

ture has, however, permitted the specification to be concealed. Mr. Lee (*r*) obtained an act of par-

the danger that foreigners might obtain copies of the specification in consequence of the enrolment.

Lord Eldon.—How can I do this? Either upon this or some other case in the last sessions a clause for this purpose was inserted in an act of Parliament; and upon the motion of Lord Thurlow, upon reasons applying not only to that, but to all cases, and seconded by Lord Rosslyn, the clause was universally rejected, and rejected as it appeared to me upon very substantial grounds, in which I readily concur. As to the worth of the apprehension suggested, a man has nothing more to do than to pirate your invention in a single instance; and he will then force you to bring an action, and then the specification must be produced.

But, with regard to the King's subjects, a very strong objection occurs, which makes it necessary that the specification should be capable of being produced. They have a right to apply to the patent office to see the specification, that they may not throw away their time and labour, perhaps at a great expense, upon an invention, upon which the patentee might afterwards come with his specification, alleging an infringement of his patent; when, if those persons had seen the specification, they never would have engaged in their project. The enrolment is, therefore, for the benefit of the public.

(*r*) See *Lacy's case*, Rep. of Arts, N. S. 29th Vol. p. 250. The Lord Chancellor observed, that Mr. Lee's case was a very peculiar one: it was for securing to the state, in the time of war, the benefit of a most important discovery. If Mr. Lacy could make out that the state was to be benefited by his invention in any peculiar way, as in the case of preparing hemp and flax, it might be doubtful whether he might not have a secret specification. His lordship was of opinion, however, that the legislature would pause a long time before they passed such an act in future. He could not put the great seal to a patent without seeing the specification.

liament, 53 Geo. 3, c. 179, by which his specification was ordered to be deposited in the Court of Chancery, to be kept secret from the public for fifteen months; and to be produced only by order of the Lord Chancellor, and by him to be examined whenever occasion required.

6. Caveat.

The caveat is an instrument by which notice is requested to be given to the person who enters it, whenever any application is made for a patent for a certain invention which is therein described in general terms. (s)

One caveat is left at the chambers of the Attorney General, another at those of the So-

(s) *Ex parte O'Reily*, 1 Ves. Jun. 112. Several caveats were entered against sealing a patent for a new Italian Opera House. From the whole of this long case, which is very full of facts, the opinion of Lord Thurlow respecting caveats may be collected. He declared that he would not sign a patent which did not hold the parties under some controul (if the case required it), even though there should be no caveat against it; and that it was not sufficient merely to answer objections, but that the party petitioning must lay a proper case before him.

Nothing is required from those who oppose a patent, but to shew that they have an interest.

There were many considerations, he observed, which certainly would not rest with him to be determined upon that petition. The use the King might derive from its having been before him, was, that the true state of that part of the case upon which the King's judgment would turn had come out more intelligibly than it had before.

The thing that came nearest to his office was to see that the King was not deceived, and that he did not throw out of his hands that authority which ought to be retained.

licitor General. They must be annually renewed.

If application be made for a patent for an invention similar in its nature to that mentioned in the caveat, then all the parties are summoned to attend upon the Attorney or Solicitor General, who separately examines each party. If he think that the inventions are not the same, both parties are entitled to patents; but if he should be of opinion that they are the same, then his report shews to whom the patent is to be granted. The practice in the office of the Attorney General is guided by rules made by each learned gentleman holding that office. (*t*)

(*t*) The clerks of the Attorneys General have adopted (amongst others) the following rules:

In the event of an opposition to a patent *on the bill*, it is customary for the opposing party to enter a caveat to that effect at the patent office in Lincoln's Inn, and at the same time to deposit 30*l.* with the clerk as a guarantee for the expenses of such opposition.

Sir Samuel Shepherd, Attorney General, ordered that no report on a petition should be delivered until the caveats were answered (*i. e.* within the given time) and that no hearing should be had *on a bill instead of petition*, without the consent of all the parties opposing the same.

May, 1829.

The following rule was laid down by Sir Robert Gifford when he was Solicitor General:

If a caveat be entered after a petition has been in the office seven days, the person is entitled to notice; but if the petitioner is put to any *additional* expense, the party opposing is to pay the same.

When Sir Samuel Romilly was Solicitor General, he es-

If the disappointed party think that he is injured, he should immediately enter a caveat at the *Chancery Patent Office*, and when the grant comes for the great seal, the Lord Chancellor will privately examine all the parties concerned, and do justice between them.

Other reasons may induce persons to enter a caveat at the Chancery office, as was done in one case, to prevent the great seal from being put to a patent, wherein the petitioner was allowed *fifteen* months to enrol the specification.

established this rule,—That a caveat entered after the report, should *not be allowed to stop the signing* of the bill, unless the party entering it paid the petitioner his expenses of the report, warrant, bill, and *hearing*, if the invention proved similar. If *dissimilar*, that he paid the petitioner his expenses at the hearing only.

A question having arisen whether seven *entire* days ought to be allowed to persons, having caveats, to answer notices of applications for patents, Mr. Attorney General Scarlett decided, that seven *whole* days should be allowed, exclusive of the date or day of notice.

22nd July, 1829.

The Attorney General (Scarlett) with the concurrence of the Solicitor General (Sugden) laid down this rule, *viz.* That upon the entry of an opposition to a patent, the party opposing shall deposit with the Attorney General's or Solicitor General's clerk the sum of 3*l.* 10*s.*, which sum includes the fee for summons heretofore paid by the petitioner; but if the opposing party appear at the hearing, the fee for summons to be remitted, and the petitioner charged with it as formerly.

8th July, 1829.

Upon which the following postscript was added to the notices:

P. S. The fee for opposing a patent is 3*l.* 10*s.*, which it will be necessary to lodge at the time of opposition.

The Lord Chancellor, in consequence, refused to seal it. (u) And where a petitioner applied for a patent, in respect of certain improvements in steam-engines, a caveat was entered under an existing grant, from which, it was alleged, the subject of this new patent was borrowed. The Lord Chancellor sealed the patent upon reading the affidavits, in one of which, made by an engineer, it was stated that the subjects did not resemble each other. (v)

Although the Lord Chancellor is very averse to a caveat, at this late stage of the business ; yet, if he think that the opposition was not unreasonable, he will not give costs. (w)

Costs of
caveat.

A caveat may be entered at the office of the Attorney General, against permission being granted to a patentee to *disclaim* any part of the title of his patent, or of his specification, under 5 & 6 Wm. 4, c. 83. (x)

Such is a caveat, the manner of entering it, and the practice respecting it.

Of its nature and effect much misconception has arisen. It does not create any right ; but is simply a request to be *favoured* with information. If the applicant think that he is unjustly deprived of an invention, after he has been heard before the Lord Chancellor, he has no remedy

(u) Ex parte *Heathcote*, in the matter of *Lacy*, ante, 179.

(v) Ex parte *Fox*, 1 Ves. & Beam. 67.

(w) Id.

(x) Post, 190.

but a *scire facias*, to repeal that which has been sealed. (y)

Upon the whole, therefore, the entering a caveat is nothing more than giving information that there is an invention nearly completed, and requesting, that if any other person should apply for a patent for the same thing, the preference may be given to him who entered it. Which request is complied with, by the courtesy of the crown, upon its being satisfied of its reasonableness by the report of the Attorney General, or the opinion of the Lord Chancellor. And when the patent is granted, it is to be judged of as though no caveat had ever been entered.

The privileges derived from a patent take effect only in England; but if the colonies are named therein, then it extends to them.

If it be the wish of the inventor to exercise his invention exclusively all over the united kingdoms, he must take out separate patents for *Scotland* and *Ireland*.

By Act of Parliament, this exclusive privilege may be preserved to the inventor in any other places, over which this government has authority, as in the East or West India territories; but otherwise, it is necessary to obtain an act of the colony to enforce the patent; for example, it is requisite in Jamaica to obtain an act of the legislature of that island, to secure the fruits of a patent in that colony.

(y) Post, Chap. IX.

II. THE ACTS OF PARLIAMENT TO ENLARGE PATENT RIGHTS.

In the first edition of this treatise, after the necessary forms and instruments have been described; the manner of soliciting, and the matter contained in the acts of parliament, which were sometimes passed to give greater utility to the statute of James, were stated; but since the 5 & 6 Wm. 4, hereafter explained, it is unnecessary to obtain an act to prolong the time of a patent; nevertheless, it may sometimes be necessary to obtain an act to enable a patentee to assign his patent to more than twelve persons.

In an act of parliament to enable a patentee to assign to more than twelve persons; after a recital of the date of the patent for the original subject, and also of that for the improvements, (if any has been granted); the proviso by which the patent is declared to be void, if it be transferred to any number of persons exceeding twelve, is set forth. Then follows the *special circumstances*; as, that the undertaking requires a large capital; and that, to make it beneficial to the public, such large sums of money are required, which rendered it impossible for twelve persons to use it.

An Act to enable the patentee to assign to more than twelve persons.

It is thereupon enacted, that the patentee may transfer his right to any number of persons not exceeding the number therein mentioned, with a proviso, that nothing in the act contained shall be construed to confirm, or give greater force, or

validity to the letters patent than they legally possessed before the passing of it.

The act, though private in its nature, is generally made a *public one*, to prevent the expense of pleading it specially. (z)

Such an act of parliament is procured in the usual manner, in which private ones are obtained, by notice and petition.

The notice, (a) after stating that an application will be made to parliament for an act to enable the patentee to assign his letters patent to more than twelve persons for the enjoyment of the benefits accruing from the invention (naming it,) granted to him on a certain day. If the patent has been made for Scotland and Ireland, then the notice must state that the act is to extend its authority over those places. If a subsequent patent has been obtained for *improvements* and additions, then it should be stated that it is the patentee's intention to apply for a new term for the use thereof in England, Scotland, and Ireland.

This notice should be *signed* by the solicitor or agent for the patentee, and should be inserted three times in the *London Gazette*. If the patent be also for Scotland and Ireland, then the notice should be inserted three times in one of the *Edinburgh papers*, and three times in the *Dublin Gazette*. These advertisements must

(z) See 41 Geo. 3, c. 125, local and personal acts.

(a) Order of the House of Commons, 30th June, 1801.

appear in the respective months of August and September, or one of them (*b*) preceding the sessions in which the application is to be made.

A *petition*, with a copy of the patent annexed to it, for leave to bring in the bill, is then prepared.

It describes the invention as in the patent, (*c*) and gives the dates of the three grants for the use of the inventors in England, Scotland, and Ireland. And if patents for improvements have been obtained for those three kingdoms, then the several dates of those three patents must be stated. Afterwards the special matter, with the reasons for the application (*d*) that may appear to the patentee to be important, should be set forth. *Then* follows the *prayer* of the petition. It must be signed by the parties who are suitors for the bill.

This petition is referred to a select committee, who examine the *witnesses*, and inspect the newspapers in which the notice has been inserted. The chairman then reports to the House that the committee have examined the matter of the petition, and that the standing orders of the House relative to bills for confirming or prolonging terms of letters patent have been complied with. Leave is then given to bring in the bill, to which

(*b*) Order, 30 June, 1801.

(*c*) Order, 26 May, 1685.

(*d*) Order, 24 November, 1699.

a copy of the patent is annexed. (e) This bill is read a *first* time, and ordered to be read a *second*. On the second reading, upon being presented, it is referred to a select committee, who hear witnesses, and then report to the House that they have examined the allegations of the bill, and find the same to be true; upon which the House orders the bill to be *engrossed*. On the *third* reading it is passed, and carried up into the House of Lords, by the member who conducted the bill through the House of Commons.

The usual routine in the House of Lords of passing a private *act*, by which term the bill is there designated, is to read it immediately a first time, and then for the chairman of the select committees to move that it be read a second time, and referred to a select committee; before whom the witnesses are examined by the chairman, who reports to the House that the allegations in the act are true. Upon his motion the act is read a third time, and passed. The Commons are informed of the agreement of the Lords to the act, and it receives the royal assent.

(e) Order, 13 May, 1690.

III. PROCEEDINGS BEFORE THE JUDICIAL
COMMITTEE OF THE PRIVY COUNCIL, &c.

Some of the defects in the laws respecting letters patent, have been remedied by acts of parliament introduced by Lord Brougham. (*f*) The 5 & 6 Wm. 4, c. 83, and 2 & 3 Vict. c. 67, which require the remedies to be applied by the Judicial Committee of Her Majesty's most honourable Privy Council.

The objects obtained under these acts by application to the Crown Law Officers, or to the Privy Council, are—

1. A remedy where it is discovered that the patentee has claimed something used before.
2. The amendment by a *disclaimer* of the description of the invention in the title or specification.
3. The prolongation of the term of a patent.

It often happened in the course of a trial that the only question discussed, was, whether or not some person besides the patentee had used the subject of the patent. In the old cases, slight proof of a prior using of the thing invented invalidated the patent, although the patentee was acknowledged to be the first person who had made any beneficial use of it. That law was

1. Public use of the subject of a patent.

(*f*) In the Appendix will be found a bill introduced by me, and passed through the House of Commons, which was stopped in the House of Lords.

gradually modified, and in the cases of *Lewis v. Marling*, (g) and *Jones v. Pearce*, (h) it was put upon an intelligible basis. (i)

The legislative remedy for the evil of varying decisions upon that point is given in section 2 of 5 & 6 Wm. 4, c. 83; as follows:—

“ That if in any suit or action it shall be proved or specially *found by the verdict of a jury* that any person who shall have obtained letters patent for any invention or supposed invention was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same, or some part thereof, before the date of such letters patent; or if such *patentee or his assigns shall discover* that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, it shall and may be lawful for such patentee or his assigns to petition his Majesty *in Council to confirm* the said letters patent, or to grant new letters patent, the matter of which petition shall be heard before the judicial committee of the privy council; and such committee, upon *examining the said matter*, and being satisfied that such patentee believed himself to be the first and original inventor, and being satisfied *that such invention or part thereof had not been publicly and generally used before the date of such first letters patent*, may report to his Majesty their opinion that the prayer of such petition ought to

(g) 10 B. & C. 22, and 4 C. & P. 52.

(h) Ante, 46.

(i) See ante, Chap. III.

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

The judicial committee of the privy council have promulgated rules for their guidance. (*j*)

(*j*) Rules to be observed in proceedings before the Judicial Committee of the Privy Council, under the Act of the 5 & 6 Wm. 4, intituled "An Act to amend the law touching Letters patent for Inventions." (cap. 83.)

Rule I. 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 Papers*, and three times in some *Country Paper*, published in the town where or near to which he carries on any manufacture of any thing 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 country 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

Their decision will have operation from the date of the verdict, which, being special, will not have

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.

Rule II. A party intending to apply by petition under sect. 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.

Rule III. 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*.

Rule IV. All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of sect. 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.

Rule V. All persons entering caveats under sect. 4 of the said act, and all parties to any former suit or action touching letters patent in respect of which petitions shall have been presented under sect. 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

any judgment pronounced upon it until after the decision of the privy council. A party intending to apply to the privy council should obtain an order of the court to stay proceedings upon the

presented under the said sections, and no application to fix a time for hearing shall be made without affidavit of such service.

Rule VI. 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.

Rule VII. Parties may have copies of all papers lodged in respect of any application under the said act at their own expense.

Rule VIII. 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.

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 deemed 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 lodging 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 application made under either the 2nd or 4th sections of the said act, in case it shall be thought fit to oppose the same on such behalf.

verdict until the privy council had examined the matter.

The principal words of this section are,—

“*That such invention or part thereof had not been publicly and generally used before the date of the first letters patent.*”—The privy council are not to give relief if the subject of the patent has been publicly and generally used. It often happened that a patent was invalidated because some one person, at a part of the kingdom distant from the patentee, had performed the same thing and had thrown it aside for ten, twenty, or thirty years before the date of the patent.

2. Prolongation of the term of a patent.

By the 21 Jac. 1, c. 19, the Sovereign is restricted in making grants of letters patent to fourteen years' duration. The legislature sometimes interfered to prolong that term, but the patentee was put to great expense.

In s. 4 of 5 & 6 Wm. 4, c. 83, it is enacted, “that if any person who now hath or shall hereafter obtain any letters patent as aforesaid shall *advertise in the London Gazette three times, and in three London papers, and three times in some country paper, published in the town where or near to which he carried on any manufacture of any thing made according to his specification, or near to or in which he resides, in case he carried on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to apply to his Majesty in Council*

for a prolongation of his term of sole using and vending his invention, and shall petition his Majesty in Council to that effect, it shall be lawful for any person to enter a caveat at the Council Office; and if his Majesty shall refer the consideration of such petition to the judicial committee of the privy council, and notice shall first be by him given to any person or persons who shall have entered such caveat, the petitioner shall be heard by his counsel and witnesses to prove his case, and the persons entering caveats shall likewise be heard by their counsel and witnesses; whereupon, and upon hearing and inquiring of the whole matter, the judicial committee may report to his Majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years; and his Majesty is hereby authorized and empowered, if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom, or usage to the contrary in anywise notwithstanding: provided, that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent."

The words "*prosecuted with effect*" gave rise to an interesting discussion before the judicial committee of the privy council, whether the application to enlarge the term of patents had been "*prosecuted with effect*" before the expira-

tion of the term of the patent. The application (*h*) had been made within the fourteen years, an opposition had been at the latest moment entered, and the judicial committee fixed a day to hear the parties. That day occurred after the fourteen years had expired. The privy councillors were of opinion that their authority was at an end, and refused to hear the case.

To remedy that defect, the 2 & 3 Vict. c. 67, (*l*) was passed: in which there is a recital thus—whereas it has happened since the passing of the said act, and may again happen, that parties desirous of obtaining an extension of the term granted in letters patent of which they are possessed, and who may have presented a petition for such purposes in manner by the said recited act directed, before the expiration of the said term, may nevertheless be prevented by causes over which they have no control from prosecuting with effect their application before the judicial committee of the privy council; and it is expedient therefore that the said judicial committee should have power, when under the circumstances of the case they shall see fit, to entertain such application, and to report thereon, according to the provisions of the said recited act, notwithstanding that before the hearing of the case before them the terms of the letters pa-

(*h*) By Mr. Bodmer, whose patent was for "certain improvements in the machinery for cleaning, carding, drawing, roving, and spinning of cotton and wool."

(*l*) On the 24th August, 1839, since page 22 of this work was printed.

tent sought to be renewed or extended may have expired. It then repeals the provision requiring the application by petition to be prosecuted with effect before the expiration of the term of the patent.

And it is enacted, by sec. 2, that it shall be lawful for the judicial committee of the privy council, *in all cases (m)* where it shall appear to them that any application for an extension of the term granted by any letters patent, the petition for which extension shall have been referred to them for their consideration, has not been prosecuted with effect before the expiration of the said term from any other causes than the neglect or default of the petitioner, to entertain such application, and to report thereon as by the said recited act provided, notwithstanding the term originally granted in such letters patent may have expired before the hearing of such application; and it shall be lawful for her Majesty, if she shall think fit, on the report of the said judicial committee recommending an extension of the term of such letters patent, to grant such extension, or to grant new letters patent for the invention or inventions specified in such original letters patent, for a term not exceeding seven years after the expiration of the term mentioned in the said original letters patent: provided always, that no such extension or new letters patent shall be granted if a petition for the same shall not have been presented as by the said recited act directed before the expiration of the

Term of patent right may be extended in certain cases, though the application for such extension not prosecuted with effect before the expiration thereof.

(m) Mr. Bodmer has renewed his petition, which will be heard in November, 1839.

term sought to be extended, nor in case of petitions presented after the thirtieth day of November, one thousand eight hundred and thirty-nine, unless such petition shall be presented six calendar months at the least before the expiration of such term, nor in any case unless sufficient reason shall be shown to the satisfaction of the said judicial committee for the omission to prosecute with effect the said application by petition before the expiration of the said term.

The act of 5 & 6 Wm. 4, c. 83, was a wise exercise of the powers of the legislature; it has been most liberally carried into operation by the members of the judicial committee of the privy council, (n) who have often advised that new letters patent (o) should be granted, and it has had a most beneficial effect upon the inventors, not only by increasing their profits by means of a prolonged term, but also by the confidence which it has spread amongst them that patents are now a *safe* property.

To protect the public, the Attorney General has generally attended the judicial committee. He has not interfered where he saw that the question of a renewal was matter of contention between opposing parties; but, of course he would urge any objection which occurred to him in

(n) To hear petitions for new patents, Lord Lyndhurst, Lord Brougham, Mr. Baron Parke, Mr. Justice Bosanquet, and Mr. Justice Erskine, almost always attend.

(o) Among the new patents are—Errard's for a harp; Wright's for making pins; Southworth's for drying calicoes; Kyan's for preserving timber; Stafford's for a coach.

cases where no opponent appeared to contest the propriety of the grant.

In every case the judicial committee require very strict proof that all the requisites of the act, as to advertisements, have been complied with. They also closely examine the books of account of the patentee. They will be clearly satisfied that he has really incurred all the expenses set forth in his petition, and will carefully scrutinize the amount of the profits which he has made. An instance occurred (*p*) in which they thought enough profit had been, or was likely to be made, before the expiration of the fourteen years, and refused then to interfere.

It is doubtful whether, in strictness, an assignee of letters patent can be the petitioner for a new patent. The difficulty has generally been removed by an arrangement between the patentee and the assignee. The words of the act are—“any person who now hath or shall hereafter obtain any letters patent.” The assignee is a person “who now hath” the letters patent, and the inclination of the mind of the judicial committee is in favour of assignees: although an assignee was not permitted by the legislature to have an extension of the term by act of Parliament.

(*p*) Mackintosh's patent.

CHAP. VI.

OF THE CONSTRUCTION OF LETTERS PATENT.

THE inventor having obtained a patent, it is now time to state the principles, and expound the rules by which it is to be *construed*. The matter may be divided for consideration into three parts as it respects the construction :—

1. Of letters patent in general.
2. Of those for inventions.
3. Of the acts of parliament enlarging the patent rights.

“In ordinary cases,” says Mr. Chitty, Jun., in his *Treatise on the Prerogatives of the Crown*, (a) “between subject and subject, the principle of construction is, that the grant shall be construed, if the meaning be doubtful, most strongly against the grantor, who is presumed to use the most cautious words for his own advantage and security. But in the case of the King, whose grants chiefly flow from the royal bounty and grace, the rule is otherwise ; and crown grants have at all times

(a) See pages 391, 2, and the authorities there collected.

been construed most favourably for the King, where a fair doubt exists as to the real meaning of the instrument, as well in the instance of grants from his Majesty, as in the case of transfers to him."

"But the rule that grants shall be construed most favourably for the King," he adds, "is subject to many limitations and exceptions. (b)

"In the first place, no strained or extravagant construction is to be made in favour of the King.

"If the intention be obvious, royal grants are to receive a fair and liberal interpretation accordingly. And, though the general words of a grant may be qualified by the recital; yet, if the intent of the crown be plainly expressed in the granting part, it shall enure accordingly, and shall not be restrained by the recital.

"In the second place, the construction and leaning shall be in favour of the subject, if the grant shew that it was not made at the solicitation of the grantee, but *ex speciali gratiâ, certâ scientiâ, et mero motu regis*. Though these words do not of themselves protect the grantee against false recitals, &c.

"In the third place, if the King's grants are upon a valuable consideration, they shall be construed strictly for the patentee for the honour of the King.

"So where the King's grant is capable of two constructions, by the one of which it will be valid,

(b) *Id.* p. 393, 4.

and by the other void, it shall receive that interpretation which will give it effect; for that will be more for the benefit of the subject, and the honour of the King, which ought to be more regarded than his profit.

“A decided *uncertainty* (c) will avoid a grant from the crown, not only as against the patentee, but also as against the King, because it raises a presumption of deceit.” “But the rule *id certum est quod certum reddi potest* obtains, even in case of the crown; and therefore, if a grant refer or has relation to that which is certain, though it be not matter of record but mere matter of fact, or *in pais*, it is sufficient.” “But where a particular certainty precedes, it shall not be destroyed by an uncertainty or a mistake coming after.”

“*Misrecitals, and false suggestions, or deceit*, (d) will, in certain cases, invalidate a grant from the crown.”

2. Construction
of a patent for
inventions.

Such are the *general rules* for the construction of all kinds of letters patent. It becomes necessary to state the principles upon which the decisions respecting patents for inventions in particular are founded.

The exposition of the patent, whether it regard the invention or other matters connected with it, is in truth nothing more than a statement of the meaning of the statute of monopolies which was made *in favour of the subject*, and ought

(c) *Id.* p. 394.

(d) *Id.* p. 396.

therefore, to be explained most liberally to his advantage.

The formal parts, the usual covenants, and the provisoes, must be expounded by the *general* rules above laid down.

The patent for an invention contains the expressions *ex speciali gratiá, certá scientiá, et mero motu*; and upon that account, the construction must lean in favour of the patentee. Moreover, there is a clause inserted, whereby it is *expressly declared*, that the letters patent shall be taken, construed, and adjudged, in the most favourable and beneficial sense, for the best advantage of the patentee, notwithstanding the not full and certain describing the nature and quality of the said invention, or of the materials thereto conducing and belonging. (*e*)

Although many of the judges have construed the statute of monopolies in favour of the inventor, (*f*) yet formerly, they inclined to give to the patent and specification, (which must be taken together when considering the proper construction of this grant,) a narrow limit; and, in fact, to no greater extent than the literal meaning of its terms. Mr. Justice Buller, however, observed, (*g*) “Whenever it appears that the

(*e*) See Form of a Patent in the Appendix.

(*f*) Lord Loughborough.—“There is no matter of favour that can enter into consideration in a question of this nature. The law has established the right of patents for new inventions: that law is extremely *wise and just*.” Dav. Pat. Cas. 55.

(*g*) In *Turner v. Winter*, 1 T. R. 606.

patentee has made a fair disclosure, I have always had a strong bias in his favour, because in that case he is entitled to the protection which the law gives him. How far that law which authorizes the King to grant patents is politic, it is not for us to determine. When attempts are made to evade a fair patent, I am strongly inclined in favour of the patentee; but, where the discovery is not fully made, the Court ought to look with a very watchful eye to prevent any imposition on the public."

But Kenyon, C. J., observed, (*h*) "I am not one of those who greatly favour patents; for though, in many instances, the public are benefited by them, yet, on striking the balance on this subject, I think that great oppression is practised on inferior mechanics by those who are more opulent."

It is said that Lord Eldon, when Chief Justice of the Court of Common Pleas, in the case of *Cartwright v. Amatt*, (*i*) put the question for consideration,—Whether the specification was such that the machinist could make the machine from the description there given, considering the case of a patent not in the light of a *monopoly*, as it had been generally put, but as a *bargain with the public*, and therefore to be construed upon

(*h*) In *Hornblower v. Boulton*, 8 T. R. 98.

(*i*) In Easter Term, 1800; not reported, but mentioned in argument, 11 East, 107, and 14 Ves. 131. His lordship afterwards said that he adhered to the law as he stated it in that case. 14 Ves. 136; and see Dav. Pat. Cas. 434.

the same principle of *good faith* that regulated all other contracts ; and therefore if the description was such that the invention could be communicated to the public, the statute was satisfied.

The extent of signification which has been given to the words “ first inventor” (*j*) and “ new manufacture,” (*k*) and also by what rules the specification (*l*) is to be judged, have been fully explained : and therefore I shall only add, that patents now receive a construction more in favour of the grantee than they formerly did, and that the opinion of Lord Eldon is generally adopted ; that, as the disclosure of the new invention is the equivalent for which the grant is obtained, letters patent come within that general rule, by which, when a valuable consideration is given, the grant is to be construed strictly in favour of the grantee. (*m*)

When the Court of King’s Bench took time to consider their judgment in the case of *Hullett v. Hague*, (*n*) Lord Tenterden observed,—“ I cannot forbear saying that I think that a *great deal too much* critical acumen has been applied to the construction of patents, as if the object was to defeat and not to sustain them.”

The tide had then turned in favour of patentees, and the judges of the present day make every reasonable intendment in their favour.

(*j*) Ante, Chap. II.

(*k*) Ante, Chap. III.

(*l*) Ante, Chap. IV.

(*m*) Ante, p. 107.

(*n*) 1 Barn. & Ad. 377. In the year 1831.

3. Of the acts of Parliament to enlarge them.

Statutes, it has been shewn, (o) are sometimes made to enlarge the benefits arising from patents for inventions. And patentees may now have the term extended by the Queen's privy council.

It was formerly contended that the view taken of letters patent by the Legislature, as expressed in the act of Parliament extending the term of a grant, supported the validity of the patent itself: but it was considered that the legislative provisions left the patent exactly in the same situation in which it was placed before they were enacted, and that the act could not be looked at as a *legislative reading* of the patent.

An attempt was lately made to put a similar construction upon an act of Parliament, by which the patent of Koops (p) was made assignable

(o) Ante, p. 185.

(p) *Hesse v. Stevenson*, 3 Bos. & Pull. 578. Lord Alvanley.—It is contended, that the act of Parliament stated in the case vested a legal interest in Koops; for that he must be taken against all the world to have that interest which the act of Parliament recites to be vested in him, that act being a public act. But though the act be public, it is of a private nature. The only object of the proviso for making it a public act is, that it may judicially be taken notice of instead of being specially pleaded, and to save the expense of proving an attested copy. But it never has been held that an act of a private nature derives any additional weight or authority from such a proviso; it only affects Koops, and those claiming under him, and authorizes him to do certain acts which by the letters patent he could not have done. It recites the letters patent, containing a clause which prevents him assigning to more than five persons; and then enables him to assign to any number of persons not exceeding sixty. It is not

to sixty persons: but Lord Alvanley on that occasion observed, that he could not look into the act for any explanation of the contents of the patent or specification.

In a late case, of *Bloxam v. Elsee*, that doctrine was confirmed. (q)

possible then to consider this act as giving title to Koops which he had not at the time when it passed. Such has been the construction which has always been put upon acts of Parliament of this nature. We are, therefore, of opinion, that no aid is to be derived to the defendant from the act of Parliament.

(q) 6 B. & C. 171. It may be useful to state the facts at length, for there were two patents in it.

