first specification may be used as evidence to show which of the parts or things mentioned in the second specification are not intended to be claimed as part of the second invention.

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

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

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

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

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

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

The various cases which have been cited show the requisites of a specification as a performance of the condition contained in the patent, in pursuance of which it is enrolled. The *general rule for the construction of a [*197] specification, (the object or purpose of the instrument being borne in mind,) is precisely the same as that which applies to all other instruments, and which was so clearly expressed by Lord *Ellenborough*. C. J., in the case of *Robertson v. French*, (p) in which that eminent judge, speaking of a policy of assurance, said, "The same rule of construction which applies to all other instruments applies equally to this instrument, of a policy of insurance, viz: that it is to be construed according to its sense and meaning, as collected in the first place from the terms used in it, which terms are themselves to be understood in their plain, ordinary, and popular sense, unless they have generally, in respect to the subject-matter, as by the known usage of trade, or the like, acquired a peculiar sense distinct from the popular sense of the same words; or, unless the context evidently points out that they must, in the particular in-

(i) 1 Stark. R. 354, cited *ante*, p. 163.

(j) 6 B. Mo. 71.

(n) 6 A. & E. 735.

(p) 4 East, 135-136.

(k) Dav. P. C. 144.

(m) Dav. P. C. 361.

(o) 3 B. & Ad. 881.

stance, and in order to effectuate the immediate intention of the parties to that contract, be understood in some other special and peculiar sense."

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

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

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

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

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

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

(q) 2 B. & Ad. 377.

(s) 1 C. & P. 563, 568.

(u) 8 M. & W. 806.

(x) And see *Neilson v. Harford*, 1 Webs. R. 340, 369.

(y) 1 Webs. R. 373.

(r) 1 Cr. M. & R. 864.

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

*CHAPTER VIII.

[*199]

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

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

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

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

SECTION I.

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

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

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

By section 2 of that statute it was enacted, "That if in any [*200] suit or action it shall be proved, or specially found by the verdict of a jury, that any person who shall have obtained letters patent for any invention or supposed invention, was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same or some part thereof before the date of such letters patent, or if such patentee or his assigns shall discover that some other person had, unknown to such patentee, invented or used the same, or some parts thereof, before the date of such letters patent, it shall and may be lawful for such patentee, or his assigns, to petition his Majesty in council to confirm the said letters patent, or to grant new letters patent, the matter of which petition shall be heard before the Judicial Committee of the Privy Council; and such committee upon examining the said matter, and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied that such invention, or part thereof had not been publicly and generally used before the date of such first letters

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

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

patent, may report to his Majesty their opinion that the prayer of such petition ought to be complied with, whereupon his Majesty may, if he think fit, grant such prayer; and the said letters patent shall be available in Law and Equity to give to such petitioner to sole right of using, making, and vending such invention as against all persons whatsoever, any law, usage, or custom to the contrary thereof notwithstanding: Provided that any person opposing such petition shall be entitled to be heard before the said Judicial Committee: Provided also, that any person party to any former suit or action touching such first letters patent, shall be entitled to have notice of such petition before presenting the same."

This provision of the act is only intended to apply to cases in which it shall appear that the patentee at the time he obtained his patent was ignorant of his title being defective, and believed himself to be the *first and original* inventor.

If the defect in the patentee's title arise from the circumstance of his not having been a *true and actual* inventor, he cannot have been ignorant of the fact, and the statute is inapplicable to such a case. (b) But if the patentee did [*201] actually *make the invention, and if at the time when he obtained his patent, he did really believe that he was the *first* inventor, he is enabled by the act upon discovering that he was not the *first* inventor, to petition for a confirmation of his patent.

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

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

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

In *Baron Heurteloup's* case, (c) it appeared that the petitioner had, in May, 1834, obtained a patent for an invention of "improvements in certain parts of certain descriptions of fire-arms." A portion of the invention consisted of a small tube made of soft metal, and filled with detonating powder for priming the gun, the end of the tube being advanced to the touch-hole by the action of cocking the gun, while a small piece is cut off just by the touch-hole, and detonated there by the falling of the hammer, without exploding the powder in the remaining part of the tube. The petitioner had discovered that a prior patent was granted in France to one Valdahon for an invention, part of which [*202] consisted of a straw filled with *detonating powder brought to the touch-hole of the gun, and cut off, as required, to prime and fire; but the mode of bringing the straw tube to the touch-hole was totally different from the petitioner's, and did not constitute the gun a self-priming gun. Valdahon's invention had never been used in France, England, or elsewhere, and

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

(c) 1 Webs. R. 553.

was not known in England otherwise than by a French work, a copy of which had been deposited in the British Museum two years before the date of the petitioner's patent. Under these circumstances, the Judicial Committee of the Privy Council, after notice to Valdahon, recommended a confirmation of the petitioner's patent, which was granted accordingly.

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

*SECTION II.

[*203]

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

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

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

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

(d) 1 Weis. R. 554.

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

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

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

(h) As to the requisites of a specification, *vide ante*, Chap. VII. pp. 151, 152, 162, 178.

By section the first of the statute 5 & 6 Wili. IV. c. 83, (i) it was enacted, (so far as the enactment relates to England,) “That any person who as grantee, assignee, or otherwise, hath obtained, or shall hereafter obtain, letters patent, [*204] for the sole *making, exercising, vending, or using of any invention, may, if he think fit, enter with the Clerk of the Patents of England, having first obtained the leave of his Majesty’s Attorney General or Solicitor General, certified by his fiat and signature,—a disclaimer of any part of either the title of the invention or of the specification, stating the reason for such disclaimer,—or may with such leave as aforesaid enter a memorandum of any alteration in the said title or specification; (not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent) and such disclaimer or memorandum of alteration being filed by the said Clerk of the Patents, and enrolled with the specification, shall be deemed and taken to be part of such letters patent, or such specification in all Courts whatever: Provided always that any person may enter a caveat, in like manner as caveats are now used to be entered, against such disclaimer or alteration; which caveat, being so entered, shall give the party entering the same a right to have notice of the application being heard by the Attorney General or Solicitor General respectively: Provided also that no such disclaimer or alteration shall be receivable in evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time when such disclaimer or alteration was enrolled; but in every such action or suit the original title and specification alone shall be given in evidence, and deemed, and taken to be the title and specification of the invention for which the letters patent have been or shall have been granted: Provided also that it shall be lawful for the Attorney General, or Solicitor General, before granting such fiat, to require the party applying for the same to advertise his disclaimer or alteration in such manner as to such Attorney General or Solicitor General shall seem right, and shall, if he so require such advertisement, certify in his fiat that the same has been duly made.”

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

[*205]

*1. *Disclaimer.*

A disclaimer may be entered by any person, who, as “grantee, assignee, or otherwise,” has *obtained* a patent.

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

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

(k) 2 Q. B. 466.

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

*In order to enter a disclaimer, the leave of the Attorney or [*206] Solicitor General must be obtained, and the granting of leave is entirely discretionary with either of those officers to whom the application may be made. The leave to enter a disclaimer must be certified by the fiat and signature of the Attorney General, (n) before it can be entered by the Clerk of the Patents, or enrolled in the manner required by the act.

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

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

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

*A party entering a disclaimer must take especial care that it does not violate the statute in this respect, for he enters the dis- [*207]

(l) R. 3.

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

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

(o) As to the titles of inventions, see Chap. IV. *ant.*, p. 43.

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

claimer at his own peril, and if it be contrary to the statute, it will be void, notwithstanding the leave granted by the Attorney or Solicitor General. (q) And if a disclaimer does not come within the provision of the act in this respect, it will not only be void, but may be very prejudicial to the patentee. It may contain (amongst the reasons for the disclaimer) an admission that there is something comprised in the title or specification for which the patent cannot be sustained.

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

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

When the disclaimer is completed and the *fiat* obtained, it is to be filed by the Clerk of the Patents, and enrolled with the specification, and then it becomes in effect a part of the patent and specification to which it relates. But the entry of a disclaimer will not have the effect of making a void patent good, *ab initio*, as to the undisclaimed parts of the invention, so as to make any person a wrong doer by relation. This was decided in the case of *Perry v. Skinner*, (t) in [*208] which it was held that although the act is obscurely worded, yet the intent could not have been to make a party a wrong doer by relation, and therefore that the act must be understood as if it had said that after a disclaimer had been filed and enrolled, the disclaimer should be deemed and taken to be part of such letters patent, or such specification, *from thenceforth* in all Courts whatsoever." The chief difficulty in construing this section of the act of Parliament arises from the introduction of the proviso that a disclaimer should not be receivable in evidence in any action (except an action of *scire facias*) pending at the time when it is enrolled, and which would seem to be unnecessary if a disclaimer could not affect any thing done prior to the enrolment. But notwithstanding this difficulty, the Court of Exchequer held, in the case of *Perry v. Skinner*, (u) just cited, that an act of Parliament cannot be construed, so as make a party a wrong doer by relation unless the words showing such an intent are manifest and plain. The object of a disclaimer must always be to cure some defect in a patent, or obviate some doubt respecting its validity, and as it must state the reason why it is made, it will in some cases bear evidence upon the face of it of an admission by the patentee, that there was something for which he could not sustain the patent.

With respect to the disclaimed parts in such cases, it is clear that the patentee by the disclaimer abandons all right to them; and as to the residue of the invention, he will be debarred from proceeding against any one for a prior infringe-

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

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

(s) See *Spilsbury v. Clough*, 2 Q. B. 406.

(t) 2 M. & W. 471.

(u) 2 M. & W. 471.

ment of the privilege, if he has admitted that it was void until the defect was cured by the disclaimer.

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

The proviso declares that a disclaimer is not to be receivable in evidence in any action or suit pending at the time it is enrolled, (except an action of *scire facias*) and that in such *actions or suits the original title and spe- [*209] cification alone are to be given in evidence. The intent of this proviso is, that a patentee shall not be enabled to give a disclaimer in evidence to the prejudice of any party against whom he may then have any action or suit pending, but it could hardly be intended that the defendant in such a suit should not be at liberty to make use of a disclaimer as evidence against the patentee, if it contains any admission respecting the prior invalidity of the patent. In such a case the disclaimer shows that the supposed privilege which the defendant is alleged to have infringed had no legal existence at the time when the alleged infringement was committed, and the patentee ought not to be permitted to enforce a patent against a defendant which he admits contained something that rendered it void; and it may be that that part of the invention which the defendant is charged with pirating, may be the very part which the patentee has disclaimed.

2. Memorandum of Alteration.

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

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

The patentee must be careful to see that any alteration he may seek to make, will not be such as, if valid, would have the effect of extending the exclusive right granted by the patent. The Attorney or Solicitor General will only examine a proposed alteration or disclaimer with a view to see how far it may affect the rights and interests of other parties, and the public in general, leaving the patentee to take care of his own interest, and if he enter a memorandum of alteration which is not warranted by the statute, it will be void. [*210] and may be very prejudicial to his interests.

The provision in the act that a disclaimer or alteration shall not be such as to extend the patent right, must however be understood with some qualification; for if a disclaimer or memorandum of alteration has the effect of rendering a void patent valid, it may be said in one sense to extend the patent right. It seems that the true question in all cases will be, whether a disclaimer or alteration made by a patentee would have the effect of extending the patent privilege, if the patent were a valid patent at the time the disclaimer or alteration is filed

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

and enrolled. If the disclaimer or alteration could not produce such an effect, then it would not be void as having a tendency to extend the patent right; but if the patent and specification, and the disclaimer or alteration, taken and construed together, purport or appear to be more extensive in effect than the patent and specification alone, then the disclaimer or memorandum of alteration is not warranted by the statute, and is therefore null and void.

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

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

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

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

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

SECTION III.

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

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

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

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

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

In three out of the four superior Common Law Courts the records are supposed to be in the custody of the chief Judge of the Court, and therefore all writs of error are directed to him alone, commanding him to return the records into the Court of Error; and he alone has the power of appointing the officers of the Court. But in the Chancery, which is the other *superior [*212] Common Law Court, the records are not in the custody of the Lord Chancellor, (who is, properly speaking,) the sole Judge of the Court; (b) but they are placed in the custody of the Master of the Rolls, who is, by virtue of his office, keeper of the records of that Court. (c)

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

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

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

The records of the Court of Chancery relating to a patent grant are, first the Privy Seal bill, or writ of Privy Seal, directed to the Lord Chancellor, and by virtue of which he makes the patent, and this writ when filed in Chancery becomes a record of that Court. Upon this writ is written the *recepti* required by the statute 18 Hen. VI. c. 1, which is also an entry of record. The patent made by the Lord Chancellor in pursuance of the writ of Privy Seal, is also a record of the Court of Chancery, (e) although it is delivered to the grantee as a muniment of his title. Letters patent are always [*213] enrolled or entered upon rolls called Patent Rolls, and such enrolments are records of this Court. A specification must also be enrolled within the time limited by the patent, and that enrolment is also a record of the Chancery. A disclaimer or memorandums of alteration must be enrolled with the specification, and must be considered as part of the same record.

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

With respect to the Privy Seal bill, or writ of Privy Seal, the Master of the Rolls has merely a right to the custody of it, in order to preserve it amongst the other records of the Court, but he has no authority to alter or amend it in any way. It is the writ upon which the Lord Chancellor's authority to make a patent was founded, and it is preserved amongst the records of the Court, in order to show by what authority the patent was made, (f) the patent itself

(b) 4 Inst. 79.

(c) The Master of the Rolls is now, under the statute 1 & 2 Vict. c. 91, the keeper of all the public records of the kingdom.

(d) See the title "Amendment," in Bacon's Abridgment, Comyn's Digest, and Viner's Abridgment; see also the Chapter on Amendment in Tidd's Practice, and Blackamore's case, 8 Co. R. 156, a; and Wynne v. Thomas, Willes, 563.

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

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

always referring to the writ by the usual conclusion, "By writ of Privy Seal." (*g*) This writ is issued by the Lord Privy Seal, under the seal of his office, and it can only be altered or amended by the same authority as that which made it, viz: the Lord Privy Seal. The Master of the Rolls will in all proper cases allow the Lord Privy Seal or his officer to have access to the writ for the purpose of altering or amending it in any way that may be necessary in pursuance of any authority received from the Crown, (*h*) but by the alteration it becomes in effect a new writ, (*i*) and must be again delivered to the Lord Chancellor, as his authority to alter and reseal the patent, and another *recepti* must be written upon the writ, or recorded in some other way in pursuance of the statute 18 Hen. VI., c. 1. (*j*) And when a party is applying to have a writ of Privy Seal altered, it seems to be proper that he should be [*214] required to deliver the letters patent to the proper officer of the Court before the writ is altered; for otherwise the party might afterwards neglect to carry in the patent to have it altered and resealed, and then there would be a patent in existence which would appear not to be warranted by the writ of Privy Seal.

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

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

Whenever the Lord Chancellor has executed a writ of Privy Seal, by making a patent in the form commanded, and it is afterwards discovered that a patent in that form is not that which was intended, the whole of the previous proceedings may, by her Majesty's command, be altered so as to make them according to the intent; and the altered writ of Privy Seal being redelivered [*215] to the Lord Chancellor, his Lordship thus acquires jurisdiction to make the patent correspond with the new form given him in the

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

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

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

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

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

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

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

(*o*) Beames' Orders, 67.

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

In Beames' Orders, (s) the form of order in *Sir Kenelm Digby's* case is given, from which it appears that the King had by letters patent granted to Sir K. Digby certain lands escheated to his Majesty by the death of J. C., without heir, part of which lands were in Kent, and were so mentioned in the office found, and in the bill signed for the patent, but at the Signet Office, "by mistake of the clerk taking the L for a K, *are mentioned to lie in [*216] com. Kank," and by that error were so mentioned both in the writ of Privy Seal, and the patent, and in the enrolment. Sir K. Digby then petitioned the King for a warrant to amend the patent, which was granted (signed by the Attorney General,) and upon seeing the King's bill, and the Signet bill, as altered in pursuance of the King's command, the Lord Chancellor ordered the writ of Privy Seal and the patent to be amended and resealed, and the enrolment to be also amended accordingly. It is also stated by the order in this case, that *the seal was to be taken from the patent*, and that it was then to be altered and resealed, which shows that when resealed, it would, in effect, be a new instrument.

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

The redelivery of an altered Privy Seal bill to the Lord Chancellor, does not make it imperative upon him to alter the patent accordingly, unless he is of opinion that the alteration will not unfairly prejudice third parties, and will not make the patent contrary to law. If the alteration sought to be made is unopposed, the patent will be altered and resealed, as a matter of course, unless the alteration appears to be objectionable to the Chancellor or his officers. If the

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

(q) See the case of *Knight v. Warren*, cited, *ante*, p. 213, n. (i).

(r) 1 Br. C. C. 578.

(s) P. 66.

alteration is opposed, as it may be on a *caveat* entered for that purpose, (s) the Lord Chancellor must then exercise his judgment on the matter, and make or refuse the alteration as he may think just or expedient under the circumstances. Thus in *Nichols'* case, (t) it appeared that the patentee had petitioned the Crown for a patent for an invention of "improvements in machinery for covering fibres applicable in the manufacture of braid and other fabrics;" but a mistake was made by a clerk in the Secretary of State's office, who prepared [*217] the Queen's warrant, and who introduced the word "recovering" into the title of the invention instead of the word "covering." This mistake was not discovered at the time, and not only the Queen's warrant, but all the other proceedings, including the Privy Seal bill, the patent, and the enrolment of the patent, contained the word "recovering" in the title instead of the word "covering;" and the docket-book, which is open to the public, and which is always resorted to by the public to obtain a knowledge of what a patent has been obtained for, also stated the patent to have been granted for improvements in machinery for *recovering*, &c. The patent was obtained in this way in April, 1838, and a specification was enrolled in October of the same year, in which the patent was referred to as a patent for "improvements in machinery for *covering*," &c. In the month of June, 1840, the patentee commenced proceedings against the London Caoutchouc Company for an alleged infringement of his patent, and the Company soon afterwards sued out a writ of *scire facias* to repeal the patent. Pending these proceedings, the patentee procured the Privy Seal bill and the prior proceedings to be altered by substituting the word "covering" for "recovering" in the title, and then without the writ of Privy Seal having been redelivered, he petitioned the Lord Chancellor to amend the patent accordingly, and carried the patent into Court to be resealed, when it was discovered that the patent had been altered after it was sealed, by erasing the letters "re" from the commencement of the word "recovering" in the title of the invention, but no explanation was given respecting the manner in which this alteration had been made. (u) The petition being opposed by the London Caoutchouc Company, Lord *Cottenham*, L. C., (without hearing the counsel for the Company,) said, that he would do nothing but what was usual, that is to say, that he should at all events only reseat the patent upon the Privy Seal bill being properly brought before him, and that he should not even do that without taking care that it should not prejudice other persons. And on a subsequent day his Lordship said, that the only terms on which he would entertain the application to amend the patent at all were, that the patentee [*218] should abandon and pay the costs of all proceedings then pending, and undertake not to bring any other action for the infringement of his patent up to that time. The petitioner declined to accede to these terms, and the Lord Chancellor, therefore, not only refused to grant the petitioner any relief, but also ordered him to pay the costs of the London Caoutchouc Company in opposing the petition. (x)

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

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

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

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

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

It is difficult to say what is the effect of such an alteration and resealing of a patent as in *Nichels'* case. The statute 18 Hen. VI. c. 1, requires that the day of the delivery of the writ of Privy Seal to the Chancellor shall be entered of record, which is always done by the usual *recepti* being written in the margin of the writ. When an alteration has been made in the writ of Privy Seal, it must be redelivered to the Chancellor, and a new *recepti* written upon it. (y) It seems therefore that the alteration in the writ of Privy Seal makes it essentially a new writ. The statute just cited also enacts, that a patent made in pursuance of the writ shall bear date the day of the delivery so recorded, and not before; and that if any letters patent be made to the contrary they shall be void. In *Nichels'* case the redelivery of the writ of Privy Seal was recorded by a *recepti* in the usual way, but the patent, after it had been altered, was resealed as of the same date as before; and therefore the altered patent bore date on a day before the day of the redelivery of the writ of Privy Seal, which seems to be contrary to the provisions of the statute of 18 Hen. VI. c. 1, just cited. The patentee however was in a difficult position, for his patent was void for want of a proper specification, and therefore it was necessary to procure an alteration in the patent; if he had procured the altered [219] patent to be resealed as of the day when the altered writ of Privy Seal was delivered to the Lord Chancellor, the patent would have borne date on a day long after the enrolment of the specification, and the patent would thus have been avoided by reason of the want of novelty in the invention at the date of the patent. The course which the patentee took was that which was the best under the circumstances, but it is very doubtful whether the alteration has given him any better title than he before possessed. The apparent want of jurisdiction in the Lord Chancellor to make a valid amendment of a patent under such circumstances is a serious defect in the law, which ought to be remedied by Parliament.

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

The enrolment of a patent is an entry of the patent upon record, which is made for the purpose of showing what the Lord Chancellor has done in pursuance of the Queen's writ of Privy Seal. This entry is made upon one of the rolls called the Patent Rolls, for the current year of the Queen's reign: and although the enrolment is, in practice, (for the sake of convenience merely,) copied from the writ of Privy Seal, it is in fact an enrolment of the patent, and not of the writ of Privy Seal. (a) After the enrolment has [220] been prepared, it passes into the custody of the Master of the Rolls, who thus acquires jurisdiction over it. (b)

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

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

(a) See *Nichels'* case, Turn. & Phil. 36. (b) See the practice, *post*, Chap. XII.

