

of a patented composition, as the making of a patent pill, seems to have been considered as an infringement of the patent.(a) Mr. Curtis questions this so far as regards the use of things that perish in the using. But innocent persons will not be restrained from the use of the product of a patent machine, as the sale and use of bedsteads of a particular construction made by a patented machine, where the person selling or using them is not privy to the use of the patented machine.(b)

*SECTION II.—WHAT IMITATION OR RESEMBLANCE IS AN IN-
FRINGEMENT. [*133]

14. The questions of infringement may be stated in these terms: Is the defendant's machine a copy made after and agreeing with that described in the plaintiff's specification?(c) Is the change, if any, colourable and formal, or substantial and essential? Is the effect the same, and is it produced substantially in the same manner and by the same means? Are the parts essential to the production of the useful result obtained by the plaintiff's invention adopted or imitated by the defendant?

15. If a defendant uses that which is virtually and substantially the invention described in the specification, a slight departure from the specification, for the purpose of evasion only, would be a fraud on the patent. The question is, whether the mode of working by the defendant has or has not been substantially different.(d) It is not in the power of any person, simply by departing in form, or in immaterial circumstances, from the mode of carrying out the invention mentioned in the specification, to use it without the leave of the patentee. The question is, whether there is such a variation in substance as to make the defendant's mode of operation a distinct thing.

16. The essence of the invention must be looked to. Gamble's patent was for the use of iron retorts worked in connection with each other, and heated by separate furnaces for the two stages of the process of manufacturing sulphate of soda, so that both might be kept in action at the same time. The material of which the chambers was composed not being of the essence of the invention, the patent right was held to be invaded by the use of chambers of other materials than those mentioned in the specification.(e)

17. In determining the question of the identity of two *me-
chanical contrivances, the jury must consider whether the defen- [*134]
dant's machine is only colourably different,—that is, whether it differs

(a) Per Story, *J. Whittemore v. Cutter*, 1 Gallison Rep. 433; Curtis on Patents, 258, 259; Curtis, *Inventor's Manual*, 109, Boston, 1851.

(b) *Boyd v. Brown*, 3 McLean, Rep. 295; *Boyd v. McAlpin*, 3 McLean Rep. 427; *Keplinger v. De Yonug*, 10 Wheaton Rep. 358; Curtis on Patents, 250, 257.

(c) *Galloway v. Bleadon*, Tindal, C. J. N. P. Webst. P. C. 523.

(d) *Hill v. Thompson and Forman*, Webst. P. C. 239; 8 Taunt. 382, S. C.; *Walton v. Potter*, Webst. P. C. 587, Tindal, N. P.; *Walton v. Potter*, 3 M. & G. 411; per Gibbs, C. J. *Bovill v. Moore*, Dav. P. C. 405; S. C. 2 Marsh. 311; *Stead v. Anderson*, 4 C. B. 806.

(e) *Gamble v. Kurtz*, 3 C. B. 435; *Bramah v. Hardcastle*, 1 Carp. R. 168.

merely in the substitution of what are called mechanical equivalents for the contrivances which are resorted to by the patentee. If the differences which exist between one machine and the other are such as do not affect the principle of the invention, the two machines are alike in substance. One man has invented the principle and another has adopted it, and though he may have carried it into effect by substituting one mechanical equivalent for another, still the jury should look to the substance, and not the mere form; and if it is in substance an infringement, they ought to find it to be so. If its principle is not the same, but really different, then the defendants cannot be said to have infringed the patent.^(f) Mechanics may be called as witnesses to prove the identity in principle of two contrivances.^(g)

18. Mr. Justice Story says it is often a point of intrinsic difficulty to decide whether one machine operates upon the same principles as another. In the present improved state of mechanics, the same elements of motion and the same powers must be employed in all machines. The material question is not whether the same elements of motion or the same component parts are used, but whether the given effect is produced substantially by the same mode of operation and the same combination of powers in both machines.^(h) Coleridge, J. said, "If the defendant has taken the same principle as the plaintiff, and has used it so as to work in the same way on the same subject-matters, so as to produce the same result, the only difference being that he has varied the mechanical agent by which he has done it, then I think it is merely a colourable imitation, and amounts to an infringement. It was stated by the witnesses on both sides, that it is often a matter of perfect indifference what mechanical agent they use to effect the result. The plaintiff has as much right to be protected against an infringement by the use of mechanical equivalents, as he would if exactly the same [*135] *means had been made use of. If this were not so, there could be no means by which a patentee's title could be at all protected, unless he specified every possible mode by which the result could be arrived at."⁽ⁱ⁾

19. There may be an infringement by the use of so much of a combination as is material. If a portion of a new arrangement of machinery is in itself new and useful, and another person, for the sake of producing the same effect, uses that portion of the arrangement, and substitutes for the other matters combined with it a mechanical contrivance, that would be an infringement of the patent. In a patent for a mode of stopping looms when the shuttle stops in the shed, the principle of the invention was to transfer the momentum of the slay to a brake acting on the fly-wheel. This was effected by an arrangement by which, if the slay beat up when the shuttle was absent from both boxes, the stop-rod finger not being elevated by the weight of the shuttle in either box, came into con-

^(f) Morgan v. Seaward, Webst. P. C. 171, Alderson, B.; Morgan v. Seaward, Webst. P. C. 168, Sir L. Shadwell.

^(g) Webster v. Uther, Godson on Patents, 232.

^(h) Odiorne v. Winkley, 2 Gallison Rep. 51, 53, cited Curtis on Patents, 263.

⁽ⁱ⁾ Mangnall v. Benecke, N. P. 24 Newt. Lond. Journ. C. S. 294.

tact with one end of a lever acting on the brake, and an apparatus by which a clutch-box was thrown out of gear, and the driving-strap shifted from the driving-pulley to a loose pulley at the same instant. This was held to be infringed by a contrivance by which the stop-rod finger, under such circumstances, was brought into contact with a lever, different in construction but similar in its mode of operation, pressing a brake on the fly-wheel, and throwing the driving-strap off of the driving-shaft. (*k*)

20. In cases of this kind it is important to consider whether the useful effect of the patented invention and what is protected by the patent, consists in the combined effect of the whole. If the patent is for the entire combination, and that alone, the doing the same thing by a contrivance similar to part of the patented machine would seem not to be an infringement. (*l*)

21. When the principle of operation is public, a patent for a particular machine is not necessarily infringed by the adoption of instruments operating on the same principal, but varying in detail from those employed in the patent machine. In such case the similarity of effect produced does not *necessarily show that one instrument is merely an equivalent for the other. (*m*)

22. The fact that the defendant has made a great improvement on the patentee's invention, will not enable him to adopt the principle of the patentee's invention. (*n*) In *Cochrane v. Braithwait*, owing to imperfections in the original invention, it had never been brought into use, and many engineers gave evidence that they did not believe it would work; but Mr. Brunel and some others having proved that they had actually seen it work, the plaintiff was held entitled to recover against the defendant, who adopting the principle of the plaintiff's invention, had greatly improved the machinery by which it was applied, and had brought the improved invention into use. (*o*) In *Macnamara v. Hulse*, the plaintiff's invention for the form of paving-blocks had been patented for many years but had not got into use till applied to a new material not mentioned in the patent, or apparently thought of at the time by the patentee. (*p*)

23. The improvement may, however, be taken into consideration in determining whether his invention is distinct from that of the patentee. (*q*) If a man has, by dint of his own genius and discovery, after a patent has been obtained, been able to give to the public, without reference to the former patent, or by borrowing the idea from the former patent, a new and superior mode of attaining the same end, there can be no objection to his taking out a patent for that purpose. But he must not avail himself of that which had before been granted exclusively to another. The jury will say whether the second invention is virtually bottomed on

(*k*) *Sellers v. Dickinson*, 5 Exch. 312.

(*l*) See *Sellers v. Dickinson*, N. P. 35 Newt. Lond. Journ. 135.

(*m*) *The Electric Telegraph Company v. Brett and Little*, 26 Newt. Lond. Journ. C. S. 134.

(*n*) *Neilson v. Harford*, Webst. P. C. 310.

(*o*) *Lord Cochrane v. Braithwaite*, 1 Carp. R. 493. See *Walton v. Potter*, Webst. P. C. 591.

(*p*) *Macnamara v. Hulse*, Car. & Mar. 471.

(*q*) *Neilson v. Harford*, Webst. P. C. 310.

the first varying only in circumstances not material to the principle and substance of the invention. (*r*)

A patent for improvements in the process of finishing hosiery, by placing the goods in a press between metallic boxes heated by steam, was held [*137] not to be infringed by *passing them between rollers similarly heated; the Court, considering that the claim was for the particular machine described, and not for a process to apply to any sort of surface. So far as it was a machine, the principle was different, the pressure in the one case being continued, and in the other momentary. (*s*)

24. If the patent be for a principle, it will extend to every mode in which the principle can be carried into operation. (*t*) If a man invents and adapts a principle, it is a question for the jury whether any other mode of doing the same thing is or is not a piracy of that which he has invented. It is said that there never were two things to the eye more different than the plaintiff's invention and what the defendant had done in contravention of the patent right, in *Crossley v. Beverley*. The plaintiff's invention was different in form, different in construction; it agreed with the invention alleged to be an infringement in one thing only. By moving in the water, a certain point was made to open so as to shut up another; the gas passing through a wheel made it revolve, and the quantity which passed through was measured by the number of revolutions made by the wheel. Scientific men all said, that the moment a practical scientific man had that principle in his head, he could multiply without end the forms in which it could be made to operate. (*u*) In *Neilson's* case, the claim was for the use of heated air for blast-furnaces; it was held that the use of the hot blast was an infringement, by whatever apparatus it was applied. (*x*)

In a case of a patent for welding tubes without a mandrel, by circumferential pressure at a welding heat, the apparatus mentioned as used by the patentee consisted of dies or tongs with conical holes, through which the tube was drawn. Welding tubes by passing them through grooved rollers placed one above another, was held by Lord Lyndhurst, C. B. to [*138] be an infringement, on the evidence of Mr. Donkin and *Mr. Brunel, that the mode of operation of the two contrivances was the same in principle. (*y*)

25. If the principle is applied in the same way, the want of two or three circumstances in the defendant's application, which are contained in the plaintiff's specification, will not affect the question. (*z*)

26. If any one of several improvements mentioned in a patent is imitated, that is a use of the invention. A declaration in case, for the

(*r*) *Walton v. Potter*, Webst. P. C. 591, Tindal, C. J. See ante, p. 18.

(*s*) *Barber v. Grace*, 1 Exch. 339.

(*t*) Per Lord Cottenham, *Neilson v. Thompson*, Webst. P. C. 283; *Morgan v. Seaward*, Webst. P. C. 171; *Cochrane v. Braithwait and Ericsson*, 1 Carp. R. 493; ante, p. 81.

(*u*) *Jupe v. Pratt*, per Alderson, B. Webst. P. C. 146; *Crossley v. Beverley*. Webst. P. C. 106.

(*x*) *The Househill Company v. Neilson*, Webst. P. C. 688.

(*y*) *Russell v. Cowley*, Webst. P. C. 462; *Russell v. Ledsam*, 14 M. & W. 580.

(*z*) *Jones v. Pearce*, Webst. P. C. 124.

infringement of a patent for giving signals and sounding alarms in distant places by means of electric currents transmitted through metallic circuits, alleged that the defendant had used the invention. The jury having found that there had been an infringement in respect of one of the improvements, it was held to be a sufficient finding of the infringement alleged in the declaration.(a)

27. It is an infringement if the defendant has pirated a material part of that to which the patent applies. If he has used that part for the purposes to which the patentee applied his invention, and for which he has taken his patent, and the jury find that the substitute used by the defendant is substantially the same thing, it is an infringement. An invention consisted in lining the boxes for axletrees with metallic compositions and alloys, as pewter, of which tin is the basis, and retaining the lining in its place by means of rims and fillets. Friction was avoided by the use of the soft metal. The defendant having lined his boxes with tin, worked upon their interior surface by means of a soldering-iron, without any rims or projections, the judge left it to the jury to say whether the part which the defendant had infringed was a new part of the invention, and whether the two contrivances were substantially the same. The jury having found for the plaintiff, the Court thought the direction correct.(b.)

28. The question of infringement by chemical equivalents involves matter of consideration materially different from the *question of infringement by mechanical equivalents.(c) Mechanics is a de- [*139] ductive science, naturally growing from the observation of common phenomena. The separate action of two mechanical forces being known, the result of their combined action can be predicated. In chemistry it is very different. Two bodies, such as muriatic acid gas and ammoniacal gas, being brought together, no previous reasoning could tell us that from these two gases a solid would be produced; and nothing inherent in themselves could enable us to say that the acid character of the one and the alkaline character of the other would wholly disappear in the resultant. Chemistry, therefore, in its present state, is not so much a deductive as an experimental science.(d)

The knowledge of the results of a particular combination of two elements in chemistry does not in general involve a knowledge of the results of the combination of one with what is in fact, but has not been actually ascertained by experiment to be, for the purposes of the invention, a chemical equivalent for the other. Two substances may be nominally identical, and, for all ordinary purposes, the same thing, and yet slight differences in their quality may cause one to be incapable of producing the useful effect attained by the employment of the other. The cases of

(a) *The Electric Telegraph Company v. Brett and Little*, 20 L. J. C. P. n. s. 123; S. C. 10 C. B. 838; *Gillett v. Wilby*, 9 C. & P. 334; *Crosskill v. Tuxford*, *Cresswell*, J. N. P. 28 *Newt. Lond. Journ.* 141.

(b) *Newton v. Grand Junction Railway*, 5 Exch. 331. See *Hancock v. Somervell*, 39 *Newt. Lond. Journ.* 158.

(c) *Per Pollock*, C. B. 5 Exch. 326.

(d) *Dr. Lyon Playfair's Lecture on the Chemical Principles involved in the Results of the Great Exhibition.*

Muntz's patent for sheathing, Christ's patent for the production of white enamelled surfaces for copperplate printing, and Derosne's patent for filtering cane juice, are instances in which this fact has been brought to the notice of the Courts.(e)

29. A very slight difference in a process may be of the highest importance.(f)

30. If for a part of the patentee's invention any well-known chemical equivalent is substituted, there can be no doubt but that this would be an infringement.(g)

31. It is doubtful whether a patent for a chemical composition is infringed by the use of an equivalent for one of *the substances [*140] employed, which was not known to be such by ordinary chemists at the date of, or described as such in, the specification.(h) The subject was much discussed in a recent case in the Exchequer Chamber. Erle, J. thought that a patent for the use of a substance in a process was infringed by the use of a chemical equivalent for that substance, known to be such at the time of the use, if used for the purpose of taking the benefit of the patent, and of making a colourable variation from it.(i) Coleridge, J. and Alderson, B. in accordance with the view of the Court of Exchequer, considered that if the equivalent was not known to be such at the time of the patent, nor by the defendant at the time of his using it, its application constituted a new discovery, and was not within the patent.

Alderson, B. put the question of equivalents thus:—"The equivalent being known as a part of the general knowledge of the world, he who by his specification describes the ingredients which he uses, describes also all those known equivalents, and so does, in fact, communicate to the world, by his specification, the knowledge of the equivalent, and on this knowledge, thus impliedly communicated, he who afterwards uses the equivalent really acts. If the equivalent be not known before, he who discovers the equivalent, if it can be used more advantageously than the substance for which it is the equivalent, has, by the use of the equivalent, improved on, and not infringed the original invention." The same view of the case was taken by Coleridge, J. and it does not seem to be inconsistent with the decision of the Court of Exchequer Chamber in the case.(k)

32. The fact that the defendant did not intend to imitate the patent process seems not material to be considered.(l) The question is what the defendant has done, not what he intended.

33. If a patent is obtained for the use of a composite substance in

(e) Muntz v. Foster, 2 Law Times, 325; S. C. Carpmael on Patents, 25, Tindal. C. J., N. P.; Sturtz v. De la Rue, 5 Russ. 325; Derosne v. Fairie, Webst. P. C. 158.

(f) Edwards v. Da Costa, 36 Newt. Lond. Journ. C. S. 130; ante, 17.

(g) Heath v. Unwin, 13 M. & W. 593.

(h) See Heath v. Unwin, 13 M. & W. 583, per Coleridge, J. and Alderson, B.; Heath v. Unwin, 22 L. J. C. P. 7; 16 Jurist, 996, S. C.

(i) Heath v. Unwin, 22 L. J., C. P. 7; 16 Jurist, 996.

(k) Heath v. Unwin, 22 L. J., C. P. 7; S. C. 16 Jurist, 996.

(l) Heath v. Unwin, 16 L. J. N. S. Chy. 283; Stevens v. Keating, L. C. there cited; Stead v. Anderson, 4 C. B. 806, 833.

combination with other things, the use of the *elements of that substance under such circumstances that the composite substance [*141] will be formed in the course of the process, seems to be an infringement of the patent for the use of the composite substance. (m) It is merely a different mode of employing the same thing. So it seems that a patent for the use of the elements of a substance may be infringed by their use in a compounded state. A patent was obtained for the use of acid and alkali in the formation of artificial stone. It was urged that it was infringed by the use of borax, which is a salt; in other words, an acid and an alkali in combination. (n) When the case was before Lord Cottenham, on a motion to dissolve an injunction, he said that the defendant did in fact profess to make a cement of the same materials as the plaintiff used, though in a different combination, and that there could hardly be a question of the plaintiff's right to an injunction. (o) The point was not finally decided, as the patent was held bad at law.

34. The case of *Heath v. Unwin* is a very important one upon this subject. Heath took out a patent for certain improvements in the manufacture of iron and steel, and declared the nature of his invention to be the use of carburet of manganese in any process in which iron is converted into cast-steel. He described the process thus:—"I propose to make an improved quality of cast-steel, by introducing into a crucible bars of common blistered steel, broken as usual into fragments, or mixtures of cast and malleable iron, or malleable iron and carbonaceous matter, along with from one to three per cent. of their weight of carburet of manganese, and exposing the crucible to the proper heat for melting the materials, which are, when fluid, to be poured into an ingot-mould in the usual manner. I do not claim any mixture of cast and malleable iron, or malleable iron and carbonaceous matter, but only the use of carburet of manganese in any process for the conversion of iron into steel." Before his discovery it was practically impossible to produce cast-steel capable of being welded with iron, except Swedish, and some other iron of the best quality. Unsuccessful attempts had been made to alloy the steel with oxide of manganese. Mr. Heath discovered, *that when carburet [*142] of manganese (which is the product of oxide of manganese and coal tar, or carbonaceous matter, exposed to an intense heat in a pot lined with charcoal), was put into a pot with blistered steel, a steel was formed capable of being welded, and a very superior quality to any before produced. Mr. Heath manufactured carburet of manganese at great expense, for the purpose of employing it in producing such cast-steel. It was afterwards discovered that if the oxide of manganese and coal-tar, or carbonaceous matter, were put together with the bar steel into the pot, the same result would take place. The defendant availed himself of this, and at a much less cost produced the same quality of steel. On the trial before Mr. Baron Parke, in 1844, the jury found that the black oxide of manganese put with carbon into a crucible containing blistered steel would form carburate of manganese in a fused state before

(m) *Heath v. Unwin*, 22 L. J., C. P. 7; 16 Jurist, 996, S. C.

(n) *Stevens v. Keating*, 2 Exch. 776.

(o) *Stevens v. Keating*, 30 Newt. Lond. Journ. C. S. 62.

any combination with the steel; but that the quality of carburet so formed would be less than one per cent. of the weight of the steel in the crucible. They stated also, that the merit of the plaintiff's invention consisted in putting into the crucible a sufficient quantity of carbonaceous matter to neutralise the oxide, and form carburet of manganese without depending upon the carbon contained in the materials of the crucible, or existing in the blistered steel. They found, that carbon and black oxide of manganese had never before the date of the patent been used practically in making steel. Upon these facts, Baron Parke, in delivering the judgment of the Court, said, "In order to decide whether the defendant is guilty of an infringement, we must determine for what invention the patent, as explained by the specification, is taken out. It is not for the use of oxide of manganese in the melting of cast-steel, for the carburet is mentioned and distinguished from the oxide, nor could a patent for the use of the oxide be supported, as the substance had been used long before in the process of melting steel. Nor is it for the use of oxide of manganese in any mode of combination with carbon generally. If it had been, it would have been liable to a similar objection, as oxide of manganese had been used in crucibles containing in their construction a quantity of carbonaceous matter, with a portion of which it would necessarily combine during the process. The patent was obtained for the [*143] use of *one peculiar combination of carbon and manganese, the metallic substance called carburet of manganese, and for the use of it in that state. The defendant has not directly infringed the patent, nor indirectly; because that which was used was not a well-known equivalent. There is no reason to think that before the inquiry, the defendant, or any one else, knew that the carburet would be formed in a state of fusion."(*p*) On a second trial, Mr. Justice Cresswell, considering himself bound by the judgment of the Court of Exchequer, directed the jury, that there was no evidence of an infringement. On this trial it appears to have been in evidence, that the carburet of manganese formed an alloy with the steel. Taking that alloy to be the invention, the majority of the judges in the Court of Exchequer Chamber thought that any mode of forming it by bringing the two substances together was a direct infringement, and that the defendant's mode of working was merely a neater way of combining them.(*q*)

In accordance with the view of the Court of Exchequer Chamber, Knight Bruce, V. C., in the case of Muntz's patent for sheathing, made of a mixture of the purest zinc and copper, said, "That if, in the course of the defendant's process, the zinc and copper were purified so as to be of the same pure character as directed to be used by Muntz's specification, he should consider this a colourable evasion."(*r*)

35. In the case of a patent for the combination and use of materials, known and used before for the same purpose, in a particular combination

(*p*) Heath v. Unwin, 13 M. & W. 583.

(*q*) Heath v. Unwin, 22 L. J., C. P. 7; 16 Jurist, 996, S. C.

(*r*) Muntz v. Foster, 24 Newt. Lond. Journ. C. S. 299, V. C. B.

and proportion, if the specific proportions be materially departed from, it is no infringement.(s)

36. In order to show to the Court what is really the subject of the patent, the patentee must put in and prove his patent and specification, and if the patent purports to be for an improvement on a former patent, then the former specification must also be proved.(t)

37. The similarity of structure in two specimens of manufactured *goods may afford presumptive evidence of their having [*144] been made in the same way.(u) In other cases the large consumption by the defendant, of the materials employed in the patent process unaccounted for, except on the supposition that they were employed as in the patent process, coupled with the similarity of defendant's goods to those made by the patent process, has been relied on.(x) (See post, *Inspection*.)

*CHAPTER XVI.

[*145]

PROPERTY IN PATENTS.—ASSIGNMENTS.—LICENSES.

1. THE right to a patent is assignable and devisable; it is personalty, and goes to the executor. If obtained by an uncertificated bankrupt, the patent vests in his assignees. The schemes which a man may have in his own head before he obtains his certificate,(a) do not pass; nor can the assignees require him to assign them, provided he does not carry his schemes into effect till after he has obtained his certificate. But if he has availed himself of his knowledge and skill, and thereby acquired a beneficial interest which may be the subject of assignment, that interest will pass to the assignees.(b) It seems doubtful whether an invention provisionally protected would pass.

2. Patents granted before the passing of the recent statute, contain a condition for making void the patent if it becomes vested in more than twelve persons. Originally the condition taken from the Bubble Act, which before its repeal in 1826 used to be recited, limited the liberty of holding a patent to five persons. In May, 1832, Sir Thomas Denman, then Attorney-General, with the consent of the Board of Trade, sub-

(s) *Hill v. Thompson and Forman*, Webst. P. C. 239; 8 Taunt. 382. *Stevens v. Keating*, 2 Exch. 777.

(t) *Lewis v. Davis*, 3 C. & P. 502; Webst. P. C. 488.

(u) *Huddart v. Grimshaw*, Webst. P. C. 92.

(x) *Hall v. Jarvis*, Webst. P. C. 100.

(a) As to a secret, see in re *Feaver*, Court of Bankruptcy, Times, Feb. 20, 1843.

(b) *Hesse v. Stevenson*, 3 Bos. & Pull. 565. See *Bloxham v. Elsee*, 6 B. & C. 169.

stituted the provision, that no more than twelve persons should be interested.(c)

3. Stat. 15 & 16 Vict. cap. 83, s. 37, enacts, that notwithstanding any [*146] proviso in former letters patent, it shall be *lawful for a larger number than twelve persons hereafter to have a legal or beneficial interest in such letters patent.

With regard to assignments made before the passing of this Act, it may be noticed that assignments to trustees for the benefit of creditors, though more than twelve, do not avoid a patent.(d) And that it is wholly immaterial in how many persons licenses to use a patent, whether exclusive or not, may have become vested.(e)

4. By stat. 15 & 16 Vict. cap. 83, s. 35, the grantee or grantees of letters patent to be hereafter granted may assign the letters patent for England, Scotland, or Ireland respectively, as effectually as if the letters patent had been originally granted for England, or Scotland, or Ireland only; and the assignee or assignees shall have the same rights of action and remedies, and shall be subject to the like actions and suits, as he or they should and would have been subject to upon the assignment of letters patent granted to England, Ireland, or Scotland, before the passing of this Act.