By letters patent of the date of the 20th April, 1801, reciting, amongst other things, that one Gamble had, by his petition, represented to the King that he was in possession of a machine for making paper in single sheets without seam or joining, from one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length, the method of making which machine had been communicated to him by a certain foreigner with whom he was connected, and that he conceived the same would be of great public utility, and that the same was new in the kingdom, and had not been practised therein by any other person whomsoever, to the best of his knowledge or belief—his late Majesty granted to Gamble, his executors, administrators, and assigns, the sole privilege “of making, using, exercising, and vending the said invention, for fourteen years.”

By other letters patent of the 7th June, 1801, reciting, amongst other things, that Gamble had, by his petition, represented to the King, that he, in consequence of a further communication made to him by a certain foreigner residing abroad, with whom he was connected, was in the possession of certain improvements on, and additions to, a machine for making paper in single sheets, without seam or joinings, from

The patent and specification must, in fact, stand or fall by themselves; and no extraneous

one to twelve feet and upwards wide, and from one to forty-five feet and upwards in length, being the machine for which he had obtained the letters patent bearing date the 20th April, 1801; that such improvements and additions would not only make the said machine more perfect and complete, but by far more useful to the public than it was in its then present state; that the same so improved was new in this kingdom, and had not, with such additions and improvements, been practised therein by any person, to the best of his (Gamble's) knowledge or belief—his late Majesty did, by the last mentioned letters patent, grant to Gamble, his executors, administrators, and assigns, the sole privilege of making, using, exercising, and vending his said invention, for the term of fourteen years from the date of the last mentioned letters patent.

On the 7th January, 1804, Gamble assigned all his interest in these two patents to H. Fourdrinier and S. Fourdrinier, the bankrupts.

By an act of Parliament passed in 1807, reciting that H. Fourdrinier and S. Fourdrinier and Gamble had made, used, and continued to make use of the said improved machine in a very extensive trade, in part whereof H. Fourdrinier and S. Fourdrinier and Gamble were jointly concerned as co-partners, and that they had been put to great expense, &c., it was enacted, that the sole privilege, right, and authority of making, using, and vending the said improved machine within the United Kingdom of Great Britain and Ireland, and in his late Majesty's colonies and plantations abroad, should, from and after the passing of that act, be, and the same was thereby declared to be vested in H. Fourdrinier, S. Fourdrinier, and Gamble, their executors, administrators, and assigns, for and during the term of fifteen years from thenceforth next ensuing, being an addition of seven years, or thereabouts, to the term granted by the said letters patent.

By the sixth section it was enacted, that every objection

matter can be introduced to explain them and establish their legality. If they are bad in

which might have been made to the validity of the said letters patent, and to the sufficiency of the specifications enrolled as aforesaid, should be of the like force and effect in law in any action or suit brought by virtue of that act, as such objections respectively would have been if that act had not been passed, and if also the specifications to be enrolled, as required by that act, had been enrolled, instead of the former specifications respectively, except only as to the extension of the said privileges for the further term of years thereby granted.

Lord Tenterden, in his judgment, made the following observations:—"I think it may be admitted, that by subsequent improvements and discoveries, a machine was obtained capable of making paper of width varying within certain limits, though probably not extending to more than half the width mentioned in the patent. The specification enrolled under the act of Parliament appears sufficiently to describe such a machine, and a mode of adjusting it to different degrees of width within the limits of its own breadth. The first specification is evidently confined to one width only. Then can the last specification be taken to furnish an answer to the objection? Now, supposing the act of Parliament so far substitutes the last specification in the place and stead of the former specification, as to remove all formal objections to them, to which the latter is not open, still it cannot so far operate retrospectively as to enable the patentee to say that he possessed in 1801, or had then discovered or invented a machine which it appears that he did not possess, and had not invented or discovered until a much later date. If the first machine had been capable of working at different degrees of width, *though clumsily and imperfectly*, the latter machine would have been an improvement of it; but as the first, whether considered as existing actually or in theory, was wholly incapable of this, the latter machine does not in this respect furnish an improvement of anything previously existing, but an addition of some new

themselves, nothing whatever can make them legal instruments.

matter not existing or known at the date of the first patent, and which nevertheless is therein represented as existing or known, and which cannot but be considered an important part of the representation then made, and of the consideration of the grant. If the first grant was void, the subsequent grants by the patent and by the statute must fall to the ground, as having nothing to support them. I think myself compelled, therefore, to yield to this objection."

CHAP. VII.

OF THE PROPERTY IN AN INVENTION.

THE inventor, being possessed of a patent, with a knowledge of the manner in which it must be construed, is next to be informed of the *nature of the property* he has acquired, and the uses to which it may be applied. The grounds upon which assistance is refused, in the courts both of common law and equity, to those persons who conceal their inventions, when applying for relief from the effects of any breach of faith, will afterwards be investigated.

I. PROPERTY IN A PATENT.

Though the statute merely mentions the “*inventor* :” yet the patent is always granted to him, his executors, administrators, and assigns, and to such others as they at any time shall agree with.

Its nature generally.
Personal property.

It is a personal chattel, (*a*) peculiar in its nature as to

1. Its *duration*, or the time it may be enjoyed.

(a) See 2 Bla. Com. Chap. XXVII.

2. The *number of persons* to whom it may be assigned ; or who may at the same moment be interested in it.
3. Being sometimes *enlarged*, by an act of parliament, or the grant of a new patent.

But in every other respect it is to be viewed in the same light as that in which personal property in general is considered.

1. Duration.

This privilege, so valuable to an inventor of the sole working or making his new manufacture, is by the statute (*b*) allowed to be enjoyed *for fourteen years or under*: which term, by express enactment, is to be accounted from the date of the first letters patent or grant of such privilege. Though the Queen, therefore, when her Majesty sees occasion, may grant this right for any time less than fourteen years, yet a patent in which it should be attempted to extend that term would, in consequence thereof, be void.

2. Number of persons interested.

It is one of the most material conditions (*c*) upon which the grant is made, that, if the person interested in it should make any transfer or assignment of it, or divide it into shares, or declare any trust, or seek public subscriptions, or should presume to act as a corporate body, so that *more than twelve persons* should in any manner become interested, and claim a benefit in the patent, it is declared to be void.

Executors and administrators are to be *reck-*

(*b*) 21 Jac. 1, c. 3, s. 6.

(*c*) Ante, 24 ; and see Appendix for copy of a patent.

oned, accounted, and considered, as and for the single person whom they represent, as to the interest they shall be entitled to in right of the testator or intestate. (d)

To a declaration in debt on a bond, conditioned for paying plaintiff 10,000*l.*, upon his forming a company, and procuring purchasers for nine thousand shares therein, (such company to carry on a distillery according to a process for which a patent had been granted,) it was pleaded,—that the patent contained a proviso, rendering it void if transferred to more than five; that it was intended the said company should consist of more than five, and be formed for the purpose of enjoying the benefit of the letters patent, of acting as a corporate body, and of dividing the benefit of the patent into ten thousand shares, transferrable and assignable without charter from the king; and that it was corruptly and illegally agreed between the parties, that the plaintiff should form the company for such purposes, and should sell the nine thousand shares in order to raise a larger sum of money, under pretence of carrying on the privilege granted by the patent. The Court held the plea to be a bar to the action. (e)

(d) 21 Jac. 1, c. 3, s. 6.

(e) *Duergier v. Fellows*, 5 Bing. Rep. 248. S. C. 4 M. & S. 403. In delivering the opinion of the Court, Best, C. J., said, The words of the condition of the bond are, “have it in contemplation to dispose of their interest of, in, and to the several patents, and of, in, and to the premises and stock in trade, and to part with the same to a company.” These terms

Assignment of
patent.

Subject to the above mentioned restrictions as to its duration, and the number of persons that

indicate an intention not to destroy, but to transfer unimpaired the monopoly secured by the patents. But it has been said, it does not appear, from the pleadings, that the plaintiff knew of this proviso in the patents, and that the insertion of such a proviso in patents is not required by any law. But we must presume that he knew the contents of the patents referred to by the bond on which he brings his action of the patents, which, it appears by the same bond, he undertakes the sale in the manner stated in that bond. Every man who undertakes to do a thing must be prepared to know what he undertakes, unless he can shew that he has been deceived by the other party. How could he undertake to negotiate for the sale of the patents unless he had seen them, and knew their contents?

If the plaintiff knew the terms on which the patents were granted, he must know that what he undertook to do could not be done. As he cannot legally perform his part of the contract, he never can be in a condition to recover the compensation stipulated to be paid on its full and complete performance. There are some old authorities which say, that if a man binds himself by the condition of his bond to do what at the time he executed the bond it was impossible for him to do, the bond shall be considered as without condition, and the obligee may recover the penalty. These authorities are rather opposed to the plaintiff's claim; they apply only to cases where there is nothing to be done by the obligee; here the plaintiff must do something before the bond can be enforced. If what he is to do can never be legally done, the instrument must be inoperative.

The plaintiff not having performed the first condition, can never have a right of action on it. The situation of the plaintiff in this case, is like that of the defendants in the cases alluded to. It is his fault that he has undertaken what he cannot perform. In *Pullerton v. Agnew*, Holt, C. J., said, "Where the condition is underwritten or indorsed, there that

may, at any one time, be interested in it, a patent may be *assigned* in the same manner as other personal property. (*f*)

1. *Generally.*

2. *Under Commission of Bankrupt.*

If the grant be valid, the assignment of it in the usual way is of course good and effectual. Assignment generally. Where a patentee, having a lawsuit respecting the validity of his patent, made an absolute grant of it, (reserving to himself the legal right until the disputes were ended) in trust for the assignee, with a covenant to further assign: it was held, that, upon the determination of the suit, the patent vested without such second assignment. (*g*)

But far different is the effect of an assignment of a grant which afterwards appears to be an invalid one. If patent be void.

If he who has a patent-right (*h*) agree with

only is void, and the obligation is single; but where the condition is part of the lien itself, and incorporated therewith, if the condition be impossible, the obligation is void." In the case before us, the service of the plaintiff, and payment for it by the defendant, are incorporated together, and if the service cannot be performed, the whole instrument is a nullity.

(*f*) The property in a patent, and the right to exercise it, should go together. See *Ex parte O'Reilly*, 1 Ves. Jun. 118.

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

(*h*) *Hayne and Another v. Maltby*, 3 T. R. 438; and see 14 Ves. 132, 3. The plaintiffs were assignees of one J. Taylor, of a patent for an engine or machine, to be fixed to a common stocking frame, for making a sort of net or open work, called point net. Permission by an agreement was given to the

another person, for a valuable consideration, that the latter may use the manufacture for a certain time, upon certain conditions; yet if the patentee, for a breach of the contract and covenant, bring an action, it may be answered by shewing in any manner that the patent is a bad one, and invalid.

But where an action was brought by the assignee of a grant against the *patentee himself*, for using an invention, *the latter* was not per-

defendant to use the engine, *provided he worked it according to the specification*, and would not use any other patent engine for the same purpose. In an action at law on the agreement, breaches were assigned upon the latter condition. It was pleaded, amongst other things, that the specification was not enrolled in time: that the plaintiff Taylor was not the inventor, nor was the machine a new one. To which the plaintiffs demurred.

Kenyon, C. J.—It is contended, that the defendant shall be bound by his covenant, though the consideration of it is fraudulent and void. This is not to be considered as a covenant to pay a certain sum in gross at all events; but to use a machine in a particular way, in consideration of the plaintiffs having conferred that interest on the defendant, which they professed to confer by the agreement. The doctrine of estoppel is not applicable here. The person supposed to be estopped is the very person who has been cheated and imposed upon.

Buller, J.—We must consider the intention of the parties. If the plaintiffs had the exclusive right to the machine, they might convey it to any other person. It is now discovered that they had no such right; and, therefore, the defendant has not the consideration for which he entered into his covenant, and notwithstanding which, they say he is still bound. Judgment for defendant.

mitted, in violation of his own contract, to infringe the patent-right which he had assigned, and to deny that he had any power to convey, by shewing any thing that would invalidate his own patent. (i)

In *Bowman v. Taylor*, (j) in a declaration in covenant, a deed was set forth by which the plaintiff granted to the defendant a license to use certain looms. In that deed it was recited that the plaintiff had invented certain improvements, &c. in power looms, and had obtained letters patent, and caused a specification to be inrolled :— the Court held that the defendant was estopped from pleading, that the plaintiff was not the inventor; that it was not a new invention; and that no specification had been inrolled.

If a person, imagining that he has discovered something new, obtain a patent for it; (k) and

(i) *Oldham v. Langmead*, Sittings after Trin. 1789, coram Lord Kenyon, cited by Mr. Wigley, in arg. 3 T. R. 439.

(j) *Bowman v. Taylor and Another*, Law Journal, vol. xiii. p. 58; and see *Bowman v. Rosaw*, id. 62.

(k) *Taylor v. Hare*, 1 New Rep. 260; and see 13 East, 348. 16 East, 207, 8. 4 M. & S. 37. The patent was granted for "an apparatus for preserving the essential oil of hops in brewing." The defendant assigned his right to the plaintiff, upon condition of receiving from him and his partner, since deceased, an annuity of 100*l.* per annum during the term of the patent. After the plaintiff had used the apparatus, and paid the annuity to defendant for several years, it was discovered that he was not the inventor. The patent had never been repealed. The plaintiff, therefore, now brought

then assign it for a valuable consideration to another, who uses it for some time ; the assignee, though the grant afterwards prove to be a bad one, cannot recover the sum of money he originally gave for the purchase of it.

There must not, however, be the least appearance of *fraud* in the transaction. Both must have acted under the mistaken notion that it was a legal patent.

If it were discovered to be an invalid patent before the assignee had made any use of it, according to the rules and equity of good con-

the action to recover back the money which had been paid to the defendant.

Mansfield, Sir James, C. J.—In this case two persons, equally innocent, make a bargain about the use of a patent ; the defendant, supposing himself to be in possession of a valuable patent-right, and the plaintiff supposing the same thing. Under these circumstances the latter agrees to pay the former for the use of the invention ; and he has the use of it. *Non constat* what advantage he made of it. For any thing that appears, he may have made considerable profit. He would never have thought of using this invention, if the privilege had not been transferred to him.

Heath, J.—As well might it be said that if a man lease land, and the lessee pay rent, and afterwards be evicted, that he shall recover back the rent, though he has taken the fruits off the land.

Chambre, J.—Both parties were mistaken. Both have thrown away their money. In the case of Arkwright's patent, very large sums of money were paid for using the patent-right ; but no money was ever recovered back after the patent had been cancelled. Judgment of nonsuit.

science, it would seem that the purchase money ought to be returned.

Where several parties were jointly interested in a patent and its profits, and had entered into covenants with the plaintiffs, in consideration of a sum paid by them, under a joint contract and all had signed the receipt, the Court of Exchequer in Equity held, that one of the parties, having by fraudulent representations, (although without the knowledge of the others,) occasioned losses in respect of the patent, they were all liable to repay in *solido*, the money received on a consideration which had failed. (*l*)

And where the assignee of certain shares in a patent right covenanted that he had full power to convey, and that he had not by any means, directly or indirectly, forfeited his right over the same: it was held, that the generality of the former words were not restrained by the latter. (*m*)

Not only can this property be assigned generally, but it will pass to the assignees of a bankrupt patentee. (*n*) The grant obtained

Bankruptcy.

(*l*) *Lovell v. Hicks*, 2 Younge & C. 481.

(*m*) 3 Bos. & Pull. 565; and see 2 N. R. 71.

(*n*) *Bloxam v. Elsee*, 6 B. & C. 169. S. C. at Nisi Prius, 1 C. & P. 558. Abbott, C. J., said, "Looking at the act of Parliament, and looking at the usual clause in letters patent, and finding that in each of them there is a reference to the statute 6 Geo. 1, c. 18, and construing the whole clause either in the letters patent or in the act of Parliament, with reference to that which appears to my mind to be plainly and manifestly its object, it is my opinion that the whole clause is *confined to assignments by acts of the party*, and does not apply to any

by an *uncertificated* bankrupt for an invention made since the act of bankruptcy is affected by

assignment or transfer by operation of law, and, consequently, that it will not apply to an assignment under a commission of bankrupt. Under the ship register acts, there are peculiar clauses requiring every assignment to be notified in a particular manner, as clear and minute as words can be, without any exception of bankruptcy, or any thing of that kind, and yet it has been held, that the assignees of a bankrupt take the interest in a ship, though there is no registration of the conveyance. Upon that point I think there should be no rule, but some of the other points are well deserving of consideration, and as to them the defendant may take a rule."

Mr. Justice Bayley.—“I have no doubt upon the construction of this clause. I disclaim all right in the Court to introduce or exclude words from this clause, but I think we are bound to construe the words which the clause contains, and that is all which I desire to do. The words in this clause are, ‘in case the power, privilege, or authority shall at any time become vested in or in trust for more than the number of five persons or their representatives, at any one time, otherwise than by devise or succession (reckoning executors and administrators as and for the single persons they represent).’ There are not only the words ‘the number of five persons,’ but there are the words ‘or their representatives;’ and those words, ‘or their representatives,’ are entitled to have some meaning, and the words ‘otherwise than by devise or succession,’ will apply to the words ‘or their representatives’ as well as ‘the number of five persons.’ Now the question in my mind is, what does the act mean by ‘their representatives?’ If the assignees of a bankrupt are the representatives of a bankrupt, this patent is not vested in them, otherwise than this act of Parliament says it may be vested; it was vested in the Fourdriniers, the bankrupts, if they did not exceed the number of five: the bankruptcy, by a statutable transfer, has

the previous assignment of the commissioners; and, vesting in the assignees, is liable to be seized by them; even in the hands of third persons. (o)

made the assignees of the bankrupt the representatives of the bankrupt, and that is the construction which, in my opinion, these words are entitled to receive."

Mr. Justice Holroyd.—“I think that in this case, the assignees of the bankrupt are to be considered as the representatives of the bankrupt, and that they had his property as his representatives, and not as the representatives of the creditors. It is true, they take the property for the purpose of selling and disposing of it; and it is true, that the proceeds from the sale they may hold in trust for the creditors, but they are the representatives of the bankrupt in relation to this property. They hold it *subject to the power of converting it into money*, and then that money they will hold *in trust*. It appears to me, that, under the act of Parliament, it is not void, though the creditors may amount to more than five.”

(o) *Hesse v. Stevenson*, 3 Bos. & Pull. 577, Lord Alvanley. It was next contended, that the nature of the property in this patent was such, that it did not pass under the assignment. That the fruits of a man's invention do not pass. It is true, that the schemes which a man may have in his own head before he obtains his certificate, or the fruits which he may make of such schemes do not pass; nor could the assignees require him to assign them, provided he does not carry them into effect until after he has obtained his certificate. But if he avail himself of his knowledge and skill, and thereby acquire a beneficial interest, which may be the subject of assignment, I cannot frame to myself an argument why that interest should not pass as any other property acquired by his personal industry. We are, therefore, clearly of opinion that the interest in the letters patent was an interest of such a nature as to be the subject of assignment by the commissioners.

From the case of *Hesse v. Stevenson*, (*p*) we discover in what manner patents for inventions

(*p*) *Hesse v. Stevenson*, 3 Bos. & Pull. 565. This was an action of covenant. It appeared by a case reserved, that in June 1790, one Koops was duly declared a bankrupt. That on the 17th and 18th of May, 1801, the said Koops obtained patents. That Koops had assigned a certain share of the patent to the defendant, who had assigned a part of that share to the plaintiff. That an act had passed by which Koops was enabled to assign the use of the said patent to any number of persons, not exceeding sixty; which act was declared to be a public act. On 9th September, 1801, the creditors of Koops executed a deed of composition with him, to which several of his creditors were not parties. The assignees, and most of the creditors, by that deed, did remise, release, and quit claim unto the said Koops, his heirs, executors, and administrators, all actions, rents, claims, and demands whatsoever. Koops failed in the performance of the consideration of the said deed; whereupon the assignees entered up judgment upon the warrant of attorney, on 31st March, 1802, and on the 14th October following, issued a *fieri facias*; and, after taking the goods, &c., of Koops, entered upon the premises, where the manufactory, under the patents and act of Parliament, was carried on, and took possession of the same. In the deed-poll between the defendant of one part, and the plaintiff of the other, was the usual covenant for good title; that the said defendant had good right, full power, and absolute and lawful authority, to assign and convey the said shares, &c.; and that he had not by any means, directly or indirectly, forfeited any right or authority he ever had, or might have had, in the said shares. Breach that he had not good title.

Alvanley, C. J.—We shall consider the case as though the whole deed were before us. From all the cases upon this subject it appears to be determined, that however general the

are viewed by the bankrupt laws. After deciding generally that a composition entered into by the bankrupt, his assignees, and most of his creditors, by which, upon certain terms, the bankrupt had all his goods and chattels attempted to be reconveyed to him, was not a conveyance in law; it was held that the general covenant for good title of a patent right was not restrained by the covenant in which Stevenson, assignee of Koops, the patentee and bankrupt, says that he has not done any act to impeach his title. This decision arose principally from the words, "for and notwithstanding any act by him done to the contrary," being omitted.

It may be well to observe, that an uncertified words of a covenant may be if standing alone, yet, if from other covenants in the same deed it is plainly and irresistibly to be inferred that the party could not have intended to use the words in the general sense which they import, the Court will limit the operation of the general words. The question, therefore, always has been, whether such an irresistible inference does arise? The warranty in this deed, in the usual and almost daily words, where parties intend to be bound by their own acts only, *viz.* "for and notwithstanding any act by him done to the contrary," omits them altogether; besides which, the defendant covenants that the assignee shall enjoy the property assigned in as ample a manner as the assignor. The omission of the words is almost of itself decisive. We are, therefore, of opinion, that the covenant for absolute right to convey is not restrained by the other parts of the deed.

It is said, secondly, that the assignees have re-conveyed the whole of their interest; but I am of opinion that deed was not intended to convey, nor did it operate in law as a conveyance.

cated bankrupt, before he attempts to carry his schemes into execution, should obtain from his assignees a renunciation of all benefit of the patent.

A trust of a patent.

It was doubted by Lord Thurlow, (*q*) whether a patent, meaning letters patent generally, could be the subject of a *trust*; but it is humbly conceived, that one for an invention might become so, in the same manner as other personal property.

Indeed it is expressly stated, (*r*) that it shall not be *assigned in trust* to more than twelve persons, thus allowing it to be made a trust for the benefit of that number.

There was a trust declared in Cartwright's patent, and no objection was raised to it *on that account*. (*s*)

It has been shewn that the invention may be communicated by a foreigner residing abroad. (*t*) A patent may become the subject of a trust for the benefit of British subjects. But it was doubted in the case of *Bloxam v. Elsee*, (*u*) at nisi prius, whether a patent could properly be taken out by a British subject on a *secret trust*, to be held for the benefit of the real inventor, who was an *alien enemy* at the time, although it was stated in the patent that the patentee had received the inven-

(*q*) 1 Ves. Jun. 129. Ex parte *O'Reily*.

(*r*) Form of Patent, Appendix.

(*s*) 2 Bos. & Pul. 44.

(*t*) Ante, p. 81.

(*u*) 1 Carr. & P. 558.

tion from a certain foreigner ; and the point has not been solemnly decided.

From the reasoning in the cases of *Cartwright v. Amatt*, (*v*) and *Bloxam v. Elsee*, (*w*) it would seem, that the mortgage of a patent to more than twelve persons would be valid, for neither their interest as creditors of the patentee, nor their character as trustees to the patentee, until they were repaid, would cause a forfeiture, because creditors are not entitled to *any proportion of the patent right* as such, but only to the amount of their debts.

Mortgage and lien.

In 1812, a case (*x*) came before the Lord Chancellor, of a bankrupt having a patent for an invention, who, after having mortgaged the right, continued in the *notorious use* of the invention until his bankruptcy. The Lord Chancellor was induced to think that the right passed to the assignees under the statute, but directed a case for the Court of King's Bench, which was never argued.

It may be bequeathed in any manner the patentee pleases. If he make not a will, it is assets in the hands of his administrator. (*y*)

Proper for a devise.

If the patentee does not wish to dispose wholly with his patent, he may grant *licences* to persons to *use it*. And it would appear, in the event of an infringement of the patent right, that all

Licence to use it.

(*v*) 2 Bos. & Pul. 43.

(*w*) 6 B. & C. 169.

(*x*) Evans's Statutes, vol. iv. p. 67, n. Ex parte *Granger*.

(*y*) 1 Ves. Jun. 118 ; and see 3 B. & P. 573.

who have licences may maintain actions for damages. (z)

3. Enlargement
of the patent
right by
parliament.

The transcendent power of Parliament, now exercised in part by the Judicial Committee of the Privy Council, (a) has, however, often been called forth to give a better effect to the right of patentees for inventions, by *extending the term* of its duration, or *increasing the number* of persons that may, at any one time, become interested in a patent.

The extension of the term is advised by the Judicial Committee, when it appears that the application, labour, and expense, of the patentee have been so great that he has not been able to receive, within the time allowed by his patent, an adequate reward from his great undertaking. Other causes have had their due effect upon Parliament; as when the patentee has discovered some improvements which have been attended with great expense, and by which the machine is become much more profitable to him, and beneficial to the community; or, where dying, he has left his family unable to proceed with the manufacture without that indulgence.

And the legislature will also lend its assistance when the undertaking is of such a magnitude that twelve persons are unable by themselves to reap any benefit from the grant, by passing an

(z) Ante, 24. *George v. B. Wackerback and Another*, MSS.

(a) 5 & 6 Wm. 4, c. 83. 2 & 3 Vict. c. 67.

act of Parliament, giving power to the patentee to assign the patent right to any number of persons. The interest in Koop's patent was, by an act of Parliament, made capable of being divided into *sixty* shares. (b)

In almost every instance in which the legislature has interfered, a proviso was introduced, that every objection in law competent against the patent shall be of the same force against the act to all intents and purposes. (c) But even if that clause were not introduced, yet the patentee, as to the *validity* of the patent, or his *title* to it, was in the same situation as though the act had never been passed. (d) The same rule applies under the 5 & 6 Wm. 4, (e) to a new patent, granting an extension of the term to seven years.

II. PROPERTY IN DISCOVERIES NOT PROTECTED BY A PATENT.

Some persons, alarmed at the frauds frequently practised upon inventors, and strongly impressed with the difficulty of making a sufficient specification, and perhaps suspicious of the manner in which the patent may be construed, have preferred to keep their discoveries secret, and to use or vend their manufacture without the protection of a patent. No one, however, can have a property—an exclusive right—in

(b) 3 Bos. & Pull. 565.

(c) See 41 Geo. 3, c. 125, Local and Personal Acts.

(d) 3 Bos. & Pull. 578.

(e) 5 & 6 Wm. 4, c. 83.

such a subject. (*f*) Injury and remedy are inseparable in law; but as there is not any rule of law, nor yet in equity, to punish or to prevent any one from making use of such manufactures, we may conclude that such discoverers do not sustain an *injury* to any legal property.

Of course, the case is altered, when any *fraud*

(*f*) *Canham v. Jones*, 2 Ves. & Beam. 221; and see *Williams v. Williams*, 3 Meriv. 157. The bill stated that Isaac Swainson was, for upwards of thirty years before his death, the sole proprietor of the secret or recipe for preparing the medicine called *Velno's Vegetable Syrup*, which he had purchased for 600*l.*, and by his will bequeathed to the plaintiff; who, since his decease, continued to make the same preparation as specified by the recipe, and made great profit; and would have made much greater, if the defendant had not imposed on the public a spurious composition under the same name. Demurrer.

Sir Thomas Plumer, V. C.—This bill proceeds upon an erroneous notion of exclusive property now subsisting in this medicine; which Swainson having purchased, had a right to dispose of by his will; and, as it is contended, to give the plaintiff the exclusive right of sale. If this claim of monopoly can be maintained without any limitation of time, it is a much better right than that of a patentee. But the violation with which the defendant is charged does not fall within the cases in which the Court has restrained a fraudulent attempt by one man to invade another's property; to appropriate the benefit of a valuable interest in the nature of good will, consisting in the character of his trade or production, established by individual merit; the other representing himself to be the same person, and his trade or production the same, as in *Hogg v. Kirby*, 8 Ves. 215, combining imposition on the public with injury to the individual. Demurrer allowed.

is practised in getting at the secret. One person must not use the name of another, nor represent his article to be the same as the one thus secretly made, or he will be liable to answer for damages in an action at law, or be restrained from using it by an injunction. (*g*)

Nor will the Court prevent a person from imparting the secret of an invention which had been the subject of a patent long since expired, the specification of which was so incorrect, that the discovery still remained undisclosed. (*h*)

But a man has such a property in his invention before a patent is procured, that if he agree to inform another person of the secret, who binds himself in a penalty not to avail himself, or take any undue advantage of the communication; he may maintain an action for the breach of that contract. (*i*)

(*g*) *Yovatt v. Arnyard*, 1 Jac. & Walk. 394. And the case of *Day & Martin*, E. T. June, 1821, MSS. before Abbott, C. J.

(*h*) *Newberry v. James*, 2 Mer. 446.

(*i*) *Smith v. Dickenson*, 3 Bos. & Pull. 630, post.

CHAP. VIII.

OF THE INFRINGEMENT OF A PATENT, AND THE
REMEDIES FOR THAT INJURY.

THE patentee having ascertained the nature of the property he has acquired by the grant, the next topic for investigation will be the conduct of persons, when it is considered to be an *infringement* of that right: and the necessary *remedies* which the law has prescribed for the injury.

I. WHAT AMOUNTS TO AN INFRINGEMENT.

Whether the act of the defendant is really an infringement of the grant is a question for the jury. (*a*)

(*a*) 2 Hen. Bla. 480. It is a very difficult question, and by some persons it has been thought that it is a matter beyond the comprehension of the ordinary tribunals; and they have recommended that a court of commissioners should be formed. A little reflection would convince any unprejudiced mind that the same judges and juries who decide causes arising from matters connected with every relation of life, and involving every exertion of men to enrich themselves, might well decide the question, whether a person had infringed a patent. The judges possess, as a part of their education, a knowledge of the first principles of every science, and it would be as rea-

The law cannot be evaded by fraud or deceit of any kind. It has been decided that the making or using of any the *least part* of a manufacture (*b*) is an infringement. If the article manufactured by the defendant be of a different *form*, (*c*) or made with slight and immaterial additions, or by the substitution of things somewhat different from those used by the patentee ; yet, if the manufactures are really sonable to say, that physicians and surgeons should try all cases which require a knowledge of medicine or surgery to be understood, as that mechanics and chemists should try the validity of claims for patents. In both cases it is more reasonable that physicians, surgeons, mechanics, and chemists, should be witnesses.

