

C A S E S
DECIDED IN THE HOUSE OF LORDS,
ON APPEAL FROM THE
COURTS OF SCOTLAND.

1843.

[Heard 20th February. — Judgment 6th March, 1843.]

The HOUSEHILL COAL and IRON COMPANY, *Appellants*.

JAMES BEAUMONT NEILSON, and OTHERS, *Respondents*.

Patent. — User of the subject of an invention, though discontinued for many years prior to the date of a patent for the invention, will invalidate the patent.

Process. — *Proof.* — Where particular instances of user of the subject of an invention were averred, “in particular, among others,” held that the proof must be confined to the instances particularly averred.

Process. — *Jury Trial.* — If, on the hearing of Exceptions, the Court is satisfied that there was a misdirection, and that the jury may have been misled by it, the Court has no discretion on a view of the verdict compared with the evidence, but must allow the Exception.

THE respondents were proprietors of a patent for an invention, which consisted in the heating of air in a vessel between the bellows used for blasting furnaces, and the mouth of the furnace, in order to produce more intense heat.

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In the autumn of 1840, the respondents complained against the appellants, by bill of suspension and interdict, that they were using the respondents' invention, and they at the same time brought an action against the appellants for payment of such damage as they might be able to establish had been incurred by such user. The note of suspension was passed, but interdict was refused, the appellants finding security to pay the damage that might be proved, and thereafter the suspension and interdict, and the action of damages, were conjoined.

In the course of preparing the record in the conjoined actions, the appellants averred, that the respondents' patent was void and ineffectual; among other reasons, — “*3d*, Because the intro-
 “ duction and application of heated air into fires, forges, and
 “ furnaces, to produce a more intense heat and combustion for
 “ various purposes, was known and publicly practised prior to
 “ the date of Mr Neilson's patent. More particularly, heated
 “ air was introduced into the process of creating combustion,
 “ and consuming smoke, by the invention of Mr George Chap-
 “ man of Whitby, in 1825, as well as in other processes.

“*4th*, Because the application of atmospheric air, heated be-
 “ yond its ordinary temperature, to promote combustion in
 “ smelting-furnaces, fires, or forges, or in the smelting of ores
 “ and metals, which, without any limitation, is the invention
 “ now claimed by Mr Neilson as his, was known and practised
 “ prior to the date of his patent, both in England and Scotland.
 “ In particular, it was, among others, practised by the late Mr
 “ Dawson of the Low Moor Iron Works in Yorkshire, by Mr
 “ Wilkinson, of the Bradley Iron Works in Staffordshire, and
 “ also at the Horseley Iron Works in that county. See also
 “ Nicholson's Journal of Natural Philosophy, Chemistry, and
 “ the Arts, for April, 1798, in which there is published a
 “ Treatise by Mr James Sadler, chemist to the Admiralty,
 “ entitled, ‘Description of an Apparatus for disengaging Oxygen

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“ ‘ Gas, and applying it to the best advantage; to which are
 “ ‘ added, Observations on the Blowpipe by William Nicholson.’
 “ Also the patent obtained by the Reverend Robert Stirling,
 “ one of the ministers of Kilmarnock, in December, 1816, for his
 “ invention ‘ for diminishing the consumption of fuel,’ &c., and
 “ relative specifications; and the patent obtained on 6th May,
 “ 1828, by Mr Botfield of Hopton Court, in the county of
 “ Salop, for his invention ‘ for certain improvements in making
 “ ‘ of iron, or in the method or methods of smelting or making
 “ ‘ of iron,’ and relative specification. Farther, in 1825, or
 “ about that time, Mr Jeffries, of the Grove Foundry, South-
 “ wark, invented a mode or modes of applying heated air in its
 “ transit in pipes, (two or more,) placed in a charcoal fire, for
 “ the purpose of producing a more intense degree of heat in the
 “ smelting of iron-ores or other minerals, and he practised, and
 “ has continued to practise his said invention, and improvements
 “ thereon, either by himself or the company carrying on busi-
 “ ness at the Grove Foundry in Southwark, of which he was a
 “ partner.”

After the record had been adjusted the cause was sent to trial by jury upon the following issues, — “ Whether, in the course
 “ of the year 1840, and during the currency of the said letters-
 “ patent, the defenders did, in or at their iron-works at House-
 “ hill, by themselves, or others, wrongfully, and in contravention
 “ of the privileges conferred by the said letters-patent, use
 “ machinery or apparatus substantially the same with the
 “ machinery or apparatus described in said specification, and to
 “ the effect set forth in the said letters-patent and specifica-
 “ tion, to the loss, injury, and damage of the pursuers? Or,
 “ 1. Whether the invention, as described in the said letters-
 “ patent and specification, is not the original invention of the
 “ pursuer, the said James Beaumont Neilson?
 “ 2. Whether the description contained in the said specifica-

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“ tion, is not such as to enable workmen of ordinary skill to
 “ make machinery or apparatus capable of producing the effect
 “ set forth in the said letters-patent and specification ?

“ 3. Whether machinery or apparatus, constructed according
 “ to the description in the said letters-patent and specification,
 “ is not practically useful for the purposes set forth in the said
 “ letters-patent ?”

After the record and the issues had been adjusted, but before the record was closed, the appellants lodged a Note of Objections, in anticipation of any objection that might be raised upon the 5th section of the 5 and 6 Will. IV. c. 83, which is expressed in these terms : — “ And be it enacted, That in any action brought
 “ against any person for infringing any letters-patent, the de-
 “ fendant, 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 objec-
 “ tions 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.” In this note the appellants stated, that the invention of the respondents had been publicly used, both in England and Scotland, before the granting of the letters-patent ; and “ in particular, the application of
 “ atmospheric air beyond the ordinary degree of temperature
 “ was known and publicly practised before the date of the said
 “ letters-patent at Irvine, Greenock, Glasgow, and at various
 “ other places in the counties of Ayr, Renfrew, and Lanark.”

