

defendant is entitled to withdraw his consent to a perpetual injunction if it was given under mistake or surprise. (l) Perpetual Injunction.

The Court does not invariably grant an injunction on proof of an invasion of the plaintiff's rights under the patent. An injunction does not in such circumstances follow as matter of course, but is in the discretion of the Court. (m) Injunction is not a matter of course.

Usually the injunction restrains the defendant, his servants, agents, or workmen from infringing the patent; (n) but sometimes it is directed to the infringement of the patent in a particular way only—*e.g.*, by making a specific article complained of—if the plaintiff's rights are thereby sufficiently protected. (o)

Acquiescence on the part of the plaintiff may induce the Court to refuse an injunction and merely grant damages, or an account of profits. (p) Acquiescence.

Though *laches* may disentitle a plaintiff to an interlocutory injunction, (q) yet delay to enforce a legal right does not prevent a person from bringing an action, provided it does not cause a statutory bar; (r) and, consequently, delay or acquiescence, which would prevent the plaintiff from succeeding on an interlocutory application, may be no bar to his right to a perpetual injunction at the trial, (s) and to damages or an account. (t)

In the event of proof of infringement of at least one of several patents of different dates (*e.g.*, governing all known methods of production of a certain article), but doubt as to which one has been infringed if one of the patents sued on expired before judgment, the Court will not grant an injunction; though it may allow an inquiry as to damages, which it would appear should be limited to acts done during the

(l) *Elsas v. Williams*, (1884) 1 Times Rep. 144.

(m) See Lord Cairn's Act, 21 & 22 Vict. c. 27; *Shelfa v. City of London Electric Lighting Co.*, [1895] 1 Ch. 257, and *Betts v. De Vitre*, (1864) 11 Jur. N. S. 9; *Geary v. Norton*, 1 De G. & S. 4; *Proctor v. Bayley*, (1889) 6 R. P. C. 537; *Lyon v. Goddard*, (1893) 10 R. P. C. 135; *Jenkins v. Hope*, (1895) 13 R. P. C. 57; *Scott v. Hull Steam Fishing and Ice Co.*, (1897) 14 R. P. C. 143.

(n) *Setou*, p. 352; see *Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 359.

(o) See *Dunlop Pneumatic Tyre Co. v. New Ixion Tyre and Cycle Co.*,

(1898) 15 R. P. C. 389; 16 R. P. C. 16.

(p) *Sayers v. Collyer*, (1885) L. R. 28 Ch. D. 103.

(q) pp. 427, 428 *ante*.

(r) *Three Towers Banking Co. v. Maddever*, (1884) L. R. 27 Ch. D. 523; *Wood v. Lambert*, (1886) 3 R. P. C. 84.

(s) *Fullwood v. Fullwood*, (1878) L. R. 9 Ch. D. 176; *Johnson v. Wyatt*, (1863) 2 De G. J. & S. 18, 25; *Proctor v. Bennis*, (1887) L. R. 36 Ch. D. 740; *Bacon v. Spottiswoode*, (1839) 1 Beav. 382; *Aluminium Co. v. Domeiere*, (1887) 15 R. P. C. 32.

(t) *Bovill v. Crate*, (1865) L. R. 1 Eq. 388.

Perpetual
Injunction.

concurrency of all the patents sued on. (u) Where under similar circumstances all the patents sued on are current at the date of judgment an injunction and inquiry may be obtained, limited to the period covered by the oldest patent; (x) and an action so founded in Scotland has been held to be relevant. (y)

Expiry of the
patent before
conclusion of
the action.

Generally speaking, the Court will not grant an injunction if the patent has expired before the commencement or during the course of an action; (z) but where it appeared that the patent would expire in a few days, and that the defendant had piratically manufactured a large stock of the patented article ready to throw on the market as soon as the monopoly was at an end, *Lyndhurst, L.C.*, granted an injunction to restrain the sale of such articles both before and after the term limited by the grant of the patent. (a)

Absence of
evidence of an
intention to
continue
infringements.

Also, if the defendant has committed only one act of infringement and there is no evidence of an intention on his part to infringe again, the Court does not usually grant the plaintiff an injunction. Thus, where it was proved that the defendant was guilty of only one act of user, and the Judge was satisfied that the defendant had no intention of infringing again, the Court did not grant an injunction, but awarded a small sum by way of damages and gave the plaintiff liberty to apply for an injunction in case of necessity thereafter. (b) And where the defendant refused to submit to an injunction, but after writ issued and before statement of claim delivered offered to account for the profits made by the sale of infringing articles, to deliver up all such in his possession, to give a perpetual undertaking not to infringe, and to pay costs of the action, the Court held that the plaintiff was entitled to have his legal right recognised, but considering the smallness of the matter the defendant's undertaking not to manufacture or sell was sufficient and no injunction was granted, and the Court made certain provisions as to the costs of the action. (c)

(u) See *Saccharin Corporation, Ltd. v. Quincy*, (1900) 17 R. P. C. 337; but see p. 394 *ante*.

(x) *Saccharin Corporation, Ltd. v. Dawson*, (1902) 19 R. P. C. 16.

(y) *Saccharin Corporation, Ltd. v. Ross*, (1905) 22 R. P. C. 246.

(z) *Betts v. Gallais*, (1870) L. R. 10 Eq. 392; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302; 35 L. J. Ch. 204; *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.*, (1858) 4 K. & J.