The answers to the questions, whether patents are for the same or different things, or whether one patent is an infringement upon another, may be drawn from many circumstances : as the concurring or contradictory evidence of persons worthy of credit well acquainted with the matter. But the use made of a supposed invention by the public is the best criterion, whether it is an improvement or not.

(*b*) In *Manton v. Manton*, Dav. Pat. Cas. 348, the alleged infringement consisted in making a perforation in the hammer of a gun, in a direction a little different to that in the patent article.

(*c*) 2 Hen. Bla. 477 ; and see *Bovill v. Moore*, Dav. Pat. Cas. 405. Gibbs, C. J.—I remember that that was the expedient used by a man in Cornwall, who endeavoured to pirate the steam engine. He produced an engine, which, on the first view of it, had not the least resemblance to Boulton and Watt's. Where you looked for the head, you found the feet ; and where you looked for the feet, you found the head. But it turned out that he had taken the principle of Boulton and Watt :—it acted as well one way as the other ; but if you set it upright, it was exactly Boulton and Watt's engine.

and substantially the same, the patentee is entitled to a remedy at law. (*d*)

In *Webster v. Uther* (*e*) the Lord Chief Justice observed, “ I believe I told the jury that it was

(*d*) See the elaborate opinion of the Court in *Hill v. Thompson*, 2 B. Moore, 447. Dallas, J.—Whether the patent be valid or not, signifies nothing in this particular case, if the defendants have not worked according to the specification. To prove the infringement of the patent, one witness only was called; this part of the case, therefore, depends entirely upon his testimony; and, before adverting to the evidence in question, it will be necessary to look at the patent, as far as it relates to this part of the subject. It has not been contended that it is a patent introducing into use any one of the articles mentioned therein, as singly and separately taken; nor could it be so contended, for the patent itself shews the contrary; and if it had been a patent of such a description, it would have been impossible to support it; for slags, as well as mine rubbish, and lime, had undoubtedly been made use of before it was passed. But, it is said, it is a patent for combinations and proportions, producing an effect altogether new, by a mode and process, or series of processes, unknown before; or, to adopt the language made use of at the bar, it is a patent for a combination of processes altogether new, leading to one end;—and this being the nature of the alleged discovery, any use made of any of the ingredients singly, or used in partial combination, omitting some, and making use of all or some, in proportions essentially different, and yet producing a result equally, if not more beneficial, will constitute an infringement of the patent. It is scarcely necessary here to observe, that a slight departure from the specification for the purpose of invasion only, would, of course, be a fraud upon the patent; and, therefore, the question will be, whether the mode of working by the defendants has or has not been *essentially or substantially different*.

(*e*) MSS. Easter Term, 1824, before Lord Tenterden.

the smallest matter for which I ever knew a patent taken." The invention was called an improvement on the patent percussion gun lock, and consisted in the *addition of a bolt* sliding or moving in a groove, by which the roller magazine was then fixed, that had formerly been fastened by a screw and washer ; the defendant's lock had a spring in the bolt.

The jury (upon the evidence of *sportsmen* that the lock with a sliding bolt was more readily used in the field, particularly in wet weather, than the screw and washer,) found that the alteration was a material and useful improvement ; and upon evidence, *by mechanics*, that a spring in a bolt was the same thing as a bolt sliding in a groove, they found that the defendant had infringed the patent of the plaintiff. The Court would not grant a new trial.

It was contended in that case, *Webster v. Usher*, that the question, whether the thing was a proper subject for a patent, was one of law and not of fact for the jury. And in *Barton v. Hall* (*f*), which was an action for an infringement of *Barton's* patent for improvements in metallic pistons for steam engines, the judge directed a nonsuit, taking on himself to decide that the pistons, which were alleged to be infringements, were not the same invention as that described in the specification of the plaintiff.

In *Jones v. Pearce* (*g*), the jury asked the

(*f*) MSS. 11th July, 1827, before Lord Wynford.

(*g*) MSS. ante, p. 46.

judge whether it was a necessary part of the infringement that the defendant should have sold or used the carriage wheels which he had made. Mr. Justice Patteson said, “the evidence is, that the defendant, who was an ironmonger, had *made* two wheels, one of which was put on a gig and the other was seen near it; and he told the witness that he had made them on a new principle. Now, one of the counts of the declaration is for making; and if he did actually make the wheels, the act of making them would be a sufficient infringement of the patent; for the terms of the patent are, ‘without leave or licence *make, &c.*’ ”

If there are some articles well specified, and others that are only mentioned in the specification, without any intention of their being considered as perfect instruments, but merely as speculative matter, as was done by Mr. Watt in his patent, (*h*) although the latter cannot be protected, and may consequently be infringed with impunity; yet any infringement of the former parts or articles cannot be excused.

Even if the improvement of a manufacture be so great and important that the *substratum* is insignificant in comparison with it, still no claim can be laid to the whole. The addition may be made and vended by itself. (*i*)

(*h*) Ante, 136. It has been doubted, whether the insertion of imperfect articles ought not to invalidate the grant.

(*i*) 1 Ves. & Beam, 67.

In a declaration for infringing a patent, (j) which granted that the plaintiff, and no others,

(j) *Minter v. Williams*, 4 A. & E. 251. Mr. Justice Coleridge said,—The granting part of the patent authorizes the plaintiff exclusively to “make, use, exercise, and vend” his invention. The prohibitory part forbids all persons to “make, use, or put in practice the said invention,” or “counterfeit, imitate, or resemble the same,” or to make “any addition thereunto, or subtraction from the same, whereby to pretend himself or themselves the inventor or inventors,” without licence from the plaintiff. Then the count alleges that the defendant, without the plaintiff’s licence, exposed to sale divers chairs intended to imitate and resemble, and which did imitate and resemble, his invention.

Do those words necessarily import the vending spoken of in the granting part of the patent? I certainly think not; because, even assuming that to vend may mean both a selling and an exposing to sale, (though I rather think it means the habit of selling and offering for sale), still those two meanings are not co-extensive; the former may include the latter, but a mere exposure to sale, *i. e.*, with intent to sell, or for the purpose of selling, is not only not equivalent to a sale, but, as regards the patentee, may be attended with wholly different consequences. If we read the word “vend” as expressly inserted in the prohibitory part of the patent, we ought only to give it there the meaning which would effectuate the purpose of the patent, the prevention of acts injurious to the patentee, with as little restraint on the public as possible. It must be taken here, that the defendant has only exposed to sale, that whatever may have been his original purpose in so doing, or whatever motive has supervened, he has abstained from selling.

Now, I cannot say that such a mere exposure to sale is necessarily injurious to the patentee; it may, on the contrary, be very beneficial; it is not, therefore, necessarily the vending which is exclusively granted to him. As to “using

should “make, use, exercise, and vend” his invention, and forbade all persons to “make, use, or put in practice” the same, or to counterfeit or imitate it, without the plaintiff’s licence, the plaintiff alleged that the defendant, without his licence, exposed to sale articles intended to imitate his invention: the Court held, on general demurrer, that the count was bad, as not stating any thing which was necessarily an infringement of the patent.

It is a wise maxim in our law that there is not an injury without its concomitant remedy. Formerly, patent-rights were investigated in the Star Chamber: (*h*) but, by the statute of Monopolies, (*l*) it was enacted, “that monopolies, letters patent, &c., and their force and validity, ought to be, and shall be, examined, heard, tried, and determined, by and according to the *common laws* of this realm, and not otherwise.” Hence the remedies for this injury are, either,

An action at law for damages ; or
Proceedings in Equity for an injunction
and account.

and exercising,” those words cannot be fairly resorted to, when we find with them the word “vending,” and that is passed by. But, if they could, the argument would be the same ; this might be an innocent using and exercising, and so not prohibited.

(*h*) 3 Inst. 183.

(*l*) 21 Jac. I. c. 3, s. 2.

II. REMEDY AT COMMON LAW.

When the King has granted a patent for the sole use of any invention, the common law gives a right of action against every person who infringes it. (*m*) It is in form an action on the case. (*n*)

Although the patentee has been defeated in one action, still he may maintain fresh suits against other persons: as was done by Mr. Arkwright (*o*) and by Mr. Watt. For actions on the case will lie, notwithstanding the patent is really void, until it has been cancelled. (*p*)

If the patent has been assigned, the assignee may sue alone, or he and the patentee may join in the action. (*q*)

1. The pleadings.
The parties.

(*m*) Buller, N. P. 76.

(*n*) 1 Chit. Pl. 142.

(*o*) *Arkwright v. Nightingale*, Dav. Pat. Cas. 55. Lord Loughborough.—It has been said that many persons have acted upon an idea that Mr. Arkwright had no right, he having failed to establish it when this cause underwent an examination in another place, in which the event was unfavourable to him. If the question at present were, what damages Mr. Arkwright should have received for the invading that right? I would have allowed the parties to have gone into evidence to shew to what extent persons had acted upon the faith of the former verdict; but the question now is upon the mere right; and if the result of this case is in favour of the plaintiff, the verdict will be with one shilling damages. A future invasion of this right would entitle Mr. Arkwright to an action for damages; but in the present case they are not asked.

(*p*) 2 Ventr. 344. Dav. Pat. Cas. 55.

(*q*) 2 Wils. 423, 2 Saund. 115-6, a.

The declaration.

When a grant by letters patent is pleaded, it ought to be shewn under *what* seal it is made; (r) and therefore, in the declaration for an infringement, the patent must be stated to be under the *great seal*. (s)

A profert is made of the letters patent, which are recited, but oyer of them is never allowed, (t) because they are matters of record.

Venue.

The venue in this action must always be laid in the county of Middlesex. In *Cameron v. Gray*, (u) a motion was made to change the venue from Middlesex to Northampton. The rule was refused, because the patent, which is the substratum of the action, is tested at Westminster.

Plea, &c.

The usual plea was *not guilty*, which, putting in issue of the whole of the declaration, forced the plaintiff to support the grant in all its parts, and gave to the defendant the greatest latitude for evidence; but now, the defendant must plead all his defences, (v) and must also deliver in a list

(r) 2 Inst. 555; 1 Vent. 222; 9 Co. Rep. 18.

(s) For precedents of declarations, see the record at full length in *The King v. Arkwright*, printed case. And see *Boulton v. Bull*, 2 Hen. Blz. 453. Dav. Pat. Cas. 162. 2 Chit. Pl. 355. 8 Went. Pl. 431.

(t) *Rex v. Amery*, 1 T. R. 149. 1 Saund. 96, a. 1.

(u) 6 T. R. 363. And see *Rex v. Haine*, 2 Cox, 235. See also *Brunton v. White*, 7 D. & R. 103, in which the venue was laid in London. A motion was made to change the venue to Lancaster. The Court refused the rule.

(v) See Rules of Court of Hil. Term, 4 Wm. 4, 1834.

of the objections upon which he intends to rely at the trial. (*w*)

In an action for infringing a patent, with a plea, alleging the user of the invention by other persons, the Court of Common Pleas held, under the 5 & 6 Wm. 4, c. 83, that a judge had jurisdiction to order a further and fuller notice of the names and addresses of all those alleged so to have used it. (*x*)

The defendant, for any thing on the face of the declaration, by which it clearly appears that the patent is void, may *demur generally*, as if the grant be of a thing for which a patent ought not to have been obtained. (*y*) Demurrer.

(*w*) By the 5th sec. of 5 & 6 Wm. 4, c. 83, it is enacted, "That in any action brought against any person for infringing any letters patent, the defendant, on pleading thereto, shall give to the plaintiff, and in any *scire facias* to repeal such letters patent, the plaintiff shall file with his declaration, a notice of any *objections* on which he means to *rely* at the trial of such action, and no objection shall be allowed to be made in behalf of such defendant or plaintiff respectively at such trial, unless he prove the objections stated in such notice; provided always, that it shall and may be lawful for any *judge at chambers*, on summons served by such defendant or plaintiff, on such plaintiff or defendant respectively, to shew cause why he should not be allowed to offer other objections whereof notice shall not have been given as aforesaid, to give leave to offer such objections on such terms as to such judge shall seem fit."

(*x*) *Bulnois v. Mackenzie*, 4 Bing. N. C. 127. S. C. 6 Dowl. (P. C.) 215. The Court of Exchequer came to a similar conclusion in *Losh v. Hague*, MSS.

(*y*) See *Minter v. Williams*, 4 A. & E. 251.

2. Evidence.
By plaintiff to
support the
patent.

By the common law, (z) a *constat* or *inspeximus* of the King's letters patent could not be shewn forth in Court, but the letters patent themselves must have been produced; but by the statute 3 & 4 Ed. 6, c. 4, explained by stat. 13 Eliz., c. 6, "patentees, and persons claiming under them, may make title in pleading, by shewing forth an exemplification of the letters patent, as if the letters patent themselves were pleaded and shewn forth; and now they are to be given in evidence in the same manner as if they were pleaded.

It is necessary in this, as in every other case, that the plaintiff should be prepared to prove the material allegations in his declaration; that the invention in all the parts to which the patent applies is *new* and *useful*; (a) that he is the *inventor*, and that the *specification* is sufficient in law. "I do not agree," said Mr. Justice Buller, (b) "with the counsel who have argued against the rule, in saying that it was not necessary for the plaintiff to give any evidence to shew what the invention was, and that the proof, that the specification was improper, lay on the defendant; for I hold that a plaintiff must give some evi-

(z) *Olive v. Gwyn*, Hardr. 119. Phil. on Evid. 498; and see 5 Co. 53. Bro. Surrender, 51. Co. Lit. 225, b. Dyer, 167—179. *Att. Gen. v. Taylor*, Prec. Ch. 59.

(a) *Boville v. Moore*, Dav. Pat. Cas. 399. *Manton v. Manton*, id. 348, 9.

(b) *Turner v. Winter*, 1 T. R. 606, 7; and see 2 B. Moore, 250.

dence to shew what his invention was, unless the other side admit that it has been tried and succeeds. But wherever the patentee brings an action on his patent, if the novelty or effect of the invention be disputed, he must shew in what his invention consists, and that he produced the effect proposed by the patent in the manner specified. Slight evidence of this on his part is sufficient, and it is then incumbent on the defendant to falsify the specification."

In the case of *Lewis v. Davis* (c) the patent put in evidence referred in its title to another patent. The plaintiffs claimed a patent for "improvements in a machine for which J. Lewis took out a patent in 1815." It was contended, that the specification to the patent of 1815, ought to be put in evidence. Lord Tenterden held, that it was necessary to give both the specifications in evidence, and observed, "When the parties applied to the Crown in the year 1818, they might have applied for a patent for their invention, without reference to anything that had gone before. Now, that they have not done; on the contrary, they profess to have improved a machine already known. That machine may be used by any one after fourteen years from the earlier patent, but any new matter which is included in the present patent is not open to every body, till fourteen years from a later period. It is, therefore, material to shew what are the improve-

(c) 3 Car. & P. 502.

ments contained in the plaintiff's patent. Now, I cannot say what are improvements upon a given thing, without knowing what that thing was before; for aught I know, all the things mentioned in the plaintiff's specification may have been included in the former specification. Sometimes the fact of infringement must be presumed from the acts of the party, as where he sells the same article, and will not shew his factory. (*d*)

It is good *prima facie* evidence, that experienced and intelligent men, versed in the art or mystery in which the invention has been made, have never before heard of it; (*e*) yet the novelty of the invention cannot be thus proved if one witness is produced who states that he has used it. (*f*)

After the plaintiff has thus supported his patent, he is required to prove that the defendant has infringed it, to whom it will be open to shew that he has not worked according to the specification. (*g*)

What amounts to an infringement has been considered, (*h*) from which it is easy to determine what evidence is necessary in each particular instance. In case for the infringement of a

(*d*) *Hall v. Gervas and Boot*, MSS. December, 1822, in K. B.

(*e*) *Manton v. Manton*, Dav. Pat. Cas. 350.

(*f*) Ante, p. 40; and see *The King v. Arkwright*, Printed Case, 183. Dav. Pat. Cas. 135.

(*g*) *Hill v. Thompson*, 2 B. Moore, 447.

(*h*) Ante, 230.

patent, (i) a purchaser of a licence to use the patent, is a competent witness for the plaintiff.

In several instances, it has been very difficult to prove the infringement, especially where it is to be ascertained by the examination of the manufactures. It is possible that two persons might make articles equally good and cheap by machines constructed upon different principles; but it is hardly probable that the manufactures would agree in all their parts.

Proof by inspection of manufactures.

The enrolment of a specification, after the patent of another party for the same invention, has been sealed, and his discovery known upon the market, does not of itself alone afford any proof whatever of the want of novelty in the manufacture made under the patent of that party. (j)

It was observed to the jury by Lord Ellenborough, in *Huddart v. Grimshaw*, (k) after it was proved that the defendant would not allow his manufactory to be inspected to furnish evidence for the cause, "When one sees the rope of the defendant agree in all its qualities with a rope actually made upon the plaintiff's plan, it is *prima facie* evidence till the contrary is shewn, that it was made upon his method; and therefore, as against him it should seem, supposing the patent in full force and a valid one, it is reasonable fair evidence, in the absence of contrary evidence, to presume that it was made in

(i) *Derosne v. Fairie*, Moody & R. Rep. vol. i. 457.

(j) *Cornish v. Keene*, Law Journal, vol. xv. p. 225.

(k) Dav. Pat. Cas. 288, 289.

that way. There is certainly great weight in the observation of the counsel,—Am I to come forward and divulge my mode of making rope, and from which I reap a great advantage?—Whether it was necessary to have gone that length in proof does not appear. Persons might have been called upon who might not be privy to the making of strands in the small room; however, whether it puts him to inconvenience or not, the question is, whether it is *prima facie* probable presumptive evidence, in the absence of evidence on the other side; and it is a competent ground for you, if you think the facts bear you out, to form that conclusion upon.”

The case of *Rex v. Hadden* (1) illustrates the practice of giving evidence. A witness was called to prove that the invention was not new, because he had made a similar machine for the same object. A drawing, not made by the witness, of the machine, as constructed by him, was put into his hands, and he was asked whether his machine agreed with that drawing. It was objected that, inasmuch as the drawing was not made by the witness, he could not be allowed to answer that question, but that he was bound to describe the machine. Mr. Justice Bayley observed, “I think that the witness may look at the drawing, and you may ask him whether he has such a recollection of the machine he made, as to be able to say that, that is a correct drawing of it.”

(1) 2 Car. & Payne, 184.

When the plaintiff has closed his case, the defendant may give any evidence which will shew that the grant is invalid, as that the patentee was not the inventor, or that the subject is not a proper object for a patent, or that the specification is incorrect. Or he may otherwise shew that the plaintiff has no right to sue.

Evidence by the defendant.

The question generally arises on the specification. It is often attempted to be shewn that it was the intention of the patentee, at the time he made the specification, to conceal the invention.

Intention of patentee to conceal invention.

It was proved that Arkwright said, that his description would operate as a specification, but that he had made it as obscure as the nature of the subject would allow ; (m) and also that he had, in a petition to the House of Commons, admitted that he had not properly specified how the machine was to be made, on purpose that foreigners might not use it. (n)

A witness may be asked whether the invention might not with ease have been clearly described, and whether he does not think that the description is *very* obscure. (o)

To prevent the miscarriage, which will almost always take place, in the endeavour to prove an infringement by comparison of the manufactures,

(m) *The King v. Arkwright*, Printed Case, 173. Dav. Pat. Cas. 108.

(n) *Id.* Printed Case, 176. Dav. Pat. Cas. 115, 116.

(o) *Id.* Printed Case, 96.

it is prudent first to apply to a court of equity to appoint persons to inspect the manufactories, as was done in several cases. (*p*)

Trial by comparing specification with patent.

The validity of the patent may, however, be questioned upon the putting in and reading of the specification. If they do not support each other: if the description in the latter be palpably at variance with the title of the thing claimed by the former instrument, the plaintiff must fail. In the *King v. Wheeler*, (*q*) Abbott, C. J., did not leave any point to the jury, because he conceived that on the face of the record it was clear that the patent was void, whatever evidence might be produced.

New trial in law.

The patentee must be very careful in collecting his evidence; for, after a verdict has once been given, the Court is very anxious not to put the parties to further expense by sending them back to a new trial. (*r*)

A rule *nisi* for a new trial was refused to Arkwright, (*s*) although he stated in his affidavits that he did not expect the *originality* of his invention to be attacked; that he was taken by surprise; and that on a future occasion he would adduce evidence to contradict or explain the evidence given against him. He added, he did not conceive that the point, that some of the

(*p*) Remedies in Equity, post, 250.

(*q*) 2 Barn. & Ald. 345.

(*r*) A new trial was granted in *Derosne v. Fairie*, 5 Tyr. 393.

(*s*) Page 188 of the Printed Case. Dav. Pat. Cas. 142.

articles were immaterial, and inserted only for the purpose of causing misconceptions, would have been litigated.

On the motion for a new trial, in *Lewis v. Marling*, (t) affidavits were produced as to the publication of the machine whereof the plaintiffs claimed to be inventors before the patent was granted. Lord Tenterden said, "it is contrary to the practice to grant a rule in such a case on affidavits. If the facts disclosed in them are sufficient to vitiate the patent, it may be repealed by *scire facias*."

Pending a rule *nisi* for a new trial, the defendant sued out a *scire facias* to try the same right. The Court of Common Pleas refused to postpone the proceedings on the rule for a new trial until a decision should have been obtained on the *scire facias*. (u).

If judgment be given for the patentee, he may of course bring other actions against every person who has infringed his right. If it be against him, still he may proceed in fresh suits, for no one is at liberty to use and vend the manufacture without subjecting himself to be sued, until the letters patent have been *cancelled*. (v) Judgment.

The costs of an action for the infringement of a patent are guided by the rules respecting other actions on the case. (w) Costs. It is often necessary for

(t) 10 Barn. & Cres. 25.

(u) *Haworth v. Hardcastle*, 10 Bing. Rep. 551.

(v) 2 Ventr. 344. See *Arkwright v. Nightingale*, Dav. Pat. Cas. 55.

(w) *Losh v. Hague*, 7 Dow. Prac. Cases, p. 495.

the parties to make many expensive *experiments* in order to give evidence for or against a patent. The costs of those experiments do not fall on the losing party. In the case of *Severn v. Olive*, (w) the Court (after hearing arguments) directed that the prothonotary should review his taxation, on the ground that no allowance ought to be made for the expense of experiments, nor for the time of scientific witnesses, unless they were medical men.

On the subject of costs a great improvement is made, by section 6 of 5 & 6 Wm. 4, c. 83, where it is enacted, "That in any action brought for infringing the right granted by any letters patent, in taxing the costs thereof, regard shall be had to the part of such case which has been proved at the trial, which shall be certified by the judge before whom the same shall be had, and the costs of each part of the case shall be given according as either party has succeeded or failed therein, regard being had to the notice of objections, as well as the counts in the declaration, and without regard to the general result of the trial."

Although a patentee was defeated in an action which proved his patent to be invalid, still he might continue to bring actions at law ; and, on the other hand, although he had supported his patent, and proved its validity at a very great expense, yet the infringers might go on and put

(w) 3 Brod. & Bing. 72.

him to a continual outlay, which in some cases has caused his ruin.

A very important improvement has been introduced. By section 3 of 5 & 6 Wm. 4, c. 83, it is enacted, "That if any action at law, or any suit in equity, for an account, shall be brought in respect of any alleged infringement of such letters patent heretofore or hereafter granted, or any *scire facias* to repeal such letters patent, and if a verdict shall pass for the patentee or his assigns, or if a final decree or decretal order shall be made for him or them, upon the merits of the suit, it shall be lawful for the judge, before whom such action shall be tried, to certify on the record, or the judge who shall make such decree or order, to give a certificate under his hand, that the validity of the patent came in question before him, which record or certificate being given in evidence in any other suit or action whatever, touching such patent, if a verdict shall pass, or decree or decretal order be made, in favour of such patentee or his assigns, he or they shall receive treble costs in such suit or action, to be taxed at *three times the taxed costs*, unless the judge making such second or other decree or order, or trying such second or other action, shall certify that he ought not to have such treble costs." (x)

A patent for the exclusive use of an improve- Mandamus.

(x) A patentee obtained a verdict. He then commenced forty actions. After the trial of one of them the patent was held to be invalid.

ment in the invention of anchors, contained a proviso for avoiding the patent, if the patentee should not supply for his Majesty's service all such articles of the invention as should be required, on such reasonable terms as should be settled by the Lords of the Admiralty. The latter used the invention, but did not take the articles from the patentee. The Court refused to issue a mandamus to them, to settle the terms according to the patent. (*y*)

III. REMEDY IN EQUITY.

1. The jurisdiction of a Court of Chancery.

The jurisdiction exercised by the Court of Chancery over patents for inventions is merely in aid of the common law; from which, by the delay sometimes arising in its proceedings, some injury might be felt by the patentee. This interference is made between the parties in order to give full effect to the provisions of the statute of James; and is never allowed to be called for, but upon the supposition, that the property in the patent, generally inferred from his possession of it, belongs to the applicant, and that he has been fraudulently dealt with by the defendant. (*z*)

The great advantage gained by commencing proceedings in equity (*a*) for an infringement, before recourse is had to the common law courts,

(*y*) *Ex parte Pering*, 4 Adol. & E. 949.

(*z*) *Boulton v. Bull*, 3 Ves. 140; and see 14 Ves. 132. 6 Ves. 607. 1 Maddox, Chan. p. 113, and post, Book III. c. VIII.

(*a*) Mitford's Chanc. Plead. 124.

arises from the power of that Court immediately to restrain the party from any further use of the patent-right, and to order him to give an account of his profits.

“The principle,” said Lord Eldon, (b) “upon which the Court acts in cases of this description, is the following:—where a patent has been granted, and an exclusive possession of some duration under it, the Court will interpose its *injunction* without putting the party previously to establish the validity of his patent by an action at law. But where the patent is but of yesterday, and upon an application being made for an injunction, it is endeavoured to be shewn, in opposition to it, that there is no good specification, or otherwise that the patent ought not to have been granted, the Court will not, from its own notions respecting the matter in dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial; but will send the patentee to law, and oblige him to establish the validity of his patent in a court of law. It will, however, in the mean time, grant him the benefit of an injunction.”

The grounds on which injunctions are granted.

Although possession has been distinctly proved; yet, if there be a strong doubt whether the specification is not bad in law, the Court will

(b) *Hill v. Thompson*, 3 Meriv. 624; and see *Prodgers v. Phrazier*, 1 Vern. 137. 2 Atk. 286, 391, 485. 1 Vern. 120. Id. 275. Amb. 406.

brevi manu interfere, and put an end to the injunction. (c)

2. The practice.
Filing a bill.

Of the manner of filing the bill for relief, which, in general, prays for an injunction and an account, with the method of issuing the subpoena, its services, &c., reference must be made generally to the books of practice, (d) observing that for each distinct invasion of the patent there must be separate bills filed. (e)

A bill (f) having been filed by an assignee of certain alleged patent inventions, for an injunction to restrain the infringement of the patents,

(c) *Harmer v. Playne*, 14 Ves. 132. *Grierson v. Eyre*, 9 Ves. 341. Forsyth's patent (for giving fire to artillery and all kinds of fire arms) came before a court of equity. (MSS. July, 1816.) The invention consisted in the application of percussion powder for priming artillery and fire arms, by introducing it into a hollow cylinder communicating with the touch-hole, and inserting a moveable plug or stopper into the cylinder, so as to inclose the powder between the bottom of the cylinder and the end of the plug. By striking a blow on the plug the powder became ignited, and the piece fired off. The Lord Chancellor *had doubts* as to the novelty of the invention, and he decreed that the patentee might bring an action at law; and, having succeeded, might move for an injunction. In other words, he found no protection in equity, but brought an action at law, *Forsyth v. Reviere*, (ante, 31,) by which his patent was supported.

(d) 2 Maddox. Chan. Ch. VII., and Eden on Injunctions, Ch. XV.

(e) *Dilly v. Doig*, 2 Ves. jun. 486.

(f) *Few v. Guppy*. *Few v. Petre and Another*. *Guppy v. Few*, 1 Mylne & C. 487.

and for an account of the profits made by their use; the defendants by their answer, insisted that the patents were originally invalid; and also, that if originally good, they had been made void by subsequent acts of the patentee. By the decree made at the hearing of the cause, the bill was retained for three years, with liberty for the plaintiff to bring an action; and the defendants were directed to admit that the plaintiff was the assignee of the patents, and that they, (the defendants) had used the alleged inventions; and the plaintiff was ordered to produce certain deeds at the trial, and to admit their execution. The defendants then filed a bill of discovery against the plaintiff; but the discovery sought by that bill had reference only to the acts by which it was alleged that the patents had become void subsequently to their creation. The defendants, afterwards, finding the necessity of a discovery as to the original invalidity of the patents, applied to the Court for permission to file another bill of discovery which should relate to such original invalidity, and the Court granted the permission desired.

The remedy sought in equity is for INSTANT RELIEF. (g) It is usual to move for the injunction upon filing the bill, before the answer is put in. It is generally granted upon the *ex parte*

An injunction.

(g) See *Ex parte O'Reilly*, 1 Ves. jun. 112; and see 1 Ves. jun. 430. 2 Ves. jun. 486. 3 Ves. 141. 6 Ves. 689. 14 Ves. 130. 1 Ves. & Beam. 67.

affidavits. The defendant is commanded *either* to refrain in future from using or vending the manufacture, or to keep an account of the proceeds, until it can be determined whether the patent is valid, and whether it has been infringed by the defendant.

The affidavits.

In *Hill v. Thompson*, (h) Lord Eldon said, "he doubted whether the injunction ought to have been granted in the first instance, unless the *affidavits* had stated more particularly in what the alleged infringement of the patent consisted; and that it should have been shewn to be, by working in the *precise proportions* mentioned in the specification, as *being* of the essence of the invention. That when, in future, an injunction is applied for *ex parte*, on the ground of a violation of a right to an invention, secured by patent, it must be understood, that it is incumbent on the party making the application, to swear, at the time of making it, as to his belief that he is the original inventor; for although, when he obtained his patent, he might very honestly have sworn as to his belief of such being the fact, yet circumstances may have subsequently intervened, or information been communicated, sufficient to convince *him* that it was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect."

