

Again, in an action brought for the infringement of *Bartlett's* patent for "improvements in tyres or rims for cycles and other vehicles," (*r*) *Romer, J.*, held that the essence of *Bartlett's* invention was the combination of an outside flexible tyre that can be easily removed, because it is not itself a complete tube, and of an inside complete tube capable of inflation, so that when the inside tube is inflated the flexible tyre is kept on to the grooved metal rim of the wheel by the pressure of the sides of the flexible tyre against the groove. The patentee in his specification pointed out that by thickening the sides or edges of the flexible tyre the grip could be increased; and obviously the more the grip was increased the more difficult it would be for the inside complete tube, if made elastic, to force the flexible tyre out of the narrow mouth of the grooved metal rim. The defendants took the patentee's idea and the essence or substance of his invention. All they did, by way of alteration, was to increase the size of the outside flexible tyre and the thickening of its edges, and to exaggerate the dovetailing of the metal grooved rim, so as to give a greater grip, and to render it more difficult for the flexible tyre to be forced out of the mouth of the groove, and thus they were enabled to employ for the inflatable inside tube a more elastic tube than that mentioned in the body of the specification. The Judge held that the defendants' tyre might be an improvement upon the plaintiff's, but still, in substance, it was the plaintiff's and an infringement of the patent. Other points incidental to the structure of the different parts of the combination used by the defendants were urged as differentiating it from the plaintiff's, but unsuccessfully, in face of the finding of the Court that the essence or substance of the plaintiff's invention was present in the defendants' combination. (*s*)

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(*r*) *North British Rubber Co. v. Macintosh*, (1894) 11 R. P. C. 477.

(*s*) See also *North British Rubber Co. v. Gormully and Jeffery Manufacturing Co.*, (1896) 13 R. P. C. 691; 14 R. P. C. 283; 15 R. P. C. 245; *Pneumatic Tyre Co. v. Tubeless Tyre*, (1897) 15 R. P. C. 74, 236; 16 R. P. C. 77; *White v. Bertrams*, (1897) 14 R. P. C. 501, 735; *Dunlop Pneumatic Tyre Co. v. New Ixion Tyre and Cycle Co.*, (1898) 16 R. P. C. 16; and as to the true construction of the claims of the Welch patent for bicycle tyres and what was and what was not held to

be an infringement see the following cases: *Pneumatic Tyre Co. v. Caswell*, (1896) 13 R. P. C. 164, 375; *Pneumatic Tyre Co. v. East London Rubber Co.*, (1897) 14 R. P. C. 77, 573; *Pneumatic Tyre Co. v. Ixion Patent Pneumatic Tyre Co.*, (1897) 14 R. P. C. 853, approved by C. A., 16 R. P. C. 17; *Dunlop Pneumatic Tyre Co. v. New Ixion Tyre and Cycle Co.*, (1898) 16 R. P. C. 16; *Dunlop Pneumatic Tyre Co. v. Wapshare Tube Co., Ltd.*, (1900) 17 R. P. C. 433; *Dunlop Pneumatic Tyre Co. v. Clifton Rubber Co.*, (1902) 19 R. P. C. 433; 20 R. P. C. 393;

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So also a patent for a chemical mixture or compound suitable for a beetle poison was held to be infringed by the addition of non-material ingredients to the material ingredients specified by the patentee. (t) And in a case where the defendants took what was the merit of the plaintiff's improved sewing machine—*i.e.*, using a looper in such a way and with such a variety of machinery as to present the thread at a sufficient tension to the notch of the needle, though they introduced a portion of an alleged anticipating but useless machine, which was not necessary to the plaintiff's mechanism, they were held to have infringed. (u)

Criterion of
novelty and
infringement
are not the
same.

An arrangement, though it be an infringement of a prior patent, may be such as would itself support a patent on the ground of novelty. The criterion of novelty and infringement in this respect are not the same. This point was stated by *Pollock, C.B.*, in *Newton v. Grand Junction Railway Co.* (x) Thus :—

“It was agreed that the same criterion is to be applied to the question of infringement as to that of novelty. But that is not so. In order to ascertain the novelty, you take the entire invention, and if in all its parts combined together it answer the purpose by the introduction of any new matter, by any new combination, or by a new application, it is a novelty entitled to a patent. But in considering the question of infringement, all that is to be looked at is, whether the defendant has pirated a part of that to which the patent applies ; and if he has used that part for the purposes for which the patentee adapted his invention and for which he has taken out his patent, and the jury are of opinion that the difference is merely colourable, it is an infringement.” (y)

Combination
may be in-
fringed by an
unlawful
taking of its
substance.

In further pursuance of the principle under discussion, *viz.*, that there is no infringement unless the substance of the invention claimed is pirated by the alleged infringer, the following remarks of Lord *Cairns, L.C.*, and Lord *Esher, M.R.*, made in reference to patents for combinations, may be usefully quoted :—

Dunlop Pneumatic Tyre Co. v. United Rubber Works, Ltd., (1902) 19 R. P. C. 406; *Dunlop Pneumatic Tyre Co. v. New Lamb Tyre Co.*, (1902) 20 R. P. C. 303; *Dunlop Pneumatic Tyre Co. v. Hyde Rubber Co.*, (1904) 21 R. P. C. 208.

(t) *Lane v. Herold*, (1892) 9 R. P.

C. 447.

(u) *English and American Machinery Co. v. Union Boot and Shoe Co.*, (1894) 11 R. P. C. 137, 367.

(x) (1846) Ex. R. 334; 20 L. J. Ex. 427 *n.*

(y) See p. 339 *ante*.

Lord Cairns in *Clark v. Adie*, (1877) L. R. 2 App. Cas. 320, speaking in the House of Lords on the different possible modes of infringing a patent for a horse-clipper which consisted of a combination of several parts, said: "One mode of infringement would be a very simple and clear one: the infringer would take the whole instrument from beginning to end, and would produce a clipper made in every respect like the clipper described in the specification. About an infringement of that kind no question could arise. The second mode would be one which might occasion more difficulty. The infringer might not take the whole of the instrument here described, but he might take a certain number of parts of the instrument here described; he might make an instrument which in many respects might resemble the patent instrument, but would not resemble it in all its parts. And then the question would be, either for a Judge or for any tribunal which was judging of the facts of the case, whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented, and whether in what he had done he had not really taken and adopted the substance of the instrument patented. But there is a third way in which it is possible to conceive an infringement of a patent of the kind to which I have referred. Inside the whole invention there may be that which itself is a minor invention, and which does not extend to the whole, but forms only a subordinate part or integer of the whole. Now, again, that subordinate integer may be a step, or a number of steps in the whole, which is or are perfectly new, or the subordinate integer may not consist of new steps, but may consist of a certain number of steps so arranged as to form a novel combination with the meaning which is attached by the patent law to the term "combination." Suppose that in a patent you have a patentee claiming protection for an invention consisting of parts which I will designate as A, B, C, and D; he may at the same time claim that as to one of those parts, D, it is itself a new thing, and that as to another of those parts, C, it is itself a combination of things which were possibly old in themselves, but which, put together and used as he puts together and uses them, produce a result so new that he is entitled to protection for it as a new invention. In a patent of that kind the monopoly would or might be held to be granted, not only to the whole and complete thing described, but to those subordinate integers entering into the whole which I have described. But then, the invention must be described in that way; it must be made plain to ordinary apprehension, upon the ordinary rules of construction, that the patentee has had in his mind and has intended to claim protection for those subordinate integers; and, moreover, he is, as was said by

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the Lords Justices, at the peril of justifying those subordinate integers as themselves matters which ought properly to form the subject of a patent of invention."

Lord *Esher*, M.R., speaking on the same question, in reference to the patent for the *Nordenfelt* gun in *Nordenfelt v. Gardner*, (1884) 1 R. P. C. 61, 65, said: "That seems to me to claim the feeding apparatus as a combination, and to claim the combination, and the combination alone. If that be so, how can such a combination be infringed? The machine which is challenged may have that combination actually without any variance at all. If so, it is obvious that the challenged machine is an infringement. Or it may have that combination with some alteration. The alteration of a combination, as it seems to me, may be by addition, or subtraction, or substitution of parts. Any one of these alters the combination. If the alteration, whether it be by addition, or subtraction, or substitution, be merely colourable, then the two machines are substantially the same; although not mathematically exactly the same, they are substantially the same, and in any case, notwithstanding such colourable alteration, there may be an infringement. An alteration by addition may be an improvement, but then that will leave the whole of the original combination, and add something to it. If such an alteration of the combination be made, it seems to me that no good patent can be made with regard to the new machine, except by claiming the invention as an improvement, and by showing distinctly what the addition is, so as to show what the improvement is. An alteration by subtraction, if it were more than a colourable subtraction, would, as it seems to me, alter the combination. It would not be a combination of the same things; it would be a combination of different things, and, if the combination were altered by a material subtraction, I should think that it was a new combination. But an alteration by substitution, that is by substitution of one of the material elements of the original combination, must to my mind be a new combination. The second combination, then, is a combination of different things from the first. There is a taking away of one of the elements, and a material element of the old combination, and the putting in of a new material element which is different from any of the elements of the former. Somebody tried to express these things by A, B, and C; but if the original combination is of A, B, and C, and you take away C, and make a combination of A, B, and D, it seems to me as clear as possible that the new combination is a different combination from the old."

In order to answer a charge of infringing a patent for a combination of several parts by the omission of one of them,

it is not necessary for a defendant to prove that the part omitted was an essential element in the combination in the sense that the machine would not work without it; but he must at least show that it is a material element and not a mere detail which may be varied or omitted altogether without serious detriment to the successful working of the combination. (z)

Infringe-
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Thus, the substitution of a weighted valve for a water valve or column in a combination forming a milking machine was held to be an infringement. (a) Also the substitution of a pump, though contrived with great ingenuity, for a bellows in a smoke-testing and fumigating apparatus. (b) Again, a patent for an improved carriage lamp, in which the candle tube was prevented from falling out by means of a flat sliding bolt which engaged with a knob on the tube being pushed home by the coachman's hand, or simply by shutting the door of the lamp, and kept in its place by contact with the door when shut, was infringed by a sliding bolt with spring engaging with a collar on the tube and kept in position by the shut door of the lamp. (c)

But if the defendant's combination is really a different one to the plaintiff's there is no infringement, (d) *i.e.*, if an essential feature of the plaintiff's combination is not to be found in the defendant's combination. (e)

It has been explained (f) that in the case of a patent for a combination of several parts a claim may be made to the combination as a whole, and also to any one or more of the several parts separately, or in combination as a minor invention. The question whether the use of one or more of the component parts of a combination is an infringement or not, depends upon whether or not the parts are claimed separately, or whether taken together they are claimed as a subsidiary combination. It is not possible to say in the abstract whether the use of two parts, A and B, of a combination consisting of A, B, and C, is or is not using part of the invention; nor can it be decided in the abstract whether or not the specification

Special claims
for subsidiary
parts of a com-
bination.

(z) Consolidated Car Heating Co. v. Came, (1903) 20 R. P. C. 766.

(a) (1893) 10 R. P. C. 417.

(b) Macdonald v. Fraser, (1893) 10 R. P. C. 386; 11 R. P. C. 169.

(c) Howes v. Webber, (1895) 12 R. P. C. 465; 13 R. P. C. 39.

(d) Automatic Diversions Syndicate v. Urry, (1897) 14 R. P. C. 365.

(e) Griffiths v. The Birmingham

Stopper and Cycle Component's Co., (1899) 16 R. P. C. 383; Brooks v. Lamplugh, (1898) 16 R. P. C. 41; Pneumatic Tyre Co. v. Tubeless Pneumatic Tyre and Capon Heaton, Ltd., (1898) 16 R. P. C. 77; Consolidated Car Heating Co. v. Came, (1903) 20 R. P. C. 745; Hardmuth v. Baker, (1904) 21 R. P. C. 66.

(f) p. 256 *ante*.

Infringe-
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shows that A and B is claimed separately or whether they are claimed together as a separate subordinate combination within the larger combination consisting of A, B, and C. (*g*)

A patent for a combination is infringed by the use of a subordinate part only, if that part is new and material and is the subject of a claim; (*h*) though, if the patent is for a combination of two or more old inventions, the use of only one of them will not be an infringement, since the patentable novelty claimed is the combination of the two. (*i*)

Thus, if a man invents a machine consisting of three parts, of which one is a very useful invention, and the other two are found to be of less practical use, it is not free for a person to adopt the useful part, and contrive some other mode of carrying out the less useful parts. (*h*) The question always is, "Has the combination in substance been taken? Has the defendant, though not exactly taking the whole combination which has been patented, taken by slight variation or by mechanical equivalent the substance of it, so as to produce the same result by practically the same means?" (*l*)

Equivalents
substituted for
specified parts.

When the ambit of the claim is not limited to the particular thing specified, the law will not allow a person in lieu of a part described by the patentee to employ a substitute in its place, for the purpose of effecting the same end, by means of an equivalent, using the skill and knowledge which he may possess to evade the patent. (*m*)

In fact, when, having regard to the state of public knowledge, a narrow construction is not to be put upon the claim, (*n*) it is an infringement to substitute mechanical

(*g*) *Clark v. Adie*, (1877) L. R. 2 App. Cas. 335.

(*h*) *Lister v. Leather*, (1857) 8 E. & B. 1004; *Parkes v. Stevens*, (1869) L. R. 8 Eq. 358, 366; L. R. 5 Ch. App. 36; *Wright v. Hitchcock*, (1870) L. R. 5 Ex. 37; *Foxwell v. Bostock*, (1863) 12 W. R. 723; *Sellers v. Dickinson*, (1850) 5 Ex. 312; *Newton v. Grand Junction Ry.*, (1846) 5 Exch. 331; *Smith v. London and North-Western Ry.*, (1853) 2 E. & B. 69; *Young v. Rosenthal*, (1884) 1 R. P. C. 33; *Clark v. Adie*, (1873) L. R. 10 Ch. App. Cas. 667; 3 Ch. D. 134, 143; 2 App. Cas. 315, 327, 335; *Consolidated Car Heating Co. v. Came*, (1903) 20 R. P. C. 763.

(*i*) *Smith v. London and North-Western Ry.*, (1853) 2 E. & B. 69, 76.

(*k*) *Ibid.*

(*l*) See per Cotton, L.J., *Proctor v.*

Bennis, (1887) L. R. 36 Ch. D. 254, 740; 4 R. P. C. 333; see also *Burnett v. Tato*, (1882) 45 L. T. N. S. 143; *Murray v. Clayton*, L. R. 10 Ch. App. Cas. 675 *n.*; *Kaye v. Chubb*, (1888) 5 R. P. C. 641; *Garrard v. Edge*, (1889) 6 R. P. C. 372, 563; *Combination Hubs, Ld. v. Seabrook*, (1906) 23 R. P. C. 205.

(*m*) *Bateman v. Gray*, (1853) Macr. P. C. 102; *Morgan v. Seaward*, (1837) 1 W. P. C. 171; *Thorn v. Worthing Skating Rink Co.*, (1876) L. R. 6 Ch. D. 415 *n.*; *United Telephone Co. v. Harrison Cox-Walker*, (1882) L. R. 21 Ch. D. 720; *United Telephone Co. v. Bassano*, (1886) 3 R. P. C. 295; *United Telephone Co. v. St. George*, (1886) 3 R. P. C. 321; *Hancock v. Moulton*, *Johns. Pat. Man.* 5th ed. p. 254.

(*n*) p. 353 *post.*

equivalents for parts of the patentee's invention and add at the same time an improvement; (o) or to omit some part or parts of a patented combination and add anything, whilst at the same time using the substance and essence of it. (p)

Infringe-
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It is an accepted proposition of patent law, known as the rule in *Sellers v. Dickinson*, (q) that if a portion of a patented new arrangement of machinery is in itself new and useful, and a person, for the purpose of producing the same effect as it produces, uses that portion of the arrangement, and substitutes another mechanical equivalent for the other matters combined with it, he thereby commits an infringement of the patent.

Rule in *Sellers*
v. Dickinson.

It is important to remember that the novelty connoted in the above paragraph may, in some cases, be the employment for the first time for a particular purpose of an underlying principle, and, in other cases, the novelty may be the employment of details whereby an old principle is carried into effect in a new way. The doctrine of infringement by the substitution of equivalents is applicable only to cases of the first of the above-indicated two classes. (r)

In order, however, that the substitution of an equivalent for any part of a patented mechanical combination or process may constitute an infringement, the equivalent must, judged by the standard of public knowledge at the date of the patent, be obviously and demonstrably an equivalent. To produce the result arrived at by the patentee by the use of an equivalent means, which required subsequent discovery to demonstrate that it is an equivalent, may be perfectly good subject-matter for a subsequent grant of letters patent, and no infringement of the prior patent. (s) Thus, rendering cast steel easy to weld and malleable by subsequently discovered equivalents, viz., the addition of coal tar and black oxide of manganese to a crucible containing bars of common blistered steel, broken into fragments, or mixtures of cast and malleable iron, or malleable iron and carbonaceous matter, and

Equivalents
not known at
the date of the
patent.

(o) *Proctor v. Bennis*, (1887) 4 R. P. C. 333; L. R. 36 Ch. D. 740; *Ehrlich v. Hulce*, (1888) 5 R. P. C. 437, 454.

(p) *Proctor v. Bennis*, (1887) 4 R. P. C. 333; 36 Ch. D. 740, 755; *Needham v. Johnson*, (1884) 1 R. P. C. 49; *Gwynne v. Drysdale*, (1886) 3 R. P. C. 65, 67; *Cannington v. Nuttall*, (1871) L. R. 5 H. L. 205.

(q) 5 Exch. 312, 326; 20 L. J. N. S. Ex. 417.

(r) See p. 341 *ante*, and pp. 354, 366 *post*.

(s) *Heath v. Unwin*, (1855) 5 H. L. C. 545; *Badische Anilin und Soda Fabrik v. Levinstein*, (1883) L. R. 24 Ch. D. 156, 170-173; L. R. 12 App. Cas. 710; *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 113, 300; *Thomson v. Moore*, (1889) 6 R. P. C. 426; 7 R. P. C. 329.

Infringe-
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heated to the proper heat for melting the materials, was held by the House of Lords (*t*) to be no infringement of a claim made by a prior patentee for doing the same thing by means of carburet of manganese, although there was evidence to the effect that carburet of manganese was formed by exposing the mixture of carbon and oxide of manganese to a high temperature. This decision of the House of Lords was based upon the fact that, at the date of the patent sued on, it was not known that coal tar and oxide of manganese would be chemical equivalents of the carburet of manganese claimed by the patentee, (*u*) *i.e.*, judged by the light of public knowledge at the date of the patent coal tar and oxide of manganese were not obviously and demonstrably the equivalent of carburet of manganese. As stated by Lord *Abinger*, C.B., in the Court of Exchequer, the materials or elements of carburet of manganese, as used by the defendant, being out of all proportion cheaper than the carburet of manganese itself, the use of such materials in the composition was a new discovery or invention, and not within the claim of the letters patent. (*r*) The foregoing remarks must not be taken to imply that the substitution for a part in the patented combination or process of a subsequently invented or discovered equivalent, which itself may possibly be subject-matter for valid letters patent, is necessarily no infringement. Assuming a particular case to be one to which the doctrine of infringement by the substitution of equivalents is applicable, (*x*) it is submitted the real point for determination is whether or not the newly invented or discovered equivalent is, when judged by the light of public knowledge at the date of the patent alone, clearly and obviously an equivalent *qua* the function of the part for which it is substituted.

State of public knowledge affects the question whether or not the substitution of known equivalents is an infringement in a particular case, *i.e.*, public

With regard to the question of the infringement of patents by the substitution of equivalents for parts described by the patentee in the specification, it must be remembered that it is necessary first to determine the true construction of the specification, and so ascertain what is the real invention claimed. (*y*) It must also be borne in mind that the true construction of the specification and ambit of the claim may be affected (*inter alia*) by the state of public knowledge at the

(*t*) *Heath v. Unwin*, (1855) 5 H. L. Cas. 505.

(*u*) 5 H. L. C. 545, 548.

(*v*) *Heath v. Unwin*, (1855) 2 W. P. C. 217; 5 H. L. C. 545, 548; Nobel's

Explosives Co. v. Anderson, (1895) 12 R. P. C. 167, 168.

(*x*) See *infra*.

(*y*) pp. 265, 338, 353 *ante*.

date of the patent. (z) The substitution of an equivalent in the place of a part mentioned in the patentee's specification may, or may not, be an infringement according as the state of public knowledge affects the true construction and ambit of the claim. (a)

Infringe-
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knowledge
affects the
true ambit of
the claim.

When the invention relates to the production by means of a novel combination of old parts of an old result, or to a machine of a known type, *i.e.*, a machine utilising an old principle or system, the patentee is protected only in respect of the particular means he sets forth in the specification; and under such circumstances it may be no infringement to achieve the same result by the use of well-known equivalents. (b) In other words, when the invention claimed is the particular arrangement of old parts previously used in combination, the doctrine of infringement by substitution of equivalents, *i.e.*, different mechanical contrivances formerly used for the same purpose or of newly invented mechanical contrivances, is not applicable, and the patentee cannot complain of the use of different mechanical appliances in lieu of one or more of the parts, (c) though, no doubt, he might restrain the substitution of mere colourable variations for a part or parts in the new arrangement. (d) In such cases it is the rule of the Court, if it can fairly and logically be done, to give the claim the limited construction above indicated, for the rule is that the specification is to be construed so as to support the patent, if it can fairly and logically be done, (e) and if a wider construction were put upon it under the circumstances indicated it would claim what had been done before, and so make the patent void for want of novelty.

On the other hand, when the invention consists in the production of a new result, or a machine which is of a totally new type, *i.e.*, a machine involving the use of a new principle or system, the patentee is not tied down strictly to the particular means, or the identical parts he sets forth in the specification; and under such circumstances it is an infringement to substitute obvious equivalents for the parts specified,

(z) pp. 283, 285 *ante*, and p. 467 *post*.

(a) See p. 342 *ante*, and p. 366 *post*.

(b) *Curtis v. Platt*, (1866) L. R. 3 Ch. D. 135 n.; *Seed v. Higgins*, (1860) 8 H. L. C. 550; *Gosnell v. Bishop*, (1888) 5 R. P. C. 550; *Hick v. Sim-*

monds, (1904) 21 R. P. C. 632; *Hardmuth v. Baker*, (1904) 21 R. P. C. 66.

(c) See *Brooks v. Lamplugh*, (1898) 16 R. P. C. 48.

(d) See p. 339 *ante*, and pp. 358, 363, 365, 366 *post*.

(e) p. 286 *ante*.

Infringement. and at the same time to make use of the novel principle the carrying of which into effect is the real substance of the patentee's invention. (*f*).

Curtis v. Platt and Proctor v. Bennis as types of the two classes of cases.

Curtis v. Platt, (*g*) which followed the earlier House of Lords' decision in *Seed v. Higgins*, (*h*) and the principle of which was also applied by the House of Lords in *Boyd v. Horrocks*, (*i*) and in *Morris v. Young*, (*j*) *Chamberlain and Hookham v. Mayor, &c., of Bradford*, (*k*) and *Ashworth v. English Card Clothing Co.*, (*l*) is usually cited as the leading authority with reference to the first class of cases, and *Proctor v. Bennis*, (*m*) the principle of which was approved by the House of Lords in *Moore v. Thomson*, (*n*) is the leading authority with reference to the second class of cases.

Curtis v. Platt. In *Curtis v. Platt*, (*o*) where the patent was for certain improvements in spinning mules, a class of machine previously well known, and the invention consisted in a novel combination of old parts, all of which had been previously used before, and the invention was, consequently, a particular means of effecting an old result, though not in the same combination, for a similar purpose, Lord *Matherley* (then Vice-Chancellor *Page Wood*) and Lord *Westbury*, L.C., and the House of Lords followed the rule laid down by the House of Lords in *Seed v. Higgins*, (*p*) which applies to patents for means of achieving known results, viz., that if you find a specific mechanical improvement claimed, then you must hold the person strictly to that particular mechanical device

(*f*) *Clark v. Adie*, (1887) L. R. 2 App. Cas. 315; *Proctor v. Bennis*, (1887) L. R. 36 Ch. D. 740; *Boyd v. Horrocks*, (1891) 9 R. P. C. 77; *Chamberlain and Hookham v. Mayor, &c., of Bradford*, (1903) 20 R. P. C. 684.

(*g*) (1863) L. R. 3 Ch. D. 135 n.; L. R. 1 H. L. 337; 35 L. J. Ch. 852.

(*h*) (1860) 8 H. L. C. 550.

(*i*) (1892) 9 R. P. C. 77.

(*j*) (1893) 12 R. P. C. 455. The rule in *Curtis v. Platt* was also applied in the following cases: *Bovill v. Pimm*, (1856) 11 Exch. 718; *British Tanning Co. v. Groth*, (1891) 8 R. P. C. 113; *Jahneke v. Bell*, (1892) 9 R. P. C. 94; *Nettlefolds v. Reynolds*, (1892) 9 R. P. C. 270; *Parkinson v. Simon*, (1894) 11 R. P. C. 238, 493; *Ticket Punch Register Co. v. Colley's Patents*, (1894) 12 R. P. C. 1, 171; *Shoe Machinery Co. v. Cutlan (No. 2)*, (1896) 13 R. P. C. 141; *Cleaver v. Wallwork*, (1896) 13 R. P. C. 277; *Birch v. Harrap* (1896)

13 R. P. C. 615; *Scott v. Hamling*, (1897) 14 R. P. C. 123; *Scott v. Hull Steam Fishing and Ice Co.*, (1897) 14 R. P. C. 143; *Brooks v. Lamplugh*, (1898) 16 R. P. C. 41; *Bailey v. Airey*, (1905) 22 R. P. C. 461; 23 R. P. C. 277.

(*k*) (1903) 20 R. P. C. 684.

(*l*) (1903) 20 R. P. C. 790.

(*m*) (1887) L. R. 36 Ch. D. 740; 4 R. P. C. 333.

(*n*) (1890) 7 R. P. C. 325. The rule in *Proctor v. Bennis* was held to apply in *Gosnell v. Bishop*, (1887) 5 R. P. C. 41, 151; *Peckover v. Rowland*, (1893) 118, 234; *Jardine v. King, Mendham & Co.*, (1896) 13 R. P. C. 411; *Presto Gear Case and Component's Co. v. Simplex Gear Case Co.*, (1898) 15 R. P. C. 635; *Presto Gear Case and Component's Co. v. Orm, Evans & Co.*, (1900) 17 R. P. C. 218; 18 R. P. C. 17.

(*o*) (1863) L. R. 3 Ch. D. 135 n.; L. R. 1 H. L. 337; 35 L. J. Ch. 852.

(*p*) (1860) 8 H. L. C. 550.

which he has claimed for effecting the object he had in view; and if he says it is to be done in one precise and particular way, to that precise and particular way he must be held, and those who have *bonâ fide* employed a different system and a different way must not be held to have infringed.

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ment.

Lord *Hatherley*, then *Page Wood*, V.C., stated the law thus—

“Where the thing is wholly novel and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machines for effecting the same object to see whether or not they are merely colourable contrivances for evading that which has been done before. When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before has the right to extend very largely the interpretation of those means which he has adopted for carrying it into effect.” (q)

Lord *Westbury*, L.C., stated the law thus—

“The mechanism that Mr. *Wain* [the patentee] describes is the proximate means of making the clutch-box operate for the purpose of making a break in the rotation of the shaft, it is, therefore, nothing more than a particular means for effecting a given result. That being so, I cannot but think that in patents of that description the doctrine of mechanical equivalents is not by any means applicable. The thing itself is nothing more than a particular agent for attaining a certain end, and if Mr. *Wain* was entitled to a patent for the particular agency by which he effected in a more convenient manner the opening and shutting of the clutch-box, any person is, on the same principle, entitled to a patent for the means of effecting the same result, provided those means are not a colourable evasion of Mr. *Wain*'s patent, or provided those means do not embody Mr. *Wain*'s patent with an improvement.” (r)

It has wrongly been alleged that *Curtis v. Platt* laid down the principle that, when an invention is claimed for improvements in machinery consisting only in combination, the patentee must be held to the description which he gives of the particular means by which his invention is to be carried

(q) L. R. 3 Ch. D. 136 n.

(r) L. R. 3 Ch. D. 138, 139 n.

Infringe-
ment.

into effect, and that there can be no infringement by the substitution of parts. What *Curtis v. Platt* really lays down is, "that where there is no novelty in the result, and where the machine is not a new one, but the claim is only for improvements in a known machine for producing a known result, the patentee must be tied down strictly to the invention which he claims and the mode which he points out of effecting the improvement." (s) Or, to put it in another way, where at the date of the patent there were other known combinations of elements equivalent to the elements of the patentee's combination, and the real invention is neither more nor less than the substitution of a combination of elements for and mechanically equivalent to the elements of the mechanism previously known and used to attain the same end as the patentee's combination attains, the patentee is not in a position to take benefit from the principle of mechanical equivalents. In such circumstances there can be no infringement unless the apparatus complained of is in substance identical with the combination claimed by the patentee. (t) Consequently under such circumstances a claim for a particular means to effect certain purposes is not infringed where the same purposes are effected by different means; (u) nor is a combination to effect certain results infringed by a combination of similar parts operating in a different manner, though the results effected are the same; (v) but the claim is infringed when a variation in detail which amounts only to a colourable imitation is used. (w) When there is not only novelty in the machine, but also novelty in the result it produces, *Curtis v. Platt* does not apply. (x)

Proctor v.
Bennis.

In *Proctor v. Bennis* (y) the patent in question related to a new combination of tappets, shafts and springs in connection

(s) Per Cotton, L.J., *Proctor v. Bennis*, (1887) L. R. 36 Ch. D. 756, 757; see also *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 437; *Boyd v. Horrocks*, (1889) 6 R. P. C. 152, 558; *Thomson v. Moore*, (1889) 6 R. P. C. 426; *Brown v. Jackson*, (1895) 12 R. P. C. 324.

(t) *Miller v. Clyde Bridge Steel Co.*, (1891) 8 R. P. C. 198; 9 R. P. C. 470, 478; *Gosnell v. Bishop*, (1888) 5 R. P. C. 159, judgment of Bowen, L.J.

(u) *Sugg v. Bray*, (1885) 2 R. P. C. 233-39; 19 R. P. C. 285; *Crocker v. Aerators, Ltd.*, (1903) 20 R. P. C. 621; p. 355 *ante*.

(v) *Lawrence v. Perry*, (1885) 2 R. P. C. 179, 188; *Boyd v. Horrocks*, (1889) 6

R. P. C. 152; 9 R. P. C. 77; *Automatic Weighing Co. v. Knight*, (1889) 6 R. P. C. 113, 297.

(w) See per Westbury, L.C., p. 357 *ante*; *Boyd v. Horrocks*, (1888-91) 5 R. P. C. 557; 6 R. P. C. 152.

(x) Per Cotton, L.J., *Proctor v. Bennis*, (1887) L. R. 36 Ch. D. 756, 757; see also *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 437; *Boyd v. Horrocks*, (1889) 6 R. P. C. 152, 558; *Thomson v. Moore*, (1889) 6 R. P. C. 426; *Brown v. Jackson*, (1895) 12 R. P. C. 324; *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 113.

(y) (1887) 4 R. P. C. 333; L. R. 36 Ch. D. 749.

with a flap or door, producing a new kind of mechanical intermittent radial stoker for distributing coal on the fires of furnaces. The novel feature and underlying principle of this machine as compared with others was that in it the result of throwing coal on to the furnace by the intermittent radial action of a flap or door was for the first time applied. There was thus not only novelty in the machine, but there was novelty in the effect and the result produced. The defendant did not copy exactly the plaintiff's machine; on the contrary, the defendant's combination looked at first sight very different to the plaintiff's. What the defendant really did was to omit certain parts from the patented combination and to substitute mechanical equivalents for other parts, at the same time retaining the novel underlying principle of intermittent radial action. Therefore, although the defendant had not got the exact combination, yet he had got the combination in substance and result by adopting the underlying principle and putting mere mechanical equivalents for those things which were specifically mentioned in the plaintiff's specification.

The Court of Appeal held that, notwithstanding the substitution of the equivalents above referred to for analogous parts in the plaintiff's combination as specified, the defendant infringed because he had adopted the substance of the plaintiff's patented invention, which was the employment of the novel principle of intermittent radial action of the flap or door in the machine, and not the less so though he had added certain further improvements. *Cotton, L.J.*, (z) referring to *Curtis v. Platt*, (a) and distinguishing that case from the present, in his judgment said—

“The plaintiff there was a patentee or the assignee of a patent for improvements in spinning mules. A spinning mule was a well-known machine, working and acting long before the patent on which the plaintiff in that case relied was taken out, and it was necessary in such a machine that there should be an intermission of the action of certain parts, although the motive power was still acting on the machine as a whole. That result had been produced before the patent in question by, amongst other means, the patent of *Roberts* and the patent of *Lakin* and *Rhodes*, and they had done it by adopting certain mechanical means. What the patentee whose patent was relied on by the

(z) 4 R. P. C. 355.

(a) (1866) L. R. 3 Ch. D. 135 n.; 35 L. J. Ch. 852.

Infringe-
ment.

plaintiff did was to correct and improve the means which they described in their patents for the purpose of obtaining that result; and that, therefore, is a most material matter, because I find at page 857 of the 35 L. J. Ch., where the specification of the patent is set out, that what the patentee claimed was 'the novel construction, combination, and application of mechanism as hereinbefore described, whereby one half of the clutch or catch-box hereinbefore, and in the said specification of *Robert Lakin* and *William Henry Rhodes* described, or any mechanical equivalent therefor, is connected with and acts upon the cams or other similar parts of mechanism for effecting the changes in the action of the mule.' So that there he refers to that previous patent, and I think he also had done so with reference to the previous patent of the other patentee which I have mentioned. It was specially to introduce improvements into the mechanical means and arrangements which a previous patentee had used to obtain a well-known object in a well-known machine. Therefore, in that case, in applying those words used by the Judges we must deal with the case before them and must come to the conclusion, as I do, that what they meant was this, that where there is no novelty in the result, where neither the machine nor the result is new, there you must tie down the patentee, who claims an improvement in the machinery for producing in a known machine that result, strictly to the invention which he claims, and the mode of effecting the improvement which he says is his invention. But here the throwing coal on to the furnace by the intermittent radial action of a flap or door was new, and nothing of the kind had been done before. It is true there had been previous, though imperfect, machines for feeding furnaces automatically, but that had not been done previous to this machine by any intermittent radial action of a flap or door as was done by the plaintiff, and apparently successfully done by him. In my opinion, therefore, these opinions expressed by the Judges with reference to mere improvements in an old machine for an old purpose cannot lay down any law for a case like this, where the result of throwing coal on to the furnace by the intermittent radial action of the flap is first applied in a machine invented by the plaintiff. There was not only novelty in the machine, but there was novelty in the effect and in the result to be produced by that machine. In my opinion, therefore, we must come to the conclusion that here the defendant *Bennis*, and also the other defendants, do, in fact, infringe that which is claimed by the plaintiff as his combination, and that so far as that goes the appeal of *Bennis* fails."

Tweedale's in-
vention and
Everitt's in-

The history of the litigation in connection with *Tweedale's* invention, which related to cotton and wool carding and

consisted in improvements in flats and fasteners for securing the carding cloth thereon and thereto; and also *Everitt's* invention of the so-called penny-in-the-slot or coin-freed weighing apparatus, afford good illustrations of the application of the principles of *Curtis v. Platt* and *Proctor v. Bennis* respectively.

Infringe-
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vention as
illustrating the
application of
the doctrines
of *Curtis v.*
Platt and Proc-
tor v. Bennis
respectively.

History of the
litigation in
connection
with
Tweedale's
invention.

Tweedale's invention of "improvements in flats and fasteners for securing the card clothing thereon and thereto" was merely a new mechanical mode of obtaining an old result, *i.e.*, stretching evenly and fastening a carding cloth or fillet on the flat, and did not involve a question of principle. The claim, properly construed, was for the mode of achieving the result and the thing described. As pointed out by Lord *Watson*, the plain object of the invention was to substitute better mechanical equivalents for those already known and used as a means to the same end. (b) Consequently the rule in *Curtis v. Platt* (c) governed the question of infringement, and the doctrine of substitution of mechanical equivalents did not apply. Though *Tweedale's* invention was useful, ingenious, and meritorious, the claim was not infringed by another means of attaining the same result, the details of which were different. The new means adopted by *Tweedale* to attain the old result were thus described by Lord *Watson* (d) in the House of Lords: "The 'flat' consists of a straight bar of solid metal, to the surface of which there is attached a wire brush. What in ordinary language would be described as the back of the brush is of elastic material, and is technically termed its foundation. For the efficiency of the carding machine it is necessary that the surface of the brush shall be perfectly level, and shall remain so in course of working. The attainment of that result has been found in practice to depend mainly, if not wholly, upon the manner in which the foundation of the brush is fastened to the bar of metal upon which it rests. At the date of the patent there appears to have been only two known modes of attachment. The foundation was placed upon the bar, and its edges fastened to the bar either by a series of rivets about half an inch apart, or by substituting a wire thread, with stitches of that length, for the rivets. Both the methods were liable to the same defects. In attaching it to the bar the foundation was apt to

(b) *Tweedale v. Ashworth*, (1892) 9 R. P. C. 129; (1900) 17 R. P. C. 625.
(c) (1886) L. R. 3 Ch. D. 135 n.; 35

L. J. Ch. 852; pp. 355-356 *ante*.
(d) *Tweedale v. Ashworth*, (1892) 9 R. P. C. 128.

Infringe-
ment.

become puckered, thereby causing inequalities in the surface of the brush; and in working the exposed edges of the foundation became frayed, and caused an accumulation of waste from the material carded. The patentee's invention obviated these defects by introducing a different mode of fastening the foundation of the brush to the bar. The fasteners which he employed were thin strips of metal, one for each side of the bar. One edge of each strip was moulded so as to grip firmly the outer edge of the foundation, independently of the bar; the other edge of the strip was moulded so as to fit and grip a ridge cast upon the back of the bar. After a strip was attached to each edge of the foundation, the bar was inserted, producing a degree of tension which made the foundation adhere to it flatly and evenly, and then the other edges of the strips were made to grip the ridges cast on the other side of the bar, the result being that the surface of the brush was made and kept uniformly level, and that the edges of the foundation were, by the encasing metal, protected from fraying and becoming a receptacle for waste."

In *Tweedale v. Ashworth* (e) it appeared that the alleged infringer attained the old result, *i.e.*, secured the carding cloth to the "flat" in the following manner: By a long strip of metal he clasped one side of the fillet to the bar, and then, by a steel comb operating like a carpet stretcher, he stretched the elastic material of the fillet to the other side, and then clamped this other side of the fillet to the bar by a long strip of metal, precisely as he had already clamped the first side of the fillet and bar together. The stretching was thus produced by external mechanical means. This different means was held by the Court of first instance, the Court of Appeal, and the House of Lords to be no infringement of the means claimed by the patentee, which necessarily involved as one of the merits of the invention the power of stretching the material of the fillet at the same time and by the same operation as completed the machine. An essential feature of the patentee's invention was the gripping the edges of the fillet independently of the bar; and, as stated in the specification, it was evident that the forms of the edges of the bar and of the bent portions of the strips might be varied, so long as it is provided that one edge of each strip secures a firm grip upon the foundation of the fillet, and the other edge secures a tight grip upon the under portion of the bar.

(e) (1890) 7 R. P. C. 426; 8 R. P. C. 49; 9 R. P. C. 121.

In *Tweeddale v. Ashworth* (No. 2), (*f*) in the form there complained of the defendant fixed teeth in the top of the fastener, which, as in the above case, was a long strip of metal, but, as in the above case, the stretching was done by the external means of a steel comb operating like a carpet-stretcher, and the strip did not "grip" the edge or selvage of the foundation, neither did the insertion of the bar effect a stretching. Under these circumstances it was held by all the Courts that there was no infringement. The higher Courts, however, did not adopt the view of the Judge of first instance that the defendant's production was identical with that of the plaintiff, but held there was an all-important and very essential difference.

Infringe-
ment.

In *Tweeddale v. Howard and Bullough*, (*g*) which was intermediate in date between the two cases above referred to, the infringers there slightly varied the form of the parts employed, but attained the result by a "colourable imitation" of the patentee's invention, in that they obtain a sufficient grip of the fillet independently of, and before, the insertion of the bar, which grip was increased when the strip was clamped upon the bar, and the insertion of the bar effected the desired stretching. The following *résumé* of the evidence (*h*) shows the variations in form adopted by the infringers. The defendants' fastener was a continuous strip of metal bent horizontally at the top and bottom, so that it firmly fixed the foundation of the clothing to the bar. There was no longitudinal rib, as in *Tweeddale's*, under the bar, but the under side of the bar was bevelled for some distance in a slightly slanting upward direction, so as to admit of the fasteners being applied firmly. The top part of the strip had a distinct curl, by which it got a direct grip of the foundation, and the pressure applied to fix on the bar increased the curl, so that when the end of this part of the strip penetrated the foundation and was clinched, it got an adequate hold of the foundation, which was necessary for stretching purposes. The foundation was stretched by forcing in the bar. Thus the defendants attained the same end by substantially the same means, and the Court held that they had infringed, since the means used by them were only "colourable" variations of the patentee's means, and not mechanical equivalents for the parts specified by him and claimed in combination.

(*f*) (1899) 16 R. P. C. 145, 520; 17 R. P. C. 620.
(*g*) (1896) 13 R. P. C. 522. (*h*) 13 R. P. C. 532.

Infringe-
ment.

History of the
litigation in
connection
with Everitt's
invention.

Everitt's invention of the automatic weighing machine consisted essentially in a contrivance by which he set the indicating apparatus in motion by means of a penny placed in the slot. The patentee was clearly not entitled to a patent for this principle apart from the method in which it was carried out as disclosed by the specification; and especially the patentee was not entitled to protection for every mode of operating upon every conceivable indicating apparatus by means of a penny. (i) The essential elements in *Everitt's* invention are three, viz.: (a) a weighing apparatus, (b) an indicating apparatus, and (c) a break, or want of continuity between the two, together with a contrivance by means of which the indicating apparatus, broken from the weighing apparatus, is, by a penny placed in the slot, set at work in such a way that the indicator will stop at a point fixed by the weighing apparatus itself, or by a stop upon it, and the index does not operate to show the weight on the dial till the coin is inserted. (j)

Everitt's invention produced the first machine of its class, which operated by the utilisation of the principle above described, and therefore the rule in *Proctor v. Bennis* (k) applied as to the infringement of the claim by the use of mechanical equivalents.

The first reported case relating to an infringement of *Everitt's Patent* was *Automatic Weighing Machine Co. v. Knight*, (l) and both the Judge of first instance and the Court of Appeal held that no infringement had been committed, because the essential features of the patentee's apparatus were not reproduced by the substitution of equivalents, or otherwise in the alleged infringing machine. The defendant's apparatus in this case differed from the patentee's in that it had a stop which prevented the machine being set in operation till a coin was put in the slot and raised a lever, thereby allowing a handle to be moved by the person being weighed, and the machine so to be set in operation; this was in effect equivalent to putting a lock on the machine, and so, though both machines attained the same result by the operation of the coin, the defendant's by the intervention of a different principle did it in a different way to that protected by the claim of the patent.

(i) p. 45 ante.

(j) *Automatic Weighing Machine Co. v. National Exhibitions Association, Ltd.*, (1891) 9 R. P. C. 44, 45.

(k) (1888) 4 R. P. C. 333; L. R. 36 Ch. D. 740.

(l) (1889) 6 R. P. C. 297.

Then in *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, (m) it was also held that there was no infringement, where in the defendant's apparatus the coin was first introduced through the slot, and so placed in position that, on an outside knob being pushed by the person being weighed, the coin was moved and made to operate on the lever, which, so to speak, unlocked and set the weighing apparatus in action.

Infringe-
ment.

These cases were followed by *Automatic Weighing Machine Co. v. National Exhibition's Association, Ltd.*, (n) where it was held, both by the Judge of first instance and the Court of Appeal, that what the defendants had done was an infringement of *Everitt's Patent*, since the essential principle of the invention was pirated, though the defendants had most ingeniously attempted to conceal this fact by bringing about the same result by a somewhat different method. They adopted a lever instead of a wheel and axle, and they employed a different indicating apparatus, in which an electric battery was introduced; but these things were nevertheless held to be nothing but equivalents for the things pointed out by the patentee, and the defendants committed an infringement because they made use of the essential principle or substance of the patentee's machine, and gave effect to it merely in a different way by the substitution of mechanical equivalents for the parts which the patentee described.

