

Judgment of the Lords of the Judicial Committee of the Privy Council on the Petition of Ross Winans and Thomas Winans for prolongation of the term of their Letters Patent for Improvements in Shipbuilding; delivered 11th January 1872.

Present:

SIR JAMES W. COLVILLE.
SIR ROBERT PHILLIMORE.
SIR MONTAGUE SMITH.
SIR ROBERT P. COLLIER.

IN this case the material facts are shortly these. A patent was taken out by the petitioners in this country in June 1858, and contemporaneously with that patent a patent was taken out by them in France; which, though applied for at a later period, was dated at the same time as the English patent. A few months afterwards, in October 1858, a patent was taken out in America. The French patent has been suffered by the patentees to expire. The American patent will shortly expire, and of course it is questionable whether or not it will be renewed.

Their Lordships have first to consider whether the objection raised on the part of the Crown to their jurisdiction is maintainable for the reasons which have been intimated in the course of the argument, and they think that the objection is not maintainable. They consider that the proviso in the 25th section of the 15 & 16 Vict. c. 83. must receive the interpretation which was put upon it in *Betts' case*; viz., that it applied to the same set of conditions as the early part of the section. It therefore only applied to the cases where the foreign patent had been taken out before the English patent. That was not the case here.

Therefore their Lordships deem that their jurisdiction to extend this patent is not ousted by that section. But then they have to consider the principles upon which that jurisdiction should be exercised. These principles are very clearly expressed by Mr. Justice Coleridge in a well considered judgment in Hill's patent in 1863. His words have been quoted with approval in many subsequent cases, among them the case of the sewing machine in 1871, and are as follows: "A monopoly
" limited to a certain time is properly the reward
" which the law assigns to the patentee for the
" invention and disclosure to the public of his
" mode of proceeding. Whether that term shall
" be extended, in effect whether a second patent
" shall be granted, for the same consideration,
" and the enjoyment by the public of its
" vested right be postponed, is to depend on the
" exercise of a discretion, judicial indeed,
" yet to be influenced by every such circum-
" stance as would properly weigh on a sensible
" and considerate person in determining whether
" an extraordinary privilege, not of strict right,
" but rather of equitable reward, should be con-
" ferred." In that case their Lordships held that they were not prevented by the operation of the 25th section from entertaining the application, still, upon grounds of general policy, they thought fit to refuse it. There is another case, in the year 1862, which has a strong bearing upon the present; that was the case of Newton's patent; and Dr. Lushington, who pronounced the judgment of their Lordships, says, "This is a petition for the prolongation of
" a patent granted in 1848, for the term of 14
" years, and it appears that in the United States
" of America a similar application was made,
" and that in consequence of that application
" letters patent were granted from the 19th of
" September 1848 for the same period of 14
" years." (It should be observed that whereas in this case letters patent were obtained in Eng-

land in June, and in America in October; there they were obtained in England in August, and in America in September.) "And application is now
 " made on behalf of the patentee or his assignee,
 " praying their Lordships to renew the patent.
 " Now their Lordships have considered the cases
 " which have been decided by the Judicial Com-
 " mittee upon former occasions, and they are of
 " opinion that those cases were rightly decided,
 " and they have no intention of departing from
 " the principles there laid down. But it appears
 " to them that the decision of the case rests
 " upon a very narrow basis indeed. The two
 " patents were granted as nearly as possible si-
 " multaneously; and though the case does not
 " come within the letter of the Statute, it ap-
 " pears to their Lordships that it comes within
 " the true spirit of it; and that, in the exercise
 " of the discretion which is reposed in them,
 " they ought not to authorize Her Majesty to
 " renew the terms of these letters patent." That case certainly bears a very strong resemblance to the present one. There was another case referred to, that of Norman's patent, where, no doubt, the circumstances were in many respects different, but in which Lord Justice Giffard makes this general remark:—that their Lordships cannot recommend Her Majesty to prolong the patent in England upon the mere chance of its being prolonged in a foreign country. There is another case, a sewing machine case, which has not yet been reported, and which, no doubt, differs in many circumstances from the present case, but in which the general principles laid down in the cases referred to are affirmed.

In this case we have very much the same circumstances as those which existed in Newton's case; but we have this additional circumstance, which appears to their Lordships very material: not only, as in Newton's case, were two patents taken out in this country and in America, within a short time of each other, so

that the American patent as well as the English was nearly expiring, but in this case a patent was taken out in France which has been allowed to expire by the patentees. The petitioners having published their invention in France, but not having kept up their French patent, now ask their Lordships to prohibit the subjects of the Queen for a certain time from manufacturing the described vessels, whereas the manufacture of them will be open to all shipbuilders in France, to whom the invention has been published by the patentees.

Under all these circumstances their Lordships, having regard to the principles which have been laid down in the cases referred to, and in many others, are of opinion that, assuming in favor of the patentees all that has been alleged as to the merits of their invention, it is not their duty to advise the Crown to prolong this patent.