(h) 3 Meriv. 624. And *Hill v. Wilkinson*, MSS.

Although a patent has expired, the Court will grant an injunction to restrain the sale of articles manufactured in fraud of that patent previous to its expiration. (i)

On an application for an injunction to restrain the infringement of a patent, the party must swear, that, at the time of making the application, he believes, that at the date of the patent, the invention was new, or had not been previously known or used in this kingdom. (j)

In the usual time, the defendant must bring in his answer to the bill, which generally contains a statement of facts, verified by affidavit, that shew, either that the patent is not a good one, or that the defendant has not infringed it. The answer.

Where a bill (k) was filed to restrain the infringement by the defendant of letters patent, a sufficient case to justify it must be stated by the plaintiff on the face of the bill, and he must not depend solely on the admissions contained in the defendant's answer, for the granting or continuing of the injunction. If the answer deny the invention to be new, and also the enjoyment under the letters patent, and state, (as was the fact) that the specification is imperfectly set forth in the bill, the Court will dissolve an injunction previously obtained on affidavit, giving the plaintiff

(i) *Crosley v. The Derby Gas Light Company*, 1 Russ. & M. 168. Law Journal, vol. xiii. p. 25.

(j) *Sturz v. De la Rue and Others*, 5 Russell's Rep. 322.

(k) *Curtis v. Cutts*, Law Journal in Chancery, vol. xvii., p. 184.

liberty to bring an action, although the defendant admit by his answer that he has made machines upon the principle comprised in the letters patent.

Plea.

The defendant may plead any matters, as in other cases in equity, or he may demur. A demurrer, alleging that the right to the patent had not been previously established at law, was immediately overruled. (l)

The Court will not, for the purpose of determining the validity of a plaintiff's title as the patentee of an invention, make an order upon demurrer, directing the bill to be retained, with liberty to the plaintiff to bring an action.

Where the bill alleges that the plaintiff is the patentee of an invention, stating its nature generally, but referring for greater certainty to a specification, in which it is set forth and described at large, and alleges also, that the plaintiff has been for ten years in the exclusive enjoyment of such patent, and has established his legal title by repeated actions, a general demurrer on the ground of the invalidity of the patent as stated in the bill, will be overruled. (m)

The hearing.

When the answer is read, the plaintiff may move to make the *injunction perpetual*, if one has previously been obtained; or, on the other hand, the defendant may move to have it dis-

(l) *Hicks v. Raincock*, 2 Dick. 647.

(m) *Kay v. Marshal*, 1 Mylne & C. Rep. 373. Law Journal, vol. xv. p. 258. See 5 Bing. N. C. 592.

solved. (n) But if, when the bill was filed, an injunction was denied, it may now be moved for. (o) The Court will exercise its own discretion, and, in continuing it, will perhaps, direct *an issue at law* to try the validity of the patent; or, in dissolving it, will leave the party to bring an action for the supposed infringement. In the latter instance, the Court will, in general, order that the party against whom the application is made shall still keep an account pending the litigation; (p) but sometimes, when the affidavits are very contradictory, it will dismiss the suit altogether.

It is unnecessary to go into the manner of making the record of a *feigned issue* directed by the Court of Chancery. (q)

5. Feigned issue at law.

The evidence to be given at the trial is nearly the same as if the suit had been originally commenced at the Common Law Court. (r)

Evidence.

The Lord Chancellor will place the parties under such conditions as will meet the equity of the case. He will order admissions to be made of facts, which, though true, could not easily be

(n) See *Gibbs v. Cole*, 3 P. Wms. 355.

(o) 1 Ves. jun. 430.

(p) 3 Meriv. 628. And see 1 Stark. N. P. C. 205. *Wood v. Cockerell*, Aug. 1819, MSS. Of the practical use of a decree for an account, see *Crosley v. Derby Gas Light Company*, 3 Mylne & Craig, 428.

(q) See Tidd's Practice, p. 750, 7th edit.

(r) Ante, 240.

proved. If the infringement be done secretly, he will order the *manufactory to be inspected.* (s)

New trial.

When a verdict has been given, and the plaintiff moves to revive or to make an injunction perpetual; or the defendant having been successful moves to dissolve it, either motion may be opposed, on the ground that the verdict is bad, and that it is his intention to move for a new trial.

If the Lord Chancellor think that, in point of law, he is not so well satisfied with the patent as to take it for granted that no argument can prevail upon a court of law to let the question be reconsidered in a new trial, then he will not revive the injunction, but direct the account to be kept until that motion has been made. But if he be convinced that a court of law must and will consider the verdict of the jury as final and conclusive, then he will revive the injunction, and make it perpetual. (t)

In one instance (u) in which the judges of the Court of Common Law were equally divided in opinion as to the validity of the grant, the Court of Chancery directed a new trial to be had, but would not impose any terms on the patentee, nor dissolve the injunction in the meantime.

Costs in equity.

At the same time, the party that is successful may move for the costs and expenses which

(s) See *Huddart v. Grimshaw*, Dav. Pat. Cas. 265, and *Boville v. Moore*, id. 361; and see ante.

(t) 3 Meriv. 631.

(u) *Boulton v. Bull*, 3 Ves. 141.

he has sustained by a suit which could not be supported. (v)

IV. REMEDY BY STATUTE.

For the protection of patentees, the new act (w) gives a penalty of 50*l.* against a party using the name, &c., of a patentee.

It is enacted, that if any person shall write, paint or print, or mould, cast, or carve, or engrave or stamp, upon any thing made, used, or sold by him, for the sole making or selling of which he hath not, or shall not have obtained letters patent, the name, or any imitation of the name, of any other person, who hath, or shall have obtained letters patent for the sole making and vending of such thing, without leave in writing of such patentee, or his assigns, or if any person shall upon such thing, not having been purchased from the patentee, or some person who purchased it from or under such patentee, or not having had the license or consent in writing of such patentee or his assigns, write, paint, print, mould, cast, carve, engrave, stamp, or otherwise mark the word "patent," the words "letters patent," or the words "by the King's patent," or any words of the like kind, meaning, or import, with a view of imitating or counterfeiting the stamp, mark, or other device of the patentee, or shall in any other manner

(v) 3 Meriv. 629; and see Tidd's Prac. 1001, 7th edit.

(w) 5 & 6 Wm. 4, c. 83, s. 7.

imitate, or counterfeit the stamp or mark, or other device of the patentee, he shall for every such offence be liable to a penalty of 50*l.*, to be recovered by action of debt, bill, plaint, process or information, in any of his Majesty's Courts of Record at Westminster or in Ireland, or in the Court of Session in Scotland, one half to his Majesty, his heirs and successors, and the other to any person who shall sue for the same; provided always, that nothing herein contained shall be construed to extend to subject any person to any penalty in respect of stamping, or in any way marking the word "patent" upon any thing made, for the sole making or vending of which a patent before obtained shall have expired.

It is to be regretted that this clause did not give a penalty to be paid by all persons who mark the word "patent" on articles which they know never were the subject of patent. In the Courts of Equity, a manufacturer is always restrained from using the letters and figures which a patentee was in the habit of using. (x)

General
observations.

Thus, it appears that, before a suit is commenced at law, it is often preferable to take proceedings in equity. If the patent is really good, the injunction prevents any further infringement; and, if it be a doubtful one, the defendant will be restrained from using it until its validity has

(x) *Ransome v. Bentall*, Law Journal, vol xii. page 161.

been examined. The order for an account puts the patentee in a better situation than if he had to depend upon a jury for damages; and, if he wants any indulgence, any alleviation from the strict rules of law as to evidence, &c., it becomes absolutely necessary to sue first in Chancery. (*y*)

(*y*) For observations more in detail on "*Proceedings in Equity*," see post, COPYRIGHT, Chap. VIII.

CHAP. IX.

OF LETTERS PATENT WHEN VOID, AND THE
MANNER OF HAVING THEM CANCELLED.

ALTHOUGH the infringement of an invalid grant may, by shewing its defects, be justified in an action at law, or in an answer to a bill in equity, and the Courts may declare, that, in their opinion, the patent is voidable ; yet, until it is actually cancelled, the patentee may go on against different parties, maintaining proceedings upon it in law and equity, (a) although the jury, under such circumstances, would of course, give their verdict for the defendant. And the reason assigned is, that the patent must, for the honour of the grantor—the Queen—be protected, until it is found by inquisition at law that the grant either ought not to have been made, or cannot with propriety be enforced. It is, therefore, necessary that the public should be provided with means of destroying a bad patent. This object is effected by a *writ of scire facias*.

All the instances in which patents are considered as void, will first be enumerated, and then those things will be stated which do *not*

(a) Ante, 287. 2 Ventr. 344; and see *Attorney General v. Vernon*, 1 Vern. 277, 370. 2 Chan. Rep. 353.

vitate patents; and afterwards the *proceedings* by *scire facias* will be investigated. (b)

I. WHAT RENDERS A PATENT VOID.

The construction, which in law is put upon royal grants in general, was considered in a former chapter. And it was there pointed out, as far as the law of patents in general was necessary to elucidate that of patents for inventions, how all kinds of grants were rendered void for uncertainty, misrecitals, and false suggestions. (c)

1. What makes all kinds of patents void.

A patent may be void, although the invention be new, either altogether, or for something in particular.

2. Patent for invention void generally under the statute.

It is expressly provided by the statute of monopolies, (d) that letters patent shall be void altogether, or generally, if they are—

1. Contrary to law; or
2. Mischievous to the state.

The mischief contemplated may, it appears, be done,

1. By their raising the price of commodities at home.
2. Or being hurtful of trade.
3. Or being generally inconvenient.

(b) See *George v. B. Wackerback and Another*, Repertory of Arts, N. S. vol. xxvii. p. 252.

(c) Ante, Chap. VI.; and see Chit. jun. Prerog. of Crown, 391, 399.

(d) 21 Jac. 1, c. 8, s. 6.

Contrary to law.

If an inventor obtain a patent for a proper object, and give a correct specification, and it be otherwise valid, yet, if it produce the baneful effects by which Lord Coke distinguishes monopolies, as described in Book I. of this Treatise, it will be contrary to law. (e) It will then be void for being a monopoly. It is almost impossible, that at the present day, a patent, professing to be for a new invention, (which would be invalid on the grounds that grants were formerly declared to be monopolies,) could be *obtained*; and therefore, it is unnecessary to add more on that subject.

Mischievous to the state, &c.

It has been shewn, that by the common law, and the statute of James, all monopolies are illegal. (f) According to the letter of the statute, the exception of patents for inventions, from the consequences attendant on monopolies, goes only to the *sole working and making*; the sole buying, selling, and using, continue under the general prohibition; and with apparent good reason, for the exclusive privilege of *buying, selling, and using*, could hardly be brought within the qualification of not being contrary to law, and mischievous to the state. (g)

Raising the price of commodities at home.

That injurious effect of monopolies in general, of raising the price of commodities at home, will seldom be produced by the limited monopolies of

(e) 3 Inst. Ch. LXXXV.; and see the case of *Darcy v. Allen*, 44 Eliz. 11 Co. Rep. 85. Noy. Rep. 179.

(f) Ante, p. 10.

(g) 2 Hen. Bla. 492, by Eyre, C. J.

grants for inventions; for one of the objects of almost every patent is to diminish the price of the manufacture, or by furnishing a better article, to render it at the same nominal price, of more intrinsic value.

One of the issues (*h*) to be tried on the *scire* Being hurtful
of trade.

(*h*) *The King v. Arkwright*, Printed Case, p. 30. Mr. Justice Buller.—Mr. Bearcroft, what do you understand to be the meaning of the first issue? Mr. Bearcroft.—The evidence on our side will be to shew that the grant is prejudicial and inconvenient to his Majesty's subjects in general. I mean to say, there is great danger from such a grant as this, that it will go into foreign countries, if the monopoly is permitted. Your lordship will permit me to state it. I mean to say, it is of such a sort that it may be taken into other countries without all doubt; and if you can only work it here, loaded with a monopoly, and in another country it may be worked without, it will be a great danger to the whole trade, as applied to all the cotton manufactures. Mr. Justice Buller.—I don't see, with respect to that issue, you can be permitted to give any evidence at all; it is merely a consequential issue; it is a question of law, whether it is prejudicial or not? When the facts are stated, therefore, if you thought it necessary to attack the patent upon those general words of the act of Parliament, you should have stated it in what respect it was so then,—the fact would be put in issue. This is such a surprise upon the party, he can never come prepared to answer it. Mr. Lee.—It strikes me the prejudice must be, in the nature of it, a matter of fact; and your lordship sees it is a condition annexed to every patent by the terms of the act of Parliament. Now, there is no making any sense, use, or application of that, but upon some idea the patent is to stand or fall upon the ascertainment of that fact. My lord, if the patent is to be void, if proved prejudicial to the public—and good, if no such prejudice arises from it, in the nature of it—then, *ex vi termini*, there must be some mode of ascertaining it. Mr. Justice

facias to repeal Mr. Arkwright's patent was, whether the grant was not prejudicial and inconvenient to the King's subjects in general. It appeared, from the opening speech of the counsel,

Buller.—That is no answer to my question, Mr. Lee; my idea is, if the patent is void as a question of law, if prejudicial or hurtful to the country, you can only take issue upon some fact that makes it so; therefore your issue should not be in general terms prejudicial to the country: but you should state how, and then the party comes prepared to answer it.—
 Mr. Bearcroft.—Then, according to your lordship's observation, it is an immaterial issue; and we should state the fact, in order to give notice to the party. Mr. Justice Buller.—
 Upon that issue, upon this record I must take it thus:—the other three are precise pointed issues; but the first is of consequence to stand or fall as they are proved. Mr. Lee.—
 Suppose this principle is assumed, and I conceive it may be fairly assumed, there is no one thing of equal importance in any country to the employing of the inhabitants that compose it. I will suppose any invention, and you have a right to put the most extravagant supposition upon earth. I will conceive all that manufactory which has been for ages carried on by men, women, and children, and the sustenance of them all, to be performed by an invention that does not admit of any human hands at all. It is possible, in the nature of the thing, all those spindles might, for aught I know, be worked by a turnspit dog, and afford no subsistence at all to any human being. I should conceive such a thing upon proof would be directly a public inconvenience, and destructive of the happiness of mankind. And yet it would not be necessary to shew that was the nature of it, but only to state that.
 Mr. Justice Buller.—Then you should state the fact upon record. Then he knows what he comes to answer. Whether you attack it upon one ground or the other, as to the inconvenience to the public, it is impossible for a man to come to answer that.

that he intended to give evidence to shew that the patent would be hurtful to trade, by loading the cotton manufactories of this country with a monopoly. Mr. Justice Buller would not allow him to call any witnesses to prove it, upon the ground that it was merely a consequential issue, and that it was a *question of law*, whether the patent was or was not prejudicial to the community.

The observations of that very learned judge were founded on the circumstance, that no facts shewing the inconvenience were stated in the record to be proved. The defendant was not able to learn by the pleadings from whence the supposed inconvenience arose. Such an investigation would be a surprise upon him. He could not possibly come prepared with evidence to rebut an undefined accusation.

A question of inconvenience arose in an early case, (i) whether Mr. Arkwright should obtain

Generally inconvenient.

(i) *Arkwright v. Nightingale*, Dav. Pat. Cas. 55. Lord Loughborough.—It is said, it is highly expedient for the public that this patent, having been so long in public use after Mr. Arkwright had failed in that trial, should continue to be open: but nothing could be more essentially mischievous than that a question of property between A. and B. should ever be permitted to be decided upon considerations of public convenience or expediency. The only question that can be agitated in Westminster Hall is, which of the two parties in law or justice ought to recover.

Lord Thurlow declared, that letters patent, even if they were granted in fee, could not stand half an hour, if *abused*, 1 Ves. jun. 118.

a verdict after having submitted upwards of three years to a nonsuit on a former trial, inasmuch as many persons had, in consequence of his apparent abandonment of the patent, laid out great sums of money in constructing his machine. Such submission merely prevented him from obtaining damages, because the patent still remained uncanceled.

Hence it is evident, that if an issue were joined on certain facts stated in the record of *scire facias*, which shewed that the patent had a tendency to produce any of the bad effects, of being contrary to law, hurtful to trade, or generally inconvenient, such issue would be capable of trial; and the patent might on that account be declared to be void.

Grant void in particular under the statute.

That the grant is invalid when the patentee is not the *inventor*, (*j*) when its *object* is not a manufacture, (*k*) and when the *specification* is not sufficiently correct, (*l*) has already been shewn. If the patent has not been *obtained* (*m*) in the usual mode, or will not bear the *construction* (*n*) that must necessarily be put upon it, it is also void. *Any one* of these circumstances appearing in evidence will be the means of destroying the patent; and it is not necessary to prove more than one objection or cause for cancelling the grant. (*o*)

(*j*) Chap. II.

(*k*) Chap. III.

(*l*) Chap. IV.

(*m*) Chap. V.

(*n*) Chap. VI.

(*o*) *The King v. Arkwright*, Printed Case, 187. Dav. Pat. Cas. 141.

II. WHAT THINGS DO NOT VITIATE PATENTS
GENERALLY.

There are some instances in which mistakes do not vitiate a grant. (*p*)

1. Every false recital in a thing not material will not vitiate the grant, if the queen's intention is manifest and apparent.

2. If the queen is not deceived in her grant by the false suggestion of the party, but from her own mistake, upon the surmise and information of the party, it will not vitiate or avoid the grant.

3. Although the queen is mistaken in point of law, or of matter of fact, if that is not part of the consideration of the grant, it will not avoid it.

III. PROCEEDINGS BY SCIRE FACIAS TO REPEAL
A PATENT.

Upon these grounds letters patent are voidable in themselves, but cannot be treated as of no effect in law until they are cancelled by the legal process of a writ of *scire facias*; in the investigation of which it will be necessary to consider

1 By whom it may be obtained.

2. The necessary instruments.

3. The surrender of the patent.

(*p*) Bull. N. P. 75; and see as to construction, ante, p. 200.

1. By whom
obtained.

If a patent be void for any of the reasons which have been assigned as sufficient to invalidate the grant, the queen, *jure regio*, for the advancement of justice and right, may have a *scire facias* to repeal his own grant. (*q*)

A subject also, who is prejudiced by a grant, may of *right* petition the queen to use her name for its repeal. All persons are injured by the existence of an illegal patent for an invention, and every one is therefore at liberty to petition for a *scire facias* to have it cancelled. (*r*)

But between subject and subject, if the queen has granted a patent to each of them for the same thing, then generally the *first* patentee may have a *scire facias* to repeal the second patent: (*s*) but the second patentee cannot bring a *scire facias* to repeal the first patent, though the better right should be in him. (*t*) In the case of two patents for the same invention, supposing the object to have been simultaneously discovered by the patentees, the second grant would necessarily be bad, even if the first were for some informality rendered invalid. (*u*)

2. The necessary instruments.

The *scire facias* for repealing letters patent is an original writ, and must be founded on some

(*q*) 4 Inst. 88. For the law and practice of repealing letters patent by *scire facias*, see Tidd's Prac. 7th edit. 1123. 2 Wms. Saund. 72, p. q. Com. Dig. Patent F. 6. id. Pleader.

(*r*) Dyer, 276, b. 2 Ventr. 344. 3 Lev. 220. S. C. 6 Mod. 229.

(*s*) 4 Inst. 88. Dy. 197, b. 198, a.

(*t*) Dy. 276, b. 277, a.

(*u*) Ante, p. 40.

matter of record. (v) A patent for an invention is a record in Chancery, and therefore the writ must issue out of that court. It is directed to the sheriff of Middlesex, and made returnable in the Petty Bag Office. (w) The record of the proceedings upon the writ is made up in that court, and sent into one of the courts of common law at Westminster, to be tried. (x)

The first step to be taken is to present a petition Memorial. or *memorial* (y) to the crown for a *scire facias*. The next is to obtain the queen's *warrant* to sue; (z) which is directed to the Attorney General, who thereupon grants his *fiat*. (a)

A summons is then sent to the defendant; Summons. which informs him that this writ has been issued against him, and warns him to appear to it. (b)

The *scire facias* in *form* recites the patent, and states the grounds upon which it is meant to be impeached; as that the patentee was not the first and true inventor, but that it had been previously invented or used by others, &c. (c)

After the defendant has appeared, he may Plea. plead either in abatement or in bar. The most

(v) 4 Inst. 88. 3 Lev. 223.

(w) *Rex v. Haine*, 2 Cox, 235; and see 3 Lev. 223; 6 Mod. 229; and ante, p. 238.

(x) See 21 Jac. 1, c. 3, s. 6.

(y) 2 Rich. Prac. C. P. 391.

(z) Id. 392.

(a) Id. 395.

(b) See Tidd's Prac. 1158, 1172.

(c) For precedents, see the printed account of Mr. Arkwright's patent, where the whole record is set out; and Tidd's Prac. Appendix, Chap. XLI. s. 6. Lil. Entr. 411. 2 Rich. Prac. C. P. 395.

usual defence is the *general issue* to force the prosecutor to prove all the allegations in the writ.

Demurrer.

If the matter be insufficient in law, upon the face of the proceedings, to support the writ, the defendant may demur. (*d*)

If there be a demurrer to part and issue on the residue, the whole record is sent by the Lord Chancellor to the Court of Common Law; and judgment is given there upon the demurrer as well as upon the issue. (*e*)

Judgment by default.

After the defendant has been warned, and *nihil* twice returned, judgment for annulling the patent may be taken by *default*. (*f*) It is obtained by *confession*, if no defence is made after the appearance. (*g*)

The record is delivered to the Court of Common Law by the clerk of the petty bag: (*h*) and it is not necessary that the issue should be tried at bar; it may be at *nisi prius*. (*i*) And the Court will not now grant trials at bar, unless some particular reasons are assigned.

Evidence.

The evidence is similar to that which must be produced upon the trial for an infringement; (*j*) except that the patentee being here the defendant, he does not want any *prima facie* evidence of the novelty of the invention, and the sufficiency of the specification; but he must be prepared strongly to rebut every allegation in the writ.

(*d*) 3 Lev. 221.

(*e*) Latch. 3. 1 Eq. Cas. Abr. 128.

(*f*) Dyer, 198.

(*g*) Dyer, 197, b.

(*h*) 1 Eq. Cas. Abr. 128, 9, 2 Wms. Saund. 6. (1).

(*i*) Cro. Car. 313.

(*j*) Ante, 240.

If the patentee can, on an application to the Court, shew any thing to induce them to believe that his case has not undergone the fullest investigation, they will grant a *new trial*; (k) but otherwise they will deny it. New trial.

It is said, that after trial, the record is to be remanded into Chaucery, and judgment to be there given; yet the practice has been to give the judgment in Common Law Courts. Judgment.

If the verdict be for the Queen, the Court adjudges that the letters patent be revoked, and the enrolment be cancelled; if it be for the defendant, then the judgment will be that the letters patent are valid.

This judgment is final. No writ of error, no appeal to another tribunal can be made. The very nature of the proceedings precludes it.

Although the statute 8 & 9 Wm. 3, c. 11, gives costs in suits upon writs of *scire facias*, yet inasmuch, as this proceeding is criminal in its nature, that statute does not extend to it; and therefore, costs are not payable to the Crown, prosecutor, or defendant, on this *scire facias*. (l) Costs.

The expense of obtaining a *scire facias* is great, and there is much delay. By a legislative enactment it might be much improved. The writ cannot be entirely superseded, because there should always remain in the Crown a strong

(k) Ante, 246.

(l) *The King v. Miles*, 7 T. Rep. 367.

power immediately applicable for repealing its own improvident grants.

The manner in which patentees may torment each other by writs of *scire facias*, may be thus illustrated.

Hadden obtained a patent in 1818, for an improvement in preparing, spinning, and roving wool, which was done by applying heat to the fibres of wool during the operation of spinning, and it was effected by inserting hot iron heaters into hollow rollers, between which the slivers of wool passed. Lister obtained a patent for the same object in 1823, and effected the purpose by applying steam within the hollow rollers, and causing the slivers previously to pass through water to soften them.

Then Hadden, thinking himself aggrieved by the patent of Lister, sued out a writ of *scire facias* to repeal it, (m) on the ground that the process used by Lister was the same as his own. Lister returned the compliment by suing out another writ against the patent of Hadden, on the ground that the invention was not new. *They both* (in the same day) *succeeded*; Hadden in proving that Lister had infringed his neighbour's patent; and Lister in proving that neither of them ought to have had a patent.

Another instance occurred. (n) Daniell had

(m) *The King v. Lister*, and *The King v. Hadden*, tried January, 1826, in the King's Bench. MSS.

(n) *The King v. Fussell*, and *The King v. Daniell*, tried July, 1827, before Lord Tenterden. MSS.

a patent in 1819, for improvements in dressing woollen cloth. They were thus effected. After the surface of the cloth had been properly dressed, and the nap on the surface laid very smooth, the piece was rolled up very smoothly and evenly in a close and compact roll; which piece being immersed in hot water, the fibres of the wool became softened, and acquired a tendency to retain the same direction; and thus the effect of the dressing was rendered permanent. Fussell obtained a patent in 1824, for an improved method of heating woollen cloth for the purpose of giving a lustre in dressing, this process was the same as Daniell's, except that he submitted the roller to steam instead of hot water. Daniell saw, with justice, the repeal of Fussell's patent, on the ground that it was the same as his own, and Fussell had the satisfaction of proving, that many years before the date of Daniell's patent, a person had used a similar method. And thus they both succeeded in destroying each other's patents.

When the patent has thus been adjudged to be void, it must be delivered up to be cancelled. For until there is an actual *surrendering*, *cancelling*, or *vacatur*, entered on the enrolment of the patent, it is not sufficiently cancelled as to be of no effect in law.

3. Surrender of the letters patent.
Cancelling patent.

If a patent be granted to two persons jointly for a simultaneous invention, and the Lord Chancellor, making a duplicate, deliver the original to one, and the duplicate to the other; if a sur-

render of the original patent be made, the grant is vacated, although the duplicate be not surrendered or cancelled; for the duplicate is made by the Chancellor without warrant.

Enrolment.

The *surrender* must be enrolled; for it is then only that the patent is vacated.

The certificate.

A certificate should be of the *vacatur* having been entered on the roll.

CHAP. X.

FOREIGN LAWS RESPECTING INVENTIONS.

IN this chapter will be found the laws respecting inventions, of those countries in which British subjects are accustomed to secure the privilege of using their inventions.

The same analysis is given (as nearly as possible) as that which was made of the British law.

THE AMERICAN LAW.

The existing laws relating to patents are those approved July 4th, 1836, March 3rd, 1837, and March 3rd, 1839; all former acts having been repealed by the act of 1836. (*a*)

Patents (*b*) are granted to citizens of the United States, to aliens who shall have been resident in the United States one year next preceding, and shall have made oath of their intention to become citizens thereof, and also to foreigners who are inventors or discoverers. The inventor,

(*a*) Messrs. Newton & Berry, agents for patents, furnished me with the above abstracts of the acts of the Congress of America.

(*b*) See ante, Chap. II.

A patent may be taken out by the inventor in a foreign country, without affecting his right to a patent in the United States, provided the invention has not been introduced into public and common use in the United States, prior to the application for such patent. In every such case the patent is limited to fourteen years, from the date of the foreign letters patent. A patent is not granted upon introduction of a new invention from a foreign country, unless the person who introduced it be the inventor or discoverer. If an alien neglects to put and continue on sale the invention in the United States, to the public, on reasonable terms, for eighteen months, the patentee loses all benefit of the patent.

Joint inventors are entitled to a joint patent, but neither can claim one separately.

In case of the decease of an inventor, before he has obtained a patent for his invention, "the right of applying for and obtaining such patent shall devolve on the administrator or executor of such person, in trust for the heirs-at-law of the deceased, if he shall have died intestate: but if otherwise, then in trust for his devisees, in as full and ample manner, and under the same conditions, limitations, and restrictions, as the same was held, or might have been claimed or enjoyed, by such person in his or her life time; and when application for a patent shall be made by such legal representatives, the oath or affirmation shall be so varied as to be applicable to them." Act of 1836, sec. 10.

The patents (c) are granted for any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement (d) on any art, machine, manufacture or composition of matter, not known or used by others, before his or their discovery or invention thereof, and not, at the time of his application for a patent, in public use, or on sale, with his or their consent or allowance, as the inventor or discoverer." Act of 1836, sec. 6. "No patent shall be held to be invalid by reason of the purchase, sale, or use (of the invention) prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public, or that such purchase, sale, or public use, has been for more than two years prior to such application for a patent." Act of March 3rd, 1839.

The manufacture.

The term for which a patent is granted is fourteen years; but it may, under certain circumstances, be renewed for seven years.

The duration of the patent.

An inventor can assign his right before a patent is obtained, so as to enable the assignee to take out a patent in his own name; but the assignment must be first entered of record; and the application, therefore, must be duly made, and the specification signed and sworn to by the inventor. And in the case of an assignment by

Property in a patent.

(c) See ante, Chap. III.

(d) See the American case of *Pennock v. Dialogue*, 2 Peters' Reports, p. 1. Ante, 51.

a foreigner, the same fee will be required as if the patent issued to the inventor.

The assignment of a patent may be to the whole, or to an undivided part, "by any instrument in writing." All assignments, and also the grant or conveyance of the use of the patent in any town, county, state, or specified district, must be recorded in the patent office, within three months from the date of the same. But assignments, if recorded after the three months have expired, will be on record as notice to protect against subsequent purchases. No fee is now charged for recording assignments. Patents and assignments recorded prior to the 15th of December, 1836, must be recorded anew, before they can be valid as evidence of any title. This is also done free of expense.

Mode of obtaining the patent.

All fees (e) received are paid into the treasury, and the law has required the payment of the patent fee before the application is considered; two-thirds of which fee is refunded on withdrawing the application. But no money is refunded on the withdrawal of an application, after an appeal has been taken from the decision of the commissioner of patents. And no part of the fee paid for caveats, and on applications for the addition of improvements, re-issues, and appeals, can be withdrawn.