5. The assignment may be by deed or will. A monopoly privilege cannot be assigned at all, unless a power to do so is given by the Crown. As licenses must be under the hand and seal of the patentee, so also must assignments.(f) Under a grant of letters patent reserving the legal interest to the patentee until the determination of a pending suit, on the happening of that event, the legal interest passes to the grantee.(g)

6. The assignor may covenant that the patentee is the true inventor; that the specification is sufficient; that the patent is valid; that he has a right to assign, for quiet enjoyment, for further assurance; that the patentee will do all things necessary to enable the assignee to obtain patents in foreign countries, either in his own name or in the name of the original inventor; and that he will aid in procuring confirmation or [*147] extension. A power of attorney to receive and *sue for royalties under existing licenses, in the name of the patentee, may, in some cases, be convenient. If the assignment is of a partial interest, it should contain covenants by the patentee to allow his name to be used in actions and suits for infringements, and to produce the patent in evidence.

7. The assignment must be perfected by an entry in the register of proprietors.

Letters patent have hitherto been the most unmarketable of all titles.

(c) Holroyd on Patents, 137.

(d) MacAlpine v. Magnall, 3 C. B. 496; Bloxam v. Elsee, 1 C. & P. 558, 6 B. & C. 169.

(e) Protheroe v. May, 5 M. & W. 675.

(f) See Sheppard's Touchstone, 231; Duvergier v. Fellows, 10 B. & C. 829. See Power v. Walker, 3 M. & S. 7; Davidson v. Bohn, 5 C. B. 460; Leader v. Purday, 7 C. B. 12.

(g) Cartwright v. Annatt, 2 Bos. & Pull. 43.

It has been said, "An objection to the title acquired by a patentee arises out of the nondescript nature of the grant, and the almost total impossibility of ascertaining whether it is encumbered, so that on the sale of a patent, the purchaser must take his chance of the sufficiency of the title, and rely almost entirely on the covenants of the vendor. As it is quite unsettled whether the letters patent pass any legal estate,^(h) and what is the effect of the bodily possession of the letters patent, it follows, that if a patentee mortgages or grants licenses without delivering up the letters patent, and there is no notice of the charge indorsed, and the patentee then sells, and the purchaser takes possession of the letters patent, it is uncertain whether he takes subject to the mortgage or license, or not.⁽ⁱ⁾"—14 Jurist, 462.

8. These difficulties will be remedied for the future by the enactment that until an entry shall have been made in the register of proprietors, the grantee or grantees shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such letters patent, and of all the licenses or privileges thereby given and granted.^(j) The certificate of the entry of an assignment or license is subject to a stamp-duty of five shillings, and the certificate of the assignment or license, five shillings.

From a perusal of the rest of the section, it would appear that, in enacting this clause, the Legislature had rather in view the facilitating proceedings by scire facias, than the rendering the titles to letters patent secure and marketable.^(k) *But is to be hoped that convenience, as well as the analogy of the construction put upon stat. 5 [*148] & 6 Wm. 4, cap. 83, s. 4, will induce the courts to construe the word grantee as meaning the person appearing on the register to be the grantee either of the Crown or the original patentee.^(l)

9. Erroneous or improper entries in the register of proprietors may be expunged by an order of the Master of the Rolls, or of any of the courts of common law in term time, or any judge thereof in vacation. It is enacted, that if any person shall deem himself aggrieved by any entry made in the registry of proprietors, it shall be lawful for such person to apply by motion to the Master of the Rolls, or to any of the courts of common law at Westminster in term time, or by summons to a judge of any of the said courts in vacation for an order that such entry may be expunged, vacated, or varied; and upon any such application the Master of the Rolls, or such court or judge, respectively, may make such order for expunging, vacating, or varying such entry, and as to the costs of such application to the said Master of the Rolls, as to such court or judge may seem fit; and the officer having the care and custody of such register, on the production to him of any such order for expunging,

(h) Another writer in the Jurist, vol. vii. pt. 2, p. 242, says, "Letters patent do not profess to vest in the grantee any estate; they merely grant him a power." See 7 Jarm. by Sweet, 536.

(i) See Jones v. Jones, 8 Sim. 633; Wilmot v. Pike, 5 Hare, 14.

(j) Stat. 15 & 16 Vict. cap. 83, s. 35.

(k) See Report on the Patent Law Amendment Bills, 1851, p. 376.

(l) See Russell v. Ledsam, 14 M. & W. 574; Ledsam v. Russell, 16 M. & W. 633.

vacating, or varying any such entry, shall expunge, vacate, or vary the same according to the requisitions of such order.^(m)

10. A mere licensee cannot maintain any action against any one else for the piracy of the invention.⁽ⁿ⁾ But perhaps the proprietor of any partial interest, or a person having an exclusive license from the patentee, might do so in respect of any injury to his separate interest.^(o) Or he might join with all the other persons interested in the patent in any action or suit relating to the matter affecting their common interests.^(p) But the better opinion would seem to be, that a licensee, or a person who has only a grant from the patentee, of the sole right in a particular locality, or to exercise some only of the inventions in respect of which a [*149] sole right is conferred by the *patent,^(q) has no such interest as will enable him to maintain a separate action in his own name.^(r) Until a recent alteration of the law enabling him, it was held in the United States that the grantee for a particular district was not an assignee of the patent and could not sue.^(s)

11. A license appears to be a personal privilege which cannot be granted over to another by the licensee. At any rate, it cannot be divided and assigned in part.^(t)

12. A license should be under the hand and seal of the patentee; but it will not be void though it is by parol only. To grant a license not under seal may be a contempt of the Crown, but the man to whom it is granted, and who has derived a benefit from it, must pay the price of it.

If a person to whom a license to use a patent is granted by an instrument not under seal, keeps it, and acts upon it, he will be taken to have waived all objection on the score of the want of a seal.^(u)

13. A license to use a patented invention, though under seal, need not be by deed. If it does not appear to have been delivered as a deed, it does not require a stamp, as a deed not otherwise charged within the meaning of 55 Geo. 3, cap. 189, sched. part 1, tit. Deed.^(x)

14. It will be convenient that licenses should contain provisos against alienation.

A stipulation may be introduced, that the inventor, on being indemnified, shall commence and prosecute actions or suits, or allow his name to be used by the licensee in proceedings against persons pirating the invention.

(m) Stat. 15 & 16 Vict. cap. 83, s. 38.

(n) *Derosne v. Fairie*, per Lord Abinger. N. P. Webst. P. C. 154.

(o) See *George v. Wackerback*, Godson on Patents, 226.

(p) *Coryton v. Lithebye*, 2 Saund. 115, 116; *Weller v. Baker*, 2 Wils. 423.

(q) See American cases, *Blanchard v. Eldridge*, J. W. Wallace Rep. 337, cited in Putnam's Digest for 1850, tit. Patent, 3; *Gayler v. Wilder*, 10 Howard's Supreme Court Reports, 477, 494.

(r) See Co. Litt. 164, 165; Lord Mountjoy's case, Godbolt, 17; *Boosey v. Davidson*, 13 Q. B. 259; *Protheroe v. May*, 5 M. & W. 675.

(s) *Tyler v. Tuel*, 6 Cranch, R. 324, cited Curtis on Patents, 310.

(t) *Brooks v. Byam*, 2 Story Rep. 544; Com. Dig. Grant, 9. See *Protheroe v. May*, 5 M. & W. 675, 684; *Pidding v. Franks*, 1 Macnaght. & Gord. 593.

(u) *Chanter v. Dewhurst*, 12 M. & W. 823. See in this case the form of a count *in assumpsit*, for money due for the grant of a license.

(x) *Chanter v. Johnson*, 14 M. & W. 408.

The right to damages to be awarded in such actions, may be reserved to the patentee.

15. By granting or accepting an interest or license as *against such person, a man may be estopped from disputing the validity [*150] of a patent. In an action by the assignee of a patentee against the patentee, for infringing the patent-right assigned by him, the patentee will not be permitted to set up that his invention was not a new one.(y)

If, acting under a license, a man has actually used the invention by the permission of the patentee, he cannot afterwards set up that the patent is void in answer to an action for rent during the time he had the enjoyment; nor can he recover back the rent he had paid for the use of the invention,(z) unless he can also show that he was induced to take the license by the fraud of the patentee.(a)

In covenant on an indenture for the non-payment of rent due for license, the licensee will be estopped by a recital in the indenture from alleging that the patentee was not the first inventor, if he has had enjoyment under the license.(b)

By the acceptance of rent accruing due subsequent to a breach of covenant, involving a forfeiture of a license, the patentee will be estopped from insisting on the breach of covenant as a forfeiture.(c)

16. In *Hayne v. Maltby*, by articles of agreement under seal, reciting that the plaintiffs were assignees of one Taylor, of a patent for a machine for making net, they gave license to the defendant freely to use a machine in a particular manner, and the defendant covenanted not to use any other machine.

It was held that the defendant was at liberty, in answer to an action for using other machinery, to allege that the patentee was not the first inventor, and that no specification was enrolled.(d) The case has been often doubted,(e) but is, perhaps, sustainable on the ground that the covenant, being in restraint of trade, required a consideration to support it.(f)

*17. Although a party has dealt with the patentee for a license at a rent, yet he may stop; and if he can show that the grantee has [*151] no title to the patent; he may do so in answer to an action for subsequent rent. He is not estopped by the acceptance of the grant of the license, except during the continuance of actual enjoyment under it.(g) When a court of equity directs an action against a person having an equitable

(y) *Oldham v. Langmead*, Lord Kenyon, 3 T. R. 441.

(z) *Taylor v. Hare*, 1 N. R. 260; *May v. Trye*, Freem. 447.

(a) *Lovell v. Hicks*, 2 Younge & Collyer, 46; ib. 484.

(b) *Bowman v. Taylor*, 2 A. & E. 278. See *Cutler v. Bower*, 11 Q. B. 973.

(c) *Warwick v. Hooper*, 3 MacNaght. & Gord. 60.

(d) *Hayne v. Maltby*, 3 T. R. 438. See *Baird v. Neilson*, 8 Clark & Finnelly, 726.

(e) See 8 C. B. 712. Per Maule, J. 2 A. & E. 292.

(f) See *Mitchell v. Reynolds*, 1 P. Wms. 181, cited 3 T. R. 440.

(g) *Neilson v. Fothergill and Thompson*, Webst. P. C. 289, 290, Lord Cottenham; *Stocking v. Llewellyn*, 3 Law Times, 33; *Hayne v. Maltby*, 3 T. R. 441. See *Stroughill v. Buck*, 19 L. J. N. S. Q. B. 209.

assignment of a license, it will not restrain him from trying the validity of the patent. (*h*)

As to a contract not under seal for license to manufacture and sell several patented inventions, where one of the inventions was not new, see the case of *Chanter v. Leese*. (*i*)

18. It has been determined in the United States, that a grant of a patentee of an exclusive right to use a machine, and vend the same to others for use within a specified district, authorizes the grantee to vend the products of the machinery elsewhere out of the district. (*k*)

19. A curious discussion has taken place in the American courts, as to the right of a person entitled to use a particular patented machine, to repair it, not making it a new machine. (*l*)

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*CHAPTER XVII.

EVIDENCE.—SEARCHES, AND INSPECTIONS.—REGISTERS.

1. EVERY patentee is bound to know the existing records, but hitherto he has had no means of access to them. He could not go through all the offices except at a very great expense; and if he did, he could not be secure that he had not missed something. Patentees did not attempt it. Practically speaking, old specifications were of no use. Mr. Webster said, "they ought to be burned, rather than left as they were."

2. By stat. 15 & 16 Vict. cap. 83, s. 28, every provisional specification and complete specification, left or filed at the office of the Commissioners on the application for any letters patent, shall forthwith, after the grant of the letters patent, or, if no letters patent be granted, then immediately on the expiration of six months from the time of such application, be transferred to and kept in the office appointed for filing specifications in Chancery.

3. True copies of all specifications, disclaimers, and memoranda of alterations filed under or in pursuance of the Patent Law Amendment Act, 1852, are to be open to the inspection of the public at the office of the Commissioners, and at an office in Edinburgh and Dublin respectively, at all reasonable times, subject to such regulations as the Commissioners may direct.

Provisional specifications are to be open for inspection after the provisional protection has expired. (*a*)

4. Specifications, disclaimers, and memoranda of alterations deposited [*153] or filed under the Act (not being provisional specifications), *are to be printed and published as soon as conveniently may be after the filing thereof. Provisional specifications are to be printed and pub-

(*h*) *Pidding v. Franks*, 13 Jur. 593, Chy.; 1 MacNaght. & Gord. 56.

(*i*) *Chanter v. Leese*, 4 M. & W. 295. In Cam. Scacc. 5 M. & W. 698.

(*k*) See *Simpson v. Wilson*, 4 Howard Rep. 709, cited Curtis, 257.

(*l*) *Simpson v. Wilson*, 9 Howard Rep. 109. (*a*) 15 & 16 Vict. cap. 83, s. 29.

lished as soon as conveniently may be after the expiration of the provisional protection.(b) They are to be sold at such prices as the Commissioners shall think fit.

The Commissioners may present copies of all such publications to such public libraries and museums as they may think fit, and allow the person depositing or filing any such specification, disclaimer, or memorandum of alteration, to have such number, not exceeding twenty-five, of the copies thereof so printed and published, without any payment for the same, as they may think fit.(c)

5. With regard to the specifications of existing patents, the Lord Chancellor and the Master of the Rolls may direct the enrolment of specifications, disclaimers, and memoranda of alterations heretofore or hereafter enrolled or deposited at the Rolls Chapel Office, or at the Petty Bag Office, or at the Enrolment Office of the Court of Chancery, or in the custody of the Master of the Rolls as keeper of the Public Records, to be transferred to and kept in the office appointed for filing specifications in Chancery under this Act.(d)

6. The Commissioners shall cause indexes to all specifications, disclaimers, and memoranda of alterations heretofore or to be hereafter enrolled or deposited as last afore-said, to be prepared in such form as they may think fit; and such indexes shall be open to the inspection of the public at such place or places as the Commissioners shall appoint, and subject to the regulations to be made by the Commissioners; and the Commissioners may cause all or any of such indexes, specifications, disclaimers, and memoranda of alterations, to be printed, published, and sold in such manner and at such prices as the Commissioners may think fit.(e)

Stat. 16 Vict. cap. , s. , empowered the Commissioners to purchase certain indexes prepared by Mr. Bennett Woodcroft.

*7. The fee for searches and inspections of specifications filed under the new Act, is one shilling.(f) For searches in the En- [*154]rolment, Petty Bag, and Rolls Chapel Offices, the fee is one shilling. At the Enrolment and Rolls Chapel Offices, the fee for a search includes an inspection. At the Petty Bag Office, the fee for an inspection is two shillings and sixpence, besides the fee for the search.(g)

At the Rolls Chapel Office persons may, in pencil, take extracts from or copies of any part of the enrolment of a specification.

The charge for office or other copies of documents in the Great Seal Patent Office, is twopence for every ninety words, which is collected by stamps. An additional charge will be made for copies of drawings.(h)

As to the cost of office copies in the other offices, see the table of fees in the Appendix.

(b) 15 & 16 Vict. cap. 83, s. 30.

(c) 15 & 16 Vict. cap. 83, s. 30.

(e) 15 & 16 Vict. cap. 83, s. 32.

(g) Rules of the Petty Bag Office, 1848.

(h) Order of Lord St. Leonards, 1852.

(d) 15 & 16 Vict. cap. 83, s. 31.

(f) Stat. 15 & 16 Vict. cap. 83, schedule.

8. Hitherto it has been the practice to enter from the docket the titles and particulars of all letters patent, in a book at the Great Seal Office. From this book, which is accessible to the public, the extracts were made, which were published in various books. This book, and the enrolment of the patent and specification, were the only authentic evidences of the patent and specification accessible to the public.⁽ⁱ⁾

9. There shall be kept at the office appointed for filing specifications in Chancery a book or books, to be called "The Register of Patents," wherein shall be entered and recorded in chronological order all letters patent granted under this Act, the deposit or filing of specifications, disclaimers, and memoranda of alterations filed in respect of such letters patent, all amendments in such letters patent and specifications, all confirmations and extensions of such letters patent, the expiry, vacating, or cancelling such letters patent, with the dates thereof respectively, and all other matters and things affecting the validity of such letters patent as the Commissioners may direct; and such register, or a copy thereof, [*155] shall be open at all convenient times to the inspection *of the public, subject to such regulations as the Commissioners may make.^(k)

10. As an official register, this book will be evidence of the filing of specifications, disclaimers, and memorandums of alterations filed under the Patent Law Amendment Act, 1852, and of the date of such filing or deposit. And as it is of a public nature, its contents may be proved by copy or extract, provided it be proved to be an examined copy or extract, or provided it purport to be signed and certified as a true copy or extract by the officer to whose custody the original is intrusted.^(l)

11. The patent may be proved by production of the instrument itself: the Great Seal proves itself. A patent passed before October 1, 1852, may be proved by an exemplification of the enrolment of it in Chancery under the Great Seal.^(m)

But as there will be no record in Chancery of patents passed after October 1, 1852, in the event of loss, the patentee must prove his patent by a new patent obtained under the provisions of the 22d section of the new Act.

12. With regard to specifications of patents passed after the 1st of October, 1852, by stat. 15 & 16 Vict. cap. 83, s. 33, copies printed by the Queen's printer of specifications, disclaimers, and memoranda of alterations, shall be admissible in evidence, and deemed and taken to be *primâ facie* evidence of the existence and contents of the documents to which they purport to relate, in all courts, and in all proceedings relating to letters patent.

13. The proof of the due enrolment of specifications in the Petty Bag Office, is provided for by stat. 12 & 13 Vict. cap. 109, s. 12, which enacts, that the clerk of the Petty Bag Office shall indorse upon any specification which at any time heretofore has been enrolled in the Petty

(i) See Webst. P. C. 659, Lord Cottenham.

(k) 15 & 16 Vict. cap. 83, s. 34.

(l) Stat. 14 & 15 Vict. cap. 99, s. 14.

(m) See stat. 13 Eliz. cap. 6. See Page's case, 5 Rep. 53, b.

Bag Office, provided the enrolment shall be then in his custody, a certificate, stating that such specification was enrolled and the day of its enrolment; and such certificate, sealed with the Chancery common-law seal, is to be evidence of its enrolment on that day.

*Section 13 makes office copies, sealed with the Chancery common-law seal, evidence of the contents of such records, and [*156] that they are records of the Court of Chancery.

14. The due enrolment of specifications, disclaimers, and memoranda of alterations enrolled in the Enrolment Office in Chancery, may be proved by the certificate of the clerk of the Enrolment Office, indorsed on the specification, stating that the specification has been enrolled in the office, and the day of the enrolment; such certificate being stamped with the seal of the Chancery Enrolment Office.⁽ⁿ⁾

All documents or writings stamped with the seal of the Chancery Enrolment Office, including drawings thereunto annexed, are to be deemed true copies of such enrolments, and of such drawings; and shall be received in evidence as proving the contents of such enrolments, and that they are records of the court, and of the date of filing or entering them.^(o)

15. Copies of enrolments in the Rolls Chapel Office, certified by the deputy keeper of records, or one of the assistant record-keepers, and purporting to be sealed or stamped with the seal of the Record Office, are by stat. 1 & 2 Vict. cap. 96, ss. 12, 13, made evidence without further or other proof.

16. Should the enrolments be removed from these offices to the office for filing specifications in Chancery, the time and fact of the enrolment may be proved by an examined copy of the enrolment of the specification, and of the certificate of enrolment, written at the foot of it, signed by the officer in whose custody it is.^(p)

Until the making of the several statutory provisions for facilitating the proof of specifications, the only mode of proving them was by producing the original specifications from the offices.

17. The entry of a disclaimer with the clerk of the patent seems to be only proveable by the production of the original copy entered.

18. There shall be kept at the office appointed for filing specifications in Chancery under this Act, a book or books, entitled, "The Register of Proprietors," wherein shall be entered, in such manner as the Commissioners shall direct, *the assignment of any letters [*157] patent, or of any share or interest therein; any license under letters patent, and the district to which such license relates, with the name or names of any person having any share or interest in such letters patent or license; the date of his or their acquiring such letters patent, share, and interest; and any other matter or thing relating to or affecting the proprietorship in such letters patent or license. "And such register, or a copy, shall be open to the inspection of the public at the office of the Commissioners of Patent, subject to such regulations as the Commissioners shall make."^(q)

(n) Stat. 12 & 13 Vict. cap. 109, s. 18.

(o) Stat. 12 & 13 Vict. cap. 109, s. 19.

(p) See 14 & 15 Vict. cap. 99, s. 14.

(q) 15 & 16 Vict. cap. 83, s. 35.

On the entry of an assignment or license, a stamp-duty of ten shillings is payable; for every search and inspection, one shilling. Certified duplicates of all entries made in the register of proprietors, are to be forthwith transmitted to the office of the Commissioners in Edinburgh and Dublin, where the same shall also be open to the inspection of the public.^(r)

19. A copy of any entry in the "Register of Proprietors," certified under such seal as may have been appointed, or may be directed by the Lord Chancellor to be used in the office for filing specifications in Chancery, shall be given to any person requiring the same, on payment of the fees in the Act provided. And such copies so certified, shall be received in evidence in all courts and in all proceedings, and shall be *primâ facie* proofs of the assignment of such letters patent, or share or interest therein, or of the license or proprietorship as therein expressed.^(s)

Every certificate of assignment or license is subject to a stamp-duty of five shillings.^(t)

20. Until an entry is made in this book, the grantee or grantees of the letters patent shall be deemed to be the sole and exclusive proprietors of such letters patent, and of all licenses and privileges thereby given and granted.^(u) It would therefore appear, that the production of a deed of conveyance or of a license, would not be sufficient evidence of the title of the person named therein.

[*158] 21. *The falsification of entries in the "Register of Proprietors," is a misdemeanor. If any person shall wilfully make, or cause to be made, any false entry in the "Register of Proprietors," or shall wilfully make or forge, or cause to be made or forged, any writing falsely purporting to be a copy of any entry in the said book, or shall produce or tender, or cause to be produced or tendered in evidence, any such writing, knowing the same to be false or forged, he shall be guilty of a misdemeanor, and shall be punished by fine and imprisonment accordingly.^(x)

We have seen that erroneous entries in this book may be expunged by an order of the Master of the Rolls, or a Court, or judge of a superior court of common law.^(y)

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*CHAPTER XVIII.

REMEDIES OF PATENTEE.—ACTION AGAINST INFRINGER.

SECTION I.—NATURE OF REMEDY.

1. THE remedies available to the patentee are by action to recover

^(r) 16 Vict. cap. , schedule; 15 & 16 Vict. cap. 83, s. 35.

^(s) 15 & 16 Vict. cap. 83, s. 35. ^(t) Stat. 16 Vict. cap. , schedule.

^(u) 15 & 16 Vict. cap. 83, s. 35, ante p. 147.

^(x) Stat. 15 & 16 Vict. cap. 83, s. 37.

^(y) Stat. 15 & 16 Vict. cap. 83, s. 38, ante, p. 148.

damages for any injury he may have sustained by the invasion of his privilege, by injunction to restrain infringements for the future, and by suit or order for an account of the profits which have been made by the offending parties by the wrongful use of the invention.

2. Until the passing of 15 & 16 Vict. cap. 83, s. 42, courts of law had no power to issue injunctions, or order an account of profits. Before 14 & 15 Vict. cap. 99, they could not compel the disclosure of evidence exclusively within the knowledge of the defendant. Now, in any action in any of her Majesty's superior courts of record at Westminster and in Dublin for the infringement of letters patent, it shall be lawful for the Court in which such action is pending, or for any judge of such court, on the application of the plaintiff or defendant respectively, to make such order for an injunction, inspection, and account, and to give such direction respecting such action, inspection, and account, and the proceedings therein respectively, as to such Court or judge may seem fit.

3. For the future, it is probable that the greater part of patent litigation will commence and be determined in the superior courts of common law. The above-cited enactment, in conjunction with the provisions of stat. 14 & 15 Vict. cap. 99, will, in almost all cases, supersede the necessity of proceeding in Chancery.(a)

*4. The right conferred by letters patent appears to be a franchise within the meaning of that word in stat. 9 & 10 Vict. [*160] cap. 95, s. 58, and therefore, if a plaint for the infringement of a patent is entered in the County Court, the jurisdiction of the court would be ousted by any defence putting the title of the patentee, or the validity of the patent, in question.

5. Hitherto, patentees relying chiefly on their remedies in the Court of Chancery, have seldom obtained or asked for more than nominal damages in actions for the infringement of a patent. There is often considerable difficulty in laying down rules as to the principle on which the damages should be assessed. In *Neilson v. The Househill Company*, tried before Lord Justice-Clerk Hope, it was proved that the saving by the use of the plaintiff's patent apparatus was £2. 2s. per ton of iron manufacture. The answer was, that profit was not made. The judge said, "That is no answer in point of law. It is for the jury to say whether that saving amounted to £3,400, the sum calculated. I am bound to tell you that in point of law the pursuer is entitled to claim the benefit of the saving made by the use of his apparatus. But it is said, it does not follow that he is entitled to obtain in law the whole of that saving. It is impossible to take it as a legal estimate, from which you are not to depart in deliberating on the claim. If you find for the pursuer, you are entitled to weigh the whole matter in your minds.(b)

"Then there is another branch of damage,—compensation for the invasion of the patent. Now, the invasion of a patent is just as much an invasion of a man's rights as if you were to make an inroad into his

(a) As to a bill of discovery in aid of a defence, see *Few v. Guppy*, 1 M. & Cr. 487.