In *Automatic Weighing Machine Co. v. International Hygienic Society*, (o) which was decided before the last-mentioned case, but did not go to the Court of Appeal, it was held that the defendants had infringed by the use of an indicating mechanism in which the indicating was effected by the removal of two shutters exhibiting the figures denoting the weight on a movable dial, which was a mere mechanical equivalent for the patentee's indicating mechanism where the indicating was effected by the movement of an index on a fixed dial, and there was a break between the weighing and indicating part of the mechanism, though the spindles in the defendants' machine were not on the same axial lines.

Again, in *Automatic Weighing Machine Co. v. Fearby*, (p) the defendant there was held to have infringed by using an apparatus consisting of a weighing apparatus and an indicating apparatus disconnected, in which a coin put in the slot fell

(m) (1889) 6 R. P. C. 367.

(n) (1891) 8 R. P. C. 345; 9 R. P. C. 41.

(o) (1889) 6 R. P. C. 475.

(p) (1893) 10 R. P. C. 443.

Infringe-
ment.

into position by its weight and formed a coupling between an exterior handle and a lever. The handle, when turned by the person being weighed, moved a lever, which drew down one arm and released a catch which set free the indicating mechanism and allowed it to fall down by its weight on the weighing mechanism and so indicate the weight.

“Pioneer
patent” and
“pioneer
claim.”

The terms “pioneer patent” and “pioneer claim,” or “master patent” and “master claim,” are sometimes not inaptly used in reference to a claim which, having regard to the state of public knowledge in relation to the art at the date of the patent, is properly construed according to the rule in *Proctor v. Bennis*. (*q*)

Correct appli-
cation of the
doctrine of
infringement
by substitution
is a matter of
difficulty in
some cases.

The doctrine of infringement by substitution is, however, much misunderstood, and, as above indicated, is by no means easy to apply correctly in dealing with many particular cases. It is necessary to consider the step in invention which the patentee has taken, and also the alleged infringement, and to ascertain if, in substance, it is the same. A mechanical equivalent is a mechanical variation, and if the step taken by the patentee is a small one, as in *Curtis v. Platt*, then identity means taking the same or only colourably different mechanical variations. An arrangement may be said to be an equivalent of a part in a particular combination as performing the same function, when the general objects of the patent are referred to; but this is not the proper point of view when the ultimate result attained by the patented combination is an old one. In such case the particular mechanical means used by the patentee for arriving at the old result are to be considered of prime importance, and an arrangement substituted by an alleged infringer for one of the parts of the patented combination is in no sense an equivalent, when it performs a different function (*e.g.*, evidenced by the fact that it necessitates the performance of two operations in lieu of one), notwithstanding that the same result is ultimately attained. (*r*) If the invention is detail, difference in detail can be successfully pleaded by the alleged infringer. If on the other hand the step taken by the patentee is a long one, and he is in fact the

(*q*) pp. 354-356 *ante*; see also *Proctor v. Bennis*, (1888) L. R. 36 Ch. D. 764; *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System, Ltd.*, (1896) 13 R. P. C. 331; *Lambert Co. v. International Phonograph Indestructible Record Co., Ltd.*, (1904) 21 R. P. C. 255; *Brown v. Hastic*, (1904)

21 R. P. C. 445; 22 R. P. C. 85; 23 R. P. C.; *Wallace v. Alexander Jack & Sons, Ltd.*, (1905) 22 R. P. C. 590; *Van Berkel v. Simpson*, (1906) 23 R. P. C. 237.

(*r*) See *Brooks v. Lamplugh*, (1898) 16 R. P. C. 41, 48, 49.

first person to show how some principle which underlies the actual form described by him may be utilised, as in *Proctor v. Bennis*, then all the details in an infringement may be different, and, provided there is substantial identity, which is evidenced by the adoption of the underlying principle, mere difference in detail cannot be pleaded as an excuse. In dealing with the facts of particular cases, great difficulty often arises in reference to what, having regard to the state of public knowledge at the date of the patent, is the true ambit of the claim, *i.e.*, whether it is to be construed according to the rule in *Curtis v. Platt*, (s) or according to the rule in *Proctor v. Bennis*. (t) This difficulty may be illustrated by a consideration of the following cases, which were finally disposed of by the House of Lords, *viz.*, *Boyd v. Horrocks*, (u) *Thomson v. Moore*, (v) *Pneumatic Tyre Co. v. Tubeless Tyre and Capon Heaton, Ltd.*, (y) and *Brooks v. Lamplugh*. (z)

Infringe-
ment.

Illustrations of
the difficulty
in correctly
applying the
doctrine of
infringement
by substitu-
tion.

*Boyd v. Hor-
rocks.*

In *Boyd v. Horrocks* (a) the patentee *Boyd* claimed as his invention not only an entire machine, but also a number of subordinate inventions. The invention comprised various improvements applicable to winding and doubling machinery of the same class or type as that described in various prior specifications. Two of the subordinate claims were alleged to have been infringed by a variation of some of the details referred to by the patentee, and the Court of first instance held that such was the fact. The Court of Appeal, however, overruled this finding, on the ground that the claims in question ought to be construed very narrowly so as to limit them to the specific details mentioned, otherwise, if a sufficiently wide construction were put upon them to cover what the alleged infringer had done, they would also embrace a combination which was old and render the patent void for want of novelty. The House of Lords, on the other hand, on a careful consideration of the language of the specification, came to a different conclusion. Their Lordships held that what was claimed was a definite arrangement of parts producing a definite result as a consequence of the arrangement,

(s) pp. 355-356 *ante*.

(t) *Ibid.*

(u) (1888-91) 5 R. P. C. 557; 6 R. P. C. 152; 9 R. P. C. 77.

(v) (1889-90) 6 R. P. C. 426; 7 R. P. C. 325.

(y) (1897-98) 15 R. P. C. 74, 236; 16 R. P. C. 77; see also *Gormully and Jeffery Manufacturing Co. v. North British Rubber Co.*, (1896) 13 R. P. C.

691; 14 R. P. C. 283; 15 R. P. C. 254; *Aktiebolaget Separator v. Dairy Outfit Co.*, (1897) 14 R. P. C. 473; 15 R. P. C. 327, 334, 335, 338.

(z) (1898) 16 R. P. C. 41.

(a) (1888-91) 5 R. P. C. 557; 6 R. P. C. 152; 9 R. P. C. 77; see also *British United Shoe Machinery Co. v. Thompson*, (1904) 22 R. P. C. 177.

Infringe-
ment.

and was not restricted to the details of the parts employed; and, further, that as the particular arrangement in question was present in the machine used by the infringer, though the details were different, but was absent from the alleged prior anticipating machine, the claims were valid and had been infringed.

Thomson v.
Moore.

In *Thomson v. Moore* (b) the facts relative to the question of infringement were as follows: The plaintiff, now Lord Kelvin, was the patentee of improvements in the mariner's compass. The following were the chief features of the invention: an extremely light card, consisting of a narrow rim of thin paper supported by a thin rim of aluminium on which were marked the cardinal points; the aluminium rim was attached to the central boss, which was also of aluminium, by fine silken filaments in tension; the needles, which were short and light, were arranged in a horizontal plane a little beneath the card and attached to the rim by light silken threads. By this combination three important objects were obtained, viz., (1) diminution of friction, resulting in increased sensitiveness and accuracy; (2) small magnetic moment, and consequent amenability to *Airey's* correctors; (3) long vibration period, the magnetic moment being small and a comparatively large proportion of the weight of the card being thrown to the periphery, securing steadiness in stormy weather.

The defendant constructed and sold a card resembling the plaintiff's in the three features of (1) extreme lightness; (2) smallness of needles and magnetic moment; and (3) length of vibrational period and consequent steadiness in virtue of the greater part of the weight being thrown to the periphery. The construction of the defendant's card differed from the plaintiff's in that (a) the circumference consisted of an L-shaped aluminium ring instead of a thin rim; (b) the rim was connected to the boss by flat parallel strips of aluminium instead of silken threads in tension; (c) the short and light needles were arranged in vertical pairs some distance below the card, and were attached to it by aluminium wires instead of silk threads. The same combination of results attended the defendant's combination as were the consequence of the plaintiff's combination—viz., diminution of frictional error, steadiness and amenability to correctors. The defendant contended that his arrangement of the needles was specially adapted to his own patented correctors.

(b) (1889) 6 R. P. C. 426; 7 R. P. C. 325.

The case first came before the Irish Master of the Rolls and the result of his Lordship's view of the effect of the evidence as to the state of public knowledge at the date of the patent was, that the patent being for a new means of attaining a well-known object—viz., to produce a compass-card, which would be steady and true under all circumstances—it was the case of a combination of known mechanical means for effecting a known improvement in an old machine, and that the doctrine of mechanical equivalents did not apply, and further that the defendant's card not being the same in substance as the plaintiff's there was no infringement. The plaintiff thereupon appealed, and the Court of Appeal in Ireland took a different view of the evidence and held that the essence of the plaintiff's invention being so to combine extreme lightness of card with long period of vibration and shortness of needles as to obtain a combination of results not previously obtained, viz., diminution of frictional error, steadiness, and amenability to correction, such a combination amounted to a new result, and the doctrine of mechanical equivalents applied. Further, the question was whether there was a pith and substance underlying the invention; and, if so, had the defendant taken that pith and substance? The Court held that he had done so, since his card attained the same results by substantially the same means, agreeing in essentials with the plaintiff's and differing only in non-essentials, and, consequently, he had infringed. The case ultimately went to the House of Lords, and their Lordships affirmed the decision of the Court of Appeal, and held that the plaintiff had attained a new result—a new instrument—and that the differences between his card and the defendant's were mere colourable differences introduced for the purposes of avoiding the appearance of imitation, and an infringement had been accordingly committed.

Infringe-
ment.

As regards the infringement of chemical patents, the rules which have been discussed chiefly with reference to patents for mechanical contrivances have equal force when the subject-matter of the patent is a chemical process or a chemical compound, both as regards the true way in which to fix the ambit of the claims and to determine the question of infringement by the substitution of equivalents for the parts or ingredients referred to in the specification; (c) but it is well to draw

Chemical pa-
tents and in-
fringement by
substitution of
equivalents.

(c) *Heath v. Unwin*, (1855) 5 H. L. C. 595; as compared with *Incandescent Gas Light Co. v. De Mero Incandescent Gas Light System*, (1896) 13

Infringe-
ment.

attention to the fact that ingredients are not to be considered substantially different merely because they have different chemical names. (*d*) In many cases having reference to chemical patents the rule that there is no infringement in the substitution of an equivalent, which judged by the light of public knowledge at the date of the patent is not known and demonstrably an equivalent of the process or ingredient for which it is substituted, (*e*) is of the utmost importance in arriving at a true conclusion.

Thus, in *Nobel's Explosives Co. v. Anderson*, (*f*) the Court of first instance, the Court of Appeal, and the House of Lords all decided that the claims of the specification were limited to the use of the "soluble" form of nitro-cellulose for the purpose of preparing the explosive compound referred to and that the "insoluble" form was not known to be an equivalent at the date of the patent. The Lord Chancellor (*g*) pointed out that the contention that, though the patentee claimed only the combination of the "soluble" nitro-cellulose with nitro-glycerine, yet an infringement had been committed because all that had been done was that the "insoluble" form had been substituted for the "soluble," and that one chemical equivalent had been substituted for another, had not been made out, and that there was no evidence to show that the two were known to be equivalents at the date of the patent. The evidence was the other way; and the patentee, who obviously had a competent knowledge of the subject, was careful to always stipulate for the use of the "soluble" form. (*h*)

When proportions of the substances used are of the essence of the invention, (*i*) there is no infringement by the use of proportions outside the limits included by the claim. (*k*)

The form (*l*) now used, of all letters patent for inventions, grants to the patentee full power, sole privilege, and authority by himself, his agents, or licensees, to make, use, exercise, and vend the invention, and then forbids the rest of the public

It is no infringement to use proportions of ingredients outside the limits claimed.

Various methods of infringing a patent.

R. P. C. 301, 332, 559, 578; see also *Fabriques de Produits Chimiques de Thau v. Caspers*, (1897) 15 R. P. C. 94.

(*d*) See *Welsbach Incandescent Gas Light Co. v. Daylight Incandescent Mantle Co.*, (1899) 17 R. P. C. 146.

(*e*) p. 353 *ante*.

(*f*) (1894) 11 R. P. C. 115, 519; 12 R. P. C. 164.

(*g*) 12 R. P. C. 167.

(*h*) Other cases in which the infringement of chemical patents by the

use of equivalents was considered are: *Muntz v. Foster*, (1844) 2 W. P. C. 95; *Stevens v. Keating*, (1847) 2 W. P. C. 181; *Hancock v. Moulton*, (1852) *John's Pat. Man.* 6th ed. 254.

(*i*) pp. 338, 340, 341, 343 *ante*.

(*k*) *Maxim-Nordenfelt Guns and Ammunition Co. v. Anderson*, (1897) 14 R. P. C. 371, 671; 15 R. P. C. 421.

(*l*) 46 & 47 Vict. c. 5, 1st Schedule, Form D.

during the continuance of the patent, either directly or indirectly, to make use of or put in practice the invention, or any part of the same, or in any wise to imitate the same, or make, or cause to be made, any addition thereto, or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent or agreement of the patentee in writing under his hand and seal. Consequently, there are several ways in which a patent privilege may be infringed, *i.e.*, by manufacturing or making articles for use or sale by means of the art which is the subject of the patent; or by using, exercising, or putting the art in practice to the prejudice of the patentee in any other way; by making for use or sale, or vending articles made in pursuance of the invention; or by counterfeiting, or imitating the invention in any other way.

Infringe-
ment.

It is an infringement to order an article to be made according to a patented process, for he who causes an article to be made may be said to make it himself. (*m*)

Ordering the construction of a patented article.

But it is not an actionable infringement to make, use, or sell a patented invention by or at the instigation of a patentee or his duly authorised agent; (*n*) neither is a person who gives another a licence to work under a patent which infringes the patent of a third person himself an infringer of that patent. (*o*)

Use of patented invention at the instigation of the patentee.

What the public is by the patent prohibited from doing is to exercise the art which is the subject of the grant. In the case of making an article without proof of sale, the fact that the defendant has not sold the article manufactured according to the patent, and therefore not derived pecuniary profit, does not prove that he has not exercised the art, though it does show that the plaintiff has not suffered any substantial loss, and it is, therefore, an argument in mitigation of damages.

When the patent is for a combination of various parts, each of which is in itself old, the manufacture and sale in this country of those parts is no infringement, nor is the exportation of them with the intention of putting them together abroad, for the single parts do not make the patented combination, and the making of them is in itself lawful. (*p*) Nor is it any infringement to manufacture or sell an article which

Manufacture and sale of the separate parts of a patented combination.

(*m*) *Gibson v. Brand*, (1842) 1 W. P. C. 631.

(*n*) *Kelly v. Batchelor*, (1893) 10 R. P. C. 289.

(*o*) *Montgomerie v. Paterson*, (1894) 11 R. P. C. 221, 633.

(*p*) See *Goucher v. Clayton*, (1865) 11 Jur. N. S. 462; *M'Cormick v. Gray*, (1861) 7 H. & N. 25; *Dunlop Pneumatic Tyre Co. v. David Moseley & Sons*, (1904) 21 R. P. C. 53, 274.

Infringe-
ment.

may be used for the purpose of infringing a patent, whether in ignorance of the patent, (q) or even though the person manufacturing and selling it actually knows that it will be used for purposes of infringement, or intends that it shall be so used. (r) If, however, upon the facts of a particular case, the person knowing that it will be used for the purpose of infringement sells an article and also constitutes the person who actually uses it in infringement his agent for that purpose, then the vendor is liable as an infringer, for he, indirectly at any rate, puts the invention in practice contrary to the prohibition in the grant. (s)

If the circumstances were such that the vendor of a part could be truly said to be a person inciting and procuring another to commit an infringement, an action on the case would probably lie, and an injunction could be obtained against the continuance of such conduct. This point has not yet been discussed in relation to a patent case. There is authority for supposing that an action on the case would lie, and a patentee could obtain the relief above indicated for the reason that the vendor was a person who knowingly and for his own ends procured the violation of the patentee's rights which violation was an actionable wrong. (t)

In *Innes v. Short* (u) the Court restrained the sale of zinc dust in conjunction with an invitation to use it in infringement of a patent for a method of preventing corrosion and incrustation in steam boilers. The alleged invitation consisted merely in printed instructions for use supplied with each patent of the zinc dust. It is submitted that the injunction was wrongly granted, because no complaint could be made in the case of a purchaser who was a licensee of the patentee, or a person having no intention to use the zinc dust for boilers without obtaining the licence of the patentee. The sale of the zinc dust by the defendant was *per se* lawful, and the doctrine *omnia præsumuntur rite et solenniter esse acta* should have been applied in his favour.

(q) *Savage v. Brindle*, (1896) 13 R. P. C. 267.

(r) *Townsend v. Haworth*, (1875) 48 L. J. Ch. N. S. 770; 12 Ch. D. 831 n.; *Sykes v. Hawarth*, (1878) L. R. 12 Ch. D. 826; 48 L. J. Ch. 769; *Dunlop Pneumatic Tyre Co. v. David Moseley & Sons*, (1903) 21 R. P. C. 53, 274; *Incandescent Gas Light Co. v. New Incandescent Gas Mantle Co.*, (1897)

15 R. P. C. 83, 84.

(s) See *Sykes v. Howarth*, (1879) L. R. 12 Ch. D. 826, 831 n., 832; 48 L. J. Ch. N. S. 773.

(t) See *Lumley v. Gye*, (1853) 2 E. & B. 216; see also *Allen v. Flood*, [1898] A. C. 495, judgment of Lord Watson, 96, 106, 107; *Quinn v. Leatham*, [1901] A. C. 495.

(u) (1898) 15 R. P. C. 449.

In *Incandescent Gas Light Co. v. New Incandescent Gas Mantle Co.* (x) a defendant who sold an unpatented article, which could not be used in conjunction with another and patented article without the licence of the patentee, was restrained from infringing the patent. It appeared the defendant *Tossel* sold the article in question in the lower story of a building whilst his confederate and co-defendant sold the infringing article in an upper story of the same building, and, further, that *Tossel* had in his window for exhibition purposes some specimens of the infringing article. (y)

Infringe-
ment.

Defendants have been committed for breach of injunctions restraining the sale of complete machines where the breaches alleged consisted in the sale of *all* the component parts in such a way that they could easily be put together by any one. (z) Probably a defendant would be restrained if he were party to an infringement in such sense that he would be a principle in the first or second degree if infringement were an indictable offence. (a)

It has been held to be an infringement of a combination patent to restore instruments by renewing parts which were essential to the combination. (b)

Restoration of
a patented
instrument.

The mere making of articles for the purpose of sale or use, and not by way of *bonâ fide* experiment, (c) is an infringement, although no actual sale or use has taken place; (d) but there is no infringement unless a saleable article is produced; (e) though the thing constructed may infringe without being separately prepared and saleable, as in the case of fitting a ship for the reception and laying of a telegraph cable. (f)

Infringement
by manufac-
ture without
actual sale.

It is no actionable invasion of a patentee's rights for another person to use the invention, and thereby produce the finished product by way of *bonâ fide* experiment or amusement, without the intention of selling or making use of the

Use by way of
bonâ fide ex-
periment is no
infringement.

(x) (1897) 15 R. P. C. 83.

(y) See 15 R. P. C. 83.

(z) *United Telephone Co. v. Dalo*, (1883) L. R. 25 Ch. D. 773; *E. M. Bowden's Patents Syndicate v. Wilson*, (1903) 20 R. P. C. 644.

(a) See *Dunlop Pneumatic Tyre Co. v. David Moseley & Sons*, (1901) 21 R. P. C. 280.

(b) *United Telephone Co. v. Neilson*, W. N. (1887) 193; see also *Dunlop Pneumatic Tyre Co. v. Neal*, (1899) 16 R. P. C. 247; *Dunlop Pneumatic Tyre Co. v. Wilson*, (1900) 17

R. P. C. 332; *Dunlop Pneumatic Tyre Co. v. Excelsior Tyre, & Co.*, (1901) 18 R. P. C. 209; *Dunlop Pneumatic Tyre Co. v. Holborn Tyre Co.*, (1901) 18 R. P. C. 222.

(c) See *infra*.

(d) *Muntz v. Foster*, (1814) 2 W. P. C. 101; *Jones v. Pearce*, (1832) 1 W. P. C. 125.

(e) *Higgs v. Goodwin*, (1858) E. B. & F. 529; 27 L. J. Q. B. 421.

(f) *Newall v. Elliot*, (1863) 10 Jur. N. S. 954.

Infringe-
ment.

thing so made for the purpose for which the patent was granted, but with the view merely of improving upon the invention the subject of the patent, or with the view of seeing whether an improvement can be made. (g) In the words of *Jessel, M.R.*, (h) "patent rights were never granted to prevent persons of ingenuity exercising their talents in a fair way. But, if there be neither using or vending of the invention for profit, the mere making for the purpose of experiment, and not for a fraudulent purpose, ought not to be considered within the meaning of the prohibition, and, if it were, it is certainly not the subject for an injunction."

Use for advantage is an infringement.

Use of a pirated article for the purpose of making experiments for the instruction of pupils is use for advantage, and an infringement of the patent under which the article was manufactured. (i) Thus, where an English electrician purchased and imported from a foreign manufacturer apparatus made according to an English patent, and maintained that he had only purchased the apparatus for examination and experiment by himself and his pupils, as certain royalty-paid instruments in his possession were too expensive to be taken to pieces, and further insisted that he had never sold, and had never otherwise used the apparatus, the Court held that such use was an infringement, and granted an injunction restraining the continuance of it. (k)

Also where it appeared that certain persons purchased infringing machines upon the understanding that they were not to be paid for unless they proved successful, and the machines in question were used by the defendants in their works for several months, the Vice-Chancellor of the Court of the County Palatine of Lancaster held that such use was not experimental; but the Court of Appeal dissolved the injunction on the ground, however, that supposing the infringement was proved, as the defendants were merely users and not manufacturers and the only infringement was put an end to some considerable time ago and there was no evidence of any intention on their part to continue in the wrongful act, an injunction ought not to have been granted. (l)

(g) *Frearson v. Loe*, (1878) L. R. 9 Ch. D. 48; *Jones v. Pearce*, (1832) 1 W. P. C. 121, 125; *Muntz v. Foster*, (1844) 2 W. P. C. 101; *United Telephone Co. v. Sharples*, (1885) 2 R. P. C. 28; *Proctor v. Bayley*, (1889) 6 R. P. C. 107.

(h) *Frearson v. Loe*, (1878) L. R. 9 Ch. D. 48.

(i) *United Telephone Co. v. Sharples*, (1885) L. R. 29 Ch. D. 164.

(k) *Ibid.*

(l) *Proctor v. Bayley*, (1889) 6 R. P. C. 106, 538.

The *ratio decidendi* of cases which decide that a person may be an infringer, though he has derived no pecuniary profit from his infringement, is that such profit is not a condition precedent to liability, but the condition precedent is actual or probable damage to the patentee arising from the acts complained of.

**Infringe-
ment.**

Pecuniary profit is not a condition precedent to liability.

It is an infringement to sell or use an article which was manufactured according to a patented process, (*m*) or by a patented machine, (*n*) or during the manufacture of which a patented article (though not as such constituting an ingredient of the final product) was used, (*o*) without the licence of the patentee; (*m*) whether the article was made in this country or was imported from abroad, (*p*) or whether the sale was to an English or a foreign customer for shipment abroad, (*q*) or whether the articles were shipped from this country to a foreign country to be sold there, (*r*) makes no difference; and a person who accepts an order for an infringing article and forwards it to another for execution, but receives a commission on the transaction is himself liable as an infringer; (*s*) but, if the article was in the first instance manufactured or sold by an unrestricted licensee of the patentee, it is no infringement for the purchaser to resell it, either within or outside the area comprised by the licence. (*t*) If the article is manufactured abroad and sold and delivered by the manufacturer abroad to the person or his agent who imports it, *e.g.*, by the post into this country, such foreign manufacturer aiding and abetting the importation into this country does not thereby make himself amenable to the jurisdiction of the Court, nor is he an infringer, (*u*) since no material part of the sale was done within the realm. (*v*) In

Unlicensed sale of patented article within the area of the patent is an infringement, notwithstanding the locus of the manufacture.

(*m*) *Wright v. Hitchcock*, (1870) L. R. 5 Ex. 37; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302.

(*n*) *Townsend v. Howarth* (1875) L. R. 12 Ch. D. 831 *n*.

(*o*) *Saccharin Corporation v. Anglo-Continental Chemical Works*, (1900) 17 R. P. C. 307; but see *Saccharin Corporation v. Reitmeyer*, (1900) 17 R. P. C. 611.

(*p*) *Walton v. Lavater*, (1860) 8 C. B. N. S. 162; *Elmslie v. Boursier*, (1869) L. R. 9 Eq. 217; *Von Heyden v. Neustadt*, (1880) L. R. 14 Ch. D. 230; *Société Anonyme des Manufactures de Glaces v. Tilghman's Sand Blast Co.*, (1883) L. R. 25 Ch. D. 1; *Carlsburn Sugar Refining Co. v. Sharp*, (1884) 1 R. P. C. 181; *United Tele-*

phone Co. v. Sharples, (1885) 2 R. P. C. 31; 29 Ch. D. 164; *Saccharin Corporation v. Anglo-Continental Chemical Works*, (1900) 17 R. P. C. 307.

(*q*) *United Telephone Co. v. Sharples*, (1885) 2 R. P. C. 28; L. R. 29 Ch. D. 164, 167; *Lyon v. Goddard*, (1894) 11 R. P. C. 113.

(*r*) *British Motor Syndicate v. John Taylor & Sons*, (1899) 17 R. P. C. 723, 728.

(*s*) *Incandescent Gas Light Co. v. Brogden*, (1899) 16 R. P. C. 179.

(*t*) *Smith v. Buchanan*, 26 S. J. 347; p. 377 *post*.

(*u*) *Badische Anilin und Soda Fabrik v. Johnson*, (1897) 14 R. P. C. 919.

(*v*) *Ibid.*; *British Motor Syndicate*,

Infringe-
ment.

such a case the importer only is the infringer; but if the foreign manufacturer contracts for and, either personally or by means of an agent—*e.g.*, the post or other carrier—makes delivery in this country, he is himself the importer and an infringer. (*y*)

A contract of sale made in this country and followed up by acts such as would, by the law of this country, pass the property in the article to the purchaser is not a vending of the article within the meaning of the letters patent, if the delivery of the article pursuant to the contract does not take place in this country. (*z*) Thus a person who obtains orders on commission in this country for a foreign manufacturer who delivers to an English customer at a foreign port does not thereby import or sell the article in this country, or otherwise make, use, exercise, or vend the invention within the realm so as to make himself liable as an infringer. (*a*)

The *ratio decidendi* of the cases to the effect that the sale in this country of an article made abroad by a machine or process which is patented in this country is an infringement, is that the sale of the article is an indirect use of the invention within the prohibition of the patent. The selling of an article and converting it into money is about the most effectual mode that can be imagined of using the invention whereby it was produced. (*b*) The object of the patent is to give the inventor the profit of his invention; and the most effectual way of defeating that object would be to permit others to derive, from a sale of an article made in infringement of the patent, the profit which it was intended to secure to the patentee. (*c*)

Exposure for
sale.

It has been held that the mere exposure for sale of an article made according to a patent, without actual proof of sale, is not an infringement; (*d*) though, on the other hand, it was held by a Court of first instance that where a defendant had manufactured articles, and his traveller had offered them

Ld. v. John Taylor & Sons, Ltd., (1899) 17 R. P. C. 192. As to liability in the converse case of a transport of a patented article in this country for the purpose of a sale wholly effected abroad see p. 383 *post*.

(*y*) *Badische Anilin und Soda Fabrik v. Johnson*, (1897) 14 R. P. C. 919, 929.

(*z*) See per Stirling, L.J., *Badische Anilin und Soda Fabrik v. Hickson*,

(1905) 22 R. P. C. 580.

(*a*) *Saccharin Corporation, Ltd. v. Roitmeyer*, (1900) 17 R. P. C. 606; *Badische Anilin und Soda Fabrik v. Hickson*, (1905) 22 R. P. C. 575.

(*b*) Per Keating, J., *Walton v. Lavater*, (1860) 8 C. B. N. S. 188.

(*c*) Erle, C.J., *Walton v. Lavater*, (1860) 8 C. B. N. S. 185.

(*d*) *Minter v. Williams*, (1835) 4 A. & E. 251.

for sale, though he had not actually sold any, there had been such a use as to amount to an infringement. (e) Infringe-
ment.

In a recent case in the Court of Appeal the Lords Justices differed as to the truth, in fact, of the above statement, but they were agreed that the principle involved in the latter portion of the paragraph is sound law, viz., that an exposure for sale without actual proof of sale is an actionable infringement. (f)

A mere loan of a patented article, without any intention of selling it or evading the patent, is no infringement. (g) Mere loan.

Any person who purchases an article made under a British or a foreign patent, whether in this country or abroad, which is sold without any restrictions on the buyer, acquires an absolute right to resell it or otherwise deal with it as he pleases, and he is at liberty to sell it in any country where there is a patent in the possession of, and owned by, the vendor. (h) Also a purchaser of a patented article, without notice of an exclusive licence for a limited area, is not affected by the licence, and cannot be restrained from using the machine within the area; (i) but a licence to manufacture an article under a foreign patent in a foreign country does not imply permission to sell or use the article in this country in violation of an English patent. (k) Unrestricted
sale of a pa-
tented article
by the patentee
or his licensee.

An unrestricted licence to manufacture and sell a patent article is an authority to the vendees of the licensee to vend it without the consent of the patentee, and their doing so is no infringement, (l) whether they do so inside or outside the area comprised in the licence; for a purchaser from an unrestricted licensee, whether special or general, acquires the patented article for all purposes, and can exercise every right of ownership in respect of it. (m) Unrestricted
licence to
manufacture
and sell.

It is competent to a patentee to sell, or to license the sale of, a patented article with a restriction that it shall be used only in a certain way. The maxim *cujus est dare ejus est disponere*, is applicable in such a case. If the purchaser has notice of any such restriction, a breach of Restrictions
may be placed
on purchaser
of a patented
article; and
breach of
restrictions
is an infringe-
ment.

(e) *Oxley v. Holden*, (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68.

(f) *British Motor Syndicate v. John Taylor & Sons*, (1900) 17 R. P. C. 723.

(g) *United Telephone Co. v. Henry*, (1885) 2 R. P. C. 11.

(h) *Per Cotton, L.J., Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.*, (1883) L. R. 25 Ch. D. 9; *Betts v. Wilmott*, (1870) L. R. 6 Ch. 239.

(i) *Heap v. Hartley*, (1888) 5 R. P. C. 603.

(k) *Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.*, (1883) L. R. 25 Ch. D. 1.

(l) *Thomas v. Huut*, (1864) 17 C. B. N. S. 183.

(m) *Smith v. Buchanan*, (1882) 26 S. J. 347.

Infringe-
ment.

the restriction will constitute an actionable infringement. Thus, in *Incandescent Gas Light Co. v. Cantelo* (n) it appeared that the plaintiffs' course of business was to sell only through agents, whose dealings were restricted to their respective localities. The defendant employed a friend, who resided within the district of the plaintiffs' London agent, to purchase from that agent certain goods. After these were paid for by his friend, and, at the request of the latter, consigned direct to the defendant in the Isle of Wight, the defendant discovered, on unpacking them, that each box had a notice on it stating that the goods were sold upon condition that they were to be used only in a certain way. The defendant covered up the notices with his own labels, and resold the goods to his customers. His friend when buying never saw the boxes or notices. The Court held that, as there was insufficient notice, there was no infringement under the circumstances; but the learned Judge, *Wills, J.*, stated that, if a purchaser on the sale is cognisant of restrictions put upon the use of the goods, he is bound by them on the principle that "the patentee has the sole right of using and selling the articles, and he may prevent anybody from dealing with them at all. Inasmuch as he has the right to prevent people from using them, or dealing in them at all, he has the right to do the lesser thing—that is to say, to impose his own conditions. It does not matter how unreasonable or how absurd the conditions are. It does not matter what they are if he says at the time when the purchaser proposes to buy, or the person to take a licence, 'Mind, I only give you this licence on this condition,' and the purchaser is free to take it or leave it as he likes. If he takes it, he must be bound by the conditions. It seems to be common sense, and not to depend upon any patent law, or any other particular law." In *Incandescent Gas Light Co. v. Brogden*, (o) *Kennedy, J.*, pointed out that when the purchaser of a patented article has knowledge at the time of purchase that it was sold under a limited licence, it is immaterial whether he purchased from the patentee direct or from a third party, and upon the facts of the case the learned Judge granted an injunction restraining infringement by a purchaser from a licensee in breach of the conditions of a limited licence. The limitations imposed by the patentee upon a licensee probably follow

(n) (1895) 12 R. P. C. 262; see also
Badische Anilin und Soda Fabrik v.

Isler, (1906) 23 R. P. C. 173.
(o) (1899) 16 R. P. C. 179.

the goods, and can be enforced against a purchaser from the licensee without notice. (p) Infringe-
ment.

A restriction imposed by a patentee is quite a different thing to a restriction imposed by a licensee. All the licensee can do is to effect a contract between himself and a purchaser from him; and a subsequent purchaser is not bound by any such contract, even he takes with notice, since there is no privity between him and the original vendor the licensee who has no patent rights. (q) Restrictions
imposed by
licensee.

Upon the above-discussed principle it does not follow that authority from the patentee to construct an article necessarily implies permission to use the article when constructed. (r) Authority to
construct does
not necessarily
imply per-
mission to use
a patented
article.
A person may be at one and the same time both a licensee and an infringer—*c.g.*, he may be a licensee in respect of articles actually paid for, but an infringer in respect of articles not paid for. (s)

When a patentee draws his specification and claims for his invention chiefly with reference to an application of it to a particular purpose, a person who uses the invention cannot escape the consequences of infringement if he uses it in an analogous manner though for a purpose different from that mentioned by the patentee; provided, of course, that the patentee has not distinctly limited his claim to the use of the invention for the first purpose. Thus, where the invention consisted in the adaptation of a machine (which was not subject-matter in itself) to the manufacture of cement for decorative purposes, an analogous adaptation of the machine to the manufacture of concrete blocks for street paving was held to be an infringement. (t) Use for a pur-
pose analogous
to the purpose
specified by
the patentee. So, generally to adopt a combination of machinery, which originally was directed to one purpose, to make it minister to another and additional purpose is an infringement of the patent which first introduced that combination, provided that there is no invention involved in the adaptation. (u)

But where the patentee distinctly limits his claim it is not infringed by a user outside the limitation. Thus, where a patentee distinctly limited his claim to the use of his invention in a process for making manure by chemically treating Claim may be
limited to use
for one parti-
cular purpose.

(p) See *Badische Anilin und Soda Fabrik v. Isler*, (1906) 23 R. P. C. 180, 181.

(q) *McGruther v. Pitcher*, [1904] 2 Ch. 307.

(r) *Basset v. Gradon*, (1897) 14 R. P. C. 701.

(s) *Tweeddale v. Howard and Bul-
lough*, (1896) 13 R. P. C. 529, 531.

(t) *Adamant Stone Paving Co. v.
The Corporation of Liverpool*, (1896)
14 R. P. C. 11, 21.

(u) *Cannington v. Nuttall*, (1871)
L. R. 5 E. & I. App. Cas. 205, 239.

Infringe-
ment.

sewage-water with hydrate of lime, the claim was not infringed by a person who used the process for purifying water only, and did not sell or use any of the precipitated manure. (x) And where the patentee made an invention which could be applied to open-ended pneumatic hammers, but, by his description and claims, he limited his patent to the use of the invention in open-ended hammers, the Court held that the adaptation of the invention to closed-ended hammers was no infringement. (y) Thus a claim for the use of a thing for one purpose is not infringed by the use of the thing for a totally different purpose, requiring different variations in the details of the use of the thing in question. (z)

Use for a pur-
pose totally
different to the
purpose speci-
fied.

Possession
may amount
to an infringe-
ment.

The use of an article which will amount to an infringement of a patent for its production may be either active or passive; (a) and the mere possession of an article made in infringement of a patent, if there is an evident intention to use it, is infringement and sufficient to entitle the patentee to an injunction; (b) and the mere passive exhibition of an unlicensed patented article serving the purpose for which the patentee intends it, even though there is no intention of selling it, amounts to a user which the Court will restrain. (c)

Thus, an injunction was granted to restrain the master of a ship from using an invention for pumps, although he denied having used any pumps which were an infringement of the patent, and did not suggest that the owners ought to be parties. It was shown in evidence that the ship was fitted up exclusively with pumps which were an infringement of the patent, but had been so fitted up before the defendant, who was not a part owner, had command of her, and that he had nothing to do with putting them on board, and they had

(x) *Higgs v. Goodwin*, (1858) E. B. & E. 529; 27 L. J. Q. B. 421; see also *Morewood v. Tupper*, (1885) 3 C. L. R. 718; *Lister v. Eastwood*, (1864) 9 L. T. N. S. 766.

(y) *Pilkington v. Massey*, (1904), 21 R. P. C. 696.

(z) *Preston v. Black*, (1894) 11 R. P. C. 299, 574; *Fletcher v. Glasgow Gas Commissioners*, (1887) 4 R. P. C. 386; *Edison v. Holland*, (1888) 5 R. P. C. 482; *Pilkington v. Massey*, (1904) 21 R. P. C. 696.

(a) *Chldwell v. Van Vlissingen*, (1851) 9 Hare 415; *Betts v. Neilson*, (1868) 3 De G. J. & S. 82.

(b) *Adair v. Young*, (1879) L. R. 12 Ch. D. 13; *Proctor v. Bayley*, (1889)

6 R. P. C. 106; *United Telephone Co. v. London and Globe Telephone and Maintenance Co.*, (1884) 1 R. P. C. 117; L. R. 26 Ch. D. 766; *British Motor Syndicate v. John Taylor & Sons*, (1900) 17 R. P. C. 732; *Dunlop Pneumatic Tyre Co. v. British and Colonial Motor Car Co.*, (1901) 18 R. P. C. 315.

(c) *Dunlop Pneumatic Tyre Co. v. British and Colonial Motor Car Co.*, (1901) 18 R. P. C. 315. As to a foreign corporation carrying on business at a stand in a British exhibition, see *Dunlop Pneumatic Tyre Co. v. Actien Gesellschaft für Motor, &c.*, (1902) 19 R. P. C. 46.

never been worked in British waters. The majority of the Court of Appeal held that the defendant, being in command of a ship exclusively fitted with pumps which were an infringement of the patent, was intending to use the invention. (*d*)

Infringe-
ment.

And where certain defendants, a telephone company, contracted with an American agent for the purchase of a number of telephones, and were supplied accordingly with instruments containing *Blake* transmitters, the subject of both English and American patents, which they kept unused in a warehouse, the Court held that they had infringed the English patent, notwithstanding that they had dismantled the telephones by taking out the *Blake* transmitters, and kept the different parts stored separately. (*e*)

It is no answer to the charge of infringement for the defendant to say that he committed the acts complained of because the plaintiff failed to carry out an agreement whereby the plaintiff undertook to supply him with articles made according to the patent. (*f*)

Breach of con-
tract is no
justification
for an infringe-
ment.

The use of a patented invention in a British ship outside British waters is no infringement of a British patent. This is so notwithstanding the doctrine that a vessel of a country is the territory of that country, because the grant of a British patent is by its terms limited to the United Kingdom of Great Britain and Ireland and the Isle of Man. (*g*) Use within British waters is, of course, use in Britain.

Use in British
vessel.

The use of an invention for the purpose of the navigation of a foreign vessel within the jurisdiction of any of his Majesty's Courts in the United Kingdom or the Isle of Man is by statute no infringement in respect of which the patentee can obtain an injunction. (*h*) Neither is the use of any other invention in a foreign vessel within the jurisdiction of the same Courts, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in, or exported from, the United Kingdom or the Isle of Man. (*i*)

Use of a
patented in-
vention in a
foreign vessel
within the
jurisdiction of
the British
Courts.

The above provisions do not extend to vessels of any foreign State of which the laws authorise subjects of such foreign States, having patents or like privileges for the exclusive use

(*d*) *Adair v. Young*, (1879) L. R. 12 Ch. D. 13.

(*e*) *United Telephone Co. v. London and Globe Telephone and Maintenance Co.*, (1884) 1 R. P. C. 117; L. R. 26 Ch. D. 766.

(*f*) *United Telephone Co. v. Tasker*, (1888) 5 R. P. C. 628.

(*g*) See *Newall v. Elliott*, (1864) 10 Jur. N.S. 958.

(*h*) 46 & 47 Vict. c. 57, s. 43, sub-s. 1.

(*i*) *Ibid.*

Infringe-
ment.

or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign State, or in the waters within the jurisdiction of its Court, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign State. (*k*)

Transshipment
of goods may
be an infringe-
ment.

Transshipment in this country of goods made according to a British patented invention may be such a use as will amount to an infringement of the British patent. Thus, in *Betts v. Neilson*, (*l*) which was an action brought for the infringement of an *English* patent for the manufacture of a combined metal to be (amongst other purposes) applied as capsules to put on bottles, the House of Lords held that the defendant, who resided in *Scotland*, and purchased capsules, made according to the patent, from a foreign manufacturer, and in *Scotland* put them on beer bottles, which he sent to *England* for *transshipment and exportation*, was, by the user of the capsules whilst the beer remained in England, guilty of an infringement of the patent, and this notwithstanding that there was no evidence to show that the beer was sold in England for consumption there.

But in *Varasseur v. Krupp*, (*m*) where it appeared that certain shells made in Germany for the Mikado of Japan, according to an *English* patent, were brought to this country to be placed on board a ship belonging to the Mikado, it was held that the Court could not interfere to prevent him removing the shells. The ground of this decision was that the Court had no jurisdiction to interfere with the property of a foreign Sovereign; otherwise foreigners are subject to the laws of the country in which they happen to be, and if a foreigner in England infringes an English patent he may not only be restrained by the injunction of the Court, but his property may be ordered to be delivered up to the patentee if necessary to protect the patentee's rights under the patent. (*n*)

A person who is merely the Custom House agent of the actual importer is not responsible for infringements. Thus, in *Nobel's Explosives Co. v. Jones, Scott & Co.* (*o*) it appeared that the plaintiffs were the owners of an English patent for

(*k*) 46 & 47 Vict. c. 57, s. 43, sub-s. 2.

(*l*) (1871) L. R. 5 H. L. 1.

(*m*) (1870) L. R. 9 Ch. D. 351.

(*n*) *Caldwell v. Van Vlissingen*,

(1851) 9 Hare, 415; 21 L. J. N. S. Ch. 97; L. R. 9 Ch. D. 351; see p. 391 *post*.

(*o*) (1882) L. R. 8 App. Cas. 5.

an invention for rendering nitro-glycerine less dangerous, and that certain foreigners imported into England an article compounded of nitro-glycerine and other substances, which they had manufactured abroad according to the patent, and the respondents, acting as Custom House agents for the importers, passed the article through the Custom House, and obtained permission (*p*) to land and store it in magazines belonging to the importers. The House of Lords held, affirming the decision of the Court of Appeal, that the respondents being only Custom House agents for the importers and not themselves the importers and having neither possession of nor control over the goods, their acts did not amount to an exercise or use of the patent, and that no action could be maintained against them for infringement.

Infringe-
ment.

Transport of patented articles in this country for the purpose of sending them abroad for sale abroad may, upon the facts of a particular case, be, if not a use of the patented invention, at any rate, such an indirect use of it within the meaning of the prohibition part of the grant as will constitute an infringement. (*q*)

Every patent is dated and sealed as of the day of the application, but no proceedings can be taken in respect of an infringement committed before the publication of the complete specification; (*r*) and after the acceptance of a complete specification until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, an applicant has the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification, but he is not entitled to institute any proceedings for infringement unless and until a patent has been granted to him. (*s*) Consequently, until the patent is actually granted, no proceedings in respect of infringements can be taken at all, nor even then, in respect of any committed before the acceptance of the complete specification; (*t*) but, in an action brought subsequently to the grant of the patent, relief may be obtained in respect of infringements committed during the interval between the acceptance of the complete specification and the actual date of the grant as well as in respect of infringements committed since the grant.