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The jury returned a verdict for the respondents on all the issues. The case then came before the Court upon a motion for new trial, and upon thirteen exceptions taken by the appellants to the rejection of evidence, and the charge of the Judge, (the *Lord Justice Clerk*.)

The motion for a new trial was refused, because it was not insisted in, and the whole exceptions were disallowed, after argument.

The appeal was against an interlocutor, (20th July, 1842,) disallowing the exceptions.

At the hearing of the appeal only two of the thirteen exceptions were maintained, namely, the first and eleventh. The first regarded the rejection of evidence; the eleventh was to the charge of the Judge.

The first exception arose under these circumstances, — the appellants tendered a witness to prove use in Irvine, about twenty years previously, at an anchor smith's forge, of a pipe heated between handbellows and the forge, for the purpose of producing more intense heat in the forge. The respondents objected to the evidence, and the Judge sustained the objection by a deliverance in these terms, — “ 1. That a paper of objections, lodged in process, with notice thereof before the record was closed, cannot supply defects in the averments in the record, on which parties agreed to close the record, in terms of the statute, supposing that in such paper of objections there had been any such averment, as in this case would be necessary in the record; 2. On the ground that no proper notice is given on the record of the proposed line of inquiry generally, and no notice whatever of prior use of the invention at a smith's at Irvine, by the application of hot-blast to a smith's fire; and, 3. On the ground, that in an inquiry as to the anticipation and prior use of an invention, by instances of the

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“ practices of individuals, going back to twenty years, it is essen-
 “ tially necessary for the interests of the patentees, and ends of
 “ justice, that the record should contain such information as
 “ shall enable the patentee to be able to meet by inquiry these
 “ cases, and to investigate the character, purposes, and objects
 “ of the practices to be proved against him, in which the prior
 “ use of his discovery and invention is said to be found.

“ Same objection held to apply to any other evidence of
 “ same character.” The first exception was to this delive-
 rance.

The 11th exception arose thus: In the course of the evidence the appellants proved, that forty years before, the proprietor of smelting works at Bradley, in England, had interposed and heated a cylinder between the furnace and the bellows, which had made the iron run “like milk;” but that as the iron would not do for malleable iron, because it was “so gray or rich,” though it might have done for small castings, the proprietors had discontinued the use of the cylinder after an experience of six months.

The charge which related to this, and which gave rise to the 11th exception, was in these terms, — “The next direction I
 “ have to give you relates to the counter-issues. I must give
 “ you two directions in point of law on this issue, —

“ 1. It is not sufficient to shew that others, in experiments or
 “ incidental trials, had hit upon the same idea, not having made
 “ public the principle and the application of it to the same pro-
 “ cesses.

“ Even if the principle had been a known principle, still, if it
 “ is for the first time applied by mechanical contrivance and
 “ apparatus to certain processes in which it had not been pre-
 “ viously used as an agent, the patent would be good; and still
 “ more when the principle and the mode of carrying it into a
 “ practical beneficial result are claimed. I have to repeat, that

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“ the originality of the invention is not destroyed by proof that,
“ in the history of the arts and trades of this country, some
“ one or two, or even more persons, may have apparently had
“ some glimpse of the same conception in occasional and insu-
“ lated experiments, which were not prosecuted nor made
“ known, and from which, so far as the rest of the world were
“ concerned, no result or change followed on former practice.

“ The second direction in point of law which I have to give
“ you on this issue, respects what is prior use, so as to destroy
“ the invention.

“ Now, this is well expressed in the words of the patent in
“ this and other cases. This is what the defender must prove,
“ — that it was not new, in respect of the public use and
“ exercise thereof in this kingdom. These emphatic and plain
“ words hardly require explanation — they convey the meaning
“ to you in a way that it is impossible to mistake; the question
“ in each case is a matter of fact for the Jury, but this is, in
“ point of law, the sort and kind of use, the existence of which
“ a Jury must find to be proved, in order to warrant them to
“ find against the patentee. I may state to you that great uti-
“ lity is one important element in the question of novelty. For
“ if the process is of great, manifest, striking, and immediate
“ utility, that is of the utmost importance to the point. — Could
“ this have been previously in public use and exercise, without
“ clear and abundant proof? The cases referred to at the bar
“ have settled that the use must be public use; that the existence
“ and trial of regular machines of the very same sort, if aban-
“ doned, if not used and introduced into practice, is not public
“ use and exercise thereof in the kingdom.

“ Again, in the case of the suspension principle for wheels, it
“ was well stated by Mr Justice Pattison to the Jury who tried
“ that case, — ‘ If, on the whole of this evidence, either on the
“ ‘ one side or the other, it appeared that this wheel, constructed