(b) *Neilson v. The Househill Company*, Webst. P. C. 697, n. See *Crossley v. Derby Gas Company*, 3 M. & Cr. 428.

house, or if you were to trespass on his property. It is an injury done to him, and therefore he is entitled to compensation." (b) In *Neilson v. Baird*, it was said that damages ought to be given against the infringer for the injury to the sale of licences. (c)

6. A person whose patent right is infringed and denied, and attempted to be destroyed, is not to receive as damages merely the price for which [*161] he would peaceably and willingly have sold the use of it to any person coming to ask him for a *license. The defendant can found nothing on the terms on which the plaintiff is in the habit of granting licenses. They are the terms of a contract which he has expressly repudiated. (d)

7. When improvements accessory to the patented invention have been made while the patent was being invaded, if by the improvements the invention protected by the patent has been used to greater advantage, the profit made by means of the improvements is part of the profit made by the unlawful use of the patented invention. *Neilson's hot blast* was applied with greater advantage by means of *Condie's pipes* and improved water-twires. No deduction from the amount of profits was allowed, on the ground that part of the profits was derived from the use of these improvements. (e)

8. In *Newton v. Grand Junction Railway Company*, it appeared, that, about six months after the patent was taken out in 1843, the defendants began to line some of the brasses of their axles with tin. They had gone on by degrees increasing their employment of the invention till the commencement of the action in 1845. *Cresswell, J.* said, that as the defendants had the account, and had not shown to what extent they had used the patent, the jury must make the best guess they could as to what compensation the defendants ought to make to the plaintiff for violating his patent right. The damages were assessed at £1,000. (f)

In *Russell v. Cowley*, the plaintiff, in a bill in Chancery, charged the defendant with selling pipes at prices greatly under their real value, and prayed that the defendants might account for the profits which might or ought to have been made. The case was compromised. (g)

9. Now that a court of common law has the power of ordering an account, it would seem a proper and convenient course to obtain an order [*162] for an account, and to take a verdict for a large nominal sum, to be reduced to such sum as a *master of the court, or an arbitrator, should find due on the account of profits, added to such damages, if any, as the plaintiff has sustained by the infringement. It would seem to be a proper mode of taking the account, to ascertain the profits which might have been made by the patentee on the articles made, used, or sold by the infringer, had they been made, used, or sold by the patentee; or

(b) *Ibid.*

(c) *Neilson v. Baird*, Decisions of the Court of Session, 2d ser. vol. vi. 51.

(d) *Neilson v. Baird*, Decisions of the Court of Session, 2d ser. vol. vi. 51.

(e) *Neilson v. Baird*, Decisions of the Court of Session, 2nd series, vol. vi. 51, see per Lord Jeffrey.

(f) *Newton v. Grand Junction Railway*, N. P. 27 Newt. Lond. Journ. C. S. 220.

(g) *Russell v. Cowley*, Webst. P. C. 471, n. See *Bacon v. Spottiswoode*, 1 Beav. 387.

the profits or saving made by the infringer by his use of the patent right may be claimed.

10. According to the old practice, in the action of account, if the defendant refused to account, or gave an imperfect account, the judgment was that the plaintiff should recover according to the value mentioned in the declaration.^(h)

11. It has been said, that the fact that the plaintiff had acquiesced in infringements, by neglecting to take proceedings, may be considered by the jury as a ground of mitigating the damages. In *Arkwright v. Nightingale*, Lord Loughborough said, if the question had been what damages Mr. Arkwright should have received for invading his right, he should have allowed the parties to go into evidence to show to what extent persons had acted on a former verdict against the patentee, he having acquiesced in the result of that decision for three years.⁽ⁱ⁾

SECTION II.—PARTIES, PLEADINGS, ETC.

12. The action should be brought in the names of the persons for the time being legally interested in the patent, who may join as co-plaintiffs.^(k) If the action is brought in the name of an assignee, it is proper to state the assignment and its nature in the declaration.^(l)

13. In actions in the case for the infringement of patents, the parties will not be allowed to annex copies of drawings to pleadings setting out the specification. A plea setting out the specification and drawings, and concluding with a *statement that the plaintiff did not [*163] particularly describe the nature of the invention, will be set aside.^(m)

Drawings were, however, annexed to the pleas in *Minter v. Mower*, 6 A. & E. 737; and in *Bickford v. Skewes*, Webst. P. C. 214. The case of a scire facias is said to be peculiar; it contains the whole history of the proceedings.

14. Stat. 15 & 16 Vict. cap. 76, schedule B, No. 31, gives a form of declaration at the suit of a patentee. Forms of declaration and breaches may be seen 2 Chitty on Pleading, 7th ed. 576; *Jones v. Pearce*, Webst. P. C. 122; *Allen v. Rawson*, 1 C. B. 552; *Stocker v. Warner*, 1 C. B. 148; *Minter v. Mower*, 6 A. & E. 735. By assignee, *Bentley v. Keighley*, 6 M. & G. 1040. As to breaches by selling, &c., see *Minter v. Williams*, 4 A. & E. 251; Webst. P. C. 135. Forms stating disclaimer, *Stocker v. Warner*, 1 C. B. 148; 2 Chitty on Pleading, 7th ed. 578; *Perry v. Skinner*, 2 M. & W. 471; S. C. Webst. P. C. 350. As to the evidence of a disclaimer, ante, 99, 100, 155, 156. In an action for infringing the undisclaimed part of the invention, the defendant will not

^(h) *Williams v. White*, Cro. Eliz. 806, Winch. 5, S. C. See Com. Dig. Accompt, E. 15.

⁽ⁱ⁾ *Arkwright v. Nightingale*, Webst. P. C. 61; Dav. P. C. 37.

^(k) See *Birch v. Wood and Another*, 2 Law Times, 2 Cresswell, J.; as to the right of assignees of partial interests and licensees to sue, see ante, p. 148.

^(l) See Stephen on Pleading, 340; 1 Wms. Saund. 276, E, note 2; *Cornish v. Keene*, Webst. P. C. 512.

^(m) *Betts v. Walker*, 14 Jurist, 647, Q. B. See also *Sealy v. Browne*, 14 L. J. Q. B. N. S. 169.

be allowed to plead together, as several pleas, that the whole invention was not new, and also that the undisclaimed part was not new.⁽ⁿ⁾

See a form stating a prolongation of the term under the provisions of 5 & 6 Wm. 4, cap. 83, s. 4, and compliance with the conditions on which it was granted.—*Russell v. Ledsam*, 14 M. & W. 574.

The venue may be laid in any county. It could not have been changed on the common affidavit.^(o)

15. The plaintiff must deliver with his declaration, particulars of the infringements complained of in the action.

By stat. 15 & 16 Vict. cap. 83, s. 41, it is enacted, that in any action in any of her Majesty's superior courts of record at Westminster or in Dublin, the plaintiff shall deliver with his declaration particulars of the breaches complained of in the said action, and no evidence shall be given of any alleged infringement not contained in the particulars.

[*164] *16. Courts of common law have an inherent jurisdiction to order particulars in writing of the infringements in respect of which the action is brought;^(p) and it has been the practice to make such orders. By the statute, any judge may allow the plaintiff to amend his particulars on such terms as he may think fit, or he may make an order for better particulars.

In *Perry v. Mitchell*, the plaintiff had obtained letters patent for the manufacture of improved pens. His specification described thirteen different kinds of improvements, referring to them by numbers. The defendant prayed that he might be informed what particular numbers he was charged with having infringed. The Court granted an order for such particulars.^(q)

Where particulars can be given without any great difficulty or embarrassment to the plaintiffs, the Court will compel the plaintiff to furnish them.

But when separate actions were brought for alleged infringements of three several patents, and the plaintiffs complained of an infringement by means of an apparatus combining the principles of the three patents, and the matter of the infringement had been fully discussed by affidavits, on a motion for an injunction in the Court of Chancery, the Court considered that the circumstances were not such as to warrant their making the order. The Court in refusing the application said, it might be impossible for the plaintiffs to point out which of the several heads of invention they charged the defendant with having imitated. What was required must necessarily very greatly embarrass the plaintiffs, and they were not satisfied that there was any probability of surprise on the defendant from the want of it; or that he did not possess an adequate amount of information on the subject.^(r)

17. The burden of proof of the existence of the conditions of the

⁽ⁿ⁾ *Clark v. Kenrick*, 12 M. & W. 219; S. C. 2 D. & L. 392.

^(o) *Brunton v. White*, 7 D. & R. 103. See *Cameron v. Gray*, 6 T. R. 363. See Rules, II. T. 1853, 18.

^(p) *The Electric Telegraph Company v. Nott*, 4 C. B. 462.

^(q) *Perry v. Mitchell*, Webst. P. C. 269, cited 4 C. B. 467, 469.

^(r) *The Electric Telegraph v. Nott*, 4 C. B. 462.

validity of the patent, lies upon the patentee. In the absence of all evidence, the presumption in an action on the patent is against the patent, because an exclusive privilege is against common right. In the American courts, the patent is considered *prima facie* evidence of the novelty of the invention; but in America the patent is not granted without inquiry. *In one case, the Court of Session in Scotland adopted the same doctrine,^(s) but it is contrary to the uniform course of English [*165] decisions. The patentee has therefore a right to begin and prove his case. The courts will not allow a defendant to put his pleas, denying the existence of these conditions, into an affirmative form, for the purpose of depriving the plaintiff of this advantage.^(t)

18. The plea of not guilty puts in issue the fact of the infringement, only. The plaintiff may be entitled to a verdict upon this issue, notwithstanding the invalidity of his patent.^(u) Unless the patent and specification are set out on the record, and admitted by the pleadings, the plaintiff must prove them though there is no plea denying them, in order to show what is the nature of the right infringed. A plea that the defendant has used an invention protected by a former patent setting out the saving in the plaintiff's patent, amounts to not guilty, and will not be allowed.^(v)

It has been suggested by Tindal, C. J., and Dallas, C. J., that if a person had previously done that for which a patent is subsequently taken out, he could not be prevented by the subsequent patent from doing that which he had done before, though his operations were known to no one but himself.^(y) A plea in confession and avoidance, would appear to be the proper mode of raising the point, if there is anything in it. The authority of *Dolland's case*, though not acted upon in the United States,^(z) has been too often recognised here to be questioned at the present day.

19. See forms of the plea of non concessit, 8 C. B. 680, *Nickels v. Ross*; 7 M. & G. 630, *Bedells v. Massey*; 13 M. & W. 552, *Bunnett and Corpe v. Smith*. This appears to be the proper plea to raise the question whether the grant includes the plaintiff's claim. It puts in issue, not only the *existence of the letters patent, but the legal effect of them [*166] as stated by the plaintiff.

Non concessit is the proper form of pleading, to enable the defendant to object that the title in the patent does not correctly describe the invention. This plea puts in issue all the surrounding circumstances of the grant.^(a) Maule, J. thought that it seemed to be against the spirit of the new rules, that the fact of the Queen having been deceived in her grant, should be given in evidence under non concessit, but that the case had not been provided for. But it will not put in issue that the plain-

(s) *Russell v. Crichton*, Decisions of the Court of Session, vol. xvi. 1157.

(t) See *Bentley v. Keighley*, 6 M. & G. 1041; *Muntz v. Foster*, 6 M. & G. 734.

(u) *Sandiford v. Neild*, Webst. P. C. 311, n.

(v) *Holmes v. London and North-Western Railway Company*, 19 Law Times, 158, C. P.

(y) See per Dallas, C. J., *Hill v. Thompson*, Webst. P. C. 240, 8 Taunt. 382; per Tindal, C. J. *Cornish v. Keene*, N. P. Webst. P. C. 511.

(z) See *Reed v. Cutter*, 1 Story Rep. 590; *Curtis on Patents*, 33.

(a) *Bunnett v. Smith*, 13 M. & W. 553; *Platt v. Elce*, 20 L. T. 226.

tiff was the first inventor, if that fact is averred in the declaration independently. (b)

20. Nul tiel record is the proper plea where the existence of the patent is denied altogether.—Co. Litt. 260, a.

21. That the letters patent originally granted were cancelled, and new letters patent granted, which were antedated. Replication to the same—Nickels v. Ross, 8 C. B. 680, 688.

22. That the letters patent were obtained upon a false suggestion, that the invention was communicated to the patentee by a foreigner.—Nickels v. Ross, 8 C. B. 684.

23. That the letters patent were obtained upon a false suggestion, that the invention was an improvement.—Nickels v. Ross, 8 C. B. 684; Bedells v. Massey, 7 M. & G. 630. This will be allowed as a distinct plea, from a plea that the invention was of no use. It is said that the invention may be an improvement, and yet detrimental to the public.

24. That the invention was not new.—Nickels v. Ross, 8 C. B. 686. A plea that the invention was not, at the time of making the patent, a new manufacture within this realm, within the true intent and meaning of the Act, was held bad for ambiguity. It is left doubtful whether the plaintiff means to deny that the matter to which the patent related, was a manufacture within the statute, or that it had the quality of being new. A person advising the plaintiff as to proofs in answer to such a plea, would not know to what point they should be applied. (c) A plea that the invention is not a *new manufacture, admits that it is a manufacture [*167] within the statute. To sustain the plea, prior user must be proved. (d)

25. That the invention is not a manufacture within the statute.—Walton v. Bateman, 3 M. & G. 773; Nickels v. Ross, 8 C. B. 686. This seems the proper plea to raise the objection so often made unsuccessfully, that the patent is for a principle. A patent is the better, rather than the worse, that it involves the discovery of an important principle. No doubt it must contain the invention of a practical mode of the application of the principle. It is necessary that the invention should conduce to certain economical purposes, for increasing the wealth or comforts of the community. (e)

26. That the invention is of no use.—Nickels v. Ross, 8 C. B. 687. The plea in this form will not be proved by evidence that one of the articles comprised in the patent was of no use, or that the patented articles were of no use for one of the purposes suggested. (f)

The defence in such case is, that the patent was obtained upon a false representation, and it should be so pleaded. A plea that the invention was not of such use as to make it a sufficient consideration for the grant

(b) Nickels v. Ross, 8 C. B. 679, 722. See also Baddley v. Leppingwell, 3 Burr. 1544; Hinde's case, 4 Rep. 70, b; Eden's case, 6 Rep. 15.

(c) Spilsbury v. Clough, 2 Q. B. 466; S. C. 2 G. & D. 17. See Millingen v. Picken, 1 C. B. 799.

(d) Walton v. Potter, 3 M. & G. 434; Neilson v. Harford, 8 M. & W. 806; Elliott v. Aston, Webst. P. C. 223; Stead v. Anderson, 4 C. B. 806.

(e) Neilson v. Baird, Decisions of the Court of Session, 2d series, vol. vi. 51.

(f) Walton v. Bateman, Webst. P. C. 624.

of letters patent, is bad. *(g)* It leaves that which is properly a question of law, to the jury.

The jury may, if they please, rely on the opinions of scientific men who have not tested the invention. But if the trial has not been actually made, it leads to the suggestion or belief, that the defendant has abstained from causing the experiment to be made, because he knew it would answer too well. *(h)*

27. That the specification does not duly describe the invention.—3 Chitty on Pleading, 268; Nickels v. Ross, 8 C. B. 687; Derosne v. Fairie, 2 C. M. & R. 478. The affirmative lies on the plaintiff. *(i)* The issue is, whether the specification is sufficient to enable competent workmen to *make the patented invention. That the specification is defective in other particulars, as that it does not disclose the sub- [*168] ject-matter of a patent, is not in issue. *(k)*

28. That no specification was enrolled in Chancery, and replication to the same.—Nickels v. Ross, 8 C. B. 687, 691; see also Minter v. Mower, 6 A. & E. 736; Derosne v. Fairie, 2 C. M. & R. 478; 3 Chitty on Pleading, 269. As to the evidence, ante, chap. xii. sect. 4, chap. xvii. p. 154, 156.

29. Insufficiency of title.—Croll v. Edge, 9 C. B. 465; Cooke v. Pearce, 8 Q. B. 1044.

30. That the plaintiff was not the first inventor.—3 Chitty on Pleading, 269; Minter v. Mower, 6 A. & E. 736; Derosne v. Fairie, 2 C. M. & R. 477. The affirmative of the issue lies on the plaintiff; but if the plaintiff gives general evidence of the novelty of the invention, the defendant must prove the negative. The plaintiff need not show how he acquired the invention.—Nickels v. Ross, 8 C. B. 711. As to the evidence in support of the plea, ante, 40—48. See Stead v. Williams, 7 M. & G. 842; Stead v. Anderson, 4 C. B. 806.

31. The illegality of an invention must be specially pleaded. If the invention is said to be generally inconvenient, the plea must show how it is inconvenient. *(l)*

32. That the letters patent were assigned in trust for more than twelve persons.—MacAlpine v. Mangnall, 3 C. B. 503; now see 15 & 16 Vict. cap. 83, s. 36.

33. That a disclaimer was not entered until after the committing of the grievances, and that the patent was void until after the entry of the disclaimer.—Perry v. Skinner, 2 M. & W. 471. See 15 & 16 Vict. cap. 83, s. 39.

As to a traverse of the entry of the disclaimer; pleas that the disclaimer was invalid, as being not authorized by the statute, see Wallington v. Dale, 6 Exch. 284; see further, Wallington v. Dale, 19 Law

(g) Betts v. Walker, 14 Jur. 647, Q. B.

(h) Neilson v. Harford, Webst. P. C. 316, Parke, B.; Reg. v. Steiner, Lord Campbell, N. P. Times, Dec. 6, 1851.

(i) Bentley v. Goldthorp, 1 C. B. 368.

(k) Gibson v. Brand, 4 M. & G. 179; The Househill Company v. Neilson, Webst. P. C. 677; Wallington v. Dale, 19 Law Times, 187.

(l) Rex v. Arkwright, Dav. P. C. 79; Gillett v. Wilby, 9 C. & P. 334; Millingen v. Picken, 1 C. B. 814.

Times, 187. Evidence is not admissible under a traverse of the disclaimer, that the disclaimer is invalid as being not authorized by the statute.

34. With regard to the allowance of pleas, it may be observed, that [*169] if in any action brought by order of the Court *of Chancery, the defendant by his pleas, attempts to raise questions which have not been raised in the Court of Chancery, the pleas, if fair and good on the face of them, will not be disallowed by a court of common law. Thus, where in the Court of Chancery the dispute had been as to the infringement by the defendant, but in the action the defendant put in issue the title of the patentee, and the fact of the grant of the patent, pleas, raising these questions, were allowed. (*m*)

If, however, the pleas are pleaded contrary to an order of the Court of Chancery, the court of common law would probably disallow them. (*n*)

SECTION III.—PARTICULARS OF OBJECTIONS.

35. Particulars of objections must be delivered with the declaration. Stat. 5 & 6 Wm. 4, cap. 83, s. 5, relating to the notice of objections, is superseded by stat. 15 & 16 Vict. cap. 83, s. 41, which enacts, that in any action in any of her Majesty's superior courts of record at Westminster or in Dublin, for the infringement of letters patent, the defendant, on pleading thereto, shall deliver with his pleas, particulars of any objections on which he means to rely at the trial in support of the pleas in the said action; and at the trial of such action, no evidence shall be allowed to be given in support of any alleged infringement, or of any objection impeaching the validity of such letters patent, which shall not be contained in the particulars delivered as aforesaid; provided always, that the place or places at or in which, and in what manner, the invention is alleged to have been used or published prior to the date of the letters patent, shall be stated in such particulars. Provided also, that it shall and may be lawful for any judge at chambers to allow such plaintiff or defendant, or prosecutor respectively, to amend the particulars delivered as aforesaid, upon such terms as to such judge shall seem fit.

36. It is incumbent on the Court to see that the objections are stated in a definite and intelligible form, before the parties go down to trial, that the patentee may not be taken by surprise. (*o*)

[*170] In general, a mere copy of the pleas will not be sufficient *notice of objections. The objections, however, may be so fully expanded upon the record, that a mere transcript of the pleas may be enough. What degree of particularity is required, it is difficult to define. (*p*) Each case must depend on its own circumstances. The Le-

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

(*n*) See 15 & 16 Vict. cap. 76, s. 226.

(*o*) *Coltman, J., Fisher v. Dewick*, 4 Bing. N. C. 706.

(*p*) *Tindal, C. J., Jones v. Berger*, 5 M. & G. 215; *Neilson v. Harford*, 8 M. & W. 806, 882; S. C. 1 Webst. P. C. 370.

gislature, however, never intended that the defendant should argue his case in the objections delivered. (q)

37. Particulars of objections delivered by the defendant, must be precise and definite. It is not sufficient to say, that the improvements, or some of them, have been used before; the defendant must point out which. An objection that if any part be new, the same is useless and unnecessary, should point out what part. (r)

In a recent case, Creswell, J. intimated a strong opinion, that the notice should specify the pleas to which the objections were intended to apply. (s)

Perhaps it is enough if they disclose fairly the case of the defendant, and convey such information as a plaintiff in a bill of discovery in Chancery would be entitled to; that is to say, if they disclose the case of the defendant, without showing the evidence by which he means to support it. (t)

Parke, B., in *Leaf v. Topham*, said, "It is not necessary that the notice of objection should set forth the evidence on which the defendant relies." (u)

In another case, Alderson, B. said, "In asking for the names of the persons who have used the invention, are you not requiring to be furnished with a statement of the evidence in the briefs?" (x)

38. Considerable difference of opinion formerly existed amongst the judges, as to whether the names of persons alleged to have used the invention could be required.

In *Bulnois v. Mackenzie*, Vaughan, B., at chambers, made an order, that the defendant's attorney should furnish *to the plaintiff's attorney the names, descriptions, and places of abode, of the [*171] persons by whom, and also the dates when the invention was used. The Court rescinded so much of it as required the defendant to furnish names and descriptions. (y)

So in *Galloway v. Bleaden*, Coltman, J. ordered names, addresses, and descriptions of persons who were alleged to have used the invention, to be given, and the words "other persons" to be struck out. (z)

Where the particulars stated that the invention was known to and used by A. B. and others before the grant of the letters patent, the Court refused to require the defendant to strike out the words "and others," or to make an order that the names and descriptions of the others should be stated. "It is difficult," said Maule, J., "to define the exact degree of particularity which ought to be required, but it should not be greater than the knowledge of the party making the objection may be presumed to enable him to give." (a)

(q) *Heath v. Unwin*, 10 M. & W. 684.

(r) *Fisher v. Dewick*, 4 B. N. C. 706; S. C. Webst. P. C. 264.

(s) *Walton v. Bateman*, Webst. P. C. 286, n.

(t) See *Attorney-General v. Corporation of London*, 2 McNaght. & Gord. 247.

(u) Per Parke, B., *Leaf v. Topham*, 14 M. & W. 146.

(x) *Russell v. Ledsam*, 11 M. & W. 649.

(y) *Bulnois v. Mackenzie*, Webst. P. C. 260.

(z) *Galloway v. Bleaden*, Webst. P. C. 268, n.

(a) *Bentley v. Keighley*, 7 M. & G. 652; *Carpenter v. Walker*, 7 M. & G. 657, note a.

On a scire facias to repeal a patent, the prosecutor having filed a notice of objections, that other persons than the patentee had used the invention in England before the grant of the patent, the Court refused to order the delivery of a particular stating the names of such persons.(b)

39. Where it was objected that the alleged invention had been published in the specifications of two previous patents, particularizing them, and also by other persons in other books and writings, it was held that the *books* should be specified.(c) Per Tindal, C. J., "The defendant might keep back his evidence, and then start upon the plaintiff at the trial with some article in a foreign cyclopædia. No hardship is imposed on the defendant, as he can add the name of other publications to his notice at any time before the trial."

40. A notice of objections stated, that the invention was in use by [*172] many persons before the patent; and particularly, that the use of rice-starch in clear-starching lace, &c., was *known and practised at Nottingham and elsewhere. It was held, that upon striking out the words "and elsewhere," the objection was sufficiently precise. The objection being narrowed to the use of rice-starch in the dressing of lace, there was a sufficient particularity.(d)

41. A particular, that the specification does not sufficiently describe the nature of the invention, need not state in what manner the specification is deficient in its description of the invention;(e) but a notice of objection, that the patentee has not caused any specification sufficiently describing the invention to be enrolled, is not sufficiently certain. It may mean, either that there is no specification existing on the rolls of the Court of Chancery, or that the one enrolled is defective in not sufficiently describing the invention.(f)

42. The notice of objections need not state who the first inventor was. To require the defendant to afford this information, would be throwing the burden of proof on the wrong party.(g)

But it should be such as not to leave the plaintiff in doubt what are the objections really intended to be made to the patent upon the trial. If he means to deny that the plaintiff invented any part of the supposed invention, he should say so, and not that the plaintiff did not invent the invention.(h) If it is doubtful what the defendant means to object to, there would be a difficulty thrown upon the plaintiff in getting the costs occasioned by objections not sustained.

43. The defendant must 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 proposes to object to part, then he must state what part.(i)

A notice stating that defendant would object that the invention was

(b) Reg. v. Walton, 2 Q. B. 969.

(d) Jones v. Berger, 5 M. & G. 208.

(f) Leaf v. Topham, 14 M. & W. 146; Betts v. Walker, 14 Jur. 647. Q. B.

(g) Russell v. Ledsam, 11 M. & W. 647.

(h) Betts v. Walker, 14 Jur. 647, Q. B.

(i) Bodmer v. Butterworth, 2 Law Times, 368, Q. B.

(c) Jones v. Berger, 5 M. & G. 208.