Unauthorised
use of an in-
vention prior
to the sealing
of a patent.

(*p*) As required by the Explosives Act, 1875.

(*q*) *British Motor Syndicate, Ltd. v. John Taylor & Sons, Ltd.*, (1900) 17 R. P. C. 189, 730; *Badische Anilin und*

Soda Fabrik v. Johnson, [1898] A. C. 200; 14 R. P. C. 929, 930.

(*r*) 46 & 47 Vict. c. 57, s. 13.

(*s*) *Ibid.* s. 15.

(*t*) *Ibid.* s. 10.

**Infringe-
ment.**

Infringement committed in the interval between a decision adverse to the validity of the patent and its reversal on appeal.

If a patentee brings an action for infringement against any member of the public, it is open to the defendant to give evidence showing that the patent is invalid; (u) and, if the Court be of opinion that such is the case, a declaration of invalidity will be the result; also it is open to any member of the public, either of right or on obtaining the sanction of the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, to obtain a declaration of invalidity on presentation of a petition to the Court. (x) The patentee has the right to appeal to the Court of Appeal and the House of Lords from the decision of the Court of first instance declaring the patent void either in an action for infringement or upon a petition for revocation, and the adverse decision may be reversed. It is submitted that any act done by a member of the public during the interval between a decision of the Court of first instance adverse to the patent and its reversal on appeal, which would be an infringement had the patent not been declared void, is, in fact, an infringement which entitles the patentee to damages or an account, because the decision of the Court of Appeal or House of Lords, as the case may be, gives validity to the patent *ab initio*; but it is further submitted that if the defendant could show that what he did was done in reliance on the former decision the plaintiff would only be entitled to nominal damages. (y)

Threatened
infringements.

A patentee can sustain an action in respect of a threatened infringement of his patent, even though no actual infringement has taken place, for if a person threatens to do an act amounting to an infringement it is sufficient to found an action for an injunction. (z) The mere offer, however, to supply an article for the production of which there is an existent patent, which does not lay claim to the production of every kind of such article, in the absence of evidence of positive infringement, is not sufficient to support an application for an injunction. (a)

(u) p. 401 *post*.

(x) p. 293 *ante*.

(y) *Arkwright v. Nightingale*, (1785) 1 W. P. C. 60; *Deeley v. Perkes*, (1896) 13 R. P. C. 587.

(z) *Frearson v. Loe*, (1878) L. R. 9 Ch. D. 48, 65; *Dowling v. Billington*, (1890) 7 R. P. C. 191; *Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 357; *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light*

System, (1896) 13 R. P. C. 301, 559; *Incandescent Gas Light Co. v. Sunlight Incandescent Gas Lamp Co.*, (1896) 13 R. P. C. 333; *Castner-Kellner Alkali Corporation, Ltd. v. Commercial Development Corporation, Ltd.*, (1899) 16 R. P. C. 262; p. 399 *post*.

(a) *Gwynne v. Drysdale*, (1885) 2 R. P. C. 160; 3 R. P. C. 65.

PROCEEDINGS BEFORE COMMENCEMENT OF ACTION.

Proceedings
before
Action.

When a patentee becomes aware of the fact that several persons are infringing his patent he is in a somewhat awkward position, for he cannot join all the infringers as defendants in one action; (b) and, if he issues separate writs simultaneously against all the infringers, he will have to uphold the validity of his patent in several distinct proceedings, in each of which he may have to meet different objections, and further he may be guilty of the charge of oppressive litigation. On the other hand, if he singles out one infringer and establishes his patent against him first, as regards the others they are not bound by the decision in the first action, and may raise the question of validity anew; and the conduct of the plaintiff may be construed by the Court to amount to laches, and so disentitle him to interlocutory injunctions against the other infringers, to which, having previously established the validity of the patent, he would have been entitled had he commenced action against them earlier. (c) In such a state of circumstances the proper course for a patentee to pursue is that suggested by Lord Hatherley, then Vice-Chancellor *Page Wood*, (d) viz., after getting information of case after case of infringement to select that which he thinks the best, in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction. At the same time, he should write to all the others who are *in simili casu*, and say to them: "Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise I shall proceed against you by way of interlocutory injunction, and if you will not object on the ground of delay, I do not mean to file bills against all of you at once. Am I to understand that you make no objection of that kind? If you do not object I shall file a bill against only one of you."

Proper course
for a patentee
to pursue on
discovering
several
infringers.

There is the authority of the Court of Appeal for the proposition that where a patentee brings two separate actions on the same patent and fails at the hearing of the first action to prove infringement this is no ground on which the defendant in the second action can claim to have it stayed or dismissed as frivolous and vexatious pending an appeal in the first action

(b) pp. 389, 390 *post*.(c) p. 428 *post*.(d) *Bovill v. Crate*, (1865) L. R. 1Eq. 391; see also *North British Rubber Co. v. Gormully and Jeffery Manufacturing Co.*, (1894) 12 R. P. C. 21.

Proceedings
before
Action.

Usual course
before com-
mencing an
action for
infringement.

or otherwise, unless he can show that he would have been bound by judgment in the earlier action. (*e*)

It is usual and proper for a patentee, before commencing proceedings in respect of an infringement of the patent, to apply to the alleged infringer, warning him not to continue the acts complained of, and asking him voluntarily to afford the relief which, in the event of the patentee bringing an action and succeeding, he would claim from the Court, though he is by no means bound to do so, and is entitled to commence his action without making any such demand. (*f*) Neither is he bound to rely on the infringer's promise not to repeat the wrongful act, but he is entitled to the injunction of the Court in aid of his legal rights, (*g*) though, if his conduct is oppressive, he may lose the costs of the action. (*h*) The Court does not, as a rule, take notice of negotiations between the parties preliminary to the issue of the writ, unless they amount to an accord and satisfaction, or release and binding agreement in relation to the cause of action, or the proceedings are tainted with a lack of good faith. (*i*)

Patentee
though suc-
cessful in the
action may be
disentitled to
an injunction
or costs.

Consequently though a patentee has an undoubted right of action against a person who infringes, whether in ignorance of the patent or not, it does not follow, as a matter of course, that he will in all cases succeed in obtaining an injunction or costs of the action. (*k*)

Thus, where a defendant unknowingly sold a few articles in infringement of a patent, but gave the plaintiff full information as to where he had obtained the articles complained of, and promised not to sell any more, a Bill for an injunction was dismissed, and he was left to his remedy in damages. (*l*)

In another case, where it appeared that the plaintiff had obtained possession of certain instruments admitted to be made in infringement of his patent, but that the defendant

(*e*) See *Dunlop Pneumatic Tyre Co. v. Rimington*, (1900) 17 R. P. C. 665.

(*f*) *Upmann v. Elkan*, (1871) L. R. 12 Eq. 146; *Upmann v. Forester*, (1883) L. R. 24 Ch. D. 231; *Burgess v. Hills*, (1859) 26 Beav. 244, 247; *Burgess v. Mately*, (1859) 26 Beav. 249.

(*g*) *Losh v. Hague*, (1837) 1 W. P. C. 200; *Geary v. Norton*, (1846) 1 De G. & S. 9; *Nunn v. D'Albuquerque*, (1865) 34 Beav. 595; *Upmann v. Forester*, (1883) L. R. 24 Ch. D. 231; *Nicols v. Pitman*, (1884) L. R. 26 Ch. D. 374; *Wittmann v. Oppenheim*, (1884) L. R. 27 Ch. D. 260; *Fradella v. Weller*, (1831) 2 Russ. & My. 247;

Proctor v. Bayley, (1889) 6 R. P. C. 106.

(*h*) *Nunn v. D'Albuquerque*, (1865) 34 Beav. 595; *Hudson v. Bennett*, (1866) 14 W. R. 911; *Smith v. Roberts*, (1888) 5 R. P. C. 611; p. 512 *post*.

(*i*) *Edelston v. Edelston*, (1863) 1 De G. J. & S. 203; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 305.

(*k*) pp. 486, 511 *post*.

(*l*) *Betts v. Willmott*, (1870) 16 W. R. 1 Eq. 305; see also *Upmann v. Elkan*, (1871) L. R. 12 Eq. 145; *Thornton v. Baker*, (1886) 3 Times Rep. 715.

had never intended to sell them, and relied on an undertaking for their return, the action was dismissed with costs, but an order was refused for the return of the instruments to the defendant.

Parties.

And in a case tried in Scotland, where the facts were that the defendant admitted infringement before the action, but had discontinued and offered to pay damages in respect of such infringement, and the action was brought in respect of a different article which was not an infringement, the Court refused an interdict, and, notwithstanding the previous admitted infringement, condemned the plaintiff in the costs of the action. (*m*)

And when it appeared that there had been only one infringement, which had been discontinued, the Court of Appeal held that in the absence of any evidence of the defendant's intention to continue the unlawful act an injunction should be refused. (*n*)

PARTIES.

All persons interested in a patent should be made parties to an action for infringement, either as co-plaintiffs or, if they refuse to join, as defendants, especially if an account is claimed instead of damages, in order that the infringing defendants may not be called upon to account twice, first to the plaintiff and then to the other defendants who claim an interest. (*o*) If the patent is the separate estate of a married woman she is capable of suing alone. (*p*) The owner of a distinct and severable part of a grant can sue alone. (*q*) And a co-owner can do so, if the defendant does not object: (*r*) a defendant who means to object should do so without delay. (*s*)

All parties interested should be before the Court.

Assignees have the same rights to sue as the original Assignee. . . patentee had, (*t*) whether they are assignees by direct

(*m*) *Fletcher v. Glasgow Gas Commissioners*, (1887) 4 R. P. C. 386.

(*n*) *Proctor v. Bayley*, (1889) 6 R. P. C. 538.

(*o*) *Westhead v. Keene*, (1838) 1 Beav. 287, 295; *Bergman v. Mac-Millan*, (1881) L. R. 17 Ch. D. 423; *Hindmarch on Patents*, p. 308.

(*p*) See *Savage v. Harris*, (1896) 13 R. P. C. 375, as to the usual order as to costs when an action brought by a married woman is unsuccessful.

(*q*) *Dunncliffe v. Mallet*, (1859) 7 C. B. N. S. 209; 29 L. J. C. P. 70.

(*r*) *Davenport v. Richards*, (1860) 3 L. T. N. S. 503.

(*s*) *Sheehan v. G. E. Ry. Co.*, (1880) L. R. 16 Ch. D. 59.

(*t*) *Boulton v. Bull*, (1795) 2 H. Bl. 464; *Electric Telegraph Co. v. Brett*, (1851) 10 C. B. 838; *Walton v. Lavater*, (1860) 8 C. B. N. S. 162; Vol. II. p. 122.

Parties. assignment or act and operation of law—*e.g.*, trustee in bankruptcy or his assignee (*u*)—or whether they are co-owners. (*x*)

An assignee's title should be registered, but registration is not always a condition precedent to the right to sue. (*y*)

Trustee and
cestui que trust.
Mortgagor.

A trustee may sue alone, as also a *cestui que trust*. (*z*)

The mortgagor of a patent is entitled to sue in respect of an infringement in his own name without joining the mortgagee as plaintiff, and the mortgagee does not possess such an interest in the patent as to make it necessary that he should be joined as a defendant. (*x*)

Agent.

The mere agent of a foreign patentee cannot, in his own name, maintain an action of infringement. (*b*)

Misjoinder of
parties.

It is provided by the Supreme Court Rules of 1883 (*c*) that no cause or matter shall be defeated by reason of the misjoinder or nonjoinder of parties, and the Court may in every cause or matter deal with the matter in controversy so far as regards the rights and interest of the parties actually before it, and the Court or a Judge may, at any stage of the proceedings, either upon or without the application of either party, and on such terms as may appear to the Court or a Judge to be just, order that the names of any parties improperly joined, whether as plaintiffs or as defendants, be struck out, and that the names of any parties, whether plaintiffs or defendants, who ought to have been joined, or whose presence before the Court may be necessary in order to enable the Court to effectually and completely adjudicate upon and settle all the questions involved in the cause or matter, be added.

The above rule does not authorise the amendment of the pleadings by allowing a plaintiff who has no right to sue to amend by joining as co-plaintiff a person who has a right to sue; (*d*) but it does authorise a plaintiff entitled to sue to add a necessary party—*e.g.*, in the case of an equitable assignee of a patent his assignor—with his consent, as plaintiff, or, without his consent, as defendant. (*e*)

(*u*) *Bloxam v. Elsee*, (1827) 6 B. & C. 169.

(*x*) *Anderson v. Patent Oxonite Co.*, (1886) 3 R. P. C. 279.

(*y*) See Vol. II. p. 128; also *Stewart v. Casey*, (1891) 8 R. P. C. 259.

(*z*) Vol. II. p. 128.

(*a*) *Van Gelder Apsimon & Co., Ltd. v. The Sowerby Bridge Flour Society, Ltd.* (1890) 7 R. P. C. 208.

(*b*) *Adams v. North British Ry. Co.*,

(1873) 29 L. T. N. S. 367.

(*c*) R. S. C. (1883) Ord. xvi. r. 11.

(*d*) *Walcott v. Lyons*, (1884) L. R. 29 Ch. D. 584; *Van Gelder, Apsimon & Co. v. The Sowerby Bridge Flour Society, Ltd.*, (1890) 7 R. P. C. 41, 45; but see 7 R. P. C. 208.

(*e*) See *Van Gelder, Apsimon & Co. v. Sowerby Bridge Flour Society, Ltd.* (1890) 7 R. P. C. 208.

In a case where it appeared that the plaintiff's rights had during the progress of the trial been transferred to a company, leave was given to add the company as plaintiffs, but the right was reserved to the defendant, if he thought fit, to have the trial postponed, although the fact of the transfer was known to him when he put in his statement of defence; (*f*) but where the defence was that the defendant had not infringed subsequent to the assignment of the patent to the plaintiff, leave, at the trial, was refused to add as co-plaintiffs the predecessors in title of the plaintiff; (*g*) as likewise was an order for leave to add as defendants the assignees of the defendants where it appeared that the assignment had been made pending the action. (*h*)

Parties.

Any person who infringes or takes part in the infringement of a patent may be made a defendant to an action, and held responsible for his acts, whether he be a principal or an agent; and it is no justification for a servant to say that his master ordered him to commit the infringement; (*i*) nor can the master avoid liability for the acts of his workmen and servants by saying that he gave them directions not to violate the patent, for the principal is always responsible for the acts of his agent which are not done in excess of his authority. (*j*)

Any person who infringes or takes part in an infringement may be made a defendant.

Though one individual partner in a firm may have a right to manufacture and sell under a patent, the firm may have no such right, as, according to the circumstances, the firm may be contractors for and not mere agents of the patentee and so properly made defendants. (*k*)

Firm as distinct from a partner.

Any person who authorises an infringement may properly be made a defendant in conjunction with a person who actually carries out the infringement. (*l*) Thus the directors of a company may be made personally liable, both in damages and costs of the action, for infringements carried out under their

Directors of a company.

(*f*) *Ruston v. Tobin*, (1878) 49 L. J. Ch. 262.

(*g*) *Nobel's Explosives Co. v. Jones*, (1880) 42 L. T. N. S. 754.

(*h*) *Briggs v. Lardeur*, (1885) 2 R. P. C. 13.

(*i*) *Betts v. De Vitre*, (1865) 11 Jur. N. S. 11; *Adair v. Young*, (1879) L. R. 12 Ch. D. 19; *Betts v. Neilson*, (1868) 6 N. R. 221; *Denley v. Blore*, (1851) 38 Lond. Jour. 224; *Day v. Davies*, (1904) 22 R. P. C. 34.

(*j*) *Sykes v. Howarth*, (1878) L. R.

12 Ch. D. 826; *Betts v. De Vitre*, (1873) L. R. 3 Ch. App. Cas. 429; *Gregory v. Piper*, (1829) 9 B. & C. 591; *Whatman v. Pearson*, (1868) L. R. 3 C. P. 422; *Sharrod v. London and North-Western Ry. Co.*, (1849) 4 Exch. 580, 587; *Gordon v. Rolfe*, (1849) 4 Exch. 365; *Lyons v. Martin*, (1838) 8 A. & E. 512; 3 N. & P. 509.

(*k*) *Howard v. Tweedale*, (1895) 12 R. P. C. 519.

(*l*) *Day v. Davies*, (1904) 22 R. P. C. 34.

Parties. direction by the workmen employed by the company. (*m*) Of course the company could be made a defendant also.

Foreigners.

Foreigners resident in Great Britain or the Isle of Man are responsible for any infringement of a British patent, just as they are for the infraction of any British law, and they may be made defendants to infringement actions. (*n*)

Manufacturers and persons who have purchased from them may be made defendants to the same action or sued separately.

The usual form in which injunctions are granted against infringers restrains the defendant, his servants, agents, or workmen from continuing the acts complained of. (*o*)

In cases where a plaintiff succeeds in obtaining a verdict against both a manufacturer and a person who uses an article made in infringement of his patent, he is entitled to relief against both, *e.g.*, to an account against the manufacturer and damages against the user. (*p*)

Manufacturers and persons who have purchased from them may be sued as defendants in the same action; (*q*) though if the manufacturer or user be sued alone, the other cannot claim to be joined as a defendant against the wish of the plaintiff. It is not the case of attacking a principal through his agent or the improper selection of a member of a class. (*r*)

Foreign manufacturer.

Further, if a foreign manufacturer is not also an importer, he is not liable to the jurisdiction of the Courts in this country, and is not an infringer. (*s*) Thus, a foreign manufacturer who delivers goods abroad—*e.g.*, by means of the post—to a person who imports them into this country—*e.g.*, by his agent, the post—is no infringer; but a foreign manufacturer who contracts for and makes delivery in this country—*e.g.*, by the post or other carrier—would be an infringer. (*t*)

Purchaser from unlicensed vendor.

A person who has purchased articles from an unlicensed manufacturer and finds himself mulcted in damages at the suit of the patentee, has, in the absence of express warranty,

(*m*) *A.-G. v. Vestry of Bermondsey*, (1883) L. R. 23 Ch. D. 60; *Mathias v. Yates*, (1882) 46 L. T. N. S. 497; *Betts v. De Vitre*, (1865) 11 Jur. N. S. 9; L. R. 3 Ch. App. Cas. 441; *Spencer v. The Ancoats Rubber Co.*, (1889) 6 R. P. C. 46; *Welsbach Incandescent Gas Light Co. v. Daylight Incandescent Mantle Co.*, (1899) 16 R. P. C. 344; *Welsbach Incandescent Gas Light Co. v. New Incandescent (Sunlight Patent) Gas Lighting Co.*, (1900) 17 R. P. C. 247.

(*n*) *Caldwell v. Van Vlissingen*, (1851) 21 L. J. N. S. Ch. 97; 9 Hare, 415; *Vavasseur v. Krupp*, (1870) L. R. 9 Ch. D. 351; *Toni Tyres, Ltd. v. Palmer*

Tyre, Ltd., (1905) 22 R. P. C. 369.

(*o*) *Seton*, p. 352.

(*p*) *Penn v. Bibby*, (1866) L. R. 3 Eq. 308; 36 L. J. Ch. 277; *United Telephone Co. v. Walker*, (1887) 4 R. P. C. 67.

(*q*) *Proctor v. Bennis*, (1887) 4 R. P. C. 333; L. R. 36 Ch. D. 740; *United Telephone Co. v. Walker*, (1887) 4 R. P. C. 67.

(*r*) *Moser v. Marsden*, (1892) 9 R. P. C. 214.

(*s*) *Badische Anilin und Soda Fabrik v. Johnson*, (1897) 14 R. P. C. 919, 405, 211; see p. 375 *ante*.

(*t*) *Ibid.*

no redress against the vendor. Upon the sale of the goods the property in them passed from the vendor to the purchaser. (u) The mere act of sale implies no warranty against the use of the goods by the purchaser being an infringement of existing patent rights. The mere possession of goods in the absence of evidence of intention to use them is not an infringement. (x)

Parties.

When goods are made in infringement of an English patent, and shipped from abroad, the consignees are proper defendants in an action, and where they were resident out of the jurisdiction of the Court leave was given to serve the writ out of the jurisdiction. (y)

Consignees of goods shipped from abroad are proper defendants.

In other cases of separate infringements of the same patent by different persons separate actions must be brought against each individually; (z) though where one person has infringed several patents belonging to the plaintiff he may be sued in respect of all the infringements in one action. (a) A plaintiff who brings several actions against the same defendant in respect of infringements of several patents will probably be allowed only the costs to which he would have been entitled had he included all the infringements in one action. (b)

When separate actions must be brought against separate infringers.

An agreement of indemnity against actions for infringement is not necessarily void as being against public policy. (c) In an action for infringement against a person to whom an indemnity had been given by the manufacturers, and where such person gave notice under the third party procedure (d) claiming indemnity, and the manufacturers put in an appearance, it was held that the proper order to be made was that, on the manufacturers admitting their liability to indemnify the defendants, they should be at liberty to appear at the trial and take such part therein as the Judge should direct, and that they should be bound by the decision of the Court in the action on any question as to the above indemnity as might arise between them and the defendants, but not further or otherwise. (e) The Court of Appeal held that no

Person who has indemnified the defendant may be allowed to take part in the action.

(u) See *Vavasseur v. Krupp*, (1878) L. R. 9 Ch. D. 360.

(x) See *ibid.*; p. 380 *ante*.

(y) *The Washburn and Moca Manufacturing Co. v. The Cunard Steamship Co.*, (1889) 6 R. P. C. 398; *Massey v. Haynes*, (1888) L. R. 21 Q. B. D. 330.

(z) *Dilly v. Doig*, (1794) 2 Ves. 486.

(a) *Lister v. Wood*, Seton, 3rd ed. p. 909.

(b) *United Telephone Co. v. Sharples*, (1885) 2 R. P. C. 28.

(c) See *Townsend v. Haworth*, (1875) *Higgins Digest Appendix*, pp. 61, 62.

(d) R. S. C. (1883) Ord. xvi. r. 48.

(e) *Edison v. Holland*, (1886) 3 R. P. C. 397.

Pleadings. injunction could be granted against such manufacturers brought in under the third party rules, as they were not made defendants, and leave to amend was refused, but they were ordered to pay the costs of the action. (*f*)

Writ.

PLEADINGS.

Usual pleadings.

The usual pleadings in an action for the infringement of a patent, after service of the writ with regard to which there is nothing special in patent actions, (*g*) are a statement of claim, particulars of breaches, a statement of defence, and particulars of objections. Further pleadings are not usual in actions of infringement of patent rights, but, if they are required, the practice as to them is regulated by R. S. C. Order xxiii.

Trial without pleadings.

Where the parties to a cause or matter are agreed as to the questions of fact to be decided between them they may, after writ issued and before judgment, by consent and order of the Court or a Judge, proceed to the trial of any such questions of fact without formal pleadings. (*h*)

If the parties to a patent action adopt this course, it is submitted, they will not be exempted from the necessity of delivering particulars of breaches and particulars of objections, but these will be required, as was the case where issues were directed under the old practice by the Court of Chancery. (*i*)

WRIT.

The same rules apply to the service of the writ in patent actions as in other actions. (*k*)

In the case of a foreigner resident abroad who does any act (*e.g.*, importing and selling in this country or obtaining orders in this country by means of a patented article, whether or not the orders are for this country or abroad) which is *prima facie* an infringement of a British patent, the patentee may, under R. S. C. 1883, Order xi. r. 1 (*f*), obtain leave to serve notice of the writ out of the jurisdiction; (*l*) but Order xi. r. 1 (*f*)

(*f*) *Edison v. Holland*, (1889) 6 R. P. C. 243.

(*g*) For forms of indorsement of the writ, see Appendix.

(*h*) R. S. C. (1883) Ord. xxxiv. r. 9.

(*i*) *Order in Davenport v. Jephson*, *Seton*, p. 346; *Bovill v. Smith*, (1867)

W. N. 1867, p. 240; 46 & 47 Vict. c. 57, s. 29; pp. 395, 412 *post*.

(*k*) R. S. C.

(*l*) *Badische Anilin und Soda Fabrik v. Johnson*, [1896] 1 Ch. 25; *Badische Anilin und Soda Fabrik v. Chemische Fabrik vormals Sandoz*, (1903) 20 R.

does not enable the Court to direct service out of the jurisdiction of a writ claiming damages for infringement of a patent which has expired at the date of the writ, and this is so, although an injunction is also sought in respect of another and subsisting patent. (m) Similarly interdict may be obtained in Scotland by an English company against an English company, notwithstanding that there is no effectual service within the territory. (n) A patentee who desires leave to serve notice of a writ on a foreigner out of the jurisdiction should be careful as to the evidence on which he seeks the leave. (o)

Statement
of Claim.

STATEMENT OF CLAIM.

In the statement of claim the patentee should allege the grant of the patent, and if his title is a derivative one it should be clearly stated.

Allegation of
grant and title.

It is not necessary to allege that the invention was new at the date of the patent, since the allegation of the grant and the production of the letters patent themselves throws on the defendant the *onus* of disputing the novelty. (p)

Not necessary
to allege
novelty,

It is common to state in the statement of claim that the letters patent are, and since the grant thereof always have been, valid and subsisting; but this is not necessary and the allegation is not contained in the form given in the Appendix to the Supreme Court Rules, 1883. (q)

or validity.

It is not necessary to set out in the statement of claim either the whole or any portion of the specifications, (r) though this was usually done in bills in Chancery under the old practice.

or to set out
the specifica-
tions.

If any disclaimer has been entered at the Patent Office, this fact, with the date, should be alleged in the statement of claim.

Disclaimers
should be
alleged.

The statement of claim must state a sufficient case to justify the injunction asked; (s) and must not set out a

Sufficient case
to justify the
relief asked
for must be
stated.

P. C. 413; 21 R. P. C. 533; *Badische Anilin und Soda Fabrik v. W. G. Thompson & Co., Ltd.*, (1902) 20 R. P. C. 422; *Badische Anilin und Soda Fabrik v. Chemische Fabrik vormals Sandoz in Basel*, (1904) 21 R. P. C. 345.

(m) *Badische Anilin und Soda Fabrik v. Chemische Fabrik vormals Sandoz in Basel*, (1904), 21 R. P. C. 345.

(n) *Toni Tyres, Ltd. v. Palmer Tyre, Ltd.*, (1904) 22 R. P. C. 369.

(o) See *Chemische Fabrik vormals Sandoz v. Badische Anilin und Soda Fabrik*, (1904) 21 R. P. C. 533.

(p) *Amory v. Brown*, (1869) L. R. 8 Eq. 664.

(q) R. S. C. 1883, Appendix C. Form 6.

(r) *Kay v. Marshall*, (1836) 2 W. P. C. 39; *Westhead v. Keene*, 1 Beav. 287.

(s) *Curtis v. Cutts*, (1839) 8 L. J. N. S. Ch. 184.

Statement of Claim. separate and different cause of action to that endorsed on the writ. (*t*)

Several patents sued on in one action.

More than one patent may be put in suit in the same action; but if the circumstances are such as to render the joining of a plurality of causes of action oppressive as against the defendant, he may, by application before defence, confine the plaintiff to a reasonable number. (*u*) Thus, where the plaintiffs sued on twenty-three patents, alleging that the said patents covered all known ways of producing a certain chemical body, and, though they could not say which particular patent or patents had been infringed, the defendants must have infringed one or more, the Court ordered that the action should in the first instance be limited to such of the patents not exceeding three in number, as the plaintiffs might select, and ordered the plaintiffs to amend their pleadings accordingly. (*v*) It may be doubted whether under such circumstances the Court ought to arbitrarily fix the number of causes of action on which the plaintiffs may proceed. In another case, where the Judge had limited the plaintiff to four patents, the Court of Appeal held that under the circumstances of the particular case the order should be varied by allowing the plaintiffs to sue on seven patents, but on special terms as to costs. (*y*) The order of the Court was as follows: "This Court doth order that the Order, so far as it directed that the plaintiffs should be limited in the first instance at the trial of this action to such number of the letters patent sued on herein, not exceeding four, as they might select, be varied; and it is ordered that the plaintiffs be at liberty to amend their statement of claim and particulars of breaches by discontinuing this action except as to seven patents, and by alleging as one cause of action infringement of one or other patent out of a group of three patents, and, as an additional cause of action, infringements of one or other patent out of another group of four patents. And it is ordered that, if the plaintiffs shall not, as to any of the patents so sued upon, open or proceed upon their case sufficiently to enable the Judge at the trial to decide whether any particulars of objections, which may be delivered by the defendants, are reasonable and proper, the plaintiffs shall be taken to admit that such particulars of objections are reasonable and proper,

(*t*) *United Telephone Co. v. Tasker* (No. 2), (1889) 6 R. P. C. 38.

(*u*) *Saccharin Corporation, Ltd. v. Wild*, (1902) 20 R. P. C. 243.

(*v*) *Ibid.*

(*y*) *Saccharin Corporation, Ltd. v. R. White & Sons, Ltd.*, (1903) 20 R. P. C. 454; see also *Saccharin Corporation, Ltd. v. Alliance Chemical Co., Ltd.*, (1905) 22 R. P. C. 175.

and a certificate to that effect shall be granted by the Judge. And it is ordered that the costs of this appeal and in the Court below be costs in the action." (z)

It must be remembered that in the cases above referred to the defendants proposed to attack the validity of the patents sued on, and were consequently embarrassed by the great number put in suit; and, further, the Court did not purport to interfere with the plaintiff's right to put all the patents in suit later on, provided they sued upon them fairly. (a) The case, therefore, is no authority for saying that when the defendant does not dispute, or is precluded from disputing, validity it is improper for a plaintiff to sue upon a large number of patents. (b) In a recent case judgment by default was obtained without objection by the Court where the allegation was that all of seven patents sued upon had been infringed. (c)

Particulars of Breaches.

PARTICULARS OF BREACHES.

The allegation of infringement in the statement of claim need only be in general terms, for it is specially enacted that the plaintiff must deliver with his statement of claim, or by order of the Court or a Judge at any subsequent time, particulars of the breaches complained of; (d) and at the hearing no evidence can, except by the leave of the Court or a Judge, be admitted in proof of any alleged infringement of which particulars have not been given. (e) Thus, when the particulars of breaches only alleged infringement by user and not by manufacture, the Court at the trial refused to consider the question whether there had been infringement by manufacturing the articles complained of. (f)

Particulars of breaches are necessary.

According to the practice in Scotland a separate statement of particulars of breaches is not required, but, none the less, particulars of breaches must be set forth on the record such as are required by sec. 29 of the Patents Act, 1883. (g) Apparently the principles governing the English Courts in

(z) 20 R. P. C. 458.

(a) See judgment of Collins, M.R.

(b) See Saccharin Corporation, Ltd. v. Jackson, (1903) 20 R. P. C. 616.

(c) Saccharin Corporation, Ltd. v. Hopkinson, (1904) 21 R. P. C. 272.

(d) 46 & 47 Vict. c. 57, s. 29, sub-s. 1. For forms of particulars of breaches,

see Vol. II. p. 383.

(e) 46 & 47 Vict. c. 57, s. 29, sub-s. 4.

(f) *Hensce v. Hardie*, (1894) 11 R. P. C. 421.

(g) See *Mica Insulator Co. v. Bruce Peebles & Co., Ltd.*, (1905) 22 R. P. C. 527.

Particulars of Breaches.

Amendment of particulars of breaches.

matters relating to particulars under sec. 29 of the Patents Act, 1883, are applied *mutatis mutandis* by the Judges in Scotland to cases within their jurisdiction. (*h*)

The Court or a Judge has power from time to time to grant leave to amend particulars. (*i*) And further and better particulars may be ordered at the instigation of either party, even though the action has actually been put down for trial and notice of trial given. (*k*) Though the Court of Appeal is not a "Court or Judge" within the meaning of sec. 29 of the Act of 1883, yet, when there is an appeal, it has, if not an inherent power, at any rate a special power, under R. S. C. 1883, Order 58, r. 4, to allow an amendment of the particulars of breaches or objections so as to admit further evidence. This power is purely discretionary, and the Court of Appeal is loath to exercise it, and only does so in special cases. (*l*)

Any party desiring an amendment of the particulars of breaches or objections in an action for infringement must satisfy the Court that he is really placed in a difficulty by the particulars as they stand. (*m*)

Where, on a motion for further and better particulars, it appeared that the plaintiff had stated that he was unable to give further particulars till he had obtained discovery from the defendant, the motion was ordered to stand over till after the defendant had given discovery. (*n*)

Particulars must be reasonable and proper.

The plaintiff must take care that the particulars which he furnishes are reasonable and proper ones, otherwise he will fail to obtain the certificate of the Court or a Judge, which is necessary to entitle him to the costs of such particulars on taxation. (*o*)

Sufficient if, with the pleadings, they give the defendant notice of the case to be made against him.

Particulars of breaches are sufficient if, taken together with the pleadings, they give the defendant fair notice of the case to be made against him. (*p*) The object of particulars is not to disclose evidence, but to tell the case to be made at the trial, (*q*) and the office of particulars of breaches is to tell the defendant what the plaintiff says he has done in infringement,

(*h*) See *Mica Insulator Co. v. Bruce Peebles & Co., Ltd.*, (1905) 22 R. P. C. 527.

(*i*) 46 & 47 Vict. c. 57, s. 29, sub-s. 5.

(*k*) *Mandelberg v. Morley*, (1893) 10 R. P. C. 256.

(*l*) *Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 530.

(*m*) *Haslam v. Hall*, (1887) 4 R. P. C. 203, 207, per *Wills, J.*

(*n*) *Russell v. Hatfield*, (1885) 2 R.

P. C. 144.

(*o*) 46 & 47 Vict. c. 57, s. 29 (6).

(*p*) *Needham v. Oxley*, (1863) 1 H. & M. 248; *Petman v. Bull*, (1886) 3 R. P. C. 390; S. C. reported in *Ledgard v. Bull*, L. R. 11 App. Cas. 618; *Cheetham v. Oldham* (No. 3), (1888) 5 R. P. C. 624.

(*q*) *Mandelberg v. Morley*, (1893) 10 R. P. C. 260.

and it is not the office of particulars to answer an interrogatory as to the construction of the patent. (r)

Thus, where the pleadings stated that the defendant's machine included a certain new and important combination which was the plaintiff's invention, and the particulars of breaches simply pointed to certain specified machines, and stated in general terms that these infringed the patent, they were held to be sufficient, in spite of the contention that the plaintiffs ought to specify precisely in what respect the defendant's machines were an infringement. (s) Again, where the particulars of breaches specified a particular article as an infringement, the Court, being of opinion that the defendant must know whether and in what respect he had infringed, refused to compel the plaintiff to specify the persons with respect to whom, and the occasions on which, the infringement occurred, or to order him to point out the particular parts of the specification alleged to have been infringed. (t) And where the alleged infringement, which is not a complicated structure, is an exhibit in the case, it has been held not to be necessary that the particulars of breaches should point out the precise portion of the specification alleged to have been infringed. (u)

Where, however, a specification describes two processes wholly distinct from each other, and the defendant's process is capable of being an infringement of the one, but not of the other, particulars of breaches in general terms would not be sufficient. (x) And if the specification contain a description of a number of articles, all of which are the subject of the invention, the particulars must point out which part of the specification has been infringed. (y)

Thus, where the specification contained a description of thirteen different sorts of pens, the plaintiff was ordered to point out specifically which particular pens shown in the drawing he alleged to have been infringed. (z)

It is to be noticed that when the alleged infringer is a user A user may require fuller

(r) *Wenham Co. v. Champion Gas Co.*, (1891) 8 R. P. C. 22; *Cassella v. Levinstein*, (1891) 8 R. P. C. 473.

(s) *Needham v. Oxley*, (1863) 1 H. & M. 248.

(t) *Talbot v. La Roche*, (1854) 15 C. B. 310; see also *Moseley v. Victoria Rubber Co.*, (1886) 3 R. P. C. 351.

(u) *Batley v. Kynock (No. 2)*, (1874) L. R. 19 Eq. 229; *Needham v. Oxley*, (1863) 1 H. & M. 248; *Perry v.*

Mitchell, (1840) 1 W. P. C. 269.

(x) *Talbot v. La Roche*, (1854) 15 C. B. 310, 320; *Patent Type Founding Co. v. Richards*, (1860) 2 L. T. N. S. 359.

(y) *Perry v. Mitchell*, (1840) 1 W. P. C. 269; *Patent Type Founding Co. v. Richards*, (1860) 2 L. T. N. S. 359.

(z) *Perry v. Mitchell*, (1840) 1 W. P. C. 269.

Particulars of Breaches.

particulars than a manufacturer.

and not a manufacturer the particulars of breaches must be fuller than would be necessary if he were a manufacturer. When the alleged infringer is a manufacturer he knows what the process he uses is, but if the alleged infringer is a user or vendor only he may be dependent for his knowledge of the process used upon the statement of the actual manufacturer. The plaintiff might dispute the manufacturer's statement, and content that some other process mentioned in the specification had been used. Hence the necessity in such a case of giving the user or vendor full notice of which of the plaintiff's processes it will at the trial be contended have in fact been used. (a)

Must specify which claims have been infringed, if necessary, by reference to pages and lines of the specification.

The defendant is entitled to a statement in the particulars of breaches as to which one or more of several claims in the specification he is charged with having infringed; (b) but it is sufficient if the particulars refer to pages and lines of the specification without direct mention of the claiming clauses. (c)

Provided the particulars of breaches give the defendant a fair idea of the case to be made against him, they will be sufficient if they refer to specific claims, and specify certain machines of the defendant as infringements of those claims, and it is not necessary that they should state by reference to pages and lines what portion of the specification has been infringed; (d) neither can the plaintiff be compelled to put a construction on his claims or specification in the particulars of breaches; (e) though if the invention is a complicated one, or the defendant has any other sufficient grounds for requiring the information in the preparation of his defence, the plaintiff may be compelled to furnish particulars of pages and lines of the specification alleged to have been infringed. (f)

Specific instances and dates of some infringements must be given, but certain general words may be added.

The particulars of breaches must not merely refer in general terms to acts of the defendant, but must specify definite instances of infringements committed by him, and give at any rate the date of some of the various occasions

(a) *Mandelberg v. Morley*, (1893) 10 R. P. C. 260.

(b) *Haslam v. Hall*, (1887) 4 R. P. C. 203.

(c) *Elsev v. Butler*, (1881) 1 R. P. C. 189.

(d) *Walter C. Church Engineering Co. v. Wilson*, (1886) 3 R. P. C. 123; *Electric Telegraph Co. v. Nott*, (1847) 4 C. B. 462; *Talbot v. La Roche*, (1854)

15 C. B. 310; *Batley v. Kynock* (No. 2), (1875) L. R. 19 Eq. 229; *Cheetham v. Oldham* (No. 3), (1888) 5 R. P. C. 624.

(e) *Cassella v. Levinstein*, (1891) 8 R. P. C. 473.

(f) *Lamb v. Nottingham Manufacturing Co.*, cited L. R. 19 Eq. 230; *Wren v. Weild*, (1869) L. R. 4 Q. B. 213; *Jones v. Lee*, 25 L. J. Ex. 241.

when the infringements took place, and the names and addresses of the persons (if any) concerned as buyers, &c. (g)

Particulars of Breaches.

Thus, in an action for infringement, where the particulars of breaches alleged that the defendants had infringed by importing into this country, selling, exposing for sale, and otherwise dealing with glass globes, shades, and moons, having their surfaces wholly or in part roughened in a particular way, the Judge expressed an opinion that the plaintiffs ought to give two or three specific instances of globes which they alleged to be infringements, but ought to be at liberty to add general words so as not to be confined to such instances at the trial, and his Lordship accordingly made an order for further and better particulars. (h)

In *Walter C. Church Engineering Co. v. Wilson*, (i) the words "in particular and by way of illustration" were held to be too wide; but, on the other hand, in *Haslam v. Hall*, (j) where the particulars of breaches, "by way of example and not of limitation," alleged certain machines fitted by the defendants on board the "*Selembria*," and "all machines made by the defendants similar to them," to be infringements of the plaintiff's patent, the words in italics were allowed to remain, but the plaintiff was confined, so far as concerned machines fitted to ships, to the "*Selembria*," unless he gave further names.

Though a threatened infringement may be restrained, (k) an injunction will not be granted where the action is only framed in respect of, and fails as to *specific* infringements alleged to have been committed prior to the action, and the plaintiff seeks to give evidence of acts of a different nature committed after action as infringements, unless the pleadings are, by leave of the Court on terms, amended so as to include threatened infringements; in which case the subsequent real infringements may be evidence of intention prior to action brought to infringe, otherwise evidence of subsequent infringements will not be admitted at all. (l)

Particulars of actual infringements are necessary, and evidence is limited by them, unless the action is solely based on threats to infringe.

The patentee may bring two distinct kinds of action—the one based on the fact that the defendant has infringed before

(g) *Sykes v. Howarth*, (1878) L. R. 12 Ch. D. 826; cf. *Flower v. Lloyd*, (1876) 45 L. J. Ch. 476; 25 W. R. 17.

(h) *Tilghman's Patent Sand Blast Co., Ltd. v. Wright and Butler Co., Ltd.*, (1881) 1 R. P. C. 103; see also *Talbot v. La Roche*, (1854) 15 C. B. 310.

(i) (1886) 3 R. P. C. 123.

(j) (1887) 4 R. P. C. 203.

(k) p. 384 *ante*.

(l) *The Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 522; *Welsbach Incandescent Gas Light Co. v. Dowie*, (1899) 16 R. P. C. 391.

Particu-
lars of
Breaches.

action brought, and the other based on the fact that the defendant threatens and intends to infringe. These two grounds of action may be combined in one action, but they are quite distinct in themselves. In the first case the plaintiff is entitled to claim damages or an account, and an injunction to prevent similar infringements in the future. In the second case the plaintiff may claim an injunction to restrain the threatened infringement. In so far as the action is based on infringement before action brought the plaintiff is bound to give particulars of breaches, and by statute no evidence can, except by leave of the Court or a Judge, be given, at the hearing, of any breaches other than those stated in the particulars. Of course, in so far as the action is based on threats to infringe no particulars of breaches can be given, but care is always taken that the defendant shall have fair notice as to the nature and particulars of the special infringement he is alleged to be contemplating. (m) *Shoe Machinery Co. v. Cutlan* (n) was on the pleadings an action of the first class referred to above. The plaintiff was obliged to admit that the acts done before action brought were in fact not infringements, but he sought to contend that acts done after action brought were different in nature and infringements. The Judge refused on the pleadings (no amendment of which was asked for) to admit evidence of such latter acts. These latter acts were of such a nature that they would probably have been admissible as evidence of a threat or intention to infringe prior to action brought, if an amendment of the pleadings necessary to include threatened infringement had been asked for. Similarly in *Welsbach Incandescent Gas Light Co. v. Dowle*, (o) which was also an action of the first class, the Judge held that evidence of the alleged acts prior to the writ was not sufficient to prove the plaintiff's case, and the action being founded on an alleged infringement as distinct from a threatened infringement he refused to admit evidence of alleged acts subsequent to the writ. *Frearson v. Loe* (p) was a case of the second class, and an injunction was granted to restrain the threatened infringements, evidence of which was on the pleadings clearly admissible. *Dowling v. Billington*, (q) on the other hand, though in form an action of the first class, was treated by the Judge as one of the

(m) *Shoe Machinery Co. v. Cutlan*,
(1895) 12 R. P. C. 357.
(n) (1895) 12 R. P. C. 342.

(o) (1899) 16 R. P. C. 391.
(p) (1878) L. R. 9 Ch. D. 48.
(q) (1890) 7 R. P. C. 191.

Defence.

second class, and under the peculiar circumstances of that case evidence of infringement committed after action brought was admitted. The peculiarity of the case was that the alleged infringements committed before action brought were technically not infringements at all, since the complete specification had not then been accepted. The articles made after action brought were admitted in evidence to be the same in kind as those made before, and since the action was brought in respect of that kind of article the Judge must be taken to have admitted the evidence of infringement after action, on the principle that the defendant had on the pleadings fair notice that the plaintiff would contend at the trial that the future manufacture of such articles would be an infringement and that he claimed an injunction to restrain such future manufacture.

DEFENCE.

By way of defence (r) it is open to the defendant to defeat an action for infringement of a patent by proving either that he has not committed any infringement, supposing the patent to be a valid one, or that the patent is in fact non-existent or void, and that the acts complained of are consequently no violation of any right vested in the plaintiff. (s)

Two main defences.