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“ ‘ by Mr Strutt’s order in 1814, was a wheel on the same
 “ ‘ principles, and in substance the same wheel, as the other for
 “ ‘ which the plaintiff has taken out his patent, and that it was
 “ ‘ used openly and in public, so that every body might see it,
 “ ‘ and had continued to use the same thing up to the time of
 “ ‘ taking out the patent, undoubtedly then that would be a
 “ ‘ ground to say that the plaintiff’s invention is not new, and
 “ ‘ if it is not new, of course his patent is bad, and he cannot
 “ ‘ recover in this action ; but if, on the other hand, you are of
 “ ‘ opinion that Mr Strutt’s is an experiment, and that he found
 “ ‘ it did not answer, and ceased to use it altogether, and aban-
 “ ‘ doned it as useless, and nobody else followed it up, and that
 “ ‘ the plaintiff’s invention, which came afterwards, was his own
 “ ‘ invention, and remedied the defect, (if I may so say,)
 “ ‘ although he knew nothing of Mr Strutt’s wheel, he remedied
 “ ‘ the defects of Mr Strutt’s wheel, then there is no reason for
 “ ‘ saying the plaintiff’s patent is not good.’ Again, I close
 “ what I have to say to you here, by the well considered lan-
 “ guage of Chief Justice Tindal, whose opinion I am always
 “ glad to quote, as he unites the character of the accomplished
 “ scholar with the most profound knowledge of law. ‘ It will be
 “ ‘ for the Jury to say whether the invention was or was not in
 “ ‘ public use and operation at the time the patent was granted.
 “ ‘ There are certain limits to this question. A man may make
 “ ‘ experiments in his own closet ; and if he never communicates
 “ ‘ these experiments to the world, and lays them by, and ano-
 “ ‘ ther person has made the same experiments, and being
 “ ‘ satisfied, takes a patent, it would be no answer to say that
 “ ‘ another person had made the same experiments. There
 “ ‘ may be several rivals starting at the same time ; the first
 “ ‘ who comes and takes a patent, it not being generally known
 “ ‘ to the public — that man has a right to clothe himself with
 “ ‘ the authority of the patent, and enjoys the benefit of it, if

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“ ‘ the evidence, when properly considered, classes itself under
 “ ‘ the description of experiment only, that would be no answer.
 “ ‘ On the other hand, the use of an article might be so general
 “ ‘ as to be almost universal ; then you can hardly suppose any-
 “ ‘ body would take a patent. Between these two limits most
 “ ‘ cases will arrange themselves, and it must be for the Jury to
 “ ‘ say whether the evidence convinces their understanding, that
 “ ‘ the subject of the patent was in public use and operation at
 “ ‘ the time when the patent was granted.’

“ You will observe that it is settled, that the trials founded on
 “ as proofs of prior use, —

“ 1. Must have been public.

“ 2. Must have been continued, not abandoned.

“ 3. Must have continued to the time when the patent was
 “ granted, — I don’t say to the very exact period, but it must
 “ have been known and used as a useful thing at the time.

“ The abandonment of trials, as not successful or satisfactory,
 “ is a decided proof that the invention was not turned to account
 “ for public utility, and was not in public use and operation.”

The appellants excepted to this charge, “ In so far as the
 “ said Lord Justice Clerk directed the Jury, in point of law, that
 “ the proof of prior use of the patent invention must not only be

“ (1.) Public, but

“ (2.) Must have been continued, not abandoned ; and

“ (3.) Must have continued to the time when the patent was
 “ granted, — not to the very exact period, but that it must have
 “ been known and used as a useful thing at the time.”

The Attorney-General, the Lord Advocate, and Mr Kelly, for the appellants. — Ist Exception. The ground upon which the evidence, to which this exception applies, was rejected, was, that sufficient notice had not been given to the respondents upon the record.

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[*Lord Brougham*, to respondents. — Your ground is, I suppose, that although there was a general averment of user made, there ought to have been a specification of persons, time, and place in the appellant's statement, in order to put you on your guard ?

Mr Rutherford. — Precisely so.]

That was not the ground taken in the Court below ; there the objection was, that particular instances of user having been averred, the party was misled to think that these alone would be proved. If the general averment with which the statement set out was sufficient, the addition of particular instances could not destroy its efficacy ; that was only so much favour to the party. That the general averment was sufficient, is shewn by the terms of the 8th section of the 6 Geo. IV. cap. 120, and the 105th section of the Act of Sederunt, 11th July, 1828, and the application these received in *Leys, Masson, & Co.*, 5 *W. and S.* 384 ; *Wilson v. Beveridge*, 10 *S. and D.* 110 ; *Rutherford v. Carruthers*, 1 *D. B. and M. (N. S.)* 1109 ; and in *Dalzell v. Queensberry Executors*, 4 *Murray*, 14, where the Judge said, — “ It cannot be required to aver every fact that is to prove or “ make out the case.” In *M'Donald v. M'Kay*, the Court reprehended the statement of every fact and circumstance to be proved, as this House did in *Gillon v. M'Kinlay*, 5 *W. and Sh.* 472.

There is no special rule differing cases on questions of patents ; that is shewn by *Russell v. Crichton*, 16 *S. and D.* 1157, where the averment was quite general of use “ in Glasgow and Edinburgh, or elsewhere in Scotland ;” there the issue given was, whether the defender did, “ at Glasgow, &c.” and no restriction was put upon the evidence attempted to be led.

The averment of the particular instances could not mislead the party, because it is expressly qualified by the words “ in particular, among others,” thereby giving warning that there were

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other instances to be proved ; and moreover, the general averment was of user “in England and Scotland,” while the particular instances were confined to England alone, shewing, that, as to Scotland, the party meant to rely on the general averment.

If it be held that the 5th section of 5 and 6 Will. IV. c. 83, applies to Scotland, then the note of objections required by that section was given, and the party had in it notice of the particular instance in regard to which the evidence rejected was tendered.

[*Lord Chancellor.* — I should doubt if that clause applied to Scotland.]

The statute in its other clauses certainly embraces both ends of the kingdom, but if this section does not apply, the general averment of user was sufficient.

[*Lord Chancellor.* — I was much struck with the case of *Russell v. Crichton*, but on looking at the report, I don't find the question raised.]