(e) See ante, Chap. V.

THE SPANISH LAW. (*f*)

The present laws in force in Spain are given in a decree of King Ferdinand VII. dated the 27th March, 1826.

The Inventor. (g)—Any person, of whatever condition or country, who proposes to establish any new invention, may have a *Royal Patent of Privilege*, without previous examination of the novelty or utility of the object; but without the concession of the grant being considered in any way as a recognition of the novelty or utility of the invention.

The manufacture. (h)—The subject of a patent may be any *machine, apparatus, instrument, or a mechanical or chemical process or operation*, which may be wholly or in part new, or which may not have been established in the same manner and form in the kingdom.

If the subject has not been practised in Spain, nor in any foreign country, then the privilege will be given by a *Patent of Invention*, but if it have been practised abroad, then the party will have a *Patent of Introduction*.

The Specification. (i)—When the petition for a patent is presented it must be accompanied with a *plan or model*, and a description or explanation

(*f*) See the Appendix to the Parliamentary Report, dated 12th June, 1829.

(*g*) See ante, Chap. II.

(*h*) See ante, Chap. III.

(*i*) See ante, Chap. IV.

of the invention, specifying what is the peculiar mechanism or process which is presented therein, as not having been hitherto practised ; the whole being stated with the greatest precision and clearness, so that there may be at any time no doubt as to the identity of the invention, and of that peculiarity which is represented as hitherto unpractised in that form.

The Practice of obtaining the Patent. (j)—The inventor must draw up a *memorial* (petition) and deliver it to the Intendant of the province in which he resides, or to the *Intendant of Madrid*.

The petition is addressed to the King, and shortly describes the object of the privilege, whether it is the invention of the petitioner or whether it is brought from a foreign country, and also of the *time* for which the privilege is sought. Not more than one invention can be introduced into the same representation.

The plan or model must be delivered in a box or packet closed and sealed, as well as the plans, descriptions, and papers of explanation.

The Intendant indorses the box or packet and remits it to the Secretary of State, who forwards it to the *Supreme Council of State*, who open the box or packet, and grant or refuse a patent.

Before the patent is issued, the inventor produces the receipt of the Intendant that he has paid the following duties :—

(j) See ante, Chap. V.

	<i>Reals Vellon.</i>
For a privilege of 5 years	1000
————— 10 years	3000
————— 15 years	6000
For a privilege of introduction or importation	3000

and, in addition, 80 reals are paid for the costs of issuing the royal patent.

The documents sealed up in the boxes or packets are remitted to the Royal Conservatory of Arts, and they are not opened except in case of litigation, and by virtue of the official order of a competent judge.

The titles of the grants are published in the Gazette.

A register is kept at the Royal Conservatory of Arts, expressing the dates, the names and residences of the parties interested, the object of the privilege, and the term of its duration; which register is open for inspection.

The property in an Invention. (k)—The possessor of the privilege has the exclusive property in that part of his subject which he has declared to be new, from the day of presentation of his petition to the Intendant; but the duration of the *privilege* is reckoned from the date of the patent.

The right may be transferred, given, sold, or exchanged, or left by will, like any other *personal* property.

The *transfer* must be by a *public* deed, stating whether it is for the use of the invention in the

(k) See ante, Chap. VII.

whole or only in a part of the kingdom ; whether it is absolute or with a reservation of part ; whether it is with the power of again transferring ; and whether any transfer has already been made to any person of a part of it. It must be presented to the Intendant to be *registered* within thirty days after its execution.

Legal Proceedings. (l)—The possessor of a privilege obtained under any title whatever may cite all persons usurping his right before an Intendant, from whom an appeal lies to the Council of State. The offender may be condemned to the confiscation of all the machines, apparatus, utensils, and works of art made by him ; and to the payment (as a fine) of three times the value of the same, for the benefit of the possessor of the privilege.

When void and how cancelled. (m)—The patent is declared to be void—

1. When the time is elapsed.
2. When the party does not apply for it within three months from the time he presented his petition.
3. When the patent has not been put in force for a year and a day after the date thereof.
4. When the patentee abandons his right by not using it for a year and a day.
5. When the subject has been used in any part of the kingdom, or described in printed books, or in engravings, pictures, models, plans or descrip-

(*l*) See ante, Chap. VIII.

(*m*) See ante, Chap. IX.

tions, contained in the *Royal Conservatory of Arts*; or when the subject has been used in a foreign country and the patentee has presented it as new and of his own invention.

When the time of the grant has expired, the *Council of State* declare the cessation; but in all other cases of cessation the competent judge proceeds at the suit of any party to try the fact, and then the sealed boxes or packets are opened, and the facts published in the *Gazette*.

THE AUSTRIAN LAW.

The Inventor. (n)—The privilege is granted to a native or foreigner; and he may also take out a privilege in a foreign country.

The Manufacture. (o)—All new discoveries, inventions, and improvements, in every branch of industry, are entitled to an exclusive privilege in the Austrian monarchy. The following enumeration of subjects for patents is given to prevent disputes:

1. Every new finding out of a process in industry, which, although practised in former times, has been since entirely lost, or which, although still practised in foreign countries, is unknown in the monarchy, shall be held a discovery.

2. Every production of a new object by new means, or of a new object by means already known, or the production of an object already

(n) See ante, Chap. II.

(o) See ante, Chap. III.

known, by means different from those which have hitherto been used for that object, shall be held an invention.

3. Every addition of a preparation, arrangement, or method of working to a process, already known or privileged, by which more complete *success* or greater economy shall be attained in the result of that process, or in its mode of operation and application, shall be held to be an improvement.

4. Every discovery, invention, improvement, or change, shall be held as new, if it is not known in the monarchy, either in practice or by a description of it contained in a work publicly printed. But the novelty of a discovery, invention or improvement, shall not be called in question, on account of its being described in a work publicly printed, unless that description is so accurate and clear, that any person acquainted with the subject can, by means of that description, manufacture the object, or practise the process, for which the privilege has been granted.

The Specification. (p)—The inventor must send in, at the same time that he presents his petition, a sealed parcel containing an accurate description of his discovery, invention or improvement, in which the following qualifications are required :

1. The description must be written in the German language, or in the language used for

(p) See ante, Chap. IV.

business in the province from which the petition is presented.

2. It must be drawn up so clearly that every person who understands the subject may be able to manufacture the object, by means of the description, without being obliged to supply any further inventions, additions, or improvements.

3. That which is new, and which consequently constitutes the object of the privilege, must be accurately distinguished and set forth in the description.

4. The discovery, invention, or improvement must be clearly and distinctly described, and without any ambiguities that can mislead, or that are contrary to the object stated.

5. Nothing must be kept secret, either in the materials or the method of execution; therefore more expensive means, or means not producing an entirely similar effect, must not be described; nor must any manipulations which are essential to the success of the operation be concealed. If it is practicable *drawings* and *models* are to be added, for the better understanding of the description; but these are not strictly required, if the object can be made sufficiently clear by the description alone, according to the requisites stated.

Practice of obtaining Privilege. (q)—A petition is first presented to the *direction of the circle* in which the inventor resides, wherein he must state

(q) See ante, Chap. V.

the substance of his invention, the number of years for which he desires to obtain the privilege, and with it a full description of the invention sealed up. He must at the same time deposit one-half of the duty payable for the patent. The direction of the circle will give a receipt for the petition, the money, and the description ; and within three days forward the money and documents (with the seal unbroken) to the government of the province, who will not inquire into the novelty or utility of the invention, but will report within eight days to the Imperial Government whether it is hurtful in any public view, or contrary to the laws of the country, and send the papers to the Imperial Board of Commerce. A representation is made by that board, upon which the patent is made out and delivered to the inventor.

The duties upon privileges are to be paid in proportion to the time granted for their duration. For each of the first five years the tax is ten florins convention money, for the 6th year fifteen florins, with an increase of five florins upon each year, making for the 15th year the sum of 60 florins, and for the whole of the longest term 425 florins convention money. One-half of the duty for the whole term is paid on the receipt of the petition, and the other half is paid at the beginning of each year, in as many yearly rates as the years for which the privilege was taken, under pain of its being annulled. Except the above tax, the patentee has not any fees or expenses to pay,

but the patent deeds, (three in number) are granted *ex officio*, like all other decrees.

The Chief Registrar of the Imperial Board of Commerce is bound to *register* all the grants of privileges, and all *transfers* of them

The property in an Invention. (r)—The *priority* of the invention takes effect from the hour and day of the receipt of the petition. Although the *term* of the privilege commences from the date of the patent, yet the inventor is protected from the time of the receipt of his petition.

The patentee has the exclusive privilege over the whole monarchy. He may take such partners as he may choose, in order to increase the profits of his invention to any scale; he may dispose of the privilege, bequeath it, let it out, or assign it away at pleasure.

But a patent for an improvement gives only a property in the improvement itself.

To give encouragement for the trial of *experiments*, one who has originally taken a privilege for a less term than fifteen years, may, before the expiration of that privilege, obtain a prolongation thereof to a term of fifteen years, on condition of paying for the prolongation of the privilege after the usual rate.

Legal Proceedings. (s)—Infringements are visited with a penalty of 100 ducats in specie, of which one-half goes to the patentee, and the other half to the poor of the place where the judgment

(r) See ante, Chap. VII.

(s) See ante, Chap. VIII.

is given, besides the confiscation of the objects imitated.

When a privileged person believes himself to be aggrieved, he can require the judge of the place to put a stop to the further imitation of the object of his privilege, and also require the immediate seizure of the articles so imitated, whether they are in the possession of the imitator himself or of a third person; or whether they have been brought in from foreign countries.

The questions of infringement of compensation for damages—of the application of the legal penalty, &c. rest with the ordinary judges.

When void, and how cancelled. (t)—The privilege becomes void,

1. If the accurate description of the discovery, invention, or improvement, for which the privilege was petitioned, is wanting in the requisites of a new manufacture above stated, or in only one of those requisites.

2. If any one proves legally, that the privileged discovery, invention, or improvement, could not be considered new in the monarchy, previous to the date of the official certificate.

3. If the possessor of a privilege in force for a discovery, invention, or improvement, proves that the privilege subsequently granted is identically the same as his own discovery, invention, or improvement, which was regularly described and privileged at an earlier date.

(t) See ante, Chap. IX.

4. If the privileged person has not began to practise his discovery, invention, or improvement, within the term of one year from the delivery of his privilege, whether he is a native or foreigner.

5. If he discontinues that practice for the space of a year, during the term of the privilege, without showing sufficient grounds for the same.

6. If the second half of the tax is not paid in the above stated annual rates.

The questions, whether the privilege ought to be annulled on public grounds, or because it has been neglected, or the possessor has not fulfilled the conditions of the grant, are decided by the political authorities, with the reservation of appeal to the higher authorities.

THE BELGIAN LAW.

Laws were promulgated by the King of the Netherlands on the 25th January, 1817, which have some peculiarities about them.

The Inventor. (u)—Patents are granted to those who, in the kingdom, make an invention, and also to those who first introduce or practise in the kingdom an invention made in foreign parts.

The Manufacture. (v)—The subject of a patent may be an invention or essential improvement in any branch of arts or manufactures, domestic or *foreign*, provided it has not been put in operation or exercised by another person in the kingdom before the grant of the patent. But changes of

(u) See ante, Chap. II.

(v) See ante, Chap. III.

form, or of proportions, or ornaments, are not to be considered as improvements.

The possession of the improvement does not give any right to the original manufacturer, nor the ownership of the manufacture any power over the improvement.

The Specification. (w)—The inventor must send with his petition a sealed packet containing an exact and detailed description, signed by himself, of the object or the secret for which the patent is solicited, together with the necessary plans and drawings.

If he *fraudulently* omit in the description to mention any part of his secret, or shall state it falsely, or if the object has been already described in any work printed or published, then the patent becomes void.

The Practice of obtaining the Patent (x).—A petition to the King must be deposited with the *Recorder of the States* of the province, containing the object of the invention in general terms, with the name and place of residence of the inventor, as well as the time for which he wishes to obtain a patent, and the time for which the same object may have received a *protection in a foreign country*.

The specification or description of the invention, signed by himself and sealed up, must accompany the petition; which is not to be published until the expiration of the term of the

(w) See ante, Chap. IV.

(x) See ante, Chap. V.

patent; and not even then if the government, for important reasons, should think it necessary to defer the publication.

The Recorder of the States makes an indorsement on the sealed packet, and sends it, within ten days, to the Commissary General of Instruction of Arts and Sciences; who presents the same to the King with his opinion thereon, and his Majesty either grants or refuses the patent.

When the King thinks fit to refuse the grant, or to refer it to the opinion either of the Royal Institute of the Netherlands, or of the Royal Academy of Sciences and Literature of Brussels, a notice thereof is given to the petitioner.

The patent for an invention contains the description of the invention, but it does not guarantee the priority of the invention; and a patent of importation contains a further clause, that the objects mentioned therein shall be manufactured in the kingdom.

If a party wish for a patent for an improvement or for a prolongation of a term, he must apply to the Commissary General, who will obtain the King's signature to it.

A Register is kept at the office of the Commissary General of all the patents granted, and of the transfers and assignments thereof; and he who takes a patent by right of succession must register his name before he attempts to use the invention; and notice of all patents are given in the official journals.

The Duties to be paid for patents are regulated

according to the duration of the patent or the importance of the invention, in the following manner:

	<i>Francs.</i>
For a patent for five years . . .	150
ten . . .	300 to 400

according to the importance of the invention or improvement.

	<i>Francs.</i>
For a patent for fifteen years . . .	600 to 750
For the transfer, or for the acquisition } by right of succession of a patent }	0

The Minister of Finance keeps a separate account of the taxes paid by those who obtain patents for inventions, and remits the same to the Commissary General, who proposes to the King the best manner in which the money can be employed *in rewards* for the encouragement of the arts, and of the national manufactures.

The Commissary General forwards the patents to the Governor of the province in which the petitioner resides, stating to him the sums to be paid for the grant, who remits the same to the inventor when he shows that he has paid the duty.

When a patent is declared to be void, the duty paid for the patent is refunded in proportion to the time which the patent has to run.

The Property in them. (y)—Patents are granted for five, ten or fifteen years; and they may be

(y) See ante, Chap. VII.

prolongated from five or ten, to fifteen years. But patents for the introduction or application of inventions or improvements made in foreign countries, and for which inventors have obtained patents in those countries, are not granted for a longer time than that during which the *exclusive right in such foreign countries* for those objects shall last; and they contain an express clause that the objects shall be manufactured in the kingdom

The patentee may by himself or his *agents* make and sell the invention, or he may cause them to be made and sold by others, whom he shall authorise so to do. He may *assign* his right either wholly or in part with the king's authority. The patent follows as a matter of course, the law of succession to personal property: but it cannot be enjoyed by any one until he has registered his right to it.

Legal Proceedings. (z)—A patentee may cite a person before the courts of law who infringes his exclusive right, in order to obtain *the confiscation*, for his own advantage, of the objects which have been made but not sold, and *for the price* of those already sold; and also for *damages* for the wrong done to him.

When void, and how cancelled. (a)—The patent is void if the specification is not given as above stated. It also becomes void if the patentee *does not use* his invention within the space of two

(z) See ante, Chap. VIII.

(a) See ante, Chap. IX.

years from the date of his patent, unless there have been strong reasons for that delay ; of which reasons *the government* is the judge. A patentee invalidates his grant if he *subsequently* obtains a patent for the same invention in a foreign country.

If it should appear that the invention is, in its nature or in its application, dangerous to the security of the kingdom or its inhabitants, it may be ordered to be cancelled.

At the expiration of the patent, or after it has been declared to be void, the Commissary General of Instruction makes public the discoveries and inventions which have been protected and concealed, unless it be deemed advisable not to do so, for political or commercial reasons, and then he reports to the King, who decides as he thinks fit.

THE FRENCH LAW.

The laws respecting patents for inventions granted in France, were passed on the 7th January, 1791 ; the 26th May, 1791 ; the 8th October, 1798 ; the 27th September, 1800 ; the 25th November, 1806 ; the 25th January, 1807 ; and the 13th August, 1810.

The Inventor. (b)—The National Assembly stated in their decree, that *every new idea*, whereof the manifestation or the development may become useful to society, *belongs originally to him who has conceived it*, and that it would be to

(b) See ante, Chap. II.

attack the rights of man in their essence, not to regard a discovery in industry as the property of the author.

Patents are granted for five, ten or fifteen years, according to the choice of the inventor, for any discovery or new invention in all kinds of industry. The terms of five years and ten years may be extended by a subsequent patent, but the term of fifteen years can only be prolonged by a decree of the legislative body.

Whoever brings into France a *foreign discovery* becomes the inventor of it, and may have a patent for one of the terms of years above mentioned.

The Manufacture. (c)—Every discovery or invention in all kinds of industry, and the means of *adding* to any fabrication whatsoever a new degree of perfection, is regarded as an invention. But discoveries already pointed out and described in works printed and published, cannot be the subject of patents.

A petition for a patent will not be received if it contain *more than one* principal object, with the details that may relate to it.

If an inventor wishes to make any change in the object stated in his first petition, he is permitted to do it; and any improvement of a manufacture may be the subject of a patent.

The Specification. (d)—The patent is forfeited if the inventor conceal his real means of execu-

(c) See ante, Chap. III.

(d) See ante, Chap. IV.

tion ; or if he uses any secret means which were not detailed in his description of the invention. That description must be an exact account of the principles and the means and processes which constitute the discovery, and must be accompanied with such plans, sections, drawings, and models, which may be required to explain it.

When the Legislature decrees that the description of the invention shall be kept a secret, three Commissioners are appointed to examine the *correctness of the description*, after a view of the means and processes, without the author ceasing on that account to be responsible for the correctness of the specification.

The Practice of obtaining the Patent. (e)—An office is established at Paris, under the name of “The Directory of Patents of Inventions.” The expenses of the establishment are taken solely from the tax upon patents for inventions ; and the surplus of the amount beyond those expenses is distributed in rewards for national industry.

The inventor must apply to the Secretary of the Directory in his department, and there present a petition to the King, declaring in writing, if the object that he presents is of a new invention of improvement, or only of importation. He must at that time deposit *in a sealed packet* an exact description of the means which constitute the discovery, together (if necessary) with plans,

(e) See ante, Chap. V.

sections, drawings, and models, in order that the said packet may be opened at the time when the inventor receives his title of his property.

The petitioner must make two copies of the list of papers in the sealed packet. He is entitled to have information given to him of all subjects for which patents have been obtained, in order that he may judge whether he will persist in his demand or not.

On the back of the cover of this packet is written the date of the deposit of the packet, a receipt for the amount of the tax, or an engagement to pay it ; and the Directories of Departments must forward the packets to the Directory of Patents of Inventions during the same week in which they have been presented.

The Directory of Patents, after registering the packet, open the seal, and deliver out a patent containing the description of the invention under their own seal. At the same time a proclamation by the King, relative to the patent, is addressed to all the tribunals and departments in the kingdom.

A prolongation of the term of a patent may be made by the legislature.

A register is kept at the directory of each department, and also at the Directory of Patents for Inventions, of the patents granted and the proclamations issued, and the prolongations made of the terms of any patents, and also of all transfers of the right.

Any citizen may inspect the catalogue of new

inventions at the office of the Secretary of his department, and any *resident* citizen is at liberty to examine the specifications of the patents actually in force at the Directory of Patents, unless the *legislature* has decreed that the discovery shall be kept secret.

Commissioners examine the specification, when it is ordered to be concealed; and if they are satisfied with it, they re-seal the packet.

The patentee being at liberty to make changes in the object mentioned in his first petition, he may take out successive patents for those changes, or put them all into one patent.

The duties collected from an inventor may be paid in two sums—one-half on presenting his petition, and the remainder within six months. If the latter sum is not paid within that time, the patent becomes void.

The following scales exhibit the duties to be paid by patentees.

1. A scale of the taxes to be paid to the Directory for inventions.

	<i>Livres.</i>
Tax on a patent for five years	300
Tax on a patent for ten years	800
Tax on a patent for fifteen years	1500
Fee for passing the patent	50
Certificate of improvement, change or addition	24
Tax for the prolongation of a patent	600
Registry of a patent of prolongation	12
Registry of the conveyance of a patent, wholly or in part	18
For the search and communication of a de- scription	12

2. A scale of the taxes to be paid to the Secretary of the department.

	<i>Livres.</i>
For the attestation of the deposit of a description, or of any improvement, change or addition, and of the papers relating thereto, all costs included	12
For the Registry of the Conveyance of a Patent, wholly or in part, all costs included	12
For the communication of the catalogue of inventions, and search fees	3

The possessor of a patent for invention must also pay the tax of annual patents levied upon all professions in the useful arts and trades.

The Property in Patents. (f)—The inventor may have a patent for 5, 10, or 15 years, or for such longer periods as the legislature may grant ; and the exercise of the right commences from the date of the certificate of the petition.

It is *personal* property. He may form establishments through the kingdom, and he may authorise other persons to use his means and processes: and he may form any association he chooses for the exercise of his right, under an order from the government to that effect.

He may *transfer* it either wholly or in part.

Legal Proceedings.—The government, in granting a patent, does not guarantee the priority, the merit, or success of the invention.

A patentee may proceed against an infringer before a judge, who will hear the parties and their

(f) See ante, Chap. VII.

witnesses, and judgment will be executed provisionally, notwithstanding any appeal from it.

In a contest between two patentees whose patents are for the same object, if the similarity is declared complete, the patent bearing the earliest date shall alone be valid, but if there is a dissimilarity in some parts, the patent of the latest date may be converted (without any new tax) into a patent for an improvement thereof.

But *the priority* of invention, in case of a dispute between two patentees for the same object, is adjudged for him who first deposited his papers as above stated.

When Patent void, and how cancelled. (g)—The patent becomes void if the inventor be convicted of having, in his description, *concealed his real means of execution*, or of having used in his manufacture *secret means* which were not detailed in his description ; and the patent is invalid if the inventor be convicted of having obtained a patent for discoveries already pointed out and described in works printed and published ; and also if the inventor shall not in the space of *two years*, reckoning from the date of his patent, have put his discovery in practice, or shall not have given sufficient reasons to justify his inaction.

And also if the inventor, having obtained a patent in France, shall be convicted of having taken one for the same object in any foreign country ; and as every person acquiring the right

(g) See ante, Chap. IX.

of exercising a discovery secured by a patent is subject to the same regulations as the inventor, if he infringe them, the patent is to be revoked, the discovery published, and the use thereof to be open to the whole kingdom.

When the term has expired or the patent has become void, the Minister for the Interior takes care that it be immediately published.

BOOK III.
ON COPYRIGHT.

CHAP. I.

HISTORICAL INTRODUCTION—OF COPYRIGHT IN
GENERAL.

THE history of that right, by which authors have an exclusive power over the productions of their minds, may be condensed into a few sentences.

Copyright or literary property may be defined to be—the ownership (by an author or his assignee) of the original manuscript of a work or THE COPY, being the incorporeal right to the sole printing, publishing, and selling of something intellectual, communicated by writing or letters. (a)

(a) See 4 Burr. Rep. 2311, 2346, 2396, and 2 Blackstone's Commentaries, 405.

“It is admitted by our opponents (says Mr. Serjeant Talfourd, at p. xxii. of his ‘Present state of the copyright question’) that an author's work remains his own property so long as it exists only in manuscript, and is retained in his own possession. We have not much to be grateful for in

It would be idle to speculate upon the probabilities whether this exclusive right existed among the Greeks and Romans; we cannot trace its existence by any satisfactory authority.

In England before the art of printing was introduced, it seems that the University of Oxford claimed the exclusive right of transcribing and multiplying books by means of writing, (*b*) but it nowhere appears that the authors of books claimed that privilege.

After the introduction of the art of printing into England by *Caxton*, in the year 1474, the

this concession, because, as the uncontrollable power remains in the author, the public had no means of enforcing any claims upon the fruits of his industry. Without fear of the most tyrannical law, or the most absolute monarch, the intellectual magician may, like Prospero,

Break his staff—

And deeper than did ever plummet sound
May drown his book.

But he is ready to admit his contemporaries and posterity to a participation in the results of his labours; and, having the power, and with it the right, of withholding all, he seeks to make one reservation from the grant of that which is wholly his own. In selling each copy of his work, he claims to stipulate with the purchaser that he shall not use it to multiply copies for his own pecuniary gain: and, *the power of annexing this condition to every delivery of the book to a buyer, constitutes COPYRIGHT.*"

See also a *Treatise on the Laws of Literary Property*, by ROBERT MAUGHAM, Secretary to the Law Institution, &c. (published since the first edition of this work) page 1.

(*b*) Bishop Fell's *Memoirs*. Gutch's *Coll. Curiosa*, Vol. i. p. 271.

question, of the perpetual right of multiplying copies of works by printing, became one of importance; and yet it does not appear to have been claimed in his time.

The first instance of a claim of exclusive right to print a book, occurs in the year 1518, (c) when it was made by a printer as a privilege granted by the crown.

It is quite clear from all the ancient records, that if there were any copyright at common law before the existence of the Stationers' Company, it was at first protected only by royal grants, sometimes for a few years, and sometimes for particular classes of books, and in all instances, the claim was set up by the printer, not by the author, who no doubt, had paid the author for his labour.

On the 4th of May 1556, letters patent were granted to the *Stationers* to form themselves into a corporate body with power to make bye-laws: so that, no one but a member of their company should be allowed to practise or exercise the art or mystery of printing within the dominions of England.

By a bye-law, every person who had printed a book was required to enter it first in their register, and obtain a *license* from them, and those laws were supported by the Star-chamber; for it was the policy of the then governments to keep a

(c) By Richard Pynson, who succeeded William Faques, the first "regius impressor." Herbert. Typ. Ant. Vol. i. p. 264.

strict watch and great control over the publishers of books, which was best effected by making the whole of them, as a corporate body, answerable for the acts of each printer or stationer.

After some deference had been paid to the right of the author, we find that the Crown interposed instead of the Company of Stationers, and the stat. of 13 & 14 Car. 2, c. 33, commonly called "*the Licensing Act*" was passed. At first it was for a limited time, afterwards renewed, and ultimately expired in 1694.

At length the legislature interfered by the 8 Ann. c. 19, and released authors, whatever their original right might be, from the thralldom of the Stationers' Company, the uncertainty of the decisions of the courts, and the usurpation of the Crown.

Copyright at
common law.

It would be foreign to the plan of this work, to enter into a discussion to shew whether copyright existed at common law; upon that topic the most learned men have held different opinions.

It may suffice to say, that it was formerly supposed that the author of a book had at common law, an unrestricted right to dispose, even after publication, of this work (the production of his mind) in any manner he pleased; and that the statute 8 Ann. c. 19, was passed merely to *protect* that right, by subjecting those, who encroached upon such literary property, to severe penalties.

This doctrine was questioned; and underwent a learned discussion in the Court of Common

Pleas, in the case of *Tonson v. Collins*: (d) but the point was not determined. It was afterwards agitated in the Court of King's Bench, (e) where three judges, among whom was Lord Mansfield, delivered very elaborate opinions to prove the existence of the right. But Mr. Justice Yates, in a most profound and eloquent opinion, declared that an author had not such a common law right. The same question arose for consideration in the

(d) 1 Bla. Rep. 301, 321.

(e) *Millar v. Taylor*, 4 Burr. 2303; and see 1 Bla. Rep. 675. This was an action of trespass in the case. The plaintiff stated in his declaration that he was the true and only proprietor of the copy of a book of poems intituled the "*Seasons*," by James Thomson; and whilst he was sole proprietor of the said copy, caused 2000 books of it to be printed for sale at his own expense, and had a great number of the said 2000 books remaining in his hands for sale. That the defendant *Taylor* published and exposed for sale, several other books of the like copy, and bearing the same title; which latter books had been injuriously printed by some person or persons without the license or consent of the plaintiff *Millar*; the defendant knowing that they had been so injuriously printed by some person or persons, without such license or consent; by means whereof the plaintiff was deprived of the profit and benefit of the said copy and book, and of the books, printed at his expense as aforesaid, and then remaining in his hands unsold. Not guilty was pleaded, and the jury found a special verdict.

The question was "whether after a voluntary and general publication of an author's work by himself, or by his authority, such author had a *sole and perpetual property* in that work, so as to give him a right to confine every subsequent publication to himself and his assigns for ever. Lord Mansfield, C. J., Willes, J., Aston, J., were of opinion that an author had such right. Yates, J. contra.

case of *Beckett v. Donaldson*, (*f*) when it was decided without discussion in favour of the right,

(*f*) 2 Bro. P. C. 145, and 4 Burr. 2408. In this case, which came before the House of Lords, by appeal from the Court of Chancery, the judges were directed to deliver their opinions on the following points.

1. Whether, at common law, an author of any book or literary composition had the sole right of first printing and publishing the same for sale; and might bring an action against any person who printed, published, and sold the same without his consent?

Upon this question, the judges Nares, Ashurst, Blackstone, Willes, Aston, Perrot, and Adams; and Smythe, C. B., and De Grey, C. J., of the Common Pleas, delivered separately their opinions against Baron Eyre, that, at common law, an author of any book or literary composition had the sole right of first printing and publishing the same for sale, and might bring an action against any person who printed, published, and sold the same without his consent.

2. If the author had such right originally,—did the law take it away upon his printing and publishing such a book or literary composition? and might any person afterwards reprint and sell for his own benefit such book or literary composition against the will of the author?

Upon this question, the judges Nares, Ashurst, Blackstone, Willes, and Aston, and Smythe, C. B., were of opinion against Eyre, Perrot, Adams, and De Grey, C. J., of the Common Pleas, that the law did not take away his right upon printing and publishing such book or literary composition; that no person might afterwards reprint and sell for his own benefit such book or literary composition against the will of the author.

3. If such an action would have lain at common law—is it taken away by the statute of 8 Ann. c. 19. (See this act.) And is an author by the said statute precluded from every remedy, except on the foundation of the said statute, and the terms and conditions prescribed thereby?

in order that it might immediately be carried by writ of Error into the House of Lords: where it was settled, that if the right contended for did ever exist, it had been abrogated by the statute of 8 Anne; and that all remedies, for any violation of it, cease at the expiration of the terms therein mentioned.