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

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

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

Thus in *Nichels'* case, (d) the Master of the Rolls had ordered an alteration to be made in the enrolment of the patent, which had the effect of making the enrolment vary from the patent, and upon an appeal to the Lord Chancellor against this order of the Master of the Rolls, it was objected by the respondents that the Lord Chancellor had no jurisdiction, but Lord *Cottenham*, L. C., held that he had jurisdiction, and said that the Master of the Rolls either had jurisdiction or no jurisdiction; if he had jurisdiction, then the Lord Chancellor had jurisdiction also upon appeal against his order; and that if the Master [221] of the Rolls had no jurisdiction, the Lord Chancellor had jurisdiction to set aside his void order.

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

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

(c) 4 Beavan, 567, 570; see the same cases mentioned in a note to Mr. Webster's report of Sharp's case, 1 Webs. R. 647, n. (b).

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

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

(f) *Ante*, p. 218.

(g) 4 Beavan, 563.

Lord Chancellor, his Lordship thought it best to raise the question respecting the legality of such an alteration in the enrolment by making an order, and thus compelling the opposing party to carry the case before the Lord Chancellor by way of appeal.

Upon an appeal to the Lord Chancellor (Lord *Cottenham*,) this order was discharged, and his Lordship said in delivering judgment, "I have communicated with the Master of the Rolls since the case was argued, and the Master of the Rolls entirely concurs with me in the opinion which I understand that he intimated when the case was before him, that nothing can *be [*222] permitted to remain which will enable the party to produce an enrolment differing from the letters patent. If any doubt could exist upon that point upon other grounds, it would be removed by the statute of Elizabeth, (*h*) which enables parties, by producing the enrolment, (*i*) to dispense with the necessity of producing the letters patent, that provision evidently proceeding on the assumption, that the enrolment correctly represents what is contained in the letters patent. The title of the party derived from the Crown rests on the authority of the letters patent, the enrolment being only permitted to be used for the purpose of showing what the patent was, or rather of preventing the danger which might otherwise arise from attempts to alter the letters patent, which, being in the possession of the party, are of course more exposed to frauds and other casualties than the enrolment, which is kept in this Court, can be." And after suggesting an application for an amendment of the patent, his Lordship added, "The patentee may be assured that he will, in no event, be permitted to produce, as evidence of his patent, an enrolment which does not represent what the letters patent contain."

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

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

*These records or rolls also pass into the custody of the Master [*223] of the Rolls, and as the keeper of them he has jurisdiction to make any alteration or amendment which may be necessary to make the enrolment correctly represent what the specification was at the time when it was brought into Court to be enrolled. Cases of this kind have occurred in which the enrolments have been amended by order of the Master of the Rolls, and there can be no question about the legality of such amendments.

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

Thus in *Redmund's* case, (*m*) it appeared that the clerk who had copied the specification, had by mistake transposed some of the references to the plan,

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

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

(*k*) Vide *ante*, Chap. VII. p. 151, respecting the specification.

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

(*m*) 5 Russ. 44.

and nearly seven years after the date of the patent the specification having been corrected, the enrolment was by order of Sir John Leach, the Master of the Rolls, altered so as to make it conformable with the altered specification.

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

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

In *Sharp's case*, (s) Lord Langdale, M. R. said, speaking of these cases of amendment, or rather alterations:—"In every case which has occurred, it has plainly been intended to do no more than amend mere slips or clerical errors made by the parties, or the agents of the parties, who, intending to make an [*224] accurate enrolment, have, by mere inadvertence, *made an enrolment which was not what it purported to be, a true statement of that which the party intended at the time; and not only has strict evidence of error been required, but in order to enable any third party to dispute the validity of the amendment, and of the order, it has been directed that the order itself should be indorsed on the enrolment."

It seems however that in making these orders, some objections to them have been lost sight of. The proviso in a patent which requires the specification, makes it necessary that the patentee should do two things, which are perfectly distinct from each other. He must firstly ascertain and describe the nature of his invention, and the manner of using it, by an instrument under his hand and seal, and that he must do within the time limited in the proviso. He must also, within the same time, cause that instrument to be enrolled or entered upon the rolls of the Court for the benefit of the public. These two things are perfectly separate and distinct; and in actions at law issues are frequently taken separately upon each of them. (ss) When the fact is put in issue, the patentee must show that he had made a sufficient specification within the time limited by the patent, and that quite independent of the question respecting the enrolment. If the patentee has made a sufficient specification within due time, it is unnecessary to alter it; and if the specification was not sufficient, then the patentee has not complied with the proviso, and his patent is void. But it is a principle in law that a record cannot be contradicted, so far at least as it alleges an act done by the Court, and a record must always be presumed to have been in the same state ever since it was made. (t) It may therefore appear in a case such as those alluded to, that a sufficient specification was enrolled on a certain day, and if so, no person can be permitted to deny the record in that respect, even if the specification itself, and also the enrolment of it, were clear and indisputable, until long after the time limited for the enrolment had elapsed. The indorsement upon the roll of the order under which an alteration was made will not in any way assist a person who may desire to object to the [*225] enrolment, *for the order forms no part of the record; and it would be contrary to all principle to allow a record to be contradicted or varied by anything which is not of as high a nature as itself. By allowing such an amendment as this, therefore, it seems that a patentee is enabled by

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

(p) 13 Jan. 1830.

(r) 17 August, 1836.

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

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

(o) Ibid.

(q) 15 April, 1836.

(s) 1 Webs. R. 646.

the record to prove the performance of part of the condition contrary to the fact, and the opposite party is estopped by the record from denying what the record thus untruly alleges.

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

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

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

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

These observations are made with the utmost deference to the very eminent Judges who have allowed alterations to be made; and with respect to the law, as the writer humbly conceives it to be, not as it ought to be. There can be no question that the Master of the Rolls ought to be authorized *to [*226] allow such alterations to be made, and all doubt on the subject ought to be set at rest by the Legislature.

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

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

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

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

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

(x) See the case of *Wynne and Another, demandants, Thomas, tenant, and Apperley and Wife, vouchers*, Willes, 563.

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

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

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

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*CHAPTER IX.

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

- SECT. I.—*Of the Nature of the Right or Property.*
 II.—*Of Assignments in Fact and in Law.*
 III.—*Of Licenses.*
 IV.—*Of Surrenders.*

SECTION I.

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

It has frequently been contended that every person has as much natural and moral right to the produce of his mental exertions, as to the profits of his corporeal labour or industry. The subject was much discussed in the copyright case of *Millar v. Taylor*, (a) to which the reader is referred. The composition of a literary work is not, however, quite analogous to the invention of a new manufacture. The author of a literary work, it may correctly be said, actually *creates* the work which is the produce of his labour; he does not merely invent or discover it, for it could not have any previous existence. An author, therefore, may very fairly contend that he has a natural right of property in his work, and the law gives him an exclusive copyright as a reward for his labour, *without the aid of any grant from the Crown*. But a person who invents or discovers any new manufacture, merely discovers an art of practically applying some of the laws of nature in the manufacture or production of articles of commerce. The laws or principles which an inventor thus [*228] applies *must have had existence, and must have been capable of the practical application invented, prior to the discovery being made; although, perhaps, both the laws or principles themselves, and the particular application of them, may have been unknown to the world.

An inventor, in fact, does not create, but only invents or finds out something which had a prior existence, although unknown to the world, in precisely the same way as persons make discoveries in geography and astronomy. If Milton

(z) 3 Beaven, 245; and 1 Webs. R. 641. (a) 4 Burr. 2303.

had not written "Paradise Lost," it is extremely improbable that it would ever have been written at all. But if Watt had never published his invention, it would most probably have been discovered, long ere now, that a condensing steam engine is worked with more economy when the steam is condensed in a separate vessel, and not in the cylinder.

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

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

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

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

The law does not deprive an inventor of any advantage he may obtain from the secret use of his invention, but it will *not recognize anything [*229] like a right of property in his invention, nor will it interfere to prevent others from using the invention, if they obtain a knowledge of it without being guilty of any breach of trust.

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

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

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

(c) 2 Ves. & B. 218.

be the same person, and his trade or production the same, as in *Hogg v. Kirby*, (d) combining imposition on the public with injury to the individual. This is not that sort of case. The observation is correct, that the bill stating [*230] the defendant's medicine to be spurious, asserts it not to be the *same as the plaintiff's. The defendant does not hold himself out as the representative of Swainson, setting up a right in that character to the medicine purchased by him; but merely represents, that he sells not the plaintiff's medicine, but one of as good a quality. He is perfectly at liberty to do so. If any exclusive right in this medicine ever existed, it has long expired. The foundation of this bill, therefore, the exclusive right asserted by the plaintiff, failing, all the consequential relief falls with it; and the demurrer must be allowed."

In the case of *Newberry v. James*, (e) it appeared from the bill filed in the Court of Chancery, that by certain articles of agreement between Dr. James, the inventor and proprietor of certain pills for the gout, rheumatism, &c., and Newberry, the plaintiff's deceased father, it was agreed that James should prepare the aforesaid pills, and sell and deliver them to Newberry at a certain rate, to supply his customers, and that James should not sell any of such medicines to any other person except in the course of his private practice. Newberry was also to be instructed in the secret of preparing the pills, but it was not to be disclosed by him except to his representatives after his death. It also appeared that letters patent had been granted in 1747, to James, for the exercise of his invention; and that James had assigned to Newberry, his executors, &c., one moiety of the invention during the term of fourteen years. The agreement contained in the articles was to be continued so long as either of the parties, their executors, &c., or any or either of them, should desire. Newberry bequeathed to the plaintiff all his interest in the preparing and vending the medicines. The defendants had succeeded to the rights of James, who died in 1776. The bill prayed a specific performance of the agreement, and an injunction to restrain the defendants from disclosing the secret of preparing the medicines except to the persons mentioned in the agreement. An injunction was granted *ex parte*, only as to the sale of the medicines, expressly without prejudice to any question that might be made as to the possibility of sustaining such an injunction. On a motion to dissolve the injunction, Lord [*231] *Eldon*, L. C., said, "That the difficulty in such a case was, how *to decree the specific performance of the agreement. Either it was a secret, or it was none. If a secret, what means did the Court possess, of interfering so as to enforce its own orders? If none, there was no ground for interfering. In this case, the medicines in question were the subject of a patent which had expired; and the agreement which the bill sought to enforce was an agreement by which, independently of the patent, the proprietors had entered into covenants not to sell that which was the subject of the patent except to each other. But in order to support a patent, the specification should be so clear as to enable all the world to use the invention so soon as the term for which it has been granted is at an end." Lord *Eldon* concluded by saying that "He thought he ought not to continue the injunction; and that, if he did not mention the case again, (which he did not do,) his opinion must be considered to be that the injunction must be dissolved."

In the same case a similar agreement had been made between James and the plaintiff respecting an invention by James of certain pills called Analeptic Pills, but for which no patent had been obtained. Lord *Eldon* remarked, that "With regard to the Analeptic Pills, if the art and method of preparing them were a

(d) 8 Ves. 215.

(e) 2 Mer. 446.

secret, what signified an injunction, the Court possessing no means of determining, on any occasion, whether it had or had not been violated? The Court of Chancery could do nothing but put the parties in a way to try their legal rights by an action. That was the utmost extent to which it would go, and he would not even order the injunction to be continued in the mean time, till an action should be tried. The only way by which a specific performance could be effected would be by a perpetual injunction; but this would be of no avail, unless a disclosure were made to enable the Court to ascertain whether it was or was not infringed; for if a party comes here to complain of a breach of injunction, it is incumbent on him first to show that the injunction has been violated."

In the case of *Williams v. Williams*, (*f*) the plaintiff in his bill (filed in Chancery) stated that he had entrusted the defendant (his son) with a secret of making a medicine. Upon a motion to dissolve an injunction which had been obtained, Lord *Eldon*, L. C., said, "So far as the injunction goes [232] to restrain the defendant from communicating the secret, upon general principles, I do not think that the Court ought to struggle to protect this sort of secrets in medicine. The Court is bound indeed to protect them in case of patents to the full extent of what was intended by the grant of the patent, because the patentee is a purchaser from the public, and bound to communicate his secret to the public at the expiration of the patent. Then whether the principle can be extended to such a case as this—whether a contracting party is entitled to the protection of the Court in the exercise of its jurisdiction to decree the specific performance of agreements, by restraining a party to the contract from divulging the secret he has promised to keep, that is a question which would require very great consideration. But the present case is not one which calls for the determination of it. If the defendant has already disclosed the secret, the injunction can be of no use. If he only threatens to disclose, it then becomes necessary to look at his affidavit; and by that he insists that what he has to disclose is no secret at all—then how is the Court to try this question? Or what can the Court do with the case altogether?" And his Lordship dissolved the injunction.

In the case of *Fovatt v. Wingard*, (*g*) a motion was made for an injunction to restrain the defendant from making use of or communicating certain recipes for veterinary medicines, and from printing and publishing certain papers of directions for the mode of administering them. The plaintiff who was the proprietor of the medicines had employed the defendant as an assistant under an agreement, by which he was to be instructed in the general knowledge of the business, but was not to be taught the mode of composing the medicines; afterwards the defendant left the plaintiff, and the latter had lately discovered that he had while in his service surreptitiously got access to his book of recipes and copied them, and was selling the medicines with printed papers for administering them, which were almost literal copies of those composed by the plaintiff. Lord *Eldon* granted the injunction upon the ground of there having been a breach of trust and confidence; but confined it, so as not to prevent the defendant from administering the medicine to any animals then under [233] course of treatment, it being stated in the papers of directions, that a sudden discontinuance would be prejudicial.

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

(*f*) 3 Mer. 157.

(*g*) 1 Jac. & W. 394.

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

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

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

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

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*SECTION II.

Of Assignments of Patent Rights in Fact and in Law.

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

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

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

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

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

(*i*) *Ante*, Chap. IV. p. 53, and Chap. V. s. 1, p. 73.

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

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

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

(*n*) Co. Lit. 9, b. 172, u.; Shep. Touch. 229-231.

and the rule of law is, that things which can only be granted or created by deed, can only be assigned by deed. (o)

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

Lord *Ellenborough*, C. J., said in the case of *Power v. Walker*, (q) respecting the assignment of a copyright, "if the license which is the lesser thing must be in writing, *a fortiori*, the assignment which is the greater thing must also be." (r) "The same principle seems to be clearly applicable [235] to assignments of patent rights; and as the patent requires a license to be granted under hand and seal, that is by deed, the conclusion seems almost irresistible that an assignment must also be made by a deed or instrument under hand and seal.

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

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

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

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

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

The condition now inserted in patents provides, that if the patent, or the liberties and privilege thereby granted, shall become vested in, or in trust for more than twelve persons, or their representatives, at any one time, as partners dividing or entitled to divide the benefits or profits obtained by [236] reason of the patent (including executors or administrators for the single person they represent) then the patent is to be void.

This condition seems to be inserted with the object of preventing a patent from being made the means of creating an oppressive monopoly by a large number of persons associating together for the purpose of working the patent privilege. In this clause in a patent it seems that the patentee is not prevented from assigning to more than twelve persons if the assignees do not become

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

(p) See *Vile Chanter v. Dewhurst*, 12 M. & W. 823.

(q) 3 M. & S. 9.

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

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

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

(u) 2 B. & P. 43.

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

entitled to the profits arising from the patent *as partners*, for if the assignees are entitled severally, and work the patent privilege independent of each other, and not as partners, there will be such a competition amongst them, that the public will be protected, and will not suffer from the effects of any monopoly.

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

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

Upon the assignment of a patent right, the person making the assignment usually enters into covenants with the assignee respecting his title, and the validity of the patent; and if the deed does not contain any express covenant on the subject, it seems that a covenant for title on the part of the assignor will [237] not be implied from the words, "bargain, sell, and assign," contained in the operative part of the instrument. (*b*) For the law will not create any covenant respecting anything merely of a personal nature.

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

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

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

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

A patent does not mention all the cases in which persons may become assignees in law; but the words executors, administrators, and assigns, which are added after the name of the patentee, and which are clearly words of limi-

(*y*) *Duvergier v. Fellows*, 5 Bing. 218; S. C., in error, 10 B. & C. 826.

(*z*) *Oldham v. Langmead*, cit. 3 T. R. 439; *Bowman v. Taylor*, 2 A. & E. 278.

(*a*) 2 A. & E. 278.

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

(*c*) 3 B. & P. 565.

tation, sufficiently indicate the intention of the Crown that the patent privilege is to be of an assignable nature; and the law implies *therefore [*238] that it is to be assignable either by deed or in law, in the same way as other chattel interests.

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

SECTION III.

Of Licenses.

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

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

*The power of granting licenses is thus expressly conferred upon [*239] a patentee, and those claiming under him. And provision is made that the power shall be granted only in a particular manner, that is under hand and seal. Every instrument under hand and seal is not a deed, but as the patentee must by the instrument make a GRANT of an authority or permission, it seems that a deed must be intended.

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

Under the old form of condition against an assignment to more than five persons, it was considered doubtful whether a grant of a license to more than five persons was not such an assignment, within the meaning of the condition,

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

(*e*) *Hesse v. Stevenson*, 3 B. & P. 565. (*f*) *Ante*, p. 234.

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

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

(*i*) 12 M. & W. 823.

as would avoid the patent. (*k*) In order to obviate this doubt a clause is now inserted in all patents, whereby it is provided, that nothing therein contained shall prevent the granting of licenses in such manner, and for such considerations, as they may by law be granted. (*l*)

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

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

Thus, a license may be granted so as to continue in force during the whole of the term mentioned in the patent, or for any shorter term. So it may extend over all parts of the realm comprised in the patent, or it may be restricted to some particular district or districts. And a license may be granted [*240] so as to entitle the licensee to use the whole of the invention, *or only some particular portion of it, or to use it only for some particular purpose.

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

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

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

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

Unless the patentee retains a right to use the invention himself, an exclusive license for the entire term of the patent shows that the parties to it intended the licensee to have the *sole* right to exercise either the whole or some particular portion of the privilege comprised in the patent; and also, that the patentee [*241] should not have power to grant any other license to use the patent privilege, or the portion of it which is comprised in the license.

(*k*) See 6 Jarm. Byth. Conv. 188, n. (*a*). (*l*) Vide *ante*, Chap. IV. pp. 66, 68.

(*m*) See respecting the difference between a license and a grant, 15 Vin. Abr. tit. License (A).

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

(*o*) See Noy, Max. p. 4, dial. ten, p. 45; Winter v. Foweracres, 2 Rol. R. 39; Thompson v. Brown, 7 Taunt. 356, and the cases there cited.

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

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

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

It was determined in the case of *Protteroe v. May*, (*s*) that an exclusive license granted to more than twelve persons does not invalidate the patent under the condition against assigning to more than twelve persons. But there were reservations to the licensees made by the license in that case, and also provisions for determining the license, from which it is to be inferred that the parties did not intend the instrument to operate as an assignment, and if it did not operate as an assignment, it could not affect the validity of the patent. The reservation of a sum of 2*l.* for every ton of soap made by the [*212] licensees in that case *during the continuance of the license*, shows that the intent of the parties was, that the instrument should operate as a license and not as an assignment; and indeed the payments to be made by the licensees, shows that they were not to be entitled to divide the profits to be obtained by reason of the patent, in such a way as to bring them within the meaning of the condition against an assignment to more than twelve persons.

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

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

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

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

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

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

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

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

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

Licenses are, however, frequently granted to licensees, their executors, administrators, and assigns, and then they become of course assignable and [243] transmissible in the same way as a patent privilege. (*y*) And it would seem that the assignment of a license, like the assignment of a patent, ought to be made by deed under hand and seal.

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

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

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

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

Therefore, in all cases in which a licensee intends to have the benefit of covenants by the patentee for his title to grant the license, care should be taken to insert express covenants to the effect intended by the parties. (*d*) And in some cases licensees are fairly entitled to such covenants, especially where [244] being themselves without the means of ascertaining the validity of the patent, they may, on the faith of the license and the validity of the patent, embark considerable capital in business for the manufacture of the patent article.

When a license is granted in consideration of periodical or other payments, it usually contains covenants on the part of the licensee with the patentee to pay the sums reserved. And where the payments reserved are to vary according to the extent to which the licensee shall use the privilege, the license also

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

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

(*z*) See *Plowd.* 308.

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

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

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

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

contains covenants by the licensee to render accounts, to be properly verified, and sometimes to permit periodical inspections of premises, machinery, &c. And in cases where payments are reserved, and covenants are entered into by the licensees, it is usual to insert conditions avoiding the licenses if the licensee shall fail to pay any of the sums reserved, or to perform any of the covenants. (e)

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

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

We have seen, (h) that a patentee cannot, as between himself and a person to whom he has assigned his patent, be permitted to question the validity of the patent. [245] And it has been held that the same doctrine is applicable as between a patentee and his licensee. (i)

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

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

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

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

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

(f) See 5 Co. R. 16, b, and 17, a. (g) See Forms in the Appendix.

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

(i) *Baird v. Neilson*, 8 Cl. & Fin. 726. (k) *Bowman v. Taylor*, 2 A. & E. 278.