(e) Heath v. Unwin, 10 M. & W. 684.

not new, and had been wholly, or in part, used and made public before the obtaining of the letters patent, held insufficient. (*j*)

*An objection that the plaintiff's specification did not sufficiently distinguish between what was old and what was new, [*173] was held sufficiently precise, as the objection was to an omission in the specification. (*k*)

That the plaintiff did not state in his specification the most beneficial method with which he was then acquainted of practising the invention, held sufficiently precise. (*l*)

44. If he insists that the patent was obtained by fraud and misrepresentation, he should state in what the fraud consisted, and was the species of misrepresentation by which the patent was obtained. (*m*)

45. If the particulars are insufficient, the plaintiff should take out a summons, or move for a rule to show cause why better particulars should not be delivered. A rule to set aside the particulars is improper. (*n*)

When at the time of pleading, the defendant had omitted to deliver a notice of objections with the pleas, a summons was subsequently taken out before a judge at chambers by the defendant, to show cause why he should not be at liberty to deliver such notice. The Court made an order, that the plea already pleaded should be considered as pleaded de novo, and the objections added considered as delivered with the pleas. (*o*)

46. The defendant cannot avail himself of his notice of objections to raise any defence at the trial, on which no issue is joined by the pleadings. (*p*)

A declaration in scire facias to repeal a patent contained suggestions, alleging want of novelty and utility, in a certain part of the said invention." (*q*) The pleas denied all the suggestions in the declaration. Objections were filed with the declaration, pointing out claim No. 6 as bad, for want of novelty and utility. After issue joined, the defendant entered a disclaimer of claim No. 6. It was held, that the objections filed with the declaration were not part of the record, so as *to be incorporated with the issues, and to add to or explain the sugges- [*174] tions.

47. At Nisi Prius, the only question for the judge is, whether the language of the notice fairly includes the objection. (*r*)

The notice of objections must be considered as a kind of notice appended to the pleas as notice of the set-off; the attention of the Court should be called to it as part of the plaintiff's case. The objections should be read at the time of the pleadings being opened. (*s*) Reading them at a subsequent period after the conclusion of the speech of the

(*j*) Heath v. Unwin, 10 M. & W. 685.

(*k*) Jones v. Berger, 5 M. & G. 208.

(*l*) Jones v. Berger, 5 M. & G. 208. See Neilson v. Harford, Webst. P. C. 324, n.

(*m*) Russell v. Ledsam, 11 M. & W. 647.

(*n*) Hancock v. Moulten, Exch. 20 Law Times, 102.

(*o*) Losh v. Hague, Webst. P. C. note, *a*.

(*p*) Gillett v. Wilby, 9 C. P. 334; S. C. Webst. P. C. 270.

(*q*) Reg. v. Mill, 20 L. J. C. P. n. s. 16; 10 C. B. 379, S. C.

(*r*) Neilson v. Harford, Webst. P. C. 324, n.

(*s*) Neilson v. Harford, Webst. P. C. 309, n.

defendant's counsel will not give the plaintiff's counsel a right of reply.

SECTION IV.—INSPECTION.

48. It has been doubted, but apparently without good reason, whether a court of equity will make an order for an inspection of the defendant's machinery in aid of a trial at law except by consent.^(t)

Such an order will not be made unless there is good cause for suspecting an infringement, for the defendant might be prejudiced by the disclosure of his process.^(u)

49. An order for the inspection of the defendant's process cannot be executed by force. It operates only on the person as a foundation for process for contempt, and to take the bill pro confesso, if necessary.^(x)

50. By stat. 15 & 16 Vict. cap. 83, s. 42, courts of common law, or a judge may make such order as they or he may think fit, for an injunction, inspection, or account.

An application for an order for inspection under this statute, may be made at any time, either before declaration or afterwards. It will not be granted unless the party applying for it shows by affidavit that it is material, and really wanted for the purposes of the cause.^(y)

[*175] *51. As to the form of such orders, it may be observed, that it has been made a condition of the dissolution or refusal to grant an injunction, that defendant shall keep an account; that the plaintiff and his witnesses may, at all reasonable times, giving reasonable notice, inspect the defendant's works and the articles alleged to have been made in contravention of the patent; and that all books and papers relating to the matters in question shall be produced at the trial.^(z) Where the question to be tried was, whether certain lace was made by a machine similar to that patented, Lord Eldon, in directing an action to be brought, made an order that the plaintiff's witnesses should be at liberty to inspect the defendant's machine, and see it work.^(a)

In *Russell v. Cowley*, an order was made by consent that defendants should permit the solicitor of the plaintiff, with men of science, to go over the manufactory of the defendants, and inspect the machinery set up there for making iron tubes, and observe the methods of manufacturing such tubes, for which purpose the defendants were ordered to put their machinery to work; the plaintiff to suffer defendant's solicitors, with scientific persons, to go over the plaintiff's manufactory, and inspect their machinery, which was to be put to work. The viewers were to be at liberty to carry away the tubes operated upon.^(b)

^(t) 7 Jarman, by Sweet, 550. See *Brown v. Moore*, 3 Swanst. 264; *Earl of Lonsdale v. Curwen*, 3 Bligh, 168; *Walker v. Fletcher*, 3 Bligh, 172.

^(u) *Huddart v. Grimshaw*, Webst. P. C. 92. See post.

^(x) *East-India Company v. Kynaston*, 3 Bligh, 153.

^(y) *Amies v. Kelsey*, 16 Jur. 1047, B. C.; *Shaw v. The Bank of England*, 22 L. J. n. s. Exch. 26. See 20 Law Times, Exch. 70. 227.

^(z) *Morgan v. Seaward*, Webst. P. C. 167.

^(a) *Bovill v. Moore*, 2 Coop. C. C. 56, n. See *Huddart v. Grimshaw*, Webst. P. C. 92.

^(b) *Russell v. Cowley*, Webst. P. C. 457.

52. In *Russell v. Crichton*, a patentee moved in the Court of Sessions in Scotland, for an order for the inspection of the defender's works by persons of skill; the defender alleged that his manufacture involved a secret process, the value of which would be lost if inspection was allowed. It was held, that some inspection must be allowed, otherwise any patent might be infringed with impunity; and an order was pronounced for giving inspection of the works and manufactories of both parties to certain viewers, other than the plaintiff or manufacturers in the same trade, who were to see the works in actual operation; with power to them to adjourn and continue the inspection, so that they might be able to give evidence at the trial.(c)

*In *Brown v. Brown and Somerville* an order was made, under similar circumstances, on an affidavit by the pursuer that an in- [*176] spection was necessary to enable him to establish his case.(d)

53. A court of common law in England will not make an order that the plaintiff should permit the defendant to inspect the mode of manufacture under the patent, to enable him to judge if his own manufacture is an infringement.(e) He has the opportunity of examining the plaintiff's specification.

SECTION V.—NEW TRIAL, COSTS, ETC.

54. After a verdict for the plaintiff in an action for the infringement of a patent, the courts will not readily grant a new trial on affidavits showing that a witness who was disbelieved by the jury spoke the truth, because the proceedings are not final and conclusive; it being open to those who wish to question the validity of the patent, to do so by suing out a writ of scire facias. Nor on the ground that the verdict was against evidence, unless they are thoroughly satisfied that the verdict was wrong.(f) For the same reason, the Court of Common Pleas has refused to allow a point, that the patent was for machinery, while the invention was of the application of a machine, where the point had not been made at the trial, to be argued in Banco, on a motion to enter a nonsuit.(g) Probably the decision might have been otherwise if substantial damages had been awarded in the action.

55. Proceedings in actions for infringement will not in general be stayed, because a scire facias to repeal the patent is pending.(h)

56. If the verdict is for nominal damages only, it will be proper to apply for certificates, that the action was properly *brought in the superior court,(i)—to enable the plaintiff to get his costs under [*177]

(c) *Russell v. Crichton*, Decisions of the Court of Session, vol. xv. 1271.

(d) *Brown v. Brown and Somerville*, Decisions of the Court of Session, 2d series, vol. ii. 1356.

(e) *Crofts v. Peach*, Webst. P. C. 268; 2 *Hodges*, 110; *Hamilton v. Cochrane*, 33 *Newt. Lond. Journ.* 148. See *Russell v. Cowley*, ante, 175.

(f) *Wallington v. Dale*, 19 *Law Times*, 187; *Lewis v. Marling*, 10 B. & C. 22.

(g) *Haworth v. Hardecastle*, Webst. P. C. 483.

(h) See *Smith v. Upton*, 6 M. & G. 259; *Bentley v. Goldthorp*, ib. note b; *Muntz v. Foster*, ib. note e; *Patteson v. Holland*, *Hindmarch on Patents*, 293.

(i) See *In re Adey v. The Deputy Master of the Trinity House*, 22 L. J. N. S. Q. B. 3; *Davis v. Walton*, 8 *Exch.* 153.

3 & 4 Vict. cap. 24, s. 2,—and if such was the case, that the title to the patent came in question. See post. The judge must also certify as to the particulars proved.

57. By stat. 15 & 16 Vict. cap. 83, s. 43, in taxing the costs in any action in any of her Majesty's superior courts at Westminster or in Dublin, commenced after the passing of this Act, for infringing letters patent, regard shall be had to the particulars delivered in such action; and the plaintiff and defendant respectively shall *not* be allowed any costs in respect of any particular, unless certified by the judge before whom the trial was had, to have been proved by such plaintiff or defendant respectively, without regard to the general costs of the cause.

58. By stat. 5 & 6 Wm. 4, cap. 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 the case which has been proved at the trial, which shall be certified by the judge before whom the same shall be heard, and the costs of each part of the case *shall be given* accordingly as either party has succeeded or failed therein, regard being had to the notice of objections, as well as the counts of the declaration, and without regard to the general result of the trial.

59. The effect of these two provisions is important with respect to particulars of breaches delivered by the plaintiff with his declaration, and to particulars delivered with a plea, pointing out several branches of evidence. For instance, in support of a plea denying the novelty of the hot-blast, if a particular is delivered, stating user at the Dowlais and the Ynisedwin works, though the defendant should succeed in proving user at the Ynisedwin works, if he did not also prove a user at the Dowlais works, he would not only not get his costs of the witnesses on that branch of the evidence, but would have to pay any costs of the plaintiff relating to it.

60. The judge must certify as to the determination of each question upon the particulars of breaches, and the particulars of objection, [*178] and not merely as to the issues under stat. 5 & 6 *Wm. 4, cap. 83. Before the passing of 15 & 16 Vict. cap. 83, it was considered that the costs of the issues must be taxed according to the ordinary rule, and that the Act made no difference, except as to the costs of copying and transcribing the objections. Where a defendant succeeded on a plea, which went to the whole cause of action, he was held to be entitled to the general costs of the cause, deducting the costs of the objections on which the plaintiff had succeeded, and of the issues found for him.(j)

61. By stat. 15 & 16 Vict. cap. 83, s. 43, it shall be lawful for the judge before whom any action for infringing letters patent, commenced after the passing of that Act, shall be tried, to certify on the record that the validity of the letters patent in the declaration mentioned came in question; and the record with such certificate, being given in evidence in any suit or action for infringing the said letters patent, or in any proceeding by scire facias to repeal the said letters patent, shall entitle the plaintiff in any suit or action, or the defendant in such proceeding by

(j) *Losh v. Hague*, 5 M. & W. 387; S. C. Webst. P. C. 209, n.

scire facias, on obtaining a decree, decretal order, or final judgment, to his full costs, charges, and expenses, taxed as between attorney and client, unless the judge making such decree or order, or the judge trying such action or proceeding, shall certify that the plaintiff or defendant respectively ought not to have such full costs.

62. To enable a judge to certify in actions commenced before the passing of that Act, in a court of equity, or in a scire facias, recourse must be had to stat. 5 & 6 Wm. 4, cap. 83, s. 3, which enacts, that if any action at law, or any suit in equity for an account, shall be brought in respect of an alleged infringement of such letters patent, 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, 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 action or suit whatever touching such patent, if a *verdict shall pass, or a decree or decretal order be made in favour of such [*179] patentee or his assigns, he or they shall receive full costs (5 & 6 Vict. cap. 97) in such suit or action, unless the judge making such record or other decree, or order, or trying such record or other action, shall certify that he ought not to have such costs.

63. Under a plea that the invention is not new, the validity of the patent is brought into question; and the judge has therefore power to certify such fact under the statute.^(k) But Mr. Justice Erskine has refused to certify in a case where the defendant consented to a verdict, saying, "That his certificate would affect third parties, and it would be possible for the parties to collude for the purpose of injuring another party, who was really contesting the validity of the patent."^(l)

64. When the record of a former verdict, with a certificate of the judge indorsed upon it, is produced for the purpose of enabling the patentee to receive his full costs, it appears to be the proper course to put it in after the verdict is given. The defendant's case ought not to be prejudiced by the putting it in evidence during the trial.^(m)

It would seem that the costs may be obtained, on proof of the production of the certificate, either by the judge's indorsement, or by a suggestion on the record.⁽ⁿ⁾

65. Notwithstanding that a certificate has been granted under 5 & 6 Wm. 4, cap. 83, s. 3, and has been produced and proved on the trial of an action on the case for the infringement of a patent, if the plaintiff recovers only nominal damages in such action, he cannot have full costs under that Act and 5 & 6 Vict. cap. 97, unless the judge certifies at the trial to give him his costs under stat. 3 & 4 Vict. cap. 24, s. 2. After

(k) *Gillett v. Wilby*, 9 C. & P. 334; *S. C. Webst. P. C.* 270.

(l) *Stocker v. Rodgers*, 1 C. & K. 99.

(m) *Newhall v. Wilkins*, 17 *Law Times*, 20, Lord Campbell, N. P.

(n) See *Bowyer v. Cook*, 4 C. B. 236.

the taxation of costs, the judge has no power to grant such a certificate.(o)

66. Where an action was not directed, but the Court of Chancery, on a motion for an injunction, ordered that the plaintiff should be at [*180] liberty to bring such action as he might *be advised, provided he delivered a declaration within a month, Baron Parke considered, that the question as to the costs of the action must be determined by the rules of the common law, inasmuch as either plaintiff or defendant could apply for a nonsuit or new trial, or bring a writ of error, without the leave of the Court of Chancery.(p)

[*181]

*CHAPTER XIX.

REMEDIES OF PATENTEE.—INJUNCTION.—ACCOUNT.

1. COURTS of equity have hitherto granted injunctions to restrain persons from using the invention without license, and compelled the rendering of an account of the profits made by any wrongful use of the invention.

2. Concurrent jurisdiction in such matters is now given to the superior courts of common law. In any action pending in any of her Majesty's superior courts of record at Westminster and Dublin, for the infringement of letters patent, it shall be lawful for the Court in which such action is pending, if the Court be then sitting, or if the Court be not then sitting, then for a judge or such court, on the application of the plaintiff or defendant, to make such order for an injunction, inspection, and account, and the proceedings therein, as to such Court or judge may seem fit.(a)

3. Lord Eldon, in one case, granted an injunction against a public servant, to restrain him from employing patented inventions in the service of the Government. He subsequently punished him for disobeying the injunction ; suggesting, at the same time, but not deciding, that probably the injunction ought not to have issued. However, as it had been infringed, he said he would treat Government as he would any suitor of the court, subject to the question at law. He ordered an account to be kept of all machines made in violation of the plaintiff's patent, and of the profits to which the plaintiff would be entitled if the patent had been infringed. He recommended the Government to pay the costs of the application, and said, he would have it understood that if [*182] the recommendation was not attended to, he would make an order for the defendant, Sir William Congreve, to pay.(b)

(o) Gillett v. Green, 7 M. & W. 347 ; Webst. P. C. 271.

(p) Russell v. Cowley, before Parke, B. at chambers, Webst. P. C. 471, n.

(a) Stat. 15 & 16 Vict. cap. 83, s. 42.

(b) Walker v. Congreve, Rep. 1829, 202 ; 1 Carp. R. 356. See Rankin v. Huskisson, 4 Sim. 14 ; Priddy v. Rose, 3 Mer, 102 ; Frewen v. Lewis, 4 Myl. & Cr. 255 ; De Haber v. The Queen of Portugal, 20 L. J. N. s. Q. B. 488.

4. The Court of Queen's Bench have refused a mandamus to the Lord's of the Admiralty, to settle the terms on which they might be allowed to make use of an invention protected by letters patent, of which they were availing themselves.(c) The proper course for the patentee to take, when his patent is infringed by the officers of Government acting in that capacity, is, perhaps, by petition of right.(d)

5. Foreigners coming in their own ships into the ports of this country, may be restrained from infringing a patented invention on board such ships.(e)

6. The jurisdiction of the Court of Chancery is founded upon legal rights. Great latitude is allowed to the Court in dealing with the application. When an interlocutory injunction is applied for, several courses are open. The Court may at once grant the injunction simply, without more; a course which is not likely to be taken, when the defendant raises a question as to the validity of the plaintiff's title. Or it may follow the more usual and wholesome practice of either granting the injunction and at the same time directing the plaintiff to establish his title at law; or of requiring him first to establish his title at law, suspending the grant of the injunction till the result of the legal investigation is known.(f)

7. It is the duty of a court of equity to protect property pending litigation; but when it is called upon to do so, it requires some proof of the title of the party asking its interference. When a patent is new, the Court considers the proof of title in the patentee to be wanting, inasmuch as the public have had no opportunity of contesting the validity of the patent. In such a case, the Court will not act upon its own notions as to the validity of the patent, but will oblige the *patentee to establish his title at law before it will grant him the injunc- [*183] tion.(g)

8. If there be any doubt as to the validity of the legal right, the Court will be very cautious in granting an injunction, first, because if the legal right ultimately fails, or if the acts complained of turn out not to be a violation of the legal right, it will have acted without any authority whatever, the authority being merely derivable from the legal right; secondly, and principally, because an injunction, if improperly granted, causes infinitely more mischief to the defendant, than the delay of granting it can possibly cause to the plaintiff. As a general rule, the Court will not grant an injunction unless satisfied that, in the result, the legal right will be established, and that the acts complained of are a violation of it.

9. If the Court does not entertain any serious doubt on these subjects,

(c) *Ex parte Pering*, 4 A. & E. 949.

(d) See *Smith v. Upton*, 6 M. & G. 252, n. See, however, *The Baron de Bode's case*, 8 Q. B. 208, 271, and cases in note; *The Baron de Bode v. The Queen*, 13 Q. B. 380.

(e) *Caldwell v. Van Vlissingen*, 9 Harc, 415.

(f) *Bacon v. Jones*, 4 M. & C. 433.

(g) *Hill v. Thompson and Farnam*, Webst. P. C. 331; 3 Mer. 622; S. C.; per Lord Cottenham, *Coop. U. C.* 48; *Baxter v. Combe*, 1 Irish Chan. R. 284.

it will grant^a an injunction without putting the plaintiff to establish his title at law.^(h)

10. The legal right being in doubt is a matter for the serious attention of the Court, and one to which great weight should be given; but it is not a matter which renders it absolutely incumbent on the Court to refuse an injunction. The Court must be guided by a discretion, to be exercised according to the circumstances of each particular case.⁽ⁱ⁾

11. In a patent case, long and exclusive possession and enjoyment is considered such prima facie evidence of title, as to justify the Court in protecting the patent right by an injunction until its invalidity is established at law.^(k) In such a case, there is less inconvenience in granting the injunction than in refusing it; for unless such injunctions were [*184] granted, patentees might be ruined by litigation.^(l) Thus, *where the plaintiff had been successful in proceedings at law and in equity against other persons, and had had exclusive enjoyment of the patent for a considerable time, although some doubt existed as to the validity of the patent, the Court granted an injunction.^(m) Where a bill alleged exclusive possession for ten years, and that the plaintiff had established his title by repeated actions, a demurrer, on the ground of the invalidity of the patent, as appearing from the specification set out in the bill, was overruled.⁽ⁿ⁾

12 Lord Eldon said, "If a party had got his patent, and put his invention into execution, and proceeded to sell articles made according to it, that was a sufficient possession."^(o)

Lord Cottenham said, "He should be satisfied if he found manufacturers had acquiesced in the patentee's enjoyment; but that he should require very satisfactory evidence of the exclusive possession of the patentee. He did not think it enough where some manufacturers stated, that out of respect for the patentee they had not used the invention, and others stated, that they had done so constantly."^(p)

13. The period of enjoyment which will be sufficient, must vary according to the circumstances. In the case of Losh's patent for "wheels for railway carriages," enjoyment for seven years was held sufficient. In Bickford's patent for a "miner's fuze," six years was considered sufficient, though the article was one in which there was little competition.^(q)

(h) *Electric Telegraph Company v. Nott*, 2 Coop. C. C. 41; *Stevens v. Keating* 9 Phillips, 333; *Bacon v. Jones*, 4 M. & C. 436.

(i) *Ollendorff v. Black*, 20 L. J. N. S. Chy. 165.

(k) *Hill v. Thompson and Forman*, Webst. P. C. 231; 3 Mer. 622, S. C.; *Stevens v. Keating*, 2 Phillips, 333; *Bickford v. Skewes*, 4 M. & C. 500; *Neilson v. Thompson*, Webst. P. C. 275.

(l) *Harmar v. Plane*, 14 Ves. 132; *Boulton and Watt v. Bull*, 3 Ves. 140; *Universities of Oxford and Cambridge v. Richardson*, 6 Ves. 707; *Muntz v. Foster*, 2 Law Times, 325.

(m) *Newall v. Wilson*, 19 Law Times, 161, Chy. Court of Appeal; *Beeston v. Collyer*, 2 Coop. C. C. 58, Lord Lyndhurst.

(n) *Kay v. Marshall*, 1 M. & C. 373.

(o) *Boulton and Watt v. Bull*, 3 Ves. 140.

(p) *Collard v. Allison*, 4 M. & C. 488; *Curtis v. Cutts*, 2 Coop. C. C. 59.

(q) *Losh v. Hague*, Webst. P. C. 200; *Bickford v. Skewes*, Webst. P. C. 212.

14. In some cases the conduct of parties will induce the Court to assume the validity of the patent as against them. Thus, where a patent had been worked by the plaintiff and defendant as partners, and during the partnership the defendant did not dispute the validity of the patent, the Court, on an interlocutory application against him after the dissolution of the partnership, assumed that the patent was valid.^(r)

*Where a license had been taken by the defendant for the use of two inventions, one of which was afterwards disclaimed, the defendant refusing to pay the royalties reserved, a demurrer to a bill, praying for an account or an injunction to restrain the defendant from all future use of the invention, in case of his refusal to pay the royalties, was overruled.^(s) [*185]

15. Where there is conflicting evidence upon the question of infringement, the Court will not grant an injunction till it has been ascertained by action at law, that the acts complained of are an infringement of the legal right granted by the patent.^(t)

Lord Eldon said, "Where there is one question, whether a patent is valid, and another, whether it has been infringed, the Court would be going a great way if it granted an injunction.^(u) If there has been no infringement, the Court has no power to make compensation to the defendant for the injury occasioned by the injunction.^(x)

16. An injunction will not be granted on the application of the assignee of a patent, unless his title as assignee is clear.^(y)

17. It is a principle of equity, that a person shall not, by his silence or acquiescence, induce another to expend his money, and incur risk, and then come in and share in the profit. Where the defendants went to considerable expense in erecting hot-blast apparatus, the plaintiff not interfering to stop them, but permitting them to complete their works, under the expectation that if they proved successful, the defendants would take a license, Lord Cottenham dissolved the injunction obtained by the patentee; but the plaintiff having succeeded in an action, the injunction was revived by Lord Lyndhurst.^(z)

18. If the plaintiff has been guilty of unnecessary delay in coming to the Court, though the impression of the Court is strong in his favour, an injunction will be refused till the *legal right is established.^(a) [*186] The difficulty of proving the infringement by the defendants, they having prevented all access to their manufactory, has been held a sufficient excuse.^(b) So a delay of a year and a half was explained by the pendency of an action in the Court of Exchequer, and writ of error

(r) *Muntz v. Grenfell*, V. C. Knight Bruce, 2 Coop. C. C. 61; 7 Jurist, 121.

(s) *Haddam v. Smith*, 17 L. J. Chy. n. s. 43. See *Neilson v. Fothergill*, Webst. P. C. 289.

(t) *The Electric Telegraph Company v. Nott*, 2 Coop. C. C. 41.

(u) *Wood v. Cockerell*, 2 Coop. C. C. 57.

(x) *Morgan v. Seaward*, Webst. P. C. 168.

(y) *Lowndes v. Duncombe*, 2 Coop. C. C. 216.

(z) *Neilson v. Thompson*, Webst. P. C. 286. See *Crossley v. Derby Gas Company*, Webst. P. C. 120. See *Wood v. Sutcliffe*, 21 L. J. n. s. Chy. 253; *Rochdale Canal Company v. King*, 20 L. J. n. s. Chy. 675.

(a) *Bridson v. Benecke*, 12 Beav. 1; *Baxter v. Combe*, 1 Irish Chan. R. 284.