No observation was made on the matter, but the issue was allowed generally as to Edinburgh or Glasgow.

XIth Exception. With regard to this Exception, the argument at the bar on both sides was directed to ascertain the meaning in which the Judge used the expressions which gave rise to the Exception. For assuming them not to refer to experiment, but to trial, in the sense of use, discontinued, of a completed invention, the counsel for the Respondents did not attempt to maintain the Charge. As the argument on this Exception amounted to no more than a critical disquisition on the words of the Charge, it does not require farther notice.

Mr Solicitor-General and Mr Rutherford, for the respondents. — Ist Exception. The only issue under which the evidence tendered, and to which this Exception refers, could have been tendered, is the first, being a general issue. Under such an issue it was not competent to offer evidence as to facts of prior user,

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without disclosing them on the record, 6th and 8th section, 6 Geo. IV. cap. 120.

The form of the general issue was adopted as the more convenient; but, with the view to prevent surprise and frequent motions for new trials, the statute required that the case to be proved should be averred on the record. A distinction is taken in the statute between the grounds of action and defence, and the facts and circumstances on which they are to be rested. And it is the duty of the Judge, when evidence is tendered, to refer to the record to see whether the evidence comes within the case there made.

The issue would have been unobjectionable, no doubt, though the averment had been general; the only consequence would have been, that the party could not have led evidence at all. So here the issue was unobjectionable, and the party was entitled to lead evidence under it, because the averments were not general but special; but he was not entitled to lead evidence beyond the averments under the words “in particular, among other instances,” as shewing that those stated were not alone intended to be relied on:—this would go to create all the inconvenience which the statute, by requiring special averment, intended to remedy.

In *Wilson v. Beveridge*, the question being as to partnership, and what had occurred between the parties themselves, to have required a special statement of all the facts, would have been to require a statement of the evidence; but in *Gye v. Hallam*, 10 *S. and D.* 710, a new trial was allowed, because the pursuer, after specifying on the record various errors in account, had gone into evidence of many more, and thus taken the party by surprise. In *Leys, Masson, and Co.* 5 *W. and S.* 384, the attempt was to alter the issue, not to limit the evidence, and neither in *M'Donald v. M'Kay*, nor in *Gillon v. M'Kinlay*, was any question raised upon the issue. As to *Russell v. Crichton*,

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there was no question raised there as to the issue, but although the averment was as to use in Edinburgh and Glasgow, “ or “ elsewhere in Scotland,” these words were left out of the issue, which was confined to Glasgow alone.

Lord Advocate in reply. — The general issue is no doubt to be qualified by the record, but the party, in leading evidence under it, is only limited by not having made any averment at all on the subject attempted to be proved, or by having so limited his statement as necessarily to preclude evidence beyond it; but it was never intended in principle, nor has it been observed in practice, that the party is to state in detail every circumstance he is to lead in evidence. *Adams on Jury Trial*, p. 78. In *Gye v. Hallam*, the new trial was allowed, in order, not to exclude, but to admit, the evidence tendered.

LORD CHANCELLOR. — My Lords, the principal question in this case arises out of the 11th exception. The learned Judge stated to the jury what he considered to be sufficient evidence to support prior use so as to invalidate the patent. The learned Judge expressed himself in these terms; he says, “ You will “ observe that it is settled that the trials founded on as a proof “ of prior use must have been public, must have been continued, “ not abandoned, must have continued to the time when the patent “ was granted; I do not say to the very exact period, but it “ must have been known and used as a useful thing at the time.”

Now, my Lords, the first question that arises upon this charge is, what the learned Judge meant by the word “ trials.” The word “ trials,” as I understand it, does not in that passage import experiments going on for the purpose of concluding or perfecting the invention. But I understand the word “ trials” to have been used in a different sense. It could not have been used in the former sense, for this reason, that the distinction which the

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learned Judge draws, and draws with so much pains and so much care, could not have applied to that meaning of the term “ trials,” because, if they were mere trials and experiments in the progress of the invention, it was wholly immaterial whether they were continued, or whether they were abandoned. In neither case could they have been made use of as evidence of prior use, for the purpose of invalidating the patent.

It becomes necessary, therefore, from the context, to consider what it was that the learned Judge meant by the word “ trials;” and I think that sufficiently appears by a reference to the former passage, which former passage, indeed, is only separated from the passage in question by the two cases to which the learned Judge refers. He says, — “ The cases referred to at the bar
“ have settled that the use must be public use, that the existence
“ and trial of regular machines of the very same sort, if aban-
“ doned, if not used and introduced into practice, is not public
“ use and exercise thereof in the kingdom.” Then he goes on, after stating the two cases, thus, — You will observe that it is
“ settled, that the trials founded on as a proof of prior use must
“ have been continued, not abandoned, must have continued to
“ the time when the patent was granted.” He is therefore obviously speaking of the same trials to which he had before referred, namely, trials of regular machines of the very same sort. And he says, those trials of regular machines of the very same sort, if abandoned, will not be evidence of public use. And that he so meant is quite obvious also from the concluding part of the sentence, when he says, — “ But it must have been
“ known and used as a useful thing at the time.” What is the meaning of that? The invention must have been known and used as a useful thing at the time. So that I understand the proposition of the learned Judge to be this, that if the machine had been made, and had been put in trial, unless those trials had gone on, and the machine had been used up to the time of

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the granting of the letters-patent, it would not be evidence of prior use, so as to invalidate the letters-patent.