(l) *Bowman v. Rostron*, 2 A. & E. 295. (m) *Taylor v. Hare*, 1 N. R. 260.

in the case of *Hayne v. Maltby*; (n) and although some doubt was expressed [*246] *by the Court of Queen's Bench respecting the authority of that case in *Bowman v. Taylor*, (o) yet it is conceived that the only doubt is whether the defendant, in *Hayne v. Maltby*, was not estopped from denying the validity of the patent, not whether he might not set up the invalidity of the patent as an answer to the action in case he was not estopped.

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

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

SECTION IV.

Of the Surrender of a Patent.

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

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

[*247] The surrender of a patent must be made by deed, enrolled *in Chancery. (s) A surrender is of no effect until it is enrolled, even if the patent be cancelled, (t) for the rule of law is, that nothing can be conveyed to the Queen except by matter of record. (u)

(n) 3. T. R. 438.

(o) 2 A. & E. 278.

(p) 4 M. & W. 295.

(q) But see *Chanter v. Dewhurst*, 12 M. & W. 823.

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

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

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

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

*CHAPTER X.

[*248]

OF THE REMEDIES FOR PATENTEES, AND FOR THE PUBLIC RESPECTIVELY.

- SECT. I.—*Of the various Remedies provided by Law for Patentees and the Public.*
- II.—*Of an Action for the Infringement of a Patent.*
- III.—*Of a Suit in Equity to restrain the Infringement of a Patent, and obtain an Account of Profits.*
- IV.—*Of an Action for Penalties for counterfeiting a Patentee's Name or Device.*
- V.—*Of other Remedies for Patentees.*
- VI.—*Of an Action of scire facias to repeal a Patent.*
- VII.—*Of the Revocation of a Patent.*

SECTION I.

Of the various Remedies provided by Law for Patentees and the Public respectively.

It is evident that a privilege, such as that granted by a patent for an invention, would be worthless if the law did not provide some remedy for the patentee against those who may invade it. The right to any species of corporeal property may to a great extent be vindicated by the physical means at the command of the owner; but with respect to an incorporeal chattel right, such as a patent privilege, which is a mere creature of the law, the proprietor must depend almost entirely upon the law itself for vindication and support.

It is to be regretted that the remedies which the law has provided for patentees are very imperfect, and insufficient for the protection of their rights from invasion.

Many of the imperfections of those legal remedies, however, have arisen from the peculiar nature of patent rights, *and the difficulty of [*249] providing adequate remedies for patentees without producing too great an invasion of the rights of the public. We have seen, (a) how much doubt and uncertainty has prevailed as to what can be made the subject of a patent privilege, and there has been nearly as much uncertainty (b) respecting the degree of novelty, and the utility which an invention must possess in order to support a patent. When the existence of so much perplexity and confusion in the law respecting the nature and effect of patent privileges is remembered, it cannot be considered extraordinary that the remedies provided for patentees and the public are very far from being perfect.

Many of the grievances under which patentees formerly laboured have been recently removed by the legislature, (c) and others have ceased to exist

(a) Vide *ante*, Chap. V. sec. 1, p. 77.

(b) Vide *ante*, Chap. V. ss. 2 & 3, pp. 102, 149.

(c) See 5 & 6 Will. IV. c. 83; 2 & 3 Vict. c. 67; and 7 & 8 Vict. c. 69.

since our Courts have begun to construe the law more liberally in favour of patentees.

In former times slight defects were held sufficient to avoid patents, and our Courts seemed always to look upon patent rights with the utmost jealousy. This feeling against patentees was doubtless produced by the widely spread and deeply rooted aversion to all monopolies which was engendered by the unrelenting oppression practised by means of patent grants previous to the passing of the Statute of Monopolies. That statute completely suppressed all unlawful grants, and most effectually guarded the rights of the public against illegal monopolies; but notwithstanding the securities which the statute provided for the public against illegal monopolies, it is singular enough that a period of two centuries should have elapsed before the public prejudices against grants of patent privileges to inventors disappeared, and before the Judges began to determine questions respecting patent rights fairly between the patentees and the public.

Our Courts now universally adopt the principle laid down by Lord *Eldon*, L. C., in the case of *Cartwright v. Eamer*, (*d*) that a patent contains a bargain made between the public (represented by the Crown) and the patentee, to be [*250] judged of *like other bargains. And accordingly any question which may now arise respecting the validity of a patent for an invention will be determined fairly and impartially between the parties in litigation, and without any strained or strict construction being put upon the law, or patent, in favour of or against either party.

If the reported patent cases which have been decided in our Courts of Law are examined, it will be found that in a great majority of those which were formerly determined against patentees, the party failed to support their patents on the ground of the insufficiency of their specifications. And, indeed, if we look at the vague and meagre descriptions of their inventions which patentees were formerly in the practice of inserting in their specifications, we cannot be surprised that our Courts should have held that those instruments did not sufficiently comply with the conditions or provisoes contained in patents by which they are required to be enrolled.

But the decisions of our Courts avoiding patents on the ground of insufficient specifications, have been productive of great benefit to the public, and indeed to patentees themselves. For specifications are now drawn in a manner much more perfect than they were formerly, (although there is still room for very considerable improvement,) and consequently not only are the public now more frequently put in possession of the information they are entitled to receive, but patentees much less frequently fail to support their patents, on the ground of the insufficiency of their specifications.

The chief remedies of which a patentee may avail himself in case his privilege is invaded, are, an action at Law, and a suit in Equity, against the violators of his privilege, both or either of which he is at liberty to adopt.

By an action at law a patentee may recover, from a person who has violated his patent, damages for the injury which he has sustained by the violation of his right. In a suit in Equity, the patentee may not only compel a person who has infringed his privilege to account for all the profits which he has made by the piracy, but may also obtain an injunction, restraining the guilty party from again infringing the patent.

[*251] Patentees are also enabled by the statute of 5 & 6 Will. IV. *c. 83, s. 7, to maintain actions for penalties against those who may counterfeit any names or devices upon their patent articles.

(*d*) 14 Ves. 131, 136.

The remedies which the law provides for the public against illegal patents are twofold:—*firstly*, Any one against whom proceedings may be taken by a patentee, is enabled to defeat the action or suit by showing that the patent in question is void; and, *secondly*, Any person prejudiced by an illegal patent is entitled, upon certain terms, to bring an action, called an action of *scire facias*, in the name of the Queen, against the patentee or his assignee, for the purpose of repealing the patent.

Patents always contain a proviso under which they may be avoided by the Queen or her Privy Council, if they are found to be contrary to law. (*d*)

SECTION II.

Of an Action at law for the Infringement of a Patent.

THE injury which a patentee sustains by the infringement of his patent entitles him to maintain an action at law against the wrong doer, to recover compensation for the damage he has sustained. (*e*)

Such injuries are in law technically denominated *torts*, but as the wrongful act is not committed with any direct force or violence, and the injury is only the indirect effect of the wrongful act of the defendant, the form of action which a patentee can maintain is that description of action of *tort* called an action of *case*, or *trespass on the case*. (*f*)

In such an action, the patentee or other party in whom the legal right to the patent privilege was vested at the time of the infringement, must be made plaintiff, and the person who has directly or indirectly committed or authorized the alleged wrongful act must be defendant.

A patentee who has not assigned any part of his privilege must be the sole plaintiff. But if a patentee has assigned over to another the whole of his privilege, he ceases to have any interest, and cannot maintain an action for the infringement *of the patent. And if a patent be assigned to a single person, he alone must be plaintiff in an action for infringing [*252] it; and the patentee cannot be made a co-plaintiff, for he has ceased to have any interest in it. If there are several patentees, they may all join in bringing the action; and if a patentee has assigned a part only of his patent right, he and his assignee may be joined as plaintiffs in any action for infringing the patent. (*h*)

And if a patent has been assigned in several shares, all the assignees may join in bringing an action; and it is conceived that it makes no difference whether the title of the several assignees accrues to them by only one or by several deeds. But it has never been decided whether one of several patentees, or an assignee of a portion of a patent privilege, can sue alone for the damages which he has sustained by the infringement of the patent. There does not seem to be any good reason why such a part proprietor should not be able to sue alone, although the language of the Court of King's Bench in a somewhat similar case (*i*) seems to be an authority to the contrary.

(*d*) See the condition, *ante*, p. 62, and in the Form of Patent in the Appendix, Chap. II. s. 1.

(*e*) Bull. N. P. 76.

(*f*) See Chit. on Pl. Vol. I.

(*h*) See *Boulton & Watt v. Bull*, 2 H. Bl. 463, and several subsequent cases in which patentees and assignees have joined in bringing actions.

(*i*) *Weller v. Baker*, (Case of Dippers, at Tunbridge Wells,) 2 Wils. 423.

If a patentee dies during the existence of his patent right, we have seen that his interest vests in his executor or administrator, (*k*) and the executor or administrator will of course have the same right to an action for an infringement of the patent as the deceased patentee had, or would have had, if living. If there are several executors, all must join in bringing an action, for a probate obtained by one of such executors inures to the benefit of all. (*l*) If there are several administrators, they must all be joined as plaintiffs in the action.

The assignees of a bankrupt or insolvent patentee may maintain an action for a violation of his patent right; (*m*) for, as we have seen, (*n*) the whole of the bankrupt or insolvent patentee's interest passes to his assignees by virtue of their appointment. All the assignees must of course join in bringing any action.

[253] It has never been decided whether the assignees in law of a proprietor of part of a patent privilege can be joined as plaintiffs with the other proprietors, but there seems to be no reason why they should not.

The action may be brought against several defendants, where they have been guilty of any joint act of infringement, but not otherwise. And if several persons have been guilty of a joint infringement, the plaintiff may, at his election, sue all or any number of them at his election. (*o*)

The declaration (*p*) usually commences with an averment, that the patentee was the true and first inventor of the invention comprised in his patent, and that it was a new invention. Such an introductory averment does not, however, seem to be essential; and it is sometimes omitted, particularly when brevity is desired. The declaration then states the grant contained in the patent upon which the defendant is sued, and that may be done either by setting out the operative words of the patent, or by stating the effect of the instrument as a grant to the patentee and a prohibition to all other persons.

In declaring upon a patent it must be shown under what seal it was made. (*q*) English patents for inventions granted since the union with Ireland, must have been made under the Great Seal of the United Kingdom. (*r*) A declaration upon such a patent therefore describes it as "letters patent under the Great Seal of the United Kingdom of," &c. (*s*) English letters patent are always dated at Westminster, (being the place where the Court of Chancery usually sits,) and of the day they are sealed with the Great Seal. A declaration therefore usually describes the patent to bear date at Westminster, of the day upon which they purport to be made. A date is not necessary to the validity of a patent, (*t*) but if it be not dated, the plaintiff, in declaring upon it, must show when it was made, for otherwise it would not be certain whether the act complained of as an infringement was done within the term granted by the patent. In such a case the plaintiff may have recourse to the writ of Privy Seal and [254] *recipi*, the enrolment of the patent, and the docket paper, and state the time of the making of the patent as accurately as possible. In ancient times the clerks in Chancery not unfrequently omitted the dates of letters patent, but such mistakes are now of very rare occurrence.

(*k*) Vide *ante*, Chap. IV. p. 58; Chap. IX. s. 237.

(*l*) See Williams's Law of Executors.

(*m*) See the case of *Brown v. Elce*, 1 C. & P. 558; 6 B. & C. 169.

(*n*) Vide *ante*, Chap. IX. s. 2, p. 238. (*o*) 1 Saund. 291, c.

(*p*) See the Forms of Declaration, *post*, Appendix, Chap. II. s. 4.

(*q*) Com. Dig. Pat. (H).

(*r*) See *R. v. Bullock*, 1 Taunt. 71; *R. v. Vandell*, 4 T. R. 521.

(*s*) See the Form of Declaration in the Appendix, Chap. II. s. 4.

(*t*) Plowd. 231; Vin. Abr. prerog. (G, b, 3).

In declaring upon letters patent it is necessary to make profert of them, that is, to make an offer to prove what the plaintiff is about to state respecting the effect of them, by producing and showing them to the Court. (*u*) If profert be omitted, the declaration will be bad on special demurrer; and before the statute 4 & 5 Ann. c. 16, the omission was a good cause of general demurrer. (*v*)

An action is never brought for the infringement of a patent until after the invention has been specified; and as the general language of the title gives little or no information respecting the real nature of an invention, if such an action were to be brought before specification, it is most probable that a jury would not give him a sufficient amount of damages to carry costs. The time for specification then having passed before the commencement of the action, it seems that the plaintiff must show that he has performed the condition of the patent, which requires him to enrol a specification; (*y*) and therefore the declaration in such an action always states in what manner the patentee has complied with that condition. It is not, however, usual to set out the specification in the declaration at full length, but merely to allege that the patentee has, in pursuance of the proviso contained in the patent, described the invention by an instrument under his hand and seal, and has caused that instrument (which is commonly called the specification) to be enrolled in Chancery, within the time limited by the patent.

In some cases, however, it is desirable, if not necessary, to set out the description of the invention contained in the specification; as, for instance, where there has been a disclaimer or memorandum of alteration filed and enrolled under the statute 5 & 6 Will. IV. c. 83, s. 1, which perhaps could not be understood without reference to the specification.

Although a specification is an instrument under hand and seal, [255] yet it is not a deed, nor is it an instrument of which the plaintiff need to make profert in his declaration.

When any part of the title or specification has been disclaimed or altered under the statute 5 & 6 Will. IV. c. 83, s. 1, the disclaimer or memorandum of alteration must be stated in the declaration, for the statute provides that the disclaimer or memorandum of alteration shall be deemed and taken to be part of the patent or specification.

If the plaintiff, or any one of several plaintiffs, claims under an assignment of the patent declared upon, the assignment must be stated in the declaration, so as to show his title to the patent right. An assignment, we have seen, must be made by deed, (*z*) and should be so stated in the declaration. But the omission to state that an assignment was made by deed is only matter of form and is aided after verdict. (*a*) And when an assignment by deed is pleaded in the declaration, the plaintiff must make profert of it in the ordinary way. (*b*)

If the action is brought for an infringement of a new patent, granting an extension of the original term, the declaration must, of course, set out the new patent, or state the effect of it. But it seems that it is not necessary in such a case to allege in the declaration that the grantee of the new patent has complied with all the preliminaries required by the statute 5 & 6 Will. IV. c. 83, s. 4; and that if the patentee has not complied with them, the defendant must plead the non-compliance with the statute in defence to the action. (*c*)

(*u*) Dyer, p. 29, b, pl. 199, and p. 54, a, pl. 17; 10 Co. 94, b.

(*v*) Dr. Leyfield's case, 10 Co. R. 88, a, 94, b.

(*y*) See per Tindal, C. J., in *Muntz v. Foster*, 1 Dowl. & Low. 742, and Com. Dig. Pleader, C. 62.

(*z*) *Ante*, Chap. IX. s. 2, p. 234.

(*a*) *Keene v. Cornish*, MS.

(*b*) See the Forms of Declaration in the Appendix, Chap. II. s. 4.

(*c*) See *Russell v. Lodam*, in the Exchequer; but not yet reported.

The plaintiff's title to the privilege he claims, having been shown by stating the patent, the specification and the assignments (if any) under which he claims, and also any disclaimer or memorandum of alteration varying his privilege, he must next show in respect of what injury he complains against the defendant. This is done in that part of the declaration called the breach, in which the plaintiff points out the particular breach of duty committed by the defendant.

It was formerly the practice to insert several counts in a declaration upon [*256] a patent, each count alleging the infringement 'in a different form.' Since the pleading rules of H. T., 4 Will. IV. 1834, (*d*) it has not been usual or proper to insert more than one count in a declaration for infringing a patent, but a plaintiff is at liberty to insert as many breaches as he pleases, and it is usual to allege several. (*e*)

In every breach the wrongful act of the defendant is alleged to have been committed after the making of the patent, and within the term of years which it grants, and this is necessary because the allegation of time in the breach is immaterial, and therefore it would not sufficiently appear, that the alleged grievance was committed during the existence of the patent, unless there was an express allegation to that effect, and without such an allegation, the breach would be bad on special demurrer.

If there has been any disclaimer or alteration of any part of the title or specification, the plaintiff ought generally to allege in every breach, that the grievance was committed after the disclaimer, or memorandum of alteration, was enrolled under the provisions of the statute. For if the disclaimer or memorandum of alteration shows that, until it was enrolled, the patent was void, the defendant could not be liable to an action for any infringement committed before the enrolment.

Thus in the case of *Perry v. Skinner*, (*f*) where the patentee had disclaimed part of the invention described in the specification, the Court of Exchequer held that the defendant was not liable for any infringement committed by him before the enrolment of the disclaimer, although the part of the invention which he had infringed had not been disclaimed.

So also if the plaintiff, or any one of several plaintiffs, is an assignee, it should be alleged in the breaches that the infringements were committed after the making of the assignment under which he claims: for an assignee cannot recover damages for any infringement of a patent prior to the time when his title accrued to him by virtue of his deed of assignment, which, we have seen, must be stated in the declaration. (*g*) And even if the assignment of a patent were also to contain an assignment of the patentee's right to damages for infringements committed prior to the assignment, the assignee could [*257] not recover such damages in an action at law, for the assignment of such a *chase in action* would be held to have no operation in a Court of Law, whatever it might have in a Court of Equity.

The wrongful acts stated in the breaches are always alleged to have been done, not only "wrongfully and injuriously," (as in all actions on the case,) but also with the intent to deprive the plaintiff of "the profits, benefits, and advantages which he might and otherwise would have derived and acquired from the making, using, exercising, and vending his invention." This is done, because it is necessary to show, on the face of the declaration, that the acts complained of were not only wrongful; but also that they were injurious to the plaintiff by depriving him of the profits of his invention. But it is unne-

(*d*) See *Cham. N. R.* 125.

(*e*) See the various Forms of Breach in the Appendix, Chap. II. s. 1.

(*f*) 2 M. & W. 471.

(*g*) *Ibid.*, p. 255.

cessary to prove this allegation of intent to injure the plaintiff further, than by giving evidence of the acts of infringement complained of; for every person must be presumed to be aware of the existence of the patent, and to intend what must necessarily be the effect of the wrongful acts which he is about to commit.

Every breach must also show that the acts complained of were done without the license of, and against the will of, the patentee, or those claiming under him, because the patent only prohibits those from using the invention who have not the license, consent, or agreement, of the patentee, his executors, administrators or assigns.

A person is guilty of a breach of a patent privilege when he has directly or indirectly used the art or invention which has been made the subject of the privilege, or applied it in any way for his own profit or benefit. And if the defendant has employed means only colourably different to produce the same or a similar result, yet he is guilty of an infringement if he has in fact used the art which is the subject of the privilege. The nature of the art or invention which can be made the subject of such a privilege has been considered in a former part of this work, (g) and it is always necessary to determine what is the subject of the privilege comprised in a patent, in order to see whether the defendant has committed a breach of the privilege. It is a very [258] common mistake to confound the purposes or objects of an invention with the art or invention itself. And it frequently happens that the use of the produce of an art or invention is erroneously deemed to be the use of the art or invention itself. To be an infringement of a patent privilege, the defendant's act must be either a use of the art invented by the patentee, or a fraudulent imitation of it, made for the purpose of evading the privilege, and not such a distinct art or invention as would be sufficient to support a patent. (h)

It is usual in declarations for infringing patents to allege breaches in the terms of the granting and prohibitory parts of the patent: that the defendant did "use," "exercise," or "put in practice" the invention, or some part of it; or did "make" articles according to the invention, or some part of it; or did "vend" or sell such articles; or did "counterfeit," "imitate," or "resemble" the invention; or make some "addition unto," or "subtraction from," the invention, "whereby to pretend himself the inventor or devisor thereof." (i) And in the case of *Minter v. Williams*, (k) it was laid down by the Judges of the Court of Queen's Bench, that this is the proper mode of alleging the breaches of a patent.

When it is alleged in a breach respecting an infringement, that the defendant has used, exercised, or practised *the plaintiff's invention*, the word invention must be understood in the sense in which it is used in the patent; (l) that is, as signifying the art which has been invented by the patentee, and which has been made the subject of the privilege comprised in the plaintiff's patent.

If the plaintiff alleges a supposed wrongful act in a breach which does not, *as alleged*, amount to an infringement of the patent, the defendant may demur to the breach.

Thus, in the case of *Minter v. Williams*, (m) the plaintiff "al- [259] leged as a breach, in one count of the declaration, that the defendant

(g) *Ante*, Chap. V. s. 1, p. 77.

(h) The various acts which amount to infringements of patent privileges are more particularly examined in Chap. XI. respecting the evidence upon a plea of not guilty.

(i) See the various forms in the Appendix, Chap. II. s. 4; and the evidence to be given upon the plea of not guilty, *post*, Chap. XI. s. 1.

(k) 4 A. & E. 251; 1 Webs. R. 135, *infra*.

(l) *Vide ante*, Chap. V. s. 1, p. 91.

(m) 1 Web. 135.

exposed to sale divers chairs which were intended to imitate and resemble, and did imitate and resemble, the plaintiff's invention. To this the defendant demurred, and the Court of Queen's Bench held, that the breach was insufficient, and gave judgment for the defendant.

