

*Judgment of the Lords of the Judicial Committee of the Privy Council on the Petition of Thomas Davison for Prolongation of the term of Poole's Patent for Improvements in Surface Condensers; delivered on the 20th July, 1867.*

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Present:

LORD ROMILLY.

SIR JAMES WILLIAM COLVILLE.

SIR EDWARD VAUGHAN WILLIAMS.

SIR RICHARD T. KINDERSLEY.

IN this case their Lordships, having considered the evidence laid before them, are of opinion that a case has been made out for a prolongation of the Patent, provided no legal impediment stands in the way. It appears that Mr. Sewell took out a Patent in this country, in November, 1853, for the ordinary term of fourteen years, and that in the following November, in 1854, he obtained a Patent in the United States, which, according to the laws then existing there, would expire one year after the time when the English Patent would expire. Their Lordships are informed, though I am not sure that the evidence of this is distinctly before them, that Mr. Sewell was an English born subject, residing in America when the Patent was taken out. Their Lordships do not consider that circumstance of very material importance with respect to the question which arises upon the point of law to be mentioned presently.

It appears that for the first six years Mr. Sewell made no profit at all in this country. There is no account of what profits he made in the United States, nor do their Lordships think it material for this purpose, because the question before them is what profits were made and what benefits were sustained by the introduction of the invention into this country. It appears that he made no profits at all for nearly seven years; but for the remaining

seven years he seems to have made a little more than £7000 in the whole. It was accomplished in this manner. He employed a gentleman to come to this country to manage the Patent for him, upon an agreement that they should divide the profits between them. Upon the documentary evidence given to their Lordships, which is confirmed by the evidence taken orally before them, it appears that they have had about £3500 each.

Their Lordships consider that the Patent is one of great utility. They think that it has been proved to them that it is a Patent of great advantage for the construction of steam engines. That the mode of fixing the tubes so as to enable a perfect flow of cold water to take place externally, thus producing the required effects of condensation of the steam without the injurious consequences hitherto observed, is of the greatest value. The testimony is unanimous on that subject. Mr. Hannen very properly stated that he could not dispute that there was very great utility in the invention. That being so, their Lordships think that £7000 is an inadequate remuneration for the time and trouble and risk occasioned by this invention, and therefore that it is desirable that the Patent should be extended.

The question then arises, whether their Lordships are fettered by any legal impediment from granting any extension. The objection is taken, that by the 25th section of the Act of the 15th and 16th of the Queen, Letters Patent in the United Kingdom cannot continue in force after the expiration of a foreign patent; and if that is the true construction of the Statute, the result will be, that upon the expiration of the American Patent, no patent can be granted in this country. But their Lordships think that this is not the true construction of this clause. The clause is this:—"Where, upon  
 "any application made after the passing of this  
 "Act, Letters Patent are granted in the United  
 "Kingdom for or in respect of any invention first  
 "invented in any foreign country, or by the sub-  
 "jects of any foreign Power or State, and a patent  
 "for the monopoly or exclusive use or exercise of  
 "such invention of any foreign country is there ob-  
 "tained before the grant of such Letters Patent in  
 "the United Kingdom, all rights and privileges

“under such Letters Patent shall (notwithstanding  
“any term in such Letters Patent limited) cease  
“and be void immediately upon the expiration or  
“other determination of the term during which  
“the patent obtained in such foreign country shall  
“continue in force, or, where more than one such  
“patent is obtained abroad, immediately upon the  
“expiration or determination of the term which  
“shall first expire or be determined of such several  
“patent.” Now their Lordships think, upon the  
due construction of that clause, that it applies to  
the case where a patent has been obtained in a fo-  
reign country before the patent was obtained in  
this country, combined with this further circum-  
stance, that the invention in respect of which the  
patent here was granted was first invented either in  
a foreign country or by the subject of a foreign  
State. Their Lordships are of opinion, therefore,  
that this clause of the statute must apply to a case  
where a patent has been previously obtained in a  
foreign country. And it is obvious, from various  
considerations, that that must be the meaning of  
the clause, for, if not, an English born subject who  
took out a patent in this country for an invention  
invented here could not venture to take out a pa-  
tent in a foreign country if the patent in the foreign  
country was of shorter duration than that in this  
country,—as, for instance, in Belgium, where the  
term appears to be ten years,—as it would abso-  
lutely preclude his ever applying for a continuation  
of the patent here, inasmuch as the patent for the  
same invention would previously have expired in  
the foreign country. Therefore, their Lordships  
think that the section is not meant to apply to  
such cases, nor to prevent persons, if they are na-  
tural born English subjects, who have taken out a  
patent here, from obtaining a continuation of the  
patent, though they have subsequently taken out  
a patent in another country for the same invention.

Their Lordships' view of this case is confirmed  
by the case of Betts's Patent, which is reported in  
the first volume of the new series of Mr. Moore's  
Reports. There it appears that the Letters Patent  
for an invention made in England were granted,  
in 1849, to Mr. Betts, who was a British subject.  
In the following year a patent was granted in  
France for the same invention for fifteen years, and

in the same year another patent was granted in Belgium for ten years. The Belgian patent of course expired before the English patent, and before any application was made for a prolongation of the patent. In that case the Judicial Committee held that the section which I have read did not apply so as to deprive their Lordships of the power of entertaining an application for a prolongation of the patent; and their Lordships in that case decided that this section applied only to cases where the original patent had been granted in a foreign country, and not to those where the patent had been first granted in the United Kingdom: and in this decision no reference is made to the question by whom the patent was taken out, whether by a foreigner or natural born English subject. Their Lordships think that decision applies to this case. The patent here was taken out in November, 1853, and the patent in the United States was taken out in November, 1854. The consequence of this is, that their Lordships, taking into consideration the whole of the matter, the remuneration received, the value of the invention, and the arrangement which has been entered into between the gentleman who applies here and the family of the inventor, who is deceased, think it fit that an extension should be granted of five years; and their Lordships will therefore humbly report to Her Majesty as their opinion, that this patent should be so extended.