It is not a valid defence to say that the defendant committed the infringement because the plaintiff failed to carry out an agreement whereby he undertook to supply the defendant with a certain number of the patented machines; but, in such a case, the injunction of the Court restraining further infringements will only be granted on the terms that the plaintiff undertakes to supply the defendant with a certain limited number of machines in the place of those which the injunction would prevent him from using. (t) Moreover, the defendant is at liberty to counterclaim for damages consequent on the breach of the agreement. (u)

Breach of contract by the plaintiff is not a valid defence.

The defendant should state in his defence the grounds on which he relies, if he disputes the validity of the patent or alleges that the acts complained of were authorised by the plaintiff, for he cannot at the trial bring forward any ground

All grounds of defence should be stated.

(r) For forms of defence, see Vol. II. p. 390.

(s) See *Dudgeon v. Thomson*, (1877) L. R. 3 App. Cas. 37.

(t) *United Telephone Co. v. Tasker*, (1888) 5 R. R. C. 628.

(u) *Heald v. Incandescent Gas Light Co.*, (1893) 10 R. P. C. 165.

Defence. of defence which is not stated in his pleadings. (*x*) He must also be careful that his pleas are not embarrassing, otherwise they may be ordered to be struck out at the instigation of the plaintiff. (*y*)

An order has been made that a defendant should, upon an issue as to the sufficiency of the specification, be at liberty to dispute the utility of the alleged invention, although he had not raised the general issue as to utility. (*z*)

Particulars do not stand in the place of pleas.

Particulars of objections do not stand in the place of pleas, (*a*) and they cannot go outside the pleas, (*b*) though they must give more detailed information, (*c*) and not be merely reiterations. (*d*) The Court has refused to allow a defendant to contend that the patent was illegal when it appeared that he had only given notice of an objection to that effect, and not specially pleaded it. (*e*)

Short form of defence.

Any objection to the validity of a patent will be properly raised if the defence contains a simple denial of the validity of the patent, "on the grounds stated in the particulars of objection delivered herewith"; (*f*) but it is by no means uncommon for the grounds of objection to appear on the defence itself.

Grounds on which invalidity may be pleaded.

The defendant may deny infringement and plead also that the acts complained of were done by the leave and licence of the patentee. (*g*) It is further open to him to plead the invalidity of the patent on any one or more of the following grounds:—

- i. The grantee was not the true and first inventor. (*h*)
- ii. The alleged invention is not the proper subject-matter of a patent. (*i*)
- iii. The invention is not useful. (*k*)
- iv. The invention is not new. (*l*)
- v. The specification is insufficient. (*m*)

(*x*) *Bovill v. Goodier* (No. 2), (1866) L. R. 2 Eq. 195; see R. S. C. (1883) Appendix D.

(*y*) R. S. C. Ord. 19, r. 27; *Ashworth v. Law*, (1887) 7 R. P. C. 231.

(*z*) *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 531, 536.

(*a*) p. 412 *post*.

(*b*) *Macnamara v. Halse*, (1842) 2 W. P. C. 128; *Jones v. Berger*, (1843) 1 W. P. C. 544.

(*c*) *Bulnois v. Mackenzie*, (1837) 1 W. P. C. 260; *Jones v. Berger*, (1843) 1 W. P. C. 544; *Walton v. Bateman*, (1842) 1 W. P. C. 616.

(*d*) *Neilson v. Harford*, (1841) 1 W.

P. C. 370; *Betts v. Walker*, (1850) L. R. 14 Q. B. 363, 368; *Walton v. Bateman*, (1842) 1 W. P. C. 268 *n*.

(*e*) *Gillet v. Wilby*, (1839) 1 W. P. C. 270.

(*f*) See order in *Kurtz v. Spence*, (1887) 36 Ch. D. 776.

(*g*) *Hensee v. Hardie*, (1874) 11 R. P. C. 421; *Guyot v. Thompson*, (1894) L. R. 3 Ch. 388; 11 R. P. C. 541.

(*h*) Chap. i. *ante*.

(*i*) Chap. ii. *ante*.

(*k*) Chap. iv. *ante*.

(*l*) Chap. iii. *ante*.

(*m*) Chap. v. *ante*.

- vi. There is some disconformity between the specifications. (*n*) Defence.
- vii. The letters patent have lapsed previously to the committal of the acts complained of, in consequence of the non-payment of fees, or the period of their duration having expired. (*o*)
- viii. Any ground on which the patent might, at the commencement of the Patents, Designs, and Trade Marks Act, 1883, have been repealed by *scire facias*, (*p*) *i.e.*:
- a.* Letters patent of earlier date than those forming the subject of the action have been granted in respect of the same invention. (*q*)
 - b.* The letters patent were granted on a false suggestion. (*r*)
 - c.* The grant of the letters patent was not lawful. (*s*)
 - d.* Non-compliance on the part of the patentee with the conditions of the letters patent.
 - e.* Failure of the essential requisites of novelty or utility.
 - f.* Abuse of the privileges granted by the letters patent.

The objection that the invention is not the proper subject-matter of a patent cannot be taken under a plea that the invention is not new, (*t*) or under a plea of insufficiency of the specification. (*u*) Not subject-matter.

As we have seen, (*x*) the requirement of utility does not arise from any express words in the Statute of Monopolies, but is an inference to be drawn from the Common Law and the enactment that the monopoly granted must not be "mischievous to the State, or to the hurt of trade, or generally inconvenient." (*y*) Though it may be thought that the proper form of plea is to plead the statute, and not merely the want of utility, the practice at Common Law, which was adopted by the Court of Chancery, (*z*) *viz.*, to deny the utility Not useful.

(*n*) Chap. v. *ante*.

(*o*) Vol. II. p. 54.

(*p*) 46 & 47 Vict. c. 57, s. 26.

(*q*) Chap. iii. *ante*.

(*r*) *Ibid.*

(*s*) Chap. ii. *ante*.

(*t*) *Walton v. Potter*, (1841) 1 W. P. C. 597; *Househill Co. v. Neilson*, 1 W. P. C. 677.

(*u*) 21 Jac. I. c. 3, s. 6; *Househill*

Co. v. Neilson, (1843) 1 W. P. C. 677; *Jupe v. Pratt*, (1837) 1 W. P. C. 151; *Walton v. Potter*, (1841) 1 W. P. C. 597.

(*x*) p. 157 *ante*.

(*y*) *Morgan v. Seaward*, (1837) 1 W. P. C. 197; 21 Jac. I. c. 3, s. 6.

(*z*) *Seton*, 4th ed. p. 347; *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 531, 536.

Defence. in general terms, is that usually followed. (a) The defence of want of utility cannot be raised under a plea that the invention is not a new manufacture if the plaintiff objects. (b)

If the specification describes different modes of carrying out the invention, which vary in utility, though all are to some extent useful, this fact cannot be made a valid ground of defence. (c)

Not new.

The issue of novelty is quite distinct from that of true and first inventor, (d) for an invention may be a new manufacture within the Statute of Monopolies (e) but the patentee may not be the true and first inventor, in which case the patent would be void. The defendant is consequently entitled to have the question of newness of manufacture tried apart from that of newness of invention; (f) and a plea that the invention is not the proper subject-matter of letters patent does not raise the issue of novelty. (g)

In *Walton v. Potter* (h) it was pleaded that the invention was not a "new manufacture," and the Court held that this plea admitted the invention to be a "manufacture" within the meaning of the statute, and only put in issue the novelty. On the other hand, in *Spilsbury v. Clough* (i) it was held that a plea that the invention was not a "new manufacture" was bad, as it left it doubtful whether the objection was that the invention was not new, or that it was not a manufacture within the statute. But neither of these cases is to be considered as good law on the subject, for in *Bush v. Fox* (k) the House of Lords held that a plea to the effect that an invention is not a "new manufacture" puts in issue both the novelty of the invention and its being a manufacture; and in *Spencer v. Jack* (l) the Lords Justices, on appeal, ordered the questions of newness of invention and newness of manufacture to be tried separately.

Prior grant.

The issue of prior grant which is a permissible defence (m) must not be confounded with that of novelty. When a prior document is relied on for the purpose of attacking the novelty of the invention which forms the subject of the plaintiff's

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| (a) Hindmarch on Patents, p. 275. | <i>Co. v. Neilson</i> , (1843) 1 W. P. C. 689. |
| (b) <i>Walton v. Bateman</i> , (1842) 1 W. P. C. 623. | (g) <i>Booth v. Kenuard</i> , (1856) 1 H. & N. 527. |
| (c) <i>Miller v. Searle</i> , (1893) 10 R. P. C. 106. | (h) (1841) 1 W. P. C. 601, 611. |
| (d) <i>Househill Co. v. Neilson</i> , (1843) 1 W. P. C. 689. | (i) (1842) 1 W. P. C. 255. |
| (e) 21 Jac. I. c. 3. | (k) (1856) Macr. P. C. 179. |
| (f) <i>Spencer v. Jack</i> , (1862) 3 De G. J. & S. 346; 11 L. T. N. S. 242; <i>Househill</i> | (l) (1864) 3 De G. J. & S. 316; 11 L. T. N. S. 242. |
| | (m) See p. 403. |

patent, it is necessary to prove publication by the document; (n) when, however, the ground of attack is a prior grant in respect of the same invention, all that it is necessary to prove is that the alleged prior grant was in fact made in respect of the same invention before the grant to the plaintiff. The plaintiff is entitled in his reply to deny the validity of the alleged prior grant relied on by the defendant, and, it is submitted, if he do so, he may be required to give particulars of his objections to the validity of the alleged prior grant. (o)

Defence.

It must be remembered that now patents are, in accordance with the statutory requirements of the Act of 1883, always dated and sealed as of the day of application, (p) and, further, by the express provisions of the statute, in the case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications does not prevent the sealing of a patent on an earlier application. (q) In the event of more than one patent being sealed on concurrent applications, it is submitted, those in respect of applications of later date are made void *ab initio* by the sealing of a patent on an application of prior date. (r)

Of late years the defence of prior grant has been frequently raised, but the writer is not aware of any case in which it has succeeded.

Under the practice prior to the Act of 1883, insufficiency of the specification was one of the most frequent objections raised in patent actions. The reason of this was that formerly the letters patent contained a condition requiring the patentee within a stated period to file a specification ascertaining the nature of the invention, and in what manner the same was to be performed, under pain of forfeiting the grant altogether. (s)

The form of letters patent at present in use does not contain any condition (though it might do so) (t) avoiding the grant, if the specification, which is filed previously to the grant, is insufficient. As, however, insufficiency of the specification was a ground on which the repeal of a patent might at the commencement of the Act of 1883 have been obtained by *scire facias*, as being a failure to comply with one of the

(n) pp. 140-156 *ante*.(o) See Vol. II. pp. 391, 393 *post*, and *Brooks v. Lamplugh*, (1898) 16 R. P. C. 45, for forms of pleadings.(p) See Vol. II. p. 53 *ante*.(q) *Ibid*.

(r) See Vol. II. p. 53.

(s) *Arkwright v. Nightingale*, (1785) 1 W. P. C. 61.

(t) 46 & 47 Vict. c. 57, s. 33.

Defence. conditions of the grant, (*u*) it is still a ground of defence to an action for infringement under the present practice. (*x*)

Disconformity. Deception of the Crown by obtaining a patent by means of a false representation was formerly a ground for a *scire facias*, (*y*) and, it is submitted, the Crown is deceived if there is a material difference between the provisional and complete specification; the patent must in such a case have been obtained in respect of an invention which was not foreshadowed in the provisional specification; (*z*) and the objection that there is disconformity is consequently a good defence to the validity of a patent. (*a*) Moreover, it may be said that the complete specification does not particularly describe and ascertain the nature of the invention, if it departs from the terms of the title or of the provisional specification, in which the nature of the invention must be described. It would consequently appear that evidence of a defect in the title and disconformity between the specification may be tendered under a plea of insufficiency. (*b*)

Fresh issues during the progress of the action.

The Court will at any time during the progress of an action for infringement allow the defendant to raise a fresh issue on the discovery of facts which could not with due diligence have been discovered before. (*c*) Thus, in one case, the plaintiff having altered his case from that originally set up, the defendant was at the trial allowed to amend his defence by adding a plea of want of subject-matter. (*d*) In another case, where the defendant at the trial asked for leave to amend his defence by adding a plea of invalidity on the ground of variance between the title and the claims, the Court refused to grant the leave, on the ground that it was asked for too late. (*e*)

Decision in a prior action.

Estoppel.—The fact that a patent has been questioned and upheld in a former action does not estop a person questioning it again in a subsequent action, when the parties to the second action are not the same as the parties to the first; and, though the plaintiff in both actions is the same, the Court

(*u*) p. 297 *ante*.

(*x*) 46 & 47 Vict. c. 57, s. 26, sub-s. 3.

(*y*) *R. v. Arkwright*, (1785) 1 W. P. C. 66.

(*z*) *Curtis v. Platt*, (1863) Griff. L. O. C. 53.

(*a*) 46 & 47 Vict. c. 57, s. 26, sub s. 3; see also p. 297 *ante*.

(*b*) *Penn v. Bibby*, (1866) L. R. 2 Ch. App. 127, 130; but see *Derosne v. Fairie*, (1835) 1 W. P. C. 161; *Neilson*

v. Harford, (1841) 1 W. P. C. 312; *Morgan v. Fuller* (No. 1), (1866) R. R. 2 Eq. 297.

(*c*) *Holste v. Robertson*, (1876) L. R. 4 Ch. D. 9; R. S. C. (1883) Order xxviii.; p. 483 *post*.

(*d*) *Crossthaite v. Moorwood*, (1894) 11 R. P. C. 558.

(*e*) *Shrewsbury and Talbot S. T. Cab and Noiseless Tyre Co. v. Morgan*, (1896) 13 R. P. C. 75.

trying the second action is not bound by the decision in the former in favour of the plaintiff; for its operation is not *mutual* as between the parties to the second action, (*f*) and the evidence in the second action may be different to that in the former—*e.g.*, a prior user relied on as an anticipation may fail to defeat the patent from want of evidence in the first action, but be completely successful in view of further evidence adduced in the second action. (*g*) In second actions, however, the Court usually considers itself bound by the interpretation put on the specification by a Court of equal or superior jurisdiction in the first action when the facts as to prior knowledge are the same; (*h*) though, if the specification has to be reconstrued in the light of fresh facts as to prior knowledge, the Court would most probably not consider itself so bound. (*i*)

The fact that the patentee has been defeated in a prior action cannot be pleaded successfully as a bar to a subsequent action, (*k*) unless the patent was declared invalid in the prior action and the parties are the same when the matter is *res judicata*, (*l*) for until the patent is revoked, or lapsed by effluxion of time, a right is presumed to be in the patentee, and his remedy for an infringement of such right is by action on the patent. When the question of validity has been fought out to judgment, and a separate finding has been come to on the point, the matter is *res judicata* between the parties, and cannot be raised again in any fresh action between the same parties. It cannot be raised afresh even if the defendant is prepared with fresh objections as to validity which were not before the Court on the former occasion. When the question of validity is brought to trial it is the duty of the defendant to put his whole case before the Court, and if he does not do so it is his fault or misfortune. In other words, he cannot be permitted to bring his case as to validity piecemeal before the Court in a series of actions. (*m*) He could,

Defence.
Estoppel.

(*f*) Taylor on Evidence, 5th ed. vol. ii. p. 1444; *Shedden v. A.-G.*, (1860) 30 L. J. (N. S.) Pr. & Mat. 217.

(*g*) *Shaw v. Day*, (1894) 11 R. P. C. 185; see, *e.g.*, *Gammons v. Battersby*, (1901) 21 R. P. C. 322, and *Gammons v. Singer Manufacturing Co.*, (1904) 22 R. P. C. 129, 452.

(*h*) *Edison v. Holland*, (1888) 5 R. P. C. 459; 6 R. P. C. 243; *Slazenger v. Feltham*, (1889) 6 R. P. C. 130; *Automatic Weighing Machine Co. v.*

Combined Weighing Machine Co., (1889) 6 R. P. C. 367.

(*i*) p. 283 *ante*.

(*k*) *Arkwright v. Nightingale*, (1785) Dar. P. C. 52.

(*l*) *Horrocks v. Stubbs*, (1895) 12 R. P. C. 540; 13 R. P. C. 69; *Shoe Machinery Co. v. Cutlan (No. 2)*, (1896) 13 R. P. C. 141.

(*m*) *Shoe Machinery Co. v. Cutlan (No. 2)*, (1896) 13 R. P. C. 141.

Defence.
Estoppel.

however, after action, petition for the revocation of the patent. (n)

When in the prior action the question of validity has been decided against the patentee, this fact may be pleaded by the defendant in the second action, on the ground that the matter is already *res judicata* between the parties.

In one case where the patentee was defeated on the validity of the patent on several grounds, including disconformity, and he then amended the specification, but did not remove the portions which affected the question of disconformity, and then commenced a fresh action, the Court of first instance held that the subject of the action was *res judicata*, and dismissed the action. On appeal, the Court of Appeal, without deciding whether the matter was *res judicata*, held that the true interpretation of a certain agreement between the parties was that the decision on the question of disconformity should be final between them, and dismissed the action on that ground. (o)

The fact that the actual defendant in the second action was—*e.g.*, by virtue of an indemnity—the virtual defendant in the first action does not operate as an estoppel, and the matter is not *res judicata* between the parties to the second action. (p)

Specification amended after prior adverse decision.

When the portions of the specification which affected the question of validity in a prior action have been entirely removed by amendment before the commencement of a subsequent action, the decision in the former action cannot, of course, be pleaded by the defendant as an estoppel against the plaintiff in the subsequent action. (q)

Admission of infringement.

A defendant who has once submitted to an injunction is estopped in a second action, or, on being attacked for a second infringement, from either directly or indirectly raising arguments against the validity of the patent. (r) On the other hand, where a defendant has, prior to action brought, stated—not in litigation *inter partes*—in howsoever a definite manner, that he has infringed, this fact does not raise any sort of estoppel against him in an action brought for the infringement of the patent. The question of infringement is one which must in such circumstances be determined quite apart from the defendant's previous statements, excepting in

(n) p. 306 *ante*.

(o) *Horrocks v. Stubbs*, (1895) 12 R. P. C. 540; 13 R. P. C. 69.

(p) *Gammons v. Singer Manufacturing Co.*, (1904) 22 R. P. C. 459.

(q) *Decley's Patent*, (1894) 11 R. P. C. 76.

(r) *Moor v. Thomson*, (1890) 7 R. P. C. 327.

so far as they may affect his credibility as a witness of truth or as an expert. (s)

Defence.
Estoppel.

The defendant in an action for infringement may in consequence of his relationship to the plaintiff be estopped from denying the validity of the patent, *e.g.*, where he is a licensee under a licence granted by deed which contains a recital implying the validity of the patent; (t) for, the contract being by deed, the failure of the consideration is immaterial, and it is not competent to a defendant by plea to deny the effect of a deed which he has executed. (u) The incapacity of a licensee to deny the validity of a patent against the licensor terminates with the termination of the licence, and he is then in exactly the same position as any other member of the public against whom an action of infringement may be brought. (x) A revocable licence may be determined by due notice, and thus a licensee may, by proper notice given before action brought, determine the licence, and so turn himself from a licensee into a wrongdoer, and become entitled to dispute the validity of the patent in an action of infringement brought against him by his former licensor; (y) but a plea in a defence to the effect that the licence has been determined will not operate as a due notice of determination. (z)

Defendant a
licensee.

Persons, other than licensees, may in consequence of their past conduct be estopped from denying the validity of the patent as against the plaintiff. Thus, a patentee who has assigned his patent is estopped from denying its validity in an action for infringement brought by the assignee. (a)

Defendant an
assignor.

Although it is a sound principle of law that a grantor cannot derogate from his grant, yet the language of a specification must not be strained against an assignor who happens to be the original patentee and defendant in an action of infringement brought by the assignee; (b) and he is at liberty to show that the specification is not as wide as the plaintiff alleges. (c) Moreover, an assignor cannot be restrained from

(s) *Osborne v. Board*, (1896) 13 R. P. C. 748.

(t) *Bowman v. Taylor*, (1834) 2 A. & E. 278; 1 W. P. C. 292; *Cutler v. Bower*, (1848) 11 Q. B. 973; see Vol. II. p. 148.

(u) *Smith v. Scott*, (1859) 6 C. B. N. S. 771; 5 Jur. N. S. 1358; *Hall v. Conder*, (1857) 2 C. B. N. S. 22.

(x) *Dangerfield v. Jones*, (1865) 13 L. T. N. S. 142; *Axmann v. Lund*, (1874) L. R. 18 Eq. 330; *Crossley v.*

Dixon, (1863) 10 H. L. C. 293.

(y) See Vol. II. pp. 150, 151.

(z) *Ibid.*

(a) *Oldham v. Longmead*, (1789) cited 3 T. R. 441; *Walton v. Lavater*, (1860) 8 C. B. N. S. 162, 187; *Heugh v. Chamberlain*, (1877) 25 W. R. 742; but see Vol. II. pp. 115, 116.

(b) *Hocking & Co. v. Hocking*, (1889) 6 R. P. C. 69.

(c) *Ibid.*

**Defence.
Estoppel.**

Defendant a
former partner
of the plaintiff.

assisting, as a scientific witness or otherwise, the defendant in an action brought by the assignee. (*d*)

A patentee who has worked the patent in partnership with his co-patentee, but has dissolved partnership and assigned the whole of his interest in the patent to his former partner, is estopped from denying the validity of the patent in an action of infringement at the instance of such former co-patentee. (*e*) But a person who has worked a patent in partnership with the patentee, and during the partnership asserted its validity against various infringers, but refrained from taking legal proceedings, is not estopped from disputing the patent in an action brought by the patentee after the termination of the partnership. (*f*)

Agreement
may operate as
an estoppel.

In *Baird v. Neilson* (*g*) it appeared that *Baird* had agreed with *Neilson* to put an end to litigation and pay a royalty for the use of *Neilson's* patented invention. Subsequently *Neilson* brought an action against *Baird* for specific performance of the agreement, and *Baird*, in a cross action, sought to deny that what he was doing was an infringement, but the House of Lords held that the very object of the agreement was to put an end to the question of the particular thing done by *Baird* being an infringement, and that he was therefore estopped from setting up the defence.

Where, on an action being brought to enforce an agreement, the defendants gave an undertaking to the patentee not to sell certain grates having a patent canopy, without marking them in an agreed manner, it was held, on a motion to commit them for breach of the agreement, which motion was by consent turned into a motion for an injunction, that they were estopped from denying the validity of the plaintiff's patent. (*h*)

Defendant may
be estopped
from denying
validity of the
patent on a
motion for
interlocutory
injunction
though not at
the trial.

A defendant may be estopped from denying the validity of a patent on a motion for an interlocutory injunction, and yet not be so estopped at the trial.

Thus, where in a previous action judgment and costs had been given against the defendants, Lord *Hatherley*, then Vice-Chancellor *Wood*, on the hearing of a suit against the same defendants, for the infringement of the same patent, held that

(*d*) *London and Leicester Hosiery Co., Ltd. v. Griswold*, (1886) 3 R. P. C. 250, 253.

(*e*) *Chambers v. Crichley*, (1864) 33 Beav. 374; *Gouville v. Hay*, (1903) 21 R. P. C. 49.

(*f*) *Axmann v. Lund*, (1874) L. R. 18 Eq. 330.

(*g*) 8 C. L. & F. 726.

(*h*) *Crossthwaite v. Steel*, (1888) 5 R. P. C. 220.

if the plaintiffs had made an interlocutory application they would have been entitled to an injunction till the hearing; but, the question being as to a perpetual injunction, the right of the defendants to deny the validity of the patent was not barred. (i) And again, where it appeared that the patentee had formerly worked the patent in partnership with the defendants under an agreement reciting the patent, and during the partnership the defendants had joined the patentee as co-plaintiff in suits against various infringers, the same Judge held that, the partnership having been determined, and the defendants having commenced working the invention without the leave of the patentee, the latter was entitled to an interlocutory injunction against them before establishing the patent at law. (j)

Defence.
Estoppel.

Where it appeared that in a previous action tried in Scotland, and decided in favour of the plaintiff, the defendant had omitted to dispute the validity of the patent, he was not allowed to set up this defence on a motion for an interlocutory injunction in England. (k) But in an action for the infringement of a patent which had been declared valid in a previous arbitration between the plaintiff and defendant, the Court held that the defendant was not estopped from disputing it at the trial. (l)

A bankrupt patentee is not estopped from denying the validity of the patent against a purchaser from his trustee in bankruptcy, if there is nothing to show that the purchaser has bought on the faith of any representation made by the patentee. (m)

Assignment by trustee in bankruptcy no estoppel against the patentee.

When there is more than one defendant, an estoppel may affect only one of them. (n) Thus, in a case where it appeared that one defendant had, during the existence of a partnership between the plaintiff and the defendant, by his acts barred his right to dispute the validity of the patent against the plaintiff, the other defendant, who was not affected by the acts of his co-partner, was not estopped, in an action brought subsequent to the termination of the partnership, from disputing the patent. (o) But where two defendants, disputing

Estoppel may operate against one only of several defendants.

(i) *Goucher v. Clayton*, (1865) 11 Jur. N. S. 107.

(j) *Mantz v. Grenfell*, (1842) 2 W. P. C. 88, 91.

(k) *Dudgeon v. Thomson*, (1877) 30 L. T. N. S. 214.

(l) *Newall v. Elliott*, (1863) 1 H. & C. 797.

(m) *Cropper v. Smith*, (1884) L. R. 26 Ch. D. 700, 706; 10 App. Cas. 249; 1 R. P. C. 81; 2 R. P. C. 17.

(n) *Goucher v. Clayton*, (1865) 11 Jur. N. S. 107; *Heugh v. Chamberlain*, (1877) 25 W. R. 742.

(o) *Heugh v. Chamberlain*, (1877) 25 W. R. 742.

Particulars of Objections.

in the same interest, sever their defence, and one delivers particulars disputing the validity of the patent, but the other omits to do so, the latter is entitled to the benefit of such particulars, if proved, (*p*) provided he is not otherwise estopped from denying the validity of the patent. (*q*)

PARTICULARS OF OBJECTIONS.

Must be delivered with the defence, or by order of the Court or a Judge, at any subsequent time.

It is enacted by the Patents, Designs, and Trade Marks Act, 1883, (*r*) that the defendant in an action for infringement must deliver with his statement of defence, or by order of the Court or a Judge at any subsequent time, particulars of any objections on which he relies in support thereof. And, if he disputes the validity of the patent, the particulars must state on what grounds he disputes it; and, if one of those grounds is want of novelty, they must state the time and place of the previous publication or user alleged by him.

Evidence limited by particulars.

It is also by the same statute (*s*) further enacted that at the hearing of an action for infringement no evidence shall, except by leave of the Court or a Judge, be admitted in proof of any alleged objection of which particulars have not been delivered. (*t*)

As we have seen, particulars of objections do not stand in the place of, and cannot go beyond, the pleas raised by the defence; (*u*) and it is to be noticed that the Act of 1883 requires far more detail in the particulars of objections than in the particulars of breaches complained of by the plaintiff. (*x*)

Time for pleading after delivery of particulars.

The party at whose instance particulars are delivered under a Judge's order has, unless the order otherwise provides, the same length of time for pleading after the delivery of the particulars that he had at the return of the summons; and an order for particulars does not, unless the order otherwise provides, operate as a stay of proceedings, or give any extension of time. (*y*)

Costs of further and better particulars.

The party against whom an order for further and better particulars is made may be ordered to pay the costs of the

(*p*) *Cropper v. Smith*, (1885) L. R. 10 App. Cas. 249.

(*q*) *Heugh v. Chamberlain*, (1877) 25 W. R. 742; *Goucher v. Clayton*, (1865) 11 Jur. N. S. 107.

(*r*) s. 29. As to the disadvantages in giving an unnecessary multiplicity of objections, see *Allen v. Oates*, (1898)

15 R. P. C. 303.

(*s*) s. 29, sub-s. 4.

(*t*) See p. 454 *post*.

(*u*) p. 402 *ante*.

(*x*) pp. 395-401 *ante*.

(*y*) R. S. C. (1883) Order xix. r. 8; *Boyd v. Farrar*, (1883) 5 R. P. C. 33, 36.

application; (z) and if the party against whom the order is made does not comply with it, the proper course is for the other side to apply by summons in chambers to have the insufficient particulars struck out. (a)

Particulars of Objections.

A defendant complying with an order for further and better particulars is not entitled to give *fresh* particulars without having obtained leave to amend, and if he does insert them they may be struck out by the plaintiff on summons. (b)

Fresh particulars cannot be given in compliance with an order for further and better particulars.

It was decided that the notice of objections required by 5 & 6 Will. IV. c. 83, s. 5, to be delivered by a defendant in an action for infringement were not conclusive at his peril, but the Court or a Judge, under their general jurisdiction, as well as under the statute, might order a further and fuller notice. (c)

Amendment of particulars of objections.

Under the Act of 1883, the Court or a Judge has power to order the amendment from time to time of the plaintiff's or defendant's particulars; (d) as also has the Court of Appeal; (e) and if they are insufficient or too general, the opposite party, if he means to object to them, should at once apply, by summons at chambers or a motion in Court, (f) for an order for further and better particulars; otherwise, where the particulars are too general, evidence within their literal meaning may be admitted. (g) In the words of *Mellish*, L.J.: "There is a very large difference between a case where a Judge has been applied to and has ordered further particulars, in order to state an objection more specifically, and a case where at the trial the plaintiff asserts that the defendant ought to be prevented from availing himself of an objection. It is perfectly obvious that if . . . wherever the Court would order further particulars because the objection had not been particularly specified, it would also hold that the party was precluded from raising it at the trial, nobody would be foolish enough to apply to a Judge for further particulars." (h)

If, however, the defendant delivers his objections fairly and

(z) *Grover and Baker Sewing Machine Co. v. Wilson*, W. N. (1870) p. 78; *Penn v. Bibby*, (1866) L. R. 1 Eq. 518.

(a) *Flower v. Lloyd*, (1877) 20 S. J. 860; *Higgins' Digest*, Supplement p. 78; *Aktiebolaget Separator v. Dairy Outfit Co.*, (1896) 13 R. P. C. 725.

(b) *Aktiebolaget Separator v. Dairy Outfit Co.*, (1896) 13 R. P. C. 725, 727.

(c) *Bulnois v. Mackenzie*, (1837) 1 W. P. C. 260.

(d) s. 29 (5).

(e) *Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 530; *Britain v. Hirsch*, (1888) 5 R. P. C. 226; p. 396 *ante*; p. 483 *post*.

(f) *Judicature Act*, 1873, s. 39; *Frearson v. Loo*, (1878) 26 W. R. 138; R. S. C. (1883) Order xix. r. 7.

(g) *Hull v. Bollard*, (1856) 1 H. & N. 134; *Curtis v. Platt*, (1865) 35 L. J. N. S. Ch. 852, 868; *Sugg v. Silber*, (1876) L. R. 2 Q. B. D. 493.

(h) *Sugg v. Silber*, (1876) L. R. 2 Q. B. D. 495.

Particulars of Objections.

honestly and does his best to give the plaintiff the information he is entitled to, it is not the province of the Court by ordering amendments to tie his hands so tight as to dictate to him in an early stage of the proceedings how exactly he is to frame his case, (*i*) since the object of the particulars is only to prevent surprise, to limit the scope of the inquiry and to prevent expense.

Particulars of objections may be amended any time by leave of the Court or a Judge.

It is competent for the defendant at any time during the progress of an infringement action, with the leave of the Court or a Judge (*k*) upon terms, (*l*) to raise a fresh issue, especially on the discovery of facts which could not with due diligence have been discovered before, (*m*) and he will be allowed to amend his particulars of objections accordingly, though he may be liable for the costs occasioned by any such amendment. (*n*)

The defendant may, even during the progress of the trial, obtain leave on short service of motion to amend his particulars, (*o*) if he can show that the fresh evidence he is desirous of adducing could not with due diligence have been discovered earlier; (*p*) but if an amendment be made late, though the defendant succeed in the action and the action is dismissed, it may be so dismissed without costs. (*q*)

The Court will not sanction an amendment, if, on the face of it, it appears that the fresh objection cannot be sustained. (*r*)

Particulars on a new trial.

Where a new trial is obtained the defendant is entitled to give particulars of objections which were not raised at the first trial. (*s*)

Terms usually imposed when leave is given to amend particulars of objections.

The Court has an absolute discretion to impose such terms as it thinks fit upon giving leave to amend the particulars. (*t*) When leave to amend particulars of objections is given, the Court generally imposes terms, and the usual order, with the object of putting the plaintiff in the same position as he would have been in if the particulars had originally been delivered

(*i*) *Nettlefolds v. Reynolds*, (1891) 8 R. P. C. 417, per Lindley, L.J.; see also *Holliday v. Hippenstall*, (1889) 6 R. P. C. 320.

(*k*) 46 & 47 Vict. c. 57, s. 29, sub-s. 5.

(*l*) See *infra*.

(*m*) *Holste v. Robertson*, (1876) L. R. 4 Ch. D. 9; *Otto v. Steel*, (1885) 2 R. P. C. 139.

(*n*) *Renard v. Levinstein*, (1864) 13 W. R. 229; 11 L. T. N. S. 505; *Daw v. Eley*, (1865) L. R. 1 Eq. 38; *Blakey v. Latham*, (1889) 6 R. P. C. 29; *Brown v. Hastie*, (1904) 21 R. P. C. 446.

(*o*) *Ibid.*

(*p*) *Moss v. Malings*, (1886) L. R. 33 Ch. D. 603; *Edison Electric Co. v. Sheppey*, (1887) 4 R. P. C. 471; *Blakey v. Latham*, (1889) 6 R. P. C. 184.

(*q*) *Allen v. Horton*, (1893) 10 R. P. C. 412.

(*r*) *Holste v. Robertson*, (1876) L. R. 4 Ch. D. 9.

(*s*) *Bovill v. Goodier*, (1871) 36 L. J. N. S. Ch. 360.

(*t*) See *Woolley v. Broad*, (1892) 9 R. P. C. 429; *Wilson v. Wilson*, (1899) 16 R. P. C. 315.

in their amended form, gives the plaintiff time within which to elect whether he will discontinue the action, and orders the defendant, in the event of discontinuance, to pay all costs incurred by the plaintiff since delivery of the original particulars of objections, and only allows the objections to be amended in the event of the plaintiff not electing to discontinue, and makes the cost of the application, and consequent on the amendment, the plaintiff's in any event. (*u*)

The fact that the plaintiff was aware of the existence of the fresh objection which the defendant seeks to raise will not in itself entitle the defendant to an order on any more favourable terms. (*x*)

Though the Court in giving leave to amend has an unfettered discretion as to terms, (*y*) it appears to be the practice to impose such conditions as will, in the event of the plaintiff electing to discontinue, secure to him his costs subsequent to the delivery of the particulars in the form on which issue was last joined. Thus in *Ehrlich v. Ihlee*, (*z*) where issue had not been joined on the first amended particulars of objection, the plaintiff was, in the event of his electing to discontinue, given his costs subsequent to the delivery of the original particulars. On the other hand, in *Wilson v. Wilson*, (*a*) where the plaintiff had elected to continue, and had joined issue on the amended particulars of objections, it was made a condition of reamendment that the plaintiff, if he should elect to continue after the reamendment, should have his costs subsequent only to the date of delivery of the particulars as first amended. In a case decided before the Act of 1883, where a defendant in compliance with an order of the Court had amended his particulars of objections, and made an application for leave to reamend them by inserting further specified instances of alleged prior use which had come to his knowledge, he was ordered to pay the costs of the application, and the costs arising out of, and consequent on, the reamendment were reserved; (*b*) and where a cause was in the paper for hearing,

(*u*) *Baird v. Moule's Earth-closet Co.*, (1881) L. R. 17 Ch. D. 139; *Edison Telephone Co. v. Indiarubber Co.*, (1881) L. R. 17 Ch. D. 137; *Aveling v. Maclaren*, (1881) L. R. 17 Ch. D. 139; *Ehrlich v. Ihlee*, (1887) 4 R. P. C. 115, 119; *Darrar v. Purser*, (1889) 6 R. P. C. 365; *Solvo Laundry Supply Co. v. Mackie*, (1893) 10 R. P. C. 68; *Morris and Wilson & Co. v. Coventry Machinist's Co.*, (1891) 8 R. P. C. 353;

[1891] 3 Ch. 419; *Consolidated Pneumatic Tool Co. v. Churchill & Co.*, (1905) 22 R. P. C. 209.

(*x*) *Ehrlich v. Ihlee*, (1887) 4 R. P. C. 115.

(*y*) p. 414 *ante*.

(*z*) (1887) 4 R. P. C. 115.

(*a*) (1893) 16 R. P. C. 315.

(*b*) *Penn v. Bibby*, (1866) L. R. 1 Eq. 548.

Particulars of
Objections.

the defendant was, after giving notice to the plaintiff, allowed to give evidence, by affidavit, of prior user discovered after the cause was in the paper, but the terms imposed insured to the plaintiff an opportunity of filing affidavits in answer, and the costs of, and consequent on, the application were reserved. (c)

Order when plaintiff elects to continue before the terms of the order are settled.

When the plaintiff, at the hearing of an application by the defendant for leave to amend his particulars, elects to proceed with the action, or the leave to amend is obtained at the trial, and the terms of the order are reserved till the plaintiff makes his election and he elects to proceed, the order merely provides that the costs of the application, and all costs occasioned by the amendment, and costs unnecessarily caused to the plaintiff by reason of the amendment being made, shall be the plaintiff's in any event. (d)

Further evidence on appeal.

On an appeal the Court has power to receive further evidence, and to order an amendment of the particulars of objection for the purpose of admitting it; (e) but if the appeal is from a judgment after trial, this evidence, except as to matters subsequent to the judgment, can be admitted only on special grounds (*e.g.*, the party desiring to tender it has found a lost document), (f) and not without special leave. (g)

Particulars of objections must be precise and definite.

The particulars of objections must be precise and definite, and should not contain a long list of anticipations, of which only a few are relied on at the trial; (h) but they should give such information as will enable the plaintiff to make the necessary inquiries at any places named. (i)

Object of particulars of objections.

The Act of 1835 (k) was the first statute which specifically required the delivery of particulars of objections by the defendant to the plaintiff, and this was done, not to limit the defence, but to prevent the patent from being upset by any unexpected turn of the evidence, and to lessen the expense. (l) This object is similarly provided for by the Act of 1883. (m)

(c) *Wilson v. Gann*, (1875) W. N. (1875) 78.

(d) *Parker v. Maignen's Filtre Rapide Co.*, (1888) 5 R. P. C. 208; *Badische Anilin und Soda Fabrik v. La Société Chimiques Usines du Rhône*, (1897) 14 R. P. C. 875.

(e) *Cropper v. Smith*, (1884) 1 R. P. C. 81; 2 R. P. C. 17; *Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 530. As to the practice in Scotland, see *Brown v. Hastie*, (1904) 22 R. P. C. 85.

(f) *Hinde v. Osborne*, (1885) 2 R. P. C. 45.

(g) R. S. C. (1883) Order lviii. r. 4.

(h) *Thomson v. Batty*, (1889) 6 R. P. C. 84.

(i) Per Parke, B., *Palmer v. Cooper*, (1853) 9 Exch. 236.

(k) 5 & 6 Will. IV. c. 83, s. 5.

(l) See remarks of Tindal, C.J., *Fisher v. Dewick*, (1838) 1 W. P. C. 267; *Curtis v. Platt*, (1863) 8 L. T. N. S. 657.

(m) s. 29, sub-s. 2; *Holliday v. Heppenstall*, (1889) 6 R. P. C. 320; *Nettlefold's v. Reynolds*, (1891) 8 R. P. C. 417.

The particulars of objections must state clearly which individual claim or claims of the plaintiff's specification the defendant proposes to attack in respect of each objection. (n) Particulars of Objections.

A patent may be void on account of disconformity between the specifications, or in consequence of the claim being defective; (o) but, it is submitted, a defendant relying on either of these grounds cannot dispense with the necessity for delivering particulars of objections, for the Court will not undertake to decide as to the disconformity of the specifications or the validity of the claims without the evidence of witnesses, (p) which could not be given unless particulars had been previously delivered. (q) Particulars of disconformity.

If a defendant object that there is a disconformity between the specifications, he may be required to state in what the disconformity consists, or how the invention described in the complete differs from that described in the provisional specification. (r) So when it was stated that the invention described in the complete specification was different from that described in the provisional specification, and in particular the inventions described in certain pages and lines of the complete were not described in the provisional specification, the particular was held too wide, and the defendant was ordered to limit the allegation of variance to the particulars given. (s)

The objection that the patentee is not the true and first inventor does not raise the question of novelty generally, but only that some one other than the patentee was the true and first inventor, (t) and the defendant may now, probably, be required to state the name of the person alleged to be the true and first inventor, though this was not so under the practice prior to the Act of 1883. (u) True and first inventor.

When it is objected that the invention is not subject-matter the reason should be definitely stated. When other objections fail the objection that the invention is not subject-matter can rarely be made out. (x) Subject-matter.

Also when an objection is directed to the issue of prior grant Prior grant.

(n) See, e.g., *Birmingham Pneumatic Tyre Syndicate v. Reliance Tyre Co.*, (1900) 17 R. P. C. 277.

(o) *Chap. v. ante.*

(p) *Arnold v. Bradbury*, (1871) L. R. 6 Ch. App. 706; *Longbottom v. Shaw*, (1889) 6 R. P. C. 510.

(q) p. 412 *ante.*

(r) *Anglo-American Brush Electric Light Corporation v. Crompton*, (1886) L. R. 34 Ch. D. 152; *Fisher v. Dewick*,

(1838) 1 W. P. C. 551 n.

(s) *Heathfield v. Greenway*, (1894) 11 R. P. C. 17.

(t) *Thomson v. Macdonald & Co.*, (1890) 8 R. P. C. 5; *Househill Co. v. Neilson*, (1843) 1 W. P. C. 689.

(u) *Russell v. Ledsam*, (1843) 11 M. & W. 64.

(x) See per *Esher, M.R.*, *Edison-Bell Phonograph Corporation v. Smith and Young*, (1894) 11 R. P. C. 398.

Particulars of Objections.

it must state distinctly the grounds on which it is alleged that the patentee was not the first grantee, (*y*) and which of the plaintiff's claims are alleged to be included in the prior grant. (*z*)

Novelty.
Requisite details.

The Act of 1835 did not require any further detail in the defendant's particulars of objections than in the plaintiff's particulars of breaches, but the terms of the subsequent Act of 1852, (*a*) which are very similar to, though not quite so general as, the words of the Act of 1883, which regulates the present practice as regards particulars directed to the issue of want of novelty, required that the particulars of objection should state "the place or places at or in which and in what manner the invention is alleged to have been used or published prior to the date of the letters patent."

Since the Act of 1883 requires greater detail in the particulars of objections than did the Acts of 1835 and 1852, it follows that words which were held to be too general under the latter Acts will be too general under the Act of 1883, which regulates the present practice in patent actions.

Must not be too general.

Particulars of objection will be too indefinite if, for instance, they allege as an anticipation a user by certain persons specified, and "*divers other persons*," (*b*) or "*by other persons in London and Birmingham*," (*c*) or "*at Nottingham and elsewhere*," (*d*) or "*by manufacturers generally in London and the vicinity*," (*e*) and in such cases the words in italics may be ordered to be struck out. The particulars of objection must state whether the whole of the invention is alleged to have been anticipated, or whether a portion only is old, (*f*) and, if the invention deals with complicated machinery or with several distinct machines, the particulars must state which particular machines, or which portion of the invention, has been anticipated. (*g*)

General public or common knowledge.

The defendant in an action for infringement frequently relies on the invalidity of the patent on the ground that the

(*y*) *Rothwell v. Macintosh*, (1894) 11 R. P. C. 274; *Mica Insulator Co. v. Electrical Co.*, (1898) 15 R. P. C. 489.

(*z*) *Birmingham Pneumatic Tyre Syndicate v. Reliance Tyre Co.*, (1900) 17 R. P. C. 277.

(*a*) 15 & 16 Vict. c. 83, s. 41.

(*b*) *Galloway v. Bleaden*, (1839) 1 W. P. C. 268 *n.*; *Fisher v. Dewick*, (1838) 1 W. P. C. 551 *n.*

(*c*) *Flower v. Lloyd*, (1877) 20 S. J. 860.

