[25*th February*, 1842.]

JAMES BROWN of Eskmills, Appellant.

ALEX. ANNANDALE and SON, at Polton, Respondents.

Patent. — Use of an invention in England previous to the grant of a Scotch patent in regard to the same invention, voids the patent.

IN 1836, Brown obtained a patent for Scotland for a better and more perfect application of a vacuum under the endless web of paper-making machines. The patent recited, that Brown, by his petition, represented, "se invenisse aut excogitavisse in "vulgari, a certain improvement in the making of paper. "Quam inventionem haud unquam antehac factitatam aut usi- "tatam fuisse per ullum aliam personam aut personas quascunque "intra haec regna ut intellegit et credit," and was made under a proviso that it should be void if "dictam inventionem quoad "publicam ejus in illa parte regni nostri uniti Scotia vocata "usum et exercitium non esse novam inventionem vel a dicto "Jacobo Brown ut praedicitur non esse inventam," and another proviso, that the patent should not give any privilege as to any thing, "quod prius ab ullis subditis nostris quibuscunque ex- "cogitatum aut inventum publiceque in praedicta regni nostri "uniti parte Scotia vacata factitatum vel exercitatum fuerit "quibus simile literae patentes pro solo usu exercitio et beneficio "ejusdem antea concessæ fuerint." The patent farther contained a declaration, that it should be construed in the manner most favourable for the grantee, "tam intra omnes curias nos- "tras quam alibi et ab omnibus et singulis offiicariis," and "in

BROWN *v.* ANNANDALE & SON. — 25th Feb. 1842.

" ea regni nostri uniti parte Scotia vocata et inter omnes et " singulos subditos nostros hæredum et successorum nostrorum " quoscunque et ubicunque."

Brown raised a suspension and interdict against Annandale and Son, and subsequently brought an action of damages against them for infringement of his patent. To this action Annandale and Son pleaded, among other things, that the invention was not new, but, on the contrary, was known and publicly used in England and Scotland, prior to the date of the patent. The action went to trial upon the following, among other issues, " Whether " at the paper-mill works of the defenders, subsequent to the " date of the letters patent, and the said specification, the de- " fenders, without the consent of the pursuer, wrongfully, and " in contravention of the said letters patent, used in their said " works, machinery in imitation of, and substantially the same " with, the machinery described in the said specification, to the " loss," &c.? And, " Whether the said machinery described in " the said specification is not the original invention of the " pursuer ?"

At the trial of these issues the defenders tendered the evidence of witnesses to shew, " that the invention specified by the pursuer " had been publicly used in England before the date of the " patent." The pursuer objected that the previous use of the invention " in England was not a ground for invalidating the " pursuer's patent in Scotland." The Judge repelled the objection. The pursuer excepted to the Judge's opinion, and consented to a verdict for the defenders, " subject to exception to the opinion of the Judge," and a verdict was found accordingly. Subsequently the Court " disallowed the bill of exceptions; in " the suspension and interdict found the letters orderly pro- " ceeded; and in the action of damages assoilzied the de- " fenders."

Brown appealed from this interlocutor.

The Attorney General, and *Mr Andrews*, for the appellant. — Previous to the union of the two kingdoms, the Crown, by its prerogative, enjoyed the power of granting patents for inventions, which were then undoubtedly limited in every matter to Scotland alone. That power it enjoyed at common law, and independently of statute, and the power was not altered or taken away either by the union or by subsequent statute. The right of the Crown in England depends on the common law prerogative, and not on the 6th sect. of 21st Ja. I., cap. 3; that section only saved the right which previously existed from the effect of that statute. At all events, the 21st Ja. I. was not extended to Scotland, and the right of the Crown in that part of the kingdom depends now, as it did previous to the union, upon the royal prerogative. Accordingly, the operation of the patent is limited to Scotland, and is without any virtue on the south side of the Tweed; were it otherwise, the force of the patent would prevail in either part of the kingdom.

The only user, then, which can void the patent, is a user within that part of the kingdom to which the patent applies. If a party import an invention from beyond seas, he may, in his petition, state himself to be the inventor, or he may state that he has received a communication from abroad, and this will amount to his being the inventor, and be sufficient to authorize the Attorney General to make out the bill for the patent, otherwise the party would not be within the exception of the statute, Edgebury *v.* Stevens, 2 Salk. 477. England is a foreign country in regard to this matter, as it is as to many others.