(b) *Crossley v. Derby Gas Company*, Webst. P. C. 119.

in the Exchequer Chamber, in which a point on which the plaintiff's title depended was determined.(c)

19. An interlocutory injunction will not be granted, if irreparable injury, or even very serious inconvenience, would be the result of granting it, unless the case is so clear, that there can be no reasonable doubt about the legal title.(d) Thus, when the effect would have been to stop the running of a steamboat, in which it was said that the plaintiff's rudder was pirated, it was refused.(e)

20. The balance of convenience in granting or refusing the injunction, will be considered. Where an undertaking by the defendant, to keep an account, will afford to the Court ample means of doing justice to the patentee, the Court rarely grants an interlocutory injunction.(f)

21. An allegation not denied, that the defendant's circumstances are such as to render it improbable that he would be able to meet the pecuniary demands to which he would be liable if unsuccessful at law, may be an additional reason for granting an injunction.(g) In *Pow v. Betteley*, the fact of the defendant's solvency was considered by Knight Bruce, V. C., in refusing to grant an injunction.(h)

22. There is no doubt of the power of a court of equity to grant an injunction absolutely, and leave the defendant to impeach the patent if he can by *scire facias*. But it is not usual to do so. The patentee is generally compelled to bring an action to establish his right.(i) A trial [*187] at law, in which *the plaintiff has been successful, is not binding on another person alleged to have committed infringement, so as to induce the Court to grant the injunction absolutely.(k)

23. In *Muntz v. Grenfell*, before Vice-Chancellor Knight Bruce, the plaintiff, on obtaining the injunction, undertook to abide by any order which the Court might make as to compensation and damages, in the event of the injunction being dissolved. It is the present practice to impose this condition.(l)

24. The Scotch courts allow damages to be recovered, when an interdict or suspension is pronounced, if the party applying for it ultimately fails.(m)

25. Where the terms of bringing an action are imposed, the Court will deprive the plaintiff of the protection of the injunction, if he does not commence and proceed with his action with reasonable promptitude.(n)

(c) *Buxton v. James*, 5 De Gex & Smale, 80, V. C. Parker.

(d) *Neilson v. Thompson*, Webst. P. C. 286; *Spottiswoode v. Clarke*, 2 Phillips, 154; *Sheriff v. Coates*, 2 Russ. & Myl. 157.

(e) *Laird v. Crispin*, Times, Dec. 3, 1851.

(f) *Jones v. Pearce* 2 Coop. C. C. 58.

(g) *Newall v. Wilson*, 19 Law Times, 161, Chy. Court of Appeal.

(h) *Pow v. Betteley*, 24 Newt. Lond. Jour. C. S. 223.

(i) *Wilson v. Tindal*, Webst. P. C. 730; *Russell v. Barnesley*, Webst. P. C. 472; *Bramwell v. Holcomb*, 4 Myl. & Cr. 737.

(k) *Crosskill v. Tuxford*, 5 Law Times, 342; *Crosskill v. Evory*, 10 Law Times, 459.

(l) *Muntz v. Grenfell*, 2 Coop. C. C. 59, n.; *Morison v. Moat*, 21 L. J. n. s. Chy. 248; *Newall v. Wilson*, 19 Law Times, 161.

(m) *Stirling v. Roebuck*, Webst. P. C. 50, n.

(n) *Stevens v. Keating*, 2 Phillips, 336.

But it will not interfere, if the defendant has acquiesced in the delay by not coming to the court to complain of it.(o)

26. Where an injunction has been obtained *ex parte*, the defendant may move to dissolve it. The plaintiff will not be permitted to subject the defendant to any inconvenience which is not necessary for his protection.(p)

27. It is almost a matter of course to grant or revive an injunction when the plaintiff has established his title at law.(q)

28. There are some cases in which the Court is to such an extent satisfied by a verdict that the legal right exists, that it will give the plaintiff the benefit of an injunction, though further litigation is necessary; as where a bill of exceptions had been tendered, but many of the points raised had been decided in proceedings against a former infringer.(r)

*The Court will, in such cases, sometimes consult the judge [*188] who tried the cause.(s)

29. An injunction will not be granted, pending a rule *nisi* for a new trial, in an action in which the patentee has obtained a verdict, where it had been refused before trial.(t)

30. The Court of Chancery will be guided in some degree by its opinion of the correctness of the decision at law. Where an action had been brought, and a verdict obtained by the patentee, which was set aside by the Court of Exchequer, on grounds which the Vice-Chancellor considered unsatisfactory, it being objected, in answer to a motion for an injunction, that the bill ought to be dismissed, the Court ordered the motion to stand over, the bill to be retained for twelve months, and the plaintiff to bring such action as he should be advised.(u)

31. The defendant cannot demur to a bill in Chancery, because the specification is not set out in it.(x) Nor where a *prima facie* title is stated, because the specification as set out in the bill appears defective.

The Court will not on demurrer make an order directing the bill to be retained, with liberty to the plaintiff to bring an action.(x)

32. When the cause comes on to a hearing on bill and answer in Chancery, the case must, generally speaking, be in such a state that the Court can adjudicate upon it. If prior to that the patentee has not established his legal title, it is a question of discretion how far the Court will assist him, by allowing the bill to be retained and an action then brought.(y) Where four years had elapsed between the filing of the bill and the hearing, and the plaintiff had not made out such a case as would have entitled

(o) *Bickford v. Skewes*, 4 Myl. & Cr. 498.

(p) *Bacon v. Jones*, 4 M. & C. 433; 1 Beav. 382.

(q) *Neilson v. Harford*, Webst. P. C. 373; *Russell v. Cowley*, Webst. P. C. 471.

(r) *Bridson v. Benecke*, 12 Beav. 1. (s) *Bridson v. MacAlpine*, 8 Beav. 229.

(t) *Collard v. Allison*, 4 Myl. & Cr. 487; *Hill v. Thompson*, Webst. P. C. 236; S. C. 3 Mer. 626.

(u) *Heath v. Unwin*, 15 Sim. 552.

(x) *Westhead v. Keene*, 1 Beav. 287; *Kay v. Marshall*, 1 Myl. & Cr. 373.

(y) *Bacon v. Jones*, 1 Beav. 382; on appeal, 4 Myl. & Cr. 433; *Few v. Guppy*, 1 Myl. & Cr. 487.

him to an interlocutory injunction, the Court refused to retain the bill, and dismissed it with costs.

[*189] In *Ward v. Key*, the defendant submitted to an interlocutory *injunction, the order not containing a direction that the plaintiff should try his right at law. The defendant put in an answer, and both parties examined witnesses, and the case was brought to a hearing without a preliminary trial of the right at law. Vice-Chancellor Wigram, considering that there was a sufficient case for protecting the plaintiff's right, but not a case for a perpetual injunction without the establishment of the right at law, retained the bill for a year, to give the patentee an opportunity of establishing his right.(z)

33. The plaintiff must come at the earliest possible period to ask for an injunction. If he has been delayed by unavoidable circumstances, on the hearing, an injunction may be granted, and made perpetual, if none has been previously obtained.(a)

34. The sale or use of machines piratically made during the existence of the patent, will be restrained both before and after the term. The articles manufactured, and things used in the manufacture, may be ordered to be given up and destroyed.(b)

35. An account of the profits made by the wrongful use of the patented invention, will be granted. Considerable difficulties sometimes occur in taking it.(c) Lord Eldon stated in one case, that if there was an invincible difficulty in taking the account, the Court might send the case to a jury, to ascertain what damage the plaintiff had sustained.(d)

36. Where the defendants had sold the invention, making no profit of it, and not used it otherwise than by furnishing the patent burners to their customers, Lord Langdale thought the plaintiff not entitled to an account.(e)

37. An account of the profits made during the existence of a patent, [*190] has been ordered four years after the expiration of *a patent.(f) But it has been said, that an account will not be ordered unless an injunction is also granted (g)

38. If the defendant cannot deny the infringement, he should at once submit to the injunction, and offer to pay the costs of the suit up to that time. The plaintiff is not bound to be satisfied with an undertaking, but has a right to the protection of an injunction. If the defendant does not submit to these terms, the Court will give the plaintiff the costs of the suit to the hearing, and make the injunction perpetual.(h)

39. The affidavits used in moving for the injunction, should state the

(z) *Ward v. Key*, 10 Jurist, 792, Chy. (a) *Bacon v. Spottiswoode*, 1 Beav. 387.

(b) *Crossley v. Beverley*, 1 Russ. & Myl. 166; *Crossley v. Derby Gas Company*, 3 Myl. & Cr. 420; *MacRae v. Holdsworth*, 1 De Gex & Smale, 496.

(c) *Crossley v. Derby Gas Company*, 3 Myl. & Cr. 420, as to an account of the profits made by the use of a gas-meter. See ante, p. 160.

(d) Per Lord Eldon, 6 Ves. 706.

(e) *Bacon v. Spottiswoode*, 1 Beav. 387. See ante, p. 161.

(f) *Crossley v. Derby Gas Company*, Webst. P. C. 119.

(g) *Bailey v. Taylor*, 1 Russ. & Myl. 73.

(h) *Losh v. Hague*, Webst. P. C. 200; *Geary v. Norton*, 1 De Gex & Smale, 9; *Fradella v. Weller*, 2 Russ. & Myl. 247; *Stericker v. Matthews*, V. C. Turner, July 25, 1852.

belief of the patentee at the time of swearing it, that he was the true and first inventor. For though when he obtained the patent, he might very honestly have sworn to his belief of such being the fact, yet he may have since been convinced of the contrary. *(i)*

Accordingly where on a motion by the assignee of a patent for an injunction, neither the affidavits nor the bill stated the belief of the assignee at the time when he made the application, that the invention was new, the injunction was dissolved with costs. *(k)*

The affidavits should state particularly the facts which are relied on, as showing that an infringement has been committed. *(l)*

40. The Court will not make an order for costs where it is probable that proceedings may afterwards take place which would affect the decision of the Court on the question of costs. *(m)* It is the practice of courts of equity to make no order for the costs, except where the opposition is without foundation, until the hearing. *(n)*

41. Courts of common law, in dealing with questions of *in- [*191] junction, inspection, and account will probably regulate their practice by that which has hitherto been the practice of the Court of Chancery. Where the title of the patentee has already been established at law, or the patentee has had long and uninterrupted possession, they may sometimes grant interlocutory injunction before trial, especially where the circumstances of the defendant are such that a judgment for damages is not likely to be a sufficient remedy. If an injunction is refused, at any rate an order for an inspection and account may be obtained. Probably the proper course would be, to obtain a summons or rule in the alternative.

In *Howard v. Brown*, the first case under this section, it was ordered, that on notice being given to the defendant or his attorney, he should within four days show cause why he should not be enjoined not to make, use, exercise, or vend springs made in imitation of Woods's invention; why he should not furnish an account of all springs theretofore made by him in such manner, and keep an account of all springs thereafter to be made. The affidavits stated the plaintiff's title as assignee, the substance of the patent and specification, the belief of the plaintiff and different scientific persons that Woods, the patentee, who was dead, was the first inventor, the novelty of the invention, and the sufficiency of the specification. They referred to the springs of the plaintiff and defendant, which were in court, and stated that the defendant's springs were substantially the same as the plaintiff's.

It was suggested that the best course would be to follow the practice of the Court of Chancery, and receive affidavits in reply to the defendant's affidavits; that it would be a convenient course to grant the injunction

(i) *Hill v. Thompson*, 3 Mer. 622; *Webst. P. C.* 231, S. C.; *Neilson v. Thompson*, *Webst. P. C.* 276, n. 279, n.

(k) *Sturtz v. De la Rue*, 5 Russ. 522.

(l) *Hill v. Thompson*, 3 Mer. 622; *Webst. P. C.* 229.

(m) *Ward v. Key*, 10 Jurist, 792, *Wigram, V. C.*

(n) *Russell v. Cowley*, *Webst. P. C.* 471, *Lord Lyndhurst, C.*

ex parte on a prima facie case, and leave the defendant to move to dissolve it.(o)

Rules will probably be made on the subject.

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*CHAPTER XX.

FRAUDULENTLY USING THE NAME OR MARK OF PATENTEE.

1. It often happens that the goods of a particular manufacturer are ordinarily known in the trade by some figure, mark, or name, which he is in the habit of using. If another trader uses such a mark for the purpose of passing off his own goods as those of the man whose goods are well known by such mark, it is a fraud, for which an action for damages will lie at common law.(a)

Courts of equity will restrain such practises by injunction.(b) But where the manufacturer who complains of the use of his mark, adopted it for the purpose of deception, or has used a name he had no right to, courts of equity will not interfere.(c)

2. In addition to these remedies at common law, by stat. 5 & 6 Wm. 4, cap. 83, s. 7, it is enacted, that if any person shall put upon anything made, used, or sold by him, for the sole making or selling of which he has not obtained letters patent, the name, or any imitations of the name of any other person who has obtained letters patent for the sole making and vending of such thing, without leave in writing; or shall upon such thing, not having been purchased from the patentee or his licensee, or not having had the license or consent in writing of such patentee or his assigns, put the word "patent," the words "letters patent," or the words [*193] "by the king's *patent," or any words of the like kind, with a view of imitating 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, to be recovered by action of debt 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. Nothing therein contained is to 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 made, for the sole making or vending of which a patent before obtained shall have expired.

(o) Howard v. Brown, Q. B. Jan. 24, 1853.

(a) Rodgers v. Nowill, 5 C. B. 110; Crawshay v. Thompson, 4 M. & G. 357; Sykes v. Sykes, 3 B. & C. 541; Blofield v. Payne, 4 B. & Ad. 410.

(b) Ransome v. Bentall, 3 L. J. n. s. Chy. 161; Rodgers v. Nowill, 6 Hare, 325; Holloway v. Holloway, 13 Beav. 209; Millington v. Fox, 3 Myl. & Cr. 338; Motley v. Downman, 3 Myl. & Cr. 1.

(c) Perry v. Trucfitt, 6 Beav. 66; Pidding v. How, 8 Si. 477

3. An action has been held to lie against a person fraudulently representing that an exclusive right to manufacture a particular article, which he was then bringing into the market, was vested in other persons, with intent to prevent the plaintiff from manufacturing such article, and deprive him of the profits to be derived from such manufacture.(d)

*CHAPTER XXI.

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REMEDIES AGAINST PATENTEE.

Scire Facias to repeal Letters Patent.

1. THE writ of scire facias to repeal letters patent lies, in the ordinary course of justice, in three cases: First. When the king, by his letters patent, doth grant, by several letters patent, one and the same thing to several persons, the *former patentee* shall have a scire facias to repeal the second patent.

Secondly. When the king granteth anything 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 anything which by law he cannot grant, he, *jure regio*, for advancement of justice and right, may have a scire facias to repeal his own letters patent.(a)

The writ issues out of the common-law side of the Court of Chancery.

2. A writ of scire facias to repeal letters patent was formerly obtained upon a petition to the Crown, the prayer of which was grantable as of course, the petition being in the nature of a petition of right.(b) In *The Earl of Kent's* case, it is said that the petition is the original writ. The remedy to be obtained is the cancelling of the letters patent, after calling upon the patentee to show why the grant should not be repealed.

*The writ of scire facias was said to be founded on the record of the patent remaining in Chancery. [*195]

3. By stat. 15 & 16 Vict. cap. 83, s. 15, the writ of scire facias shall lie for the repeal of any letters patent issued under that Act, in the like cases as the same would lie for the repeal of letters patent which before that Act were issued under the Great Seal.

4. All parties are to have all their remedies by scire facias in Ireland, as if the letters patent had been granted to Ireland only.(c)

Nothing in the Act contained is to affect the jurisdiction or forms of proceeding in the courts of Scotland. When any proceedings shall require to be taken in Scotland to repeal any letters patent, such pro-

(d) *Barley v. Walford*, 9 Q. B. 197.

(a) 4 Inst. 88; *Rex v. Mussary*, Bull. N. P. 76, a; *Brewster v. Weld*, 6 Mod. 229; *Hunt v. Coffin*, Dyer, 197, b; *Penwarren v. Thomas*, Dyer, 198, a.

(b) 6 M. & G. 251, note to *Smith v. Upton*, citing *The Earl of Kent's* case, 21 E. 3, fol. 47, pl. 68. See further, *Webst. P. C.* 669, n.; 2 Wms. Saund. 72, w, note 4.

(c) Stat. 15 & 16 Vict. cap. 83, s. 29.

ceedings shall be taken in the form of an action of reduction at the instance of her Majesty's Advocate, or at the instance of any other party having any interest, with concurrence of her Majesty's Advocate, which concurrence her Majesty's Advocate is empowered to give upon just cause shown only. *(d)* In any proceedings in Scotland to repeal any letters patent, service of all writs and summonses is to be made according to the existing forms and practice. *(e)*

5. It is not necessary that the prosecutor in a scire facias should have any direct interest in the repeal of the patent. An alien may be the prosecutor.

An illegal monopoly is a public grievance, and the Crown having been informed of such a grievance, and having the power and duty to remove it, if it be such, ought not to be disabled from directing the necessary proceedings to ascertain the truth because the prosecutor is an alien, has no interest in the matter, or is endeavouring improperly to promote the interests of other people.

If there is reason to suspect collusion, the Attorney-General may stay the proceedings. *(f)* It has been said, that after one person has sued out a scire facias, another cannot *do so. *(g)* Instances to the contrary have occurred. Probably, pending one writ, the Attorney-General would not allow another to be issued or proceeded with.

6. By the Petty Bag Office Amendment Act, 1849, every solicitor of the Court of Chancery shall, by virtue of his admission, be an attorney of the Petty Bag. All proceedings which, before the passing of that Act, were conducted by the clerks of the Petty Bag as the attorneys for their clients, may now be taken by such client in his own proper person, or by his attorney. *(h)* The solicitor acting as an attorney on the common-law side of the Court of Chancery, is in all proceedings to be named and treated as the attorney of the party by whom he is retained. *(i)*

7. Any party changing, or ceasing to employ his attorney in the course of any action, &c., is to cause an entry of such change to be entered with the clerk of the Petty Bag, and to cause notice thereof to be served on every party to such proceeding. Until such entry and notice, the former attorney is to be deemed the attorney of the party. *(k)*

8. Attorneys are entitled to such costs for the transaction of business on the common-law side of the court, as are allowed to attorneys for business of a similar nature in her Majesty's superior courts of common law. *(l)*

9. Attorneys are to cause their names to be entered in a book at the

(d) Stat. 15 & 16 Vict. cap. 83, s. 43. *(e)* Stat. 15 & 16 Vict. cap. 83, s. 35.

(f) Reg. v. Prosser, 11 Beav. 306. See Sir Oliver Butler's case, 2 Vent. 344; 3 Lev. 221; Rex v. Wakelin, 1 B. & Ad. 50.

(g) Per Pollock, A. G. arg. Reg. v. Neilson, Webst. P. C. 673. See Hawk. P. C. Ch. 34; Com. Dig. Abatement, H. 24.

(h) Stat. 12 & 13 Vict. cap. 109, s. 24.

(i) Rules of the Petty Bag Office, 1849, rule 9.

(k) Rules of the Petty Bag Office, 1849, rule 10.

(l) Stat. 12 & 13 Vict. cap. 109, s. 25.

Potty Bag Office, with their addresses, at which pleadings, notices, and other proceedings may be left for, or sent to them.^(m) The omission of the entry of the name of the attorney in the book is not a thing which renders the proceedings void, though it may be ground for setting them aside as irregular.⁽ⁿ⁾

10. All persons who have any interest in the letters patent should be joined as defendants. Their names may be taken from the register of proprietors.^(o) The Crown has a right *to call on all the persons who obtained the patent to show cause why it should not be [*197] cancelled. The suggestion is, that the Queen has been deceived: the writ should call upon all those who are supposed to be guilty of the deception. A plea in abatement, by one of two defendants, that the other defendant had assigned all his interest to him, and that the action ought to have been brought against him alone, is bad.^(p)

It is said that if a defendant is prejudiced by the fact that a party having no interest is collusively joined as a co-defendant, an application may be made to the Court for its summary interference, as upon an abuse of process. It would seem that the person improperly joined might plead in abatement.^(q) So if the parties really interested in the patent are not made defendants.^(r)

Where judgment had already passed against the patent in a writ in which one party was defendant, a writ of scire facias called upon others to show why the patent should not be vacated as to them, and so far as their interests were concerned, and no objection was taken. In a subsequent case, the Court questioned the regularity of this course of proceeding.^(s)

11. The control of the proceedings in scire facias rests with the Attorney-General. In one case Lord Lyndhurst, on the application of the defendant, ordered an application to stay the proceedings in scire facias to stand over till after the decision of an appeal to the House of Lords from the Court of Session of Scotland, in which the validity of the patent would be determined.^(t)

But in a subsequent case, Lord Langdale said, "That the Lord Chancellor acting as a judge, had no power to interfere with the discretion of the Crown. He might suggest to the Attorney-General the propriety of considering the circumstances of the case, and stay the proceedings, to give him an opportunity of doing so, but could not overrule his decision when formed. The Attorney-General might enter a nolle prosequi, and determine on what conditions the action should *be prosecuted; but he would not be permitted to prosecute an action if merely [*198] vexatious, and without any legal object."^(u)

In a recent case, the Attorney-General (Sir F. Pollock,) on a petition for relief against certain suggestions in a writ of scire facias, which had

(m) See 12 & 13 Vict. cap. 109, s. 44.

(n) In re Baddley, 4 Exch. 508.

(o) Stat. 15 & 16 Vict. cap. 83, s. 35.

(p) Reg. v. Betts and Stocker, 15 Q. B. 540; S. C. 14 Jurist, 912.

(q) See Com. Dig. Abatement, F. 14.

(r) Com. Dig. Abatement, F. 4.

(s) See Reg. v. Hamilton, cited Bynner v. Reg. 15 Q. B. 544.

(t) Reg. v. Neilson, Webst. P. C. 665.

(u) Reg. v. Prosser, 11 Beav. 306; 18 L. J. n. s. Chy. 35; 13 Jurist. 71 S. C.

issued regularly, decided that he would direct a *nolle prosequi* to be entered to some of the suggestions in the writ; if the prosecutor insisted on retaining them. (x)

12. According to the present practice, the draft of the writ—having been settled by the counsel for the prosecution, with a short statement of any legal proceedings that have taken place with respect to the patent, that the amount of security may be fixed, and the names of the two sureties for the bond—must be taken to the Attorney-General, who thereupon subscribes his fiat.

Forms of writs may be found—Tidd's Forms, p. 446; Abbott's Forms of Writs on the Common Law Side of the Court of Chancery, p. 97. It will be necessary to observe, that if the *scire facias* is to repeal letters patent granted under the provisions of stat. 15 & 16 Vict. cap. 83 the words referring to the enrolment of the letters-patent in Chancery, must be omitted. Forms of suggestions will be found in Reg. v. Cutler, 3 Car. & K. 216; Reg. v. Bynner, 9 Q. B. 525; Reg. v. Mill, 10 C. B. 380. As to the degree of particularity required—Rex v. Arkwright, Dav. P. C. 51. See Dyer, 198.

A caveat may be entered at the chambers of the Attorney-General against the issuing of the writ, upon which notice will be given of the application for it, and the parties will come before him. (y)

13. Formerly a memorial was presented to the Crown for a *scire facias*, and a warrant issued to the Attorney-General for issuing it out. The Attorney-General then granted his fiat. This practice has been abandoned, but at what period, or on what grounds, has not been noticed in any of the books of practice. (z)

[*199] The fiat of the Attorney-General is necessary, whether the writ issues *ex debito justitiæ*, or not. The writ does not issue as of course in any case.

14. It was said formerly, that any one prejudiced by the granting of letters patent, was entitled to a *scire facias* as a matter of right, and therefore without conditions. (a)

By the Rules of practice in the Petty Bag Office, made in pursuance of the forms of stat. 12 & 13 Vict. cap. 109, s. 41, a writ of *scire facias* to revoke letters patent, is not to be sealed—

First. Until the fiat of the Attorney-General is filed in the Petty Bag Office.

Secondly. Until the name of one of the superior courts of common law is indorsed or written thereon.

Thirdly. Until a true copy of the writ, and of any drawings or plans annexed thereto (to be verified by affidavit), has been filed in the Petty Bag Office. (b)

The name and address of the attorney or party suing out the writ, must be indorsed on the writ and copy. (c)

(x) Reg. v. Newall, Webst. P. C. 671, n.

(y) Webst. P. C. 671, note h.

(z) Webst. P. C. 669, n.; 2 Wms. Saund. 72, u, note 4.

(a) 9 Q. B. 547, per Hill, arg.; Brewster v. Weld, 6 Mod. 229, ante, 194.

(b) Rules of Practice in the Petty Bag Office, 1849, rule 14.

(c) Abbott, Forms of Writs in the Petty Bag Office, Introduction.

15. A bond of indemnity against costs to be incurred in the prosecution of an action of scire facias, may (if so desired by the Attorney-General) be taken in the name of the clerk of the Petty Bag; but the same is not to be deposited or filed in the office of Petty Bag, unless the intended obligors, and the sums for which they are to give security, be named by the Attorney-General. *(d)*

The penal sum in the bond is usually £1,000, but it may be a larger sum if the Attorney-General think fit. See the form of bond and condition—Abbott's Forms of Writs in the Petty Bag Office, p. 921; 4 Beav. 314.

16. The bond of indemnity filed or deposited in the Petty Bag Office, may, at the request of the Attorney-General, be put in suit under such terms and conditions as the Lord Chancellor or Master of the Rolls may approve of. *(e)*

The enforcement of the bond is subject to the discretion of the Lord Chancellor or Master of the Rolls, and the Attorney-General, who will exercise a proper discretion upon it. Where a prosecutor persisted in proceeding with a scire facias, *after a defective patent had been cured by a disclaimer, the Court caused the bond to be put in suit [*200] for all costs subsequent to the entry of the disclaimer, deducting those previously incurred. *(f)*

17. The writ is to be sealed with the Chancery common seal. *(g)*

It may be issued and tested on any day, not being Sunday, Good Friday, or Christmas-day, either in term or vacation. *(h)* It must be tested on the day when it is sealed; *(i)* and indorsed with the name and address of the attorney or party suing it out. *(j)*

18. All proceedings may be taken either in term-time or vacation, on any day, not being Sunday, Good Friday, or Christmas-day. *(k)* Before the passing of this Act, proceedings must have been taken in term. *(l)*

The writ may be made returnable on any day certain to be mentioned in the writ, not being Sunday, Good Friday, or Christmas-day, whether in term-time or vacation, or forthwith after the execution thereof. *(m)*

If not executed, it must be lodged with the proper officer at least two days before it is returnable; and no alias sci. fa. shall be issued before the first sci. fa. shall be issued, lodged, and returnable as aforesaid. *(n)*

19. It may be directed to the sheriff of any county in England or Wales. *(o)*

By stat. 15 & 16 Vict. cap. 83, s. 35, any writ of scire facias to repeal letters patent, may be issued to the sheriff of the county or counties in

(d) General Rules as to proceeding in the Petty Bag, 1849, rule 17.