(*d*) *Jones v. Berger*, (1843) 1 W. P. C. 544; *Holland v. Fox*, (1853) 1 C. L. R. 440.

(*e*) *Alliance Pure White Lead Syndicate v. MacIvor's Patents*, (1891) 8 R. P. C. 321; p. 420 *post*.

(*f*) *Fisher v. Dewick*, (1838) 1 W. P. C. 264; *Russell v. Ledsam*, (1843) 11 M. & W. 647.

(*g*) *Boyd v. Farrar*, (1888) 5 R. P. C. 33.

subject-matter of the alleged invention was matter of general public knowledge before the date of the patentee's application. A defendant who relies on general public knowledge as an objection must be careful not to refer to specific specifications, or other publications, as merely showing the state of general public knowledge, otherwise he may incur the costs of amending his particulars by striking out all such references. It is neither necessary nor proper for him to state in his particulars of objections the books or publications which contain that knowledge, but such general public knowledge should be proved by ordinary evidence, with a reference to well-known books, if necessary. (*h*)

Particulars directed to prior general public knowledge—*i.e.*, common knowledge—will not authorise the defendant to give in evidence prior specifications or rare books or users as anticipations. Such publications must be referred to in separate particulars; and if this is not done the defendant will only be allowed to make the amendment necessary to admit the evidence on the usual terms. (*i*) That is to say, although it is not necessary to specify every publication which is relied on as common knowledge the defendant is not allowed, without amendment of the particulars, to refer to an isolated specification under the pretence that it goes merely to common knowledge, whereas, in fact, it has so close a bearing on the plaintiff's patent that it ought to have been included in the particulars of objections; (*k*) and the same principle applies equally to cases where it is sought to get in, on the ground of common knowledge alone, several prior documents which ought to have been included in the particulars of objections, (*l*) but it would appear that particulars are not necessary if the fact it is sought to prove is *bonâ fide* relied on only for the purpose of fixing the ambit.

Prior specifications and rare books cannot be referred to under a plea of common knowledge.

(*h*) *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 556; *Cole v. Squire*, (1888) 5 R. P. C. 489; *Holliday v. Heppenstall*, (1889) 6 R. P. C. 320; *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 302; *Phillips v. Ivel Cycle Co.*, (1890) 7 R. P. C. 77; *Thomson v. Macdonald*, (1891) 8 R. P. C. 5; *King Brown v. Anglo-American Brush Corporation*, [1892] A. C. 367; 9 R. P. C. 313; *Cassel Gold Co. v. Cyanide Gold Co.*, (1895) 12 R. P. C. 232.

(*i*) *Edison Telephone Co. v. India Rubber Co.*, (1881) L. R. 17 Ch. D.

137; *Peckover v. Rowland*, (1893) 10 R. P. C. 118; *Solvo Laundry Supply Co. v. Mackie*, (1893) 10 R. P. C. 68; *English and American Machinery Corporation v. Union Boot and Shoe Machine Co.*, (1894) 11 R. P. C. 373; p. 414 *ante*.

(*k*) *English and American Machinery Co. v. Union Boot and Shoe Machinery Co.*, (1894) 11 R. P. C. 373, 374.

(*l*) *Peckover v. Rowland*, (1893) 10 R. P. C. 118; *Solvo Laundry Supply Co. v. Mackie*, (1893) 10 R. P. C. 68.

Particulars of Objections.

Distinction between issue of common knowledge and prior publication.

of a claim as distinct from disputing the validity of the patent. (*m*)

Common knowledge is really a different issue to prior publication, of which definite particulars must be given. Common knowledge goes to subject-matter and prior publication to novelty; and when common knowledge is pleaded it is not necessary to give particulars of it. (*n*) In framing a particular as to common knowledge care must be taken that it does not include or point to something of which a separate particular should be given, otherwise the plaintiff may be entitled to further and better particulars. (*o*) Thus, when the particular given was to the effect that "the alleged invention was not the subject-matter of valid letters patent, but was the mere analogous use and application to an old and well-known sewing machine of mechanical appliances and arrangements of parts well known and in common use in machines of a similar kind, and used for similar or analogous purposes, prior to the date of the said alleged Letters Patent," it was held not to be merely one of common knowledge, but to point to some particular mechanical appliance used in the machine as having been used previously to the date of the patent, and further and better particulars were ordered accordingly. (*p*)

A specification referred to in the particulars of objections as being an anticipation may be given in evidence at the trial on the points of common knowledge. (*q*)

Objection to general plea of want of novelty.

The general plea that the invention was not new is objectionable, as it may be said to be ambiguous in so far as it may go to general public knowledge or specific prior publications or users, of which detailed particulars are necessary. (*r*)

General user may be stated in general,

It may be that if the defendant relies on and states a general user in general terms—*e.g.*, the invention was previously to the patent in question used by persons engaged in the trade to which it refers, "*generally in London and the vicinity thereof*"—he is perfectly justified in so doing, and

(*m*) *Appleby's Twin Roller Chain, Ltd. v. Albert Eadie Chain, Ltd.*, (1899) 16 R. P. C. 325; *Holliday v. Heppenstall*, (1889) 6 R. P. C. 326; *Boxwell v. Cochran*, (1895) 12 R. P. C. 169.

(*n*) *Holliday v. Heppenstall*, (1889) 6 R. P. C. 326; *Boxwell v. Cochran*, (1895) 12 R. P. C. 169.

(*o*) *Chadburn v. Mechan*, (1895) 12

R. P. C. 120; *Birch v. Harrap*, (1895) 12 R. P. C. 431.

(*p*) *Birch v. Harrap*, (1895) 12 R. P. C. 431.

(*q*) *Sutcliffe v. Abbott*, (1902) 20 R. P. C. 51.

(*r*) *Singer v. Rudge Cycle Co.*, (1894) 11 R. P. C. 585.

does not inflict any hardship on the plaintiff, for proof of one person is not sufficient to prove a general user, and the plaintiff in such a case cannot complain of generality of statement, for the more general it is the more the defendant must prove under it. (s) In such a case the plaintiff is entitled by means of interrogatories to obtain the names and addresses of such manufacturers, and the places and dates of user. (t) An allegation of general public user must not, however, be in too indefinite terms. Thus, in a case in which the defendant's particulars of objections alleged previous user of the invention by "*carriage-builders generally throughout Great Britain,*" and also by "*various carriage-builders in or near London, Liverpool, Manchester, and Southampton, and various others of the principal towns of Great Britain,*" they were held to be insufficient. (u) On the other hand, an application which alleged the general user of an invention by a particular class of persons, consisting of lace makers at Nottingham, has been held to be sufficient. (x)

Particulars of Objections.

but not too indefinite terms.

The Court will sometimes allow general words such as "amongst others," (y) or "amongst other instances," (z) to remain in the particulars of objections, but it will take care that the plaintiff shall not be taken by surprise at the trial. (a)

In one case the defendants by their particulars of objections alleged that the method described by the plaintiff in his specification had been in ordinary and common use for forty years prior to the date of the patent. In further answers to interrogatories they gave a description of the particular method they relied on to support their plea of general user. At the trial, evidence was given of another method which had been used at a large number of places, and which appeared to be a complete anticipation of the plaintiff's invention. The plaintiff objected that no particulars had been given of this, and asked that the case might stand over. *Kay, J.*, held that the action must stand over, but at the plaintiff's risk as to costs, and that the defendants (whose

(s) *Palmer v. Wagstaff*, (1853) 8 Exch. 840; *Jones v. Berger*, (1843) 1 W. P. C. 517; *Bentley v. Keighley*, (1844) 7 M & G. 652; 8 Scott N. R. 372.

(t) *Alliance Pure White Lead Syndicate v. MacIvor's Patents, Ltd.*, (1891) 8 R. P. C. 321.

(u) *Morgan v. Fuller (No. 2)*, (1866)

L. R. 2 Eq. 297.

(x) *Jones v. Berger*, (1843) 1 W. P. C. 549.

(y) *Curtis v. Platt*, (1863) 8 L. T. N. S. 657.

(z) *Peun v. Bibby*, (1866) L. R. 1 Eq. 548.

(a) *Curtis v. Platt*, (1863) 8 L. T. N. S. 657, judgment of Wood, V.C.

Particulars of Objections.

witnesses had given many instances of this user) should be allowed to give particulars of further instances. The Judge refused an application to the effect that the plaintiff might have a certain time, after the delivery of the fresh particulars, to elect whether he would discontinue the action on paying costs up to the first delivery of particulars, but to get the subsequent costs. (b)

Specific prior users.

Where specific users are relied on the defendant is generally required to state the time and place of such users, (c) and to describe the thing alleged to have been used by a definite description, *e.g.*, by use of a *Wenham* lamp will not do, as that might be by any lamp made by *Wenham*. (d)

The particulars will be sufficient if they state definitely the kind of article, the prior sale, manufacturer, or user of which it is alleged anticipates the patent, the names of the alleged prior sellers, manufacturers, or users, and the dates. (e) The particulars must, however, state the mode in which the alleged prior user anticipates the invention. (f)

We have seen that the Act of 1852 required the particulars of objections, if prior user was relied on, to state "the place or places at or in which, and in what manner, the invention was alleged to have been used or published prior to the date of the letters patent;" (g) whereas the words of the Act of 1883 are to the effect that if one of the grounds on which the defendant disputes the validity of the patent is want of novelty he "must state the time and place of the previous publication or user alleged by him." (h)

In consequence of the similarity between the wording of these two statutes, the cases decided under the former are important, as bearing on the construction which will probably be placed on the latter enactment as occasion requires.

In *Flower v. Lloyd* (i) the Court of Appeal held that the particulars of objections could not be required to go beyond the words of the Act, and varied the order of the Court below,

(b) *Pascall v. Toope*, (1890) 7 R. P. C. 125.

(c) *Holliday v. Heppenstall*, (1889) 6 R. P. C. 320; *Boyd v. Horrocks*, (1886) 3 R. P. C. 281; *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 302; *Philips v. Ivel Cycle Co.*, (1890) 7 R. P. C. 82; *Heathfield v. Greenway*, (1894) 11 R. P. C. 17; *Siemens v. Karo*, (1891) 8 R. P. C. 376.

(d) *Siemens v. Karo*, (1891) 8 R. P. C. 376; *Palmer v. Wagstaffe*, (1853) 8

Ex. 840; *Boyd v. Farrar*, (1837) 5 R. P. C. 35; *Sidebottom v. Fielden*, (1891) 8 R. P. C. 272; *Alliance Pure White Lead Syndicate v. MacIvor*, (1891) 8 R. P. C. 321.

(e) *Sidebottom v. Fielden*, (1891) 8 R. P. C. 266.

(f) *Scott v. Hull Steam Fishing and Ice Co.*, (1896) 13 R. P. C. 206.

(g) p. 418 *ante*.

(h) s. 29 (3).

(i) (1877) 46 L. J. Ch. 746; 20 S. J. 860.

which required the defendants to state "the names and addresses of the persons by whom, and the places where, and the dates at, and the manner in which" the invention had been publicly practised in *England* before the date of the patent, by requiring the defendants to state "the place or places at or in which, and in what manner" the invention was known or publicly practised in *England* before the date of the patent. In pursuance of this order, the defendants delivered particulars alleging prior user by three persons, whose names and addresses were given, and by other persons in *Birmingham* and *London* respectively. On summons for better particulars, the Judge held them to be insufficient, and ordered the defendants to give the names and addresses of the other persons in *Birmingham* and *London* by whom the patented process had been previously used, and pointed out that if they could not give further information the words in italics were useless, and ought to be struck out.

Particu-
lars of
Objections.

According to the practice under the Patents Act, 1883, as was the case under the Act of 1852, the plaintiff is entitled to the names and addresses (*i.e.*, the present residences) (*k*) of the persons by whom prior user was alleged to have been made, as well as the places where the prior user took place; (*l*) and, further, where the plaintiff or the defendant, as the case may be, makes out a proper case, the Court has jurisdiction to order interrogatories to be answered, notwithstanding the provision in the Act for the delivery of particulars. (*m*) The common practice is to ask for further and better particulars. (*n*) Where the defendants objected that there was a prior American patent which had been surrendered; that the invention had been published in certain journals of specified dates, and in sketches and drawings in the Patent Office Library; and also alleged prior user, it was held that better particulars ought to be given, specifying the date, name of patentee, and time of surrender of the alleged American patent, and the pages of the journals, also identifying the drawings, and the order as to prior user ought to be in the terms of *Flower v. Lloyd*. (*o*)

It is to be observed that the Act of 1852 required the *place* Different
requisites

(*k*) *Palmer v. Cooper*, (1853) 9 Exch. 236.

(*l*) *Birch v. Mather*, (1883) L. R. 22 Ch. D. 629; *General Electric Co., Ltd. v. Safety Lift and Elevator Co.*, (1903) 21 R. P. C. 109.

(*m*) *Ibid.*

(*n*) See *General Electric Co., Ltd. v. Safety Lift and Elevator Co.*, (1903) 21 R. P. C. 114.

(*o*) *Plimpton v. Spiller*, (1877) 20 S. J. 859; see p. 422 *ante*.

Particulars of Objections.

under Acts of 1852 and 1883 respectively.

and *manner, &c.*, of prior publication to be stated in the particulars of objection, whereas the Act of 1883 requires a statement of the *time* and *place* of such prior publication. And it has been held that, if a defendant under the latter Act disputes the patent on the ground of want of novelty, he must state reasonably on what ground, in respect of want of novelty, he disputes it, and he must also state the time and place of the previous publications or user alleged by him. (*p*)

In *Curtis v. Platt*, (*q*) the particulars of objection, which were furnished under an order requiring a statement of "the place where, and the earliest date at which," certain alleged anticipating machines had been made, stated a list of thirteen persons and firms, and that, in all the cases, the user had been at the earliest from 1825 downwards; and, in answer to the contention that they ought to state in each instance the place at which the first machine had been made and the date of making, Lord *Hatherley*, then Vice-Chancellor *Wood*, ordered an amendment, on the ground that, as regarded the date of user and the place of user of the machines, the defendants were bound to give the plaintiff all the information they themselves possessed.

The defendants in this case were also ordered to amend an objection alleging prior publication in books, &c., with a mere general reference, by stating the particular work or document and the volume of that work in which the alleged prior publication was to be found. (*r*)

Requisites of a particular directed to publication by prior specifications or printed books.

A defendant who relies on prior specifications, (*s*) or printed books, (*t*) must point out, by reference to pages and lines, what portions of such specifications or books he relies on; (*u*) but it must be remembered that it is *primâ facie* for the defendant to say what portions he relies on, and against which of the plaintiff's claims each portion is to be used. (*x*) Where particulars of objection stated, with regard to a certain alleged anticipating specification, "the parts relied upon are the whole specification but more particularly" certain specified portions, an order was obtained requiring their amendment

(*p*) *Fowler v. Gaul*, (1886) 3 R. P. C. 247, 250; *Boyd v. Horrocks*, (1886) 3 R. P. C. 285; *Darrah v. Purse*, (1889) 6 R. P. C. 365.

(*q*) (1863) 8 L. T. N. S. 657.

(*r*) *Ibid.*

(*s*) *Fowler v. Gaul*, (1886) 3 R. P. C. 247.

(*t*) *Harris v. Rothwell*, (1886) 3 R.

P. C. 243.

(*u*) See *Grover and Baker Sewing Machine Co. v. Wilson*, W. N. (1870) 78; *Fisher v. Dewick*, (1838) 1 W. P. C. 264; *Plimpton v. Spiller*, *Higgins' Supplement*, p. 79.

(*x*) See *Edison-Bell Consolidated Phonograph, Ltd. v. Columbia Phonograph Co.*, (1900) 18 R. P. C. 4.

by striking out the words denoting reliance on the whole specification, but the defendant was held to be at liberty to specify other pages and lines beyond those already referred to. (y) A defendant is entitled to rely on the whole of a specification if necessary, and cannot be forced to point out special parts, unless it appears that no attempt at discrimination has been made. (z) When, however, specifications or other publications are relied on, and the whole is stated to be relied on, it is always in the discretion of the Court to see how far the defendant really does rely on the whole, and to order further particulars if it thinks fit; and each case must be considered on its own merits. (a) A defendant may be required to state in the particulars of objection, by means of a reference to the claiming clauses of the plaintiff's specification, what portion or portions of the invention or inventions, as the case may be, he alleges have been anticipated and published, (b) or have been the subject of a prior grant, (c) and he may be compelled to refer to pages and lines of any anticipating documents which he alleges as publications of any of the plaintiff's claims. (d)

Particulars of Objections.

Where a specified machine was relied on, *Kay, J.*, held it was not necessary to state which of the plaintiff's claims it infringed, as he must be taken to understand his own patent well enough to be able, when he saw the machine, to judge how far it was or was not an anticipation of his invention. (e) And objections which referred to certain specified machines as anticipations of particular claims in the specification were held sufficient, notwithstanding the fact that the owner of some of the machines refused to allow the plaintiff to inspect them, and the defendants were not sure whether some of the others were in existence. (e)

Requisites of a particular directed to publication by a machine.

If it be objected that the complete specification does not sufficiently describe and ascertain the invention and in what manner the same is to be performed, it is not sufficient for the particulars to state merely that the directions given are not

Requisites of a particular directed to insufficiency of specification.

(y) *Harris v. Rothwell*, (1886) 3 R. P. C. 243.

(z) *Sidebottom v. Fielden*, (1891) 8 R. P. C. 266.

(a) *Siemens v. Karo*, (1891) 8 R. P. C. 376.

(b) *London and Leicester Hosiery Co. v. Higham*, *Lawson on Patents*, 3rd ed. p. 610; *Harris v. Rothwell*, (1886) 3 R. P. C. 243; *Fowler v. Gaul*,

(1886) 3 R. P. C. 247; *Boyd v. Horrocks*, (1886) 3 R. P. C. 258; *Boyd v. Farrar*, 5 R. P. C. 33, 36.

(c) *Birmingham Pneumatic Tyre Syndicate v. Reliance Tyre Co.*, (1900) 17 R. P. C. 277.

(d) *Jones v. Berger*, (1843) 1 W. P. C. 551 n.

(e) *Boyd v. Farrar*, (1888) 5 R. P. C. 33, 35.

Particulars of
Objections.

sufficient to enable a workman skilled in the manufacture to which the patent relates to make a machine the subject of the invention, and if the defendant is in a position to give better particulars he must state in what respect the specification is insufficient. (*f*) But in a case under the Act of 1834 it was held that, if the plaintiff was content to accept as notice an objection that the specification was insufficient, any objection showing insufficiency at the trial might be taken. (*g*)

Also where the objection is that the specification is ambiguous and misleading it is necessary to state definitely in what respect it is alleged to be ambiguous and misleading. (*h*) Where the allegation is that the specification does not distinguish what is new from what is old the mere statement is sufficient. (*i*)

Greater detail is required under Act of 1883 than under the former practice.

The effect of the Act of 1883 and the recent cases is to require far greater detail in the particulars of objections than was formerly necessary, and particulars simply alleging that the specification does not describe the most beneficial method of practising the invention known to the patentee, (*k*) or that it is calculated to deceive, (*l*) or does not sufficiently set forth the nature of the invention, (*m*) or that the invention does not produce the effect stated, (*n*) which were held sufficient under the old practice, would most probably not be held so now.

Objection directed to non-payment of fees.

Under the practice prior to the Act of 1883, a defendant could, at the trial, take the objection that the patent was improperly stamped, without having raised it in the particulars. (*o*) It is, however, submitted that, if a defendant now desires to take the analogous objection that the patent is void for non-payment of duties, the particulars must refer to the fact.

(*f*) *Crompton v. Anglo-American Brush Corporation*, (1886) L. R. 35 Ch. D. 283; *Leaf v. Topham*, (1845) 14 M. & W. 146; *Heathfield v. Greenway*, (1894) 11 R. P. C. 17; *Heath v. Unwin*, 1 W. P. C. 551 n.

(*g*) *Neilson v. Harford*, (1811) 1 W. P. C. 332.

(*h*) *Farbenfabriken vorm F. Bayer v. Bowker*, (1891) 8 R. P. C. 391; *Heathfield v. Greenway*, (1894) 11 R. P. C. 17.

(*i*) See, e.g., *Delta Metal v. Maxim-Nordenfelt Guns and Ammunition Co.*,

(1891) 8 R. P. C. 170; *Thomson v. Batty*, (1888) 6 R. P. C. 88; *Fisher v. Dewick*, (1838) 1 W. P. C. 551 n.; *Jones v. Berger*, (1843) 5 M. & G. 208; *Baker v. Kinnell*, (1893) 9 R. P. C. 443.

(*k*) *Jones v. Berger*, (1843) 5 M. & G. 203; W. P. C. 546.

(*l*) *Neilson v. Harford*, (1811) 1 W. P. C. 324 n.

(*m*) *Heath v. Unwin*, (1842) 10 M. & W. 687.

(*n*) *Jones v. Berger*, (1843) 1 W. P. C. 551 n.

(*o*) *Hindmarch on Patents*, 438.

INTERLOCUTORY INJUNCTION.

§ Inter-
locutory
Injunction.

If the plaintiff in a patent action, as is usually the case, desires to obtain an interlocutory injunction restraining the defendant from continuing the acts complained of, or commencing to commit threatened infringements, till the trial of the action, he ought to commence the action expeditiously on becoming aware of infringements or threats to infringe and apply to the Court, *ex parte*, or on notice, and in either case without delay. (p)

An application for an interlocutory injunction may be made to the Court or a Judge. (q) In the Chancery Division the usual course is to proceed by way of motion in Court, and in the King's Bench Division the usual course is to proceed by way of summons heard by the Judge in Chambers.

In order to obtain an interlocutory injunction it is necessary for the plaintiff, in addition to not being guilty of *laches*, to establish a *prima facie* case of validity of the patent and of the fact of infringement. Where the plaintiff makes out a really strong *prima facie* case upon these two points and is not guilty of *laches* an interim injunction is properly granted even though the defendant offers to keep an account. (r)

On an interlocutory application the Court avoids as far as possible expressing an opinion on the merits of the case, (s) and does not decide the question of validity unless the patent appears on the face of it so irretrievably and hopelessly bad that it could not possibly be supported. (t) The Court endeavours to keep things *in statu quo*. (u)

Former proceedings between the parties and a disputed compromise may constitute a bar to an interim injunction. (x)

Acquiescence is a bar to the right to an interim injunction. Thus, an interim injunction was dissolved by *Cottenham*, L.C., where it appeared that the plaintiff, about two years before he

(p) *Bacon v. Jones*, (1839) 4 My. & Cr. 436; *Baxter v. Coolidge*, (1850) 1 Ir. Ch. R. 284; *Bridson v. Benecke*, (1849) 12 Beav. 1; *Bovill v. Crato*, (1865) L. R. 1 Eq. 388; *Lister v. Norton*, (1884) 1 R. P. C. 114; *United Telephone Co. v. Equitable Telephone Co.*, (1888) 5 R. P. C. 235; *Leonhardt v. Kellé*, (1894) 11 R. P. C. 534.

(q) 46 & 47 Vict. c. 57, s. 30; Vol. II. p. 215.

(r) *Dunlop Pneumatic Tyre Co. v. Hubbard Patents and Tyre Syndicate*,

Ld., (1902) 19 R. P. C. 546.

(s) *Plimpton v. Malcolmson*, (1875) L. R. 20 Eq. 38.

(t) *Briggs v. Lardoux*, (1884) 1 R. P. C. 126; *Shillito v. Lannuth*, (1885) 2 R. P. C. 1; *Plimpton v. Malcolmson*, (1875) L. R. 20 Eq. 38; *Tadman v. Owens*, (1894) 11 R. P. C. 349.

(u) *Plimpton v. Spiller*, (1877) L. R. 4 Ch. D. 288.

(x) *Roberts v. Graydon*, (1903) 20 R. P. C. 578.

Inter-
locutory
Injunction.

applied to the Court, was aware that the defendants were at considerable expense in preparing and erecting apparatus for the purpose of using the patented invention, and never interfered to stop them, but permitted them to go on in the expectation that they would pay the royalties required. (z) Acquiescence also may at the trial of the action be a ground for granting damages instead of an injunction. (a)

The conduct of a plaintiff who knows of the existence of a patent of later date than his own for the same invention, but takes no steps to get it repealed, does not amount to acquiescence, unless the invention is actually put in practice under the subsequent patent. (b)

Laches.

Unexplained delay is a bar to an interlocutory injunction, both when the patent has not been previously contested (c) and when it has been established in prior proceedings. (d) In case of delay the defendant may be able to plead a growth of trade which would not have arisen but for the plaintiff's *laches*, and the Court will not interfere with it pending a final decision as to the validity of the patent and the fact of infringement. (e)

Thus, a plaintiff was held to be too late who applied on December 2 for an interim injunction in respect of infringement committed on November 13 and 23. (f)

And where the plaintiff knew in December what the defendant was doing, but did not move for an injunction till the following July, he was held too late, notwithstanding that he had obtained judgments by default in several earlier actions. (g) So, again, a plaintiff was too late where it appeared that he had known of the defendant's conduct for eleven months before moving. (h)

Delay in prosecuting a pending action.

Avoidable delay caused by the plaintiff in one pending action may be a sufficient ground for refusing an interlocutory

(z) *Neilson v. Thompson*, (1841) 1 W. P. C. 275, 285.

(a) *Sayers v. Collyer*, (1885) L. R. 28 Ch. D. 103.

(b) *Newall v. Wilson*, (1852) 2 De G. M. & G. 282.

(c) *Bacon v. Jones*, (1839) 4 My. & Cr. 436; *Baxter v. Coombe*, (1850) 1 Ir. Ch. R. 284; *Bridson v. Benecke*, (1849) 12 Beav. 1, 3; *Bovill v. Crate*, (1865) L. R. 1 Eq. 388; *Lister v. Norton*, (1884) 1 R. P. C. 114; *United Telephone Co. v. Equitable Telephone Co.*, (1888) 5 R. P. C. 235; *Leonhardt v. Kallé*, (1894) 11 R. P. C. 534; *Dunlop Pneumatic Tyre Co. v. Pneu-*

matic Tyre Co., (1897) 14 R. P. C. 263; *Aluminium Co. v. Domeire*, (1897) 15 R. P. C. 32.

(d) *North British Rubber Co. v. Gormully and Jeffery Manufacturing Co.*, (1894) 12 R. P. C. 21.

(e) *Ibid.* 17; p. 486 *post*.

(f) *Greer v. Bristol Tanning Co.*, (1885) 2 R. P. C. 268.

(g) *Edison-Bell Phonograph Corporation v. Hough*, (1894) 11 R. P. C. 594; see also *Actien Gesellschaft für Cartonagen Industrie v. Temler*, (1899) 16 R. P. C. 447.

(h) *Leonhardt v. Kallé*, (1894) 11 R. P. C. 534.

injunction in subsequent actions where the defendants are willing to keep an account. (i)

Delay in some cases is capable of a satisfactory explanation, and then it is no longer a bar to the injunction.

Thus, where it appeared that the plaintiff had on several previous occasions established his patent, and there was a combination of persons against him interested in resisting his claims, in consequence of which he waited till he had established his patent again against one of the members of this combination before proceeding against the other members, his conduct was held to be no bar to an interlocutory injunction. (k)

Again, where the plaintiffs, in February, received notice from the solicitors to a company that the company was being formed for the purpose of manufacturing an article which might possibly be an infringement of the plaintiff's patent, and inspection was offered, the Court held that they were not too late in applying, in March, for an interlocutory injunction, the delay being sufficiently explained on the ground that they had been advised not to apply for it till the company had raised a substantial capital, and had actually commenced to manufacture the infringing article. (l) And an interim injunction was granted, when the plaintiff became aware of the infringement on March 23, but spent some time in making inquiries before giving the defendant notice to desist on May 8, and continued in correspondence with him till the bill was filed on July 7. (m)

A plaintiff is not to be held guilty of *laches* disentitling him to an interim injunction merely on the ground that the infringement was committed under the supposed protection of a patent, of the existence of which he had knowledge some time before the commencement of the action. (n)

But where a defendant contended that he was working under a patent of his own, which he maintained was valid, *Cottenham*, L.C., in refusing an interim injunction, said: "It would be rash in me if I were to give an opinion, coming to a conclusion contrary to what is sworn by the most eminent scientific persons in this country. If in a question so open to doubt as

Inter-
locutory
Injunction.

Delay may
sometimes be
satisfactorily
explained.

Defendant
working under
a patent of his
own.

(i) *Welsbach Incandescent Gas Light Co. v. General Incandescent Co.*, (1901) 18 R. P. C. 533.

(k) *Bovill v. Smith*, (1867) W. N. 240.

(l) *United Telephone Co. v. Equit-*

able Telephone Association, (1888) 5 R. P. C. 233.

(m) *Losh v. Hague*, (1837) 1 W. P. C. 201.

(n) *Osmund v. Hirst*, (1885) 2 R. P. C. 265, 267.

Inter-
locutory
Injunction.

this I should interfere with the defendant I should be setting up my own judgment in opposition to those who, being practically acquainted with matters of this description, have deposed that, according to all rules and principles, the subject-matter of the defendant's patent may be perfectly new and unconnected with anything claimed by the plaintiff. I may not be satisfied that these gentlemen are right, or that the plaintiffs are wrong, but I am satisfied that the case is not one so free from doubt as to justify me in interfering." (o)

Persons other
than the
defendant who
could establish
a case of *laches*.

Where as against the actual defendant there has been no *laches*, it cannot be contended in his favour that there are other persons or that the defendant even is merely the agent of such another person not a party to the action, who would have been able to establish a complete case of *laches* if the action had been brought against them or him. (p) But where the defendant is merely the customer of another, against whom there is a pending action in which an interlocutory injunction has been refused, on an undertaking to pay money into Court and keep an account, most probably the injunction will not be granted and the motion will be dismissed with costs on the ground that it ought not to have been made at all. (q)

Ex parte appli-
cation for an
interlocutory
injunction.

The rule laid down by Lord *Eldon*, L.C., in *Hill v. Thompson*, (r) is that when an injunction is applied for *ex parte*, on the ground of violation of the rights to an invention secured by patent, 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.

It is submitted that in the case of a plaintiff having a derivative title the above rule will be satisfied if he swears that in his belief the original patentee was the first and true inventor.

(o) *Electric Telegraph Co. v. Nott*, (1847) 11 Jur. 157; 2 Coop. C. C. 41. See also *Morgan v. Seaward*, (1837) 1 W. P. C. 167; *Muntz v. Vivian*, (1840) 2 W. P. C. 87.

(p) *Pneumatic Tyre Co. v. Warri-
low*, (1896) 13 R. P. C. 284.

(q) *Pneumatic Tyre Co. v. Goodman*,

(1896) 13 R. P. C. 723.

(r) *Hill v. Thompson*, (1817) 1 W. P. C. 231; see also *Sturtz v. De la Rue*, (1828) 5 Russ. 322, 329; *Gardner v. Broadbent*, (1856) 2 Jur. N. S. 1011; *Whitton v. Jennings*, (1860) 1 Dr. & Sm. 110; *Mayer v. Spence*, (1860) 1 J. & H. 87.

Not only must a patentee applying for an *ex parte* injunction comply with the above-mentioned rule, but he must in all other respects exercise perfect good faith, and put the Court in possession of all the facts within his knowledge bearing on the question whether an injunction ought under the circumstances to be granted or not. (s)

Inter-
locutory
Injunction.

The Court does not commonly grant injunctions on *ex parte* applications, but the usual course is to make an order extending over a specified day, liberty being given to the applicant to serve short notice of motion for the day before that on which the order expires, and the applicant is required to give an undertaking to abide by the order of the Court as to any damages the defendant may be put to by reason of the interim order, such other terms being imposed upon him as the case may require. (t)

Usual course
on *ex parte*
applications.

The question of the validity of the patent, though not decided on an interlocutory application, is, and ought to be, an important consideration with the Court when determining whether or not to grant an interim injunction. (u)

Validity of the
patent is an
important
question |
on motion for
interlocutory
injunction.

The Court will, in the words of *Jessel*, M.R., "grant an injunction before the hearing, where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the Court to say that, as against himself, there is no reason to doubt the validity of the patent." (x)

If there is any *estoppel* against the defendant raising the question of the validity of the patent in the action, (z) of course it is treated as valid upon a motion for an interlocutory injunction.

The rule was laid down and acted upon previously to the Act of 1883, that an interim injunction will be refused where

Where the pa-
tent is recent
and has not

(s) *Dalglish v. Jarvie*, (1850) 2 Mac. & G. 231; *Curtis v. Cutts*, (1839) 3 Jur. 31.

(t) *Daniell's Chancery Practice*, 6th ed. p. 1611; *Moser v. Jones*, (1893) 10 R. P. C. 368.

(u) *Jackson v. Needle*, (1884) 1 R. P. C. 172, 177; *Bridson v. McAlpine*, (1846) 8 Beav. 229, 230; *Neilson v. Thompson*, (1841) 1 W. P. C. 278.

(x) *Dudgeon v. Thomson*, (1877) 30 L. T. N. S. 244; S. C. 23 W. R. 464; see also *Hill v. Thompson*, (1817) 3

Mer. 622; S. C. 1 W. P. C. 229, 231; *Universities of Oxford and Cambridge v. Richardson*, (1806) 6 Ves. 689, 707; *Stevens v. Keating*, (1847) 2 W. P. C. 177; *Hamar v. Plane*, (1809) 14 Ves. 130; *Bickford v. Skewes*, (1837) 1 W. P. C. 211, 213; *Electric Telegraph Co. v. Nott*, (1847) 2 Coop. Ch. Cas. 41; *Wilson v. Tindal*, (1841) 1 W. P. C. 730; *Renard v. Levinstein*, (1864) 10 L. T. N. S. 54; *Davenport v. Jepson*, (1862) 4 De G. F. & J. 440.

(z) See p. 406 *ante*.

Inter-
locutory
Injunction.

been ques-
tioned an in-
junction is
refused.

Presumption
in favour of
validity arises
from long un-
interrupted
enjoyment.

the patent is recent and its validity has not been established, (a) and this rule is still acted upon notwithstanding the investigation and protection afforded to the public by secs. 10 and 11 of the Act of 1883; (b) provided, of course, there is no *estoppel* preventing the question of the validity of the patent being raised *inter partes*. (c)

An important factor is the strength of the presumption in favour of the validity of the patent. A presumption in favour of the validity of the patent may arise from long enjoyment, a prior action resulting in a declaration of validity, or other circumstances. Where there has been long enjoyment under a patent the presumption in favour of its validity is based on the consideration that it was in the power of anybody to have obtained the repeal of the patent by *scire facias* before 1884 and on petition for revocation since that date, yet no one has done so. (d)

Where it is established to the satisfaction of the Court that the plaintiff has been in long, active, (e) and uninterrupted (f) enjoyment of the patent, an interim injunction will be granted, notwithstanding that the validity of the patent may be doubtful; for if a party gets his patent and puts his invention in execution, and has proceeded to a sale, that may be called possession under it, however doubtful it may be whether the patent can be sustained; and possession under colour of title is ground enough to enjoin and to continue the injunction till it is proved that it is only colour and not real title; (g) provided that the enjoyment has been sufficiently long, and the patent is not on the face of it so irretrievably and hopelessly bad that it is clear it cannot be supported. (h)

Thus, where a patentee had been in possession of his exclusive privilege for several years, and a defect in the

(a) *Caldwell v. Van Vlissingen*, (1851) 9 Harc, 424; *Plimpton v. Malcolmson*, (1875) L. R. 20 Eq. 38; *Jackson v. Needle*, (1884) 1 R. P. C. 174, 177; *Lister v. Norton*, (1884) 1 R. P. C. 114; *Holophane, Ltd. v. Berend*, (1897) 15 R. P. C. 19.

(b) *Jackson v. Needle*, (1884) 1 R. P. C. 117; *Wapshare Tube Co. v. Hyde Imperial Rubber Co.*, (1901) 18 R. P. C. 374; *Spencer v. Holt*, (1902) 20 R. P. C. 144.

(c) See *Wapshare Tube Co. v. Hyde Imperial Rubber Co.*, (1901) 18 R. P. C. 379.

(d) *Stevens v. Keating*, (1847) 2 W. P. C. 176; *Davenport v. Jepson*, (1862)

4 De G. F. & J. 440; *Caldwell v. Van Vlissingen*, (1851) Harc, 415, 424; *Electric Telegraph Co. v. Nott*, (1847) 2 Coop. Ch. Cas. 41; 46 & 47 Vict. c. 57, s. 26.

(e) See *supra*.

(f) *Ibid*.

(g) See judgment of Eldon, L.C., *Universities of Oxford and Cambridge v. Richardson*, (1806) 6 Ves. 706; *Dudgeon v. Thomson*, (1877) 30 L. T. N. S. 244; *Betts v. Menzies*, (1857) 3 Jur. N. S. 357, 358; *Gardner v. Broadbent*, (1856) 2 Jur. N. S. 1041.

(h) p. 433 *post*; *Briggs v. Lardeur*, (1884) 1 R. P. C. 126; *Shillito v. Larmuth*, (1884) 2 R. P. C. 1.

specification was suggested, the Court refused to allow the privilege to be disturbed until the question of title had been decided; (i) and an injunction has been granted in the face of a prior specification, which seemed to be fatal. (k)

Inter-
locutory
Injunction.

It is not necessary for the plaintiff, on motion for an interim injunction, to state that the patent has never been disputed, nor is the mere assertion that the patent is invalid sufficient to determine the Court to withhold the injunction. (l)

If the plaintiff relies on long enjoyment as entitling him to a presumption in favour of the validity of his patent on an application for an interim injunction, it is incumbent on him to show that he has actually used the invention. Thus, an injunction was refused where the plaintiff was only able to produce evidence of actual user at a recent period, notwithstanding that the patent was ten years old. (m)

It is also incumbent on the plaintiff to show that his enjoyment of the monopoly has been an uninterrupted one; (n) and it has been held that where the invention is of such a nature that it cannot be exercised without the licence of a prior patentee, the plaintiff's undisturbed enjoyment only commences from the expiration of the prior patent, and where this amounts to only one year the injunction must be refused. (o)

In regard to the length of uninterrupted and active enjoyment of the monopoly claimed under a patent which will establish a presumption in favour of the validity of the patent, and so entitle a plaintiff to an interim injunction, thirteen, (p) twelve, (q) eleven, (r) ten, (s) nine, (t) eight, (u) seven, (x) and six (y) years have, on different occasions, been held to be sufficient.

Length of un-
interrupted
active enjoy-
ment sufficient
to raise a pre-
sumption in
favour of
validity.

(i) *Muntz v. Foster*, (1843) 2 W. P. C. 93, 95.

(k) *Losh v. Hague*, (1837) 1 W. P. C. 201.

(l) *Read v. Andrew*, (1885) 2 R. P. C. 119, 122.

(m) *Plimpton v. Malcolmson*, (1875) L. R. 20 Eq. 38.

(n) *Collard v. Allison*, (1839) 4 My. & Cr. 487; *Curtis v. Cutts*, (1839) 8 L. J. N. S. Ch. 184; 2 Coop. C. C. 60; *Hill v. Thompson*, (1817) 3 Mer. 622.

(o) *Hugh v. Magill*, (1877) W. N. 62.

(p) *Hamar v. Plane*, (1809) 14 Ves. 130; *Read v. Andrew*, (1885) 2 R. P. C. 119; *Stevens v. Keating*, (1847) 2 W. P. C. 176.

(q) *Neilson v. Thompson*, (1841) 1 W. P. C. 277, 279.

(r) *Wilson v. Tindal*, (1841) 1 W. P. C. 730.

(s) *Sbillito v. Larmuth*, (1884) 1 R. P. C. 1.

(t) *Davenport v. Richard*, (1865) 3 L. T. N. S. 503; *Howes v. Webber*, (1894) 11 R. P. C. 586.

(u) *Betts v. Menzies*, (1857) 3 Jur. N. S. 357; L. R. 3 Eq. 312.

(x) *Stevens v. Keating*, (1847) 2 W. P. C. 176; *Osmond v. Hirst*, (1885) 2 R. P. C. 265.

(y) *Rothwell v. King*, (1886) 3 R. P. C. 379; *Bickford v. Skewes*, (1837) 1 W. P. C. 211, 213; *Renard v. Levinstein*, (1864) 10 L. T. N. S. 94.

Inter-
locutory
Injunction.

Three years were held sufficient under circumstances from which it appeared that, previously to the grant of the patent, many inventors had been endeavouring to obtain the result achieved by the patentee, who had since the grant sold, at considerable profits, numerous articles manufactured according to the invention without his monopoly being previously questioned; (z) though where the plaintiff's patent was three years old, but the works enabling him to carry on operations under it were not completed till one year before Bill filed, the injunction was refused. (a)

Where a patent was only two years old at the commencement of an action an interim injunction was obtained, but afterwards it was dissolved by the Lords Justices on appeal, *Knight Bruce*, L.J., saying, in reference to the recent date of the letters patent: "There cannot have been any considerable length of enjoyment under them, and the defendant, in such a case, at least is entitled, I apprehend, to the benefit of any reasonable doubt and reasonable difficulty which he can show to exist as to the sufficiency and validity of the specification." (b) And in a more recent case two years' uninterrupted enjoyment was held insufficient to warrant the granting of an interlocutory injunction. (c)

Again, where a patent was a recent one and the only question as to its validity was one founded on an objection to the sufficiency of the specification, and it was proved that a competent workman, with no other assistance than the specification, could work the invention, an interlocutory injunction was refused. (d)

A patent which has been established is regarded as valid in an interlocutory application.

Where the validity of the patent has been established on previous occasions, though it is open to the defendant at the trial to dispute it, the Court will, on an interlocutory application, regard its validity as sufficiently established by the previous proceedings to warrant the grant of an interim injunction, (e) if the infringement is clear, (f) or there is a

(z) *Wheatstone v. Wilde*, (1861) Griff. P. C. 247.

(a) *Hill v. Thompson*, (1817) 1 W. P. C. 232; 3 Mer. 622; see also *Plimpton v. Malcolmson*, (1875) L. R. 20 Eq. 37.

(b) *Renard v. Levinstein*, (1864) 10 L. T. N. S. 177.

(c) *British Tanning Co. v. Groth*, (1889) 7 R. P. C. 1.

(d) *Coles v. Baylis*, (1886) 3 R.

P. C. 178.

(e) *Dudgeon v. Thomson*, (1877) 30 L. T. N. S. 244; *Davenport v. Jepson*, (1862) 4 De G. F. & J. 440; *Davenport v. Goldberg*, (1865) 2 H. & M. 282; *Newall v. Wilson*, (1852) 2 De G. M. & G. 282; *Bovill v. Smith*, (1867) W. N. p. 240; *Bovill v. Goodier*, (1866) L. R. 2 Eq. 200.

(f) *Hayward v. The Pavement Light Co.*, (1884) 1 R. P. C. 207.

prima facie case of infringement, (g) and this notwithstanding that the defendant disputes the validity of the patent on a ground not raised in any of the previous proceedings. (h)

Where the plaintiff has established the validity of the patent but there is an appeal pending to the Court of Appeal or House of Lords, the Court considers the validity as established on the hearing of a subsequent motion for an interlocutory injunction; and the injunction may be obtained notwithstanding that the defendant offers to pay royalties pending the appeal. (i)

If it could be established to the satisfaction of the Court that the judgment in favour of the patent in a prior action was wrongly obtained, this fact would no doubt induce the Court to depart from the usual course of treating the question of validity as established; (k) though it has been held that a certificate of validity given in a prior action in which judgment was obtained by default or consent is ground for treating the validity as established on subsequent motion for interlocutory injunction. (l)

The fact that a plaintiff has succeeded in obtaining an interdict of a Scotch Court restraining a prior infringement in Scotland is sufficient *prima facie* evidence of the validity of the patent to justify the grant of an interim injunction against a subsequent infringement in England. (m)

Where a patent had been the subject of an arbitration at the request of parties to a former action, and the arbitrator had given his award in favour of its validity, the Court, in a subsequent action of infringement against the same defendant, considered the patent sufficiently established by the arbitrator's award, and granted an interlocutory injunction. (n)

An interim injunction may be granted in a subsequent action, where it is shown by the plaintiff that he has established his patent on a former occasion, though against a different defendant; but the subsequent defendant will at the trial be in no way bound by the previous decision, and may contest the patent anew on the same or different evidence,

(g) *Thorn v. Worthing Skating Rink Co.*, (1876) L. R. 6 Ch. D. 415 *n.*

(h) *Newall v. Wilson*, (1852) 2 De G. M. & G. 282; 19 L. T. 161; *Heine v. Norden*, (1904) 21 R. P. C. 513.