Now, I am obliged to say, with all deference to the learned Judge, and with all respect for the learned Judges of the Court of Session, that I think in that respect they are mistaken; and that if it is proved distinctly that a machine of the same kind was in existence, and was in public use, although the use was discontinued, still that is sufficient evidence in support of prior use, so as to invalidate the letters-patent. That is, if use or if trials had been made of the machine in the eye and in the presence of the public, it is not necessary that the use should come down to the time when the patent was granted.

Now, my Lords, it appears to me that the learned Judges in the Court below were misled by the two cases that were cited by the learned Judge who presided at the trial. There is an expression supposed to have been made use of by Mr Justice Pattison at a trial at *nisi prius*, upon which reliance was placed, reported, I think, in Mr Godson's book. Whether the learned Judge did really make use of this expression or not, I have no means of knowing. But afterwards, when that case came before the Court of Exchequer, and when reference was made to that passage in the summing up of the learned Judge to whom I have referred, Mr Baron Alderson, apparently with the assent of the rest of the Court, commented upon that observation, dissenting from the position, and expressed an opinion that that learned Judge, if he had so expressed himself, had expressed himself incorrectly in point of law.

Again, my Lords, in the other case which has been referred to, which is also a *nisi prius* case, at which the Chief Justice of the Common Pleas presided, similar expressions are imputed to him. But in a subsequent case of *Cornish v. Keene*, which came before the Court of Common Pleas, in which they took time to consider their judgment, and in which the learned Chief Justice

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afterwards pronounced the opinion of the Court, he did not state the position in those terms, but said, that if before the granting of the letters-patent the machine had been in use, that was prior use sufficient to invalidate the letters patent, and it was not necessary that the contrivance or the machine should be in use up to the time of the letters-patent. If it is discontinued, provided it has been once in public use, and the recollection of it has not been altogether lost ; if it has been once publicly used, that will be sufficient to invalidate the letters-patent, although the use may be discontinued at the time when the letters-patent were granted.

Now, my Lords, I apprehend that that is the law, and the known law, upon the subject in this country. I never heard it before questioned that the notorious public use of an invention before the granting of letters-patent, though it may have been discontinued, is sufficient to invalidate the letters-patent.

Then, my Lords, the remaining question for consideration is this, and it is an important one, Whether, if the learned Judge laid down the law incorrectly to the jury, this was calculated to mislead the jury in the verdict that they were to pronounce. Now, I apprehend that in this case it was eminently calculated to mislead the jury, and for the reasons which I am about to state. The question related to the proceedings that had taken place at the Bradley Iron Works. It was contended that a machine similar to that of the plaintiff's had been publicly used at those works. And another point was raised also as to whether or not it was a mere experiment, or the actual use of a complete machine.

Now, it is quite obvious that as these were points for the consideration of the jury, the jury were liable to be misled, and greatly misled, by the summing up of the learned Judge, for the reason which I am about to state. When they retired for consideration, they would naturally say, "It is a question for our
" consideration, whether this machine used at the Bradley Works

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“ was a machine similar to that of the plaintiff’s. And another
“ consideration that we have before us is this, was that machine
“ simply in the course of experiment, or was it a complete
“ machine?” In order to disentangle themselves from the diffi-
culty of deciding this question, they might immediately have
said, and they would naturally have said, “ It is quite immaterial
“ for us to consider those points, because, as that machine was
“ afterwards discontinued, the learned Judge has told us, that
“ although we should be of opinion that the machines were the
“ same, although we should be of opinion that the machine was
“ not merely in the course of invention, but that it was com-
“ pleted for the purpose of practical use, yet the learned Judge
“ has told us, that unless that use has come down to the time, or
“ about the time, of granting the letters-patent, it cannot be
“ made use of as prior use for the purpose of invalidating the
“ letters-patent. It is unnecessary, therefore, for us to consider
“ those points.” That would have been the natural course which
the jury would have taken. Therefore it is perfectly obvious,
that if the learned Judge be incorrect in the manner in which he
stated the law in the particular which I have stated, it was cal-
culated to mislead the jury.

Now, my Lords, if this were a motion for a new trial, having
read the evidence, and having attended to the record, I really for
one should feel strongly of opinion that we ought not to have
disturbed the verdict, for I think the verdict is supported by the
evidence. But when we come to consider a bill of exceptions,
we are bound to take a different view of the subject, and if we are
of opinion that the law was laid down incorrectly, and if we are
of opinion that the jury may have been misled, we have no dis-
cretion to exercise, we are bound to say under such circum-
stances, that the exception must be allowed.

Under these circumstances, my Lords, I am of opinion, for the

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reasons which I have thus shortly stated, that the eleventh Exception ought to be allowed.

With respect to the other Exceptions : first, as to the first exception, I am quite satisfied by the arguments at the bar, that the learned Judge did right in refusing to admit the evidence. The arguments at the bar have satisfied me, that according to the law of Scotland, and according to the course of proceeding in Scotland, the Judge in that respect was correct. And with respect to the other exceptions, the eighth and ninth, it is unnecessary for me to enlarge upon them, because my noble and learned friends who are near me, and myself, expressed our opinions upon those points in the course of the argument, and I understood that they were ultimately abandoned by the learned counsel.

Under these circumstances, my Lords, I should recommend your Lordships to allow the eleventh exception, and to disallow all the rest.

Lord Brougham. — My Lords, I entirely agree in the view taken, and for the reasons so luminously expressed by my noble and learned friend on the woolsack, that the Exceptions, all but the eleventh, were properly disallowed by the Court before whom the bill was brought, and that your Lordships should disallow those exceptions here, affirming the judgment below; but I also entirely concur with my noble and learned friend, that we have no choice here but to allow the eleventh Exception.