(e) *Ib.* rule 18.

(f) Reg. v. Mill, 14 Beav. 314. See in that case the form of condition and fiat of the Attorney-General.

(g) 12 & 13 Vict. cap. 109, s. 14.

(h) 12 & 13 Vict. cap. 109, s. 26.

(i) Rules of the Petty Bag Office, 1849, rule 6.

(j) Abbott's Forms of Writs on the Common Law Side of the Court of Chancery, Introduction.

(k) 12 & 13 Vict. cap. 109, s. 28.

(l) Ex parte King, 1 Sanders' Orders in Chancery, 355.

(m) 12 & 13 Vict. cap. 109, s. 27.

(n) 1 Sanders, Orders in Chancery, 443, 444.

(o) 12 & 13 Vict. cap. 109 s. 29.

which the grantee or grantees resided at the time when the said letters patent were granted; and in case such grantee or grantees do not reside in the United Kingdom, it shall be sufficient to file such writ *in [*201] the Petty Bag Office, and serve notice thereof in writing at the last known residence or place of business of such grantee or grantees.

20. If the sheriff warns the defendant, he returns scire facias. (*p*)

The defendant is generally served with a copy of the sheriff's warrant, which recites the writ of scire facias; or at least, has some notice of the proceedings given to him. (*q*)

It is said that where the sheriff returns scire feci, the Court will not inquire into the validity of the summons on motion, but leave the party to his action against the sheriff for a false return. (*r*)

Personal service of the writ seems not necessary. If the defendant is abroad, it seems sufficient if he has reasonable notice of the proceeding. (*s*)

If the sheriff does not warn the defendant, he returns nihil, in which case an alias scire facias issues. If the sheriff return nihil to the second writ, and the defendant does not appear, there shall be judgment against him. (*t*)

Where the defendant is prevented from pleading by the plaintiff's procuring two nihils to be returned, the Court will relieve him on motion. (*u*)

An audita querela will not lie against the Crown. (*v*)

21. When the writ is returned by the sheriff, it is to be immediately filed, and the day and hour of filing are to be indorsed upon the writ. (*w*)

Upon the return of the writ, it is the practice to enter a rule to answer. It seems that judgment signed without entering such rule might be set aside. (*x*)

22. An appearance is to be entered by or on behalf of any defendant who has been summoned by the sheriff, within eight days after the writ of scire facias has been returned and filed. (*y*)

*If the defendant does not appear, judgment shall go against [*202] him by default, and the patent will be avoided. (*z*)

23. As soon as the defendant has appeared, the declaration may be delivered to the defendant or his attorney. (*a*)

Forms of declaration may be found in Abbott's Forms of Writs on the Common Law Side of the Court of Chancery, p. 97, form 90; Tidd's Forms, &c.

(*p*) Tidd's Practice, 1092.

(*q*) 2 Wms. Saund. 72, *y*, note to Underhill v. Devereaux, *ib.* 72, *e e*.

(*r*) 2 Wms. Saunders, 72, *y*, citing Barr v. Satchwell, 2 Stra. 813. See, however, Pool v. Wills, 2 T. R. 758; Webb v. Harvey, *ib.* 757.

(*s*) Weatherhead v. Sanders, 3 Scott, 407; 5 Scott, 189.

(*t*) Rex v. Eston, Dyer, 198, *a*.

(*u*) Holt v. Frank, 1 M. & S. 199; 2 Wms. Saund. 72, *e e*; Sampson v. Collingwood, 1 Salk. 262; Ludlow v. Lennard, 2 Ld. Ray. 1295.

(*v*) Manning's Exchequer Practice, 617.

(*w*) Rules of Practice in the Petty Bag, 1849, rule 7.

(*x*) Rex v. Newcastle-upon-Tyne, 1 Sanders' Orders in Chancery, 390.

(*y*) Rules of Practice in the Petty Bag, 1849, rule 19.

(*z*) Vin. Abr. Prerog. x. 6; Bro. Ab. Patents, 20; Rex v. Toly, Dyer, 197, *b*; Rex v. Blage, *ib.*; Rex v. Eston, *ib.* 198, *a*; Penwarren v. Thomas, *ib.*; Vin. Ab. Sci. Fa. 9, pt. 3; Rex v. Amery, 2 T. R. 515, 554, 567.

(*a*) Stat. 12 & 13 Vict. cap. 109, s. 30,

The prosecutor with his declaration is to deliver particulars of the objections on which he means to rely. At the trial, no evidence shall be allowed to be given which shall not be contained in the particulars.^(b) As to the particulars of objection, see ante, 169—174.

24. It appears that by the practice of the Court, the defendant has eight days' time to plead after the delivery of the declaration. No rule to plead is requisite.

If the defendant does not plead at the expiration of the eight days, judgment by *nil dicit* may be signed against him, and the patent will be avoided.^(c)

The defendant may obtain time to plead on application to the Master of the Rolls or a judge of a court of common law.^(d)

25. The defendant may plead in abatement^(e) or in bar, or may demur to the declaration, or to each suggestion in it; or he may demur to some of the suggestions, and plead to others. But as the Crown is not bound by the stat. 4 & 5 Anne, cap. 16, the defendant cannot plead several matters.^(f)

In a case where the defendant pleaded several matters, Lord Langdale made an order setting aside the pleas with costs, for irregularity.^(g) Defendants may sever in pleading, one demurring and the other pleading; and in such case *the Attorney-General may try which issues he pleases first.^(h) [*203]

26. Every demurrer, plea, and subsequent pleading, shall be delivered by the party demurring or pleading, or his attorney, to the opposite party or his attorney; and the issue shall be made up by either party or his attorney, and delivered to the opposite party or his attorney.⁽ⁱ⁾

The form of issue may be seen—Abbott's Forms of Writs, p. 95.

27. Notice of trial must be indorsed on the issue. The same number of days' notice is to be given as in the common law courts in ordinary cases.^(k) See stat. 15 & 16 Vict. cap. 76, s. 97.

28. The Chancellor, though a common law judge, has no power to summon a jury. Therefore, if there are issues in fact, the Court of Chancery cannot try the issues, but the Lord Chancellor delivers the record by his proper hands into the common law court, the name of which is indorsed on the writ to be tried there.^(l)

If there be issues in law and fact, the whole record must be sent into the court of common law;^(m) for there cannot be a judgment of the Chancellor upon one part of the record, and a judgment of the court of common law upon another part of the same record.

(b) Stat. 15 & 16 Vict. cap. 83, s. 41.

(c) *Hunt v. Coffin*, Dyer, 197, b. (d) Stat. 12 & 13 Vict. cap. 109, s. 39.

(e) *Rex v. Hare and Mann*, 1 Stra. 146; *Reg. v. Betts and Stocker*, 15 Q. B. 547.

(f) *The King v. Archbishop of York*, Willes, 533.

(g) *Reg. v. Nickels*, Hindmarch on Patents, 400, 430.

(h) *Rex v. Hare and Mann*, 1 Stra. 260.

(i) Stat. 12 & 13 Vict. cap. 109, s. 31. (k) Abbott, Forms of Writs, &c. 104.

(l) See 4 Inst. 80; *Smith v. Upton*, 6 M. & G. 253, n.; 12 & 13 Vict. cap. 109, s. 32.

(m) *Jefferson v. Morton*, 2 Saund. 23. See a query, note to *Smith v. Upton*, 6 M. & G. 258.

Where there are several defendants, and some of them plead to issue, and the others demur, the whole record must come to the court of common law, which shall give judgment both on the verdict and demurrer.⁽ⁿ⁾

Where there is a demurrer only, it has sometimes been the practice to [*204] determine it in the Court of Chancery, without transmitting it into the Court of Queen's Bench.^(o) But *although it is the practice to adjudge demurrers in law joined in Chancery before the Lord Chancellor, yet the Court of Chancery may, if it will, adjourn any cause either before or after demurrer or issue joined.^(p)

29. In case issue is joined respecting any matter of fact, to be tried by the country, the record shall be made up and filed in the office of the Petty Bag; and the issue may be tried either in the Queen's Bench, Common Pleas, or Exchequer of Pleas.^(q) The trial is to take place in the court, the name of which is indorsed on the writ.^(r) See form of record of issue—Abbott's Forms of Writs, p. 104, form 97.

30. The writ of *venire facias* was formerly issued out of the Petty Bag Office.^(s) It was returnable and returned in the court in which the issue was to be tried.^(t) (See Abbott's Forms, p. 105.) It seems no longer necessary since stat. 15 & 16 Vict. cap. 76, s. 104. It may be prudent to retain it as an instruction, till some decision has taken place on the point.

31. A transcript of the record containing the issue, shall be taken or sent into the court in which the issue is to be tried.^(u) It is delivered out to the attorney of the party, and taken by him into the court of common law.

The transcript is sealed with the Chancery common-law seal. This transcript is filed: if sent to the Queen's Bench, in the Crown Office. Another record, setting out the Chancery record, is then to be prepared, and the cause set down in the common law court in the usual manner.^(x) See forms—Abbott's Forms of Writs, pp. 104, 105. See stat. 15 & 16 Vict. cap. 76, s. 102. See forms of record of *Nisi Prius*—Abbott's Forms of Writs, pp. 104, 105; Corner's Crown Practice, App. pp. 99, 128. The venue must be laid in Middlesex.

[*205] 32. Upon the transcript of the record being brought into *the court of common law, the Court may proceed to try the issue, either at Bar or at *Nisi Prius*, as such Court shall think fit.^(y)

Since the passing of this Act, the Attorney-General's warrant seems not necessary, to enable the prosecutor to have a writ of *nisi prius* in a

(n) *Jefferson v. Morton*, 2 Saund. 23; *Jefferson v. Dawson*, 1 Sid. 437.

(o) *The King v. Butler*, 3 Lev. 220; *Vin. Ab. Prerog. T. b. pl. 21*; *Sir Oliver Butler's case*, 3 Vent. 344; *Vin. Ab. Prerog. T. b. pl. 4, n.*; *The King v. Knox*, G. Coop. 98.

(p) *Jefferson v. Morton*, 2 Saund. 23, Acc.; *Reg. v. Betts*, 15 Q. B. 540; *Jefferson v. Dawson*, 1 Sid. 437; *Rex v. Hare*, 1 Stra. 146.

(q) Stat. 12 & 13 Vict. cap. 109, ss. 32, 33.

(r) Rules of the Petty Bag Office, 1849, rule 16.

(s) Abbott's Forms, 105; *Reg. v. Aires*, 10 Mod. 259.

(t) 12 & 13 Vict. cap. 109, s. 32.

(u) Stat. 12 & 13 Vict. cap. 109, s. 32.

(x) Abbott's Forms of Writs, 105.

(y) Stat. 12 & 13 Vict. cap. 109, s. 32.

scire facias to repeal a patent.^(z) However, it appears to be still the practice to obtain it. The record need not be sealed or passed.

33. In case any issue in law, or in fact and law, shall be joined, the record of such issue or issues shall be made up and filed in the office of the Petty Bag; and a transcript of the record shall, or may be, sent into one of the superior courts of common law, who may hear and determine the same.^(a)

34. The superior courts of common law, and the judges thereof respectively, are to have the same powers in respect of the transcript of any record, and the pleadings, issues, and matters therein contained, as they would have with respect to the record in any action commenced and pending in such court.^(b)

35. The action being on a record, must be tried in Middlesex.^(c) The issues may be tried either by a special or common jury. The provisions of the Common Law Procedure Amendment Act as to juries and jury process appear to apply to the trial of issues in scire facias. The Attorney-General's warrant for a tales should be obtained.^(d) If no tales is prayed, and the cause goes off for want of a jury, neither party is liable to pay costs.^(e) If the prosecutor does not proceed to trial according to notice, he will have to pay costs.^(f)

36. The form of a subpoena ad testificandum may be seen Corn. Cro. Pr. App. 198. It will be proper to give notice to admit any documents proposed to be adduced in evidence, *though the statutes and [*206] rules of court relating to notices to inspect and admit, do not apply to proceedings at the suit of the Crown. The court of common law may issue a commission to examine witnesses.^(g)

If the prosecutor is guilty of delay in carrying the cause to trial, an application should be made to the court.^(h)

37. On the trial of any proceedings in scire facias, the defendant is entitled to begin and give evidence in support of the letters patent; and in case evidence shall be adduced on the part of the prosecutor impeaching the validity of the letters, the defendant shall be entitled to the reply.⁽ⁱ⁾ The burden of proof is apparently not affected by this enactment. The onus of proving the truth of the suggestions in the scire facias will still lie upon the prosecutor. If the jury find that the case is left in doubt, they must find a verdict for the defendant.^(k)

38. It has been doubted whether a defendant is entitled to tender a bill of exceptions, the king not being named in the statute of Westminster. There are several instances in which it has been allowed.^(l)

(z) See *Rex v. Archbishop of York*, Willes's Reports, 535; 2 Inst. 424; *Rex v. Astry*, 6 Mod. 123. See *Rex v. Wright*, 1 A. & E. 434.

(a) Stat. 12 & 13 Vict. cap. 109, s. 33. (b) Stat. 12 & 13 Vict. cap. 109, s. 34.

(c) 2 Chit. Pl. 337. (d) Corn. Cro. Pr. 142; 2 Hawk. P. cap. 41, s. 18.

(e) *Rex v. Righton*, 3 Burr. 1695.

(f) Corn. Cro. Pr. 141; *Rex v. Bartrum*, 8 East, 269; *Rex v. Waring*, 5 T. R. 454.

(g) *Hargrave v. Hargrave*, 4 C. B. 654; *Bourdeaux v. Rowe*, 1 B. N. C. 721.

(h) *Rex v. Dyde*, 7 T. R. 661; *Rex v. Macleod*, 2 East, 202; *Rex v. Masters*. Parker, 51; *Rex v. Banks*, 6 Mod. 247.

(i) Stat. 15 & 16 Vict. cap. 83, s. 41. (k) *Reg. v. Cutler*, 3 Car. & K 229.

(l) Willes's Reports, 535, and cases cited in note, ib.; *Reg. v. Cutler*, 3 Car. & Kir. 229.

New trials may be granted. If the trial is had in vacation, motions for new trials must be made within the first four days of term.^(m) After verdict for the Crown, a new trial may be ordered on payment of costs.⁽ⁿ⁾

39. Stat. 15 & 16 Vict. cap. 109, s. 32, directs that a transcript of the record shall be sent into the court of common law; the old forms stated, that the Chancellor delivered a record. The transcript seems a sufficient record to enable the court of common law to give judgment.^(o) There is a difference of opinion, whether judgment should be given in [*207] *the court to which the record is sent, or whether the record is to be remanded into Chancery for final judgment.

40. Where the judgment of the court of common law is in favour of the patentee, it is the practice to enter up final judgment for the patentee in the court of common law, because nothing remains to be done in the Court of Chancery. Judgment was so entered in *The Queen v. Mill*.

41. When judgment is given for the Crown, final judgment may be given in the Court of Queen's Bench to cancel the patent, though the letters patent remain in the Court of Chancery. The Court has authority to award the judgment, and afterwards to transmit either the record or the terms thereof to the Court of Chancery, to be fully carried into execution.^(p) The cancellation of the letters patent has been said to be a mere ministerial act. But it seems to be doubted, whether the Lord Chancellor would consider it as such.^(q)

In *Corner's Crown Practice*, it is stated, that interlocutory judgment is signed in the Court of Queen's Bench, and that final judgment is given in Chancery upon the record being sent back after the issues have been tried. It is there said not to have been the practice to give judgment in the Queen's Bench.^(r) In *The Queen v. Steiner*, an entry was made upon the record, that it did not belong to the Court of Queen's Bench to give judgment, and the record was transmitted to the Court of Chancery, and final judgment given there. In *The Queen v. Nickels*, the record of the verdict was sent out of the Queen's Bench into Chancery, and judgment given for the Crown there, to revoke and cancel the patent, and cancel the enrolment. A writ of error was afterwards brought in the House of Lords, but the want of authority of the Court of Chancery to [*208] give judgment, was not assigned as a ground of *error.^(s) The statute enacts, that the superior courts of common law are to have the same power as the Court of Queen's Bench had; "but nothing

(m) *Rex v. Macleod*, 3 Price, 203.

(n) *Rex v. Bewdley*, 1 P. Wms. 207; *Hullock on Costs*, 396.

(o) *Bynner v. Reg.* 9 Q. B. 551, *Tindal, C. J.*; *Reg. v. Bynner*, 9 Q. B. 529.

(p) *Bynner v. The Queen*, 9 Q. B. 523; *Rex v. Aires*, 10 Mod. 258, 354. See *The Baron de Bode's case*, 8 Q. B. 208; *The Baron de Bode v. The Queen*, 13 Q. B. 380; *Tidd's Practice*, 1095; *Rex v. Arkwright*, Dav. P. C. 144; *Webst. P. C.* 74; *Jefferson v. Morton*, 2 Saund. 6 a, 27; 1 Eq. Ca. Ab. 128; note to *Smith v. Upton*, 6 M. & G. 256.

(q) Cancelling the king's letters patent under the great seal is said to be the highest point of the Lord Chancellor's jurisdiction, 4 Inst. 88.

(r) *Corner's Crown Practice*, 252. See contra, *Tidd's Practice*, 1095.

(s) *Reg. v. Nickels*, *Hindmarch on Patents*, 419; *Corner's Crown Practice*, 202.

is to authorize the giving final judgment in any case in which the Court of Queen's Bench had not such authority."(*t*)

The superior courts of common law are to give judgment, and execute judgment, as the Court of Queen's Bench might have done.(*u*)

42. Judgment in the case of *The Queen v. Bynner* was signed and entered in the following manner. Interlocutory judgment was entered in a book at the Crown Office, and signed by one of the masters on the *Nisi Prius* record; the continuance(*x*) and verdict, together with a judgment thereon, which was drawn and settled by counsel, were entered by the attorney on the Queen's Bench roll, and a transcript was then made and returned into the Court of Chancery; the original Queen's Bench roll remaining in that court.(*y*)

43. Upon the trial or determination of any issue in any of the superior courts of common law, or upon any rule or order being made, or judgment given in any action, suit, or proceeding, in which the transcript of the record shall be brought before them, a transcript of such judgment, rule, or order, and of the proceedings of the court of common law upon such issues, shall be taken into the Court of Chancery, to the end that judgment may be given, or such other proceedings had in Chancery, according to the law and custom of England; and no writ shall be necessary to remand the transcript.(*z*)

44. The clerk of the Petty Bag, upon receiving the return of the transcript of the verdict of the jury, and proceedings or judgment of any court of common law upon any issue in law or in fact, is to file the same in the Petty Bag Office, and *is to cause an entry to be made of [*209] such verdict and proceedings or judgment, and such transcript is to be annexed to the original record in the Petty Bag Office; and thereupon the judgment of the Court of Chancery is to be entered on or annexed to the same record, in conformity with the judgment of the court from which the transcript is returned.(*a*)

45. The judgment of the Court of Queen's Bench may be, that the letters patent be revoked, cancelled, vacated, disallowed, annulled, and held void, and that the enrolment be cancelled and annulled, and that the letters patent be restored into the Court of Chancery, there to be cancelled.(*b*)

46. The king's warrant for a *scire facias* used to recite that it would be in the king's power, after conviction, to suspend the entry of any judgment to vacate the patent.(*c*) The case of confirmation after verdict is specially provided for by stat. 5 & 6 Wm. 4, cap. 83, s. 2. After verdict for the Crown, if the defects in the patent or specification can be cured by disclaimer or confirmation, the defendant may apply to the

(*t*) Stat. 12 & 13 Vict. cap. 109, s. 34. (*u*) Stat. 12 & 13 Vict. cap. 109, s. 35.

(*x*) See *Corn. Cro. Pr.* 145; a form, *ib.* App. 104; 2 *Wms. Saund.* 300, note 3, 253; note 8; *Tidd's Practice*, 778. See 15 & 16 Vict. cap. 76, s. 104.

(*y*) *Reg. v. Bynner*, *Corn. Cr. Pr.* 202. (*z*) Stat. 12 & 13 Vict. cap. 109, s. 36.

(*a*) General Rules of the Court of Chancery as to Petty Bag Office, 1849, No. 9.

(*b*) *Bynner v. The Queen*, 9 *Q. B.* 523. See 4 *Inst.* 88.

(*c*) 2 *Rich. C. P.* 392, 394, cited 9 *Q. B.* 532.

Court to suspend its judgment, or to the Attorney-General to stay the proceedings, to enable him to disclaim or obtain confirmation.^(d)

47. It has been held that the patent is not effectually and finally destroyed by surrender, unless there is an actual surrender or cancelling, and a vacatur of the enrolment entered.^(e)

In *The Queen v. Newton*, the defendant being unable to bring the patent into court to be cancelled, being merely the trustee of the person in possession of it, who resided abroad, was excused from producing it in obedience to the judgment, on undertaking not to assign the patent, or bring any writ of error.^(f) The enrolment was ordered to be cancelled, and a vacatur entered upon the roll.

[*210] *After verdict and judgment for the Crown, an application was made in pursuance of leave given, that certain letters patent granted to the defendant might be restored into Chancery, and that the letters patent and the enrolment thereof might be cancelled and vacated; and that in default of producing the letters patent, the defendant might be committed for contempt. The Lord Chancellor ordered the clerk of the Petty Bag formally to call upon the defendant to produce the letters patent. The officer thereupon three times called upon the defendant to appear and produce the letters patent; the defendant, however, did not appear. The Lord Chancellor ordered an entry of the defendant's default to be made. He doubted whether the judgment obtained in favour of the Crown, was a sufficient ground to enable the Court to make the order sought, or that, in the first instance, the enrolment of the letters patent should be vacated, in the absence of the letters patent themselves. He said, the defendant should not be allowed to evade the power of the Court by withholding the letters patent; and made an order that the defendant should show cause on a day named, why, in default of production of the letters patent, the enrolment should not be vacated, and an attachment issue for the commitment of the defendant. The patent being afterwards brought into court, was ordered to be cancelled, and the enrolment vacated.^(g)

48. For errors in law in the judgment of the Court of Chancery in the Petty Bag Office, error lies to the House of Lords.^(h) A form of writ of error may be found in *Abbott's Forms*, p. 45. The fiat of the Secretary of State for the writ must be obtained. For errors in the judgment of the Queen's Bench, the writ of error lies to the Exchequer Chamber.⁽ⁱ⁾

49. Before 1849, interlocutory matters in proceedings in the Petty Bag Office, before the transmission of the record into the Court of Queen's Bench, were heard before the Master of the Rolls.

(d) 9 Q. B. 547, *Bynner v. The Queen*, Tindal, C. J. See *Reg. v. Bynner*, note to *Smith v. Upton*, 6 M. & G. 260.

(e) *Sir Robert Sidnie's case*, Dyer, 167, a; *Sir T. Wroth's case*, ib.; *Kemp v. Makewilliams*, Dyer, 195, a; *Com. Dig. Patent*, E. G.

(f) *Reg. v. Newton*, *Hindmarch on Patents*, 426; 5 *Law Times*, 261; S. C. cited 9 Q. B. 528.

(g) *Reg. v. Steiner*, 18 *Law Times*, Chy. 267.

(h) Note to *Smith v. Upton*, 6 M. & G. 257.

(i) See *Bynner v. The Queen*, 9 Q. B. 523.

In every action, suit, and proceeding in the Court of Chancery *on the common-law side, the courts of common law, and [*211] the judges thereof, are to hear and determine all such matters and applications, and do all things which before the passing of the Act might have been decided and ordered by the Lord Chancellor and Master of the Rolls, subject to the laws and rules in force for the regulation of the Court and the practice thereof. (k) The jurisdiction of the Chancellor and Master of the Rolls is not affected. (l)

Such applications *may* therefore be disposed of either by the Master of the Rolls or the Court, or a judge of the court the name of which is indorsed on the writ of scire facias.

But it seems that if an application be made to the Master of the Rolls, in a matter properly within the cognizance of a court of common law, he would either adjourn the case to the court of common law, or refuse to entertain the application altogether. (m)

50. Affidavits to be used in the Court of Chancery on the common-law side, may be sworn before the clerk of the Petty Bag. (n) By the rules of the court, affidavits, affirmations, and declarations to be used in any proceeding in the common-law side of the Court of Chancery, are to be sworn, affirmed, or declared before the clerk of the Petty Bag, or before a Master Extraordinary in Chancery, and are to be filed in the office of the Petty Bag. (o)

51. No costs are recoverable as part of the judgment by the prosecutor. (p) The defendant is entitled to costs according to the condition of the bond required from the prosecutor by the Attorney-General. Costs are sometimes given upon interlocutory proceedings. (q) In *Reg. v. Crawford*, the defendant having appealed against an order of Lord Langdale, setting aside his pleas with costs, the Lord Chancellor refused the motion, but directed that, on payment of the costs of that *appli- [*212] cation, the defendant should be at liberty to plead de novo. A new trial may be granted on payment of costs. (r) In all cases where any party shall be entitled to the costs of any issues or proceedings in any court of common law, the costs shall be taxed by one of the Masters of the court, who shall indorse his allocatur on the rule or order as the case may be, or upon the *postea* before the same shall be taken or returned into the Court of Chancery. (s)

The costs of proceedings in the Court of Chancery or the Petty Bag are taxed by the clerk of the Petty Bag.