[*Lord Chancellor.* — How do you get over "*haec regna?*"]

These words have reference to the words in the subsequent part of the patent, "intra eam partem Scotiam vocatam." And if the proviso should have been larger than it is, it may be questioned whether the patent is good, and if it is not, then all the existing patents are bad, for this is the usual form. But the

proviso is, that the patent shall be defeasible, if the invention is not new in so far as relates to its use in Scotland. There is no mention of England.

[*Lord Chancellor.* — If the patent be more extensive than it ought to be, the law will put a limit upon it.]

Throw out the proviso, and the question is, Whether the Crown has power to grant a patent for Scotland of what is known in England.

[*Lord Chancellor.* — The question is as to the limitation of the power of the Crown by the statute.]

The statute was declaratory only, and previous to it the Crown could make all reasonable grants; no doubt, in Roebuck and Garbutt *v.* Stirling and Sons, 5 *Bro. Supp.* 522; 1 *Hailes*, 566, the Court below held, that previous user in England vitiated a Scotch patent; but that decision was taken to appeal, and the judgment of the House affirmed the decision, "for other reasons "as well as the reason specified therein."

[*Lord Chancellor.* — That was a decision on the subject matter, for it included the reason in the interlocutor.

Lord Campbell. — Were the terms of the patent there the same as in this case?]

It appears so. But the respondents in that case did not put it upon user in England alone, as in this case.

[*Lord Brougham.* — Lord Mansfield assisted the House in the decision of that case, and must have come down on purpose, as he did not attend in the House either on the day before or after.]

Neither did they insist upon the user in England at all.

[*Lord Chancellor.* — The second reason of appeal raised the point distinctly.]

There was no one reason assigned which was directed to this point alone. In that second reason it is stated, that the invention was not only brought from England, but had been long in use in Scotland.

[*Lord Brougham.* — Whatever the Counsel might put this

case upon; this House put its judgment upon the individual point.]

That opinion will not, however, be binding upon the House, unless it was necessary for the decision of the case before it.

[*Lord Chancellor.* — The opinion is given, not as that of any noble lord, but is part of the judgment.]

It is quite clear, however, that in that case there had been a public user in Scotland, and your Lordships will observe, that no costs were given, probably because the House felt it necessary to adopt other reasons than those used in the Court below.

[*Lord Chancellor.* — A patent for the colonies, as well as for England, is in the same form as the ordinary patent for England alone. But if there had been a previous user in the colonies the patent would be void, because the colonies are part of the realm.]

They are so for some purposes, not for all. But sometimes a patent has been granted for the colonies separate from one for England, in cases where there must have been a user in England previous to the patent for the colonies. Kyan's patent, for instance, had been in use for some years in England before a patent was grated for the colonies.

[*Lord Chancellor.* — If at the union there had not been a great seal for Scotland the English patent would have embraced Scotland.]

If the Crown had the power, as undoubtedly it had previous to the union, to grant patents for inventions, and for inventions imported from England, there is nothing in the Articles of Union infringing on that right. The 6th Article refers to trade, and the 18th Article would rather save this right than otherwise.

[*Lord Chancellor.* — I don't think so much depends on those clauses as on the whole being made one realm.]

Then, under the 24th Article, which declares, that that seal shall be used for all instruments "which concern the whole king-"dom," the Great Seal of the United Kingdoms would be ufficient to make a patent for both parts of the kingdom, but

the subsequent part of the same article declares, that there shall be a Great Seal in Scotland, for all grants "relating to private rights "which have usually passed the Great Seal of Scotland," and which "only concern grants and private rights within that king-"dom." Patents, before the union, were sealed with the Great Seal of Scotland, and, since the union, they have been passed under the seal substituted for the Great Seal, by this article.

[*Lord Chancellor.* — That only affects the form under which the patent is to be made. It don't follow that this puts any restriction on the previous words "this realm" in the 22d article.]