This is, as my noble and learned friend has justly remarked, another case than that of an application for a new trial, and other discretion within other bounds alone remains to us to exercise. If we are of opinion, first, that the law has been mistaken, and under a misapprehension of it, it has been erroneously delivered by the Judge to the jury; and if we are, secondly, of opinion that the misdirection in point of law, the mistake in point of law,

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committed by the learned Judge, had a direct tendency, I may almost say an inevitable tendency, to mislead the jury in the conclusion to which they should come, and the verdict which they should deliver, then, my Lords, both of these questions being answered in the affirmative, that the law was mistaken, and that the mistake tended to mislead the jury in their verdict, we have no choice, but must allow the exception.

Now, my Lords, a more important mistake in point of law, your Lordships will give me leave to say, could not possibly have been made by the learned Judge, than that into which the learned Judge fell upon the present occasion. And I will not allow it to be said for one moment, in dealing with this question, that there is any thing doubtful, that there is any thing speculative, that there is any new law to be laid down, or even any new topics in respect of the law about to be broached here in dealing with the direction of the learned Judge; for I speak with all possible respect for that learned Judge's great ability and experience in his profession in Scotland, when I say that this law, which has been mistaken here by his Lordship is a matter of as perfect certainty, as thoroughly known, and as little drawn into doubt in Westminster Hall, where the law is administered touching the construction of the statute of James, the patent act, as any one branch of the law most commonly known and most frequently administered by our courts.

My Lords, the mistake into which the learned Judge fell, and in which he was followed by his brethren in the Second Division, appears to me to have arisen from this. The patent act contains two exceptions. The proviso under which the monopoly is allowed to be granted, notwithstanding the statute prohibiting all monopolies for the future, saves to the Crown the power formerly general, and now become limited by force of the act in two cases alone. In cases of inventions, the patent right, the monopoly, may be granted by the Crown to a person, provided he be "the

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“ first and true inventor ;” and provided also, secondly, that at the time of the grant of the monopoly of the patent, others shall not have used the same. Consequently, observe the result, if either he is proved not to be the true inventor, or if, being the true inventor, nevertheless it be proved that there has been an user by others, in either the one case or the other, the right flies off, the condition does not attach, which condition precedent must have existed in both those particulars, to enable the Crown to come within the benefit of the proviso, and to be saved from the prohibition of the act against all future grants of monopoly.

Now, the Court below never seem to have kept these two points distinct, which are perfectly distinct in their own nature. For a person may be disentitled to a patent who is the first inventor, on account of user at the time, or he may be disentitled to a patent, though not used at the time, if he was not the first inventor ; both titles must concur.

Now, see how this mistake, with reference to the abandonment and continuance, got in through the door which I have just shewn your Lordships, they allowed to be left open for error creeping in. If an invention has not been completed, but if it all rests in experiment and trial, then it is a most material circumstance, as a test whether any given act of a party other than the inventor, was trial or complete invention, it is a most salutary and important test to apply with a view to ascertain that, to see whether he abandoned it or continued it. If he abandoned it, if he gave it up altogether, and for twenty or thirty years did nothing, it is a very strong presumption that it was only experimental, not an invention completed. But suppose it was complete, and suppose it is admitted not to have been a trial ; suppose it is allowed to have been an invention executed, if I may so speak, — not merely executory, or not merely in the progress of invention, but an invention completed, — then it is one of the greatest errors that can be committed in point of law to say that,

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with respect to such an invention as that, it signifies one rush whether it was completely abandoned, or whether it was continued to be used down to the very date of the teste of the patent. Provided it was invented and publicly used at a time twenty or thirty, or, as in this case, forty years ago, it is perfectly immaterial — not immaterial to the second question arising upon the second condition, namely, whether it was used or not at the time of the granting of the patent, but totally immaterial to the other question, which is equally necessary to be ascertained in the inventor's favour, whether or not he was the first and true inventor; for he must be the first and true inventor, as well as the only person using it at the time, otherwise he is not entitled to the letters-patent. Herein just lies the error which has been committed by the learned Judge. He dwells upon that as if it were material in both cases; that is to say, to the question of "first and true inventor," to which it is not material, as well as to the question of user at the time, to which it is material.

My Lords, I entirely agree with my noble and learned friend, in considering that there can be no doubt that in using the word "trial" here, the learned Judge does not mean it as experiment, because in page 73, just before the two cases are cited, he speaks of "the existence and trial of machines of the very same sort," and then he makes his observations upon it. Now, "existence" implies invention; "trial" there, is rather user than experiment, and all that passage taken with what follows at the top of the next page, after citing the two cases, and somewhat misunderstanding the import of the two cases, clearly relates to invention executed and completed.

My Lords, it is always a dangerous thing in applying a *Nisi Prius* dictum, to take that dictum as law, when it goes against the known law laid down in cases in *Banc*, which have received the full consideration of the several courts before whom the question arose; but it is still more dangerous, where we are dealing

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with the law of another country, to rely upon the chance *dicta* of judges of *Nisi Prius* ; but it is most of all perilous, and most of all apt to lead judges into mistake, if they rely upon a report not in any of the regular term reports, or even *Nisi Prius* reports, but in some work, though of a learned person, yet who quotes it without authority, because it is very possible that there may have been a misapprehension of what fell from the learned Judge ; and that possibility becomes a high probability, when it turns out to be inconsistent with the reason of the case, and with other known authorities in the regular sources from which you obtain accounts of what has passed before the learned Judges.