(k) Stat. 12 & 13 Vict. cap. 109, s. 39. (l) Stat. 12 & 13 Vict. cap. 109, s. 45.

(m) See *In re Baddeley*, 4 Exch. 508. See also *Montgomery v. Blair*, 2 Sch. & Lef. 136.

(n) Stat. 12 & 13 Vict. cap. 109, s. 45.

(o) General Rules of Practice in the Petty Bag, 1849, rule 5.

(p) *Rex v. Miles*, 7 T. R. 367.

(q) *Hindmarch on Patents*, 430, citing *Reg. v. Nickels*, *Reg. v. Crawford*.

(r) *Hullock on Costs*, 396.

(s) Stat. 12 & 13 Vict. cap. 109, s. 37.

APPENDIX.

FORMS.

1.—PETITION.^(a)

To the Queen's Most Excellent Majesty.

The humble petition of [here insert name and address of petitioner] showeth, that your petitioner in possession of an invention for [the title of the invention] which invention believe will be of great public utility; that^(b) [he is the true and first inventor thereof; he acquired the same by means of a communication made to him by a certain person residing abroad, &c.; or the like] and that the same is not in use by any other person or persons to the best of knowledge and belief.

Your petitioner therefore humbly prays, that your Majesty will be pleased to grant unto his executors, administrators, and assigns, your royal letters patent for the United Kingdom of Great Britain and Ireland, the Channel Islands, and the Isle of Man, for the term of fourteen years, pursuant to the statutes in that case made and provided.

And your petitioner will ever pray, &c.

[The name and address of the petitioner, and the title of the invention, to be written very legibly. The petition must be impressed with a stamp of £5.]

[*216]

*2.—DECLARATION.

I, _____, of _____, in the county of _____, do solemnly and sincerely declare that _____ in possession of an invention for [the title as in

(a) The necessary forms, on paper of the proper size and description can be had in any quantity of Messrs. Sackett and Ruscoe, 8, Quality-court, Chancery-lane.

(b) The words in the Act are, "that I am the first and true inventor," which must be used when not a communication.—See *Nickels v. Ross*, 8 C. B. 679. If patented abroad, it should be so stated.

petition] which invention believe will be of great public utility; that I am the true and first inventor thereof [or otherwise, as the case may be], and that the same is not in use by any other person or persons to the best of knowledge and belief;(c) and make this declaration conscientiously believing the same to be true, and by virtue of the provisions of an Act made and passed in the session of Parliament held in the fifth and sixth years of the reign of his late Majesty King William the Fourth, intituled "An Act to repeal an Act of the present session of Parliament, intituled 'An Act for the more effectual abolition of oaths and affirmations taken and made in various departments of the state, and to substitute declarations in lieu thereof, and for the more entire suppression of voluntary and extra-judicial oaths and affidavits, and to make other provisions for the abolition of unnecessary oaths.'"

* (d)

Declared at _____, this _____ day of _____, in the year of our Lord 185 _____, before me,

3.—DECLARATION WHEN COMPLETE SPECIFICATION IS DEPOSITED.

The same as the preceding, but at the (c), after the word belief, insert, "And that the instrument in writing, under my hand and seal hereunto annexed, particularly describes and ascertains the nature of the said invention, and the manner in which the same is to be performed."

*4.—PROVISIONAL SPECIFICATION. [*217]

I, [or we] _____ do hereby declare the nature of the said invention for [here insert title] _____ to be as follows: [here insert description].

Dated this _____ day of _____, A. D. _____.

[To be signed by the applicant or his agent.]

[Indorse the name of the petitioner or his agent.]

5.—CERTIFICATE OF RECORD OF PETITION, DECLARATION, AND PROVISIONAL SPECIFICATION.

Patent Law Amendment Act, 1852.

This is to certify, that the petition, declaration, and provisional of spe-

(c) The old form was, "hath not been practised or used by any person within this realm." If patented or in use abroad, it should seem that it should be so stated.

(d) To be signed by the party making the declaration, where the asterisk is placed, and to be declared before a master in Chancery or justice of the peace.

cification of _____, applying for letters patent for the invention of _____, have been this day left and recorded in the office of the Commissioners of Patents for Inventions.

Dated this _____ day of _____, 185 .

6.—CERTIFICATE OF RECORD OF PETITION, DECLARATION AND COMPLETE SPECIFICATION.

Patent Law Amendment Act, 1852.

This is to certify, that the petition and declaration of _____, applying for letters patent for the invention of _____, have been this day left and recorded in the office of Commissioners of Patents for Inventions, and the complete specification accompanying such petition and declaration has been filed in the said office.

Dated this _____ day of _____, 185 .

[*218] ***7.—CERTIFICATE OF LAW OFFICERS AS TO SUFFICIENCY OF PROVISIONAL SPECIFICATION.**

Patent Law Amendment Act, 1852.

This is to certify, that the petition, declaration, and provisional specification of _____, for the invention of _____, left and recorded in the office of the Commissioners of Patents for Inventions, on the _____ day of _____, 185 , having been referred to me, and I, being satisfied that the said provisional specification describes the nature of the invention, have allowed the same.

Dated this _____ day of _____, 185 .

8.—ALLOWANCE OF AMENDMENT OF PROVISIONAL SPECIFICATION.

Patent Law Amendment Act, 1852.

Petition of _____, for a patent for _____.

Whereas the provisional specification upon this petition is insufficient, I hereby allow the same to be amended by _____

9.—NOTICE OF ALLOWANCE OF PROVISIONAL PROTECTION, FOR THE "GAZETTE."

Patent Law Amendment Act, 1852.

Office of the Commissioners of Patents for Inventions.

Notice is hereby given, that provisional protection has been allowed to _____

, for the invention of _____, on _____ petition recorded in the
 office of the Commissioners of Patents for Inventions, on the _____ day of _____, 185 .

***10.—NOTICE OF DEPOSIT OF COMPLETE SPECIFICATION, FOR "GAZETTE."** [*219]

Patent Law Amendment Act, 1852.

Office of the Commissioners of Patents for Inventions.

Notice is hereby given, that the petition of _____, praying for letters patent for the invention of _____, was deposited and recorded in the office of the Commissioners on the _____ day of _____, 185 ; and a complete specification accompanying such petition was at the same time filed in the said office.

11.—NOTICE OF PROCEEDING.

Patent Law Amendment Act, 1852.

I, [or agent for _____] _____, do hereby give notice, that it is intention to proceed [if by agent, on behalf of _____] with application for letters patent for the invention of _____, as set forth in _____ petition recorded in the office of the Commissioners of Patents for Inventions, on the _____ day of _____, 185 .
 Dated this _____ day of _____, 185 .

12.—CERTIFICATE OF NOTICE TO PROCEED, FOR "GAZETTE."

Patent Law Amendment Act, 1852.

Office of the Commissioners of Patents for Inventions.

Notice is hereby given, that _____ given notice at the office of the Commissioners, of _____ intention to proceed with _____ application for letters patent for the invention of _____, as set forth in _____ petition recorded in the said office, on the _____ day of _____, 185 . And notice is hereby further given, that all persons having an interest in opposing such application, are at liberty to leave particulars [*220] in writing of their objections to the *said application at the said office of the Commissioners, within twenty-one days after the date of the Gazette in which this notice is issued.

[The certificate of record of notice to proceed, must be impressed with a £5 stamp.]

13.—NOTICE OF OBJECTION.

Patent Law Amendment Act, 1852.

I, _____, hereby give notice, that I object to the grant of letters patent to _____, for the invention of _____, as set forth in petition recorded in the office of the Commissioners of Patents for Inventions, on the _____ day of _____, 185 . And my objection to the grant of such letters patent _____ as follows:—
Dated this _____ day of _____, 185 .

14.—REFERANCE TO LAW OFFICERS.

[To be indorsed on the petition.]

Her Majesty is pleased to refer this petition to _____, to consider what may be properly done herein.

15.—NOTICE OF HEARING.

Her Majesty having referred to me the petition of _____, praying letters patent for _____, I therefore appoint _____ to consider thereof; of which let all parties have notice.

By order of the Attorney-General.

To Mr.

[*221] *16.—WARRANT FOR PATENT.

In humble obedience to her Majesty's command referring to me the petition of _____, of _____, to consider what may properly be done therein, I hereby certify as follows: That the said petition sets forth that the petitioner

[Allegations of the petition.]

And the petitioner most humbly prays,

[Prayer of the petition.]

That in support of the allegations contained in the said petition, the declaration of the petitioner has been laid before me, whereby he solemnly declares, that

[Allegations of the declaration.]

That there has been also laid before me [a provisional specification, signed _____, and also a certificate _____] or [a complete specification and a certificate of the filing thereof], whereby it appears that the said invention was provisionally protected, [or protected] from the _____ day

of _____, A. D. _____, in pursuance of the statute. That it appears that the said application was duly advertised. Upon consideration of all the matters aforesaid, and as it is entirely at the hazard of the petitioner whether the said invention is new or will have the desired success, and as it may be reasonable for her Majesty to encourage all arts and inventions which may be for the public good, I am of opinion that her Majesty may grant her royal letters patent unto the petitioner, his executors, administrators, and assigns, for his said invention within the United Kingdom of Great Britain and Ireland [colonies to be mentioned, if any], for the term of fourteen years, according to the statute in that case made and provided, if her Majesty shall be graciously pleased so to do, to the tenor and effect following:— [See next form.]

Given under my hand this _____ day of _____, A. D.

(Seal) of the Commissioners.

*17.—LETTERS PATENT.

[*222]

Victoria, by the grace o' God, of the United Kingdom of Great Britain and Ireland, Queen, defender of the faith; to all to whom these presents shall come greeting:

Whereas _____ hath by his petition humbly represented unto us that he is in possession of an invention for _____, which the petitioner conceives will be of great public utility; that he is the true and first inventor thereof; and that the same is not in use^(e) by any other person or persons, to the best of his knowledge and belief: the petitioner therefore most humbly prayed, that we would be graciously pleased to grant unto him, his executors, administrators, and assigns, our royal letters patent for the sole use, benefit, and advantage of his said invention within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man [colonies to be mentioned, if any], for the term of fourteen years, pursuant to the statutes in that case made and provided:

[And whereas the said _____ hath particularly described and ascertained the nature of the said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and has caused the same to be duly filed in _____:](^f)

And we, being willing to give encouragement to all arts and inventions which may be for the public good, are graciously pleased to condescend to the petitioner's request: know ye, therefore, that we, of our especial grace, certain knowledge, and mere motion, have given and granted, and by these presents, for us, our heirs and successors, do give and grant unto the said _____, his executors, administrators, and assigns, our especial license, full power, sole privilege, and authority, that he the said _____, his executors, administrators, and

(e) The old form ran,—“And that the same has not been practised or used before within this Kingdom.”

(f) These words will be used if a complete specification has been deposited at the time of filing the petition.

assigns, and every of them, by himself and themselves, or by his and their deputy or deputies, servants or agents, or such others as he the said _____, his executors, administrators, or assigns, shall at any time agree with, and no others, from time to time, and at all times hereafter during the term of years herein expressed, shall and lawfully may make, use, exercise, and vend his said invention within our United Kingdom of Great Britain and Ireland, the Channel Islands, and [*223] *Isle of Man, in such manner as to him, the said _____ his executors, administrators, and assigns, or any of them, shall, in his or their discretion, seem meet; and that he the said _____, his executors, administrators, and assigns, shall and lawfully may have and enjoy the whole profit, benefit, commodity, and advantage from time to time coming, growing, accruing, and arising by reason of the said invention, for and during the term of years herein mentioned; to have, hold, exercise, and enjoy the said licenses, powers, privileges, and advantages hereinbefore granted or mentioned to be granted unto the said _____, his executors, administrators, and assigns, for and during and unto the full end and term of fourteen years from the _____ day of _____, A. D. _____ next and immediately ensuing, according to the statute in such case made and provided; and to the end that he the said _____, his executors, administrators, and assigns, and every of them, may have and enjoy the full benefit and the sole use and exercise of the said invention, according to our gracious intention hereinbefore declared, we do by these presents, for us, our heirs and successors, require and strictly command all and every person and persons, bodies politic and corporate, and all other our subjects whatsoever, of what estate, quality, degree, name, or condition soever they be, within our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man [colonies to be mentioned, if any], that neither they nor any of them, at any time during the continuance of the said term of fourteen years hereby granted, either directly or indirectly do make, use, or put in practice the said invention, or any part of the same, so attained unto by the said _____ as aforesaid, nor in anywise counterfeit, imitate, or resemble the same, nor shall make or cause to be made any addition thereunto or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors, deviser or devisors thereof, without the consent, license, or agreement of the said _____, his executors, administrators, or assigns, in writing under his or their hands and seals first had and obtained in that behalf, upon such pains and penalties as can or may be justly inflicted on such offenders for their contempt of this our royal command, and further to be answerable to the said _____, his executors, administrators, and assigns, according to law, for his and their damages thereby occasioned: and moreover we do by these presents, for us, our heirs and successors, will and command all and singular the justices of the peace, mayors, sheriffs, bailiffs, constables, head-boroughs, and all other officers and ministers whatsoever of us, our heirs and successors, for the time being, [*224] that they or any of them do not nor shall at any time during the said term hereby granted, *in anywise molest, trouble, or hinder the said _____, his executors, administrators, or assigns, or any of them,

or his or their deputies, servants, or agents, in or about the due and lawful use or exercise of the aforesaid invention, or anything relating thereto: Provided always, and these our letters patent are and shall be upon this condition, that if at any time during the said term hereby granted it shall be made appear to us, our heirs or successors, or any six or more of our or their Privy Council, that this our grant is contrary to law, or prejudicial or inconvenient to our subjects in general, or that the said invention is not a new invention as to the public use and exercise thereof, or that the said is not the true and first inventor thereof within this realm as aforesaid, these our letters patent shall forthwith cease, determine, and be utterly void to all intents and purposes, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided also, that these our letters patent, or anything herein contained, shall not extend or be construed to extend to give privilege unto the said , his executors, administrators, or assigns, or any of them, to use or imitate any invention or work whatsoever which hath heretofore been found out or invented by any other of our subjects whatsoever, and publicly used or exercised, unto whom our like letters patent or privileges have been already granted for the sole use, exercise, and benefit thereof: it being our will and pleasure that the said , his executors, administrators, and assigns, and all and every other person and persons to whom like letters patent or privileges have been already granted as aforesaid, shall distinctly use and practise their several inventions by them invented and found out, according to the true intent and meaning of the same respective letters patent and of these presents: Provided likewise, nevertheless, and these our letters patent are upon this express condition, [that if the said (g) shall not particularly describe and ascertain the nature of his said invention, and in what manner the same is to be performed, by an instrument in writing under his hand and seal, and cause the same to be filed in within calendar months next and immediately after the date of these our letters patent;] [and also if the said instrument in writing, filed as aforesaid, does not particularly describe and ascertain the nature of the said invention, and in what manner the same is to be performed;] (h) [and also if the said , his *executors, administrators, or assigns, shall not pay or cause to be paid at the office of our Commissioners of Patents for Inventions [*225] the sums following; that is to say, the sum of pounds on or before the day of , A. D. , and the stamp-duty payable in respect of the certificate of such payment, and the sum of pounds on or before the day of , A. D. , and the stamp-duty payable in respect of the certificate of such payment;] (i) and

(g) Executors cannot specify. As to the death of the patentee after the sealing of the patent and before specification, see ante, p. 67.

(h) These words are to be used if a complete specification has been deposited.

(i) This condition is to be complied with by the payment of the stamp-duty, under stat. 16 Vict. In patents granted after the passing of 16 Vict. cap. , the words will be,—“And also subject to a condition that the same shall be void, and that the powers and privileges thereby granted shall cease and determine at the expiration of three years and seven years respectively from the date thereof, unless there be paid before the expiration of the third year and seventh year respectively,

also if the said _____, his executors, administrators, or assigns, shall not supply or cause to be supplied for our service all such articles of the said invention as he or they shall be required to supply by the officers or commissioners administering the department of our service for the use of which the same shall be required, in such manner, at such times, and at and upon such reasonable prices and terms as shall be settled for that purpose by the said officers or commissioners requiring the same; that then and in any of the said cases these our letters patent, and all liberties and advantages whatsoever hereby granted, shall utterly cease, determine, and become void, anything hereinbefore contained to the contrary thereof in anywise notwithstanding: Provided that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted. And lastly, we do by these presents, for us, our heirs and successors, grant unto the said _____, his executors, administrators, and assigns, that these our letters patent, or the filing thereof, shall be in and by all things good, firm, valid, sufficient, and effectual in the law, according to the true intent and meaning thereof, and shall be taken, construed, and adjudged in the most favourable and beneficial sense for the best advantage of the said _____, his executors, administrators, and assigns, as well in all our courts of record as elsewhere, and by all and singular the officers and ministers whatsoever of us, our heirs and successors, in our United Kingdom of Great Britain and Ireland, the Channel Islands, and Isle of Man, and amongst all and every the subjects of us, our heirs and successors, whatsoever and wheresoever, notwithstanding the not full and certain describing the [*226] nature or quality of *the said invention, or of the materials thereunto conducing and belonging. In witness whereof, we have caused these our letters to be made patent, this _____ day of _____, A. D. _____, and to be sealed and bear date as of the said _____ day of _____, in the _____ year of our reign.

[A stamp of £5 must be impressed on the patent.]

18.—SPECIFICATION.

To all to whom these presents shall come;

I, _____ of _____, send greeting.

Whereas her most excellent Majesty Queen Victoria, by her letters patent bearing date the _____ day of _____, A. D. _____, in the _____ year of her reign, did for herself, her heirs and successors, give and grant unto me the said _____ her special license, that I, the said _____, my executors, administrators, and assigns, or such others as I, the said _____, my executors, administrators, and assigns, should at any time agree with, and no others, from time to time, and at all times thereafter during the term therein expressed, should and lawfully might make, use, exercise, and vend, within the United Kingdom of Great Britain and

that is to say, fifty pounds at the expiration of the third year, and one hundred pounds at the expiration of the seventh year."

Ireland, the Channel Islands, and Isle of Man [colonies to be mentioned, if any], an invention for _____, [insert title as in letters patent] upon the condition (amongst others), that I, the said _____ by an instrument in writing under my hand and seal, should particularly describe and ascertain the nature of the said invention, and in what manner the same was to be performed, and cause the same to be filed in within _____ calendar months next and immediately after the date of the said letters patent. Now know ye, that I, the said _____, do hereby declare the nature of my said invention, and in what manner the same is to be performed, to be particularly described and ascertained in and by the following statement; that is to say,

[describe the invention.]

In witness whereof, I, the said A. B., have heretofore set my hand and seal, this _____ day of _____, A. D. _____ . A. B.
[A stamp of £5.]

*DISCLAIMER.

[*227]

19.—CAVEAT AGAINST DISCLAIMER.

Caveat against any fiat or leave being granted to _____, to enter any disclaimer or memorandum of alteration of any part of the title or specification in the patent of _____, for _____, dated the _____ day of _____, 185 _____, without notice to _____

In case of patents under stat. 15 & 16 Vict. cap. 83, this caveat must be lodged at the office of the Commissioners, and is subject to stamp-duty of £2.

In case of patents in respect of applications before the passing of the Act, the caveat must be entered at the chambers of the law officers.

20.—FORM OF PETITION TO THE COMMISSIONERS OF PATENTS FOR LEAVE TO ENTER A DISCLAIMER OR MEMORANDUM OF ALTERATION.

The petition of _____, of _____, in the county of _____, showeth, that your petitioner hath obtained her Majesty's letters patent for _____, bearing date the _____ day of _____, 185 _____, and hath duly described the nature of his invention, and in what manner the same is to be performed, by an instrument in writing duly filed in the office of the Court of Chan-

cery appointed by the Lord Chancellor for filing specifications. [State the nature of the alterations wished to be made, and the reasons for the same.]

Your petitioner therefore prays leave to file, in the office appointed for filing specification in Chancery, the said disclaimer [or memorandum of alteration], a copy of which, signed by your petitioner, is left herewith in the form in which your petitioner is desirous the same should be entered as aforesaid.

[*228] If the patent is one granted in respect of an application before *the 1st of October, 1852, the petition must be addressed to one of the law officers.

In cases under the Patent Law Amendment Act, the application is subject to a stamp duty of £5. 16 Viet. cap.

21.—FORM OF DISCLAIMER.

In the matter of a patent granted to _____, Disclaimer [or Memorandum of alteration] proposed to be filed in the office for filing specifications in Chancery by _____, pursuant to the provisions of an Act passed in a session of Parliament holden in the fifth and sixth years of the reign of his late Majesty King William the Fourth, intituled "An Act to amend the law touching letters patent for inventions, and also the Patent Law Amendment Act, 1852."

[State the proposed alteration and the reason for it, setting out such parts of the patent and specification as are necessary to make the sense clear.]

22.—FIAT OF LAW OFFICER.

See old form—Hindmarch on Patents, Appendix, page 640.

PROLONGATION AND CONFIRMATION.

23.—NOTICE OF INTENTION TO APPLY FOR CONFIRMATION.

In the matter of certain letters patent granted to _____, bearing date the _____ day of _____ 185 _____, for certain improvements in the manufacture of _____, notice is hereby given, under and in pursuance of an Act of Parliament (5 & 6 Wm. 4, cap. 83) and of the Patent Law

Amendment Act, 1852, I, _____, intend to apply by petition to her Majesty in Council for the *confirmation of the said letters patent for improvements, &c. granted to _____, and bearing [*229] date the _____ day of _____, 185 ; and notice is hereby given, that I, the said _____, intend to apply by counsel to the Lords of the Judicial Committee of the Privy Council, on the _____ day of _____ next; or if the said Judicial Committee shall not be then sitting, then at the next sitting of the Judicial Committee, for a time to be fixed for the hearing of the matter of my petition; and that on or before such _____ day of _____, notice must be given of any opposition intended to be made to my petition; and any person desirous of being heard in opposition to the prayer of my petition, must lodge a notice to that effect on or before the said _____ day of _____, A. D.

24.—NOTICE OF OPPOSITION.

In the Judicial Committee of the Privy Council.

In the matter of the petition of _____, of _____, for a confirmation of letters patent granted to _____, notice is hereby given, that _____, of _____, intends to oppose the said application.

25.—NOTICE OF APPLICATION FOR PROLONGATION.

In the matter of certain letters patent granted to _____, of _____, in the county of _____, bearing date the _____ day of _____, 185 , for certain improvements in the manufacture of _____, notice is hereby given, that under and by virtue, and in pursuance of an Act made and passed in the session of Parliament holden in the fifth and sixth years of the reign of his late Majesty King William the Fourth, intituled "An Act to amend the law touching letters patent for inventions;" and of an Act made and passed in the session of Parliament held in the second and third years of the reign of her present Majesty Queen Victoria, intituled "An Act to amend an Act of the fifth and sixth years of the reign of King William the Fourth, intituled 'An Act to amend the law [*230] touching letters patent for inventions;'" *and of an Act made _____ and passed in the session of Parliament held in the seventh and eighth years of the reign of her said present Majesty, intituled "An Act for amending an Act passed in the fourth year of the reign of his late Majesty, intituled 'An Act for the better administration of justice in his Majesty's Privy Council, and to extend its jurisdiction and powers;'" and of the "Patent Law Amendment Act, 1852," a petition will be presented to her Majesty in Council by _____, praying her Majesty to grant a prolongation of the term of the said letters patent: And notice is hereby further given, that an application will be made to the Right Honourable the Lords of the Judicial Committee of her Majesty's Privy Council, for the said committee to fix an early day for the hearing of the

matters contained in the said petition; and any person desirous of being heard in opposition to the prayer of the said petition, must enter a caveat to that effect in the Privy Council Office on or before the said day of _____ next.

Dated the _____ day of _____, in the year of our Lord 185 .

26.—CAVEAT AGAINST PROLONGATION.

In the Privy Council.

In the matter of the petition of _____ .

Caveat against the prolongation of the term of the exclusive privileges granted by certain letters patent for improvements _____, granted to _____, on the _____ day of _____, 185 , without notice to _____ .

Dated this _____ day of _____, 185 .

(Signed) _____

27.—FORM OF PETITION FOR PROLONGATION OF THE TERM.

To the Queen's Most Excellent Majesty in Council.

The humble petition of _____, of _____, in the county of _____ .

Showeth,—[*Here state fully the facts relied on, as, for instance,—the history of the invention—difficulties contended against—the [*231] *obtaining the patent—the filing of the specification—the importance and utility of the invention—any efforts made for the purpose of getting it adopted—the patentee's expenditure—any infringements—any successful legal proceedings against pirates—the patentee's losses or annoyances thereby—that the patentee has not received any adequate reward, and how—that patentee has been always ready to grant licenses—that the petitioner has caused to be published the advertisements required by the statute, &c.*].