Supposing then that no right existed at common law, by the exercise of which an author

Upon this third question the judges Eyre, Nares, Perrot, Gould, and Adams, and De Grey, C. J., C. P. delivered their opinions against Ashurst, Blackstone, Willes, Aston, and Smythe, C. B., that such action at law is taken away by the statute 8 Anne; and that an author by the statute is precluded from every remedy, except on the foundation of the said statute, and the terms and conditions prescribed thereby.

4. Whether the author of any literary composition, and his assigns, had the sole right of printing and publishing the same in perpetuity by the common law?

The judges Nares, Ashurst, Blackstone, Willes, Aston, and Gould, and Smythe, C. B., delivered their opinions (contra Eyre, Perrot, Adams, and De Grey, C. J.) that the author of any literary composition, and his assigns, had the sole right of printing and publishing the same in perpetuity, by the common law.

5. Whether this right is any way impeached, restrained, or taken away, by the stat. of 8 Anne?

The judges Eyre, Nares, Perrot, Gould, and Adams, and De Grey, C. J., C. P., delivered their opinions upon this fifth question against Ashurst, Blackstone, Willes, and Aston, and Smythe, C. B., that this right is impeached, restrained, and taken away, by the stat. 8 Anne.

The Lord Chancellor (Lord Apsley) seconded Lord Camden's motion to reverse; and the decree of the Court of Chancery was reversed accordingly.

might prevent others from multiplying the copies of his work, after he had published it: it follows therefore that when a person prints a literary composition—when he publishes a book—he has now no other property in it than that which is recognized or vested in him by legislative enactments.

The rights conferred by the statute of copyright, 8 Ann. c. 19, have, at different times, been altered and enlarged, by the 41 Geo. III. c. 107, and by the 54 Geo. III. c. 156.

There is other property of a literary kind, differing in some degree from that claimed under the copyright acts, given by several statutes; as in prints and engravings, models and statues.

Hence all literary property or copyright is either founded by construction on the statute of 8 Anne, or given by the positive provisions of other acts of parliament.

1. Statute law.
8 Ann. c. 19.

The excellent statute of 8 Anne (*g*) gave to the author or proprietor of a book, then (10th April 1710) already printed, the sole right of printing it for twenty years. And to the author and his assignee, of a work, then already composed but not published, or of one that should thereafter be composed and published, the sole liberty to print and reprint it, for the term of fourteen years, to commence from the day of first publishing it, *and no longer*.

It was further provided, that if the author

(*g*) 8 Anne, c. 19, s. 1.

should be living at the expiration of that term, then the sole right of disposing of the copies of the work should *continue in him* for another term of fourteen years. (*h*)

Next in chronological order comes the act of parliament (*i*) giving to each of the Universities a *perpetual* right over the literary property that had been or might thereafter be, bequeathed to them. This statute will be more particularly noticed under the head of Universities. (*j*)

15 Geo. 3,
c. 56.

Immediately after the union with Ireland, an act of parliament (*k*) was passed to make the law of copyright in every respect the same all over the United Kingdom.

41 Geo. 3,
c. 107.

In it were introduced provisions, extending the benefits arising from literary property to authors in Ireland, which are similar to those contained in the statutes of 8 Anne, and 15 Geo. III.

By this statute eleven copies of every book was to be delivered to eleven public libraries. (*l*)

The most important act of parliament on copyright was passed on the 29th July, 1814; in which all the provisions of the former statutes were consolidated, and at the same time considerable alterations were made in the law.

54 Geo. 3,
c. 156.

By that act, the *time* limited for enjoying the fruits of the copyright of a work, then not published, was extended from fourteen to *twenty-eight*

The time of
copyright.

(*h*) 8 Anne, c. 19, s. 11.

(*i*) 15 Geo. 3, c. 56, and see post, Chap. VII.

(*j*) See 6 & 7 Wm. 4, c. 110.

(*k*) 41 Geo. 3, c. 107.

(*l*) See post, 451.

years; (m) with a further provision, that if the author should be living at the end of that period, then that he should receive the profits accruing from it for the residue of his life. (n)

For the benefit of the *families* of those authors who were alive at the time the act passed, but who might die before the first fourteen years from the day of publishing their works, had expired, a further term of fourteen years was

(m) 54 Geo. 3, c. 156, s. 4.

(n) An author, who sells his work in general terms, without making any limitations, has no resulting right against his own assignee after the first term, formerly of fourteen, but now of twenty-eight years, is expired. Thus a book of roads, printed in letter press, was, at the expiration of the first fourteen years, sold again by its author to a person who published the high roads upon *copper plates*, and the cross roads in *letter press*. An injunction was granted to restrain the second publication of the letter press, but it did not extend to the delineations on copper plates, which were considered as forming a *new work*. *Carnan v. Bowles*, Trin. T. 26 Geo. 3. 2 Bro. C. C. 80, and 1 Cox. 283. *Rennett v. Thompson*, id.

It was ruled in the case of *Brooke v. Clarke*, 1 Barn. & Ald. 396, that if a work has been published more than twenty-eight years *before* the time of passing the stat. 54 Geo. 3, c. 156, the author is not entitled to the copyright in it for the remainder of his lifetime; for that act was made to extend the rights *then existing*, and not to re-create any expired right. It was in that case admitted, that if any persons had published the work after the expiration of the twenty-eight years, and before the act of 54 Geo. 3, had passed, the author could not have interfered with them; and certainly, whether the public had or had not actually exercised that right, no difference could exist without some express words in the statute for that purpose.

given to their *personal representatives*, without prejudice to the assignees of all or any part of the former term. (*o*)

The *places* of protection for copyright, named in that statute, are the United Kingdoms of Great Britain and Ireland, the Isles of Man, Jersey, and Guernsey, and every other part of the British dominions. (*p*)

Places of protection.

By the 3 Wm. IV. c. 15, the property in *Dramatic Works* is secured, and rendered profitable to the authors. (*q*)

3 Wm. 4, c. 15.

By the 5 & 6 Wm. IV. c. 65, (*r*) public lectures are protected, and the authors of them can maintain without difficulty their copyright in them.

5 & 6 Wm. 4, c. 65.

The other statutes, which are akin to the copyright acts, secure to artists a right over their productions, the results of their knowledge, skill and labour.

A copyright in engravings is made by 8 Geo. II. c. 13, 7 Geo. III. c. 38, and 17 Geo. III. c. 57, (*s*) extended to Ireland by 6 & 7 Wm. IV. c. 59.

Engravings.

By the 27 Geo. III. c. 38, and 34 Geo. III. c. 23, (extended to Ireland by 2 Vict. c. 13, so as to include wool, silk and hair) patterns for printing *linens, cottons, calicoes* or *muslins*, are protected for three months. (*t*)

Patterns on linen, &c.

By the 2 Vict. c. 17, original designs for, or patterns, to be worked into or printed on any

Patterns on woollen articles.

(*o*) 54 Geo. 3, c. 156, s. 8, and see post, Assignee, Chap. VII.

(*p*) Id. s. 4.

(*q*) See post, p. 390.

(*r*) See post, p. 327.

(*s*) See post, p. 397.

(*t*) See post, p. 410.

article of manufacture, except those within by 2 Vict. c. 13, are protected for *twelve months*, such as carpets &c. (*u*)

Modelling.

By the same act, 2 Vict. c. 17, inventors of designs, made for the *modelling*, or the casting, or the embossment, or the chasing, or the engraving, or for any other kind of impression or ornament on any article of manufacture, being formed of any metal or mixed metals, have the sole right to use the same during the term of *three years*. (*v*)

Sculptures.

The works of sculptors are protected by 38 Geo. III. c. 71, and 54 Geo. III. c. 56.

Such are the acts of the legislature by which the fruits of the labours of *Scholars* and *Artists* are secured to them and their representatives.

Several attempts have been made in parliament to extend *the time* of the copyright, particularly by Mr. Serjeant Talfourd. (*w*)

(*u*) See post, p. 413.

(*v*) See post, p. 414.

(*w*) See post, p. 419. See "*Three Speeches* delivered in the House of Commons in favour of a measure for an extension of Copyright, by T. N. Talfourd, serjeant-at-law. Moxon, 1840,"—most eloquent and very argumentative. In the second speech, at page 56, there is a comparison between the protection afforded to inventors and the authors of literary works. It is quoted as appropriate to the subjects forming the two parts of this Treatise. "One of the arguments used, whether on behalf of the trade or the public I scarcely know, against the extension of the term, is derived from a supposed analogy between the works of an author and the discoveries of an inventor, whence it is inferred that the term which suffices for the protection of the one is long enough for the recompense of the other. It remains to be proved that the protection granted to patentees is sufficient; but supposing it to be so,

By his bill he wishes to enact, that the copyright in any book thereafter to be published

although there are points of similarity between the cases, there are grounds of essential and obvious distinction. In cases of patent, the merits of the invention are palpable; the demand is usually immediate; and the recompense of the inventor, in proportion to the utility of his work, speedy and certain. In cases of patent, the subject is generally one to which many minds are at once applied; the invention is often no more than a step in a series of processes, the first of which being given, the consequence will almost certainly present itself sooner or later to some of those minds; and if it were not hit on this year by one, would probably be discovered the next by another; but who will suggest that if Shakspeare had not written *Lear*, or Richardson *Clarissa*, other poets or novelists would have invented them? In practical science every discovery is a step to something more perfect; and to give to the inventor of each a protracted monopoly would be to shut out improvement by others. But who can improve the masterpieces of genius? They stand perfect; apart from all things else; self-sustained; the models for imitation; the sources whence rules of art take their origin. Still they are ours in a sense in which no mechanical invention can be;—ours not only to ponder over and to converse with,—ours not only as furnishing our minds with thoughts, and peopling our weary seasons with ever-delightful acquaintances; but ours as suggesting principles of composition which we may, freely strive to apply,—opening new regions of speculation which we may delightfully explore,—and defining the magic circle, within which if we are bold and happy enough to tread, we may discern some traces of the visions they have invoked, to embody for our own profit and honour; for the benefit of the printers and publishers who may send forth the products of these secondary inspirations to the world; and of all who may become refined or exalted by reading them.”

“When I am asked, why should the inventor of the steam-engine have an exclusive right to multiply its form for only

in the lifetime of the author, should belong to the author and his assigns for the author's life, and for sixty years to commence at his death; and if published after the author's death, then to belong to the proprietor of the manuscript for sixty years from the first publication thereof.

In cases of subsisting copyright, he wishes to enact, that the extended term should also be given, except when it should belong to an assignee, for other consideration than natural love and affection; in which case it should cease at the expiration of the present term, unless its extension should be agreed to, by the proprietor and the author.

International
copyright.

By the 1 & 2 Vict. c. 59, an International copyright is attempted to be established. Her Majesty, by order in council, may direct that authors of books first published in foreign countries, and their assigns, shall have a copyright in such books within her dominions. (x)

fourteen years, while a longer time is claimed for the author of a book? I may retort, why should he have for fourteen years what the discoverer of a principle in politics or morals, or of a chain of proof in divinity, or a canon of criticism, has not the protection of as many hours, except for the mere mode of exposition which he has adopted? Where, then, the analogy between literature and mechanical science really exists, that is, wherever the essence of the literary work is, like mechanism, capable of being used and improved on by others, the legal protection will be found far more liberally applied to the latter—necessarily and justly so applied—but affording no reason why we should take from the author that which is not only his own, but can never, from its nature, be another's."

(x) See *D'Almaine v. Bossey*, 1 Y. & C. 288.

In *America*, (*y*) the copyright is secured by an act of Congress passed 3rd February, 1831, to an author, being a citizen of the United States, or resident therein, for the term of twenty-eight years; and if either he, his wife or children, survive that period, then for a further term of fourteen years.

Copyright in
foreign
countries.
America.

The law now in force in *France* (*z*) is a government decree under the empire, dated 5th February, 1810, by which the property in a work is secured to an author for his life, to his widow for her life, and, after their death, to their children for twenty years.

France.

The law, it seems, is the same in the *Two Sicilies* as in *France*. (*a*)

The Two
Sicilies.

In *Holland* and *Belgium*, (*b*) by a law passed in 1817, when the two countries were united, and now in force in each country since the separation, the duration of a copyright is to the author for his life, and to his heirs and representatives for twenty years after his death.

Holland and
Belgium.

In 1837, the Germanic Diet resolved art. 2, (*c*) that literary rights shall pass to the heirs or representatives of the authors or artists, or those

Germany.

(*y*) See "An Historical Sketch of the Law of Copyright, by John J. Lowndes, Esq.," which is a learned and elaborate and well written treatise, to prove that copyright is a right that ought to be perpetual. From the Appendix to that work the above observations on copyright in foreign countries are extracted. Published in 1840.

(*z*) Lowndes on Copyright, p. 117.

(*a*) Id. p. 131.

(*b*) Id. p. 120.

(*c*) Id. p. 122.

to whom they have been transferred ; and when he who brought out the work, or he who is the editor, is named, this right shall be recognised and protected *in all the states* of the confederation for a period of ten years at the least.

Austria.

By an *Austrian* imperial ordonnance, (*d*) art. 1169, the rights of authors respecting the reprinting of their works shall not descend to their heirs.

Prussia.

By an ordonnance dated 11th July, 1837, the law of copyright throughout *Prussia* (*e*) is, that an author shall enjoy the sole right of printing his work for his life ; and then to his heirs for a period of thirty years, to be reckoned from his death.

Bavaria.

In *Bavaria*, (*f*) literary property descends to the heir or representative of the author.

Russia.

By the law of *Russia* (*g*) passed in 1830, the author or translator of a work shall have the sole right of printing and disposing of it during his lifetime ; and his heirs and assigns shall enjoy the same for the term of twenty-five years after his decease : and for a further term of ten years if they shall publish an edition within five years before the expiration of the first term.

Denmark,
Norway,
Sweden,
Spain.

In *Denmark*, *Norway*, *Sweden*, and *Spain*, the copyright of publications is perpetual. (*h*)

(*d*) Lowndes on Copyright, p. 123.

(*e*) Id. p. 124.

(*g*) Id. p. 129.

(*f*) Id. p. 126.

(*h*) Id. p. 130, 1.

CHAP. II.

OF THE DIFFERENT KINDS OF LITERARY PROPERTY.—OF ORIGINAL COMPOSITIONS.

IN the endeavour to treat with perspicuity of the different kinds of literary property, I have arranged them in such order, that those which are similar in their nature, or depend upon the same principles, may be found together in separate divisions of the work. Thus in one chapter is given the law respecting *Original Compositions*, whether printed in a book, or preserved in manuscript, whether composed by a native, or written by a foreigner; and in another, that relating to *Particular treatises on general subjects*, whether compilations, books of calculations, abridgments, translations, or notes and additions. The laws on *Periodical publications*, as reviews, magazines, newspapers, or pamphlets; and those regulating *Theatrical Exhibitions*, as music or plays, will be found in other chapters, distinctly apart by themselves.

A concise statement of the several acts of parliament which give a property (of a literary nature) in works arising from the exertions of genius in the FINE ARTS, as in engravings or

prints, and patterns; in models and sculptures will follow, with the cases that have been decided on them.

This chapter is set apart for *compositions*, which, in the common and strict sense of the word, are called *Original*; and, therefore, it will be occupied by an investigation of the laws relating to books on common topics, as contra-distinguished from those works, which, according to their peculiar contents, are subjected to different laws, thus—

- I. *Of a book generally.*
- II. *Of works in manuscript.*
- III. *Of foreign publications.*

I. A BOOK GENERALLY.

Definition of a book.

Although it was for a long time doubted, yet it is now clearly settled, that a literary production, to be entitled to the protection of the statutes on copyright, and to come within the words mentioned in the recital of the statute of 8 Anne, "*Books and other writings,*" need not be a book in the common and ordinary acceptation of that word;—a volume made up of several sheets bound together. It may be printed only on *one sheet*, as the words of a song, (*a*) or the music accompanying it.

(*a*) *Hime* (or *Hine*) v. *Dalc*, Sittings after M. T. 1803, 2 Camp. 27, n.; and in 11 East, 244, n. S. C. (See Amb. Rep. 404.) This was an action for pirating the words of a song called "*Abraham Newland,*" published on a single sheet of paper. Erskine, contending that this was a book, said, if a

Every distinct and independent *part* of a work, is also a book within the meaning of the statute, different construction were to be put upon the act, many productions of the greatest genius, both in prose and verse, would be excluded from its benefits. But, might the papers of the Spectator, or Gray's Elegy in a country church-yard, have been pirated as soon as they were published, because they were first given to the world on single sheets? The voluminous extent of a production cannot, in an enlightened country, be the sole title to the guardianship the author receives from the law. Every man knows that the mathematical and astronomical calculations, which will inclose the student during a long life in his cabinet, are frequently reduced to the compass of a few lines. And is all this profundity of mental abstraction in which the security and happiness of the species in every part of the globe depend, to be excluded from the protection of British jurisprudence? But there is nothing in the word *book*, to require that it shall consist of several sheets bound in leather, or stitched in a marble cover. *Book* is evidently the Saxon *boc*; and the latter term is from the *beech-tree*, the rind of which supplied the place of paper to our German ancestors. The Latin word *liber* is of similar etymology; meaning originally only the bark of a tree. *Book* may, therefore, be applied to any writing: and it has often been so used in the English language. Sometimes the most humble and familiar illustration is the most fortunate. The *horn-book*, so formidable to infant years, consists of one small page, protected by an animal preparation; and in this state it has universally received the appellation of a *book*. So, in legal proceedings, the copy of the pleadings after issue joined, whether it be long or short, is called the *paper book*, or the *demurrer book*. In the Court of Exchequer a roll was anciently donominated a *book*, and so continues in some instances to this day. An oath as old as the time of Edward I. runs in this form, "And you shall deliver into the Court of Exchequer a book fairly written," &c. : but the book delivered

as one tale or piece of music printed and bound up with other tales or pieces of music. (*b*)

3. Without author's name.

It will be shewn hereafter that certain names must, for the protection of the public, be printed on every book : (*c*) but it is not necessary that the author's name should appear to secure any right given by the statutes passed for the protection of literary property. (*d*) If the author's name were omitted in the title page, says *Yates, J.*, he might equally insist on his claim ; for if the property be absolutely his own, he has no occasion to add his name to it. (*e*) But in the case of *Hogg v. Kirby*, in which it was endeavoured to be shewn that a new magazine was a fraudulent continuation of a similar work, the Lord Chancellor expressed a doubt whether he ought to interfere, because the latter book bore a *fictitious name*. (*f*)

By several acts of parliament it is enacted that the name of the publisher, and the time of publication must be marked on pieces of music, (*g*) engravings, &c. (*h*)

The *property* in a book generally will be investigated under the "title—" Author and his Assignee." (*i*)

into Court in fulfilment of this oath has always been a roll of parchment.

(*b*) *Id.* and *White v. Geroock*, 2 Barn. & Ald. 298. 1 Chit. Rep. 24, S. C. and see 4 Bing. 540.

(*c*) Post, Chap. VII.

(*d*) *Beckford v. Hood*, 7 T. R. 620.

(*e*) 4 Burr. 2366.

(*f*) 8 Ves. 226.

(*g*) Post, Chap. V.

(*h*) Post, Chap. VI.

(*i*) Post, Chap. VII.

II. WORKS IN MANUSCRIPT.

As a literary work or treatise must necessarily exist in manuscript before it is printed, it appears at first sight more logical, that manuscripts should have been treated of before the law, as it regards books in general, had been inquired into. But upon inspection it will be seen, that the protection given to manuscripts is founded on principles, which are corollaries from the rules respecting the copyright in a book. One of the points proposed to the judges by the House of Lords in the case of *Donaldson v. Becket*, (k) was, whether an author had full power over his work as long as it remained in manuscript; and, with only the dissentient voice of Mr. Baron *Eyre*, the reply was, that he had complete control over it. It follows, that literary compositions in their original state, that is, the *manuscripts*, with the right of first publishing them, are the private and exclusive property of the author. In that condition they may be kept for ever; and if they are taken from him, an action for trover, detinue, or trespass, may be maintained.

Compositions in manuscript may be arranged for consideration in the following manner:—

1. Manuscript works *not used*.
2. Manuscript works that have become *known*.
3. *Epistolary* writings.

(k) 2 Bro. P. C. 144. 4 Burr. 2408.

1. Manuscript works not used.

The Courts of Equity soon interfered to restrain all other persons besides the author from printing and publishing manuscripts, as in the cases of Mr. Webb and Mr. Forrester: (*l*) the former of whom had his precedents of conveyancing stolen out of his chambers and printed, and the latter had his notes on legal subjects, lent to a gentleman for his perusal, copied by a clerk, by whom they were printed. (*m*)

2. Manuscripts already published,

And accordingly it has been determined that a copyright in a piece of music was not lost, although it had been published in manuscript a *year* before it was printed. (*n*) The words “*printed and published,*” used in the statutes, have reference only to the *time* at which the author’s exercise of the right is *to be dated*; and, therefore, the circumstance, of an author having pre-

(*l*) Amb. 695. See *Webb v. Rose*, cited 2 Bro. P. C. 138, and *Forrester v. Waller*, *id.*; and see *Knaplock v. Curl*, 4 Ven. Abr. 278. 2 Evans Coll. Stat. p. 625.

(*m*) See *Burnett v. Chetwood*, 2 Mer. 448, n.

(*n*) *White v. Geroock*, 2 Barn. & Ald. 298. Chit. Rep. 24, S. C. Abbott, C. J.—I am of opinion that an author does not lose his copyright by having first sold the composition in manuscript; for the statute 54 Geo. 3, c. 156, must be construed with reference to the 8 Ann. c. 19, which it recites, and which, together with the 41 Geo. 3, c. 107, were all made *in pari materia*, for the purpose of enlarging the rights of authors. The 8 Ann. c. 19, gave to authors a copyright in works, not only composed and printed, but *composed and not printed*; and I think that it was not the intention of the legislature, either to abridge authors of their former rights, or to impose upon them as a condition precedent that they should not sell their compositions in manuscript before they were printed. Rule refused.

viously published in manuscript any composition which is afterwards printed, only varies the period of time, from which the twenty-eight years is to be calculated. (o)

And in Equity it was held that a copyright exists in the manuscript of a play, even after it has been performed at a theatre. (p)

Of a similar kind are lectures, the sentiments and language whereof are delivered orally. It was doubted whether there is any legal right of property in the sentiments and language of a lecture, thus orally delivered, and which cannot be shewn to have been reduced into writing: although the persons attending such lecture have no right to publish it for profit; (q) and an action upon an implied contract, will lie against a pupil attending the lecture, who causes it to be published for profit. But the Court would grant an injunction against third persons publishing the lecture, who must have procured the means of publishing it, from the persons who attended the delivery thereof, and were thus bound by the implied contract not to publish it. Lectures are now protected by 5 & 6 Wm. 4, c. 65. (r)

There is a peculiar class of manuscript literary 3. Epistolary writings.

(o) *White v. Geroock*, 1 Chit. Rep. 27.

(p) *Macklin v. Richardson*, Amb. 694; and post, Chap. V. The *property* in MSS., and the right which possessors of them have over them, will be investigated under the division "Author and his Assignee," post, Chap. VII.

(q) *Abernethy v. Hutchinson*, 3 Law Journal Rep. Eq. 209.

(r) See post, Newspapers, Chap. III.

property—*Epistolary writings*. They appear to be of several descriptions.

Letters written, originally intended for the press.

The first species is that in which the *form* of letters is merely given to a work in order to allow the author a latitude of expression, for rendering himself intelligible, or for any other purpose, whilst the work is *really* a literary composition; differing in no other respect from a book in general than in the dress it has assumed; and consequently it is protected by the law like every other kind of literary property.

Letters of literary persons.

Letters of the second species are those, which, although they have passed from one person to another, may, from the nature of the subjects mentioned in them, and the literary character of the writer, be considered, when a great number of them are collected together, as forming a literary work.

When letters thus take the *character* of a literary composition, the writer, by the mere transmission of them to the person to whom they are addressed, does not give the receiver any right to publish them.

When it was objected that where a man writes a letter, it is in the nature of a *gift* to the receiver, Lord Hardwicke observed, (r) “ I am of opinion that it is only a special property in the receiver. Possibly the property in the paper may belong to him: but this does not give a licence to any person whatsoever to publish them to the

(r) 2 Atk. 342.

world ; for at the most the receiver has only a joint property with the writer.”

If individuals, to whom such letters are addressed, have not the power to publish them, how much more strictly ought third persons, into whose hands they may have fallen, to be prevented from printing them ? Lord Hardwicke granted and continued an injunction to restrain Curl, (s) from republishing in England a book containing letters of Pope, Swift, &c., and their friends, which had been obtained without their consent, and first published in Ireland. The injunction, being originally granted at the instance of Pope, was made to extend to the letters written by him, but not to those which he had received from other persons.

Upon the same principle Lord Apsley granted an injunction to prevent the publication of Lord Chesterfield's Letters to his Son, although the widow of Mr. Stanhope was the publisher ; because she had not obtained either the consent of Lord Chesterfield in his lifetime, or that of his executors after his death. (t)

The third species consists of common letters on business, and on every other subject that can occur in the intercourse of private life, but which never could have been intended to be published, and, therefore, *cannot be considered as literary*

Common letters.

(s) *Pope v. Curl*, 2 Atk. 342.

(t) *Thompson v. Stanhope*, Amb. 737 ; and *Duke of Queensberry v. Shebbeare*, cited in 4 Burr. 2330, S. C. 2 Eden. Rep. 329 ; and see 2 Evans. Coll. Stat. p. 624.

compositions, and entitled to protection on the ground of a copyright existing in them.

Although the Courts of Equity will sometimes interpose to stop the publication of such letters; yet it is not upon the ground of copyright, but that the publication is a *breach of contract, or confidence*; or when they are intended to be made a source of *profit*, at the risk of wounding private feelings.

If in such cases the Courts of Equity were to interfere on any other principle, they would defeat the ends of justice. An individual would be deprived of his defence in proving agency, orders for goods, the truth of an assertion, or some other fact; merely because the proof was contained in letters in which a pretended copyright were claimed.

Thus, upon the principle of *breach of contract*, an injunction was granted to prevent the publication of letters written by an old lady to a young man, to whom she had been foolishly attached; there being an agreement not to publish the letters, but to deliver them up for a valuable consideration; and a sum of money having been actually paid to the defendant. (u)

In a case before Lord Manners, (x) upon a bill filed by an executor, it appeared that the defendant, who was a relation of the testatrix, and as

(u) — v. *Eaton*, 13th April, 1813, cited 2 Ves. & Beam. 27.

(x) *Earl of Granard v. Dunkin*, 1 Ball & Beat. 207, cited in 2 Ves. & Beam. 21.

such had been *permitted to reside* in her house in Dublin, where she left a great number of letters, had refused to deliver them up, and threatened to publish them by subscription; an injunction was granted to restrain the publication.

But the Court of Chancery (*y*) dissolved an injunction obtained on account of agency and

(*y*) *Ferceval v. Phipps*, 2 Ves. & Beam. 28. Sir Thomas Plumer, V. C.—This is the naked case of a bill, certainly, to prevent the publication of private letters; not stating the nature, subject, or occasion of them, or that they were intended to be sold as a literary work for profit, or are of any value to the plaintiff. Upon such a case it is not necessary to determine the general question, how far a Court of Equity will interpose to protect the interest of the author of private letters. The interposition of the Court in this instance certainly is not a consequence from the cases that were cited (*Pope v. Curl*, *Thompson v. Stanhope*); upon which I shall merely observe that, though the form of familiar letters might not prevent their approaching the character of a literary work, every private letter, upon any subject to any person, is not to be described as a literary work, to be protected upon the principle of copyright. The ordinary use of correspondence by letters is to carry on the intercourse of life between persons at a distance from each other, in the prosecution of commercial or other business; which it would be very extraordinary to describe as a literary work, in which the writers have a copyright. Another class is the correspondence between friends or relations upon their private concerns; and it is not necessary here to determine how far such letters, falling into the hands of executors, assignees of bankrupts, &c., could be made public in a way that must frequently be very injurious to the feelings of individuals. I do not mean to say that would afford a ground for a Court of Equity to interpose to prevent a breach of that sort of confidence independent of contract and property.

confidence, when the answer denied confidence and avowed that the defendant's object in publishing them in a Newspaper, of which he was the proprietor, was not to obtain profit, but to *vindicate his character* from the imputation of having published false intelligence, publicly cast on him by the plaintiff; who failed on both grounds for the interference of a Court of Equity — copyright and confidence.

III. OF FOREIGN PUBLICATIONS.

Formerly if a book were written by a foreigner and published in a foreign country, a person who purchased the right to publish it here, could not support any copyright thereon either at law or equity, in this country. (z)

But by the 1 & 2 Vict. (a) it is enacted, that her Majesty, by any order in council, may direct that the authors of books which shall, after a future time to be specified in such order in council, be published in any foreign country to be specified in such order in council, and their executors, administrators, and assigns, shall have the sole liberty of printing and reprinting such books within the United Kingdom of Great Britain and Ireland, and every other part of the British dominions, for such term as her Majesty shall by such order in council direct, not exceeding the term which authors being British subjects are now by law entitled to in respect of books first pub-

(z) *Guichard v. Mori*, 9 Law Journal, Rep. Ch. 226.

(a) 1 & 2 Vict. c. 59.

lished within the United Kingdom ; provided, that no such author or his assigns shall be entitled to the benefit of the act unless, within a time to be in that behalf prescribed by such order in council, the title to the copy of every such book, and the name and place of abode of the author thereof, and the time and place of the first publication thereof in such foreign country, shall be entered in the register book of the Company of Stationers in London ; and unless, within a time to be also prescribed by such order in council, one printed copy of the whole of such book and of every volume thereof, upon the best paper upon which the largest number or impression of such book shall have been printed for sale, together with all maps and prints relating thereto, shall be delivered to the warehouse keeper of the Company of Stationers at the hall of the said company.

In the case of books published anonymously, the name of the publisher will be sufficient, (*b*) and the wrongful first publication may be amended by Court of Chancery. (*c*)

In the event of a second edition, it is only necessary to deliver the additions or alterations made in the work. (*d*)

(*b*) *Id.* sec. 2.

(*c*) *Id.* sec. 3.

(*d*) *Id.* sec. 4.