My Lords, I doubt very much whether that fell from Mr Justice Pattison which has been stated. If it did, it has been negatived by the assent of the Court of Exchequer to what fell from Mr Baron Alderson when the subject was mentioned. As to what is supposed to have fallen from the learned Lord Chief Justice also at *Nisi Prius*, I have the most positive and indisputable authority to state, that the law as laid down now by the Lord Chancellor in his statement, and as I have now stated my opinion upon it also, is, notwithstanding what has been supposed to have fallen from the learned Chief Justice, the clear and undoubted law upon the subject ; that in the opinion of the learned Chief Justice, it is a thing that will not admit of dispute ; that it is an unquestionable position, as to which, no doubt whatever can be entertained — and I believe he would express himself as much astonished of ever having heard of its being doubted, as I have done in the course of the observations which I have taken leave to submit to the House.

All these matters being duly taken into consideration, and there being, in my apprehension, no kind of doubt that the jury upon the trial would say, “ why should we consider whether it “ was used at the Bradley works or not? why should we consider “ whether it was a trial or a completed invention? Be it so,

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“ that it was used forty years ago ; be it so, that it was a complete
“ invention, we hear the learned Lord Justice Clerk telling us,
“ that we need not trouble ourselves upon these points, for it is
“ enough for us if it was abandoned, and that takes the facts out
“ of the case, and leads us to find a verdict the other way.”

Upon these grounds, my Lords, we have no choice in this application, it being a bill of exceptions, we have no hesitation in saying, that the law was misconceived and misstated to the jury. The law is undeniable, it is a matter of no doubt or hesitation among any men in this country, who have been accustomed to administer it, or, I will venture to say, with any practitioner whose opinion is entitled to any weight. And I am also of opinion, that the law so laid down tended to mislead, and must necessarily have tended to mislead the jury. Upon these grounds I have no hesitation in supporting the proposition of my noble and learned friend, that this 11th Exception must be allowed.

I ought to apologize to your Lordships after the very luminous statement of opinion, (in which I entirely agree as well as in the reasons for it,) of my noble and learned friend the Lord Chancellor, for having occupied so long a portion of your time in adding the small weight of my opinion to his ; but I deemed it necessary upon this account, that it might clearly appear to practitioners here, as well as elsewhere, that no doubt whatever has been entertained upon the subject ; and also that it might appear in what way the error crept into the very learned and able Judge's directions to which I have adverted.

Lord Campbell. — My Lords, this case has been treated so copiously and lucidly by my noble and learned friends who have preceded me, that I shall occupy but a very few moments of your Lordships' time in offering a very few observations upon it. I entirely concur in the opinion that has been expressed upon the first Exception. I think that the learned Judge was perfectly

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justified and bound at the trial to reject the evidence which was rejected. It seems to me that the section of the recent act of Parliament about giving notice, does not apply to proceedings in Scotland.

Lord Brougham. — Clearly not.

Lord Campbell. — There are other sections of the act of Parliament that apply to Scotland, but I think that this does not. The language employed shews that it was not so intended, and there was this plain reason for abstaining from carrying into Scotland that provision, — namely, that the law of Scotland required no such amendment, because by the very salutary practice prevailing in that country there is no danger of surprise, the Condescence and the statement upon the record being to be looked at as confining the general issue that might be granted to try the merits of the question. I am therefore clearly of opinion, that where an issue of this sort, which, in the North, is called a general issue, is granted, the learned Judge at the trial is fully justified in looking, and ought to look, at the record, and to confine both parties to the facts and circumstances which are therein alleged. Looking at the record in the case, it seems to me that it excludes evidence of this trial which is supposed to have taken place at Irvine, and that the defender was not justified in entering into evidence of such trials at any of the places which are not specified in the record.

I should have been most sorry indeed to have at all prejudiced the salutary practice which prevails in Scotland upon this subject, and I wish that in England similar rules prevailed. According to the ancient practice of pleading in England, there was notice given, because in a Writ of Right the demandant stated specifically the title he made. But in an Ejectment nobody can tell what case is to be made on the part of the plaintiff, and I can say from my own experience, that I have repeatedly gone into Court, being counsel for the defendant, where an action was

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brought to recover a large estate, not only ignorant of the particular facts that were to be given in evidence, but not knowing what title was to be made; whether the lessor of the plaintiff claimed as heir-at-law or under a deed; whether he impeached the title of the purchaser in himself; or whether it was a question of parcel or no parcel. That certainly leads frequently to surprise in England, and renders it necessary on the ground of surprise, that a new trial should be granted. A much more salutary system prevails in Scotland, which I know this House most highly approves of, and will most carefully guard.

The other Exceptions, till we come to the 11th turn upon the construction of the patent. Now, in one stage of these proceedings, I certainly did entertain some doubt on that subject. But after the construction put upon it by the learned Judges of the Court of Exchequer, sanctioned by the high authority of my noble and learned friend, now upon the woolsack, when presiding in the Court of Chancery, I think the patent must be taken to extend to all machines, of whatever construction, whereby the air is heated intermediately between the blowing apparatus and the blast furnace. That being so, the learned Judge was perfectly justified in telling the Jury, that it was unnecessary for them to compare one apparatus with another, because confessedly that system of conduit pipes was a mode of heating air, by an intermediate vessel between the blowing apparatus and the blast furnace, and therefore it was an infraction of the patent.

But, my Lords, when we come to the 11th Exception, I most sincerely and deeply regret, after all this litigation, and when very probably the verdict would have been the same, if the direction had been unexceptionable, I most sincerely regret that we are bound to allow it. I have struggled as much as I could against this Exception. I was very anxious, if possible, to consider either that the learned Judge was talking merely of experiments, or if he was wrong in point of law, that the direction was imma-

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terial. But, my Lords, after very anxious consideration of the record and the proceedings, it is impossible for me to get rid of the exception, either upon the one ground or the other. For the reasons stated by my noble and learned friends, who have preceded me, it seems to me now quite clear that the learned Judge was not speaking of experiments, but that he was speaking of prior use of the invention. That appears from the language of the learned Judge himself. It appears still more clearly from the Exception to which he did not object. It appears still more clearly from the language of the learned Judges of the Second Division, when the case came to be discussed before them. They did not at all consider that the observations of the learned Lord Justice Clerk, referred to experiments. They all seem to have considered that it applied to the prior use of a perfect machine.