Your petitioner therefore humbly prays, that your Majesty will be graciously pleased to refer the matter of his petition to the Judicial Committee of your Majesty's most honourable Privy Council, to consider and report to your Majesty thereon; and that your petitioner may be heard before such Committee by his counsel, agents, and witnesses; and that your Majesty will be graciously pleased to grant new letters patent for a term of _____ years from and after the expiration of the term of _____ years granted by the said letters patent so granted to your petitioner as aforesaid, or for such other term as to your Majesty shall seem fit, according to the statutes in such case made and provided.

And your petitioner will ever and most humbly pray.

(Signed) _____

28.—NOTICE OF OBJECTIONS TO PROLONGATION.

In the Privy Council.

In the matter of the petition of _____ of _____, in the county of _____, mechanic, for the prolongation of the sole privilege of using, exercising, and vending an invention of _____, granted to him by letters patent, &c.

Notice is hereby given of the several grounds of objection of _____, of _____, to the granting of the prayer of said petition, that is to say,

Dated this _____ day of _____, in the year of our Lord 185 _____.

(Signed) _____

*ASSIGNMENTS AND LICENSES. [*232]

29.—AGREEMENT FOR PURCHASE OF A SHARE OF AN INVENTION, AND OF THE PATENT TO BE OBTAINED FOR THE SAME.

Memorandum of agreement indented, made, and entered into this 26th day of December, 1831, between _____, of _____, in the county of _____, of the one part, and _____, of _____, in the county of _____, of the other part.

Whereas the said _____ hath recently invented and discovered certain improvements in _____, never known or used in this kingdom.

And whereas the said _____ intends forthwith to apply for her Majesty's royal letters patent for her special license and authority for him, the said _____, his executors, administrators, and assigns, to make, use, exercise, and vend his said invention for his and their sole use and benefit during the term of fourteen years.

And whereas the said _____ hath contracted with the said _____ for the purchase of one-fifth share of and in the said invention, and the benefits thereof, and of the said letters patent, and all improvements thereof applicable thereto, and all future letters patent, in respect thereof, and advantages arising therefrom, at the sum of _____, to be paid as hereinafter mentioned.

Now these presents witness that the said _____ agrees to sell, and the said _____ to purchase, one part or share of and in the said invention of and in the said letters patent, and also of and in all improvements whatsoever which the said _____ shall or may hereafter make or discover in the said invention, and of and in all future letters patent (if any) which he the said _____ shall or may obtain for or in respect of such improvements, and of and in all rights, profits, or advantages whatsoever incident to the said letters patent, whether the same shall arise from making or manufacturing the said improved _____, or by the vending or sale thereof, or of any part thereof, or from the granting or sale of

any license or licenses for the using or manufacturing thereof, or of any part thereof, or from the working thereof, or by any other means [*233] *howsoever; the same to be held by the said , together with all powers and remedies for recovering the moneys to arise as aforesaid for all the term for which the said letters patent shall be granted, and for such renewed term or terms as may hereafter be granted therein.

And it is hereby agreed, that the said shall, and within days next after the date of these presents, apply and petition for the said letters patent, and shall and will follow up such petition by all proceedings and means necessary and usual in such cases, so that the said letters patent may be obtained, and the specification duly enrolled as soon as circumstances will permit; the same letters patent to be at the costs and expenses in all things of the said .

And that the said shall and will, within days after the said letters patent, or any future letters patent shall be granted, or at any time or times thereafter, if so required by the said , and at his expense, by such good and sufficient conveyances and assurances in the law as the said or his counsel shall advise and require, assign and make over the said part or share as aforesaid unto the said , his executors, administrators, or assigns; and shall and will, in such assignment or assurance, enter into all usual covenants for the quiet possession or enjoyment and further assurance of the said share; and also into a covenant not to do so; or assent to, or cause to be done, any act, deed, matter, or thing whatsoever, whereby, or in consequence of which, the said letters patent shall or may be forfeited or invalidated, or the right of the said to his share thereof be affected or incumbered; and also that the business of the said letters patent shall be managed and conducted by the said , and that he shall keep regular accounts of the same, and that such accounts shall be at all times open to the examination and inspection of the said , and that he shall have full power to make copies of, or extracts from the same; and that the said shall pay the said sum £ in manner hereinafter mentioned, viz., ; and that the sum of £ shall be applied by the said in payment of the fees and expenses incident to obtaining the said letters patent.

And it is hereby further agreed, that in case the said shall hereafter obtain letters patent for , then that he will, if and when thereunto requested by the said , and in consideration of the [*234] further sum of £ , to be *paid to him by the said , assign to the said one part or share of such last-mentioned letters patent, and all the benefit and advantage arising therefrom.

And it is lastly agreed, that if the said shall hereafter be inclined to sell and dispose of any further share or shares of the said letters patent or either of them, that he will in the first instance offer the same to the said ; and the said agrees that he will not in any instance whatever sell and dispose thereof, or offer to sell and dispose

thereof, to a third person, before the said shall have refused to purchase the same.

For a form of agreement between a person residing here and a foreigner for obtaining letters patent in the name of such person or trustee, with power to the trustee to grant licenses, see 3 Martin's Conveyancing, by Davidson, 182.

Covenant to obtain and assign letters patent, 9 Jarman, by Sweet, 660.

Assignment of letters patent, 9 Jarman, by Sweet, 664; 3 Martin's Conveyancing, by Davidson, 361.

As to covenants when the vendor retains some interest in the patent, *ib.* 364.

Assignment of shares in a patent, Crabb's Conveyancing, by Christie, 279.

30.—LICENSES.

A bare license under the patentee's hand and seal, not being by deed, see *Chanter v. Johnson*, 14 M. & W. 408.

A license by deed-poll to use an invention, to cease on the death of the licensee, or on alienation, 7 Jarman, by Sweet, 588.

License within a certain district, with covenants, *ib.* 590.

License, with powers of distress and special restrictions on alienation, *ib.* 595.

R U L E S.

FIRST AND SECOND SET OF RULES AND REGULATIONS,

Under the Patent Law Amendment Act, 1852, for the passing of Letters Patent for Inventions.

[*235] FIRST SET OF RULES AND REGULATIONS.

Under the Act 15 & 16 Vict. cap. 83, for the passing of letters patent for inventions.

By the Right Honourable Edward Burtenshaw Lord St. Leonards, Lord High Chancellor of Great Britain; the Right Honourable Sir John Romilly, Master of the Rolls; Sir Frederick Thesiger, her Majesty's Attorney-General; and Sir Fitzroy Kelly, her Majesty's Solicitor-General; being four of the Commissioners of Patents for Inventions under the said Act.

Whereas a commodious office is forthwith intended to be provided by the Crown as the Great Seal Patent Office; and the Commissioners of her Majesty's Treasury have, under the powers of the said Act, appointed such office as the office also for the purposes of the said Act.

1. All petitions for the grant of letters patent, and all declarations and provisional specifications, shall be left at the said Commissioners' office, and shall be respectively written upon sheets of paper of twelve inches in length by eight inches and a half in breadth, leaving a margin of one inch and a half on each side of each page, in order that they may be bound in the books to be kept in the said office.

[*236] 2. The drawings accompanying provisional specifications shall be made upon a sheet or sheets of parchment, paper, or cloth, each of the size of twelve inches in length by eight inches and a half in breadth, or of the size of twelve inches in breadth by seventeen inches in length, leaving a margin of one inch on every side of each sheet.

3. Every provisional protection of an invention allowed by the law officer shall be forthwith advertised in the London Gazette, and the advertisement shall set forth the name and address of the petitioner, the title of his invention, and the date of the application.

4. Every invention protected by reason of the deposit of a complete specification, shall be forthwith advertised in the London Gazette, and the advertisement shall set forth the name and address of the petitioner, the title of the invention, the date of the application, and that a complete specification has been deposited.

5. Where a petitioner applying for letters patent after provisional protection, or after deposite of a complete specification, shall give notice in

writing at the office of the Commissioners of his intention to proceed with his application for letters patent, the same shall forthwith be advertised in the London Gazette, and the advertisement shall set forth the name and address of the petitioner and the title of his invention; and that any persons having an interest in opposing such application, are to be at liberty to leave particulars in writing of their objections to the said application at the office of the Commissioners, within twenty-one days after the date of the Gazette in which such notice is issued.

6. The Lord Chancellor having appointed the Great Seal Patent Office to be the office of the Court of Chancery for the filing of specifications, the said Great Seal Patent Office and the office of Commissioners shall be combined; and the clerk of the patents for the time being shall be the clerk of the Commissioners for the purpose of the Act.

7. The office shall be open to the public every day, Christmas-day and Good Friday excepted, from ten to four o'clock

8. The charge for office or other copies of documents in the office of the Commissioners, shall be at the rate of twopence for every ninety words.(a)

(Signed)

ST. LEONARDS, C.
JOHN ROMILLY, M. R.
FRED. THESIGER, A. G.
FITZROY KELLY, S. G.

Dated the 1st October 1852.

*FEES.

[*237]

By the Right Honourable Edward Burtenshaw Lord St. Leonards, Lord High Chancellor of Great Britain; and the Right Honourable Sir John Romilly, Master of the Rolls.

Ordered, that there shall be paid to the law officers and to their clerks the following fees:—

By the person opposing a grant of letters patent.

	£.	s.	d.
To the law officer	2	12	6
To his clerk	0	12	6
To his clerk for summons	0	5	0

By the petitioner on the hearing of the case of opposition.

	£.	s.	d.
To the law officer	2	12	6
To his clerk	0	12	6
To his clerk for summons	0	5	0

By the petitioner for the hearing, previous to the fiat of the law officer

(a) See stat. 16 Vict. cap. , schedule.

allowing a disclaimer or memorandum of alteration in letters patent and specification.

	£.	s.	d.
To the law officer	2	12	6
To his clerk	0	12	6

By the person opposing the allowance of such disclaimer or memorandum of alteration, on the hearing of the case of opposition.

	£.	s.	d.
To the law officer	2	12	6
To his clerk	0	12	6

By the petitioner for the fiat of the law officer allowing a disclaimer or memorandum of alteration in letters patent and specification.

	£.	s.	d.
To the law officer	3	3	0
To his clerk	0	12	6

(Signed)

ST. LEONARDS, C.

JOHN ROMILLY, M. R.

Dated the 1st October, 1852.

[*238]

*ORDER

Ordered by the Right Honourable Edward Burtenshaw Lord St. Leonards.
Lord High Chancellor of Great Britain.

1. All specifications in pursuance of the conditions of letters patent, and all complete specifications accompanying petitions and declarations before grant of letters patent, shall be filed in the Great Seal Patent Office.

2. All specifications in pursuance of the conditions of letters patent, and all complete specifications accompanying petitions for the grant of letters patent, shall be respectively written bookwise upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in length by fourteen inches and three-fourths of an inch in breadth; the same may be written upon both sides of the sheet, but a margin must be left of one inch and a half on every side of each sheet.

3. The drawings accompanying such specifications shall be made upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in length by fourteen inches and three-fourths of an inch in breadth, or upon a sheet or sheets of parchment, each of the size of twenty-one inches and a half in breadth by twenty-nine inches and a half in length, leaving a margin of one inch and a half on every side of each sheet.

4. The charge for office or other copies of documents in the Great

Seal Patent Office shall be at the rate of twopence for every ninety words.^(b)

(Signed)

ST. LEONARDS, C.

Dated the 1st October, 1852.

NOTE.—It is recommended to applicants and patentees to make their elevation drawings according to the scale of one inch to a foot.

*SECOND SET OF REGULATIONS [*239]

Under the Act 15 & 16 Vict. cap. 83, for the passing of letters patent for inventions.

By the Right Honourable Edward Burtenshaw Lord St. Leonards, Lord High Chancellor of Great Britain; the Right Honourable Sir John Romilly, Master of the Rolls; Sir Frederick Thesiger, her Majesty's Attorney-General; and Sir Fitzroy Kelly, her Majesty's Solicitor-General; being four of the Commissioners of Patents for Inventions under the said Act.

1. The office of the Director of Chancery in Scotland, being the office appointed by the Act for the recording of transcripts of letters patent, shall be the office of the Commissioners in Edinburgh for the filing of copies of specifications, disclaimers, memoranda of alterations, provisional specifications, and certified duplicates of the register of proprietors.

2. All such transcripts, copies, and certified duplicates, shall be bound in books, and properly indexed; and shall be open to the inspection of the public at the said office, every day from ten to three o'clock.

3. The charge for office copies of such transcripts, copies, and certified duplicates, recorded and filed in the said office, shall be at the rate of twopence for every ninety words.

4. The Enrolment Office of the Court of Chancery in Dublin, being the office appointed by the Act for the enrolment of transcripts of letters patent, shall be the office of the Commissioners in Dublin for the filing of copies of specifications, disclaimers, memoranda of alterations, provisional specifications, and certified duplicates of the register of proprietors.

5. All such transcripts, copies, and certified duplicates, shall be bound in books, and properly indexed, and shall be open to the inspection of the public at the said Enrolment Office every day, Christmas-day and Good Friday excepted, from ten to three o'clock.

6. The charge for office copies of such transcripts, copies, and certified duplicates, enrolled and filed as aforesaid, shall be at the rate of twopence for every ninety words.

(b) See stat. 16 Vict. cap. , schedule.

7. No warrant is to be granted for the sealing of any letters patent which contain two or more distinct substantive inventions.

[*240] *8. A provision is to be inserted in all letters patent in respect whereof a provisional, and not a complete specification, shall be left, on the application for the same, requiring the specification to be filed within six months from the date of the application.

9. No amendment or alteration, at the instance of the application, will be allowed in a provisional specification after the same has been recorded, except for the correction of clerical errors or of omissions made *per incuriam*.

10. The provisional specification must state distinctly and intelligibly the whole nature of the invention, so that the law officer may be apprized of the improvement, and of the means by which it is to be carried into effect.

(Signed)

ST. LEONARDS, C.
JOHN ROMILLY, M. R.
FRED. THIESIGER, A. G.
FITZROY KELLY, S. G.

Dated the 15th October, 1852.

ORDER.

Ordered by the Right Honourable Edward Burtenshaw Lord St. Leonards, Lord High Chancellor of Great Britain.

Every application to the Lord Chancellor against or in relation to the sealing of letters patent shall be by notice, and such notice shall be left at the Commissioners' office, and shall contain particulars in writing of the objections to the sealing of such letters patent.

(Signed)

ST. LEONARDS, C.

Dated the 15th October, 1852.

[*241] *RULES OF PRACTICE BEFORE THE ATTORNEY
AND SOLICITOR-GENERAL,

Respecting Disclaimers and Memorandums of Alteration.

The following rules of practice before the Attorney and Solicitor General, upon petitions for leave to enter disclaimers and memorandums of alteration, were made shortly after the passing of stat. 5 & 6 Wm. 4, c. 33.

Until further directions are given, the following is to be the mode of proceeding by a party in order to obtain leave to enter a disclaimer or alteration of any part, either of the title of his invention or of the specification, pursuant to stat. 5 & 6 Wm. 4, cap. 33, s. 1:—

1. The person applying must present a petition to the Attorney-General or Solicitor-General, stating what the proposed disclaimer or alteration is, when a time will be appointed for hearing the applicant. The petition is in general to be accompanied by a copy of the original specification, and of the proposed disclaimer or alteration.

2. If on the hearing the Attorney or Solicitor-General should think fit to disallow the proposed alteration or disclaimer, no further proceeding is necessary. If he should think fit to allow it without any advertisement, then, on being applied to for the purpose, he will put his signature to the fiat authorizing the clerk of the patents to make the required enrolment.

3. If it appears to the Attorney or Solicitor-General that any advertisement or advertisements ought to be inserted, then he will give such directions as he may think fit relative thereto, and will fix any time, not sooner than ten days from the first publication of any such advertisement, for resuming the consideration of the matter.

4. Caveats may be lodged at any time before the actual issuing of the fiat; and any party lodging a caveat is to have seven days' notice of the next meeting.

5. The fiat must be written or engrossed on the same parchment with the disclaimer or alteration at the foot thereof.

*RULES TO BE OBSERVED IN PROCEEDINGS BEFORE THE JUDICIAL COMMITTEE OF THE PRIVY COUNCIL, [*242]

Under the Act 5 & 6 Wm. 4, cap. 83, intituled, "An Act to amend the Law touching Letters Patent for Inventions."

1. A party intending to apply by petition under section 2 of the said Act, shall give public notice, by advertising in the London Gazette three times, and in three London newspapers, and three times in some county paper published in the town where, or near to which, he carries on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to petition his Majesty under the said section, and shall in such advertisements state the object of such petition, and give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the London Gazette), and that on or before such day notice must be given of any opposition intended to be made to the petition; and any person intending to oppose the said application, shall lodge notice to that effect at the Council Office on or before such day so named in the said advertisements, and having lodged such notice, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

2. A party intending to apply by petition under section 4 of the said Act, shall, in the advertisements directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall not be less than four weeks from the date of the publication of the last of the advertisements to be inserted in the London Gazette), and that on or before such day caveats must be entered; and any person intending to enter a caveat shall enter the same at the Council Office on or before such day so named in the said advertisements; and having entered such caveat, shall be entitled to have from the petitioner four weeks' notice of the time appointed for the hearing.

3. Petitions under sections 2 and 4 of the said Act must be presented within one week from the insertion of the last of the advertisements required to be published in the London Gazette.

4. All petitions must be accompanied with affidavits of advertisements ¹⁸³³ *having been inserted according to the provisions of section 4 of the said Act, and the 1st and 2nd of these rules, and the matters in such affidavits may be disputed by the parties opposing, upon the hearing of the petitions.

5. All persons entering caveats under section 4 of the said act, and all parties to any former suit or action touching letters patent in respect of which petition shall have been presented under section 2 of the said Act, and all persons lodging notices of opposition under the first of these rules, shall respectively be entitled to be served with copies of petitions presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service.

6. All parties served with petitions shall lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections to the granting of the prayers of such petitions.

7. Parties may have copies of all papers lodged in respect of any application under the said Act, at their own expense.

8. The Master of the high Court of Chancery, or other officer to whom it may be referred to tax the costs incurred in the matter of any petition presented under the said Act, shall allow or disallow in his discretion, all payments made to persons of science or skill examined as witnesses to matters of opinion chiefly.

Council Office, Whitehall, Nov. 18, 1835.

SUBSEQUENTLY THE FOLLOWING RULES WERE ADDED.

A party applying for an extension of a patent under section 4 of the said Act, must lodge at the Council Office four printed or written copies of his specification, for the use of the Judicial Committee. If such specification shall have been printed in some publication, lodging four copies of the publication containing the same will be sufficient.

In the event also of the applicant's specification not having been published as aforesaid, and if the expense of making four copies of any

drawing therein contained or referred to would be considerable, the lodgment of one copy only of such drawing will be deemed sufficient.

All copies mentioned in this rule must be lodged not less than one week before the day fixed for hearing the application.

*The Judicial Committee will hear the Attorney-General or other counsel on behalf of the Crown against granting any ap- [*244] plication made under either the second or the fourth section of the said Act, in case it shall be thought fit to oppose the same on such behalf.

Council office, Whitehall, Dec. 21, 1835.

*TABLES OF FEES. [*245]

At the Rolls Chapel Office.

	£.	s.	d.
For a search and inspection	0	1	0
For a copy of a patent or specification, besides drawing and stamps, per folio	0	0	6
For authenticating any copy, per folio	0	0	6

At the Enrolment Office.

For enrolling specifications, disclaimers, and memorandums of alteration, for every skin of the enrolment containing about nine folios, and for any portion of a skin more than half a skin	0	10	6
And for any portion of a skin not more than half a skin	0	5	3
For a search and inspection	0	1	0
For an office copy of a patent or specification (besides the stamps, 2d. per sheet for the paper, 2s. for the certificate, and 1s. the search), per folio of 90 words	0	0	8

At the Patent Office.

For filing disclaimers and memorandums of alteration in respect of patents before the Patent Law Amendment Act	0	1	0
For entering, per folio of 90 words	0	0	10
If the length does not exceed twenty-seven folios, the fee is	0	9	0

Fees to be taken by the Clerk of the Petty Bag.

For sealing every original writ of scire facias to revoke letters patent or commission on petition of right	5	0	0
For sealing every alias or testatum scire facias	2	10	0
*For examining and filing every bond of indemnity [*246] against costs and affidavits	1	0	0

	£.	s.	d.
Entering appearance for every defendant	0	10	0
For entering every rule requiring entry only	0	7	0
For drawing up and entering every other rule	0	10	0
For drawing up and entering a special order	2	0	0
For signing every judgment or entry of nolle prosequi	1	0	0
For filing a record of issue on a scire facias to revoke letters patent, and sealing the transcript	5	0	0
For drawing and entering an order to vacate letters patent	2	0	0
For filing order for delivery out of bond	0	10	0
For swearing every deponent to an affidavit	0	1	6
For every exhibit thereto	0	2	6
For taxing a bill of costs for every side	0	1	0
For filing every affidavit	0	1	0
For office copy of affidavit, per folio	0	0	4
For preparing, engrossing, and perfecting the exemplification of any record, if one skin only	5	5	0
For every additional skin	1	6	8
For every search for a precipe or writ filed	0	1	0
For searching the calendar for every year	0	1	0
For inspection of any record besides the search	0	2	6
For office copy of any record, per folio	0	0	4
For certificate of examination under the officer's hand and the office seal	0	3	6
For the re-examination of the copy of any record, if short	0	3	6
If long, per folio	0	0	1

Fees payable to the Attorney-General or Solicitor-General in cases of disclaimers and memorandums of alteration of patents before the Patent Law Amendment Act, 1852.

For appointment and summons for hearing	0	5	0
For hearing a party, or counsel in support of a petition	3	5	0
For a fiat	4	4	0
For entering a caveat at the chambers of each officer	0	5	0
For hearing opposition	3	5	0

For fees on opposition to the grant of letters patent and in respect of disclaimers, payable to law officers since the passing of the Patent Law Amendment Act, see page 237.

*STAMP DUTIES. [*247]

Stamp-Duties to be paid pursuant to Stat. 16 Vict. cap. 5.

	£	s.	d.
On petition for grant of letters patent	5	0	0
On certificate of record of notice to proceed	5	0	0
On warrant of law officer for letters patent	5	0	0
On the sealing of letters patent	5	0	0
On specification	5	0	0
On the letters patent, or a duplicate thereof, before the ex- piration of the third year	50	0	0
On the letters patent, or a duplicate thereof, before the ex- piration of the seventh year	100	0	0
On certificate of record of notice of objections	2	0	0
On certificate of every search and inspection	0	1	0
On certificate of entry of assignment or license	0	5	0
On certificate of assignment or license	0	5	0
On application for disclaimer	5	0	0
On caveat against disclaimer	2	0	0
On office copies of documents, for every ninety words	0	0	2

*TABLE OF STATUTES. [*248]

21 Jac. 1, cap. 3. "An Act concerning Monopolies and Dispensations with penal Laws and the Forfeitures thereof."

5 & 6 Wm. 4 cap. 83. "An Act to amend the Law touching Letters Patent for Inventions."

Part of section 4, as to prosecution with effect within the term repealed by 2 & 3 Vict. cap. 67, s. 1. Section 3, as to treble costs, repealed. Full costs, 5 & 6 Vict. cap. 97.

2 & 3 Vict. cap. 67. "An Act to amend an Act of the fifth and sixth years of the reign of his late Majesty King William the Fourth, intituled 'An Act to amend the Law touching Letters Patent for Inventions.'"

7 & 8 Vict. cap. 69. "An Act for amending an Act passed in the fourth year of the reign of his late Majesty, intituled 'An Act for the better administration of justice in his Majesty's Privy Council, and to extend its jurisdiction and powers.'"

15 & 16 Vict. cap. 83. "An Act for amending the Law for granting Patents for Inventions."

Sections 17, 44, 45, 46, and 53, and so much of the schedule as relates to fees and stamp-duties, repealed by 16. Vict. cap. 5.

16 Vict. cap. 5. "An act to substitute stamp-duties for fees on passing letters patent for inventions, and to provide for the purchase for the public use of certain indexes of specifications."

[*249] *STATUTES RELATING TO LETTERS PATENT.

BEFORE THE PASSING OF THE PATENT LAW AMENDMENT ACT, 1852.

18 H. 6, cap. 1. "An Act that letters patent shall bear the date of the king's warrant delivered into the Chancery."

13 Eliz. cap. 6. "An Act that the exemplification or constat of letters patent shall be as good and available as the letters patent themselves."

55 Geo. 3, cap. 184. Schedule, title, specification.

5 & 6 Wm. 4, cap. 62, s. 11. Declaration substituted for oath on taking out a patent.

1 & 2 Vict. cap. 96, ss. 12 and 13. As to enrolments in the Rolls Chapel Office.

11 & 12 Vict. cap. 94, repealed and its provisions re-enacted by 12 & 13 Vict. cap. 109. See ss. 12, 13, 15, 18, 19. As to enrolment in the Enrolment Office, and evidence of enrolment in the Enrolment and Petty Bag Offices.

14 & 15 Vict. cap. 82. "An Act to simplify the forms of appointments to certain offices, and the manner of passing grants under the great seal."

TEMPORARY ACTS.

14 Vict. cap. 8. "An Act to extend the provisions of the Designs Acts, and to give protection from piracy to persons exhibiting new inventions in the Exhibition of the Works of Industry of all Nations, in 1851.

15 Vict. cap. 6. "An Act for extending the term of the provisional registration of inventions under the Protection of Inventions Act, 1851."

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