CHAP. III.

OF PARTICULAR WORKS ON GENERAL SUBJECTS.

MANY inconveniences would arise from allowing one person to engross a *general subject*; and therefore each original *particular treatise* on a general subject will always be protected by the courts of justice. (a)

When two persons exert their talents upon the same subject, they may produce works of great similarity, but each of them will justly be entitled to full power over his own book; and any priority of publication will not affect the property in the one last published. Taking the same general subject, they may differently arrange what has been said upon it, add new parts, and omit useless ones; and each of them will respectively acquire a copyright in his production. There must not, however, be any *copying* from a former work. The *subject* is open to all, but the copyright exists only *in the result* of each man's labour.

(a) See *Matthewson v. Stockdale*, 12 Ves. 273, for an elaborate opinion of Lord Erskine on this kind of literary compositions.

It will be convenient to divide works on general subjects into,

- I. *Compilations.*
- II. *Books of Calculations*
- III. *Abridgments.*
- IV. *Translations.*
- V. *Notes and Additions to an old Book.*

I. COMPILATIONS IN GENERAL.

It would be a difficult task to enumerate all the kinds of literary works which could properly be comprised under the term *Compilations*.

They are,—

1. Road Books.
2. Series of Chronology.
3. Calendars of Names, &c.
4. Dictionaries, &c.
5. Encyclopædias, &c. &c.

Road Books are compilations. Captain Pat-
 terson, after he had sold *all* his right in his Book
 of Roads to Carnan, at the expiration of fourteen
 years, published it with the high roads engraved
 upon copper-plates; and it was ultimately con-
 sidered that although he had made a new work
 as to that part; yet as to the letter press, the
 injunction obtained against his assignee was
 founded in equity and was, therefore, con-
 tinued. (*b*)

1. Road books,

(*b*) *Carnan v. Bowles*, 1 Cox, 284, and see 2 Bro. C. C. 80, ed. by Belt, ante, 210. Lord Thurlow observed that, as the roads of Great Britain were open to the inspection and

Mr. Cary, at great expense, improved Patterson's work ; and had several times to defend his additions from piracy. In his endeavour to obtain an injunction against Faden he failed. (c) In an action against Longman, (d) it was clearly proved that *nine-tenths* of the alterations and additions had been copied *verbatim*, and he had a verdict. In that against Kearsley, (e) it appeared that, although Kearsley had transcribed observation of all mankind, every one was at liberty to publish the result of such observation ; the subject matter of these books were, therefore, *in medio*. But the question will be, whether the author has exhibited any new and distinct idea in the exposition of them, and then whether the subsequent editor has, in substance, adopted the same. When globes were first invented, this was a new scheme of exhibiting the face of the earth, different in substance from the plain chart. Now, then, the addition of a few places on the globe will not make a new invention, the substratum being the same. So, in the case of Newton's Milton, the Court thought that Milton's Works were *in medio* ; but the notes and other additions were not so ; and therefore, as to them, restrained the publication, though they left the text open to any body. Now, here, if the scheme of exhibiting this information to the public is substantially and fundamentally the same in the second work as in the first, and the former is merely reprinted with such differences as not to amount fundamentally to a different project of exhibition, the law ought to interfere and protect the exhibition. His Lordship thought the report not sufficiently clear ; and directed that it should be again referred to the Master whether the books were the same, or whether the latter differed from the former so as to render the same a new and original work in any, and what particulars.

(c) *Cary v. Faden*, 5 Ves. 24.

(d) *Cary v. Longman*, 3 Esp. N. P. C. 273. 1 East, 359.

(e) *Cary v. Kearsley*, 4 Esp. N. P. C. 168.

into his book a great quantity of Cary's new matter, yet he had done it with additions and observations of his own, and with corrections of misprintings, and that he had broken several routes into two parts, and that no entire particular paragraph had been transcribed; and thereupon Cary was nonsuited.

All human events being equally open to the observation of all men, every one is at liberty to add to or improve the materials respecting them, already collected.

A *Series of Chronology* is, therefore, another general subject; and, in considering whether a treatise is a piracy of another book on the same events, the question will be, whether in substance the one work is an imitation of the other; whether the one book is a copy of the other, by the author having availed himself of the arrangement, with alterations merely colourable, or whether it is as original as the nature of the matter will admit; for undoubtedly, in chronological works, the same facts must be related. When it appeared that Dr. Trusler's book (*f*) had been copied literally from page 20 to 34, Lord Kenyon held that he must recover in an action at law, although other parts of the defendant's work were original.

2. Series of chronology.

Another kind of compilations are Calendars. It is a very numerous species, and questions

3. List of names. Calendars.

(*f*) *Dr. Trusler v. Murray*, M. 1789, cor. Lord Kenyon. 1 East, 362, n., and ante, 215, n.; and see *Jeffery v. Bowles*, 1 Dick. Rep. 429. *Trusler v. Comyns*, id., and 12 Ves. 273.

respecting them have frequently been brought before the courts. But it has uniformly been decided, that although no copyright can exist in a *list of names* as a general subject, yet it may in an individual work; and when it can be traced that another book with a similar title is not an original compilation, but a mere transcript, with colourable variations, the one first printed will *immediately* be protected by injunction, because it is of a transitory nature. Every body may make an India Calendar, (*g*) a Court Calendar, (*h*) a Directory, &c. but no one is permitted servilely to copy one already published.

4. Dictionaries,
&c.

Histories and *Dictionaries* are general subjects. Two men may give a relation of the same facts in the same order of time, in different historical works: and in different dictionaries interpretations must necessarily be given of the same words; and hence there must be great similarity between the performances; and yet if the one author has not copied from the other, which would easily appear upon examination,

(*g*) *Matthewson v. Stockdale*, 12 Ves. 270.

(*h*) *Longman v. Winchester*, 16 Ves. 272. Lord Chancellor.—To the extent, therefore, in which the defendant's publication has been supplied from the other work, the injunction must go: but I have said nothing that has a tendency to prevent any person from giving to the public a work of this kind, if it is the fair fruit of original labour, the subject being open to all the world. But if it is a mere copy of an original work, this Court will interpose against that invasion of copyright.

both books come within the meaning of the statutes on copyright. (i)

The largest compilation is an *Encyclopædia*, or Dictionary of Arts and Sciences. The authors of this kind of literary composition have generally taken from the works of others with unsparing hands. It was formerly thought that the essence of any work might be published in a scientific dictionary, because the latter could not diminish the sale of the original treatise; for no one would purchase a voluminous work as a substitute for a small book, and therefore, that there could be *no intention* to pirate. It will be shewn to what extent quoting may be carried; and that, when large portions of a work are taken, the intention to pirate is implied. (k) When it appeared that 75 out of 118 pages of a work on *Fencing* (l) had been transcribed into an *Encyclopædia*, the Court held that a piracy had been committed. A compilation may be different from a treatise published by itself; but certain limits must be fixed to the transcripts. It must not be allowed to sweep up all modern works, or an *Encyclopædia* would completely destroy all literary property. (m)

5. An Encyclopædia.

Maps, Charts, &c., were formerly considered

(i) *Per Lord Mansfield in Sayre v. Moore*, 1 East, 361, n.

(k) See post, Piracy, Chap. VIII.; also p. 353.

(l) *Roworth v. Wilkes*, 1 Camp. N. P. C. 98; and see *Wilkins v. Aikin*, 17 Ves. 422.

(m) See *Mawman v. Tegg*, 2 Russ. 385; and *Lewis v. Fullerton*, 17th Vol. Law J. Ch. 291.

as particular works on general subjects. Some doubts have been entertained whether they could properly be brought within the meaning of the copyright acts. They are now included among *Engravings*, and under that division the law respecting them will be found. (n)

II. BOOKS OF CALCULATIONS.

All books of Calculations, if correctly made, must necessarily be the same. Yet a copyright may exist in each book, because each work being the produce of the ingenuity and labour of its respective author, it is but fair that both of them should take their chances of success, and be protected against any infringement by a third person, who has not been instrumental towards promoting the public knowledge.

This kind of books consists of *Almanacks*, (o) and those works which contain *Logarithms*, *Tables of Interest*, &c.

I. *Almanacks.* James the First, in the 13th year of his reign, granted to the Company of Stationers the right of printing such Almancks as were sanctioned by the Archbishop of Canterbury and the Bishop of London, or either of them. A similar privilege was also granted to the Universities of Oxford and Cambridge. (p) The validity of these patents,

(n) Post, Chap. VI. *Sayre v. Moore*, 1 East, 361, n.; but see 12 Ves. 274.

(o) By 4 & 5 Wm. 4, c. 57, the stamp duty is repealed.

(p) As to the equivalent given to the Universities, see post, Chap. VII.

although many injunctions had been allowed in support of them, (*p*) was questioned in the fifteenth year of Geo. 3, by Carnan, (*q*) a bookseller, in his answer to a bill in Chancery, filed by the Company of Stationers, to obtain an injunction to restrain him from publishing Almancks. The legal question was referred to the Court of Common Pleas, who certified that the crown had not a prerogative or power to make such a grant to them, exclusive of others. The bill was accordingly dismissed. (*r*)

Any person may, therefore, make the calculations usually published in Almanacks, and claim a copyright in them.

(*p*) *Stationers' Company v. Lee*, 2 Ch. Ca. 66. *Same v. Wright*, id. 76. *Same v. Partridge*, cited in *Donaldson v. Beckett*, 2 Bro. P. C. 137, Toml. ed.

(*q*) 2 Bla. Rep. 1004; and see post, Chap. VII.

(*r*) The Almanack, divested of its prognostications, was first printed with the Common Prayer Book, for the purpose of regulating the feasts and fasts: but in strictness it is no part of it. 4 Burn, 2328. That is the one to which it is said the Courts must refer. The judges have considered the calendar of sufficient authority for determining upon what day of the week a certain day of the month fell, and for other legal purposes. See *Queen v. Dyer*, 6 Mod. 41. *Brough v. Parkins*, id. 81. *Page v. Faucet*, Cro. Eliz. 227. 1 Leon. 328, 242. *Hoyle v. Lord Cornwallis*, 1 Stra. 387. Fortesc. 373. *Harvey v. Road*, Salk. 626. 6 Mod. 160. 6 Mod. 196, S. C. *Fish v. Broket*, Dyer, 182, pl. 55. 1 Leon. 242.

The Calendar was reformed by act of Parliament, 24 Geo. 2, c. 23, whereby it was enacted, that the day after the 2nd September, 1752, should be considered as the 14th September. That act was afterwards amended by 25 Geo. 2, c. 30, and 26 Geo. 2, c. 34.

Nautical
almanack.

Many acts of Parliament (s) were passed offering public rewards to such persons as should discover an exact method of ascertaining the Longitude. A power was given to the commissioners appointed to carry them into execution, to publish a Nautical Almanack, or Astronomical Ephemeris. They were further empowered to give a *license* to some one to print it. Any other person printing, publishing, or vending it, subjected himself to a penalty. Those acts have been repealed, (t) and the Nautical Almanack is now placed under the control of the Lords of the Admiralty, and the penalty is increased to 20*l.*, with costs of suit, to be paid and applied to the use of the Royal Hospital for Seamen at Greenwich.

2. Tables of
logarithms, &c.

Though books of *logarithms*, tables of *interest*, &c., must necessarily be the same, if correctly calculated, yet, inasmuch as great labour must be exerted, and much expense incurred in making the calculations, and publishing them, a copyright exists in each work. And if any circumstance transpires by which it can be shewn

(s) The statutes respecting the discovery of the longitude at sea, and the determining the longitude and latitude of the Port Towns, were 12 Ann. stat. 2, c. 15. 14 Geo. 2, c. 39. 18 Geo. 2, c. 17. 26 Geo. 2, c. 25. 2 Geo. 3, c. 18. 3 Geo. 3, c. 14. 5 Geo. 3, c. 11. 5 Geo. 3, c. 20. 10 Geo. 3, c. 34. 13 Geo. 3, c. 77. 14 Geo. 3, c. 66. 16 Geo. 3, c. 6. 17 Geo. 3, c. 48. 29 Geo. 3, c. 61. 21 Geo. 3, c. 52. 30 Geo. 3, c. 14. 36 Geo. 3, c. 107. 43 Geo. 3, c. 118. 46 Geo. 3, c. 77. 55 Geo. 3, c. 75. 58 Geo. 3, c. 20. 1 & 2 Geo. 4, c. 2.

(t) 9 Geo. 4, c. 66.

that one book is merely a copy of another, an injunction will be granted ; but, if that does not plainly appear, the bill will be dismissed. (*u*) It is, of course, competent to the defendant to shew that he made the calculations which he has published, and then both works are original.

The usual mode of proving *piracy* of compilations, and books of calculations, is by shewing that the mistakes and errors of the book first published have been copied into the one complained of. But this is not of itself sufficient. (*v*) Further proof is often given, as that parts of the first work were used at the press when the second was being printed ; and that the alterations supplied in manuscript were merely colourable.

Piracy of
general sub-
ject.

Some circumstance, which would shew that the works would not, in all probability, have been similar, but by the one being copied from the other, (as where in two calendars the persons of the name of Smith were arranged in the same but not alphabetical order of their *Christian* names,) (*w*) is good *presumptive* evidence of piracy.

In all these cases the *defendant* may prove in what the amendments and corrections consist ; and that the alterations have been made by his labour, care, and expense.

(*u*) *King v. Reed*, 8 Ves. 223, n.

(*v*) 3 Esp. N. P. C. 273. 4 Esp. N. P. C. 168. 12 Ves. 275.

(*w*) 12 Ves. 271. 17 Ves. 425.

III. ABRIDGMENTS, &c.

Nearly upon the same principles, by which it is shewn that there cannot be a monopoly of a general subject, it appears that *books themselves* for certain purposes, besides the mere act of reading them, may be used by the public.

They are in fact general subjects—data—which may afford opportunities for other persons besides the authors to exercise their ingenuity. They may be taken as the ground work of other literary labours.

Thus a copyright may exist in *abridgments* or *translations* of works. Also in the *notes and additions* printed in a new edition of a book, over which the right of the author has expired. For one man may compose a work, for instance in the Latin language, another abridge it, a third translate it, and a fourth write annotations upon it; and every one of them will acquire a copyright in the product of his own ingenuity and labour.

Many valuable works are so voluminous that abridgments of them are extremely useful. To make them, some judgment must be exercised, and some labour employed; and therefore the authors of them ought certainly to be encouraged.

In general, an abridgment tends to the advantage of the author, if the composition be good; and may serve the end of an *advertisement*.

The inquiry, whether the work is *prejudiced* by the *manner* of making the abridgment, can-

not be entertained. An injunction was refused to stop the publication in a magazine, of an abridgment of Johnson's Tale of Rasselas; (*x*) when it appeared, that not one-tenth part of the first volume had been abstracted, and that the injury, alleged to be sustained by the author, arose from the abridgment containing the narrative of the tale, and not the moral reflections. An abridgment of Dr. Hawkesworth's voyages (*y*) was protected in a Court of common law.

(*x*) *Dodsley v. Kinnersley*, Amb. 403.

(*y*) *Strahan v. Newberry*, Lofft. Rep. 775. Injunction against an editor by Mr. Newberry, of an abridgment of Dr. Hawkesworth's Voyages.

Apsley, C., was of opinion, that to constitute a true and proper abridgment of a work, the whole must be preserved in its sense; and then the act of abridgment is an act of the understanding employed in carrying a large work into a smaller compass, and rendering it less expensive, and more convenient, both to the time and use of the reader, which makes an abridgment in the nature of a new and meritorious work. That this had been done by Mr. Newberry, whose edition might be read in the fourth part of the time, and all the substance preserved, and convey in language as good or better than the original, and in a more agreeable and useful manner. That he had consulted Mr. Justice Blackstone, whose knowledge and skill in his profession was universally known; and who, as an author himself, had done honour to his country. That they had spent some hours together, and were agreed that an abridgment, where the understanding was employed in retrenching unnecessary and uninteresting circumstances, which rather deaden the narrative, is not an act of plagiarism upon the original work, nor against any property of the author, but an allowable and meritorious work. And that this abridgment of Mr. Newberry's falls within these reasons and descriptions. Bill dismissed.

But then it must be a fair and real abridgment, the work must not be colourably shortened, (z) either by republishing only part of it, (a) or by omitting some parts, and merely transposing the remainder. (b) There must, at least, be invention, learning, and judgment shewn by the author of it. And an injunction will be granted, if the *terms* in which the facts are related be merely the same in both books. (c)

Lord Hardwicke (d) ruled, that the question of a supposed piracy, by making an abridgment, was a case more proper to be examined in equity than to be sent to law, upon account of the necessity of examining and comparing the two books.

Abridgments of works published in an Encyclopedia have been mentioned; (e) and the law is the same in principle when they are inserted in reviews, &c. (f)

IV. TRANSLATIONS.

That every person, who employs his time and abilities in making translations from the ancient classic authors, justly acquires a copyright in the productions, was never doubted.

(z) *Giles v. Wilcox*, 2 Atk. 143, S. C. 3 Atk. 268. Barnard, 368; and see 17 Ves. 422.

(a) *Read v. Hodges*, mentioned in 2 Atk. 143.

(b) *Butterworth v. Robinson*, 5 Ves. 709. 2 Evans' Col. St. p. 629.

(c) *Bell v. Walker and Another*, 1 Bro. C. C. 451.

(d) 2 Atk. 144; and see 4 Ves. 681.

(e) Ante, 344.

(f) Post, 352.

A translation of a book written in the Latin language by a British subject, it has been held, is also a work to be protected. It was observed by the Court, that publishing a translation was not similar to reprinting the original, because the translator had bestowed his care and pains upon it. (*g*)

2. When written by native in foreign language.

This doctrine came under the consideration of the Court of Chancery in a late case, (*h*) when it was contended that there could not be an exclusive property in papers translated from the French and German languages, and published in a periodical work, because all the booksellers had long considered such articles to be public property, and had been accustomed almost immemorially to copy them from the publications of each other.

3. From modern authors.

The Lord Chancellor, however, granted an injunction, observing that translations, if original, whether written by the plaintiff, made at his expense, or *given* to him, could not be distinguished from other works, and were protected by

(*g*) *Burnett v. Chetwood*, 2 Meriv. 441, n. The injunction was, however, granted, on the immorality of the original work; and that it was an improper book to be translated.

(*h*) *Wyatt v. Barnard*, 3 Ves. & Beam. 77. This bill was filed at the instance of the proprietor of the Repertory of Arts, to restrain the proprietor of the Tradesman's Magazine from copying the specifications of patents for inventions as well as the translations. But it was held that no *copyright* could exist in the specifications, although they were acquired from the patent office with some labour and expense. This case is also reported in the Repertory of Arts, Vol. xxv. p. 188.

the stat. of 8 Ann. c. 19. It is expressly reserved by the International Copyright Act, (i) that translations may still be made.

V. NOTES, ADDITIONS, &c. TO AN OLD BOOK.

1. New edition with notes.

Great talents, ingenuity, and judgment, are in general required to compose good notes or additions to the established work of an author of reputation; and hence, when they are made to a book, which is already in the power of any one to print, for the purpose of presenting the public with a new edition of it, reason and justice say that they ought to confer a copyright as much as a separate and distinct work.

2. Additional pieces or parts.

It was said by Lord Kenyon, in the case of *Cary v. Longman*, (k) that the courts of justice had then been long labouring under an error, that an author had no copyright in any part of a work, unless he had an exclusive right to the whole book.

It is now clearly settled that an action lies to recover damages for pirating the additions to an old work. Thus, when Gray's poems, (l) several years after they had been given to the public, were republished by Mason, with many *additional pieces*, an injunction was immediately

(i) 1 & 2 Vict. c. 59, s. 13.

(k) *Cary v. Longman and Rees*, 1 East, 358; and see 3 Esp. N. P. C. 275. 1 B. & A. 396. 3 P. Wms. 255; and ante, p. 336.

(l) *Mason v. Murray*, cited in 1 East, 360.

granted to prevent an infringement of the copyright in the additional pieces.

An injunction is always granted to restrain any one from printing the notes published with a new edition of an old book.

Reprinting
the notes, &c.

A person was enjoined not to print the *Paradise Lost* of Milton, with Dr. Newton's notes, although any one might have republished the *Paradise Lost* by itself. (m) This piracy was endeavoured to be concealed by mixing some new notes with the old ones: but the small number of the new ones (ten) shewed that it was colourably done.

On the other hand, notes or embellishments to a book, the copyright to which is not expired, confers no power to print the original. Although authors of works on the different branches of the law have often printed the statutes at large at the end of their books; (n) yet collusive notes to an edition of the statutes will not take the right of sole printing them out of the king's printer's patent. (o) But Lord Clare doubted whether the king's printer in Ireland could restrain any one who pleased from publishing the *Bible with notes*. (p)

(m) *Tonson v. Walker*, cited in Amb. 405, and reported in 3 Swanst. Rep. 672. And see *Millar v. Taylor*, 4 Burr. Rep. 2325; and in 2 Bla. Rep. 332. See 1 Cox. Rep. 283. *Motte v. Falkner*, 4 Burr. Rep. 2353. 1 Bla. Rep. 331.

(n) Post, Chap. VII.; and see *Cary v. Kearsly*, 4 Esp. N. P. C. 169, for Lord Ellenborough's observations on publishing a part of Paley's *Philosophy* with notes.

(o) *Basket v. Cunningham*, 1 Bla. Rep. 376, post, Chap. VII.

(p) *Grierson v. Jackson*, Irish T. R. 304; see 9 Ves. 341.

3. Corrections;
verbal
criticisms.

Thus much it was necessary to say of additional pieces, and notes to old books. Corrections or additional parts, which take place in works on general subjects, have been before mentioned. (q) No doubt can be entertained but the critic has a copyright even in the verbal corrections and alterations which he makes; as, for instance, in those works published by Dr. Bentley.

(q) Ante, Compilations.

CHAP. IV.

OF PERIODICAL PUBLICATIONS.

It is not so much the *contents* of periodical publications, as the laws, which regulate *the manner of giving them* to the public, that are now to be investigated. When the matter of which they are composed affects the proprietor's *legal right* to the work—when it may be of such a description as entirely to deprive him of all control over it, and the courts of justice will not, on that account, protect him, it will then be necessary to notice and examine the substance of the work itself.

To render intelligible that part of the laws relating to the periodical publications, which are distinct in their nature, it will be convenient to arrange the subjects for discussion in the following order :

- I. *Of Reviews, Magazines, &c.*
- II. *Of Newspapers.*
- III. *Of Pamphlets.*
- IV. *The Property therein.*
- V. *The Legal Proceedings peculiar to Periodical Publications.*

I. REVIEWS.

Reviews, Magazines, Literary Journals, and works of a similar description, consist of *Essays* and *Criticisms*.

1. Original Essays.

The *Essays*, or original pieces, are to be viewed in the same light as though they had been published by themselves,—whether they are the composition of the proprietor himself, or are procured for him. (a)

The parts which contain the criticisms distinguish these productions from books in general. Those articles are compounded of matter taken from the works of other persons, and the observations of the reviewer. The law is, therefore, two-fold, as it regards the extracts, and the observations.

2. Quotations.

The *extracts* must not be made too freely: sufficient may be taken to form a correct idea of the whole; but no one is allowed, under the pretence of quoting, to publish either the whole or the principal part of another man's composition; and, therefore, a review must not serve as a substitute for the book reviewed. If so much be extracted, that the article communicates the same knowledge as the original work, it is an actionable violation of literary property. The *intention* to pirate is not *always* necessary to be proved, in an action for violating this species of

(a) *Wyatt v. Barnard*, 3 Ves. & Beam. 77. *Hogg v. Kirby*, 8 Ves. 215.

copyright; but it is generally to be inferred from the *quantity* of matter copied. (*b*)

The *remarks* made by the critic must not be personal; they must not impugn the moral character of the author. (*c*) It seems that when they are made upon the merits of the work, without any reference to the individual who wrote it, they may be justified, however ridiculous he may be rendered, or how much soever the book may be depreciated in value. (*d*) But in

3. Observations
of critics.

(*b*) *Roworth v. Wilkes*, 1 Camp. 97; and see 4 Esp. N. P. C. 170; and *Wilkins v. Aikin*, 17 Ves. 422. *Whittingham v. Wooler*, Dec. 8, 1817; Eden on Injunctions, 281.

(*c*) See *Green v. Chapman*, 4 Bing. N. C. 92; and *Macleod v. Wakeley*, 3 C. & P. 311.

(*d*) *Carr v. Hood*, 1 Camp. 355; and see *Nightingale v. Stockdale*, Selw. Ab. 1018, 5th edit. Ellenborough, C. J.—Every man who publishes a book commits himself to the judgment of the public; and any one may comment upon his performance. If the commentator does not step aside from the work, or introduce fiction for the purpose of condemnation, he exercises a fair and legitimate right. In the present case, had the party writing the criticism followed the plaintiff into domestic life, for the purpose of slander, that would have been libellous: but no passage of this sort has been produced; and even the caricature does not affect the plaintiff, except as the author of the book which is ridiculed. The works of this gentleman may be, for aught I know, very valuable: but, whatever their merits, others have a right to pass their judgment upon them, to censure them if they be censurable, and to turn them into ridicule if they be ridiculous. The critic does a great service to the public, who writes down any vapid or useless publication; such as ought never to have appeared. He checks the dissemination of bad taste, and prevents people from wasting both their time and money upon trash. I speak

an action for libel against the publisher of a Magazine, evidence of the writer's (not being the defendant) personal malice against the plaintiff is inadmissible. (e)

The *Abridgments* and *Translations* sometimes published in this description of literary works, are judged of in the same manner as abridgments and translations in general. (f)

of fair and candid criticism: and this every one has a right to publish, although the author may suffer a loss from it. Such a loss the law does not consider as an injury, because it is a loss which the party ought to sustain. It is, in short, the loss of fame and profit to which he was never entitled. Nothing can be conceived more threatening to the liberty of the press than the species of action before the Court. We ought to resist an attempt against free and liberal criticism at the threshold.

(e) *Robertson v. Wylde*, 2 M. & Rob. 101. See the cases of *Chubb v. Flannigan*, and *Chubb v. Westley*, 6 Car. & Pay. 436. Id. 431. And also *Watts v. Frazer*, 7 id. 369. If the printer and the editor of a Magazine be sued for a libellous article contained in it, they are both liable for a libellous lithographic print which is contained in the work, though it was not printed by the printer, provided that the print is referred to in the letter press part of the libellous article. And it is not libellous to criticise fairly and honestly a painting or any work of art publicly exhibited, however strong the terms of censure may be. *Thompson v. Shackell*, M. & M. 187. And it has been held, that a fair, reasonable, and temperate, though erroneous criticism of a work of art, if not written for the purpose of hurting the plaintiff in his profession, is not a libel. *Soane v. Knight*, M. & M. 74.

(f) Ante, 344, 346. See *Dodsley v. Kinnersley*, Amb. 403. As to entry of them at Stationers' Hall, see 54 Geo. 3, c. 156, s. 5, and for *property* in a review, see 8 Ves. 215, and post.

II. NEWSPAPERS.

No other class of writings makes so great an impression on the public mind as periodical publications. The most powerful is a *Newspaper*.

The governments of every country have, *therefore*, been very careful to make rules and regulations concerning newspapers. Under despotic ones, they are subject to censors; but in England, where it is contrary to the spirit of the ancient laws to anticipate the commission of evil, it is sufficient that the publishers are known, and may readily be called on to answer for the contents of their papers.

Of the laws respecting newspapers, it will be proper to notice,—

1. The rules that regulate the *publication*, so that the persons concerned in them may be easily known.
2. The *contents*, and what things are sometimes published in them, which give offence to the laws.
3. In what instances noticed by the law. The Gazettes, &c.
4. The stamp duties.

Papers for circulating news were first published in England in the reign of Queen Elizabeth. It was not until the reign of Queen Anne that any notice appears to have been taken of them by the legislature.

A newspaper may now be *defined* to be a

Definition of newspaper.

paper containing public news, intelligence, or occurrences, printed in any part of the United Kingdom, to be dispersed and made public; and it may consist of a sheet, or other piece of paper, (*g*) containing on one side thereof *a superficies*, exclusive of the margin of the letter press, of one thousand five hundred and thirty inches. (*h*)

1. Manner of publication.

The regulations that were made for the better conducting the public press, in those statutes that impose the stamps on newspapers, appear actually or virtually to be consolidated in the act passed in 1836. (*i*)

The declaration

It is required that a declaration (*k*) shall be

(*g*) 6 & 7 Wm. 4, c. 76. The oldest newspaper extant is dated July 23, 1588. "*The English Mercurie, published by authoritie for the prevention of false reports.*" It is among the state papers in the British Museum.

(*h*) For the duty on a newspaper, and the increase of it in proportion to the size, see post, *Stamps*.

(*i*) 6 & 7 Wm. 4, c. 76.