(i) *Moser v. Sewell*, (1893) 10 R. P. C. 365; *Moser v. Jones*, (1893) 10 R. P. C. 368.

(k) *Pneumatic Tyre Co. v. Marwood*,

(1896) 13 R. P. C. 347.

(l) *Edison-Bell Phonograph Corporation v. Bernstein*, (1897) 14 R. P. C. 153.

(m) *Dudgeon v. Thomson*, (1877) 30 L. T. N. S. 244; *Stevens v. Keating*, (1847) 19 L. J. N. S. Ex. 57; 2 W. P. C. 176, 177.

(n) *Lister v. Eastwood*, 26 L. T. 4.

Inter-
locutory
Injunction.

and he cannot be compelled to do so by presenting a petition for its revocation. (o) It is submitted that in such a case the Court will consider itself bound as to the interpretation of the specification by the construction put upon it by a Court of equal or superior jurisdiction. (p)

Interlocutory injunctions are usually refused where there is a real doubt as to infringement.

An interlocutory injunction is granted when the Court is satisfied that what the defendant has done, or threatens to do, is a mere invasion of the plaintiff's established right, and there is no *laches*. (q) Also when the sole question between the parties is the validity of the patent, (r) and there is a strong presumption or case in its favour; (s) but it is usually refused if there is a real doubt as to the fact of infringement considered apart from the question of title. (t)

Degree of the doubt as to infringement is an important factor.

In cases where there is not a strong *prima facie* case upon the point of validity and also upon the point of infringement, it depends on the degree of doubt whether or not an injunction will be granted; and the Court will consider the degree of convenience or inconvenience to the parties caused by granting or refusing the injunction. (u) Thus, though there is a *bona fide* doubt as to infringement and the trade of the defendants is a new one likely to lead to the sale of a large number of the alleged infringing articles, it is more convenient, and less likely to produce irreparable damage, to stop him by injunction from selling, than it would be to allow him to sell and merely keep an account, thus forcing the plaintiff to commence a multitude of actions against the purchasers; (x) and where there is evidence of long enjoyment, and consequently *prima facie* evidence of title which

(o) *Bovill v. Goodier* (No. 2), (1856) L. R. 2 Eq. 195; *Russell v. Barnsley*, (1834) 1 W. P. C. 472; 2 Coop. Ch. Cas. 58; but see *Davenport v. Goldberg*, (1865) 2 H. & M. 286.

(p) *Edison v. Holland*, (1889) 6 R. P. C. 243, 249, 276; *Slazenger v. Feltham*, (1889) 6 R. P. C. 130; *Patent Exploitation, Ltd. v. American Electrical Novelty and Manufacturing Co., Ltd.*, (1903) 20 R. P. C. 296; 22 R. P. C. 316; p. 469 *post*.

(q) *Thorn v. Worthing Skating Rink Co.*, (1876) L. R. 6 Ch. D. 415 *n.*; *Pneumatic Tyre Co. v. Warrilow*, (1896) 13 R. P. C. 288.

(r) *Neilson v. Thompson*, (1841) 1 W. P. C. 277; *Stevens v. Keating*, (1847) 2 W. P. C. 179; *Electric Telegraph Co. v. Nott*, (1847) 11 Jur. 157.

(s) p. 432 *ante*.

(t) *Stevens v. Keating*, (1847) 2 W. P. C. 177; *Electric Telegraph Co. v. Nott*, (1847) 11 Jur. 157; *Wood v. Cockerill*, (1889) 2 Coop. Ch. Cas. 58; *Plimpton v. Malcolmson*, (1875) L. R. 20 Eq. 38.

(u) *Bridson v. McAlpine*, (1846) 8 Beav. 230; *Thompson v. Hughes*, (1890) 7 R. P. C. 71; *Neilson v. Thompson*, (1841) 1 W. P. C. 278; *Plimpton v. Spiller*, (1876) L. R. 4 Ch. D. 290; see also *Elwes v. Payne*, (1870) L. R. 12 Ch. D. 468; *Brooks v. Lycett's Saddle and Motor Accessories Co., Ltd.*, (1903) 20 R. P. C. 575.

(x) *Plimpton v. Spiller*, (1877) L. R. 4 Ch. D. 286, 292; but see *North British Rubber Co. v. Gormully and Jeffery Manufacturing Co.*, (1894) 12 R. P. C. 17, where the defendant pleaded *laches plus growth of his trade*.

Inter-
locutory
Injunction.

ought to be respected, (y) the Court will not consider the injury to the defendant, but will protect the plaintiff from the possible consequences of the market being flooded with articles manufactured in infringement of his patent, supposing him to be able to sustain it. (z) If it appears that an interim injunction would seriously prejudice the defendant, and not benefit the plaintiff, it will be refused. (a)

To obtain an injunction on an interlocutory application it is sufficient to show one clear instance of infringement, (b) or to make out a *prima facie* case; (c) and the Court of Appeal is slow to interfere with the discretion of a Judge of first instance who is satisfied as to the existence of a *prima facie* case. (d)

Affidavits made from information and belief should show the source of such information and belief, otherwise they will not have much weight with the Court, and will not be of much material help to the plaintiff in making out the necessary *prima facie* case of infringement. (e)

Where the defendant admitted that he had exhibited machines which to some extent were or had been infringements of the plaintiff's patent, the Court granted an injunction in general terms, but left open the question as to the particular machines. (f)

Although the Court has the power to grant an interlocutory injunction *simpliciter*, (g) it is the invariable practice not to do so, but to bind the plaintiff in an undertaking to indemnify the defendant, if it should ultimately turn out that the patent is bad and that the injunction ought, therefore, not to have been granted; (h) and the undertaking is equally required

(y) *Stevens v. Keating*, (1847) 2 W. P. C. 177; p. 432 *ante*.

(z) *Davenport v. Jepson*, (1862) 4 De G. F. & J. 448; *Humar v. Plane*, (1809) 14 Ves. 130; *Stevens v. Keating*, (1847) 2 W. P. C. 177.

(a) *Neilson v. Thompson*, (1868) 1 W. P. C. 275, 286; *Morgan v. Seaward*, (1837) 1 W. P. C. 167; *Thomson v. Hughes*, (1890) 7 R. P. C. 71.

(b) *United Telephone Co. v. Sharples*, (1885) L. R. 29 Ch. D. 164, 169.

(c) *Briggs v. Lardeur*, (1884) 1 R. P. C. 128; *Shillito v. Larmuth*, (1885) 2 R. P. C. 1, 3; *Anderson v. Patent Oxonite Co., Ltd.*, (1886) 3 R. P. C. 279.

(d) *Baker v. White*, (1884) 1 Times R. 64.

(e) *Saccharin Corporation v. The Chemical Dye and Drugs Co.*, (1898)

15 R. P. C. 53; *Re The Young Manufacturing Co.*, [1900] 2 Ch. D. 753; *Badische Anilin und Soda Fabrik*, (1902) 19 R. P. C. 502.

(f) *Edison-Bell Phonograph Corporation v. London Phonograph Co.*, (1894) 11 R. P. C. 193.

(g) *Bacon v. Jones*, (1839) 4 M. & C. 436; *Wilson v. Tindal*, (1841) 1 W. P. C. 730; *Bickford v. Skewes*, (1837) 1 W. P. C. 214; *Tuck v. Silver, John*. 218.

(h) *Chappell v. Davidson*, (1856) 8 D. M. & G. 1; *Tuck v. Silver, John*. 218; *Wakefield v. Duke of Buccleuch*, (1865) 11 Jur. N. S. 523; *Graham v. Campbell*, (1877) L. R. 7 Ch. D. 490; *Muntz v. Greenfell*, (1842) 2 W. P. C. 91; 2 Coop. Ch. Cas. 59; *Moser v. Sewell*, (1893) 10 R. P. C. 366; *Moser v. Jones*, (1893) 10 R. P. C. 368.

Affidavits
made from
information
and belief.Indemnity on
behalf of the
defendant is
required from
the plaintiff
when an inter-
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junction is
granted.

Inter-
locutory
Injunction.

where the patent has been established on former occasions, as where there has been no previous contest. (i)

Unexplained and unreasonable delay in making an application to enforce the undertaking to be answerable in damages induces the Court to refuse the application; (k) but the undertaking is not put an end to by the discontinuance, (l) or dismissal, (m) of the action.

The undertaking can be enforced when the injunction has been wrongly granted owing to a mistake of law by the Judge; (n) and it may be entered into by, (o) and enforced against, a married woman. (p)

Inability on the part of the defendant to satisfy the plaintiff's claim.

Inability on the part of the defendant to satisfy the plaintiff's claim for damages in the event of defeat is a consideration which induces the Court to grant an interlocutory injunction. (q) Such presumption of inability may arise, for instance, from the fact that a defendant company is in liquidation. (r) If the defendant does not appear the injunction may be granted on affidavit as to validity, on the ground that the defendant not appearing the plaintiff may not be able to get an account. (s)

The motion is usually ordered to stand over till the trial if there is an independent case against an interlocutory injunction being granted.

Where there is an independent case, on any ground, against an interlocutory injunction being granted, the Court considers it better to order the motion to stand over till the trial, if the defendant asks for it, because, although when the case on the motion is the same as the case at the trial, it is better merely to make the costs in the motion costs in the action; yet, where there is an independent case against a motion, so that the defendant may say, "If you succeed at the trial, yet you must have failed on the motion by reason of this delay, and therefore you have exposed me in any view to unnecessary expense," it is better, then, to order the motion to stand to the trial, without prejudice to any question. (t)

(i) *United Telephone Co. v. Taskar*, (1888) 5 R. P. C. 628, 633; *Bovill v. Smith*, (1867) W. N. 210.

(k) *Ex parte Hall*, (1883) L. R. 23 Ch. D. 644.

(l) *Newcomen v. Coulson*, (1877) L. R. 7 Ch. D. 764.

(m) *Newby v. Harrison*, (1861) 3 De G. F. & J. 287; *Graham v. Campbell*, (1877) L. R. 7 Ch. D. 490.

(n) *Griffith v. Blake*, (1884) L. R. 27 Ch. D. 474; *Rothwell v. King*, (1887) 4 R. P. C. 76.

(o) *Re Prynce*, (1885) W. N., p. 144.

(p) *Hunt v. Hunt*, (1881) 54 L. J.

Ch. 289.

(q) *Kensington and Knightsbridge Electric Lighting Co. v. Lane Fox Electrical Co.*, (1891) 8 R. P. C. 277; *Plimpton v. Spiller*, (1876) L. R. 4 Ch. D. 291; *Nowall v. Wilson*, (1852) 2 G. M. G. 282.

(r) *Welsbach Incandescent Gas Light Co. v. Vulcan Incandescent Light Syndicate*, (1901) 18 R. P. C. 279.

(s) *Clarke v. Nichols*, (1895) 12 R. P. C. 310.

(t) *Per Chitty, J., Lister v. Norton*, (1884) 1 R. P. C. 116.

And in some circumstances—*e.g.*, where the patentee has agreed with the defendant not to oppose any company formed for the purpose of purchasing his invention—the Court will order the motion to stand to the trial notwithstanding that the defendant refuses to give an undertaking to keep an account. (u)

Inter-locutory Injunction.

When an interim injunction is refused, either on the ground that the infringement is doubtful, or on the ground of delay, (v) the usual course is to order the defendant to keep an account. (x)

When an inter-locutory injunction is refused the defendant is usually ordered to keep an account.

This order for an account may be made in different forms, as the circumstances of the case may require. (y)

In *Neilson v. Thompson*, the account was for the past as well as from the commencement of the infringement. (z) But in *Vidi v. Smith* (a) the Court held that a retrospective account should not be granted till final judgment. This is the most general form in which the order is made; (b) though in *Plimpton v. Malcolmson*, (c) and *Russell v. Cowley*, (d) the account was of "all moneys received or to be received" by the sale of the patented articles, and in *Beardsell v. Schwann* (e), the account was of the articles only. (f) In *Pneumatic Tyre Co. v. Friswell* (g) the defendant refusing to keep an account for fear of admitting the validity of the patent, the order was prefaced with the words "the defendant not admitting the validity, but on the other hand contending that the patent is invalid."

An interim injunction is not often granted when the defendant voluntarily offers to keep an account and the Court is satisfied that he will be sufficiently able to satisfy any claim the plaintiff may ultimately succeed in establishing against him; (h) or where the defendant offers not to use the alleged infringing article till trial, or further order. (i)

(u) *British Tanning Co. v. Groth*, (1889) 7 R. P. C. 1.

(v) *Bovill v. Crate*, (1865) L. R. 1 Eq. 388; *Neilson v. Thompson*, (1841) 1 W. P. C. 286; *Lister v. Norton*, (1884) 1 R. P. C. 114.

(x) *Ibid.*; *Bacon v. Jones*, (1839) 4 My. & Cr. 436; *Jackson v. Needle*, (1884) 1 R. P. C. 176; *Hill v. Thompson*, (1817) 1 W. P. C. 232; 3 Mer. 662; *Morgan v. Seaward*, (1837) 1 W. P. C. 169.

(y) For common form of order, see *Seton*, 4th ed. p. 344.

(z) 1 W. P. C. 286.

(a) 3 E. & B. 969.

(b) *Plimpton v. Spiller*, (1877) L. R.

4 Ch. D. 286.

(c) *Seton*, 4th ed. p. 344.

(d) 1 W. P. C. 458.

(e) *Seton*, 3rd ed. p. 910.

(f) *Hill v. Thompson*, (1817) 3 Mer. 626; *Jackson v. Needle*, (1884) 1 R. P. C. 176.

(g) (1895) 13 R. P. C. 15.

(h) *Gardner v. Broadbent*, (1856) 2 Jur. N. S. 1041; *Copeland v. Webb*, (1862) 11 W. R. 134; *Jackson v. Needle*, (1884) 1 R. P. C. 174; *Lister v. Norton*, (1884) 1 R. P. C. 114.

(i) *Lyon v. Mayor, &c., of Newcastle-upon-Tyne*, (1894) 11 R. P. C. 218.

Discovery. If the plaintiff does not prosecute the action with due diligence after obtaining an interim injunction, the defendant may apply to have the injunction dissolved. (*j*)

—
Action not prosecuted with due diligence.

Order as to payment of money out of Court.

In the event of the defendant paying money into Court and the plaintiff being successful in the action the proper course is for the Court to order the money to remain in Court to abide the result of the inquiry as to damages, or the taking of the account and to be paid out to the plaintiff, or so much thereof as the plaintiff shall show he is entitled to. (*k*)

DISCOVERY AND INSPECTION.

Interrogatories **Discovery.**—Notwithstanding that in patent actions particulars must be delivered by both the plaintiff and the defendant, (*l*) either party may, by leave of the Court or a Judge, deliver interrogatories in writing for the examination of the opposite parties, or any one or more of such parties, provided that interrogatories which do not relate to any matters in question in the action shall be deemed irrelevant, notwithstanding that they might be admissible on the oral cross-examination of a witness. (*m*)

must be limited to facts enabling the interrogating party to prove his case.

Interrogatories must be limited to facts, and an interrogating party is entitled only to such answers as will enable him to establish his case, and he is not entitled to administer interrogatories which inquire into the opposite parties' evidence, (*n*) nor is he entitled to answers to irrelevant questions (*o*)—*e.g.*, as to certain unsuccessful proceedings abroad for the infringement of a foreign patent in the possession of the plaintiff; (*p*) but in one case the plaintiff was ordered to answer as to the terms of a compromise in another action as being material. (*q*) Consequently, if the particulars of breaches are sufficient, the plaintiff will not be compelled to answer further questions as to the alleged infringements. (*r*)

(*j*) *Stevens v. Keating*, (1847) 2 W. P. C. 175.

(*k*) *North British Rubber Co. v. Gormully and Jeffery Manufacturing Co.*, (1894) 12 R. P. C. 17.

(*l*) 46 & 47 Vict. c. 57, s. 29.

(*m*) R. S. C. (1883) Order xxxi. r. 1; *General Electric Co.* (1900), Ld. r. *Safety Lift and Elevator Co.*, (1903) 21 R. P. C. 109; *Birch v. Mather*, (1883) L. R. 22 Ch. D. 629; *Haddan's Patent*, (1884) 51 L. J. N. S. Ch. 126; *Finnigan v. James*, (1874) L. R. 19 Eq. 72; *Crossby v. Tomey*, (1875) L. R. 2 Ch. D. 533; *Saunders v. Jones*,

(1877), L. R. 7 Ch. D. 449.

(*n*) *Delta Metal Co. v. Maxim-Nordenfelt Guns and Ammunition Co.*, (1891) S R. P. C. 169.

(*o*) *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 37; *Hoffmann v. Postill*, (1869) L. R. 4 Ch. App. Cas. 673; R. S. C. (1883) Order xxxi. r. 6.

(*p*) *Hoffmann v. Postill*, (1869) L. R. 4 Ch. App. Cas. 673, 679.

(*q*) *Betts v. Neilson*, W. N. (1866) p. 170.

(*r*) *Hoffmann v. Postill*, (1869) L. R. 4 Ch. App. Cas. 673, 679.

Thus the owner of letters patent for mechanical musical instruments brought an action for alleged infringement against the defendants, and delivered particulars of breaches, in which he complained generally of the infringement of the first claiming clause of the specification, and "in particular and by way of illustration" of a specific article sold by the defendants. The defendants delivered particulars of objections which alleged (*inter alia*) that the alleged invention was not the subject of a patent, but the new application of old machinery to an analogous purpose; that, as disclosed by the specification, it did not make any useful addition to the existing stock of public knowledge; and that the specification did not sufficiently distinguish the new from the old. The defendants also delivered interrogatories which in effect asked the plaintiff to admit the truth of the above-mentioned objections, or to state how he made them out not to be true. The plaintiff having declined to answer these interrogatories, the defendant took out a summons to compel him to do so. The summons was adjourned into Court, and the plaintiff, then consenting to answer the interrogatories as to subject-matter, and to amend the particulars of breaches by omitting the words "by way of illustration," it was held that no further answer should be ordered. (s)

Discovery.

The Court will not compel a party to discover facts beyond what is necessary to enable his opponent to prove his case. (t) Thus, where the only plea raised by the defence was that the plaintiff was not the true and first inventor, the defendant was allowed to refuse to answer interrogatories as to the accuracy of the specification, the novelty of the process, and the fact of the infringement. (u)

Fishing interrogatories, which merely help one party to get at the other's evidence and see what he can make of it, are not allowed—*e.g.*, a plaintiff is not allowed to ask a defendant to state the names of the persons to whom he alleges he sold articles similar to the plaintiff's before the date of the patent; (x) though he may be required to state whether alleged anticipating machines mentioned in his objections are in existence, and the names and addresses of alleged prior users. (y)

Fishing interrogatories are not allowed.

(s) *Ehrlich v. Ihlec*, (1887) 5 R. P. Beav. 532.

C. 37. (x) *Daw v. Eley*, (1865) 2 H. & M.

(t) *Bidder v. Bridges*, (1885) L. R. 725.

29 Ch. D. 29, 34. (y) *Birch v. Mather*, (1883) L. R.

(u) *Young v. White*, (1853) 17 22 Ch. D. 629.

Discovery.

Plaintiff and defendant have an equal right to discovery.

It has been stated that interrogatories for the examination of a plaintiff are on a different footing from those for the examination of a defendant in this respect, that a plaintiff is not entitled to discovery of the defendant's case, but a defendant may ask any questions tending to destroy the plaintiff's claim. (z) This statement must, however, be taken as having been made in the first instance in reference to a particular case, and must not be taken as establishing the proposition that the defendant has a larger right of discovery than a plaintiff. No such proposition can be upheld in the face of the authorities which, on the contrary, establish that the rights of both plaintiff and defendant are equal in respect of discovery, *i.e.*, either party is entitled to a discovery of such material facts from the other as will enable him to make out *his case*, and not to a discovery of facts which relate exclusively to the manner in which the case of the other party is to be established, or to the evidence which relates exclusively to that case. (a)

Discovery which is a matter of indifference to the party against whom it is sought,

Where discovery is a matter of indifference to the party against whom it is sought, the Court does not weigh carefully the question of materiality or immateriality; still, where the nature of the discovery required is such that the giving of it may be prejudicial to such party, the Court takes into consideration the special circumstances of the case; on the one hand it takes care that the party desiring discovery obtains all which can be of use to him, on the other it protects the opposite party against undue inquisition into his affairs. (b)

or cannot help the interrogating party.

And when a defendant's answer to an interrogatory cannot help the plaintiff to obtain a decree, but will only be of use to him if he obtains a decree, the Court has a discretion whether to oblige the defendant to answer before trial, and will not do so when compelling such discovery would be oppressive. (c) Thus, if the defendant denies infringement, but admits the possession of the infringing articles, he will not be compelled

(z) *Hoffmann v. Postill*, (1869) L. R. 4 Ch. App. 673; *Lowndes v. Davies*, (1834) 6 Sim. 468; *Commissioners of Sewers v. Glasse*, (1873) L. R. 15 Eq. 302.

(a) *Bray on Discovery*, pp. 467 and 468; *Bovill v. Smith*, (1866) L. R. 2 Eq. 459; *Daw v. Eley*, (1865) 2 H. & M. 725; *Bidder v. Bridges*, (1885) L. R. 29 Ch. D. 34, judgment of Kay, J.

(b) *Moore v. Craven*, (1874) L. R. 7 Ch. App. 94, 96; *Simpson v. Charlesworth*, (1866) W. N. p. 255; *Daw v.*

Eley, (1865) 2 H. & M. 725; *Rolls v. Isaacs*, (1878) W. N. 37; *Crossley v. Stewart*, (1863) 1 N. R. 426; S. C. 7 L. T. N. S. 848; *Craver v. Pinto Leite*, (1871) 7 Ch. App. 90, 97; *Orr v. Diaper*, (1876) L. R. 4 Ch. D. 92.

(c) *Parker v. Wells*, (1880) L. R. 18 Ch. D. 477; *Swabey v. Sutton*, (1863) 1 H. & M. 514; *Fennessy v. Clark*, (1888) L. R. 37 Ch. D. 184; *Lister v. Norton*, (1885) 2 R. P. C. 68; *Bray on Discovery*, p. 553.

to answer interrogatories which seek an account of all such articles in his possession, as well as discovery as to the purchase or hire of them, and an account of sales and profits. (*d*) Discovery.

Where a party interrogates as to facts tending to enable him to prove a particular issue, the party giving discovery will not be excused from answering fully on the ground that such answers cannot be of use to the party seeking it, if he fails to prove some other issue. (*e*)

The limitation as to answering interrogatories applies only to those relating to matters which depend on the part (or it may be the whole) of the case which will become immaterial if the case be not established, or are of such a nature that the party seeking the discovery is not entitled to it till his case is established by the judgment of the Court (*f*)—*e.g.*, where infringement is admitted and discovery is sought of the sales and profits made by trafficking in the infringing articles. (*g*) It does not protect a defendant who denies the plaintiff's title *in toto*, or alleges that the patent is invalid, from answering fully all interrogatories which are material. (*h*)

Subject to the above limitations, the old fixed and rigid rule that "he who answers at all must answer fully," guides the Court in deciding whether any particular answers given are sufficient, or whether any particular interrogatories are allowable or not. (*i*) Rule that "he who answers at all must answer fully."

In the event of the Court or a Judge granting leave to any party to administer interrogatories to any other party or parties the costs must in the first instance be secured by the party seeking such discovery in the manner prescribed by the Supreme Court Rules, 1883. (*k*) Cost of interrogatories must be secured.

As in the case of inspection, (*l*) so, when discovery is sought, if the party from whom it is sought objects to it or any part thereof, the Court or a Judge may, if satisfied that the right to the discovery sought depends on the determination of any issue or dispute in the cause, or that for any other reason it Objection on the ground that the right to discovery depends on the prior decision of an issue.

(*d*) *De la Rue v. Dickinson*, (1857) 3 K. & J. 388; *Rolls v. Isaacs*, (1878) W. N. p. 37; *Fennessy v. Clark*, (1888) L. R. 37 Ch. D. 184.

(*e*) *Foxwell v. Webster*, (1863) 2 Dr. & Sm. 250.

(*f*) *De la Rue v. Dickinson*, (1857) 3 K. & J. 391; *Parker v. Wells*, (1880) L. R. 18 Ch. D. 477; *Lister v. Norton*, (1885) 2 R. P. C. 68.

(*g*) *Ibid.*

(*h*) *Swinborne v. Nelson*, (1852) 16 Beav. 416; *Foxwell v. Webster*, (1863) 3 N. R. 103; 9 Jur. N. S. 1189.

(*i*) *Swinborne v. Nelson*, (1852) 16 Beav. 416; *Elmer v. Creasy*, (1873) L. R. 9 Ch. App. 69; *Saull v. Browne*, (1874) L. R. 9 Ch. App. 364; *Lister v. Norton*, (1885) 2 R. P. C. 68.

(*k*) Order xxxi. rr. 25, 26, 27.

(*l*) p. 452 *post*.

Discovery. is desirable that any issue or question in dispute in the cause should be determined before deciding upon the right to the discovery, order that such issue or question be determined first, and reserve the question as to discovery. (*m*)

The Court under this rule will not in the exercise of its unfettered discretion allow a defendant to postpone answering questions as to facts which go to establish infringement till after the issue of validity is determined. (*n*)

Thus, where the plaintiff framed interrogatories on statements contained in the specification of his patent and asked the defendant step by step if he ever used the processes therein described, and the defendant after answering some of the interrogatories refused to answer others on the ground that the discovery sought depended on the determination of the question at issue—viz., the validity of the patent—and that the matters inquired into were not material at that stage of the action and were a trade secret, the Court held the defendant had shown no sufficient reason for his refusal to answer and made an order for further and better answers. (*o*)

Trade secrets
and discovery.

As in the case of inspection (*p*) so with regard to discovery, the fact that the particular discovery sought would lead to the disclosure of the trade secrets of the opposite party will not deter the Court from granting it, if it is necessary in the interests of justice to enable the applicant to establish his case.

In such cases the Court endeavours, where possible, to protect the party compelled to disclose trade secrets, and will not order discovery beyond what is necessary to prove the case of the party seeking it.

Thus, where a defendant denied having infringed a patent for “improvements in preparing colouring matters for dyeing and colouring,” although he was compelled to answer interrogatories as to whether he used certain ingredients mentioned in the specification, whether he added anything else, and whether the additions made any difference in the process, yet he was not obliged to disclose the nature and quantities of the additions. (*q*)

At the hearing of another case against the same defendant,

(*m*) R. S. C. (1883) Order xxxi. r. 20.
(*n*) Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson, (1893) 10 R. P. C. 136; Ashworth v. Roberts, (1890) L. R. 45 Ch. D. 623; 7 R. P. C. 451; Rawes v. Chance, (1890) 7 R. P. C. 275.

(*o*) Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson, (1893) 10 R. P. C. 136.
(*p*) p. 452 *post*.
(*q*) Renard v. Levinstein, (1861) 10 L. T. N. S. 94.

evidence as to the defendant's secret process was taken in *Discovery*. *camerâ*, and the Judge ordered the shorthand notes and all the printed copies thereof to be sealed up and impounded in Court until there should be an appeal, in which case the parties were to be at liberty to apply for the delivery out of Court of as many copies as they should want, or until, either by lapse of time or otherwise, it should be determined that there was to be no appeal, in which case any application might be made to the Court for the disposal of them as the parties should think fit. (r)

There is, however, no hardship on the defendant in requiring him to state whether he has done what the specification says is to be done. If he answer No, but he has done something slightly different which might possibly be construed as an infringement, but which is a trade secret, the Court has ample power to protect the undue disclosure of such secret. (s)

Communications between a patentee and his patent-agent relative to the preparation of the specification are not privileged, and the patentee may be required to refer to them in answering interrogatories as documents in his possession. Thus, where the defendant interrogated the plaintiff as to documents in his possession relating to the preparation of the specification and the plaintiff refused to answer, stating as a reason for his refusal that the documents were confidential communications between himself and his solicitor (who was also his patent-agent) and counsel, the Court decided that the answer was insufficient, as not distinguishing communications between the plaintiff and his solicitor, and communications between him and his patent-agent, the former class of communications alone being privileged. (t)

And where an action was commenced in respect of the infringement of two patents for similar inventions, but discontinued as to one of such inventions, the plaintiff was nevertheless required to answer interrogatories as to communications relative to that patent between himself and his patent-agent, on the ground that such answer might be material to the validity of the patent for the other cognate invention. (u)

(r) *Badische Anilin und Soda Fabrik v. Levinstein*, (1883) L. R. 24 Ch. D. 176.

(s) *Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson*, (1893)

10 R. P. C. 139.

(t) *Moseley v. Victoria Rubber Co.*, (1886) 3 R. P. C. 351.

(u) *Ibid.*

Communications between a patentee and his patent-agent.

Discovery. Neither a plaintiff (*x*) nor a defendant (*y*) can be compelled to put a construction on the specification in answer to interrogatories.

Construction
of documents.

When complete answer cannot be given without an ocular demonstration.

When a defendant, in answer to an interrogatory asking whether or not he was making articles identical with those manufactured by the plaintiff under the patent, and requiring him to state in what respects his articles differed from the plaintiff's, stated that he had for many years before the date of the patent applied to the articles in question the same treatment as was described in the specification, and that he now made articles which, save so far as his own method or process, adopted before the patent, was similar to that described in the specification of the plaintiff's patent, differed from the articles there described, but that it was impossible, without ocular demonstration, to show in what they differed, he was held to have given a sufficient answer. (*z*)

Names and
addresses of
alleged prior
users.

When a defendant alleges prior user generally in a certain district he may be compelled to give the names and addresses of the manufacturers and the places and dates of user. (*a*)

Disclosure of
processes used
by an alleged
infringer.

Where infringement has been alleged, anything showing, or tending to show, the fact of infringement may be required to be set out in answer to interrogatories. (*b*) Thus, where a plaintiff had been successful in actions against infringers and brought a subsequent action against another infringer, the defendant was compelled to answer whether the process used was the same as that used by one of the prior infringers; (*c*) and where the defendants denied infringement they were compelled to state, in answer to interrogatories, where they first manufactured, and to whom by name they first sold any, and what quantity, of the articles alleged by the plaintiff to be infringements, and by what process they were manufactured. (*d*)

Names and

Where infringement is admitted, the plaintiff is entitled to

(*x*) *Wenham Co. v. Champion Gas Co.*, (1890) 8 R. P. C. 22.

(*y*) *Delta Metal Co. v. Maxim-Nordenfelt Guns and Ammunition Co.*, (1891) 8 R. P. C. 169.

(*z*) *Crossley v. Tomey*, (1876) L. R. 2 Ch. D. 533; see also *Smith v. G. W. Ry. Co.*, (1854) Macr. P. C. 227; 6 E. & B. 405.

(*a*) *Alliance Pure White Lead Syndicate v. MacIvor's Patents*, (1891) 8 R. P. C. 321.

(*b*) *De la Rue v. Dickinson*, (1857)

3 K. & J. 391; *Lister v. Norton*, (1885) 2 R. P. C. 68, 69; *Rennard v. Levinstein*, (1864) 10 L. T. N. S. 94; *Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson*, (1893) 10 R. P. C. 136; *Ashworth v. Roberts*, (1890) L. R. 45 Ch. D. 623; 7 R. P. C. 451; *Rawes v. Chance*, (1890) 7 R. P. C. 275.

(*c*) *Bovill v. Smith*, (1866) L. R. 2 Eq. 459, 461.

(*d*) *Swinborne v. Nelson*, (1853) 10 Beav. 416.

an answer to interrogatories asking for the names and addresses of the persons to whom the defendant's machines have been sold; (c) and where the defendant had, in answer to interrogatories, set forth the names and addresses of persons resident in England from whom he had received royalties for the use of machines which the plaintiff alleged were made in infringement of his patent, such defendant was ordered to give the names and addresses of persons resident abroad from whom royalties had been received by him in respect of machines made in England, on the ground that the answer might lead to the discovery of important facts relative to the infringement. (f)

Discovery.

addresses
of defendant's
customers.

A defendant will not be excused from giving the names and addresses of his customers on the ground that by so doing he may thereby expose them to actions for infringements. (g)

The same rules apply to the production of documents in patent cases as in other cases. The ordinary rule is that no order is made for the disclosure of documents until after a pleading has been delivered by the party desiring disclosure. (h)

Production of
documents.

Where a defendant company sought to withhold from production certain letters which had passed between the officers of the company, and between them and other persons, together with reports relative to infringement and the validity of the plaintiff's claim, it was held that such documents were not privileged, and their production was ordered. (i)

Where it appeared that certain plaintiffs, before they became owners of the patent in respect of which they were suing, had, in various proceedings, either disputed, or made preparations for disputing, its validity, and the defendants applied for inspection of the documents relating to such proceedings, it was held that they were entitled to have inspection of all except such as the plaintiff should state on oath to have come into existence merely to be communicated to the solicitor for the purpose of litigation, actual or intended, and

(e) Tetley v. Easton, (1856) 18 C. B. 643.

(f) Crossley v. Stewart, (1863) 1 N. R. 426; see also Davenport v. Rylands, (1865) L. R. 1 Eq. 302, 308; Leather Cloth Co. v. Hirschfield, (1866) L. R. 1 Eq. 299.

(g) Tetley v. Easton, (1856) 18 C. B.

643; How v. McKernan, (1862) 30 Beav. 547; Bovill v. Cowan, (1867) W. N. p. 115.

(h) See Woolfe v. Automatic Picture Gallery, (1902) 19 R. P. C. 161.

(i) Westinghouse v. Midland Ry. Co., (1883) 48 L. T. N. S. 98, 462.

Discovery. either as materials for briefs or for his advice or consideration. (*j*)

Documents not disclosed in original affidavit.

Where it appears probable from a document produced by the plaintiff or defendant that he has in his possession relevant documents besides those which are scheduled to his original affidavit, the proper course is to apply for an order calling on him to make a further and better affidavit, and in particular to state whether he has not in his possession documents, which, from that which has been said by him on affidavit or from the documents he has produced, in all probability are in his possession. (*k*) Thus, a plaintiff who in his affidavit of documents referred to certain affidavits made in a previous action against different defendants, but omitted to schedule them, was ordered to make a further and better affidavit with particular reference to the affidavits filed in the previous action. (*l*)

Further affidavit of documents.

It is established that where an affidavit of documents has been made the opposite party cannot require a further affidavit to be made, if the affidavit is technically sufficient, unless he shows, either upon affidavit or from documents which are produced, or from the pleadings, or admissions in the pleadings of the party giving discovery, or from the very nature of the case (and as regards the nature of the case there must be very strong evidence to induce the Court to act), that there are, probably, in the possession of the party giving discovery documents other than those he has scheduled in his affidavit. There can be no cross-examination on an affidavit of documents which has been filed; but though the party requiring discovery cannot take any of the courses either as to cross-examination or without such evidence above referred to, on further affidavit, he may, with the leave of the Court, interrogate the party who has made an affidavit as to documents with reference to certain specific documents which he has reason to suppose are in the possession of the party giving discovery, and which have not been disclosed. (*m*)

The Court may require an affidavit to the effect that the

(*j*) *Haslam v. Hall*, (1887) 5 R. P. C. 1; see also *Southwark and Vauxhall Water Co. v. Quick*, (1878) L. R. 3 Q. B. D. 315, 320; *Anderson v. Bank of British Columbia*, (1875) L. R. 2 Ch. D. 644.

(*k*) Per Cotton, L.J., *Brown v. Sansom*, (1888) 5 R. P. C. 585; *Jones v. Monte Video Gas Co.*, (1880) L. R. 5

Q. B. D. 556.

(*l*) *Brown v. Sansom*, (1888) 5 R. P. C. 510.

(*m*) Judgment of Cotton, L.J., *Edison v. Holland*, (1888) 5 R. P. C. 216; see also *Hall v. Truman*, (1885) L. R. 29 Ch. D. 307; *Rawes v. Chance*, (1890) 7 R. P. C. 275.

application is not vexatious, or for the purpose of delay, but that it is made honestly for the purpose of obtaining discovery; but it is doubtful whether an affidavit as to the existence and nature of documents supposed to be in the possession of the party giving discovery and not included in the schedule to his original affidavit of documents is admissible. (*n*)

Inspection.

After one party has made a sufficient affidavit of documents the other party to the action will not be allowed to administer to him a general roving interrogatory as to documents in his possession, the effect of which would be to compel him to make a further affidavit. There are cases in which, after a sufficient affidavit as to documents, the Court will allow a party to deliver an interrogatory as to some specific document or documents, but whether this shall be allowed is a matter within the discretion of the Judge in each particular case, and though this decision can be appealed from, the Court of Appeal will not readily reverse it. (*o*)

Interrogatories as to documents not disclosed.

If an application is made at chambers for the usual order for discovery of documents, and a limited order only is asked for and obtained, no further order ought subsequently to be made by the Court of Appeal if the Judge has certified that he did not require argument in Court. (*p*)

Limited order for discovery of documents.

Inspection.—It sometimes happens that the plaintiff could not establish the infringement complained of without an inspection of the process or machinery which the defendant is actually using; or the defendant could not prove his innocence by showing that the patent is invalid or that he does not infringe, without a like inspection against the plaintiff. In such cases the Court has power, both under the Act of 1883 and under the Rules of the Supreme Court, to make an order for either party to be at liberty to inspect the other's process or machinery; but neither party can claim inspection as a matter of right; (*q*) and the Court will not allow it to be oppressive or to be carried beyond what is necessary in the interests of justice, (*r*) the object of inspection being to enable the Court to have the case properly tried, and to assist the Court in forming a right conclusion. (*s*)

Inspection is not a matter of right.

Object of inspection.

(*n*) *Edison v. Holland*, (1888) 5 R. P. C. 216.

(*o*) *Hall v. Truman*, (1885) L. R. 29 Ch. D. 307.

(*p*) *Thomson v. Hughes*, (1890) 7 R. P. C. 187.

(*q*) 46 & 47 Vict. c. 57, s. 30.

(*r*) *Bovill v. Moore*, (1815) Dav. P. C. 361; 2 Coop. Ch. Cas. 56; *Russell v. Cowley*, (1833) 1 W. P. C. 458; *Piggott v. Anglo-American Telegraph Co.*, (1868) 19 L. T. N. S. 46.

(*s*) *The Patent Type Founding Co. v. Walter*, (1860) Johns. 727; *Bovill v.*

Inspection. Thus, where a defendant was charged with infringing a patent for a sewing machine, and objected to an order for the inspection by the plaintiff of all sewing machines on his premises, on the ground that such order would be oppressive, he was allowed to verify on affidavit all the different kinds of sewing machines which he had sold or exposed for sale since the date of the plaintiff's patent, and the order for inspection was confined to one of each class. (*t*) The defendant cannot be compelled to make an affidavit verifying the machines or processes he uses, if he has offered inspection. (*u*)

Evidence
necessary to
obtain an order
for inspection.

Before the Court makes an order for inspection it will require to be satisfied that the inspection sought is necessary to the case of the party seeking, (*v*) or that the inspection is the only method of determining which of conflicting statements made by the parties is or are true. (*x*)

Thus, an application for an order for inspection by the plaintiff was refused where he omitted to state on affidavit that it was necessary to his case, and the defendant swore that he made several kinds of the article complained of, and that some of them did not resemble those described in the plaintiff's specification, and that in his belief the inspection was not required for the purposes of the action, but to gain information of his improvements. (*y*) Again, when the Court was of opinion that the defendant's acts, as alleged by the plaintiff, could not possibly amount to an infringement, an order for inspection was refused. (*z*) And an order for inspection was refused where the plaintiff alleged that certain apparatus used by the defendant was an infringement, and the defendant on the other hand denied infringement and gave a description of the apparatus used by him, which showed it to be different to the plaintiff's. The order was refused notwithstanding the allegation that the plaintiff had

Moore, (1815) 2 Coop Ch. Cas. 56; Russell v. Cowley, (1833) 1 W. P. C. 459; Davenport v. Jepson, (1862) 1 N. R. 308; Pemberton, 4th ed. 484; Russell v. Crichton, (1837) 15 Decisions of Court of Session, 1st series, 1270; Germ Milling Co. v. Robinson, (1886) 3 R. P. C. 11; Cheetham v. Oldham, (1888) 5 R. P. C. 622.

(*t*) Singer Manufacturing Co. v. Wilson, (1865) 5 N. R. 505; 12 L. T. N. S. 140.

(*u*) Drake v. Muntz's Metal Co., (1886) 3 R. P. C. 43.

(*v*) Piggott v. Anglo-American Telegraph Co., (1868) 19 L. T. N. S. 46; Batley v. Kynock, (1874) L. R. 19 Eq. 90; Cheetham v. Oldham, (1888) 5 R. P. C. 617; Shaw v. Bank of England, (1852) 22 L. J. N. S. Ex. 26; Meadows v. Kirkman, (1860) 29 L. J. N. S. Ex. 205.

(*x*) Swain v. Edlin-Sinclair Tyre Co., (1903) 20 R. P. C. 435.

(*y*) Batley v. Kynock, (1874) L. R. 19 Eq. 91.

(*z*) Piggott v. Anglo-American Telegraph Co., (1868) 19 L. T. N. S. 46.

failed to make the apparatus, as described by the defendant, Inspection.
work at all. (a)

An affidavit made by the plaintiff on an application for an order for inspection should state that he has reason to believe that the process or machine used by the defendant is an infringement of his patent; (b) it should also show the grounds of such belief, (c) and in what the invention of the plaintiff consists. (d) If the plaintiff makes out a *prima facie* case of infringement, and that inspection is necessary to enable him to prove it at the trial, an order will follow almost as matter of course, (e) but inspection will be limited to those machines and processes in respect of which a *prima facie* case of infringement is made out. (f)

Plaintiff's affidavit on application for an order for inspection.

In an action for infringement the plaintiff cannot, as a rule, be compelled to produce, or allow inspection of the patented machine or process at the instance of the defendant for the purpose of preparing the defence, since the specification should give sufficient information of what the invention is and the mode of performing it. (g)

Inspection for the purpose of preparing pleadings.

When, however, the defendant alleges that he has in his possession apparatus which is an anticipation of the plaintiff's claim, and which was formerly used, an order for the production and inspection of such apparatus may be obtained at the instigation of the plaintiff. (h) But where certain defendants alleged that the patent was anticipated by the sale of articles made according to the alleged invention by various persons named in the particulars, and the plaintiff applied for an order for the production before trial of the articles to be proved by the specified persons, the Court refused the application, on the ground that there was no precedent for such an order, and that on principle it ought not to be made. (i)

Where the parties agree to an inspection without incurring the expense of obtaining an order of Court, the costs of such inspection will be allowed on taxation. (j)

(a) *Sidebottom v. Fielden*, (1891) 8 R. P. C. 266.

(b) *Shaw v. Bank of England*, (1852) 22 L. J. N. S. Ex. 26.

(c) *Germ Milling Co. v. Robinson*, (1884) 1 R. P. C. 217.

(d) *Meadows v. Kirkham*, (1860) 29 L. J. N. S. Ex. 205.

(e) *Singer Manufacturing Co. v. Wilson*, (1865) 13 W. R. 560; 5 N. R. 505; *Batley v. Kynock*, (1874) L. R. 19 Eq. 90; *Piggott v. Anglo-American Telegraph Co.*, (1868) 13 L. T. N. S.

46; *Cheetham v. Oldham*, (1888) 5 R. P. C. 617.

(f) *Cheetham v. Oldham*, (1888) 5 R. P. C. 617.

(g) *Crofts v. Peach*, (1836) 1 W. P. C. 268.

(h) *Sidebottom v. Fielden*, (1891) 8 R. P. C. 266.

(i) *Garrard v. Edge*, (1889) 6 R. P. C. 372.

(j) *Ashworth v. English Card Clothing Co., Ltd. (A)*, (1904) 21 R. P. C. 353.

Inspection. The Court is not dependent on its power to compel inspection by treating as a contempt a refusal to comply with an order. The order of the Court may authorise any person, for the purpose of inspection, to enter upon or into any land or building that may be necessary. (*k*)

Power of the Court to enforce an order for inspection.

Order may be made at any time.

An order for inspection may be made at any time during the progress of an action, and may be obtained on summons or on motion. (*l*)

Delay no bar.

Delay in asking for an order for inspection is no bar. (*m*)

Postponement of the question of inspection.