Then if that be so, there can be no doubt whatever, that the law which he laid down upon the subject was mistaken; because to suppose that there may have been a prior use of the invention, — of the perfected invention for which the letters-patent are granted, — and that that prior use, publicly known, will not vitiate the patent, if it has been abandoned but a few weeks before the date of the patent, strikes us in this part of the country with astonishment. That certainly is not the law as we have ever understood it, and I think after the opinions of my noble and learned friends who have preceded me, I can have no hesitation in saying that that cannot be considered as the law of this country.

The learned Judges in Scotland seem to me, with great deference, to have been misled by the expressions that are ascribed to Mr Justice Patteson, and to Lord Chief Justice Tindal. Now, I was counsel in the case of *Jones v. Pearce*, and I believe, that the account of it in *Godson* is substantially correct. But what Mr Justice Patteson may have said in that case, and what Lord Chief Justice Tindal may have said in the other

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case, taken in conjunction with the whole of their direction, amounts to this, that the abandonment may be material for the assistance of the Jury to consider whether it be a perfect invention or not; but assuming it to be a perfect invention, the abandonment becomes wholly immaterial. The learned Judge therefore in Scotland, in assuming that the direction of the learned Judges in England to the jury upon a point of fact, to assist the jury upon the point of fact, was laid down by the learned Judges in England as a point of law, was certainly mistaken.

That being so, the only question that remains is this, whether this misdirection shall be considered as immaterial; but when I look at the form of the issue, I cannot say that it was immaterial, because the issue is, “whether the invention, as described in the “said letters-patent and specification, is the original invention of “the pursuer.”

Now you cannot say that it was the original invention of the pursuer, within the meaning of the issue, if it had been publicly known and practised by others before the patent was granted. It has been said, that there was no evidence. But I think that is a mistake. What conclusion the jury would have come to I know not; but at the Bradley iron works there was such a machine, as Mr Rutherford acknowledged at the bar, as would have amounted to an infraction of the patent if the use of it had been subsequent to the patent. Then that being so, I know not what conclusion the jury might have arrived at. They might have thought that this was a perfect machine, that it was the same machine, and that it had been publicly used. If they had been of that opinion, although it had been abandoned, they ought to have found a verdict for the defender.

Under these circumstances, I regret exceedingly that I am obliged to concur in the opinion that has been expressed by my noble and learned friends, that this 11th Exception must be allowed, and the consequence of that will be, that there must be

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a *venire facias de novo*, and that the case must be tried by another jury.

Lord Chancellor. — My Lords, I wish to say, that if there had been any doubt whatever with respect to the meaning of the words used by the learned Judge in summing up, those doubts would be removed by the concluding words, “that it must have been known and used as a useful thing at the time.” What? The invention “must have been known and used as an useful thing at the time of the granting of the letters-patent.” That shews demonstrably what was intended.

It must not be understood, that your Lordships, in the judgment which you are about to pronounce, have given any decision upon this state of facts, namely, if an invention had been formerly used and abandoned many years ago, and the whole thing had been lost sight of. That is a state of facts not now before us. It is not raised upon this record. Therefore it must not be understood that we have pronounced any opinion whatever upon that state of things. It is possible that an invention may have existed fifty years ago, and may have been entirely lost sight of and not known to the public. What the effect of that state of things might be, it is not necessary for us to pronounce upon.

Lord Brougham. — It becomes like a new discovery. Reverse upon the 11th Exception and Affirm upon the others.

Mr Rutherford. — Affirm *quoad ultra*. My Lords, may I be allowed to suggest that remitting to the Court below, to proceed accordingly, would be sufficient to enable the Court to give directions for a new trial. Of course that would lead instantly to a new trial.

Lord Brougham. — Perhaps that is the better way.

Mr Rutherford. — It will be better if your Lordships will also remit to the Court of Session, to deal with the question of costs, including this appeal, according to the ultimate result.

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Lord Brougham.—No, you cannot have the costs of this appeal, when upon the main point there is a reversal.

Mr Rutherford.—Unless your Lordships give a special direction.

Lord Chancellor.—It is not a case in which we ought to give costs on either side.

Ordered and Adjudged, that the interlocutor of the 27th January, 1842, complained of in the said appeal, be affirmed with costs. And it is farther ordered and adjudged, that the interlocutor of the 20th July, 1842, also complained of in the said appeal, in so far as such interlocutor disallowed the eleventh Exception stated in the Bill of Exceptions, and found the pursuers in the action in the Court below entitled to the expenses incurred by them in the discussion on the said Bill of Exceptions, be reversed. And it is also farther ordered and adjudged, that in all other respects the said last mentioned interlocutor be affirmed. And it is declared, that the said eleventh Exception ought to be allowed. And it is farther declared, that neither party is entitled to the expenses incurred by them respectively in the discussion on the said Bill of Exceptions in the Court below. And it is also farther ordered, that with these declarations, the cause be remitted back to the Court of Session in Scotland to proceed farther therein, as shall be just and consistent with the said declarations, and this judgment.

GRAHAM, MONCRIEFF, and WEEMS. — ROY, BLUNT, and Co.
Agents.