For the defendant in that case, it was contended that the word vend in the patent meant to sell, (n) or expose for sale, and several dictionaries were cited in order to show that the word vend has both these significations. It was also contended, that exposing to sale is comprehended within the words, "use" and "exercise," in the granting part, and the words, "use or put in practice" in the prohibitory part of the patent. In giving judgment in this case, Mr. Justice *Patteson* said, "In drawing declarations for the infringement of a patent, pleaders have always used the words of the patent, either those in the granting or prohibiting part of it. I cannot doubt, for a moment, that there is a clear distinction between vending and exposing to sale, notwithstanding the authority of the dictionaries referred to. The plaintiff should in his declaration use the words either of the granting or prohibiting part of the patent. This is quite a new course of pleading to put in a word which does not occur in the patent. If the word vend really does mean 'to expose to sale,' as well as to 'sell,' the count should have charged the defendant with vending; and the act of exposing to sale might have been proved in support of it." Mr. Justice *Coleridge* said, "In the granting part of this patent the words are, 'make, use, exercise, and vend,' and then in the prohibiting part the words are rather different, for an obvious purpose; they are, 'make, use, or put in practice.' Now we are to see whether this count, either referring to the granting or prohibiting part, necessarily imports an offence. The words of the count are, that the defendant did 'wrongfully and unjustly expose to sale,' &c.; and it is said that these words necessarily import a vending within the granting part of the patent. It is argued that an exposing to sale is included within the meaning of the word 'vending;' [260] but even upon that construction the count would be defective, inasmuch as the evidence instead of the words of the patent is put upon the record. It seems to me that 'vending' imports the habit of selling, and 'selling,' the act of sale. If we read the word 'vend' as expressly inserted in the prohibitory part of the grant, (o) we ought only to give it there the meaning which would effectuate the purpose of the patent—the prevention of acts injurious to the patentee, with as little restraint on the public as possible. It must be taken here that the defendant has only exposed for sale; that whatever may have been his original purpose in so doing, or whatever motive has supervened, he has abstained from selling. Now I cannot say that such a mere exposure to sale is necessarily injurious to the patentee; it may, on the contrary, be very beneficial; it is not, therefore, necessarily the vending which is exclusively granted to him. As to 'using and exercising,' those words cannot be fairly resorted to, when we find with them (p) the word 'vending,' and that is passed by (q). But if they could the argument would be the same; this might be an innocent using and exercising, and so not prohibited."

It has, however, been customary in some cases to depart from the exact terms of the patent in alleging breaches; thus it is usual to allege as a breach that the defendant did "sell" articles made according to or by means of the

(n) The sale of articles is commonly alleged as an infringement in patent actions.

(o) A patent grants to the patentee the sole right to "make, use, exercise, and vend" the invention; but in the prohibition to others it commands that they shall not "make, use, or put in practice," the invention, the word "vend," being in that part of the patent wholly omitted; vide *ante*, Chap. IV. pp. 52, 59.

(p) In the granting part of the patent.

(q) That is, passed by in the prohibitory part.

invention. And this seems to be sufficient, for a selling must clearly be a vending within the meaning of the patent. (r)

The infringements stated in a breach must also be alleged to have been committed in breach of the patent privilege, or, in the ordinary language of the forms, in breach of the said letters patent, and against the privileges thereby granted.

The allegations contained in a breach are divisible; and a plaintiff may maintain his action, although he does not prove every thing alleged in a breach, if he proves such a part of it as actually amounts to an infringement of the patent. Thus, *in *Gillett v. Wilby*, (s) it was held, that an allegation that the defendant had imitated the plaintiff's improvements [*261] was a divisible allegation; and proof that the article made by the defendant imitated one of the plaintiff's improvements, was sufficient to enable him to support the action.

At the end of the breach or of the breaches (if there is more than one) the plaintiff states the amount of damage which he has sustained by the wrongful acts of the defendant. It is usual to allege damage to a large amount, but the only object in so doing seems to be, not to prejudice the plaintiff's right afterwards to recover a large sum in Equity for the loss he has sustained; the amount of damages recovered in an action at law being almost always merely nominal.

If the plaintiff sues as an executor or administrator he must, at the end of the declaration, make a profert of his probate, or of his letters of administration, so as to prove his right to sue in his representative capacity.

In some actions, when the breaches in the declaration describe the alleged wrongful acts of the defendant in very general terms, the Courts will order the plaintiff to deliver to the defendant particulars of the breaches of contract, or wrongful acts of which he complains. (t) The reason why the Courts order particulars in such cases is, that the defendant cannot know with certainty what the plaintiff intends to prove against him at the trial, and therefore may be unable to prepare for his defence, and liable to be taken by surprise at the trial. The power of the Courts to order such particulars is derived from their general jurisdiction over the proceedings before them, and not from the provisions of any statute. Acting upon this practice, the Court of Exchequer, in the recent case of *Perry v. Mitchell*, (u) ordered the plaintiff to deliver to the defendant a particular in writing of the infringements on which he intended to rely. In that case, the action was for infringing two patents for improvements in pens, and the specification set forth and described thirteen different pens, containing an indefinite number of slits and adjustments. The declaration assigned as breaches, the making, &c., of pens and nibs, in imitation of parts of the invention, with divers additions thereto and subtractions therefrom. [*262] Upon an affidavit for the defendant of the circumstances, and stating that inasmuch as neither the parts, nor the additions or subtractions were mentioned, it would be impossible to prepare the notice of objections to be delivered with the pleas, or to know what evidence to adduce; the Court made a rule absolute, ordering the plaintiff to deliver particulars of the infringements, and to specify and point out the particular pens, &c., in respect of which such infringements had taken place.

But the Courts will not order the plaintiff to produce to the defendant a specimen of his patent article, for the specification gives all the information the

(r) Vide *ante*, Chap. IV. pp. 54, 55.

(s) 9 C. & P. 334.

(t) See Tidd's Practice, and the other books of practice.

(u) 1. Webs. L. 269.

defendant can require; and the effect of such an order would merely be to enable the defendant to ascertain the evidence which the plaintiff will produce at the trial. (x)

It has been laid down in all the modern books of practice, upon the authority of the case of *The King v. Amery*, (y) that oyer of letters patent cannot be demanded. It will be observed, however, that it was not necessary to determine the point in the case of *The King v. Amery*, for the demand of oyer was too late, and therefore not admissible in that case. We have seen (z) that a plaintiff must in his declaration make profert of his patent; and the rule is, that a defendant is entitled to demand oyer of any instrument of which the plaintiff necessarily makes profert. (a)

A defendant in a patent action is at liberty to avail himself of two different kinds of defence to the action: *firstly*, he may deny that the plaintiff has any title to the privilege stated in the declaration, either on the ground that there is no such patent in existence as the plaintiff alleges, or that the patent is defective and void, and therefore the same as if there were no patent at all; and, *secondly*, he may deny that he has committed any infringement of the plaintiff's patent right. And every defendant may avail himself of both or either of these different lines of defence to a patent action.

[*263] In order to defend himself in such an action, the defendant must state his grounds of defence in one or more pleas, which he pleads to the declaration (b) in bar of the plaintiff's claim to recover damages against him.

Before the pleading rules, made in pursuance of the statute 3 & 4 Will. IV. c. 42, s. 1, (c) the only plea used in patent actions was the plea of not guilty, under which the defendant might take any objection he pleased to the validity of the patent.

Since the pleading rules above mentioned (d) came into force, (e) the plea of not guilty has ceased to have such an extensive effect as it had formerly; and that plea now merely amounts to a denial, that the defendant has been guilty of the wrongful acts complained of by the plaintiff in the breach or breaches alleged in the declaration, and does not raise any question respecting the validity of the patent.

We have seen (f) that a patent is a record; and if it be pleaded by the patentee with a profert, (which supposes a production of the instrument, and showing it in open Court,) the other party cannot plead *nul tiel record* to it. (g) Because the patent being in contemplation of law in Court at the time of pleading, it manifestly appears that there is a record; and therefore the defendant cannot be permitted to say that there is no record. (h) In cases in which the plea of *nul tiel record* is admissible, the plaintiff has stated a judgment, or other matter which he has offered to prove *by the record* of it, the record not being in Court at the time, the plea in such case alleging that there is no record of the judgment or other matter alleged, and thus compelling the plaintiff to prove his allegation,

(x) *Crofts v. Peach*, 2. Hodg. 110; 1 Webs. R. 268.

(y) 1 T. R. 149.

(z) *Ante*, p. 254.

(a) *Tidd's Prac.* c. xxiii. p. 586; and see the observation of Tindal, C. J., in *Muntz v. Foster*, 1 Dowl. & Lox. 741, 742.

(b) In a work of this description it is unnecessary to say anything respecting pleas in abatement. For information respecting such pleas see *Com. Dig. tit. Abatement; Chit. on Pleading*, vol. i.

(c) See *Charnock's New Rules*.

(d) *Reg. Gen. H. T.* 4 Will. IV. 1834.

(e) 15 April, 1834.

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

(g) 6 Co. R. 15, b; *Doct. pl.* 307, 308; *Plow.* 232.

(h) *Co. Lit.* 260, a.

by causing the record to be produced in Court. But the words "letters patent under the Great Seal," import an instrument which is and must be a record; and to say that there is no record of a patent, would be to say that there is no record of a record, which would be absurd.

And if a patent be pleaded in the declaration with a profert, the defendant cannot deny it by saying that there is no patent. (i) For the Great Seal (which must be attached to a patent) proves itself; (k) and the [*264] patent being (in contemplation of law) in Court at the time of declaring, it appears to the Court that there is a patent under the Great Seal, and therefore the defendant cannot be permitted to deny an allegation which the Court and the parties must see is perfectly true.

But a patent for an invention is in the nature of a grant as well as a record, and therefore the defendant is permitted to deny that it has the effect stated by the plaintiff in his declaration. The plaintiff must state the purport of the patent as a grant of privilege to the inventor, his executors, administrators, and assigns; and the defendant is permitted to deny the statement by a plea of *non concessit*, (l) alleging in substance that the Queen did not make such grant as stated by the plaintiff, in manner and form as in the declaration mentioned. (m)

And if a plaintiff does not correctly set out the form or effect of his patent, the only way in which the defendant can object to the mis-statement is by pleading a plea of *non concessit*. It was supposed by some persons that although *non concessit* might be pleaded to a patent granting land, &c., yet that it was inapplicable as a plea to a patent granting the sole use of an invention. The recent case of *Beddells v. Massey* (n) however decides that the plea is proper in a patent action. In that case the plaintiff obtained a rule nisi to strike out the plea of *non concessit*, on the ground that it could not be pleaded in a patent action; but after argument the Court of Common Pleas discharged the rule with costs. And in the case of *Bunnett and Corpe v. Smith*, (o) a Judge at Chambers refused the defendant leave to plead this plea, but the Court of Exchequer afterwards held that the defendant ought to be permitted to plead the plea.

If a person should proceed by action upon a pretended grant of an invention by patent, when, in fact, no such grant was ever made, it is scarcely necessary to observe that the defendant may show, by way of defence to the action, that there never was any such patent as alleged. The [*265] mode of doing this is by a plea of *non concessit*, (p) by which the defendant denies that her Majesty did make such gift or grant of privilege as in the declaration alleged; and the plaintiff being thus put to the proof of the allegation contained in his declaration, he will fail at the trial if he cannot produce a patent containing the alleged grant of privilege.

The plea of *non concessit* seems, 'so, to be applicable in every case in which the patent was void *ab initio*, and therefore never had any operation as a grant (r) But if the patent was originally good, and only became void by matter subsequent, as the non-performance of some condition contained in it, the plea of *non concessit* is inapplicable; for, although the grant may have become void, it could not be said that the Queen did not make such a grant.

(i) 4 Co. R. 71, b.; Doct. plac. 352; Plow. 232.

(k) Vide *ante*, Chap. IV. p. 30.

(l) Co. Lit. 260, a.; Doct. plac. 307, 308; 4 Co. R. 71, b.; 2 Rol. Abr. 191, b, 20; Dyer, 242, a.

(m) See the Forms of such Pleas in the Appendix, Chap. II. s. 4.

(n) 8 Jur. 608; 2 Dowl. & L. 322. (o) 13 M. & W. 552.

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

(r) Vide *post*, p. 268.

It is a principle in law, that the Queen cannot be considered to intend wrong to any one; or, as it is sometimes expressed, the Queen can do no wrong. (q) And the law provides that any patent which is contrary to law, or prejudicial to the public, shall be absolute *v* void, not only by virtue of the law itself, but as being contrary to the Queen's intent. To allow such a patent to be put in force would be contrary to the Queen's intention; and, therefore, the formal grant it contains is unavailing in a Court of Law, if the party proceeded against can show any valid objection to it. Every grant made by patent has this condition, either expressly or tacitly annexed to it;—that it shall not be contrary to law, or operate to the prejudice of her Majesty's subjects. And if the grant be contrary to this condition, it cannot be enforced against any person in any Court of Law or Equity.

In an action brought upon a patent objections may be taken to it on three different grounds: *first*, that it is contrary to the express provisions of the Common or Statute Law; *secondly*, that the Queen has been deceived in some material particular, respecting the grant contained in the patent; and, *thirdly*, [*266] that some of the conditions or provisoes contained in the *patent have been violated. (r) There are several objections, however, which may be taken to a patent on more than one of these three grounds, and some which may be taken upon all three of them.

The principal objections usually taken to a patent are the following:

1st. That the patentee was not the inventor or importer of the alleged invention.

2nd. That the title misrepresents or improperly describes the invention.

3rd. That the invention is not an invention of such a nature as may be made the subject of a patent privilege.

4th. That the invention was not new to the public at the date of the patent.

5th. That the invention is of no use to the public.

6th. That the patentee has not properly specified his invention.

Other objections may however be taken to the validity of a patent, some of which will be noticed hereafter.

The first of these objections, viz: that the patentee was not the inventor or importer of the invention, shows that a patent is void because the patentee was not a person who was capable of taking such a grant of privilege as comprised in the patent. (s)

This objection to a patent invalidates it upon each of the three grounds already adverted to.

According to both the Common Law and the Statute of Monopolies, (t) the grant of the sole use of an invention can only be made to the person who is the true and first inventor of a new manufacture, or who first imports a knowledge of such a manufacture from abroad; and the Statute of Monopolies (t) avoids all such patent grants to any other person. (u)

A patent always shows by the recital of the petition upon which it was founded, that the patentee represented that he was the true and first inventor of [*267] the alleged invention; or *that he had acquired a knowledge of it from a foreigner residing abroad, and therefore was the importer of it into this country; and if the representation was untrue the Queen was deceived, and therefore her grant is void. (x)

(q) Vide *ante*, Chap. IV. p. 38.

(r) Vide *ante*, Chap. IV. p. 36, respecting the construction of patents.

(s) Vide *ante*, Chap. III. ss. 2, 3.

(t) 21 Ja. I. c. 3, s. 6.

(u) Vide Chap. III. *ante*, p. 21.

(x) Vide *ante*, Chap. III. p. 21; Chap. IV. p. 39.

And every patent contains a proviso, that if the patentee was not the true and first inventor or importer (as the case may be) of the invention comprised in it, the grant and patent may be avoided. (y)

The usual form of plea for raising this objection, alleges that the patentee was not the true and first inventor of the invention mentioned in the declaration. (z) If the declaration contains an allegation that the patentee was the true and first inventor, the plea is merely a traverse or denial of that allegation; and therefore the defendant concludes by putting himself upon the country, (z) so as to tender an issue in fact for trial by a jury. But when the declaration contains no such allegation, the plea must aver that the patentee was not the true and first inventor of the invention, and that by reason thereof the patent is void; and then conclude with a verification, as it is called, whereby the defendant offers to prove the matters alleged in the plea. (z)

When the patent is set out on oyer, or when the declaration states the recital contained in the patent, by which it appears that the patentee represented to the Crown that he was the true and first inventor, a plea in the usual form is sufficient to enable the defendant to take this objection to the patent, on the ground that the patentee made a false suggestion to the Queen. But if the recital is not stated in the declaration, the defendant must in his plea aver that the patentee did make such a representation to the Queen, and that the Queen made the grant upon that representation; and then the plea must allege that the representation was false, and that the patent is therefore void. (a) The plea must of course conclude with a verification.

When the patentee has imported the invention, the plea that he was not the true and first inventor, would be sufficient to raise the question [*268] whether he was the true and first inventor within the meaning of the Statute of Monopolies. (b) In many cases, however, the best course for the defendant to adopt, is to plead a plea, setting out the representation made to the Crown by the patentee, and alleging that the representation was false, that the Crown was deceived in making the grant, and that the patent is therefore void. (c)

In whichever of these forms the plea is pleaded, it will be sufficient if the plaintiff joins issue upon it to enable the defendant to take advantage of this objection, on the ground that the patent is contrary to both the Common Law and the Statute of Monopolies.

It seems, however, that this objection, that the patentee was not the true and first inventor, may also be taken under the plea of *non concessit*, which has already been mentioned. (d) That plea alleges that the Queen did not make the grant alleged in the declaration; and if it can be shown that the patent mentioned in the declaration was void; at the time it was made, it could not grant the privilege which the plaintiff alleges, for nothing could pass by a void instrument. (e) And it is clear that if a patent were to be granted to a person who was not the true and first inventor, or importer of the invention, it would be absolutely null and void, for it would not be within the exception contained in the sixth section of the Statute of Monopolies, (f) and therefore it would be made void, and of none effect, by the first section of that statute.

(y) See Chap. IV. p. 62, *ante*, and the Form of a Patent in the Appendix, Chap. II. s. 1.

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

(a) See the Form in the Appendix, Chap. II. s. 4.

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

(c) See the Form in the Appendix, Chap. II. s. 4.

(d) *Ante*, p. 264, 265.

(e) *Vide Co. Lit.* 260, a, and the other authorities, cited *ante*, p. 264, n. (l).

(f) *Vide ante*, Chap. III. p. 21.

It is a very common error to suppose that the objection to a patent, that the patentee was not the true and first inventor, is the same as the objection that the invention was not new at the date of the patent. The two objections are however perfectly distinct, and different from each other. The one objection is applied to the patentee, and shows that he is not a person capable of sustaining such a grant; and the other objection is applied to the invention, and shows that it could not be made the subject of a patent privilege.

[*269] It is true that if it be shown that the invention comprised *in a patent was known to the public before the date of the patent, although the patentee may in fact have invented it, yet he cannot have been the *first* inventor, for some one must have invented and given the invention to the public before the date of his patent. (g) But an invention may be perfectly new to the public, and yet the patentee may not be the *true* and first inventor. For he may have purloined it from another, or it may have been communicated to him by one of his fellow-subjects, in either of which cases he could not be the *true* inventor.

The objection that the patentee was not the true and first inventor, is, in fact, something more than the objection that the invention is not new, for it shows that the patentee did not make the invention. (h)

The objection that the title in a patent misrepresents the nature of the invention, or improperly describes it, is taken to the patent, on the ground that the Queen has been deceived by a false representation or suggestion of the patentee.

It is the duty of a petitioner for a patent to see that the Queen is properly informed respecting the nature of his invention, and the grant which he seeks to obtain; (i) he gives a title to his invention, in his petition, at his own risk and peril, and if he makes any misrepresentation respecting it, his patent will be absolutely void.

This objection is most frequently taken in cases in which the inventions are intitled or represented by the patentee to be improvements in something previously known, or to be applicable to some particular purposes, as in the following instances:—"improvements in elastic fabrics;"—"improvements in the manufacture of iron;"—"improvement in machinery for covering fibres applicable in the manufacture of braid and other fabrics," &c., &c.

Patentees who have obtained patents for inventions described in this manner, must have represented to the Crown that their inventions were such improvements, or were applicable in the particular manner mentioned in the titles of [*270] their inventions; (k) and if their inventions were not such improvements *as represented, or were not applicable in the way alleged, their patents are void by reason of the false representation or suggestion made to the Crown.

This objection is best taken by a plea, setting out the representation made to the Queen by the patentee respecting his invention, being improvements in some description of manufacture; stating also that the Queen acted upon the representation in making the grant, and then alleging that the representation, or some part of it, was false, and that by means thereof the patent is void. (l) But the objection may also be taken under the plea of *non concessit*; for if the representation was false the patent is void, and therefore has no operation as a grant of privilege in manner stated in the declaration. (m) And where an

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

(h) Vide *post*, Chap. XI. Evidence.

(i) Vide *ante*, Chap. IV. p. 42.

(k) Vide *ante*, Chap. IV. p. 45; and the Form of Petition for a Patent in the Appendix, Chap. II. s. 1.

(l) See the Form of Plea in the Appendix, Chap. II. s. 4.

(m) Vide *ante*, p. 264, 268, respecting this plea.

invention is misdescribed in the title, the plea of *non concessit* seems to be the proper plea for taking that objection to the patent; for the patent expresses a grant different from that which the Queen must have intended, and therefore it is null and void. (n)

When the title contained in a patent is too large, and includes more than the patentee has actually invented, it is clear that the patent purports to make a more extensive grant than the Queen can have intended, and therefore the patent is wholly void. (o) And a defendant may, in an action upon such a patent, avail himself of the objection either by the plea of *non concessit*, or by a plea showing that the Crown was deceived by a false representation. The objection it seems is also admissible under a plea denying the sufficiency of the specification.