(*k*) *Id.* s. 6. That clause is so very important, that it is better it should be stated at length. It is enacted, that no person shall print or publish, or shall cause to be printed or published, any newspaper before there shall be delivered to the commissioners of stamps and taxes, or to the proper authorized officer at the head office for stamps in *Westminster*, *Edinburgh*, or *Dublin* respectively, or to the distributor of stamps or other proper officer appointed by the said commissioners for the purpose, in or for the district within which such newspaper shall be intended to be printed and published, *a declaration* in writing containing the several matters and things hereinafter for that purpose specified; that is to say, every such declaration shall set forth the correct *title of the newspaper* to which the same shall relate, and the true description of *the house or building* wherein such newspaper is intended to be

delivered into the Stamp Office at Westminster, Edinburgh, or Dublin, or to an officer in the *printed*, and also of the house or building wherein such newspaper is intended to be *published*, by or for or on behalf of the proprietor thereof, and shall also set forth the true *name*, *addition*, and *place of abode* of EVERY person who is intended to be the *printer*, or to conduct the actual printing of such newspaper, and of EVERY person who is intended to be the *publisher* thereof, and of EVERY person who shall be a proprietor of such newspaper who shall be *resident out* of the United Kingdom, and also of every person resident in the United Kingdom who shall be a proprietor of the same, if the number of such last-mentioned persons (exclusive of the printer and publisher) shall not exceed two, and in case such number shall exceed two, then of such two persons, being such proprietors resident in the United Kingdom, the amount of whose respective proportional shares in the property or in the profit or loss of such newspaper shall not be less than the proportional share of any other proprietor thereof resident in the United Kingdom, exclusive of the printer and publisher, and also where the number of such proprietors resident in the United Kingdom shall exceed two, the amount of the proportional shares or interests of such several proprietors whose names shall be specified in such declaration; and every such declaration shall be made and signed by every person named therein as printer or publisher of the newspaper to which such declaration shall relate, and by such of the said persons named therein as proprietors as shall be resident within the United Kingdom: and a *declaration of the like import* shall be made, signed, and delivered in like manner whenever and so often as any share, interest, or property soever in any newspaper named in any such declaration shall be assigned, transferred, divided, or *changed by act of the parties or by operation of law*, so that the respective proportional shares or interests of the persons named in any such declaration as proprietors of such newspaper, or either of them, shall respectively become less than the proportional share or interest of any other proprietor

country, to be appointed for that purpose, under a penalty of 50*l.* for each publication.

thereof, exclusive of the printer and publisher, and also whenever and so often as any printer, publisher, or proprietor named in any such declaration, or the person conducting the actual printing of the newspaper named in any such declaration shall be changed, or shall change his place of abode, and also whenever and so often as the title of any such newspaper or the printing office or the place of publication thereof shall be changed, and *also whenever in any case, or on any occasion, or for any purpose, the said commissioners, or any officer of stamp duties authorized in that behalf, shall require such declaration to be made, signed, and delivered, and shall cause notice in writing for that purpose to be served upon any person, or to be left or posted at any place mentioned in the last preceding declaration delivered as aforesaid, as being a printer, publisher, or proprietor of such newspaper, or as being the place of printing or publishing any such newspaper respectively; and every such declaration shall be made before any one or more of the said commissioners, or before any officer of stamp duties or other person appointed by the said commissioners, either generally or specially in that behalf; and such commissioners or any one of them, and such officer or other person, are and is hereby severally and respectively authorized to take and receive such declaration as aforesaid; and if any person shall knowingly and wilfully sign and make any such declaration in which shall be inserted or set forth the name, addition, or place of abode of any person as a proprietor, publisher, printer, or conductor of the actual printing of any newspaper to which such declaration shall relate, who shall not be a proprietor, printer, or publisher thereof, or from which shall be omitted the name, addition, or place of abode of any proprietor, publisher, printer, or conductor of the actual printing of such newspaper, contrary to the true meaning of this act, or in which any matter or thing by this act required to be set forth shall be set forth otherwise than according to the truth, or from which any matter or thing required by this act to be truly set*

To prevent fraud in the returns as to Newspapers, there is to be a distinct *die* to mark or stamp each newspaper; so that the stamps delivered for one paper may not be used by the proprietors of another newspaper. (*l*)

The declaration is filed by the commissioners, (*m*) and a certified copy made and signed by them, is delivered on payment of one shilling, will, in all matters civil and criminal, be *evidence of itself* against the makers of it. (*n*) A false certificate renders its maker liable to a penalty of 100*l*. The prosecutor for penalties,

Evidence of
publication.

forth shall be entirely omitted, every such offender being convicted thereof shall be deemed guilty of a MISDEMEANOR.

(*l*) 6 & 7 Wm. 4, c. 76, s. 3.

(*m*) *Id.* s. 8.

(*n*) In an action for a libel contained in a newspaper, the defendant has a right to have read, *as part of the plaintiff's case*, another part of the same newspaper referred to in the libel complained of. *Thornton v. Stephen*, 2 M. & Rob. 45. And in an action for a libel against the printer of a newspaper, one of the proprietors of the newspaper is a competent witness for the defendant, as he is not liable for contribution. *Moscatti v. Lawson*, 7 C. & P. 32. And it seems the proprietor of a newspaper, convicted and fined for the publication of a libel in the paper, inserted without his knowledge and consent by the editor, cannot recover against the editor the damages sustained by such conviction. *Colburn v. Patmore*, 1 C., M. & R. 73. 4 Tyr. 677. The defendant cannot go into evidence in mitigation of damages, to shew that the same libel had appeared in another newspaper, from which the plaintiff had already recovered damages; but the defendant may shew that he copied the libel from another newspaper, and omitted several passages contained in that newspaper which reflected on the character of the plaintiff. *Creevey v. Carr*, 7 C. & P. 64.

upon producing a newspaper, need not prove the purchase of it. All notices will be sufficiently served, which are left at the printing-office named in the act. (n) But if another declaration has been made and delivered to the commissioners (prior to the publication of any objectionable matter,) in which it is specified that the maker of it has ceased to be engaged in the newspaper, he will be exonerated from all liability imposed by the first declaration. (o)

Names on the paper.

The *names* and *residences* of the printers and publishers, and the day of publication, must also appear at the end of every newspaper; (p) and

(n) 6 & 7 Wm. 4, c. 76, s. 9.

(o) Id. See *Rex v. Gutch and Others*, 1 M. & M. 433. In an indictment for libel, the proprietor of a newspaper is *primâ facie* answerable for what appears in it: but the presumption arising from proprietorship may be rebutted, and an exemption established. But proof that the defendant accounted for the stamp duties of the paper in question, is proof of publication. *Cook v. Ward*, 6 Bing. 409. The Court held, in an action for a libel contained in a newspaper, that the publication was proved by the production of a newspaper corresponding in title, &c. with that described in the affidavit lodged at the stamp office. *Mayne v. Fletcher*, 9 B. & C. 382. And the rule established at nisi prius in prosecutions for libel in a newspaper, *viz.* that after production of the stamp office affidavit, a paper corresponding with it in title, printer's and publisher's name, and place of publication, may be put in and read as published by the parties therein named, without other proof on this point, applies equally on motions for criminal informations. *The King v. Donnison and Another*, 4 B. & Ad. 698.

(p) Id. s. 14. And a printer whose name does not thus appear, cannot recover in an action for work and labour for

two copies of it, signed by the printer or publisher, must, within three days, be delivered to the commissioners of stamps, (who will pay for them), under a penalty of 20*l.* Such paper may, within two years after the publication, be produced at the expense of the party applying for it, as evidence in any court of justice. (*q*)

A newspaper is generally made up of paragraphs, either essays or observations of the editor, and advertisements. 2. Its contents.

In neither shape can any thing *blasphemous*, *seditions*, or *libellous*, (*r*) be given to the world. For the proprietor of a newspaper, although he does not interfere in conducting it, is answerable, criminally, as well as civilly, for the acts of his agents, by an insertion of offensive matter in his newspaper. (*s*) The whole publication is considered in law as written by him; for otherwise, he might give the form of letters, advertisements, &c., to his own observations, and thus elude his merited punishment. (*t*) In the case of *Rex v.* Paragraphs.

printing it. *Marchant v. Evans*, 2 B. Moore, 14. See *Stephens v. Robinson*, 2 C. & J. 209. S. C. 2 Tyr. 280.

(*q*) *Id.* s. 13 and 27. See *Smith v. Gillett*, 2 A. & E. 361.

(*r*) It is a libel to publish in a newspaper a story of an individual calculated to render him ludicrous, although he may have told the same story of himself. *Cook v. Ward*, 6 Bing. 409.

(*s*) *Rex v. Walter*, 3 Esp. N. P. C. 21. *The King v. E. Topham*, 4 T. R. 127.

(*t*) Where one newspaper copied a libellous paragraph from another, adding the word "fudge" at the close, Lord Lyndhurst held, in an action by the party libelled against the publisher of the paper in which the word "fudge" was added,

Woodfall, (u) (proprietor of the *News*), in which the jury found a verdict of guilty of printing and publishing *only*, Lord *Mansfield* observed, that when the act is in itself unlawful, (as in that case, being a libel on the King, signed *Junius*,) the proof of justification or excuse lies on the defendant; and in failure thereof, the law *implies a criminal intent* in the proprietor, although it clearly appear, that the offensive paragraph was not written by him. (v)

that it was for the jury to say whether the object was to vindicate the character of the party by the addition of the word, or whether it was only introduced for the purpose of creating an argument, in case proceedings should be afterwards taken. *Hunt v. Algar*, 6 C. & P. 245. But if a person sends a manuscript to the printer of a periodical publication, and does not restrain the printing and publishing of it, and he prints and publishes it in that publication, that person is considered as the publisher, and is liable to an action. *Burdett v. Cobbett*, 5 Dow. 301. In order to shew that a defendant had caused and procured a printed libel to be inserted in a newspaper; a reporter to a public newspaper proved that he had given a written statement to the editor of the newspaper, the contents of which had been communicated by the defendant, for the purpose of such publication, and that the newspaper then produced, was exactly the same, with the exception of one or two slight alterations, not affecting the sense. Abbott, Lord, C. J., held, that what the reporter published, in consequence of what passed with the defendant, might be considered as published by the defendant; but that the newspaper could not be read in evidence, without producing the written account delivered by the witness to the editor. *Adams v. Kelly*, 1 R. & M. 157.

(u) 5 Burr. 2667.

(v) See 1 Wm. 4, c. 73, as to the bond to be given to secure payment of damages on actions for a libel.

In the newspapers are given, by the sufferance of Parliament, the speeches that are made in the House of Lords and in the Commons, and also all copies of documents printed at the command of either of them, although they may contain reflections on individuals. (*w*) But if a member publish his speech in a newspaper, and it contain slanderous charges, an information for a libel may be supported against him, (*x*) as well as against the editor. Reports.

A correct statement of what passes in a court of justice (*y*) may be published in a newspaper, unless the Court intimate that it is their desire that no report should, *as yet*, be sent forth to the world, (*z*) for fear of prejudicing some of the

(*w*) *Rex v. Wright*, 8 T. R. 293. It was contended that, although the report of the House of Commons could not itself be considered as a libel, the editor not acting under the authority of the House might be indicted for publishing with a view to general circulation. See *Stockdale v. Hansard*, 9 Ad. & El. 1.

(*x*) *King v. Lord Abingdon*, 1 Esp. N. P. C. 226, and see *Rex v. Creevy*, 1 M. & S. 273, *Rex v. Bate*, Dougl. 387.

(*y*) *Curry v. Walter*, 1 Esp. N. P. C. 457, and 1 Bos. & Pul. 525, S. C., and see 5 Esp. N. P. C. 123, 2 Camb. 563.

(*z*) *Rex v. Wright*, 8 T. R. 293, and see *Rex v. Clement*, 4 Barn. & Ald. 218, post. Chap. VII. Lawrence, J.—The proceedings of courts of justice are daily published, some of which highly reflect on individuals; but I do not know that an information was ever granted against the publishers of them. Many of these proceedings contain no point of law; and are not published under the authority of the sanction of the Courts, but they are printed for the information of the public. Not many years ago, an action was brought in the

parties to the suit. And in an action for a libel, it must be proved that the account given in the newspaper, contains in substance precisely what was delivered in the Court. (a)

Court of Common Pleas by *Currie v. Waller*, proprietor of *The Times*, for publishing a libel in the paper of *The Times*, which supposed libel consisted in merely stating a speech made by a counsel in this Court on a motion for leave to file a criminal information against Mr. Currie. Lord Chief Justice Eyre, who tried the cause, ruled that this was not a libel, nor the subject of an action, it being a true account of what had passed in this Court; and in this opinion the Court of Common Pleas afterwards, on a motion for a new trial, all concurred, though some of the judges doubted whether or not the defendant could avail himself of that defence on the general issue. Though the publication of such proceedings may be to the disadvantage of the particular individual concerned, yet it is of vast importance to the public that the proceedings of courts of justice should be universally known. The general advantage to the country in having these proceedings made public more than counterbalances the inconveniences to the private persons whose conduct may be the subject of such proceedings. The same reasons also apply to the proceedings in parliament: it is of advantage to the public, and even to the legislative bodies, that true accounts of their proceedings should be generally circulated; and they would be deprived of that advantage, if no person could publish their proceedings without being punished as a libeller. Though, therefore, the defendant was not authorized by the House of Commons to publish the report in question; yet, as he only published a true copy of it, I am of opinion that the rule ought to be discharged. Rule discharged.

(a) In order to justify the publication of a report of a cause tried in a court of justice, the report must contain a fair and accurate statement of what took place at the trial. A mere statement by counsel in his opening to the jury, unsupported

An information will lie for publishing an invective statement, unconnected with argument, by evidence, is not a fair and impartial report. *Saunders v. Mills*, 3 M. & P. 520. 6 Bing. 213. A libel purported to be a report of what occurred before one of his Majesty's commissioners of inquiry respecting corporations, Mr. Justice Patteson held, that the defendant could not give evidence of the accuracy of the report as a matter of justification, but that he might give such evidence in mitigation of damages; and that if he did so, the plaintiff might give evidence in reply to shew the inaccuracy of the report. *Charlton v. Watton*, 6 C. & P. 385. It is doubtful whether the publication of the proceedings of a court of law, containing matter defamatory of a person who is neither a party to the suit, nor present at the time of inquiry, amounts to a libel or not. But an account published in a newspaper of proceedings in a court of law, containing matter redounding to the discredit of a person in his business of an attorney, is (whether true or false) rendered actionable as libellous by the paragraph being headed or introduced with the line "shameful conduct of an attorney:" and, consequently, pleas of justification, averring that the supposed libel was a true report of such proceedings, were therefore held to be bad. *Lewis v. Clement*, 3 B. & A. 702. S. C. (in error) 7 Moore, 200. 3 B. & B. 297. 1 Price's P. C. 181. It is no justification in an action for a libel in a newspaper, that the matter complained of is a true, fair, just, and correct report and account of proceedings which took place at a public police office, in the course of a preliminary inquiry, openly and publicly conducted before a justice upon a criminal charge against the plaintiff, although published with no scandalous, defamatory, unworthy, or unlawful motive, but merely as public news. It seems, however, that it is lawful to publish in a newspaper the result of what a justice may think fit to do, upon a matter of criminal charge previous to trial, if the publication contains no statement of the evidence, nor any comments upon the case. *Duncan v. Thwaites*, 5 D. & R. 447. 3 B. & C. 556. In an action for a libel on not guilty pleaded,

against a judge or jury, for any thing done in their respective capacities, under pretence of its being a report of legal proceedings. (b) And no person will be allowed to mix his own observations with what has passed in the Court. (c)

It seems, that editors of newspapers may abuse

it appeared that the libel (which was contained in a newspaper) purported to be an account of the trial of a former action, brought by the same plaintiff, for a libel against third parties; and after stating the libel in the original action, and the facts proved by the then defendants, and the summing up of the judge, stated that the jury found a verdict for the plaintiff, with 30*l.* damages. No evidence was given as to any such trial having in fact taken place, or whether the report was fair or not. The judge left it to the jury to say whether the report, although it contained some allegations injurious to the plaintiff on the face of it; and the jury having found for the defendant, the Court refused to grant a rule for a new trial. *Chalmers v. Payne*, 2 C., M. & R. 156. 1 Gale, 69.

(b) *Rex v. White*, 1 Campb. N. P. C. 359, n.; and see *Rex v. Watson*, 2 T. R. 199.

(c) *Carr v. Jones*, 3 Smith, 491, 503. S. C. under the names of *Styles v. Nokes*, in 7 East, 493, 503. Lord Ellenborough and Grose, J., observed. that it must not be taken for granted that the publication of every matter which passes in a court of justice, however truly represented, is, under all circumstances, and with whatever motive published, justifiable: but that doctrine must be taken with grains of allowance. It often happens, said Lord Ellenborough, that circumstances necessary for the sake of public justice to be disclosed by a witness in a judicial inquiry, are very distressing to the feelings of individuals on whom they reflect. And if such circumstances were afterwards wantonly published, I should hesitate to say that such unnecessary publication was not libellous, merely because the matter had been given in evidence of a court of justice.

each other with impunity: but it is actionable to declare that any newspaper is low in circulation, and to insinuate that advertisers should avoid it. (*d*)

The editor of a newspaper cannot, in answer to an indictment, say that the objectionable part is the *advertisement of another person*, and that he has no interest in it; and, therefore, that he ought not to be accountable for it, if he give up the real author. (*e*)

Advertisements.

But some advertisements which appear to reflect on individuals, may be inserted. Thus, an advertisement in a newspaper, whereby a person requested to be informed whether another had been guilty of a transaction which amounted

Libellous ones.

(*d*) *Heriot v. Stuart*, 1 Esp. N. P. C. 437; and see *Stuart v. Lovell*, 1 Stark. 93.

(*e*) *Lewis v. Walter*, 4 Barn. & Ald. 605. *Brown v. Croome*, 2 Stark. 297, 301. See *Lay v. Lawson*, 4 A. & E. 795. The declaration stated that defendant published an advertisement in a newspaper, stating that a *capias* had issued against plaintiff, and that it had been impracticable to take him, and offering a reward for such information to be given to the sheriff's officer as would enable him to take plaintiff; *inuendo*, that plaintiff was in indigent circumstances, incapable of paying the debt, and keeping out of the way to avoid being served with process. Plea, that a *capias* had been issued, indorsed for bail, and delivered to the sheriff; that defendant had kept out of the way to avoid being taken; that the sheriff's officer had been unable to take him; and that defendant had published the advertisement, at the request of the party suing out the writ, within four calendar months of the date of the writ, to enable the sheriff and his officer to arrest. The Court held it a justification.

to a felony, was held not to be a libel, because the advertiser, or his employer, was interested in the discovery; and the inquiry was not made with any intention of wounding his feelings. (*f*).

Illegal advertisements.

Many statutes have passed to restrain the publication of certain description of advertisements. Under stat. 9 Ann, c. 6, s. 5, and 10 Ann. c. 26, s. 109, a penalty of 100*l.* is imposed on all persons, (the latter particularly mentioning printers and publishers,) for advertising the keeping of any office for illegal *insurances on marriage*, or offices under pretence of *improving small sums*.

By several statutes, the publishing proposals *for gaming in the lotteries* had been restrained, under the penalty of 50*l.* for every offence. One Smith was held to have incurred the penalty, because he had *published* a proposal in the usual way in his newspaper. (*g*) Lord Kenyon wished it to

(*f*) *Delany v. Jones*, 4 Esp. N. P. C. 191. Ellenborough, C. J.—This paper is relied upon as necessarily carrying with it the imputation that the plaintiff was guilty of bigamy. You must be of opinion that it does carry such imputation before you can find a verdict for the plaintiff, as that meaning is necessary to make the paper a libel at all. The plaintiff's counsel contend that you are to take into your consideration only, whether the advertisement conveys a libellous charge against the plaintiff or not? I am of a different opinion: I conceive the law to be, that though that which is spoken or written may be injurious to the character of the party; yet, if done *bonâ fide*, as with a view of investigating a fact, in which the party making it is interested, it is not libellous. And see *Stockley v. Clement*, 4 Bing. 162, and 12 Moore, 376.

(*g*) *King v. Smith*, 4 T. R. 414.

be understood that the distributor of *hand bills* of a similar description would be equally criminal.

The last lottery was granted by 4 Geo. 4, c. 60: enlarged by 2 Wm. 4, c. 2. There is a penalty of 50*l.* incurred by those who publish advertisements of foreign or illegal lotteries. (i)

And any person publicly advertising a reward, holding out a promise that no question should be asked, for the *return of things stolen* or lost, &c. and any person printing or publishing such advertisement, will be liable respectively to forfeit the sum of 50*l.* (k)

For advertising, or printing an advertisement, for a public debate on any subject upon the Lord's day, a person subjects himself to a forfeiture of 50*l.* (l) The action to be brought within six months.

By the 5 & 6 Wm. 4, c. 65, s. 2, a penalty is inflicted on the printers and publishers of newspapers who publish any lecture delivered in any school, seminary, institution, or other place, without the consent or leave of the author of such lecture.

A newspaper is made *legal evidence* by several acts of parliament, for particular purposes, as of meetings to petition parliament, notice of moving for a private bill, &c. (m)

3. In what instances noticed by the law.

(i) 6 & 7 Wm. 4, c. 66.

(k) 25 Geo. 2, c. 36.

(l) 21 Geo. 3, c. 49, s. 5.

(m) 36 Geo. 3, c. 8, s. 1; and see *Boydell v. Drummond*, 2 Campb. N. P. C. 157; and *Lord Gallway v. Matthews*, 10 East, 264. *Jenkins v. Blizard*, 1 Stark. 418.

But the newspaper of which the law takes the most notice is one published by authority, the *London Gazette*: (*n*) in which it is necessary to insert all dissolutions of partnership; (*o*) for there is a strong presumption that every body reads the Gazette, but it is not always held to be sufficient, without notice to each customer, unless it can be shewn that it is probable that the defendant saw it. Although the instructions for the dissolution of a partnership cannot be evidence without an agreement stamp; (*p*) yet the Gazette may, for it is only a mere recital that the partnership has been dissolved, be read. (*q*)

Notices in
gazette.

By several acts of parliament a notice published in the *London Gazette* is deemed to be good and sufficient notice to all his Majesty's subjects. (*r*)

4. Stamp
duties.

A stamp duty is imposed on newspapers: and also on *advertisements*, whether they are published on the wrappers of periodical publications, and pamphlets, or in the gazette and newspapers.

Duty on
advertisements.

For every advertisement contained in or published on the wrapper of any periodical publica-

(*n*) First published in 1642. There is also a *Dublin Gazette* published by authority.

(*o*) *Graham and Another v. Thompson and Another*, Peak. Rep. 42. *Graham v. Hope*, Peak. Rep. 154; and see 1 Sid. Rep. 127. *Godfrey v. Turnbull and Another*, 1 Esp. Rep. 371. Peak. Rep. 155, n. S. C. *Leeson v. Holt*, 1 Stark. N. P. C. 186. *Newsome v. Coles*, 2 Campb. 617.

(*p*) *May v. Smith*, 1 Esp. N. P. C. 288.

(*q*) *Jenkins v. Blizard*, 1 Stark. N. P. C. 418.

(*r*) As to the publishers of, see 6 & 7 Wm. 4, c. 76, s. 12.

tion, or with any part or number of any book, or literary work published in parts or numbers, a duty of one shilling and sixpence is imposed.

A stamp duty was first put on a newspaper in the reign of Queen Anne. (s) It had been increased at different times by many acts of parliament, but is now reduced. (t) Duty on newspapers.

No persons but commissioners of stamps or their officer can *supply paper* stamped for print-

(s) 10 Ann. c. 19, s. 101.

(t) See Schedule A. 6 & 7 Wm. 4, c. 76, containing the duties imposed by this act on newspapers; (that is to say)

	£	s.	d.
For every sheet or other piece of paper whereon any newspaper shall be printed	0	0	1
And where such sheet or piece of paper shall contain on one side thereof a superficies, exclusive of the margin of the letter-press, exceeding one thousand five hundred and thirty inches, and not exceeding two thousand two hundred and ninety-five inches, the additional duty of	0	0	0½
And where the same shall contain on one side thereof a superficies, exclusive of the margin of the letter-press, exceeding two thousand two hundred and ninety-five inches, the additional duty of	0	0	1
Provided always, that any sheet or piece of paper containing on one side thereof a superficies, exclusive of the margin of the letter-press, not exceeding seven hundred and sixty-five inches, which shall be published with and as a supplement to any newspaper chargeable with any of the duties aforesaid, shall be chargeable only with the duty of	0	0	0½

Unstamped
newspapers.

ing newspapers, until the person so supplying has given security to deliver once in six weeks an account of the quantities and kind sold, under a penalty of 50*l.* (*u*) If the papers are not duly stamped, the publishers stand indebted to the king in the sum that would have accrued if they had been properly stamped. (*v*) There are several penalties respecting *unstamped* newspapers: 20*l.* for printing and publishing, (*w*) or for having possession of them, and 100*l.* for sending them out of the kingdom. (*y*) And whoever sells newspapers unstamped may, upon not paying the penalty, be sent to the House of Correction for any time not exceeding three months, and not less

EXEMPTIONS.

£ s. d.

Any paper called "Police Gazette, or Hue and Cry," published in Great Britain by authority of the Secretary of State, or in Ireland by the authority of the Lord Lieutenant.

Daily accounts or bills of goods imported and exported, or warrants or certificates for the delivery of goods, and the weekly bills of mortality, and also papers containing any lists of prices current, or of the state of the markets, or any account of the arrival, sailing, or other circumstances relating to merchant ships or vessels, or any other matter wholly of a commercial nature; provided such bills, lists, or accounts do not contain any other matter than what hath been usually comprised therein.

(*u*) 6 & 7 Wm. 4, c. 76, s. 15 and s. 25.

(*v*) Id. s. 16.

(*w*) Id. s. 17.

(*y*) Id. s. 18.

than one month, (z) and justices of peace may grant a warrant to search for them. (a)

III. PAMPHLETS.

A Pamphlet was defined to be a book consisting of one sheet, and not exceeding eight sheets in octavo, or any other lesser page; or not exceeding twelve sheets in quarto, or twenty sheets in folio. (b) Definition of a pamphlet.

(z) Id. s. 28.

(a) Id. s. 22.

(b) All the parts or numbers of any book or literary work, published in sizes answering to this description, were deemed pamphlets. 60 Geo. 3, c. 9, s. 27, repealed by 6 & 7 Wm. 4, c. 76. By 21st sect. of that act it is enacted, that one copy of every periodical literary work or paper (not being a newspaper) having published therewith any advertisements liable to stamp duty, which shall be published within the cities of *London, Edinburgh, or Dublin* respectively, or within twenty miles thereof respectively, shall, within the space of six days next after the publication thereof, be brought, together with all advertisements printed therein, or published or intended to be published therewith, to the head office for stamps in *Westminster, Edinburgh, or Dublin*, nearest to which such literary work or paper shall have been published, and the title thereof, and the christian name and surname of the printer and publisher thereof, with the number of advertisements contained therein or published therewith, and any stamp duty by law payable in respect of such advertisements, shall be registered in a book to be kept at such office, and the duty on such advertisements shall be there paid to the receiver general of stamps and taxes for the time being, or his deputy or clerk, or the proper authorized officer; and one printed copy of every such literary work which shall be published in any place in the United Kingdom shall, within the space of ten days next after the publication thereof, be brought, together with all such

An entry of every pamphlet must be made at the stamp office, to collect the duties on the advertisements which appear on the covers or wrappers.

IV. THE PROPERTY IN PERIODICAL PUBLICATIONS.

The property in periodical publications is similar to that which will be shewn to exist generally in a book. (c) There are some peculiarities which must be here noticed, arising from their contents, and the manner in which they are sold. The matter of one number seldom having any reference to other parts of the work, it would be an easy task to obtrude a spurious publication of the same nature upon the public.

advertisements, to the head distributor of stamps for the time being within the district in which such literary work or paper shall be published, and such distributor is hereby required forthwith to register the same in a book to be by him kept for that purpose, and the duty payable in respect of such advertisements shall be thereupon paid to such distributor; and if the duty which shall be by law payable in respect of any such advertisements as aforesaid shall not be duly paid within the respective times and in the manner hereinbefore limited and appointed for that purpose, the printer and publisher of such literary work or paper, and every other person concerned in the printing or publishing thereof, and the publisher of any such advertisements, shall respectively forfeit the sum of twenty pounds for every such offence; and in any action, information, or other proceeding for the recovery of such penalty, or for the recovery of the duty on any such advertisements, proof of the payment of the said duty shall lie upon the defendant.

(c) Post, Chap. VII.

Hence, although generally two books may bear the same *title*, yet there is a property in the name given to a periodical publication. It has been decided that the title, form, and mode of publication of a *magazine* (*d*) cannot be imitated in such a

1. Property in review.

(*d*) *Hogg v. Kirby*, 8 Ves. 215. And see *Sedon v. Serrate*, cited 2 Ves. & Beam. 220. *Hogg* published a work under the title of the "Wonderful Magazine," by William Granger, Esq., a fictitious name. *Kirby* agreed to sell it. After five numbers had appeared, *Kirby* published a work under a similar title, described as the *new series improved*. In *Kirby's* first number was contained an index to the contents of the five numbers already published. One article, not finished in the fifth number, was continued in *Kirby's*, by commencing with the word at the bottom of the last page. Eldon, C.—In this case, protesting against the argument that a man is not at liberty to do any thing which can affect the sale of another work of this kind, and that because the sale is affected, therefore there is an inquiry; (for if there is a fair competition by another original work really new, be the loss what it may, there is no damage or injury.) I shall state the question to be, not whether this work is the same, but in a question between these parties whether the defendant has not represented it to be the same, and whether the injury to the plaintiff is not as great. And the loss accruing ought not to be regarded in equity upon the same principles between them, as it was in fact the same work. Upon the point whether the work was in fact meant to be represented to the public as the same, I do not say, that is not a question for a jury. But I must act upon the inference from the circumstances; and it is impossible not to say, till this is better explained; an intention does appear both upon the transaction as to the fifth number and the other circumstances; in some degree upon the appearance of the outside, in a great degree upon the first page, the index, and the promised contents, to state this as a

manner as would necessarily mislead the public, and induce them to purchase the latter work instead of the continuing parts of the former one.

It is, however, lawful for any person to publish a magazine under a *similar* though not the *same* title, and of the like nature, if the latter be *distinctly different* from the former, and nothing has been done to injure the sale of the former work. (e)

Communica-
tions.

The *communications from correspondents* to the editors or proprietors of periodical publications are of course the property of the person to whom continuation of the former work, in a new series indeed. I am not here to speculate upon the probable consequences of such conduct; for I have the actual consequences as far as fair reasoning can determine, that out of 2,000 purchasers, 1,800 have bought this, a part of the old work. The point whether he, who carries his work into the world as that of another person, shall not as between them be considered as publishing that work, if the consequences are the same, is *new*; and therefore fit to be discussed elsewhere as well as here. I must incur the hazard of occasioning finally some injurious consequence to one party or the other. The proper course will be to alter the terms of this injunction so as to make it clear, that is, to operate upon nothing but the publication handed out to the world as the continuation of the plaintiff's work, and to direct that as to these numbers that are handed out as such continuation the plaintiff shall bring an action, the defendant to plead without delay, that it may be tried with all due speed; then they who apply to dissolve the injunction shall imply that reviews, magazines, and other works of this species may not be multiplied, and, therefore, shall alter the injunction myself.

(e) 8 Ves. 222, 3.