In this matter the word realm can mean only England or Scotland, for if the two kingdoms were one as to patents, the Crown could not, under the 6th article, grant a patent for England alone, leaving the use of the invention open in Scotland, or *vice versa*, for in such case both parts of the kingdom would not be under "the same prohibitions, restrictions," &c.

[*Lord Brougham.* — There would not be any thing to hinder the Crown to grant an English patent for the counties south of the Tweed, but it could not do so if there had been a previous user in the counties to the north of that river.]

That is because of the 6th sect. of the 21st Ja. I., but the Articles of Union make no reference to that statute to extend it to Scotland, and for many purposes, such as jurisdiction, the two countries are quite distinct without any question.

The King *v.* Arkwright, *Davies' Cases*, has been relied on in the case for the respondents; but there the making was in England, though the party for whom the article was made was in Scotland; that plainly was sufficient to void the English patent. Clarke and Laycock is also founded upon on the strength of expressions used in regard to it by Lord Gardenstone, in Garbutt and Roebuck *v.* Stirling and Son.

[*Lord Chancellor.* — Clark *v.* Laycock was tried before Lord Mansfield, and he assisted this House in the decision of Roebuck's case.]

There is no English report of Clark *v.* Laycock.

[*Lord Chancellor.* — Respondent should shew where the statement he has put into Lord Gardenston's mouth comes from.

Mr Godson. — We took it from Lord Gardenston's judgment.

Lord Chancellor. — We have his judgment, and it does not contain any of the facts stated.]

Mr Kelly and Mr Godson appeared for the respondents, but they were not called upon to address the House.

Lord Brougham. — The case of Roebuck *v.* Stirling appears to me perfectly to decide this case. The Court of Session had dismissed the suit, because it appeared that the process in question was known to, and practised by, different persons in England. This House adjudged, "That the interlocutors complained of be "affirmed for other reasons, as well as the reasons specified "therein." That implies, that they concurred in the reasons thus given on the face of the interlocutor. What other reasons there may have been for the affirmance may be a question, but that reason was put forward by the Court below, as the ground of its decision, and being so put forward, was, at all events, one of the reasons for the affirmance of the judgment, with other reasons not stated by the House.

Lord Campbell. — There is an express decision, applying, in its terms, to the present, just as much as if other reasons had not been introduced into the judgment of the House. That being an express decision upon the point in question, unless it is shewn, that the House was under some great mistake at the time, it must be considered as binding. I entirely concur in the decision. I think it is perfectly right, and if it had been *res integra*, I should have so decided, but especially, after that decision, I perfectly concur in the affirmance of the judgment of the Court below. My opinion is, that the law was quite correctly laid down by this House in the year 1744.

BROWN *v.* ANNANDALE & SON.—25th Feb. 1842.

Lord Brougham. — When I stated, that I proceeded on the decision of this House in Roebuck *v.* Stirling, in the year 1744, I intended to have added, that I should have so decided without that precedent. I entirely agree with my noble and learned friend, that if this had been *res integra*, I should have so decided it.

Lord Chancellor. — Mr Andrews has stated, that several opinions have been taken, in Scotland, upon this subject.

Mr Andrews. —No, my Lord, in England.

Lord Chancellor. — When the case came before one Judge, he decided it in the way in which we think he ought to have decided it. Then it afterwards went before the full Court, and they were unanimous in their judgment, corresponding with the previous decision of this House: and, with respect to the previous decision of this House, we have searched the Journal, and we find, that the Lord Chancellor was present, and not only the Lord Chancellor, but that Lord Mansfield was present.

Mr Kelly. — My Lords, I am instructed, with my learned friend, Mr Godson, to appear in support of the judgment of the Court below. Your Lordships proposing to affirm that judgment without hearing the respondent's counsel, I trust, I may be permitted to ask, that it may be affirmed with costs, being directly in the face of a judgment of this House.

Mr Andrews. — I trust your Lordships will consider, that there was no argument allowed in the Court below.

Lord Chancellor. — I think it must be affirmed with costs.

Ordered and Adjudged, That the petition and appeal be dismissed this House, and that the interlocutors therein complained of be affirmed with costs.

G. and T. W. WEBSTER — SHEARMAN and EVANS, Agents.