In the case of *Morgan v. Seaward*, (p) it appeared that the patent had been obtained for an invention of "certain improvements in steam engines, and in machinery for propelling vessels, which improvements were applicable to other purposes." The defendant pleaded (thirdly) that the alleged invention was not an improvement in steam engines, and the defendant at the trial obtained a verdict upon that plea. The plaintiff moved for judgment, *non obstante verdicto*, or a *repleader upon the finding upon the third issue; and in delivering the judgment of the Court of Exchequer, Mr. Baron [*271] *Park* said, "The suggestion in the letters patent is, that Galloway had invented certain improvements in steam engines, and in machinery for propelling vessels, which improvements were applicable to other purposes; and the patent is granted for the invention of those improvements. But unless the specification be referred to, to explain the title of the patent, it is doubtful whether the invention claimed is of improvements in steam engines, as connected with other machinery only, or of improvements in steam engines for whatever purpose they may be employed. Upon reference to the specification there is no doubt that the claim is of the latter description; but that instrument is not stated in the record, and upon what appears on the record, it is by no means clear that the patentee does claim an improvement in steam engines, unconnected with the machinery. And if he does not, the plea would probably have been bad on demurrer, as it is uncertain whether it does not deny the invention to be an improvement in steam engines, unconnected with the machinery. But after verdict, this objection is removed: for it is a rule, that if an issue could have been material, the Court, after verdict, ought to intend it to be so, *Kempe v. Crews*; (q) and as the plaintiff did not demur, it must be taken that he admits that the plea is to be understood as denying the invention to be an improvement in steam engines in that sense in which it is used in the patent itself; and the jury must be intended so to have found." And the Court gave judgment for the defendant on the third issue.

In the case of *Morgan v. Seaward*, (r) just cited, it was also held by the Court of Exchequer, that a plea denying that the invention was such an improvement as alleged by the patentee was different from a plea alleging that the invention was of no use to the public. And the same law was laid down by the Court of Common Pleas in the case of *Beddells v. Massey*. (s)

If the invention mentioned in the declaration in a patent action, is not an invention of such a nature as may be made *the subject of a patent [*272] privilege, the defendant may take the objection by a plea in bar to

(n) That a patent is void if it be contrary to the intent of the Queen; vide *ante*, Chap. IV. p. 48.

(o) Vide *ante*, Chap. IV. p. 46.

(q) 1 *Ld. Ray.* 167.

(s) 2 *Dowl. & Low.* 322.

(p) 2 *M. & W.* 544.

(r) 2 *M. & W.* 544-560.

the action. (*t*) The nature of the inventions which may be made the subject of such privileges has already been considered in a former part of this work, (*u*) to which the reader is referred. It has been usual to raise this objection by a plea alleging that the invention is not an invention of any manner of manufacture, and that the patent is therefore void; (*t*) and that plea is intended to raise the question whether the invention be an invention within the meaning of the exception contained in the *sixth* section of the Statute of Monopolies. (*x*)

It seems, however, that the proper form of plea for this purpose would be a plea alleging that the privilege granted by the patent is not a privilege for the sole working or making of any manner of manufacture. (*y*) Whatever may be the form of plea which is adopted, the objection is taken to the patent on the ground that it is contrary to the express provisions of the Statute of Monopolies. (*z*)

This objection, it seems, may also be taken to a patent under the plea of *non concessit*, for if the invention is one which cannot be made the subject of a patent privilege, the patent is rendered void by the express provisions of the Statute of Monopolies, and cannot operate as a grant in the way alleged by the plaintiff. (*a*) It seems that the objection *may* also be taken under a plea alleging that the invention is not an invention of a *new* manufacture, (*b*) but not under a plea which merely alleges that the invention is not new to the public, (*c*) nor under a plea alleging that the specification is insufficient. (*d*)

A plea that an invention was not at the time of the making of the patent a manufacture within this realm within the meaning of the statute, (*c*) has, however, been decided to be a bad plea, on the ground that it is ambiguous, and [*273] uncertain whether *it is intended to raise the question of the invention being new, or a manufacture within the meaning of the statute. (*f*)

The objection that the invention comprised in a patent privilege is not new to the public, is taken both on the ground that the patent is contrary to the Common Law and the Statute of Monopolies, and also that the patentee has made a false representation to the Crown. The Statute of Monopolies, we have seen, (*g*) expressly provides that a patent shall be void if the invention comprised in it was not new at the time of the making of the patent; and the Common Law also required that an invention should be new, in order to be made the subject of a grant by patent. (*h*) A patent also shows that the patentee represented to the Crown that his invention was new, and if it was not so, the falsehood of the representation rendered the patent absolutely void. (*i*)

When this objection is taken on the ground that the patent is contrary to the Common Law or Statute of Monopolies, it is sufficient for the defendant in his plea to state that the invention was not new to the public at the time of the making of the grant, and that by reason of such want of novelty the patent is void. (*k*) The objection may also be taken under a plea alleging that the inven-

(*t*) See the Forms of Pleas in the Appendix, Chap. II. s. 4.

(*u*) *Ante*, Chap. V. s. 1, p. 77.

(*x*) 21 Jas. I. c. 3.

(*y*) See the Form of Plea in the Appendix, Chap. II. s. 4.

(*z*) 21 Ja. I. c. 21, s. 6.

(*a*) As to the effect of this plea, *vide ante*, p. 264, 268.

(*b*) *Walton v. Bateman*, 3 M. & G. 773.

(*c*) *Walton v. Potter*, 1 Webs. R. 585; 3 M. & G. 411; and see *Elliot v. Aston*, 1 Webs. R. 223.

(*d*) *Jupe v. Pratt*, 1 Webs. R. 150, 151. (e) 21 Ja. I. c. 3, s. 6.

(*f*) *Spilsbury v. Abbott*, 1 Webs. R. 255. (g) *Ante*, Chap. V. s. 2, p. 106.

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

(*i*) *Ante*, Chap. IV. p. 48, and *vide ante*, p. 63.

(*k*) See the Form of Plea in the Appendix, Chap. II. s. 4.

tion is not an invention of a *new* manufacture. (*l*) And on the ground that the patent was originally void, (*m*) it seems that it might also be taken under a plea of *non concessit*.

We have seen in preceding parts of this work, (*n*) that an invention must be useful in some degree in order to be made the subject of a valid patent privilege.

The objection to a patent because the invention is not useful, it seems may be taken on the ground that the patent is contrary to law, (*o*) and that it is contrary to the intent of the Queen. (*p*) And if the patentee appears by the recital of his petition to have represented his invention to be useful, the *patent will be void if the invention is not useful at all, or not useful in the way alleged by the patentee. [*274]

If the objection be taken on the ground that the grant is contrary to law, it cannot be sustained unless there is a total want of utility; (*q*) and therefore a plea for raising that objection must allege, that the invention is not of *any* use, benefit, or advantage to the public. (*r*) When the objection is taken on the ground that the patent is void by reason of a false representation, the plea for raising the objection must be framed according to circumstances. If the false representation appears on the face of the declaration, a plea alleging the want of utility may be sufficient; but if not, the plea must state the false representation made to the Crown, and then allege that it was false, and the patent therefore void. (*s*)

And it seems that this objection may also be taken to a patent under the plea of *non concessit*, for if the patent be *void* in consequence of the inutility of the invention, it could not operate as a grant of privilege to the patentee in the manner alleged by the plaintiff. (*t*)

But the utility of an invention is not put in issue by a plea denying that the invention is a new manufacture. (*u*)

In the case of *Morgan v. Seaward*, (*x*) the Court of Exchequer intimated a doubt as to whether the proper form of plea ought not to be in the words of the statute, that the patent was contrary to law, or mischievous to the State, &c., (*y*) and not merely to plead the want of utility.

And in the case of *Jupe v. Pratt*, (*z*) Mr. Baron *Alderson* intimated an opinion that it is not sufficient for such a plea to say that the invention is not useful, and that it ought to allege the invention to be prejudicial, as in *Arkwright's* case. (*a*) The learned Judge seems to refer to the first suggestion in the writ of *scire facias*, in the case of *The King v. Arkwright*, (*a*) but Mr. Justice *Buller* in that case held, that *the suggestion was too general, and that the prosecutor could not be permitted to give evidence in support of it. (*b*) [*275]

Notwithstanding these authorities, a plea merely denying the utility of the invention in general terms, is pleaded in almost every action for the infringement of a patent; and it is probable that whenever the sufficiency of the plea

(*l*) *Walton v. Bateman*, 3 M. & G. 773. (*m*) *Vide ante*, p. 264.

(*n*) *Ante*, Chap. I. p. 3, and Chap. V. s. 3, p. 132.

(*o*) See *Morgan v. Seaward*, 2 M. & W. 544.

(*p*) See Chap. V. s. 3, *ante*, p. 132.

(*q*) See Chap. I. p. 3, and Chap. V. s. 3, p. 102.

(*r*) See the Form of the Plea in the Appendix, Chap. II. s. 4.

(*s*) See the Form of such a Plea in the Appendix, Chap. II. s. 4.

(*t*) *Vide ante*, pp. 264, 268, as to the effect of this Plea.

(*u*) *Walton v. Bateman*, 1 Webs. R. 625.

(*x*) 1 Webs. R. 187-197; 2 M. & W. 544.

(*y*) See 21 Ja. I. c. 21, s. 6.

(*z*) 1 Webs. R. 151.

(*a*) *Dav. P. C.* 61.

(*b*) *Dav. P. C.* 79.

is made the subject of judicial determination, it will be held to be valid on the ground stated in a former part of this work. (c)

In the case of *Losh v. Hague*, (d) the defendant raised an objection to the validity of the patent, by a plea alleging that the improvements invented by the plaintiff were trifling and insignificant, and not legal subjects for the grant of the patent. No decision was, however, necessary respecting the sufficiency of the plea, for the plaintiff joined issue upon it, and the issue was found for the plaintiff.

In the cases of *Morgan v. Seaward* (e) and *Beddells v. Massey*, (f) it was held, that a plea denying the utility of an invention is quite different from a plea alleging that the plaintiff had falsely alleged his invention to be improvements.

Every patent for the sole use of an invention contains a proviso or condition, requiring that the patentee shall particularly describe and ascertain the nature of his invention, and the manner in which it is to be performed, by an instrument, (usually called a specification) and to cause it to be enrolled in Chancery within a certain time after the date of the patent; and it is expressly declared that the patent shall be void if the condition is not complied with. (g)

The objection that the patentee has not enrolled a sufficient specification can only be taken to the patent on the ground that the non-performance of the condition has rendered the patent void, for a specification is not required either by the Common Law or the Statute of Monopolies.

There are two objections which may be taken to a patent under this condition: the one upon the ground that there is no specification at all, or no sufficient specification; and the other upon the ground that the specification was [*276] not enrolled at all, or was not enrolled in due time. These two objections *are frequently taken by separate pleas. The total want of a specification is a thing which rarely occurs, and therefore the common form of the objection is, that the specification which the patentee has made is insufficient.

This objection is sometimes raised by a plea alleging that the patentee did not, by the instrument in writing under his hand and seal in the declaration mentioned, particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, in manner and form as in the declaration alleged. (h) A plea in this form merely questions the sufficiency of the particular specification mentioned in the declaration, and must conclude to the country. (i)

It is frequently desirable that the specification should be put upon the record, in order that the defendant may have the benefit of objections arising from defects appearing on the face of it, either on demurrer or in a Court of Error. In order to do this, it is usual to set out the specification in the plea, and annex any plans or drawings contained in the specification; and then to conclude with a special traverse alleging that the plaintiff did not by the specification particularly ascertain and describe his invention as alleged in the declaration. (k)

And in the case of *Muntz v. Foster*, (l) the Court of Common Pleas held, that such a plea concluding with a common instead of special traverse, was bad on special demurrer.

(c) Vide *ante*, Chap. I. and Chap. V. sec. 3.

(d) 1 Webs. R. 202.

(e) 2 M. & W. 544.

(f) 2 Dowl. & Low. 322.

(g) Vide *ante*, Chap. IV. p. 68, and Chap. VII. p. 151.

(h) See the Form in the Appendix, Chap. II. sec. 4.

(i) Bentley v. Goldthorp, 9 Jur. 470.

(k) See the Form of Plea in the Appendix, Chap. II. s. 4.

(l) 1 Dowl. & Low. 737.

But if the specification has been set out in any previous plea, it will be sufficient to refer to the instrument as there set out, and conclude with a traverse of the performance of the condition in the patent as alleged in the declaration. (*k*)

The objection that the specification has not been enrolled, or not enrolled within due time, may be taken by a plea alleging that the specification or instrument in writing in the declaration mentioned was not enrolled within six (or four) calendar months after the date of the patent, as alleged in the declaration. (*m*) And such a plea seems to be the proper plea for merely putting in issue the plaintiff's allegation of an enrolment of his specification in due time.

It will be observed *that the condition requiring the enrolment of a specification is not a condition precedent; but it seems that it [*277] is necessary for the patentee to allege that he has complied with the condition. (*n*)

The usual form of plea alleges that the patentee did not cause any sufficient specification to be enrolled within the time limited by the patent, and that by reason thereof the patent became void. (*o*)

A patentee is bound to describe every part of the invention comprised in his patent, and if he fail to describe any part of it sufficiently, the patent is void. (*p*) Where a patent contains a title too large for the actual invention of the patentee, the defendant may in some cases take advantage of the objection under a plea denying the sufficiency of the specification. (*q*)

For if it appears upon the face of the specification, that the patentee has neglected to describe something comprised in the patent privilege, the patent must be void by reason of the non-compliance with the condition. But the objection cannot be taken under that plea, unless it clearly appears upon the face of the specification, that the patentee has not described some part of the invention.

In addition to the objections which have already been mentioned, there are others which may be taken to a patent by proper pleas, such as, that the patent has become void by an assignment to or in trust for more than twelve persons, contrary to the condition of the patent; that the object of the invention was contrary to law, as for instance an invention of implements for housebreaking; or that the patentee has refused to supply articles for the public service, contrary to the condition in his patent.

A defendant in an action for the infringement of a patent may, under some circumstances, be precluded from taking any objection to the validity of the patent.

Thus in the case of *Oldham v. Langmead*, (*r*) which was an *action brought by the assignee of a patent against the patentee, it [*278] was held by Lord *Kenyon*, that the defendant, the patentee, could not be permitted to show that the invention was not new, contrary to his own deed by which he had assigned the patent to the plaintiff. (*s*)

So also in the case of *Bowman v. Taylor*, (*t*) in which it appeared that by a deed made between the plaintiff and the defendant, after reciting that the plaintiff had invented certain improvements in power-looms for which he had

(*k*) See the Form of Plea in the Appendix, Chap. II. s. 4.

(*m*) See the Form of Plea in the Appendix, Chap. II. s. 4.

(*n*) See the judgment of Tindal, C. J., in *Muntz v. Foster*, 1 Dowl. & Low. 741, 742; and vide *ante*, p. 254.

(*o*) See the Form in the Appendix, Chap. II. s. 4.

(*p*) Vide *ante*, Chap. VII. p. 162.

(*q*) See the case of *Neilson v. Harford*, 1 Webs. R. 373.

(*r*) Cit. 3 T. R. 439.

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

(*t*) 2 A. & E. 278.

obtained a patent, and had enrolled a specification of the invention in pursuance of the patent, the plaintiff, for the consideration mentioned in the deed, agreed to permit the defendant to use the invention, and the defendant covenanted with the plaintiff to pay him certain sums of money for the use of the invention. The plaintiff brought the action for certain sums which had become due in pursuance of the deed, but which the defendant had not paid. The defendant pleaded three pleas in which it was alleged, that the patent was void on the ground that the invention was not new, that the plaintiff was not the inventor, and that the plaintiff had not enrolled a specification. And it was held upon demurrer that the defendant was estopped by the deed from taking the objections to the patent, which were mentioned in the pleas. (u)

The last plea which it is necessary particularly to mention, is the plea of not guilty; by which the defendant says that he is not guilty of any of the grievances alleged in the declaration. This plea, as already stated, (x) had formerly a much more extensive operation in a patent action than it has at present: before the new pleading rules, (y) made in pursuance of the stat. 3 & 4 W. IV. c. 42, s. 1, this plea had the effect of compelling the plaintiff to prove every thing necessary to support a patent for an invention; and also enabled the defendant to raise any objection he might think fit to the patent, and to make almost every possible defence to the action.

By the new pleading rules, the effect of this plea is now limited to a denial [*279] of the wrongful acts complained of in the declaration; it does not therefore put in issue or deny the making of the invention, its novelty or utility, the grant of the patent, or the enrolment of the specification, or any other thing alleged in the declaration, except the breaches. The effect therefore of the plea is merely to deny the allegations contained in the breaches, it being admitted for the purposes of the issue raised on this plea, that the plaintiff is possessed of the patent privilege he alleges, and that it is a good and valid privilege. (z)

There are also other matters of defence which a defendant may avail himself of in a patent action, some of which may here be mentioned.

Thus, if a patent has been repealed by *scire facias*, the defendant in an action upon a patent will be at liberty to plead the judgment to repeal the patent in bar of the action. (a) So if a patent has been made void by a declaration under the Privy Seal, or under the hands of six Privy Counsellors, (b) such a declaration would be a defence to an action for infringing the patent. And if the patentee has been convicted of an offence which causes a forfeiture of the patent, it is apprehended that the forfeiture might be set up as a defence to any action he might bring upon the patent. If a patentee should commence an action for an infringement of his patent, after it had been assigned over to another, or after he had become bankrupt, or taken the benefit of the Insolvent Act, the assignment, bankruptcy, or insolvency might be pleaded as a defence to the action. And if he surrenders his patent to the Crown by a deed enrolled in Chancery, the surrender might be pleaded as a defence to any subsequent action he might bring for an alleged infringement of the patent.

In an action for infringing a patent the defendant is allowed to plead several pleas, so as to raise every objection which can be taken to the validity of

(u) See also the case of Baird v. Neilson, 8 Cl. & Fin. 726, in the House of Lords, which was an appeal from a decision of the Court of Session in Scotland.

(x) Vide *ante*, p. 263.

(y) R. G. H. T. 4 Will. IV. 1834; Charn. New Rules, p. 125.

(z) Vide *post*, tit. Evidence, Chap. XI.

(a) Bro. Abr. title Pat. pl. 23; and Sci. fa. pl. 138, 131.

(b) Vide *ante*, Chap. IV. p. 64.

the patent, and the Court will always grant a rule permitting him to plead a sufficient number of pleas for that purpose. A patent action is, indeed, almost always brought for the purpose of trying the validity of a patent, and frequently in pursuance of an order of the Court of Chancery; and if the defendant was not permitted fairly *to raise every legal objection [*280] to it, the object with which the action is brought would be frustrated.

But a defendant will not be permitted to plead more pleas than necessary, or to plead them in such a form that the plaintiff cannot take issue upon them. A defendant can rarely plead to a declaration in a patent action without obtaining an order for more time to plead than is allowed in the first instance, and he cannot obtain the order except upon the terms of pleading issuably. The defendant is, therefore, under the terms of this order bound to plead such pleas as the plaintiff can raise issues upon (either in law or in fact,) which will fairly decide the questions between the parties to the cause.

In each of the recent cases of *Beddells v. Massey*, (c) and *Nickels v. Ross*, (d) the defendant pleaded the following pleas: 1st, *Non concessit*. 2nd, That the patentee was not the true and first inventor. 3dly, That the invention was not an invention of such improvements as represented by the patentee, and therefore that the patent was void. 4thly, That the invention was not an invention of any manner of manufacture. 5thly, That the invention was not new. 6thly, That the invention was of no utility to the public. 7thly, That the specification mentioned in the declaration did not sufficiently describe the invention. 8thly, That the patentee did not enrol any sufficient specification; and, 9thly, Not guilty. The plaintiff in each of those cases obtained a rule to show cause why two of the pleas should not be struck out, (the first and third,) but the Court of Common Pleas, after argument, discharged the rules with costs.

In the case of *Bunnett and Corpe v. Smith*, (e) which was an action by a patentee and the assignee of a moiety of a patent, the defendant applied to a Judge at Chambers for leave to plead similar pleas to those pleaded in *Beddells v. Massey*, with an additional plea traversing the allegation of assignment of a moiety of the patent. The learned Judge refused to allow the defendant leave to plead either *non concessit*, or the plea traversing the assignment. But the Court of Exchequer held that those two pleas were proper pleas, and gave the defendant leave to plead the whole of the pleas.

*The pleas just mentioned to have been pleaded in the cases [*281] cited are indeed now the usual pleas to a declaration in a patent action; and although they do not raise every possible ground of defence, they are amply sufficient in a great majority of cases.

In the recent case of *Bentley v. Keighley*, (f) the Court of Common Pleas allowed the defendant to plead a plea that a part of the invention was not a manufacture, in addition to a plea that the whole invention was not a manufacture within the meaning of the statute. And the Court granted leave to plead the additional plea in this case, on the ground that there might be a doubt whether a plea that the whole invention was not a manufacture within the statute, would enable the defendant to raise the objection that a part of it was not such a manufacture.

But in the case of *Clark v. Kenrick*, (g) in which a part of the invention had been disclaimed, under the statute 5 & 6 Will. IV. c. 83, s. 1, the Court of Exchequer refused to allow the defendant to plead pleas applicable to the whole invention, and also similar pleas to that part which was undisclaimed.