If the party from whom inspection is sought objects, the Court or a Judge may, if satisfied that the right to inspection depends on the determination of any issue or question in dispute in the cause, or that for any other reason it is desirable that any issue or question in dispute in the cause should be determined before deciding upon the right to the inspection, order that such issue or question be determined first and reserve the question as to the inspection. (*n*)

Conditions.

The order for inspection generally makes it a condition that reasonable notice be given to the parties against whom it is made, (*o*) and, if the inspection relates to machinery, that the machines be put to work (*p*) in the presence of persons named, (*q*) and further specifies the number of inspections that are to be allowed. (*r*)

Inspection against licensee not a party to the action.

A licensee not a party to the action cannot be compelled to give inspection in an action against his licensor, though the order be made. (*s*)

Trade secrets.

It is sometimes objected that an inspection if granted would lead to the disclosure of trade secrets, and damage the trade of the party against whom it is sought, but such an objection will not deter the Court from making an order if it appears to

(*k*) R. S. C. (1883) Order l. r. 3.

(*l*) Judicature Act, 1873, s. 39; R. S. C. (1883) Order liv. r. 12; Order lv. r. 15; *Frcarson v. Loc*, (1878) 26 W. R. 138.

(*m*) *The Patent Type Founding Co. v. Walter*, (1860) Johns. 727.

(*n*) R. S. C. (1883) Order xxxi. r. 20.

(*o*) *Drake v. Muntz's Metal Co.*, (1886) 3 R. P. C. 43; *Germ Milling Co. v. Robinson*, (1886) 3 R. P. C. 11; *Flower v. Lloyd*, Seton, 4th ed. p. 351; *Russell v. Cowley*, (1833) 1 W. P. C. 458; *Davenport v. Jepson*, (1862) 1 N. R. 173; *Pemberton*, 4th ed. 484, p. 236; *Drake v. Muntz's Metal Co.*, (1886) 3 R. P. C. 43.

(*p*) Seton, 4th ed. p. 351; *Beardsel v. Schwann*, Seton, 3rd ed. p. 910; *Davenport v. Jepson*, (1862) *Pemberton*, p. 484; *Germ Milling Co. v. Robinson*, (1886) 3 R. P. C. 11; *Bovill v. Moore*, (1815) 2 Coop. Ch. Cas. 56; *Russell v. Cowley*, (1833) 1 W. P. C. 458.

(*q*) *Russell v. Cowley*, (1833) 1 W. P. C. 458; *Drake v. Muntz's Metal Co.*, (1886) 3 R. P. C. 43.

(*r*) *Heathfield v. Braby*, Seton, 4th ed. p. 1661; *Germ Milling Co. v. Robinson*, (1885) 3 R. P. C. 11.

(*s*) *Germ Milling Co. v. Robinson*, (1886) 3 R. P. C. 11, 14.

be necessary in the interests of justice, (t) though the Court will endeavour to prevent an undue advantage being taken of secrets disclosed during an inspection. (u) Inspection.

In *Flower v. Lloyd*, (x) where inspection was resisted on the ground of disclosure of trade secrets, an arrangement was come to in the Court of Appeal whereby the defendant's works should be inspected by scientific men to be agreed upon, but not by the plaintiff.

In *Cheetham v. Oldham*, (y) the plaintiff, a rival manufacturer of the defendant, was himself allowed to take part in the inspection.

In *Plating Co. v. Farquharson*, (z) the Court made an order authorising inspection by a scientific expert, but bound him not to disclose his report on the facts or opinion obtained or arrived at by him, without the leave of the Court or a Judge, and, at the trial, the expert was not allowed to be called as a witness or cross-examined.

Where an independent inspector is appointed, he is usually required to "report to the Court upon the facts, and his opinion founded upon them." (a)

Where the defendant desired an inspection of machines not belonging to, but in the power of the plaintiff, and the Court thought that such inspection would be beneficial in the interests of justice, an order was made that the plaintiff should *bonâ fide* endeavour to procure the inspection desired, and report the result to the Court. (b) Things in the power of a party.

Besides granting inspection, the Court or a Judge has the power, which is frequently exercised, to authorise samples to be taken, or any observation to be made, or experiment to be tried, which may be necessary or expedient for the purpose of obtaining full information or evidence. (c) Samples.

(t) *Renard v. Leviustein*, (1861) 10 L. T. N. S. 94; *Piggott v. Anglo-American Telegraph Co.*, (1868) 19 L. T. N. S. 46; *Smith v. G. W. Ry. Co.*, (1854) Macr. P. C. 223; *Russell v. Crichton*, 15 Decisions of Court of Session, 1st series, 1270; *Cheetham v. Oldham*, (1888) 5 R. P. C. 617; *Rylands v. Ashley's Patent (Machine Made) Bottle Co.*, (1890) 7 R. P. C. 175.

(u) *Russell v. Crichton*, (1837) 15 Decisions of Court of Session, 1st series, 1270; *Flower v. Lloyd*, Seton, 4th ed. p. 351; *Plating Co. v. Farquharson*, (1881) Griff. P. C. 187.

(x) (1876) W. N. 169.

(y) (1888) 5 R. P. C. 617.

(z) (1881) Griff. P. C. 187.

(a) *The Plating Co. v. Farquharson*, (1881) Lawson, Patents, Designs, and Trade Marks Acts, 2nd ed. p. 500; see also *Hill v. Touts*, *ibid.* 499.

(b) *Rylands v. Ashley's Patent (Machine Made) Bottle Co.*, (1890) 7 R. P. C. 175.

(c) R. S. C. (1883) Order 1. r. 3; and also see 46 & 47 Vict. c. 57, s. 30; vol. ii. p. 215; *Russell v. Cowley*, (1833) 1 W. P. C. 459; *The Patent Type Founding Co. v. Walter*, (1860) Johns. 727; *Plating Co. v. Farquharson*, (1881) Griff. P. C. 187; *The Germ Milling Co. v. Robinson*, (1886) 3 R. P. C. 14; *Cheetham v. Oldham*, (1888) 5 R. P. C. 621.

Evidence. It was held that the inspection authorised by the Act of 1852 (*d*) referred to an inspection of the instrument or machinery manufactured or used by the parties, with a view to evidence of infringement, and not to an inspection of books; (*e*) and probably the same meaning must be attached to the word as used in sec. 30 of the Act of 1883, and an inspection of books would not be allowed on affidavit merely showing the possibility of discovering matters advantageous to the case of the party seeking it. (*f*)

Inspection of books.

Inspection when the action is founded solely on a threat to infringe.

An injunction may be obtained restraining a threatened infringement; (*g*) and in a case where it appeared that the defendant had entered into a contract to make certain paddle-wheels, which the plaintiffs alleged were a violation of their patent, an order was obtained from the Court authorising the plaintiffs and their witnesses to be at liberty to inspect at all reasonable times, giving reasonable notice, the paddle-wheels or machinery relating to paddle-wheels made, or to be made, pursuant to the said contract. (*h*)

EVIDENCE.

Evidence when defendant does not appear at the trial.

If the defendant puts in a defence and does not appear at the trial, the plaintiff is not entitled to judgment without proof of his case: he must prove the grant and show that the specification is good on the face of it and also prove the infringement. (*i*)

Evidence not within the particulars.

By the Patents Act of 1852, (*k*) the evidence of both the plaintiff and the defendant was strictly confined to the particulars which had been given, and, therefore, if at the trial either party wished to give evidence not within them, the proper course was to apply at once for leave to amend, on the ground that fresh evidence had come to light since they were delivered. (*l*)

The Act of 1883 has somewhat enlarged the opportunities open to litigants of giving evidence at the trial by enacting that at the hearing no evidence shall, *except by the leave of the Court or a Judge*, be admitted in proof of any alleged

(*d*) s. 42.
 (*e*) *Vidi v. Smith*, (1854) 3 E. & B. 969.
 (*f*) *Smith v. G. W. Ry. Co.*, (1854) Macr. P. C. 223.
 (*g*) p. 384 *ante*.
 (*h*) *Morgan v. Scaward*, (1835) 1 W.

P. C. 169.
 (*i*) *Peroni v. Hudson*, (1884) 1 R. P. C. 261.
 (*k*) s. 41.
 (*l*) *Daw v. Eley*, (1861) L. R. 1 Eq. 38.

infringement or objection of which particulars have not been delivered; (m) but it is not safe to rely on the Court granting the necessary leave, and subsequently, if a party desire to go outside his particulars on the ground that the evidence was discovered since they were delivered, or for any other reason, he should still apply for leave to amend, which will, however, not be granted unless he makes out a sufficient case, (n) and then only upon the usual terms. But the Court—*i.e.*, both the Court of first instance and the Court of Appeal—has undoubted discretion, under the Act of 1883, to admit evidence not within the particulars without requiring an amendment of the particulars. (o) Nevertheless, a party desirous of giving evidence upon a point not strictly within the particulars should not depend on the Court exercising its discretion in his favour at the trial, but should make a previous formal application. If a matter is not put in issue the party against whom the issue is not raised is not only not bound to come with evidence directed to that issue, but he is actually bound to come without it, for it would be incurring useless expense if he came with evidence not addressed to an existing issue. On the other hand, an application to amend the particulars at the trial upon a matter merely subsidiary, on which evidence would be called in any case, would probably be granted.

Evidence:

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The Court has an absolute discretion, unfettered by any rule of practice, in each case as to admitting evidence not covered by the particulars, either unconditionally or upon amendment of the particulars and on terms. (p) The Court only rarely exercises its power of admitting evidence of which particulars have not been delivered—*e.g.*, where not to do so would be to stultify the action of the Court. Thus, where the defendant pleaded that what he did was done under a patent granted to him prior to the plaintiff's patent, and then at the trial tendered evidence not included in the particulars to the effect that he himself had publicly used the very thing claimed by both patents years before the date of either, *Kay*, L.J., ordered an adjournment and granted leave to adduce the defendant's evidence of prior user within a certain time, though he was not asked to do so, and stated that if it were put in he would allow the plaintiff an opportunity of dealing

Discretionary power of the Court or a Judge to admit evidence not within the particulars.

(m) s. 29 (4).

(n) *Moss v. Malings*, (1886) L. R. 33 Ch. D. 603; *Renard v. Levinstein*, (1864) 13 W. R. 229; 11 L. T. N. S. 505.(o) *Britain v. Hirsch*, (1888) 5 R. P. C. 226; see also *infra*.(p) See *Woolley v. Broad*, (1892) 9 R. P. C. 429; *Wilson v. Wilson & Co.*, (1899) 16 R. P. C. 315.

Evidence. with it, otherwise there would be judgment for the defendant without costs. (*q*)

The discretionary power of the Court to admit evidence not within the particulars is quite independent of its power to allow an amendment of the particulars for the purpose of admitting fresh evidence. (*r*)

Particulars not objected to are construed widely.

When particulars have been delivered, and not objected to, such evidence may be given under them as their words are sufficiently wide to include; (*s*) and, however general they may be, if the evidence tendered is within their literal meaning, it will be admitted. (*t*)

Thus evidence of user in Cheshire was admitted under an objection which alleged that the invention had been publicly used in "corn mills"; (*u*) and where the particulars alleged infringement by manufacture and sale at divers times between specified dates and also two specified instances of sale, evidence of a third sale was allowed, the defendant having, by his interrogatories, admitted such a sale. (*x*) When, however, an order for amendment of the particulars of objection had not been complied with, evidence of an anticipating specification not given under the order was not admitted. (*y*)

Patentee who has assigned his interest is a competent witness.

A patentee who has assigned the whole of his interest is a competent witness for the assignee in any action he may bring for the infringement of the patent. (*z*) If the patentee has covenanted with the assignee in respect of the validity of the patent, he may have an interest in the event of a subsequent action in which the question of validity is raised, but his evidence would not be excluded, although his interest would be a matter to be taken into consideration as affecting his credit. (*a*)

Licensee may be a witness for the plaintiff,

A licensee is also a competent witness for the plaintiff in a patent action, (*b*) though he may be an interested one. (*c*)

(*q*) *Hill v. Adams*, (1893) 10 R. P. C. 102; see also *Solvo Laundry Supply Co. v. Mackie*, (1893) 10 R. P. C. 68; *Britain v. Hirsch*, (1888) 5 R. P. C. 230; *Peckover v. Rowland*, (1893) 10 R. P. C. 118.

(*r*) *Britain v. Hirsch*, (1888) 5 R. P. C. 226; p. 455 *post*.

(*s*) *Neilson v. Harford*, (1841) 1 W. P. C. 331, 370.

(*t*) *Hull v. Bollard*, (1856) 1 H. & N. 134; *Curtis v. Platt*, (1866) 35 L. J. N. S. Ch. 852, 868; *Sugg v. Silber*, (1877) L. R. 2 Q. B. D. 495; *Sykes v. Howarth*, (1879) L. R. 12 Ch. D. 826;

48 L. J. N. S. Ch. 769; see also *Adair v. Young*, (1879) W. N. p. 8.

(*u*) *Hull v. Bollard*, (1856) 1 H. & N. 134.

(*x*) *Sykes v. Howarth*, (1879) L. R. 12 Ch. D. 826; 4 L. J. N. S. Ch. 769.

(*y*) *Lister v. Leather*, (1858) 3 Jur. N. S. 811.

(*z*) *Bloxam v. Elsec*, (1825) 1 C. & P. 563.

(*a*) 6 & 7 Vict. c. 85, s. 1; 14 & 15 Vict. c. 99, ss. 1 and 2.

(*b*) *Ibid.*

(*c*) *Ibid.*

If the licensee is empowered to use the invention in consideration of a periodical payment or a payment in proportion to the extent of his user, he cannot have an interest in supporting the patent (unless the payments are merely nominal or not a full consideration for the privilege granted), but he may be interested in its destruction. If the licensee has paid a gross sum for an irrevocable licence, or has obtained it for any other consideration, he may have an interest in supporting the patent, for if the invention be thrown open to the public he cannot obtain any benefit from the licence. Evidence.

Though the action be brought for the benefit of the licensee who has an exclusive licence for some particular district, he is a competent witness for the plaintiff, notwithstanding that he is a person "in whose immediate and individual behalf" the action is brought. (*d*) though the action is brought for his own benefit.

In patent actions the testimony of experts frequently forms the chief part of the evidence submitted to the Court both in importance and in volume. The following remarks of the late Lord Bowen illustrate the great importance of the evidence of scientific men of repute in cases, such as patent actions, where it is the duty of the Court to inform itself as to the state of scientific knowledge at the date of the patent bearing upon the subject-matter of the dispute between the parties. Necessity for and the value of the evidence of experts.

"If we are to act in the present instance, one must fall back upon the opinions of experts, and I wish emphatically to state my view, that in a matter like the present, so far from thinking the opinions of experts unsatisfactory, it is to the opinion of experts that I myself should turn with the utmost confidence and faith. Courts of law and courts of justice are not fit places for the exercise of the inductive logic of science. Life is short; it is impossible to place endless time at the disposal of litigants; and the laws of evidence are based upon this very impossibility of prolonging inquiries to endless length. There is hardly a scientific theory in the world which, if we were to examine into it in law courts, might not take year after year of the whole time of a tribunal. Supposing, for a moment, one had brought in question the circular theory of storms, and were to propose before a tribunal like this to examine it, not by reference to the opinions of the most experienced persons who have made it a subject of study and investigation, but to inquire ourselves into all the special circumstances of storms, with which witnesses could favour us who had crossed the Atlantic or the Eastern seas, in order to form our opinion, assisted, no doubt, by

(*d*) 14 & 15 Vict. c. 99, ss. 1 and 2.

Evidence.

scientific men, as to the circular theory of storms, with all the qualifications which might be adopted, and with all the definitions in which it might be embodied. Take another instance of a law which is very far from likely to be accepted by science, but most probably would be rejected as pure theory, and as utterly beyond reason. I believe there are many persons in India who endeavour to connect the existence of famine raging over tracts of country with spots on the sun. Supposing that theory were brought up in an English court of law, we should be bound to embark on an endless inquiry into all the instances in which spots on the sun had been found to be coincident with famines in India. The truth is, when you are dealing with scientific theories, it is hopeless for courts of law to do more than to take the evidence of scientific men, subject, no doubt, to cross-examination, which may or may not condescend to particular instances, which may be brought home to them to show, if it exists, the uncertainty of the grounds upon which their opinions are founded. The result of the admission of this evidence, assuming it, as I do, to be admissible, has been, in my judgment, to show that the endeavour to utilise such evidence launches us upon an inquiry fit only for the leisure of learned and scientific men, but for which the jury system and the judicial system are probably inadequate." (e)

Expert evidence is admissible to explain technical terms, to show the practical working of machinery described or drawn, to point out what is old and what is new in the specification, to show the particulars in which an alleged invention has been used by an alleged infringer or the real importance of any differences between the plaintiff's invention and the alleged infringement, and what are and what are not mechanical or chemical equivalents. But the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the Judge and not by a jury, nor by any expert or other witness, which is familiar law, although often disregarded by counsel when examining witnesses. (f)

The Court always scrutinises very carefully—even with suspicion—expert evidence and experiments prepared expressly for the purposes of either party at the trial. (g)

(e) *Fleet v. The Managers of the Metropolitan Asylums District* (1886); Cunningham's "Life of Lord Bowen," p. 162. The observations of Jessel, M.R., in *Thorn v. Worthington Skating Rink Co.*, (1876) L. R. 6 Ch. D. 415 n., indicate the unsatisfactory nature of

the expert evidence which is sometimes obtained and presented to the Court.

(f) See *Brooks v. Steel*, (1896) 14 R. P. C. 73; *Ticket Punch Register Co. v. Colley's Patents*, (1895) 12 R. P. C. 186.

(g) *Betts v. Neilson*, (1868) L. R. 3

If the grant of the patent be denied, it must be proved by the production of the letters patent themselves or a copy thereof certified by the Comptroller and sealed with the seal of the Patent Office, (h) and no further proof is necessary.

Evidence.
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 Proof of the grant of the patent,

The letters patent are only proof of the *purport* of the grant which they contain, the effect or operation of the grant being quite a different question. Although letters patent purport to grant a sole privilege to the patentee, it may be that the patent is for some reason illegal or void, and, if so, the patent is of no force, and the grant it purports to make has no operation, and consequently it is strictly correct to say that the King did not make such a grant as the plaintiff alleges, for a void grant is the same as no grant at all. (i) The letters patent merely prove the purport of the grant, and upon any dispute respecting the invention the specification must be read and considered as incorporated with the patent. (k)

It is incumbent on the plaintiff to prove what the invention really is for which the patent was granted. The proper way to do this is to put in the specification, and neither the patentee nor any other witness can be called to prove what the real invention is, the question being one which can only be answered from a critical examination of the specification, (l) which must, however, be interpreted by the light of public knowledge at the date of the grant, external evidence of which is, therefore, admissible for the purpose of deciding between two possible constructions of a claim. (m) Evidence of the patentee cannot be tendered to show what effect was intended by the specification. (n)

and the scope of the invention claimed.

If the defendant raises the issue that the patentee was not the true and first inventor, the *onus* of proof rests with him; (o) but it is usual for the plaintiff to tender *prima facie* evidence to the effect that the patentee was the first person who

Issue of true and first inventor.

Ch. 433; *Young v. Fernie*, (1864) 4 Giff. 609; *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 576; *Crompton v. Patents Investment Co.*, (1888) 5 R. P. C. 382, 404.

(h) 46 & 47 Vict. c. 57, s. 89.

(i) *Hindmarch*, p. 440.

(k) *Hornblower v. Boulton*, (1799) 8 T. R. 102; *Day*, P. C. 221; *Crossley v. Beverley*, (1829) 9 B. & C. 63.

(l) *Badische Anilin und Soda Fabrik v. Levinstein*, (1887) L. R. 12 App. Cas. 717; *Hinks v. Patent Safety Lighting Co.*, (1876) L. R. 4 Ch. D.

618; *Brooks v. Steel*, (1896) 14 R. P. C. 73; p. 339 *ante*.

(m) p. 286 *ante*.

(n) *Kayo v. Chubb*, (1887) 4 R. P. C. 289, 298.

(o) *Young v. White*, (1853) 22 L. J. Ch. 190; *Minter v. Wells*, (1834) 1 W. P. C. 129; *Cornish v. Keene*, (1835) 1 W. P. C. 507; *Amory v. Brown*, (1869) L. R. 8 Eq. 663; *Harris v. Rothwell*, (1887) 4 R. P. C. 229; *Nickels v. Ross*, (1849) 8 C. B. 679; *Ward v. Hill*, (1901) 18 R. P. C. 481.

Evidence. actually communicated the invention to the public. (*p*) This is usual done by calling the patentee himself, who claims to be the inventor; but when the patent was obtained on a communication from abroad, it is not necessary to call the foreign inventor. (*q*) It must not be forgotten that there is a sound distinction in the abstract between the issues of true and first inventor and novelty. (*r*)

Issue of subject-matter.

The decision of the issue raised by a plea that the alleged invention could not form the subject-matter of a valid patent rests more with a Judge than a jury. The plaintiff must give the specification in evidence, in order that the Judge may see what the alleged invention really is; and if there are terms of art involved, the jury, or Judge acting as a jury, must determine the meaning to be applied to them in the construction of the specification, which is the duty of the Court alone. (*s*) It should also be remembered that the ingenuity of any alleged invention—*i.e.*, whether there has been an exercise of the inventive faculty which will support the patent on the ground of subject-matter—is to be judged in the light of the state of public knowledge at the time it was made. (*t*) If the issues of subject-matter, novelty, and utility, or sufficiency of specification, have been decided on a previous occasion by a Court of co-ordinate or superior jurisdiction, the Court as a matter of convenience considers itself bound by the finding of the Court on the former occasion, so far as the same evidence is concerned, and will refuse to admit such evidence again. (*u*) Of course, if different evidence is adduced on any of these points, and there is no estoppel on the ground of the matter being *res judicata* between the parties, or from any other cause, the Court receives and gives effect to such fresh evidence. (*x*)

The plea of want of novelty does not put in issue the fact of the invention being a manufacture within the meaning of the Statutes of Monopolies for which a patent could be granted; (*y*) *i.e.*, it does not raise the issue of subject-matter. Another distinction between the issues of subject-matter and novelty is, that in order to consider subject-matter as distinguished from anticipation, a prior specification is not to

(*p*) p. 6 *ante*.
 (*q*) *Nettlefolds v. Reynolds*, (1892) 9 R. P. C. 270; *Badische Anilin und Soda Fabrik v. Levinstein*.
 (*r*) See p. 107 *ante*.
 (*s*) p. 265 *ante*.
 (*t*) p. 39 *ante*; *Beavis v. Rylands*

Glass and Engineering Co., (1900) 17 R. P. C. 710; *Patent Exploitation, Ltd. v. Siemens Brothers, Ltd.*, (1904) 21 R. P. C. 549.
 (*u*) *Slazenger v. Feltham*, (1889) 6 R. P. C. 130.
 (*x*) p. 406 *ante*. (*y*) p. 22 *ante*.

be excluded merely because something therein disclosed Evidence. would not work. (z)

If the novelty of the invention be denied, the plaintiff must give *prima facie* evidence that the invention had not been communicated to the public before the date of the patent. (a) In order to do this the plaintiff must call witnesses whose avocations were likely to have made them acquainted with the subject-matter of the alleged invention if it had been published prior to the date of the patent, and who are able to testify that it was unknown to them. It is clear that only indirect evidence of novelty can be given, since it is impossible to examine every member of the public; but if the plaintiff calls witnesses who for some time before the date of the patent were well acquainted with the particular branch of trade or manufacture to which the invention relates, and who can swear that they were ignorant of it until after the date of the patent, this will be sufficient *prima facie* evidence, and the *onus* of proving the negative will then be on the defendant. (b)

When novelty is in issue plaintiff must give *prima facie* evidence,

If the invention consist of several parts claimed separately, (c) or if several inventions have been comprised in the same patent, (d) it is incumbent on the plaintiff to give *prima facie* proof of the novelty of all the parts, or all the inventions, as the case may be. (e)

After the plaintiff has made a *prima facie* case in respect of novelty, the *onus* is on the defendant of showing that the invention was public property at the date of the patent, and, consequently not new as to the public knowledge and use of it, (f) but the evidence of one witness may be quite sufficient to do this; (g) though, if an alleged prior use made a long time ago is relied on, the uncorroborated evidence of persons interested in defeating the patent ought

after which the *onus* is on the defendant.

(z) See *Beavis v. Rylands Glass and Engineering Co.*, (1900) 17 R. P. C. 711; p. 152 ante.

(a) *Turner v. Winter*, (1787) Dav. P. C. 153; *Manton v. Manton*, (1815) Dav. P. C. 318; *Bovill v. Moore*, (1815) Dav. P. C. 399; *Galloway v. Bleadon*, (1839) 1 W. P. C. 525; *Cornish v. Keene*, (1835) 1 W. P. C. 509.

(b) *Cornish v. Keene*, (1835) 1 W. P. C. 509; *Manton v. Manton*, (1815) Dav. P. C. 350, 353; *Galloway v. Bleadon*, (1839) 1 W. P. C. 526; *Amory v. Brown*, (1869) L. R. 1 Eq. 663; *Harris v. Rothwell*, (1887) L. R.

35 Ch. D. 416, 427.

(c) *Manton v. Manton*, (1815) Dav. P. C. 340, 341; *Gibson v. Brand*, (1841) 4 M. & G. 179; *Gillett v. Wilby*, (1839) 9 Car. & P. 334; *Losh v. Hague*, (1837) 1 W. P. C. 208.

(d) *Brunton v. Hawkes*, (1820) 4 B. & Ald. 541; see Vol. II. p. 6.

(e) Chap. iii.

(f) *Penn v. Jack*, (1866) L. R. 2 Eq. 314; 14 W. R. 760; *Minter v. Wells*, (1834) 1 W. P. C. 129; *Peroni v. Hudson*, (1884) 1 R. P. C. 261.

(g) *Badham v. Bird*, (1888) 5 R. P. C. 238.

Evidence. not to carry the alleged prior use further than an experimental use. (*h*)

Documents as evidence of publication.

When a published document is alleged as an anticipation evidence should be called to explain it, if necessary. (*i*) But if the anticipation relied on is an English complete specification filed in the Patent Office no proof is required of further publication or its contents having been seen by the public, (*k*) for the second of two patents for the same invention must be bad in law. (*l*)

Where the want of novelty appears distinctly from a written document, it is for the Court, and not the jury, to determine the identity of the two supposed inventions, (*m*) aided as to the meaning of technical expressions by the finding of the jury, or the Judge acting as a jury. (*n*) But when a skilled workman, with the knowledge common to the trade at the date of the trial, produces in evidence a successful result, which he says he arrived at by following only the directions of an old and unused paper anticipation, the Courts weighs very carefully indeed such evidence before accepting it. (*o*)

Rebutting evidence may be given by the plaintiff on the issue of want of novelty.

Upon the issue of novelty the plaintiff is entitled to call evidence in reply for the purpose of rebutting that given by the defendant, on whom lies the *onus* of proving his case, (*p*) and such rebutting evidence is usually called at the close of the defendant's case. (*q*) Thus, at the hearing of an action where evidence had been admitted on behalf of the defendants which was not included under the particulars, the case was ordered to stand over, to allow the plaintiff an opportunity of rebutting such evidence, the defendants being allowed to amend their particulars. (*r*)

(*h*) *Dick v. Tullis*, (1896) 13 R. P. C. 149; *Pneumatic Tyre Co. v. Marwood*, (1897) 14 R. P. C. 240; p. 120 *ante*; but see *Haskell Golf Ball Co. v. Hutchinson*, (1905) 22 R. P. C. 478; 23 R. P. C. 301.

(*i*) *Hocking v. Fraser*, (1886) 3 R. P. C. 63; *Bovill v. Smith*, (1868) Griff. L. O. C. 52; *Betts v. Menzies*, (1862) 10 H. L. Cas. 117; pp. 121-124 *ante*.

(*k*) *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 551, 557; *Harris v. Rothwell*, (1887) L. R. 35 Ch. D. 416, 428.

(*l*) Chap. ii.

(*m*) *Bush v. Fox*, (1856) 5 H. L. Cas. 707; *Booth v. Kennard*, (1857) 2 H. & N. 84; *Hills v. London Gas Light Co.*, (1860) 5 H. & N. 312; *Betts v. Menzies*,

(1862) 10 H. L. Cas. 134; *Harwood v. Great Northern Ry. Co.*, (1865) 11 H. L. Cas. 654; *Simpson v. Holliday*, (1866) L. R. 1 H. L. 315.

(*n*) *Betts v. Menzies*, (1862) 10 H. L. Cas. 134; *Harwood v. Great Northern Ry. Co.*, (1865) 11 H. L. Cas. 654; *Simpson v. Holliday*, (1866) L. R. 1 H. L. 320.

(*o*) *Defries v. Sharwood*, (1897) 13 R. P. C. 313; *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 573-576; p. 464 *post*.

(*p*) p. 461 *ante*.

(*q*) *Penn v. Jack*, (1866) L. R. 2 Eq. 314; *Westley Richards & Co. v. Perkes*, (1893) 10 R. P. C. 187.

(*r*) *Blakey v. Latham*, (1889) 6 R. P. C. 29, 36.

A plaintiff, however, who has tendered evidence of novelty, and has had his attention called to a particular alleged anticipating document, cannot for the purpose of explaining its contents recall a witness in reply, who when he gave his evidence was acquainted with the document. (s) A plaintiff has been allowed, after the conclusion of all the evidence, but before judgment, which had been reserved, to give fresh evidence on a point relevant to the issue, which had not been "threshed out." (t)

Evidence.
 Recalling
 witnesses.

A defendant cannot recall the plaintiff's witnesses, after the conclusion of the cross-examination, in order to put to them fresh instances of publication, unless it can be shown that such instances only came to the defendant's knowledge since the cross-examination, and could not, with due diligence, have been discovered earlier; (u) and similarly a plaintiff who has not required an affidavit of documents cannot recall a witness for the purpose of cross-examining him as to the effect or contents of a document disclosed during the trial, (x) and the defendant will not be allowed to give further evidence in answer to the rebutting evidence given by the plaintiff in reply, if the defendant's evidence has been summed up, or the Court is of opinion that the witnesses whom the defendant tenders should, if they have already given evidence, have been examined as to the point in question in chief, or, if they have not already given evidence, should have been called in chief and not in rejoindure. (y) In cases, however, where the interests of justice require it and the defendant has not been unduly lax in his observance of the rules as to the giving of evidence, the Court will allow him to tender evidence in rejoindure to the rebutting evidence given by the plaintiff.

If the defendant relies upon publication in a prior document, he should give the plaintiff notice to admit that the document was published prior to the date of the patent. If the publication of any document is not admitted, it must be proved by calling the librarian of the public library at which the book or document was before the date of the patent. (z)

Notice to admit
 documents.

Where an affidavit of documents had been required by the

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| (s) Tetley v. Easton, (1852) Mac. P. C. 61. | Ch. 132. |
| (t) Boyd v. Horrocks, (1888) 5 R. P. C. 557. | (z) Sugg v. Bray, (1884) L. J. Ch. 132. |
| (u) Moss v. Malings, (1886) 3 R. P. C. 373; Sugg v. Bray, (1884) 54 L. J. | (y) Penn v. Jack, (1866) L. R. 2 Eq. 24. |
| | (z) R. S. C. (1883) Order xxxii. r. 4. |

Evidence. plaintiff, he was not allowed to recall one of the defendant's witnesses for the purpose of cross-examining him as to the contents of a report the defendant had received from a patent agent, which report was not produced, and was only referred to at a late stage of the trial. (a)

Models as evidence.

Models are similar to documentary evidence, and the Court will draw its own conclusions from them. (b) If a witness goes too far in his statements or admissions as to the effect of an alleged anticipation, and proved or admitted models are before the Court, the Court may be guided by the actual models themselves, notwithstanding the statements or admissions of the witness. (c)

When the difference between the patented article and an alleged disused prior anticipation is something apparently slight, but really important, the Court ought not to accept the evidence of a man who puts forward a perfected model as representing his idea of the alleged anticipation, when it appears that before making the model he saw the form patented, and made it with that knowledge evidently in his mind. Thus, *Jessel, M.R.*, in the *Plimpton* skate case, (d) in effect, said, "I will not accept the evidence of any man who says that the drawing in the Patent Office is represented by a model if he has seen the real *Plimpton* skate."

It is, of course, a most improper thing for a party to make any alteration in the working power of a model once put in evidence, whether by cleaning or otherwise, unless it be done by permission of the Court, and upon notice to, and, if desired, in the presence of the other party, or his advisers. (e)

Proof of utility.

If the plea of want of utility is raised as an objection to the patent, the plaintiff must give *prima facie* evidence to prove that the invention was useful to the public at the date of the grant. (f) It is important to do this, since the evidence of

(a) *Sugg v. Bray*, (1884) 54 L. J. N. S. Ch. 132.

(b) *Seed v. Higgins*, (1860) 8 H. L. Cas. 565; *Westinghouse v. L. & Y. Ry. Co.*, (1884) 1 R. P. C. 245; *Bovill v. Smith*, (1868) Griff. L. O. C. 52; *Winby v. Manchester, &c., Steam Tramways Co.*, (1891) 8 R. P. C. 63.

(c) *Seed v. Higgins*, (1860) 8 H. L. Cas. 565; *Moore v. Bennett*, (1884) 1 R. P. C. 137.

(d) *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 573-576.

(e) *Winby v. Manchester, &c., Steam*

Tramways Co. (No. 2), (1891) 8 R. P. C. 63.

(f) Chap. iv., *R. v. Arkwright*, (1785) Dav. P. C. 135; *Manton v. Parker*, (1815) Dav. P. C. 327; *Manton v. Manton*, (1815) Dav. P. C. 333; *Bovill v. Moore*, (1815) Dav. P. C. 399; *Minter v. Wells*, (1834) 1 W. P. C. 129; *Hill v. Thompson*, (1817) 2 W. P. C. 237; *Crane v. Price*, (1812) 1 W. P. C. 411; *Russell v. Cowley*, (1835) 1 W. P. C. 467; *Bruntan v. Hawkes*, (1820) 4 B. & Ald. 541; *Derosne v. Fairie*, (1835) 5 Tyr. 393; 2 Cr. M. & R. 476.

utility raises a presumption in favour of novelty and ingenuity. (g) Evidence.

If the defendant sets up a *prima facie* case that the invention was not useful, the burden is then on the plaintiff to prove that it was useful. (h)

The fact that the defendant has attempted to infringe is itself evidence of utility. (i)

The degree of utility is quite immaterial under this issue; it is quite sufficient if the plaintiff can show that the invention was of *any* utility to the public. (k)

The question of utility must be determined with reference to the date of the patent. If it can be shown that it was then of some utility to the public, it is no objection that owing to more recent improvements it has since become useless; (l) and, if the patentee has obtained a subsequent patent for an improvement on a prior invention, it is not to be inferred that the prior invention was therefore useless. (m)

Each essential part of the invention must be shown to be useful; (n) for, if a material part is useless, the patent is void. (o)

It is not necessary that the utility of every part of an invention should be proved by actual trial; evidence of skilled persons to the effect that if tried it would answer may be sufficient. (p) Thus, in *Neilson v. Harford* (q) a question arose as to the utility of a certain vessel which according to the specification formed a material part of the invention. There was no evidence of any person having actually tried the vessel of the shape in question, but there was the evidence of scientific witnesses to the effect that it would answer, and the Judge who tried the case told the jury that if they were satisfied with that evidence it was quite sufficient to establish utility.

If the plaintiff proves that the invention as a whole is:

(g) *Lyon v. Goddard*, (1893) 10 R. P. C. 121, 334, 343; 11 R. P. C. 354.

(h) *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 449.

(i) *Lucas v. Miller*, (1885) 2 R. P. C. 160; *Reynolds v. Amos*, (1886) 3 R. P. C. 215; *United Horseshoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 407; *Badische Anilin und Soda Fabrik v. Levinstein*, (1887) L. R. 12 App. Cas. 712.

(k) p. 164 *ante*.

(l) p. 162 *ante*.

(m) *Otto v. Linford*, (1881) 46 L. T. N. S. 39; *Elison v. Holland*, (1889) 6 R. P. C. 277; *Thompson v. Batty*, (1889) 6 R. P. C. 100; p. 76 *ante*.

(n) p. 166 *ante*.

(o) *Hill v. Thompson*, (1818) 8 Taunt. 375; *United Horseshoe and Nail Co. v. Stewart*, (1885) 2 R. P. C. 122, 132.

(p) pp. 164, 237 *ante*.

(q) (1841) 1 W. P. C. 295.

Evidence. useful, he is not bound to prove that each part of it possesses an equal amount of utility. (*r*)

Effect of user
on the issue of
utility.

The fact that an invention has not come into general use raises a strong presumption against its utility; (*s*) but it is not to be assumed from such evidence that the invention was not sufficiently useful to support a patent. The reason why an invention has not come into general use may be that immediately after the discovery an improvement upon it may have been produced, which, for commercial reasons, prevented the general adoption of the former invention. (*t*)

It is to be observed that a large sale of a patented article does not necessarily prove that it possesses the kind of utility which the patent law requires to support a patent—*i.e.*, that it is useful for the purpose in view, (*u*) or that it is novel. (*x*) The reason why the article has a large sale may be that it is well advertised, or got up in a manner likely to attract the purchasing public. (*y*) On the other hand, the fact that thousands of a patented article have been sold, and, in consequence of their superiority, others of a similar nature have become a drug in the market, may afford evidence of the utility of the patent. (*z*)

Proof of sufficiency of the specification.

The burden of giving some evidence of the sufficiency of the specification is upon the plaintiff, as was held by *Bullen, J.*, in a case in which his Lordship is reported to have said: "I do not agree with the counsel who have argued against this rule in saying that it was not necessary for the plaintiff to give any evidence to show 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 evidence to show what his invention was, unless the other side admits 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 show in what his invention consists, and that he produced the effect proposed

(*r*) pp. 161, 169, 237 *ante*; *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 203.

(*s*) *Morgan v. Seaward*, (1837) 1 W. P. C. 185; *Simister's Patent*, (1842) 1 W. P. C. 723; *Morgan v. Windover*, (1888) 5 R. P. C. 303; *Re Bakewell's Patent*, (1862) 15 Moo. P. C. 386; *Re Allan's Patent*, (1867) L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 443.

(*t*) *Badische Anilin und Soda Fabrik v. Lovinzein*, (1897) L. R. 12 App. Cas. 710, 712; *United Telephone Co.*

v. Bassano, (1886) 3 R. P. C. 313; *Kurtz v. Spence*, (1888) 5 R. P. C. 182; *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 510; *Edison v. Hollaud*, (1888) 5 R. P. C. 283.

(*u*) pp. 162, 163 *ante*.

(*x*) pp. 31, 108 *ante*.

(*y*) *Cole v. Saqui*, (1888) 5 R. P. C. 489; 6 R. P. C. 41.

(*z*) *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 437, 449; *American Braided Wire Co. v. Thompson*, (1888) 5 R. P. C. 113.

by the patent in the manner specified. Slight evidence of this on his part is sufficient, and it is incumbent on the defendant to falsify the specification." (a) Evidence.
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A plea of the insufficiency of the specification puts the plaintiff to the necessity of giving evidence to the effect that the specification does particularly describe and ascertain the nature of the invention, and in what manner it is to be performed.

For the purpose of proving the sufficiency of the specification it is enough for the plaintiff to call workmen of ordinary intelligence engaged in the trade to which the invention relates who are able to state that they can or have actually performed the invention with no other aid than the specification. (b)

Under an issue of insufficiency of the specification the plaintiff must prove that it sufficiently describes and ascertains every part of the invention; that it is intelligible to persons of ordinary skill engaged in the trade to which the invention relates; and that the invention is capable of producing the effects specified. (c) If there are any technical terms or terms of art used in the specification which require explanation to make the description intelligible, evidence must be given of their meaning, but the plaintiff is not allowed to correct or explain any error or misdescription unless it be such that it could not possibly mislead. (d)

If the defendant can prove that there is anything material stated in the specification which is false (e) or calculated to mislead or puzzle a person who might attempt to follow its directions, the patent will be void. (f)

The construction of the specification is for the Court, aided by such facts as are admissible, to explain written documents. The ambit of a claim may be largely governed by the state of common knowledge at the date of the patent. (g) Evidence of such common knowledge, which is directed merely to fixing the ambit of a claim and not to the invalidity of the patent, is admissible without specification in the particulars of objection. (h) The evidence of scientific witnesses is only Proof of
Infringement.

(a) *Turner v. Winter*, (1787) Dav. P. C. 153; 1 T. R. 606.

(b) *Cornish v. Keeno*, (1835) 1 W. P. C. 503; *Shaw v. Jones*, (1889) 6 R. P. C. 335; *Edison v. Holland*, (1889) 6 R. P. C. 243.

(c) p. 164 ante.

(d) p. 288 ante.

(e) *Bickford v. Skowes*, (1841) 1 Q.

B. 938; *Lewis v. Marling*, (1829) 10 B. & C. 22.

(f) pp. 202, 207, 217 ante.

(g) p. 355 ante.

(h) *Appelby's Twin Roller Chain*, (1899) 16 R. P. C. 325; *Holliday v. Heppenstall*, (1889) 6 R. P. C. 326; *Boxwell v. Cochran*, (1895) 12 R. P. C. 169; but see p. 419 ante.

Evidence. admissible as proof of facts. Their opinion as to whether there has been an infringement or not, though sometimes received in order to save time and trouble, is, strictly speaking, inadmissible, and if objected to ought to be rejected. (*i*)

When expert evidence is called for the purpose of explanation, and the first witness explains all that requires explanation, and is not broken down in cross-examination, there is no need to call further expert witnesses on the same points, and it is not admissible to do so. (*k*)

In order to substantiate the allegation of infringement, the plaintiff must prove that the defendant has used the art which forms the subject-matter of the patent, or that he has violated the patent privilege in the manner alleged in the statement of claim. The users or violations in respect of which relief is claimed must of course have taken place during the life time of the patent. (*l*)

And in order to make out his case it is not necessary that the plaintiff should prove that the defendant has used the whole of the art or invention comprised in the patent; it is sufficient to show that he has used any essential part of it. (*m*)

In the event of a patentee owning several patents which together control all known methods of producing a certain article, it may, obviously, be impossible to prove which particular patent has been infringed though it may be manifest that one or other must have been violated. In such a case, the Court would probably grant an injunction, but make an order as to damages suited to the facts of the particular case. (*n*)

The same rule applies to the infringement of all patents, whether they are "pioneer" or "master patents" or not—*i.e.*, in order to make out infringement it must be established to the satisfaction of the Court that the alleged infringer, dealing with what he is doing as a matter of substance, is

(*i*) *Seed v. Higgins*, (1860) 8 H. L. C. 565; *Bovill v. Smith*, (1868) Griff. L. O. C. 52; *Westinghouse v. Lancashire and Yorkshire Ry. Co.*, (1884) 1 R. P. C. 245.

(*k*) *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 116.

(*l*) See *British Insulated Wire Co. v. Dublin United Tramway Co.*, (1899) 17 R. P. C. 14.

(*m*) *Cornish v. Keene*, (1835) 1 W. P. C. 501; *Morgan v. Seaward*, (1836) 1 W. P. C. 170; *Jones v. Pearce*, (1832) 1 W. P. C. 124; *Crane v. Price*, (1842) 4 M. & G. 580; *Hill v. Thompson*, (1817) 8 Taunt. 375; 3 Mer. 622; 1 W. P. C. 232; pp. 338-345 *ante*.

(*n*) *Saccharin Corporation v. Quincy*, (1900) 17 R. P. C. 337; but see p. 394 *ante*.

taking the invention claimed by the patent, not the invention which the patentee might have claimed if he had been well advised or bolder, but that which he has in fact and substance claimed on a fair construction of the specification. (o) Evidence.

It is sometimes stated that the Court is bound by the construction put upon the specification by a Court of equal or superior jurisdiction in prior proceedings, but this statement is only partially true. When it is a matter of pure construction of the document itself, and the construction is not dependent upon a consideration of the external facts as to prior knowledge, (p) or when the conclusion depends on a consideration of external facts, but the materials before the Court are substantially the same as those considered in a previous action, (q) the Court, as a matter of convenience to itself, follows the construction adopted by a Court of equal jurisdiction as being a decision on a point of law; (r) but whether the claim is too wide is a question of fact which must be decided *de novo* in the light of any fresh evidence as to the state of public knowledge which may be adduced in any subsequent action; (s) and generally when the state of public knowledge at the date of the specification is a circumstance which may affect its true construction, (t) though a specification has been construed previously by a Court of equal or superior jurisdiction, the Court will consider and reconstrue the specification on a subsequent occasion, if it appears that the facts as regards public knowledge presented to the Court are materially different from those before the Court on the former occasion; (u) but new arguments are to be distinguished from and do not have the same effect in this matter as new facts do. (x) Further, the fact that a Court of equal jurisdiction has construed the specification with reference to a particular act complained of as an infringement will not

Effect of prior construction of the specification by a Court of equal jurisdiction.