(c) 2 Dowl. & Low. 322.

(e) 13 M. & W. 552.

(g) 1 Dowl. & Low. 392.

(d) Not yet reported.

(f) 1 Dowl. & Low. 944.

Several of the pleas which have been noticed, merely traverse some allegation contained in the declaration, and therefore conclude by the defendant putting himself upon the country, (as it is called,) so as to tender an issue in fact for trial by a jury. To such pleas the only replication necessary is a common joinder, by which the issue in fact is actually raised for trial.

If a plea that the patentee was not the true and first inventor be merely a traverse of an allegation contained in the declaration, it must of course conclude to the country, and the replication to such a plea will therefore be a mere joinder of issue. (h) But if the plea is not a traverse of any thing alleged in the declaration, it must show that the patent is void by reason of the patentee not being the true and first inventor, and conclude with a verification. The replication to such a plea must therefore allege affirmatively that the patentee was the true and first inventor of the invention, with a conclusion to the country. (h) When [*282] the plea sets out the representation made by the patentee that he was the true and first inventor, and then concludes by an averment that the representation was untrue, and that the patentee was not the true and first inventor, and the patent therefore void, the plaintiff is put to his election which part of the plea he will traverse. If the plea does not state correctly the representation which the patentee actually made to the Crown, it will be sufficient for the plaintiff to deny that part of the plea which alleges that he made the representation; but if the defendant sets out the representation correctly, then the only course for the plaintiff to adopt is to deny the latter part of the plea, and allege that the representation was correct. (i)

So with respect to a plea denying that the invention is such an improvement as described in the title, or that it is applicable in manner mentioned in the title. In such a case if the declaration contain any express allegation of which the plea is a mere traverse, the plea will conclude to the country, and the replication will be only the common joinder of issue. But if the plea sets out the representation made to the Crown that the invention was an improvement of the description, or was applicable in the way mentioned in the title, alleging that the representation was false, and that the patent was therefore void, the plaintiff must, in his replication, either deny that such a representation was made, or allege that the representation was true,—of course concluding to the country. (k)

The replication to a plea merely traversing an allegation contained in the declaration respecting the utility of the invention, will, of course, be only the common joinder. But if the plea alleges that the invention was of no use to the public, and that by reason thereof the patent was void, such a plea must conclude with a verification, and the replication to it must allege affirmatively that the invention was of use to the public.

The same observations apply to a plea putting in issue the novelty of the invention: the replication to such a plea will either be a common joinder, or a traverse of the allegations of the plea as to the want of novelty.

[*283] A plea alleging that the invention is not such an invention as may be made the subject of a patent privilege, is generally framed in the terms of the sixth section of the Statute of Monopolies, (l) and will seldom be a traverse of any allegation in the declaration. The replication to such a plea must therefore allege that the invention is such an invention as may be legally made the subject of a privilege, with a conclusion to the country.

A plea merely denying the sufficiency of the specification as alleged in the declaration, or the enrolment of it, will only require the common joinder by

(h) See a Form in the Appendix, Chap. II. a. 4.

(i) See the Forms in the Appendix, Chap. II. a. 4.

(k) See the Forms in the Appendix, Chap. II. a. 4.

(l) See the Forms in the Appendix, Chap. II. a. 4.

way of replication. But when the plea alleges that for want of a specification, or for want of a specification having been enrolled within six months, the patent has become void, the plaintiff must show a sufficient specification or enrolment in his replication.

The pleadings in a patent action very rarely extend beyond a rejoinder, for the replication is almost always either a joinder of issue, or a mere traverse of the defendant's plea. Therefore when a rejoinder becomes necessary, it is generally a mere similitur for the purpose of joining issue.

The plaintiff or defendant in a patent action may, of course, demur at any stage of the pleadings in precisely the same way as in other actions.

It is rarely expedient for a plaintiff to demur in such an action, for a plaintiff's object is generally to establish his legal title to his patent privilege with as little delay as possible; and a demurrer is almost certain to postpone the final determination of a cause.

A defendant in such an action can rarely plead without having obtained an order for time, by which he is laid under terms to plead issuably: and in order to comply with these terms, the defendant must plead pleas upon which the plaintiff can join issue, and go to trial upon the merits.

If a defendant plead any plea in violation of these terms in such an order, the plaintiff may sign judgment against him as for want of a plea. The plaintiff therefore has sufficient security that a defendant in such an action will not plead a frivolous plea; and if a plea is good in substance, it can seldom be beneficial for a plaintiff to demur to it on account of "any defect [*284] in form merely. And indeed he ought never to demur to any pleading of the defendant on the ground of informality only, or in any case, unless he will be prejudiced by pleading over instead of demurring.

And it is seldom for the benefit of a defendant in such an action to demur, for during the time the action is pending, he must generally be uncertain respecting his right to manufacture the article which is complained of as an infringement of the patent; and if it should ultimately turn out that he has been violating a valid patent right belonging to the plaintiff, he will have been employing his time and capital for the benefit of the plaintiff, who will be entitled to the whole of the profits.

It must always require some considerable time to bring a patent action to a determination; and for the reasons already given, it is not often to the interest of either party to cause more delay by any unnecessary demurrer. Demurrers, therefore, are rarely seen in such an action, each party preferring to take issue in fact upon the pleading of the opposite party when he can do so safely and without prejudice to his case.

Before the making of the new pleading rules, the defendant in a patent action was permitted to raise every possible objection to the patent by way of defence, under the plea of not guilty. (m) This operated very much to the prejudice of patentees, who were frequently taken by surprise at the trial by some objection which was quite unexpected. The new pleading rules operated very beneficially by limiting the effect of the plea of not guilty to a denial of the alleged wrongful act or acts stated in the declaration, and by compelling the defendant to raise the objections which he intends to take to the patent by some plea showing the ground upon which he alleges that the patent is void.

By the 5th section of the statute 5 & 6 Will. IV. c. 83, it was enacted, "That in any action brought against any person for infringing any letters patent, the defendant on pleading thereto shall give to the plaintiff [and in any *scire facias* to repeal such letters patent, the plaintiff shall file with his declaration]

(m) Vide ante, p. 278.

[*285] "a notice of any objections on which he means to rely at the trial of such action; and no objection shall be allowed to be made on behalf of such defendant [or plaintiff respectively] at such trial, unless he prove the objections stated in such notice: Provided always, that it shall be lawful for any Judge at Chambers, on summons, served by such defendant [or plaintiff] on such plaintiff [or defendant respectively,] to show cause why he should not be allowed to offer other objections whereof notice shall have been given as aforesaid, to give leave to offer such objections on such terms as to such Judge shall seem fit."

It is probable that, at the time this act was drawn, the beneficial operation of the new pleading rules, in favour of patentees in patent actions, was unknown, or not considered; but be that as it may, the statute was passed *after* the new pleading rules came into operation, and therefore the enactment in question must be deemed to have been made for the purpose of giving the plaintiff in a patent action some benefit other than that which he derived from the new pleading rules. For this reason it has been decided that it is not sufficient, in a notice given under the statute, to specify every objection in as general terms as in a plea. In some cases indeed a plea states an objection with as much particularity as can be required in a notice: thus, the objection that the patentee was not the true and first inventor, is stated with as much particularity in a plea as can possibly be required in a notice of objections, for the nature of the subject does not admit of anything more being stated, unless the defendant was to mention the evidence by which he would establish his objection; and it is clear that the statute was not intended to compel a defendant to state his evidence in the notice. But whenever a plea will enable a defendant at the trial to raise several different and distinct objections to the patent, the patentee is entitled under the statute to notice of the objections upon which the defendant intends to rely in a form more specific and particular than the plea.

It has been decided that the Courts of Common Law have jurisdiction over the notices to be given in pursuance of this statute; and that whenever such a notice is not sufficient, the defendant may be ordered to amend it in the several [*286] respects in which it is insufficient, or to deliver a fuller and more particular notice. (n)

The power of the Courts to order further and better notices of objections, is derived from their general jurisdiction over all proceedings in actions before them, precisely in the same way as they derive their power over particulars of a set-off, pleaded by a defendant in pursuance of the statute of set-off, from their general jurisdiction.

There has been some difference in opinion amongst the Judges respecting the particularity necessary to be observed in framing notices under this statute; but almost all the reported cases on the subject have arisen upon applications for further and more particular notices of objections, and there are very few reported cases of decisions respecting the sufficiency of such notices to let in any particular objection at *Nisi Prius*.

Indeed it has been decided, that the only question which can arise at *Nisi Prius* respecting such a notice is, whether the language of the notice is sufficient to include any particular objection made by the defendant. (o)

In the case of *Fisher v. Dewick*, (p) it was decided, that a notice of objections which is vague, and calculated to mislead the plaintiff, is not a sufficient compliance with the statute; and a further and better notice was ordered. And

(n) *Bulnous v. Mackenzie*, 4 Bing. N. C. 127; *Losh v. Hague*, Godk. 2nd ed. 239.

(o) *Neilson v. Harford*, 1 Webs. R. 370; 8 M. & W. 822.

(p) 1 Webs. R. 264; 4 Bing. N. C. 706.

it was held in that case, that an objection, "That if any part be new the same is useless and unnecessary," was insufficient; and that the defendant should have pointed out what part. And an objection, "That the improvements, or some of them, have been used long before," was also held insufficient, because the defendant ought to have pointed out which of the improvements had been used before.

In the case of *Bulnois v. Mastenzie*, (q) it appeared that one of the objections stated that the invention had been used by J. H. M., and others, before the grant of the patent. *Vaughan*, J., at Chambers, ordered (amongst other things) that the defendant should furnish the plaintiff with the names, [*287] addresses, &c., of the persons referred to in this objection; but the Court of Common Pleas afterwards set aside so much of the order as related to the names, addresses, &c., of these persons.

In the case of *Galloway v. Bleadon*, (r) the defendant had delivered a notice stating that the invention was old, and had been used by persons named, and divers other persons, before the date of the patent. Upon a summons at Chambers in this case, *Coltman*, J., ordered that the names, addresses, and descriptions of the persons who had used the invention to be given, and the words "and divers other persons" to be struck out.

In the case of *Jones v. Berger*, (s) one of the defendant's objections was, that the patentee was not the true and first inventor, the same having been published by certain persons named in the specifications of their patents, (which were sufficiently referred to,) "and also by other persons in other books and writings" before the date of the patent. The Court of Common Pleas held this objection was insufficient, and ordered the defendant to specify the books he intended to rely upon. Another objection was, that the invention had been known and practised by persons at Nottingham and elsewhere, before the patent. The Court held this objection also to be insufficient, and ordered the words "and elsewhere" to be struck out, and the names of the other places inserted.

In the case of *Heath v. Unwin*, (t) the defendant gave notice of the following objections: *first*, that the patentee was not the inventor of the improvements, in respect of which the patent was alleged to be in force; *secondly*, that the specification and disclaimer in the declaration mentioned did not sufficiently describe the nature of the invention, and the manner in which it was to be performed; *thirdly*, that the invention did not produce the effect stated in the specification, nor was such effect produced by the plaintiff in the manner therein stated; *fourthly*, that the invention was not new, and was either wholly or in part used and made public before the obtaining the letters [*288] patent; *fifthly*, that the invention did not essentially differ from other similar inventions, which were in public use at or before the granting of the said letters patent; *sixthly*, that the defendant had the plaintiff's leave and license to make use of the improvements for which the letters patent were granted. The plaintiff obtained a rule to show cause why the defendant should not deliver a further and better particular of the objections intended to be relied on. The Court of Exchequer held, upon the authority of the case of *Fisher v. Derick*, (u) that the fourth objection was insufficiently stated; and that it was not sufficient to say that an alleged invention was *wholly or in part* made public before the obtaining the letters patent, but that it should be shown what part was so used. The Court therefore ordered the fourth objection to be

(q) 4 Bing. N. C. 127.

(r) 2 Chit. Arch. Prac. 1031; 1 Webs. R. 522.

(s) 5 M. & G. 208; 1 Webs. R. 544, S. C.

(t) 2 Dowl. & Dowl. 482; 10 M. & W. 684, S. C.

(u) 4 Bing. N. C. 706.

amended, but held that all the other objections were sufficiently stated. In giving judgment in this case, Lord Abinger, C. B., (after expressing an opinion that the fourth objection was not sufficient,) said, that "With respect to the second (objection,) surely it is enough for the defendant to say that the specification does not properly set forth the invention. *The legislature never intended that the defendant should argue his case in the statement of objections, which he delivers in compliance with the act.*"

In the case of the *Queen v. Walton*, (x) which was a *scire facias* to repeal a patent, the notice of objections stated, that before the granting of the defendant's patent, a patent, comprehending part of the invention claimed by him, had been granted to one Thomas Hancock, and that part of the invention used, but neither the declaration nor the notice of objections specified the name of any person supposed to have used such part of the invention. The defendant applied to the Master of the Rolls for an order upon the prosecutors to deliver a particular of such names, but the order was refused. After the record had been brought into the Court of Queen's Bench, the defendant obtained a rule in the latter Court calling upon the prosecutor to show cause "why he should [*289] not deliver to the attorney or agent for the defendant a statement *in writing containing the names and places of abode of the persons whom he intended, upon the trial of the cause, to prove had manufactured or used the invention; or why, in default thereof, the prosecutor should not be precluded from giving evidence of such prior manufacture or use." The rule was obtained on an affidavit, stating that the defendant had no other means of gaining the information required, and was in danger of being taken by surprise at the trial, unless the particulars were ordered. The Court, after argument and taking time to consider, discharged the rule, and Lord Denman, C. J., said, in delivering the judgment of the Court, "We agree with the Master of the Rolls, rather than with the Court of Common Pleas, (y) and think that the particulars should not be ordered."

In the case of *Russell v. Ledsam*, (z) which was an action for the infringement of a patent, for an additional term granted to the assignee of the original patent, the defendant gave notice of objections:—*first*, That the original patentee was not the true and first inventor; *secondly*, That the invention was not new; *thirdly*, That the new letters patent and the report of the Judicial Committee of the Privy Council, whereon the new letters patent were founded, were obtained by fraud and misrepresentation. The plaintiff obtained a rule *nisi* for further and better particulars of the objections, which the Court made absolute as to the second and third objections, but discharged it as to the other. In delivering the judgment of the Court of Exchequer, Parke, B., said, "The principal point discussed was, whether or no it was necessary in an objection on the ground that the patentee was not the first inventor, or that the invention was not new, that the defendant should state who was the first inventor, or when and in what place, and under what circumstances, it was used before. This point is not new, for it has been already before this Court, and also before the Court of Common Pleas, in the case of *Bulnois v. Mackenzie*. (a) In that case the Court of Common Pleas would not require those particulars to [*290] be given, *and their example has been followed by this Court, in the case of *Heath v. Unwin*. (b) In the subsequent case, however, of *Jones v. Berger*, (c) the Court of Common Pleas deviated from their

(x) 2 Q. B. 969.

(y) In *Jones v. Berger*, 1 Webs. R. 544, cited *ante*, p. 287.

(z) 11 M. & W. 647; 1 D. & L. 347. (a) 4 Bing. N. C. 127.

(b) 2 Dowl. & Dowl. 482; 10 M. & W. 684, S. C.

(c) 5 M. & G. 208; 1 Webs. R. 544.

former decision in *Bullock v. Mackerzie*, and compelled the defendant to give the name of the first inventor. On consideration of the matter, however, we think that we ought to abide by the cases of *Heath v. Unwin*, and *Bulnois v. Mackerzie*, and that no particulars of the circumstances under which this invention may have been previously used, should be required from the defendant; and we are fortified in this view by the decision of the Court of Queen's Bench, in the case of *Regina v. Walton*, (d) in which they adopted the same view. That was originally an application to the Master of the Rolls, which afterwards came before the Court of Queen's Bench, which we find, on inquiry, to have determined this point the same way. On the authorities, therefore, we are bound to say that no such particulars ought to be required as are here asked for; and the argument is very strong to confirm the propriety of that course, viz: that to require the defendant to afford this information, would be throwing the burden of proof on the wrong party. This rule must, therefore, be discharged as to this part of it, and can only be made absolute so far as it requires the defendant to point out whether he means to object to the patent altogether, as being granted for what was in reality an old invention; and if he only proposes to object to part, then he must state what part. If he means to object to the entire patent, he may state that he objects to it generally as not new; if he means to object to a particular part, he must designate that part. Then with respect to another objection which has been made, relative to the part of the notice which reiterates the terms of the plea that the patent was obtained by fraud, covin, and misrepresentation, we certainly think that the defendant ought to state in what that fraud consisted, and what was the species of misrepresentation by which he means to allege that the patent was obtained from the Privy Council. This rule will therefore be made absolute so far as it requires the defendant to furnish better particulars of the fraud, [*291] covin, and misrepresentation mentioned in the plea, and also so far as requiring the defendant to state either that he objects to the patent generally as not being a new invention, or that he only objects to part of it on that account, in which case he must specify what part. In all other respects the rule must be discharged."

And in the recent case of *Bentley v. Keighley*, (e) in the Court of Common Pleas, the notice of objections stated that the invention was known to M. R. "and others," before the date of the patent; and that from them, or one of them, the patentee acquired a knowledge of the invention: that M. R., J. W., "and others," were respectively the first and true inventors:—and that the invention before the date of the patent was used by M. R., the patentee, "and others." The plaintiff obtained a rule nisi for a better notice of objections, and it was objected that the words "and others" made the notice too general, and that they ought to be expunged, but the Court discharged the rule.

Although plaintiffs always profess to apply for further and better particulars of objections, on the ground that the notice does not furnish them with sufficient information; the real motive generally is to get rid of some of the objections, or to restrict the defence as much as possible. The object of the statute, however, was not to limit the defence, but to diminish the expense at the trial, and prevent the patentee from being taken by surprise. (f)

But as a defendant in a patent action always takes care to state every possible objection which can be taken to the patent, the plaintiff does not really derive any advantage from the notice; and it is not improbable that section five of the statute 5 & 6 Will. IV. c. 83, which gives the plaintiff a right to the notice,

(d) 2 Q. B. 969.

(e) 1 Dowl. & Low. 946.

(f) Per Tindal, C. J., *Fisher v. Dewick*, 1 Webs. R. 267; 4 Bing. N. C. 706.

will be repealed as useless, and productive of much unnecessary cost and vexation.

Patent actions are always tried at *Nisi Prius*, and not at the bar of the Court, although the Court might, if it pleased, order a trial at bar. Few causes require so much care and industry in preparing for trial as patent actions, in which [*292] very nice points of law, and difficult questions of fact, must often *be decided between the parties; and it will frequently happen that a party will succeed or fail in obtaining a verdict, according to the industry with which he has got up his case for trial. Properly to understand the questions raised in such actions, and prepare the necessary proofs, a competent knowledge not only of law, but also of science in general, and the useful arts, are essentially requisite.

The plaintiff is entitled to have his action tried notwithstanding the pendency of an action of *scire facias* to repeal the patent. For the plaintiff has no means of compelling a prosecutor to proceed to trial with a *scire facias*, and even if he had means, the result must be deemed to be uncertain; and if the patentee obtains a verdict in the *scire facias*, he will have been prejudiced by the trial of his action for an infringement having been delayed.

In the case of *Muntz v. Foster*, (g) in the Common Pleas, which was an action for damages for the infringement of the plaintiff's patent, it appeared that the defendants (who were under an injunction) had brought an action of *scire facias* to repeal the plaintiff's patent, and that according to the ordinary practice of the Queen's Bench it would have been tried before the action in the Common Pleas; but that in consequence of special circumstances the trial of the *scire facias* had been delayed. The questions respecting the validity of the patent were the same in each case, and the defendants in the Common Pleas having obtained a rule *nisi* to postpone the trial of the action in that Court, it was contended for them, that as the right of the plaintiff to maintain the action might be altogether destroyed by the proceeding in *scire facias*, they ought not to be compelled to go to trial in the action for an infringement, but that the proceedings ought to be staid; that the defendants being under an injunction, the plaintiffs could not be prejudiced by the delay, the delay being rather to the prejudice of the defendants, who were willing to submit to the injunction in the mean time. But the Court discharged the rule, and the Lord Chief Justice *Tindal* said, in giving judgment, "As a general rule, a plaintiff has a right to [*293] have his cause go on to trial according to the ordinary course of *business. Special circumstances may exist, upon which the Court may see fit to interpose; but the present does not appear to us to be a case in which we ought to interfere, by staying the proceedings in the action."

But in the case of *Patteson v. Holland*, (h) in the Common Pleas, where one action for the infringement of a patent had been tried, and a rule *nisi* for a new trial had been obtained and argued; and it appeared that another action was pending in that Court for another infringement of the same patent, and that a *scire facias* had been sued out to repeal the patent, the Court suspended their judgment upon the rule for a new trial, and ordered the trial of the other action to be postponed until after the trial of the *scire facias*.

And in the case of *Smith v. Upton*, (i) in the Common Pleas, it appeared that the defendant had sued out a *scire facias* to repeal the plaintiff's patent, and a verdict had been obtained for the Crown, but a rule *nisi* for a new trial was pending in the Queen's Bench. Whilst the rule for a new trial was pending in the Queen's Bench, the defendant in the action in the Common Pleas

(g) 1 Dowl. & Low. 942.
(i) 6 M. & G. 251.

(h) T. T. 1845, not yet reported.

gave notice of trial by proviso, but the Court, upon the application of the plaintiff, made a rule absolute for postponing the trial.

The defendant in a patent action almost always pleads not guilty, or some other plea, raising an issue upon which the burthen of proof rests with the plaintiff. The plaintiff's counsel in such an action, therefore, generally obtains the right to begin, and also to reply, at the trial of the cause, if the defendant calls witnesses. As the determination of the issues, in fact, in an action respecting a patent frequently turns upon nice distinctions and the credit to be given to the respective witnesses, the right to reply is generally esteemed to be of the greatest value; and a defendant will sometimes have recourse to an action of *scire facias*, in order to obtain this advantage.

The reading of the notice of objections will not give the plaintiff's counsel a right to reply; and it seems that the proper course is, that the notice should be read at the time the pleadings are opened. (k)

*It is provided by the 5 & 6 Will. IV. c. 83, s. 5, already [*294] noticed, (l) that no objection shall be allowed to be made on behalf of a defendant at the trial, unless he prove the objections stated in his notice. The language of this enactment is very extraordinary; and it seems that according to the letter of this law, if a defendant were to prove the objections stated in his notice, he would not be prevented from taking other objections. (m) This, however, could hardly be the intention of the legislature; and although there has been no decision upon the point, yet it is apprehended that a defendant cannot be permitted to take any objection which is not actually stated in the notice. For in a subsequent part of the same section of the act, it is provided that a Judge at Chambers may give leave to a defendant to offer other objections beside those included in his notice, which would have been unnecessary if the proof of the objections stated in the notice would enable the defendant to take others also.

There are very few, if any, reported decisions respecting the sufficiency of notices to let in the defendant's objections at *Nisi Prius*. It has, however, been held, that the only question which can arise at *Nisi Prius* respecting such a notice is, whether the language of it is sufficiently extensive to include any particular objections sought to be raised by the defendant. (n)

It seems that the provision of the statute respecting notices must be construed to extend only to objections to the validity of the patent; and that is unnecessary (although usual) to state in the notice of objections that the defendant will deny the alleged infringement of the patent. And if a defence to the action should be a denial under the plea of *non concessit*, that there is in fact any such patent as the plaintiff alleges, it does not appear to be necessary to state the defence in the notice of objections; for if the defence can be sustained, it is not an objection to a patent, no such patent as alleged being in existence. So if the defendant objects to the patent being received in evidence for want of a stamp, the objection does not seem to be one of which notice need be given to the plaintiff.

*The defendant cannot at the trial be allowed to take any objection to the validity of the patent, unless he has raised the objection [*295] by a proper plea, (o) even if proper notice has been given of the objection; (p)

(k) *Neilson v. Harford*, 1 *Webs. R.* 309, n. (h).

(l) *Vide ante*, p. 284.

(m) *Vide per Rolfe, B.*, in *Neilson v. Harford*, 1 *Webs. R.* 332.

(n) *Neilson v. Harford*, 1 *Webs. R.* 370.

(o) *Walton v. Potter*, 1 *Webs. R.* 601.

(p) *Gillet v. Wilby*, 1 *Webs. R.* 270; 9 *C. & P.* 334.

for the notice of objections was not intended to supersede the necessity of the pleas required by the rules of pleading.

But although a defendant is at liberty to take any objection to a patent which comes fairly within the meaning of the language in his notice, yet he must make the objection clear at the trial, so that the plaintiff's attention may be called to it, or the defendant will not afterwards be allowed the benefit of his objection upon a rule nisi to enter a nonsuit or verdict for him. (q)

It is the province of the jury at the trial to determine each issue in fact which is developed by the pleadings; but they have nothing to do with the notice of objections further than to decide whether the several objections raised by the defendant are founded in fact, the sufficiency of the notice to let in the objections being a question for the Judge.

Although the maintenance of patent rights is in some measure an infringement of the rights of the public, (r) yet the interest which the public has in the encouragement held out to inventors by the grant of such exclusive rights is quite as great.

In the trial of a patent action, therefore, the public is only interested to have the questions as to the validity or invalidity of the patent fairly decided between the parties. But even if it were to the interest of the public to have a particular patent destroyed, yet at the trial of an action upon such a patent the consideration of the benefit or convenience which would accrue to the public by having the patent destroyed must be entirely disregarded.

Thus in the case of *Arkwright v. Nightingale*, (s) it was urged by the defendant's counsel, that it was highly for the public benefit that a verdict should be given against Mr. Arkwright the patentee; but Lord *Loughborough*, before [*296] whom the cause was tried said, "We must never decide private rights upon any idea of public benefit. I must tell the jury that they must shut out that part of the argument. I cannot let a cause between A. and B. be determined upon consequential reasons, that it is beneficial to the public that A. should prevail." And although it was urged for the defendant, that by the statute against monopolies, (t) no patent is to prevail that is generally inconvenient or against public trade, yet his Lordship held that the question of public benefit must be excluded; and said that "Nothing could be more essentially mischievous than that questions of property between A. and B., should ever be permitted to be decided upon considerations of public convenience or expediency. The only question that can be agitated in Westminster Hall, is which of the two parties in law or justice ought to recover."

The plaintiff in a patent action is, strictly speaking, entitled to recover such an amount of damages as will fairly compensate him for the injury which he has sustained by reason of the wrongful acts of the defendant proved at the trial. Patent actions, however, are generally brought merely to try the validity of the letters patent, and not for the recovery of substantial damages from the defendants. It is usual, therefore, to ask and obtain a verdict for nominal damages only, for a patent being once established at law, the Court of Chancery will afterwards support, and effectually protect, the rights of the patentee.

In order to recover substantial damages in a patent action, it would be necessary for the plaintiff to give such evidence as would enable the jury to estimate the extent of the loss and injury which he has sustained; and in the absence of such evidence, the plaintiff is not entitled to more than nominal damages. And even in a second action upon a patent which has been held to be valid, the plaintiff is not entitled, in the absence of such evidence, to more than nom-

(q) *Bickford v. Skewes*, 1 Webs. R. 219. * (r) *Vide ante*, Chap. I. p. 2.

(s) *Dav. P. C.* 51, 52, 55.

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

inal damages. (u) The infringement of a patent is usually carried on in secret, and even when that is not so, a patentee would find much difficulty in procuring the evidence necessary to show the actual extent to which a defendant has carried the infringement so as to enable a jury to [*297] award him an adequate remuneration for the injury he has sustained.

In a Court of Equity, however, where a defendant is obliged to make full discovery on oath of all the particulars in any way relating to the infringement of the patent, and the amount of profit he has thereby made, as well as to produce all his books, accounts, &c., the plaintiff may recover some adequate recompense for the amount of his losses. (x)

There have been cases, however, in which plaintiffs have recovered substantial damages for the infringement of their patent rights; (y) and where a plaintiff is able to give evidence of any considerable amount of infringement, it may be better in some cases at once to seek for substantial damages at the hands of a jury rather than have recourse to dilatory and expensive proceedings in the Court of Chancery.

If a suit in Equity is pending or intended to be commenced against the defendant in a patent action, the plaintiff ought not to ask for more than nominal damages at the trial of the action; for he cannot claim to be recompensed twice, and if he has once asked a jury to assess them, he cannot afterwards, it is apprehended, go into a Court of Equity, and say that the jury have not sufficiently recompensed him for the injury which he has sustained.

But it is usual for a plaintiff to endeavour to procure a verdict for forty shillings at least, because a verdict for a smaller amount of damages will not, since the passing of a recent statute, (z) enable him to recover his costs in the action.

New and important points of law frequently arise at the trial of patent causes, and a verdict for the plaintiff or defendant in such a cause is generally followed by an application by the unsuccessful party for a new trial, for a nonsuit, or for judgment, notwithstanding the verdict. There is, however, nothing particular respecting such applications which need to be noticed in a work of this description.

*Before the passing of a recent statute, (3 & 4 Vict. c. 24,) [*298] nominal damages in a patent action were sufficient to entitle the plaintiff to recover his full costs against the defendant; but the Judge before whom the action was tried might have certified, under the 43 Eliz. 6. c. 8. s. 2, to deprive the plaintiff of costs.

By the statute 3 & 4 Vict. c. 24, s. 1, so much of the 43 Eliz. c. 6, as relates to costs in actions of trespass on the case, (which includes patent actions) is repealed; and by section 2, it is enacted, "That if the plaintiff in any action of trespass, or trespass on the case brought in any of the Courts at Westminster, or the Courts of Common Pleas at Lancaster or Durham, shall recover by the verdict of a jury less damages than forty shillings, such plaintiff shall not be entitled to recover or obtain from the defendant, in respect of such verdict, any costs whatever, whether it shall be given upon any issue or issues tried, or judgment shall have passed by default, unless the Judge or presiding officer before whom such verdict shall be obtained, shall *immediately afterwards*

(u) *Minter v. Mower*, 1 Webs. R. 138; see the observations of Lord Loughborough, in *Arkwright v. Nightingale*, Dav. P. C. 55.

(x) Vide sec. 3, *post*, in this Chap.

(y) See *Lewis v. Marling*, 4 C. & P. 52, in which the plaintiff obtained a verdict for 200*l.* damages. There is, however, no subsequently reported case in which more than nominal damages were recovered.

(z) 3 & 4 Vict. c. 24.

certify on the back of the record, or on the writ of trial or writ of inquiry, that the action was really brought to try a right, besides the mere right to recover damages for the trespass or grievance for which the action shall have been brought, or that the trespass or grievance in respect of which the action was brought, was wilful and malicious."

The effect of this enactment is to deprive the plaintiff in a patent action of any costs whatever, unless he procures a certificate by the Judge who tries the cause that the action was really brought to try a right, besides the mere right to recover damages. (a)

In the case of *Gillet v. Green*, (b) which was tried immediately after the stat. (3 & 4 Vict. c. 24,) came into operation, the effect of the statute upon patent actions was not averted to. The plaintiff in that case obtained a verdict for nominal damages, but did not apply for a certificate under the act; and it was held by the Court of Exchequer, that the statute clearly applied to the action, and deprived the plaintiff of all right to costs. And in the same case [*299] it was held, that the *Judge had not power afterwards (several months had elapsed) to grant the plaintiff a certificate, and the Court intimated that it might even be a question whether the Judge could grant the certificate after another cause had been called on.

By the statute 5 & 6 Will. IV. c. 83, s. 6, it is enacted, "That in any action brought for infringing the right granted by any letters patent, in taxing the costs thereof, regard shall be had to the part of such case which has been proved at the trial, which shall be certified by the Judge before whom the same shall be had, and the costs of each part of the case shall be given according as either party has succeeded or failed therein, regard being had to the notice of objections, as well as the counts in the declaration, and *without regard to the general result of the trial.*"

It was decided in the case of *Losh v. Hague*, (c) that this enactment does not repeal sect. 74 of the general rules of Hilary Term, 2 Will. IV., (d) as to patent actions. By that rule, it is ordered that "No costs shall be allowed on taxation to a plaintiff upon any counts or issues upon which he has not succeeded; and the costs of all issues found for the defendant shall be deducted from the plaintiff's costs."

In *Losh v. Hague*, (c) there were four issues raised by the pleadings, and the defendant had given notice of seven objections to the patent. At the trial the defendant succeeded in establishing one of his objections, which was applicable under the third issue, but failed as to his other objections, and the plaintiff had a verdict upon the other three issues. The issue upon which the defendant succeeded being a bar to the whole cause of action, the Master in taxing the costs allowed the defendant *the general costs* of the cause, as well as those on the third issue, from which he deducted the plaintiff's costs of the three issues upon which he had succeeded. It was contended for the plaintiff, that the above section of the general rules was rendered inoperative by the 6th section of the stat. 5 & 6 Will. IV. c. 83; and that the plaintiff was therefore entitled to three-fourths of the *general* costs of the cause. The Court of Exchequer, however, held that the statute had not the effect contended for, and that the defendant was entitled to the general costs of the cause.

[*300] *By the stat. 5 & 6 Will. IV. c. 83, s. 3, it is enacted, that "If any action at law [or any suit in equity] for an account shall be brought in respect of any alleged infringement of such letters patent heretofore

(a) See the Forms of Certificates in the Appendix, Chap. II. s. 4.

(b) 7 M. & W. 347.

(c) 7 Dowl. 495.

(d) Charn. New Rules, p. 64.

or hereafter granted, [or any *scire facias* to repeal such letters patent,] and if a verdict shall pass for the patentee or his assigns, [or if a final decree or decretal order shall be made for him or them upon the merits of the suit,] it shall be lawful for the Judge, before whom such action shall be tried, to certify on the record, (d) [or the Judge who shall make such decree or order, to give a certificate under his hand,] that the validity of the patent came in question before him; which record or certificate being given in evidence in any other suit or action whatever touching such patent, if a verdict shall pass, or decree or decretal order be made in favour of such patentee, or his assigns, he or they shall receive treble costs in such suit or action, to be taxed at three times the taxed costs, unless the Judge making such second or other decree or order, or trying such second or other action, shall certify that he ought not to have such treble costs. (e)

The object of this enactment was doubtless to protect a patentee who has fairly once established the validity of his patent in a Court of Law or Equity. A patentee can rarely establish the validity of his patent without incurring a very large amount of costs both at law and in equity; and when he does at last succeed in his object, he finds that he is not allowed on taxation as against his opponent much more than half the amount of the costs he has incurred.

This is a most serious grievance to patentees, but it is difficult to provide a remedy. The subject of a patent must be new to every one to whom the patentee may apply for assistance; and he almost always finds that he must remunerate men of science and skill for their loss of time in making themselves sufficiently acquainted with the subject of his invention to enable them to give evidence in his favour.

The amount of costs which a patentee must incur in this manner is sometimes very great; but when the validity of a patent has not been previously established in a Court of Law, *it is difficult to say that a defendant should be compelled to pay the amount of costs which the [*301] plaintiff may have so incurred. Our law reports show that patent actions have raised points of law most difficult to determine, and respecting which Judges of the greatest eminence have differed in opinion. The plaintiff's right on the one hand to a patent privilege, and the defendant's right on the other hand, as one of the public, to the use and exercise of the alleged invention, may, and frequently does, depend upon questions of science or fact the most difficult to solve. It would hardly be fair, therefore, to saddle a defendant with the payment of the costs of determining questions of so much doubt and difficulty. And it has been held (f) that a plaintiff is not entitled to the costs of experiments necessarily made for the purposes of procuring evidence in the cause.

It seems to be a fair rule to lay down, that a party who succeeds in a cause (whether plaintiff or defendant) should be allowed upon taxation all the costs which he has necessarily or fairly incurred in order to procure success; but this or any other general rule which could be laid down, would be most difficult of application in practice.

The rules of taxation which prevail in our Courts might, however, be very advantageously relaxed in favour of parties trying such causes as patent actions. The very strict manner in which our Courts have at all times taxed costs as between party and party seems to have had its origin in a desire to repress frivolous and vindictive litigation; and there can be no doubt that the effect has been to diminish such litigation very much. But the application of the exist-

(d) See the Forms of Certificate in the Appendix, Chap. II. s. 4.

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

(f) *Severn v. Olive*, 3 B. & B. 72.

ing strict rules of taxation to patent actions frequently operates very unfairly to the prejudice of successful parties in such actions, by depriving them of a large amount of their costs, although such costs are such as every prudent man would have incurred in order to insure success. A more liberal mode of taxing costs in such actions would be a great boon to the parties, and remove many of the difficulties under which they labour.

Before a patentee has established his claim to a patent privilege by legal proceedings, he has no proof of his title except his patent, and that has been obtained [*302] upon his own unsupported *representation. But when a patentee's title to a patent privilege has been once fairly established in a Court of Law or Equity, he stands in a very different position; and he may very fairly claim to be better protected by the law than a patentee, who has no verdict, judgment, or decree, evidencing his title to such a privilege. It would not be fair to extend the protection to a patentee who has established his patent right in an action at law, so far as to prevent any person from afterwards contesting the validity of the patent; for the defendant in an action might, through ignorance or collusion with the plaintiff, suffer him to obtain a verdict, and other persons may afterwards be able to show that the patent is void. But when the patentee has the evidence of a verdict or judgment in his favour, it is only proper that he should be so far protected, that if he is again compelled to try the validity of his patent, he should be enabled to recover the full amount of his costs if he again succeeds in establishing his title. The object of the enactment already stated (g) was to indemnify patentees against their costs in actions which they may be compelled to bring after they have established their patent, and also to deter persons from committing vexatious infringements of such patents by the penalty of treble costs.

In order to obtain the protection of this enactment, however, it is not sufficient for a patentee merely to obtain a verdict or decree, but he must also obtain the certificate of the Judge before whom the cause was tried or heard, that the validity of the patent came in question before him. And this is made necessary because the pleadings in a cause might, upon the face of them, appear to raise almost every possible question respecting the validity of the patent; and yet the defendant may not at the trial or hearing raise any such question.

Thus in the case of *Stocker v. Rodgers*, (h) the defendant pleaded pleas putting the validity of the patent in issue; (i) but he offered no defence at the trial, and consented to a verdict for forty shillings damages. The learned Judge (*Erskine, J.*) who tried the cause, refused to give the plaintiff a certificate that the validity of the patent came in question; and *his [*303] Lordship said, "I think that as this is a verdict by consent, and as no evidence has been adduced before me, I ought not to grant a certificate. My certificate would affect third parties; and it would be possible, in a case like the present, for two parties, by collusion, to consent to a verdict in favour of a patent; and if they could obtain a certificate under the third section of the statute, to use it afterwards to the injury of another party who was really contesting the validity of the patent."

But in a case where the validity of the patent did partly come in question, a certificate was granted although the defendant did not call any witnesses. (l)

The costs which this statute enabled the plaintiff in a second or subsequent action to recover, were treble costs, *to be taxed at three times the taxed costs*. The term treble costs in our Courts does not mean three times the amount of

(g) *Ante*, p. 300.

(h) 1 C. & K. 99.

(i) The pleas denied the novelty of the invention and the sufficiency of the specification.

(l) *Gillet v. Wilby*, 9 C. & P. 334; 1 Webs. R. 270.

the parties' taxed costs; being in fact less than twice the amount of such costs. The amount of treble costs is made up thus: to the sum allowed to the party for costs taxed in the ordinary way is added one-half of that sum, and also one-fourth of the same sum, and these three sums being added together form what is technically termed treble costs. (m) But this statute provided, that the treble costs to be allowed to patentee plaintiffs should be not the ordinary treble costs, but treble costs "taxed at three times the taxed costs."

The amount awarded to a plaintiff for costs in pursuance of this statute, might be more than the amount which he actually incurred in the action; but the intention no doubt was, that he should receive the sum (if any) which he recovered from the defendant above the actual amount of his costs, by way of a penalty, and to indemnify him against losses, the amount of which could hardly be ascertained.

The amount of costs to be allowed to a plaintiff in pursuance of this statute, has, however, been materially varied by the recent statute of 5 & 6 Vict. c. 97, which, in fact, takes away treble costs altogether, except under private or local acts, and substitutes what may be termed *full costs* instead.

By the first section of that act it is enacted, that "so *much of [*304] any clause, enactment, or provision in any public act or acts, not local or personal, whereby it is enacted or provided that either double or treble costs, or any other than the usual costs between party and party, shall or may be recovered, shall be, and the same are hereby repealed: Provided always, that instead of such costs the party or parties heretofore entitled under such last mentioned acts to such double, treble, or other costs, shall receive such full and reasonable indemnity as to all costs, charges, and expenses incurred in and about any action, suit, or other legal proceeding, as shall be taxed by the proper officer in that behalf, subject to be reviewed in like manner and by the same authority as any other taxation of costs by such officer."

The cost, therefore, to be allowed to a plaintiff in a second or subsequent action upon a patent, under the 5 & 6 Will. IV. c. 83, s. 3, as altered by the 5 & 6 Vict. c. 97, s. 1, must be taxed in such a way as to be a "full and reasonable indemnity as to all costs, charges, and expenses incurred in and about" the action. (n) It is difficult to say what construction will be put upon this statute, but there can be little doubt that it will be construed liberally, and that a plaintiff will under these statutes be allowed the amount of his costs taxed as between attorney and client.

The right of a patentee to have full costs under these two statutes, in a second or other subsequent action, is, however, dependent upon the discretion of the Judge before whom the cause is tried, who may certify so as to deprive him of such costs. By the 5 & 6 Will. IV. c. 83, s. 3, already stated, (o) it is provided that a patentee shall recover treble costs in a second or other subsequent action, unless the Judge trying such second or other action shall certify that he ought not to have such costs. That provision of course extends to the full costs by the stat. 5 & 6 Vict. c. 97, s. 1, substituted for treble costs, and enables the Judge to certify that a plaintiff ought not to have such costs.

It seems to have been intended by this provision, that although, as a general rule, a patentee in a second or other action, should have treble (now full) costs; yet, that if it should *appear to the Judge trying the second or [*305] other action, that the patentee ought not to have such costs, the Judge might certify so as to prevent him from obtaining them.

(m) See Tidd's Practice, and Chit. Arch. prac. tit. Treble Costs.

(n) See the Form of Certificate, under these two statutes, in the Appendix.

(o) *Ante*, p. 300.