(o) *Per Romer, J., Nobel's Explosives Co. v. Anderson*, (1894) 11 R. P. C. 128.

(p) *Edison v. Holland*, (1889) 6 R. P. C. 276; *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 367; *Patent Exploitation v. American Novelty and Manufacturing Co., Ltd.*, (1903) 20 R. P. C. 697.

(q) *National Opalite Glazed Brick and Tile Co. v. Grand Hotel, Birmingham*, (1891) 18 R. P. C. 249.

(r) p. 265 *ante*; *Pneumatic Tyre Co., Ltd. v. Leicester Pneumatic Tyre and*

Automatic Valve Co., (1898) 16 R. P. C. 55, 58, 59.

(s) *Edison v. Holland*, (1889) 6 R. P. C. 276; *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 367; *Patent Exploitation v. American Novelty and Manufacturing Co., Ltd.*, (1903) 20 R. P. C. 697.

(t) pp. 283-284 *ante*.

(u) *Pneumatic Tyre Co., Ltd. v. Leicester Pneumatic Tyre and Automatic Valve Co.*, (1898) 16 R. P. C. 55, 58, 59.

(x) *Ibid.* 56.

Evidence. deter the Court on a subsequent occasion from considering the construction with reference to another and substantially different act alleged to be an infringement. (y)

Defendant himself a patentee.

The fact that the defendant has himself obtained a patent for what he is doing, is in itself no evidence of infringement, and the defendant is not placed thereby in any different position to any other member of the public. The question is what he has in fact done. (z)

Evidence must be given to the effect that the alleged infringement was not committed by an agent or under the licence of the patentee.

It must be proved strictly that the alleged infringing article was not made by the plaintiff, or any agent or licensee of the plaintiff. (a) Where the plaintiff omits to give this necessary evidence and merely proves the sale of the article by the defendant, an opportunity may be given him of perfecting the evidence, if he is able to do so, after his case is closed. (b) For instance, care must be taken in collecting evidence of infringement, that the article relied on as proof of infringement was not made by the alleged infringer under such circumstances that he can contend that what he did was as agent of or in accordance with the instructions of a properly authorised agent of the plaintiff and therefore no infringement. Thus in *Kelley v. Bachellor*, (c) where a patentee for the purpose of getting evidence of infringement sent an agent to a manufacturer and ordered an article to be made in a particular way which was within the patent, and then, after obtaining it, moved for an interim injunction, the Court dismissed the motion with costs on the ground that the defendant, having worked to the detailed orders of the plaintiff's agent, was not liable as an infringer. This case must be distinguished from one like *Dunlop Pneumatic Tyre Co. v. Neal*, (d) where the employment of the agent by the plaintiff was only for the purpose of seeing what the defendant would do under given circumstances. The defendant was by injunction restrained till trial from infringing. It appeared that he undertook to repair a worn-out patented article in such manner as practically to make a new one, and the contention that an old article was brought for repair by the plaintiff's agent failed on the ground that the agent had no authority to, and in fact did not, give any detailed

(y) *Welsbach Incandescent Gas Light Co. v. Daylight Incandescent Mantle Co.*, (1899) 17 R. P. C. 147.

(z) *Tweedale v. Ashworth*, (1890) 7 R. P. C. 431.

(a) *Betts v. Willmott*, (1871) L. R.

6 Ch. 239; 25 L. T. N. S. 181.

(b) *Farbenfabriken vorm F. Bayer v. Bowker*, (1891) 8 R. P. C. 389.

(c) (1893) 10 R. P. C. 289.

(d) (1899) 16 R. P. C. 247.

instructions but merely tested what the defendant would, at his own instigation, do under the circumstances. Evidence.

If the defendant alleges a licence, it is open to the plaintiff to prove, if he is able to do so, that such licence was given under misapprehension and was therefore not effective. (e)

There are many cases in which it is impossible to ascertain what it is the defendant has done. Under such circumstances the proper course is for the plaintiff to make out a *prima facie* case, and if the plaintiff makes out a *prima facie* case which the defendant does not venture to answer, the Court will conclude that the alleged wrongful acts have been done in the manner which the plaintiff or his witnesses believe. (f) The defendant may, however, give evidence to show that what he has done does not amount to a user of the art protected by the patent. Thus he may prove that the articles complained of are substantially different to those described in the specification, or that they were manufactured according to a process different to that claimed by the patentee, and this will be a complete answer to the charge of infringement. (g)

When it is sufficient for the plaintiff to make out a *prima facie* case of infringement.

If the patent is for a process only and does not include the manufactured article, the *onus* is on the plaintiff to show that the article alleged to have been manufactured in infringement has, in fact, been so made. (h) And similarly, if the patent is for the manufacture of any particular machine, the sale of an article made by the machine might be no proof of infringement.

If the plaintiff proves that the defendant has without authority (i) sold a patented article he makes out a *prima facie* case of infringement, and throws the *onus* on the defendant of showing either that he was a licensee of the plaintiff, or that he bought the article from a person who was authorised by the plaintiff to manufacture and sell it. (k)

Evidence that a defendant gave an order in England, which order was executed in England, for the manufacture by a

(e) Edison-Bell Consolidated Phonograph Co. v. Rosenberg, (1899) 16 R. P. C. 608.

(f) Huddart v. Grimshaw, (1803) Dav. P. C. 265; Hall v. Jarvis, (1822) 1 W. P. C. 100; Badische Anilin und Soda Fabrik v. Dawson, (1889) 6 R. P. C. 387, 396; Edison v. Woodhouse, judgment of Butt, J., (1886) 3 R. P. C. 167.

(g) Morgan v. Seaward, (1837) 1 W. P. C. 171; Walton v. Potter, (1841) 1

W. P. C. 585, 589.

(h) Palmer v. Wagstaffe, (1853) 8 Exch. R. 840; 22 L. J. N. S. Ex. 295; 9 Exch. R. 49; 23 L. J. N. S. Ex. 217.

(i) Betts v. Willmott, (1870) L. R. 6 Ch. 239.

(k) Badische Anilin und Soda Fabrik v. Dawson, (1889) 6 R. P. C. 387, 396; Gibson v. Brand, (1841) 1 W. P. C. 630.

Evidence. patented process of articles which were afterwards received by him, is quite sufficient to satisfy an allegation that he made those articles; for he that causes and procures things to be made may well be said to have made them himself. (*l*)

And in the absence of evidence to the effect that articles complained of may have been manufactured by a process different to that comprised in the patent, (*m*) the following facts are *prima facie* evidence of infringement: similarity of structure in the patented article and the things produced by the defendant where a trade secret is alleged and there has been no inspection by the plaintiff; (*n*) the offering for sale of an article in the state produced by the application of a patented machine where it is proved that the defendant had one such machine in his possession. (*o*)

When a plaintiff must prove that an alleged infringing article was not made under his authority.

Under some circumstances, however, the *onus* is on the plaintiff of proving not merely the sale of the patented article, but, further, that it was not manufactured by himself or under his authority—*e.g.*, where a patentee has manufactories both in England and abroad. (*p*)

Defence that an alleged infringement is a secret process.

Where the defence was that the alleged infringement was an exercise by the defendant of a secret process he was allowed to refuse to answer questions on cross-examination which might disclose his process, and, at his election, evidence was taken *in camera* of what the alleged secret process really was, and the shorthand notes of such evidence were ordered to be impounded in Court until there should be an appeal, or until further order. (*q*)

Special provisions of the Act of 1883.

The Patents Act, 1883, contains special provisions with regard to the giving in evidence of, and the effect as evidence of, the seal of the Patent Office, (*r*) the Register of Patents, (*s*) Patent Office copies and certificates of specifications, disclaimers, and other documents or extracts from them, (*t*) and orders and certificates made by the Board of Trade. (*u*)

(*l*) *Gibson v. Brand*, (1841) 1 W. P. C. 631.

(*m*) *The Cartsburn Sugar Refining Co. v. Sharp*, (1884) 1 R. P. C. 181, 186.

(*n*) *Huddart v. Grimshaw*, (1803) 1 W. P. C. 91; *Davenport v. Richard*, (1860) 3 L. T. N. S. 503.

(*o*) *Hall v. Jarvis*, (1822) 1 W. P. C. 100.

(*p*) *Betts v. Willmott*, (1870) L. R.

6 Ch. App. Cas. 239; *Société Anonyme, &c. v. Tilghman's, &c., Co.*, (1883) L. R. 25 Ch. D. 1.

(*q*) *Badische Anilin und Soda Fabrik v. Levinstein*, (1883) L. R. 24 Ch. D. 156, 170.

(*r*) s. 12, sub-ss. 2 and 84.

(*s*) s. 23, sub-s. 2.

(*t*) ss. 89 and 96.

(*u*) s. 102, sub-ss. 2 and 3; also Act of 1888, s. 25.

TRIAL.

Trial.

Actions for infringements of patents may be brought in either division of the High Court of Justice, or in the Court of the County Palatine of Lancaster. (x) The County Courts have no jurisdiction to entertain an action in which the validity of the patent is in question, because a patent is a franchise and under sec. 56 of the County Courts Act, 1888, a County Court has no cognisance of any action in which the title to any franchise is in question. Moreover a special jurisdiction was given to the High Court by secs. 28, 29, and 117, of the Patents Act, 1883, and it cannot be contended that the later County Courts Act, 1888, gave to County Courts an open jurisdiction in such actions. (y)

Jurisdiction of
the Courts.

It is submitted that an action to recover royalties amounting to not more than a hundred pounds could be brought in a County Court, notwithstanding the fact that the ambit of the claim may be disputed by a licensee. (z)

The provisions of the Arbitration Act, 1889, apply to patent actions equally as to other actions. Arbitration.

Infringement actions are, in accordance with the express provisions of the Patents Act, 1883, tried without a jury unless the Court directs otherwise. (a) Trial is usually by the Court alone.

As a rule, patent actions do not require the intervention of a jury, and can be more satisfactorily disposed of by a Judge alone. (b) In the words of Lord Selborne, L.C., (c) "It is to be observed that such cases almost always involve questions of law and fact, not only mixed, but mixed in such a way as to render the extrication of them extremely difficult; secondly, that very often much must depend upon the construction of documents, as to which a jury must take their direction entirely from the Judge; thirdly, that much of the evidence in such cases is argumentative and relative to matters of opinion, so as to make it extremely hard, even for the Judge himself, to keep it under proper control; and, lastly, that even the questions of fact are often, to a very great extent, questions of science, which, to say the least, are as likely to be as well Patent actions are in rare cases tried by jury.

(x) R. v. Judge of County Court of Halifax, (1891) 8 R. P. C. 344.

(y) *Ibid.* 338.

(z) Cutlan v. Dawson, (1896) 13 R. P. C. 710; 14 R. P. C. 249.

(a) 46 & 47 Vict. c. 57, s. 28.

(b) Bovill v. Hitchcock, (1868) L.

R. 3 Ch. 417; Young v. Fornie, (1863) 1 De G. J. & S. 353; Downes v. Hughes & Co., (1880) 69 L. T. 150; Sugg v. Silber, (1874) L. R. 1 Q. B. D. 362.

(c) Patent Marine Inventions Co. v. Chadburn, L. R. 16 Eq. 447.

Trial.

decided by a Judge as by a jury. It very rarely happens, if it ever does, that in such cases the practical work is not done by the Judge. It very rarely happens, if it ever does, when a thing is not reduced to a narrow question of fact, that the jury do not simply follow, after a very elaborate discussion of the case by the Judge, the direction of the Judge."

e.g., where there is an allegation of fraud.

An allegation of fraud may induce the Court to accede to a request for a jury. Thus in a case where the plaintiff opened fraud, but the defendant's counsel protested that this was not raised by the pleadings and asked for a jury, a trial by jury was allowed and the cause was directed to stand over for that purpose. (*d*)

Juries are rarely asked for now in patent cases, and it is submitted that only where there is an allegation of fraud (*e*) or libel (*f*) would a jury be allowed. (*g*)

Trial by jury cannot be had before a Judge of the Chancery Division of the High Court of Justice. (*h*) Actions commenced in the Chancery Division must be set down in the general list, if they are to be tried by a jury, to be tried by one of the Judges of the Common Law Division.

Trial with the aid of an assessor.

The Court has power to, and on the request of either party it must, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance. (*i*)

In cases where an assessor is called in, the remuneration to be paid to him is determined by the Court, and paid in the same manner as the other expenses of the execution of the Act of 1883. (*k*)

When the case is tried with the assistance of an assessor it is proper for the assessor to furnish a written statement of his opinion to the Judge, and such statement may be read in the Court of Appeal for the reason that without it that Court might not be able to do justice between the parties. (*l*)

(*d*) *Tangye v. Stott*, (1865) 14 W. R. 128.

(*e*) *Joseph Lucas, Ltd. v. Miller*, (1899) 17 R. P. C. 165.

(*f*) R. S. C. Order xxxvi. r. 2; *Alfred Appleby's Twin Roller Chain, Ltd. v. Albert Edie Chain, Ltd.*, (1899) 16 R. P. C. 318.

(*g*) Since the Act of 1883 there are only six patent actions reported as having been tried with a jury—*v. v.*, *Young v. Rosenthal*, (1884) 1 R. P. C. 29; *Westinghouse v. Lancashire and Yorkshire Ry. Co.*, (1884) 1 R. P. C. 229; *Edge v. Harrison*, (1891) 8 R. P. C. 74; *Westley v. Tolley*, (1894) 11 R.

P. C. 602; *Alfred Appleby's Twin Roller Chain, Ltd. v. Albert Edie Chain, Ltd.*, (1899) 16 R. P. C. 318; *Joseph Lucas, Ltd. v. Miller*, (1899) 17 R. P. C. 165.

(*h*) *Warner v. Murdoch*, (1877) L. R. 4 Ch. D. 750.

(*i*) 46 & 47 Vict. c. 57, s. 28.

(*k*) *Ibid.* s. 28 (3). As to the effect of an assessor's opinion on the judgment of the Court, see *The Beryl*, L. R. 9 P. D. 137, 141; *Hattersley v. Hodgson*, (1904) 22 R. P. C. 229.

(*l*) *Hattersley v. Hodgson*, (1904) 22 R. P. C. 229.

Before the repeal of Lord Cairns' Act (*m*) and Sir John Roll's Act, (*n*) the practice had arisen in the Court of Chancery of directing in patent suits the trial of issues relative to the validity of the patent and to the fact of infringement, and, though those Acts are now repealed, (*o*) the jurisdiction which they established is not abolished, (*p*) but is exercised by both divisions of the High Court of Justice, (*q*) though it is not usual to try the issues of validity and infringement on different occasions.

Trial.

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Trial of issues separately.

The Court has the power to order any issue of fact in a patent action to be tried before an official referee, (*r*) and to order a trial without a jury of any cause, matter, or issue requiring any prolonged examination of documents or accounts, or any scientific or local examination which cannot, in the opinion of the Court or a Judge, be tried with a jury, (*s*) or at any time to order any cause, matter, or issue to be tried by a Judge with a jury, or by a Judge sitting with assessors, or by an official referee or a special referee with or without assessors. (*t*)

If it appear to the Court or a Judge that the issues of fact in dispute in a patent action are not sufficiently defined, the parties may be directed to prepare issues, and, if the parties differ, such issues will be settled by the Court or a Judge; (*u*) but issues will not be directed unless the Court is satisfied that there is a real question to try, (*x*) and most probably not at all, if the motion is opposed by the plaintiff, (*y*) or is made after the disclosure of the plaintiff's evidence. (*z*)

If it appear to the Court or a Judge that there is in any cause or matter a question of law which it would be convenient to have decided before any evidence is given of any question or issue of fact is tried, or before any reference is made to a referee or an arbitrator, the Court or a Judge may make an order accordingly, and may direct such question of law to be raised for the opinion of the Court, either by special case or in such other manner as the Court or a Judge may

(*m*) 21 & 22 Vict. c. 27.

(*n*) 25 & 26 Vict. c. 42.

(*o*) 46 & 47 Vict. c. 49.

(*p*) *Sayers v. Collyer*, (1884) L. R. 28 Ch. D. 103, 108.

(*q*) 46 & 47 Vict. c. 57, s. 117.

(*r*) 36 & 37 Vict. c. 66, s. 57; *Saxby v. Gloucester Waggon Co.*, W. N. (1880) p. 28.

(*s*) R. S. C. (1883) Order xxxiii. r. 5.

(*t*) *Ibid.* r. 7a.

(*u*) R. S. C. (1883) Order xxxiii. r. 1; see Seton on Decrees, 4th ed. p. 347, for the form of issues.

(*x*) *Davenport v. Phillipps*, (1865) 5 N. R. 485.

(*y*) *Henderson v. The Runcorn Soap and Alkali Co.*, W. N. (1868) p. 250; 19 L. T. N. S. 377.

(*z*) *Roskell v. Whitworth*, (1870) L. R. 5 Ch. App. Cas. 459.

Trial.

deem expedient, and all such further proceedings as the decision of such question of law may render unnecessary may thereupon be stayed. (a)

And, subject to the provisions of the first seven rules of Order xxxiv. of R. S. C. 1883, the Court or a Judge may, in any cause or matter, at any time, or from time to time, order that different questions of fact arising therein be tried by different modes of trial, or that one or more questions of fact be tried before the others, and may appoint the places for such trials, and in all cases may order that one or more issues of fact be tried before any other or others. (b)

The Court of Appeal will not readily interfere with a decision of the Court below as to the mode of trial. (c)

Advantages of
separate trial
of issues.

It is generally highly inconvenient to try the issues in a patent action separately or before different tribunals, (d) but sometimes great expense may be saved to the litigants by adopting this course. (e) An order for the trial of the issue of infringement by itself will not be granted, unless the validity of the patent is not only admitted, but admitted in unqualified terms. (f)

The following are instances in which special issues may be directed to be tried separately: Where it is alleged that the specification is ambiguous or vague such question of sufficiency of the specification may be determined separately and without evidence; (g) or where several users are alleged as anticipations of a patent all the evidence on one alleged user may be taken before going into the others. (h) Where, at the trial of an action on a patent which had been repeatedly established, and the Judge was of opinion that the sufficiency of the specification, the utility of the invention, and the fact of infringement had all been proved, he granted an injunction, but ordered an issue as to the novelty of the invention to be tried before a jury. (i) And where the plaintiff admitted that, if

(a) R. S. C. (1883) Order xxxiv. r. 2.

(b) R. S. C. (1883) Order xxxvi. r. 8.

(c) *Bovill v. Hitchcock*, (1868) L. R. 3 Ch. App. Cas. 417; *Brooke v. Wigg*, (1878) L. R. 8 Ch. D. 510, 517; *Williams v. Guest*, (1875) L. R. 10 Ch. App. Cas. 467; *Ruston v. Tobin*, (1878) L. R. 10 Ch. D. 558; *Hunt v. Chambers*, (1882) L. R. 20 Ch. D. 365; *Wharton v. Boffin*, W. N. (1883) p. 96; *Saxby v. Gloucester Waggon Co.*, W. N. (1880) p. 28.

(d) *Young v. Fernie*, (1863) 1 De

G. J. & S. 353.

(e) *Kurtz v. Spence*, (1888) 5 R. P. C. 170; *Muirhead v. Commercial Cable Co.*, (1894) 11 R. P. C. 323.

(f) *United Telephone Co. v. Motorshead*, (1886) 3 R. P. C. 213.

(g) *The Republic of Bolivia v. The National Bolivian Navigation Co.*, (1876) 24 W. R. 361, 362.

(h) *Richardson v. Castrey*, (1887) 4 R. P. C. 265.

(i) *Bovill v. Goodier*, (1865) L. R. 2 Eq. 195.

the defendant could prove the prior use of a certain article, the patent would be void, the defendant was allowed to call at once his evidence of such prior use, and the action was dismissed. (k)

Trial.
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It is enacted by sec. 56 of the Judicature Act of 1873 that, subject to any Rules of Court, and to such right as existed at the date of the Act to have particular cases submitted to the verdict of a jury, any question arising in any cause or matter (other than a criminal proceeding by the Crown) before the High Court of Justice or before the Court of Appeal, may be referred by the Court or by any Divisional Court or Judge before whom such cause or matter may be pending for inquiry and report to any official or special referee, and the report of any such referee may be adopted wholly or partially by the Court, and may (if so adopted) be enforced as a judgment by the Court. Reference to a referee.

The power was exercised by Pearson, J., in *Badische Anilin und Soda Fabrik v. Levinstein*, (l) who directed certain experiments to be made by a special referee for the purpose of advising the Court; by the Court of Appeal in *Moore v. Bennett*, (m) where it was ordered that a special referee should make experiments to test the capability of a certain machine to cut brushes; by Kay, J., in *Edison v. Holland*, (n) where it was ordered that certain of the plaintiff's and defendant's witnesses should make experiments in the presence of a special referee, with a view of ascertaining the sufficiency of the complete specification; and by Romer, J., in *North British Rubber Co. v. Macintosh*, (o) where a reference to an independent expert was ordered on points on which the evidence was directly in conflict. The expert is in such a case usually furnished by the direction of the Court with printed shorthand notes, has access to all the exhibits, and is to be at liberty to make such experiments as he may think desirable. Counsel are at liberty to make observations on the expert's report and the expert then reads the observations and advises the Court.

In certain cases a sufficiently qualified expert could only be found amongst a class of persons who would be likely to have a bias against the patent—*e.g.*, rival manufacturers—and these circumstances induce the Court to

(k) *Badham v. Bird*, (1888) 5 R. P. C. 238.

(l) (1883) L. R. 24 Ch. D. 156.

(m) (1884) 1 R. P. C. 129, 133.

(n) (1888) 5 R. P. C. 459, 479.

(o) (1894) 11 R. P. C. 477.

Trial.

forego the assistance of an independent expert in such cases. (*p*)

Trial at
assizes.

Any party to any cause or matter involving the trial of a question or issue of fact, or partly of fact and partly of law, may, with the leave of the Judge or Judges to whom, or to whose division, the cause or matter is assigned, require the question or issue to be tried and determined at the assizes or at sittings to be held in Middlesex or London. (*q*)

The rules (*r*) also empower the Court to send an action for trial at assizes with the object of getting an early trial whenever on an application before trial for an injunction or other order it appears that the matter in controversy is one which can be most conveniently dealt with by an early trial without first going into the whole merits on affidavit or other evidence for the purpose of the application.

To whatever division of the High Court an action may be attached, if it has been ordered to be tried at the assizes the Judge has no power, except the interests of justice so require, to remit it for trial in London. (*s*)

Acceleration
of trial.

Actions set down for trial in the Chancery Division may, upon the application of the plaintiff, even without the consent of the defendant, by order of the Court be advanced out of their turn for hearing if a proper reason be shown—*e.g.*, that delay would cause the loss of the object of the action. (*t*)

Where a plaintiff patentee of a chemical dye applied for the acceleration of the trial on the ground that new dyes were being continuously introduced and the trade in the patented dye could not be relied upon for long, and the defendant was offering the alleged infringing goods at reduced prices to the consequent detriment of the plaintiff's trade, the Court refused to expedite the trial for the reason that, if the plaintiff's case was well founded, he could get compensation in damages, and there was no ground, therefore, for giving him priority over other suitors. (*u*)

(*p*) *Badische Anilin und Soda Fabrik v. La Société des Usines du Rhône*, (1897) 14 R. P. C. 891.

(*q*) 36 & 37 Vict. c. 66, s. 29. The following actions were tried at assizes: *Miller v. Searle*, (1893) 10 R. P. C. 106; *Legge v. Wakelan*, (1893) 10 R. P. C. 379; *Allen v. Duckett*, (1893) 10 R. P. C. 397; *Allen v. Horton*, (1893) 10 R. P. C. 412; *Westley v. Tolley*, (1894) 11 R. P. C. 602; *John Vasey, Ltd. v. Walker, Mitchell & Co.*,

(1899) 16 R. P. C. 596; *Joseph Lucas, Ltd. v. H. Miller & Co.*, (1899) 17 R. P. C. 165; *Crossley v. Coates*, (1904) 21 R. P. C. 282.

(*r*) S. C. R. (1883) Order l. r. 1 a.

(*s*) *Fairbairn v. Household*, (1885) 2 R. P. C. 195.

(*t*) S. C. R. (1883) Order xxxvi. r. 16 n.

(*u*) *Farbenfabriken vorm F. Bayer & Co. v. Bowker*, (1890) 8 R. P. C. 136.

Where issues have been ordered to be tried, or questions of fact to be determined in any manner, the plaintiff may set down a motion for judgment as soon as such issues or questions have been determined. If he does not set down such a motion, and give notice thereof to the other parties within ten days after the right so to do has arisen, then, after the expiration of such ten days, any defendant may set down a motion for judgment, and give notice thereof to the other parties. (x) And where issues have been ordered to be tried, or questions of fact to be determined in any manner, and some only of such issues or questions of fact have been tried or determined, any party who considers that the result of such trial or determination renders the trial or determination of the others of them unnecessary, or renders it desirable that the trial or determination thereof should be postponed, may apply to the Court or a Judge for leave to set down a motion for judgment without waiting for such trial or determination. And the Court or a Judge may, if satisfied of the expediency thereof, give such leave upon such terms, if any, as shall appear just, and may give any directions which may appear desirable as to postponing the trial of the other issues of fact. (y)

Trial.

Motion for judgment on determination of a separate issue.

Any party may at any stage of a cause or matter where admissions of fact have been made, either on the pleadings or otherwise, apply to the Court or a Judge for such judgment or order as upon such admissions he may be entitled to, without waiting for the determination of any other question between the parties; and the Court or a Judge may upon such application make such order, or give such judgment, as the Court or Judge may think fit. (z) If a plaintiff moves for judgment under this power on admissions in the pleadings, he is bound by statements made in the defence, and thus where a defendant admitted ten, but denied any further infringements, an inquiry as to damages was limited to the ten admitted infringements. (a)

Motion for judgment on an admission of fact.

If the defendant do not appear, the plaintiff may on motion obtain judgment and the usual certificates upon formal proof of his title and the fact of infringement. (b) In one case

Judgment when a defendant does not appear.

(x) R. S. C. (1883) Order xl. r. 7.

(y) R. S. C. (1833) Order xl. r. 8; *Fernie v. Young*, (1866) L. R. 1 H. L. 63; *Macdougall v. General Sewage and Manure Co.*, (1875) W. N. 61; *Tangye v. Stott*, (1865) 14 W. R. 386.

(z) R. S. C. (1883) Order xxxii. r. 6.

(a) *United Telephone Co. v. Donohoe*, (1886) L. R. 31 Ch. D. 399.

(b) *Pneumatic Tyre Co. v. Chisholm*, (1896) 13 R. P. C. 488; *Edison United Phonograph Co. v. Young*, (1894) 11 R. P. C. 489. Surprise may be a ground for a new trial: *Incandescent Gas Light Co. v. New Incandescent Mantle Co.*, (1897) 15 R. P. C. 81; *Brooks v. Lycett*, (1903) 20 R. P. C. 390.

Trial.

where judgment went by default the Court refused to hear counsel on behalf of the defendant in another pending action on the same patent in which an order had been made that the first action should be treated as a test case and the judgment should bind the parties to the second action. (c) The defendant to the second action could no doubt under such circumstances get the order set aside upon proper motion to the Court.

When there are two defendants—*e.g.*, the manufacturer and a user, and one—*e.g.*, the user—puts in no defence and refuses to submit to judgment, the Court will not give leave to the plaintiff to set down the action on motion for judgment against such defendant, because the other defendant may be able to prove the patent void, in which case the first defendant would be entitled to the benefit of the decision. (d)

Judgment by consent.

If judgment is obtained by consent against a defendant, such defendant may withdraw his consent before the judgment has been entered, but he will not, except under very special circumstances, be allowed to do so, when he has stated that he will not require evidence to be filed in support of the plaintiff's application, and then seeks to allege a mistake of fact with regard to infringement. (e)

Certificates should be asked for at the conclusion of the trial.

Judgment may be obtained by consent in respect of part of the cause of action, and such consent may be given in the defence. (f)

At the conclusion of the trial counsel on behalf of the successful party should not omit to ask the Judge to certify his particulars as reasonable and proper and, if the plaintiff is the successful party, that the validity of the patent came in question. These certificates are most important on taxation. (g)

Documents and evidence not actually produced and given at the trial should not be inserted in the minutes of judgment. (h)

CONSOLIDATION OF ACTIONS.

Actions may be consolidated,

When a patentee brings several actions on the same patent against different defendants, they may be consolidated, so that the validity of the patent and any other issues common

(c) Edison United Phonograph Co. v. Young, (1894) 11 R. P. C. 489.

(d) Actica Gesellschaft für Carton-nagen Industrie v. Remus, (1895) 12 R. P. C. 94.

(e) Pneumatic Tyre Co. v. Cash

Cycle Co., (1897) 14 R. P. C. 177, 326.

(f) Badische Anilin und Soda Fabrik v. Hickson, (1904) 22 R. P. C. 63.

(g) pp. 518-531 *post*.

(h) Shoe Machinery Co. v. Cutlan (No. 2), (1896) 13 R. P. C. 395.

to all the actions may be tried once for all in one action ; (i) **New Trial.** and actions pending in the same division are now to be consolidated in the manner in use before the commencement of the Judicature Act, 1873, in the superior Courts of Common Law. (j)

Actions can only be consolidated at the instance of the defendants, (k) and at Common Law a plaintiff could not be bound without his consent by the result of one action, but could after an adverse verdict proceed with any of the others. (l)

Where several actions are brought by different plaintiffs against the same defendants the Court will, on the application of the plaintiffs, make an order enlarging the time for taking the next step in several of the actions, and staying proceedings therein till after one has been tried as a test action. (m)

It was held at Common Law that a consolidation could be made as soon as the defendants had appeared, and before declaration ; (n) and where the defendants to several actions, by a consolidation order, consented to be bound by the result of one action, and the defendant in that action, which was decided against him, neglected to appeal, it was held that a defendant to one of the other actions had no equity to be allowed to carry the case to a superior Court. (o)

NEW TRIAL.

If, after the trial of a patent action, either party considers that he is entitled to a new trial, and desires to obtain one accordingly, the proper procedure is, if the action was tried with a jury, to apply by motion to the Court of Appeal ; and, if the action was tried without a jury, the procedure is by appeal to the Court of Appeal. (p)

Where, after the reversal by the Court of Appeal of a judgment obtained by fraud, the respondents sought a rehearing of the appeal with fresh evidence, it was held that the Court

(i) *Foxwell v. Webster*, (1863) 4 Do G. J. & S. 77; *Edison-Bell Phonograph Corporation v. Smith*, (1894) 11 R. P. C. 148, 389.

(j) R. S. C. (1883) Order xlix. r. 8.

(k) *Lush's Practice*, 3rd ed. 965; *Amos v. Chadwick*, (1876) L. R. 4 Ch. D. 869.

(l) *Lush's Practice*, 3rd ed. p. 965.

(m) *Amos v. Chadwick*, (1876) L. R.

4 Ch. D. 869; *Bennett v. Lord Bury*, (1880) L. R. 5 C. P. D. 339.

(n) *Lush's Practice*, 3rd ed. p. 965.

(o) *Thomas v. Winter*, (1867) 17 L. T. N. S. 148.

(p) R. S. C. (1883) Order xxxix. r. 1; *Hunt v. City of London Real Property Co.*, (1877) L. R. 3 Q. B. D. 19; *Edison v. Shippey*, (1887) 4 R. P. C. 473.

Appeal. had no jurisdiction to rehear the appeal, but that the proper course was an original action, analogous to a suit under the old practice to set aside a decree as obtained by fraud. (*q*)

APPEAL.

Procedure. All appeals of the Court of Appeal must be by way of rehearing, (*r*) and must be brought by notice of motion in a summary way, and no petition, case, or other formal proceeding, other than such notice of motion, is necessary. The appellant may, by the notice of motion, appeal from the whole or any part of any judgment or order, and the notice of motion must state whether the whole or part only of such judgment or order is complained of, and in the latter case must specify such part. (*s*)

It is not, under any circumstances, necessary for a respondent to give notice of motion by way of cross-appeal, but if a respondent intends, upon the hearing of the appeal, to contend that the decision of the Court below should be varied, he must, within eight days, or such time as may be specified by special order, give notice of such intention to any parties who may be affected by such contention. (*t*)

Power of Court of Appeal to order a new trial.

If, upon the hearing of an appeal, it appears to the Court of Appeal that a new trial ought to be had, the Court of Appeal has power, if it thinks fit, to order that the verdict and judgment shall be set aside, and that a new trial shall be had. (*u*)

Security for costs of appeal.

An appellant may be ordered to give security for the costs of the appeal; (*x*) and if such security is not given within a reasonable time, an order will, in the absence of extenuating circumstances, be made for the immediate dismissal of the appeal. (*y*)

If a respondent contends that the appellant ought to be ordered to give security for costs, he must apply to the

(*q*) *Flower v. Lloyd*, (1877) L. R. 6 Ch. D. 297.

(*r*) As to the effect of a finding of fact by the Judge of first instance on the Court of Appeal, see *Haggenschmayer v. Watson*, (1897) 14 R. P. C. 634, judgment of Esher, M.R.; see also p. 485 *post*.

(*s*) R. S. C. (1883) Order lviii. r. 1. As to service of notice of motion, and time within which appeals are allowed,

see R. S. C. (1883) Order lviii. rr. 2-19.

(*t*) R. S. C. (1883) Order lviii. rr. 6 and 7.

(*u*) R. S. C. (1883) Order lviii. r. 5.

(*x*) R. S. C. (1883) Order lviii. r. 15.

(*y*) *Washburn and Moen Manufacturing Co. v. Patterson*, (1885) L. R. 29 Ch. D. 48; *Owens' Patent*, (1900) 17 R. P. C. 637; *Birmingham Pneumatic Tyre Syndicate v. Reliance Tyre Co.*, (1903) 20 R. P. C. 288.

appellant before moving the Court for such order, otherwise he will be liable to the costs of the application. (z) Appeal.

If a defendant becomes bankrupt, after setting down an appeal, the appeal cannot be proceeded with unless he give security for costs or the trustee in bankruptcy is made a party to the proceedings, (a) but on giving security for costs in such a case he is entitled to proceed with the appeal. (b)

It has been held not to be sufficient ground for postponing an appeal that the plaintiff was abroad, but desired to attend and instruct his counsel. (c) Postponement.

The Court of Appeal has power to admit evidence not given in the Court below, and may allow an amendment of the particulars for this purpose, (d) or in its discretion admit the fresh evidence, though it is not within the particulars originally delivered, without ordering an amendment of such particulars. (e) Fresh evidence on appeal.

An application for an order to allow further evidence on appeal is not likely to be successful unless the applicant can show a reasonable probability that, if the further evidence were given, a result might be looked for different to that arrived at by the Judge below. (f) For instance, where the Judge below decided that a patent was bad because two prior users were proved, the appellant was not allowed to give further evidence on appeal with reference to one of the prior users on the ground that the Appeal Court were of opinion that the further evidence did not affect the other prior user and that the decision of the Judge below was right as to that. (g) Again, an appellant will not be allowed to give further evidence on appeal, unless it can be shown that he could not have tendered the evidence at the hearing in the Court below, (h) or that the defendant has been misled, (i) though he would be allowed to cure a merely formal defect in his title. (k)

Where a party is allowed to adduce fresh evidence on appeal, on taxation, the costs of getting up such further

(z) *Garrard v. Edge*, (1890) 7 R. P. C. 139.

(a) *United Telephone Co. v. Bassano*, (1886) L. R. 31 Ch. D. 630.

(b) *Ibid.*

(c) *Walker v. Hydrocarbon Syndicate*, (1886) 3 R. P. C. 253.

(d) pp. 396, 413 *ante*.

(e) p. 455 *ante*.

(f) *Gammons v. Singer Manufac-*

turing Co., (1904) 22 R. P. C. 459.

(g) *Ibid.*

(h) *Hinde v. Osborne*, (1885) 2 R. P. C. 45; *Walker v. Hydrocarbon Syndicate*, (1886) 3 R. P. C. 253; *Blakey v. Latham*, (1889) 6 R. P. C. 184.

(i) *American Braided Wire Co. v. Thomson*, (1888) 5 R. P. C. 113, 118.

(k) *Nordenfelt v. Gardner*, (1884) 1 R. P. C. 61, judgment of Lindley, L.J.

Appeal. evidence is matter for the discretion of the Taxing Master in the usual way, but the costs of witnesses attending the appeal but not heard, should not be allowed. (*l*)

If the defendant's witnesses at the trial give evidence of anticipations not within the particulars, and the plaintiff chooses not to ask for an adjournment to consider them, the Court of Appeal will not allow fresh evidence to be adduced by the plaintiff with regard to them. (*m*) And if the defendant in the Court below does not call evidence, but elects to rest his case on the admissions of the plaintiff's witnesses, the Court of Appeal will refuse to allow him to call fresh evidence for the purpose of making out a case, which, in the opinion of the Court of Appeal differing from the Judge below, was not substantiated by such admissions. (*n*) In general the Court of Appeal will not accede to a request for leave to call fresh evidence when the application is substantially an attempt to retry the action on new materials. (*o*)

The cases in which an appellant is allowed to adduce fresh evidence in a patent action are, *e.g.*, where he is able to show that he could not have tendered the evidence in the Court below, (*p*) or where a party has been misled, (*q*) or he desires to cure a mere formal defect in his title, (*r*) or to produce a lost document, which has been found since the trial, (*s*) or there is some other special reason why the fresh evidence should be admitted to avoid an injustice being done. (*t*)

Issues
abandoned
below.

If a party in the Court below abandons an issue, the Court of Appeal will not allow it to be raised on appeal. Thus, where the plaintiff's witnesses admitted in the Court below that, if an alleged anticipation was in fact made prior to the patent as stated, it was a complete anticipation, and the plaintiff fought the case solely on the contention that the alleged anticipating machine was in fact not made, and at the same time charged the defendant with fraudulently altering it as originally constructed, the Court of Appeal refused to allow the appellant plaintiff to raise the question

(*l*) Leeds Forge Co., Ltd. v. Deighton's Patent Flue and Tube Co., Ltd., (1903) 20 R. P. C. 185.

(*m*) Barcroft v. Smith, (1897) 14 R. P. C. 172.

(*n*) Lancashire Explosives Co. v. Roburite Explosives Co., (1895) 12 R. P. C. 470, 480.

(*o*) See Nadel v. Martin, (1903) 2 R. P. C. 721.

(*p*) Hinde v. Osborne, (1885) 2 R.

P. C. 45; Walker v. Hydrocarbon Syndicate, (1886) 3 R. P. C. 253; Blakey v. Lathom, (1889) 6 R. P. C. 184.

(*q*) American Braided Wire Co. v. Thomson, (1888) 5 R. P. C. 113, 118.

(*r*) Nordenfelt v. Gardner, (1881) 1 R. P. C. 61.

(*s*) Hinde v. Osborne, (1885) 2 R. P. C. 45.

(*t*) *Ibid.*

that though the alleged anticipation in question was made as stated yet it was no anticipation in fact, and dismissed the appeal with costs. (*u*) Appeal.

Notwithstanding that the only question on appeal is the issue of infringement, the Appellate Court will consider the particulars of objection for the purpose of ascertaining the state of public knowledge at the date of the patent whereby to properly construe the ambit of the patentee's claim. (*x*) Particulars of objection when appeal is in respect of infringement only.

There is no presumption that the Court of Appeal or the House of Lords ought not to interfere with what the Judge of first instance has done with regard to matters of fact; but, on the contrary, the Appellate Court, in which both fact and law are open to review, is bound to pronounce such judgment as, in their view, ought to have been pronounced by the lower Court; and it is not competent to the Appellate Court to say that they would have pronounced a different judgment, if they had been Judges of first instance, but because the Judge has pronounced a certain judgment they will adhere to his decision. (*y*) Decisions on facts as well as law may be reversed on appeal.

The preceding paragraph must be taken, of course, as applicable only to cases which are originally tried without a jury, and the appeal is, consequently, not governed by the rules applicable to new trials after trial and verdict by a jury. Further, when there is a question of the relative credibility of different witnesses, the Court is always fully sensitive of the great advantages the Judge below has had in seeing and hearing such witnesses. (*z*) On the other hand, circumstances quite apart from manner and demeanour may show whether a statement is credible or not, and may well warrant the Appellate Court in differing from the Judge, even on a question of fact turning on the credibility of witnesses whom the Appellate Court has not seen. (*a*)

In *Parkinson v. Simon*, (*b*) the Court of Appeal stated a rule to the effect that when two distinct points have been argued in the Court below, and the Court of Appeal is obliged to dismiss the appeal on a consideration of one point alone, yet to render Decision of several points when one is sufficient.

(*u*) *Westley, Richards & Co. v. Perkes*, (1893) 10 R. P. C. 181, 382.

(*x*) *Morris v. Young*, (1895) 12 R. P. C. 455.

(*y*) *Riekmann v. Thierry*, (1897) 14 R. P. C. 105, 116; but see *Haggenmacher v. Watson*, (1897) 14 R. P. C. 634, judgment of Esher, M.R.

(*z*) See observations of Lindley, M.R., *Coghlan v. Cumberland*, [1895] 1 Ch. 704; and Esher, M.R., *Haggenmacher v. Watson*, (1897) 14 R. P. C. 634.

(*a*) *Ibid.*

(*b*) (1895) 11 R. P. C. 493; see also *Deeley's Patent*, (1896) 12 R. P. C. 192, 197.

Perpetual Injunction. further litigation between the parties more unlikely the Court will give a decision on the other point also. In the same case, however, the House of Lords (*c*) dismissed the appeal on the same ground as the Court of Appeal, but declined to express any opinion on the second point, and did not call upon the respondent's counsel to argue it. And during the argument their Lordships stated that the practice of giving decisions (which only amount to *dicta*) on issues not necessary to decide on appeal is not to be recommended, and will not be adopted by their Lordships' House.

Decision of Court of Appeal in absence of respondent.

A decision of the Court of first instance may be reversed by the Court of Appeal, notwithstanding the absence of a respondent who does not appear at the hearing in the Appellate Court. (*d*)

Interest on costs paid by successful appellant to respondent.

A judgment of the House of Lords for the appellant with costs involves the return by the respondent to the appellant of the costs paid by him together with interest, if any, paid by the appellant to the respondent, and interest at four per cent. from the Court of Appeal decision to the date of return after the House of Lords decision. (*e*)

PERPETUAL INJUNCTION.

Successful plaintiff is usually entitled to a perpetual injunction.

If at the trial of an action the plaintiff succeeds in conclusively (*f*) proving that the defendant has infringed, and the validity of the patent, together with the plaintiff's title, is established, one of the remedies to which he is usually entitled is a perpetual injunction (*g*) restraining the defendant from repeating the acts complained of during the continuance of the monopoly. And where the defendant is desirous and willing to consent to a perpetual injunction without bringing the action to a trial, it may be obtained, by the consent of both parties, on the hearing of the motion, (*h*) or by summons in chambers. (*i*) With the object of preventing misrepresentation, the Court, sometimes, prefers to accept the undertaking of the defendant instead of granting an injunction. (*k*) A

Injunction by consent.

(*c*) 12 R. P. C. 403.

(*d*) *Pneumatic Tyre Co. v. Casswell*, (1896) 13 R. P. C. 375.

(*e*) *Ashworth v. English Card Clothing Co., Ltd.*, (1904) 21 R. P. C. 355.

(*f*) *Hill v. Evans*, (1862) 4 De G. F. & J. 288.

(*g*) *Shelfa v. City of London Electric Lighting Co.*, [1895] 1 Ch. 287, 310, 311.

(*h*) *Morrell v. Pearson*, (1849) 12 Beav. 284.

(*i*) 46 & 47 Vict. c. 57, s. 30; Judicature Act, 1873, s. 39; *Frearson v. Loe*, (1877) 26 W. R. 138.

(*k*) See *Dover v. New Townend Cycle Co., Ltd.*, (1903) 21 R. P. C. 135; *Badische Anilin und Soda Fabrik v. Spivey*, (1904) 22 R. P. C. 65.