Such a provision was necessary in order to enable a Judge to prevent a patentee from availing himself of a certificate obtained in an action tried by collusion for the purpose of obtaining it. And there may be many other cases in which a Judge would not allow a patentee to have full costs under the statutes; as, if it should appear to him that an action was a harsh or unnecessary proceeding; or that the defendant did not question the validity of the patent, but defended the action *bond fide* for the purpose of trying a doubtful question of infringement; in such cases it is to be apprehended that a Judge would certify in order to prevent a plaintiff from obtaining more than ordinary costs from a defendant.

The form of certificate in such a case would be under the first statute, as altered by the second, that the plaintiff ought not to have full and reasonable indemnity as to all his costs, charges, and expenses, in pursuance of the statutes. (p)

SECTION III.

Of a Suit in Equity.

It is a general rule, that a person is entitled to maintain a suit in Equity only when he can have no adequate or sufficient remedy in a Court of Law. The objects which a patentee has in view when he has recourse to legal proceedings against any person who infringes his patent, are: *firstly*, To put a stop to the further invasion of his rights; and, *secondly*, To recover a recompense for the injury which he may have sustained by the violation of his patent privilege.

In order to restrain the further infringement of a patent, it is absolutely necessary to have recourse to a suit in Equity; for a Court of Law has power only to give a patentee damages for any injury he may have sustained by the actual violation of his right, after it has been committed; and such a Court has no means or power to interfere, so as to protect a patentee against the future invasion of his rights.

[*306] *But a Court of Equity by means of its process of injunction, has power to command a person who has once violated a patent right, to refrain from committing any repetition of the offence, or again violating the patent in any manner whatsoever. And if such a person afterwards violates the patent, he makes himself liable to be punished by attachment, and imprisonment for contempt, at the discretion of the Court.

Nor has a Court of Common Law the means of enabling a patentee to recover an adequate recompense for the violation of his privilege. The infringement of a patent is generally committed in secret, or, at all events, under such circumstances as to preclude the possibility of procuring sufficient legal evidence of the extent of the infringement. There is, in consequence, frequently very much difficulty in the way of procuring evidence of a violation of the patent by a suspected person, and it would be almost impossible in any case to show by legal evidence in a Court of Law the full extent of the injury which the patentee has sustained by the infringement of his patent. But a Court of Equity has a power, not possessed by a Court of Law, of compelling a defendant to answer on oath the complaint made against him by the plaintiff's bill.

(p) See the Form of Certificate in the Appendix, Chap. II. s. 4.

and to make a full discovery of every thing which is necessary to enable the Court to do justice between the parties.

It is evident from what has been stated, that a patentee cannot have any adequate remedy in a Court of Law against parties who may infringe his patent; and therefore it has been held that he is entitled to the aid and protection of a Court of Equity, whenever his patent privilege has been invaded.

But the privilege conferred by a patent is a legal right, (g) which, according to the declaration contained in the Statute of Monopolies, (r) ought only to be tried by the Common Law of the realm. It is a maxim that equity follows the law, and therefore a Court of Equity will only protect the clear and undoubted legal right of a patentee.

And if this title of a patentee is denied by a defendant in Equity, the Court cannot dispense with the necessity which the plaintiff is under to prove a clear and undisputed legal right to the patent privilege which he seeks to protect. Before a patent privilege has been established by a [*307] 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.

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. (v)

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 of the patent privilege, but will compel him to recompense the [*308] patentee for all the profits which he has lost by means of the infringement. (x)

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

(g) As to the Nature of the Right, see Chap. IX. s. 1.

(r) 21 Jac. I. c. 3, s. 2.

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

(t) As to such an action, vide *ante*, s. 2, p. 254.

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

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

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.

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.

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)

[*309] *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 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 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 speci-

(y) See *Dilly v. Doig*, 2 Ves. Jun. 486. (z) See *Westhead v. Keene*, 1 Beavan, 287.

(a) See the Forms in the Appendix, Chap. II. s. 5.

(b) 1 My. & Cr. 373.

fication 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 defendants put in a general demurrer [*310] 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."

In the subsequent case of *Westhead v. Keene*, (c) it appeared [*311] 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 *Kay 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

(c) 1 Beavan, 287.

(d) 1 My. & Cr. 373, cited *ante*, p. 309.

is very questionable whether the whole of the disclaimer or memorandum of alteration should not be set out in the bill.

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

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 [*312] refrain from infringing the patent until he answers the bill, or until *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.

In 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 [*313] of opinion of the Court. That is not the fault *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.

(e) *Ante*, p. 306, 307.

(g) 3 Ves. 140.

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

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."

In the case of *Harmer v. Playne*, (m) upon a motion to dissolve 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." 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;

(k) 6 Ves. 707.

(m) 14 Ves. 130.

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

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

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 [*315] in the shape of a case, stating the *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 said, "The principle upon which the Court acts in cases of this description is the following:—Where a patent has been granted, and an exclusive possession of some duration under it, the Court will interpose its injunction, without putting the party previously to establish the validity of his patent by an action at law. But where the patent is but of yesterday, and, upon an application being made for an injunction it is endeavoured to be shown in opposition to it that there is no good specification, or otherwise that the patent ought not to have been granted, the Court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent without the right having been ascertained by a previous trial, but will send the patentee to law, and oblige him to establish the validity of his patent in a Court of Law before it will grant him the benefit of an injunction."

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

In the case of *Collard v. Allison*, (p) the patent had been granted twelve years before, for an improvement in the manufacture of grand square pianofortes. The plaintiffs filed affidavits in support of a motion for an injunction in the usual way. The defendants by their answer, and by affidavits in opposition to the motion, admitted that if the patent was valid, they had infringed it; but they denied the validity of the patent, and stated facts to show that the plaintiffs had not been in the exclusive and undisturbed enjoyment of the patent 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 Cottenham, L. C., [*316] by way of appeal, but his Lordship refused the motion. His *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 cer-

(o) 3 Mer. 622.

(p) 4 My. & Cr. 487.

tain 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 case, in my opinion, wants that evidence of exclusive possession [*317] 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 *prima facie* evidence upon which to grant an interlocutory injunction, until a trial at law.

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 license (since expired,) the plaintiff will be deemed as against him to have a sufficient *prima facie* title. (x)

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.

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.

Thus, in the case of *Hill v. Thompson*, (y) it was laid down [*318] 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

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

(t) 7 Jur. 121.

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

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

(y) 3 Mer. 622.

(z) See in a subsequent part of this Chapter what must be proved by affidavit in order to obtain an injunction.

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 plaintiff's patent, and Sir L. Shadwell, V. C., dissolved the injunction. His Honour, after comparing the alleged infringement with the invention as specified, said, "The alteration is therefore not merely colourable, but, *prima 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 *prima 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 [*319] patent, the plaintiff cannot afterwards have the 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 license, or to pay the plaintiffs a shilling a ton, which was demanded for license 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 license, 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 licenses 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

(a) 1 Webs. R. 167.

(b) 1 Webs. R. 275.

that may be correct, assuming the whole statement *to be true;— [*320] 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 *from using at their furnaces that apparatus, which, with the consent of the plaintiff, they have erected. [*321] 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."

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 [*322] patent article during the *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.

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.

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 sub- [*323] *pœna*; and it is the usual course in such cases to serve *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.

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.

(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.

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.

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.

The advantages of moving for an interlocutory injunction after notice are: first, a saving in expense, (the motion to dissolve being rendered unnecessary;) and in the next place, sufficient time being upon such a motion allowed to both parties *to answer the affidavits of each other, there is much less [*324] probability of either party being taken by surprise.

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.

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.

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 opportunity *of having the deter- [*325] mination 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

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

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 *making all their preparations and arrangements *de* [*326] *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."

In the case of *Collard v. Allison*, (k) 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

(g) 3 Mer. 626.

(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.

matter of course to revive or grant an injunction. (k) 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.

Thus in the case of *Cornish and Sievier v. Keene and another*, (l) 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 discharged, *final judgment was signed, and then the plaintiffs applied to the Court of Chancery for an injunction against [*327] the defendants. The application was opposed by the defendants on two grounds: first, because the defendants had brought a writ of error to reverse the judgment in the action; and, secondly, because the bill in Chancery did not sufficiently allege the assignment of a moiety of the patent to one of the 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 has 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 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 opposed *by the defendants, upon the ground that there [*328] 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 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

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

(l) M. S.

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

(n) 1 Webs. R. 373.

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 [*329] 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 the 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. Roepke; 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 [*330] 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."

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.

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.

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. But 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)

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 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. [331]

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 recompense.

For, as observed by Sir L. Shadwell, V. C. L., in *Morgan v. Scatard*, (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

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

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

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

(s) 1 Webb R. 168.

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.

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 [*332] immediately *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)

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 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.

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.

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 to 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.

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.

[*333] *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.

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.

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

(t) See *Boulton v. Bull*, 3 Ves. 140; and *Colard 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.

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.

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 *that [*334] it was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect."

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 licenses 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.

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 [*335] laying down a *rule which was to apply to all future cases, and

(y) 3 Mer. 622.

(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.

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 *Lynnhurst*, 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, [*336] at the time 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 *Lynnhurst*, 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. Skews*, (*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 *prima 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

(*f*) 5 Russ. 322-328, 329.
(*h*) 1 Webs. R. 211.

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

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 invention must, [*337] 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.

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 watch-maker 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.

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.

A plaintiff must therefore procure the evidence of some competent person upon affidavit, respecting the utility of the invention; [*338] and it is always advisable to show the extent to which the public has been benefited by the invention.

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.

And if persons have taken licenses 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.

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

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

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. Skewes*, (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 [*339] cited) of *Harmer v. Playne*, (q) and **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.

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 defendant's which is complained of as an infringement.

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.

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.

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.

[*340] The plaintiff must also show that he has used due expedition *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 interlocu-

(k) 3 Ves. 140.

(m) 1 Webs. R. 277.

(o) Ibid. 211.

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

(s) 3 Mer. 622.

(l) 14 Ves. 136.

(n) Ibid. 200.

(p) 3 Mer. 622.

(r) 3 Ves. 140.

tory 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.

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."

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, *to show by affidavit the nature and result of the legal proceedings which have taken place. For [*341] 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)

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 *prima 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.

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

(t) See the case of *Neilson v. Thompson*, before the Lord Chancellor, on Appeal, 1 Webs. R. 278.

(u) 1 Webs. R. 200.

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

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.

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)

[*342] *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)

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)

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)

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)

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 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.

[*343] *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 *prima 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 expenses

(y) Vide *ante*, Chap. III. s. 4, p. 31; and *post*, Chap. XI.; and Index, tit. Evidence.

(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.

(e) 3 Mer. 622.

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."

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 *usual, and, as I apprehend more wholesome prac- [*344]
tice 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 [*345]

(f) 4 My. & Cr. 433.

(g) 4 My. & Cr. 498.

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.

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 new 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 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.

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)

When the Court refuses an interlocutory injunction, or dissolves it upon [*346] motion, and sends the plaintiff into a Court of 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)

(h) 3 Ves. 140.

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

(k) *Beddells v. Massey*, cor. Sir. L. Shadwell, V. C. E., E. T. 1844.

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

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 *of several plaintiffs under an assignment, the defendant will be compelled either to traverse the title so stated, or (by not traversing [*347] 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.

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)

The object of the Court in imposing terms upon the parties *in [*348] 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. (t) For a plaintiff may, at any

(m) 14 Ves. 136.

(n) 1 Webs. R. 167.

(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.

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

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.

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 [*349] injunction to continue during the continuance 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 one form or other,

(s) See the 6th Section of this Chap.

(t) 1 Webs. R. 730.

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

and the most convenient and most effective mode appears to me [*350] 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."

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.

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 *bill [*351] 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

(x) 1 My. & Cr. 373.

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 inquires, not whether the plaintiff may have a title from the facts stated, but whether he has stated a good title. But the cases which [*352] stand upon legal titles differ from those in which the title is altogether *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 [*353] applies *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

(y) 3 Ves. 140.
(a) 3 Mer. 622.

(z) 14 Ves. 133.

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."

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.

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.

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.

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 *to the validity of the patent, [*354] and also whether he admits or denies the alleged infringement. (d)

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.

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 despatch, 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.

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 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 an *account of the [*355] 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

(b) 2 Dick. 647.

(c) 1 Keen. 190.

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

(e) In the 2nd section of this Chap. *ante*, p. 266.

(f) *Ante*, p. 330.

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.

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.

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)

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.

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.

[*356] When a cause comes on for hearing, the Court will deem 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.

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 returned 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)

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 *Baton 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

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

(h) See *Few v. Guppy*, 1 M. & Cr. 487. (i) 1 Beavan, 382.

plaintiff to move for an injunction, (k) although he might be entitled to an injunction upon the merits at the hearing."

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., ['357] 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."

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. 10: "These two bills were filed to obtain an injunction to restrain an alleged infringement on the plaintiff's patent, and for consequential accounts. When a cause of this kind is brought to a hearing, (an ['358] 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

(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) 1 Beavan, 382.

(m) 4 M. & Cr. 433.

(n) 4 M. & Cr. 433.

(o) *Id.*

(p) 1 Beavan, 382.

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 [*359] that, if he fails 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 [*360] plaintiff has neglected to avail himself of the opportunity 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 [*361] 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.

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.

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*)

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

(*q*) *Buley 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 utterancements 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

[*362] It is difficult to define the extent to which the Court can *go in compelling the defendant to account to the plaintiff for profits. It

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 1,000 cubic feet of gas, equivalent to profit, and thereby enabling the Company 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 1,000 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.

"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 2s. 6d. per 1,000 cubic feet less than to

is clear that the Court will give to the plaintiff all *the profits which the defendant has actually made by infringing the plaintiff's ['363]

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 10s. 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 10s. per 1,000 feet, that is 2s. 6d. 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 2s. 6d., 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 2s. 6d. 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 inquiring whether they are so or not—the calculation proceeds upon the supposition that 2s. 6d. 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 10s.; nay, much more, for it is admitted that 10 per cent. is lost under either system before the gas comes to the consumer's premises, so that 1,375 must be made for every 1,000 paid for; and if their proposal of charging 7s. 6d. only be used as evidence against them, it would show the value of the 1,000, or rather 1,100, cubic feet to be 7s. 6d. and not 10s. 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 the 1,250 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 those 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 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

[*364] patent privilege, but in the absence of *all authority on the subject,
 [*365] it is impossible to say whether the Court can also compel the
 defendant to pay the plaintiff *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

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 employed; 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 inquire,) 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. 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."

*Jac. 284. See also Lord Brougham's observations in *Docker v. Somes*, 2 My. & K. 665-8.

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.

*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 [*366] 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 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. 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)

When the validity of the patent actually comes in question at the hearing or 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.

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 invention.

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

(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.

[*367] *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 license 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.”

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)

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.

[*368] *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)

(c) Vide *post*, sec. 5, in this Chapter. (d) See the Act in the Appendix, Chap. I. s. 1.

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 *used in [*369] 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.

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.

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.

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 license or consent in writing of such patentee." The offence *may be committed not only by writing, painting, printing, &c., as [*370] 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 anything 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, [*371] 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 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 good defence to such an action on the ground of the patent 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 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 [*372] patentee's patent as a defence to the action, *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.

(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.

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

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.

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.

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.

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 that he has been deprived of [373] 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 plaintiff, and was to some extent an injury to the plaintiff.

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.

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

(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.

(i) 4 B. & Adol. 410.

(k) Ibid.

those of the plaintiff, the plaintiff was nevertheless entitled to recover damages against the defendant for the fraudulent imitation of the plaintiff's articles.

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.

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' [*374] '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)

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 recompense 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.

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 "if I could see the marks so placed, that no person [*375] 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*, (o) an injunction was obtained upon an *ex parte* application, restraining the defendant from running or using for the conveyance of passengers his omnibuses in the bill mentioned with the names "Lew-

(l) 3 B. & C. 241.

(m) See the cases of *Southern v. Howe*, 2 Rid. B. 20, *Simpson v. Bolton*, 3 Deaf 237.

(n) 5 Law. J. N. S. 101.

(o) 2 Keen, 212.

don 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 license, and that pursuant to the stat. 2 & 3 W. IV. c. 120, ss. 9 & 11, the license 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 license, 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 public to believe that the omnibus which he painted and appointed, [376] 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 omnibuses 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, or 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 from the order 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.

ALTHOUGH patents for inventions are not demandable as of right, yet they [*377] 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.

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.

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 appears that the Queen has been deceived in any material particular, by a false representation [*378] or suggestion of the *grantee, 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).

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

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

(v) See 10 Co. R. 113, b.

(x) 1 Co. R. 52, a.

(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.

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.

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.

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 *where by fraud or false suggestion he is deceived, that he himself in such cases shall avoid his own grant [*370] *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.

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 grantee.

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)

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

(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.

(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.

attend to such matters, and to transact all such business of the Court as may be done by a Judge at Chambers.

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

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.

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)

After the Act of Union with Scotland, (t) the Great Seal became the Great [*381] Seal of Great Britain, but that did not 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.

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

(n) 4 Inst. 79-88.

(p) 1 Str. 151.

(r) Lally, Ent. 419.

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

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

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

(y) P. 72.

(o) 4 Inst. 88.

(q) Vide 1 Str. 151-158.

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

(z) Misprinted, fol. 7.

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. *Briefs*, pl. 104,) to the same effect as here given, but with a "*quod querere*," added to it.

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)

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.

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 error was brought in the House of Lords [*382] 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.

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)

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.

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.

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 the point was [*383] 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.

(a) Title, Petit. pl. 11

(c) 3 Lev. 220-223.

(e) Lally, Entr. 411-415; and see the Form in the Appendix, Chap. II. s. 7.

(f) P. 131, pl. 74.

(b) P. 134—3rd Century, case 74.

(d) *Ante*, Chap. IV. p. 38.

(g) 6 Mod. 229.

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.

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 intitled "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, (*k*) that "the process in this Court is under the Great Seal, according to the course of the Common Law."

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.

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.

[384] 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 attorneys in all causes in the Petty Bag in which Six Clerks might have been such attorneys 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.

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.

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."

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.

(*i*) 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.

(*j*) 4 Inst. 80.

(*k*) Ibid. 82.

(*l*) 4 Inst. 88.

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 a void patent." (n) So, in the Court of Queen's Bench, in the case of *The Queen v. Aires*, (o) it was also said, [*385] 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.

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)

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)

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)

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.

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. (v)

(m) 2 Vent. 311.

(n) That no subject is to be troubled by an action upon the patent, and put to the trouble and vexation of having to plead and prove the invalidity of it.

(o) 10 Mod.

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

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

(r) 1 Str. 19.

(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.

(v) 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

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.

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.

The reason for requiring this security is, that patentees may not be vexatiously harassed by action 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 prosecutors shall pay him the amount of his costs taxed as between attorney and client.

[*387] *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 1,000*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.

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)

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.

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.

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,

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.

(y) Afterwards Lord Chief Baron.

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

and therefore is interested in *the continuation or destruction of it; [*388] 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.

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 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.

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.

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.

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

*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. [*389]

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. Arkwright*, (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)

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—

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

(b) Dav. P. C. 79.

(a) 3 Lev. R. 222.

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

“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.”

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.

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.

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 [390] city; yet the Court is in fact a moveable Court, that is, a Court which may be held 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.

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 *Parker*, 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)

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.

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 [391] 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.

(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.

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.

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*)

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.

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, even when [392] the defendant is known to reside or could be summoned elsewhere in England.

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.

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.

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.

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

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

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

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

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

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

be reckoned exclusive of the day of entering the rule, and exclusive of the last [*393] day, if it be a Sunday. If the rule is entered on the last 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.

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.

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.

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 [*394] time by delaying to enter his appearance. But by delaying to 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.

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.

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

(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.

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.

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.

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 becomes necessary upon filing the declaration, for the defendant answers upon the writ, and the rule to answer is the only rule which is necessary for compelling the defendant to plead. [*395]

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 the defendant to answer within the first four days of [*396] 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.

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.

(q) Charn. N. R. 125.

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

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

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

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

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 upon 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.

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)

[*397] But the Attorney General has power to control the *prosecutor's proceedings in the action, and he may at any time interfere and 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

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

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

(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.

cancelled or vacated, and the prosecutor may join in demurror, 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 *to the declaration. (g) But if a *scire facias* has sufficient matter it [*398] 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 *against [*399] 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.

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

(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.

(g) See *Tidd's Practice* (9th Edit.) c. xliii. p. 1,095.

(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.

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*.

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.

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.

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 [*400] his disadvantage to allow the prosecutor to obtain a judgment by default. *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.

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

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.

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)

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 *Dandy 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 Langdale, M. R., after consulting some of the Judges, made an order for setting aside the pleas for irregularity *with costs*.

[*401] The defendant is at liberty to plead any matter he pleases *in bar to the several suggestions contained in the writ, and it is the

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

(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.

usual and better course to plead to each suggestion separately, and the pleas are generally mere traverses of the various suggestions. (x)

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.

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.

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

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.

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.

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.

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.

When there are any issues to be tried, except those which [*402] *must be tried by a jury, the trial may take place in the Court of Chancery. (yy) 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 *ne 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

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

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

(yy) *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.

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*)

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 [*403] then to be taken into 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.

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.

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*)

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*)

[*404] The *venire facias* must be directed to the Sheriff of Middlesex, the record upon which the action is founded being in that county. (*s*)

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*)

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

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

(*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.

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

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