727; *Smith v. L. & S. W. Ry. Co.*, (1854) Macr. P. C. 209; 23 L. J. Ch. 562; *Kane v. J. Boyle & Co.*, (1901) 18 R. P. C. 325.

(a) *Crossley v. Beverley*, (1829) 3 Car & P. 513; 1 Russ. & M. 166 n.; 1 W. P. C. 119; see also *Crossley v. Derby Gas Co.*, (1834) 4 L. J. Ch. 25.

(b) *Scott v. Hull Steam Fishing and Ice Co.*, (1897) 14 R. P. C. 143.

(c) *Jenkins v. Hope*, (1895) 13 R. P. C. 57.

Where, after the plaintiff had obtained an interlocutory injunction, the defendant removed the alleged infringing parts from a machine, the plaintiff, at the trial, was awarded a perpetual injunction together with an account of profits and costs, on the ground that the defendant had, in fact, infringed, and had not submitted on the hearing of the interlocutory motion to the relief which the plaintiff asked for. (d)

Perpetual
Injunction.

When an injunction is granted, if in the interests of justice it is desirable, certain infringements contemplated may be excluded from its operation. Thus, when the defendant had before trial accepted orders for infringing machines, and the plaintiff at the trial elected to take an account of profits in lieu of damages, the defendant agreeing to bring into the account any machines then under order, the Court granted an injunction, and made it operate immediately, but suspended its operation as to orders then accepted but not executed till the hearing of appeal, if notice of appeal should be given within three days of the drawing up of the order. (e) But where the infringing machines had been ordered since the commencement of the action, though they were not completed before judgment, no stay of the injunction was allowed. (f)

Certain in-
fringements
may be
exempted from
injunction.

It is not usual for the Court to stay the injunction. In special and important cases, however, when it is obvious that, if an appeal which will be made, is successful, the injury caused to the defendant by the injunction continuing would be great, without any corresponding advantage to the plaintiff, the Court will suspend the operation of the injunction, and possibly also the taking of an account or inquiry as to damages pending the appeal. (g)

Stay of injunc-
tion pending
an appeal.

Where the justice of the case requires it, the Court will, in lieu of a stay of the injunction, allow the defendant to go on with his business provided he accepts a licence from the plaintiff without prejudice to the appeal, and upon the undertaking of the plaintiff to return the royalties if he is unsuccessful in the appeal, and such relation between the parties should be made continuous to the decision of the House of Lords

Licence in
lieu of injunc-
tion pending
appeal.

(d) Edison-Bell Phonograph Corporation v. London Phonograph Co., (1894) 11 R. P. C. 471.

(e) Lyon v. Goddard, (1893) 10 R. P. C. 135; see also Ducketts v. Whitehead, (1895) 12 R. P. C. 191.

(f) Lyon v. Goddard (No. 2), (1893) 10 R. P. C. 348.

(g) North British Rubber Co. v. Macintosh, (1894) 11 R. P. C. 489; Franklin, Hocking & Co. v. Fraser, (1885) 3 R. P. C. 7; Young v. Morris, (1894) 11 R. P. C. 214; National Opalite Glazed Brick and Tile Syndicate v. Ceralite Syndicate, (1896) 13 R. P. C. 658.

Perpetual Injunction. in the event of the plaintiff succeeding in the Court of Appeal and the defendant deciding to take the case to the Lords. (*h*)

Injunction to restrain threatened infringements.

Although no actionable infringement has been committed, and consequently there could be no claim to damages, yet, if there is an evident intention on the part of the defendant to infringe, the Court will grant an injunction. (*i*) Thus, where it appeared that the defendants had opposed the plaintiff's application for a patent, and had infringed it during the interval between the filing and acceptance of the specification, and also subsequently, the Court, though there was no actionable infringement, granted its injunction on the ground that there was an evident intention to infringe. (*k*)

Injunction becomes inoperative if the specification is amended.

If a plaintiff, after having obtained an injunction, amends the specification, the injunction becomes inoperative, and in the event of fresh infringements by the defendant the plaintiff must proceed *de novo*. (*l*)

Breach of injunction.

As a rule, the breach of an injunction of the Court is a contempt, which renders the party guilty of it liable to committal, and it is no answer for a defendant to say that he did not intend to commit the contempt, for if he has actually infringed after injunction he is guilty of contempt, (*m*) and none the less may he be guilty though only one act is relied on by the plaintiff who seeks his committal. (*n*)

Motion for committal.

In all cases of motion for committal, where the liberty of the subject is involved the strictest proof is necessary, both as regards the fact of infringement, (*o*) and that the defendant is a person enjoined by the injunction, or a person who, with knowledge of the injunction, has wilfully aided and abetted a person or persons enjoined, (*p*) and proper and accurate compliance with the rules relating to service. (*q*) The copy of the

(*h*) See *Jandus Arc Lamp and Electric Co., Ltd. v. Arc Lamp Co.*, (1905) 22 R. P. C. 298.

(*i*) *Frearson v. Lee*, (1878) L. R. 9 Ch. D. 48; *Dowling v. Billington*, (1890) 7 R. P. C. 191; *The Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 342; see also pp. 384, 399 *ante*.

(*k*) *Dowling v. Billington*, (1890) 7 R. P. C. 191.

(*l*) *Dudgeon v. Thompson*, (1879) L. R. 3 App. Cas. 34.

(*m*) *Plimpton v. Spiller*, (1876) L. R. 4 Ch. D. 288; *Thompson v. Moore*, (1889) 6 R. P. C. 426, 445; *Farbenfabriken vorm F. Bayer v. Laporte*, (1894) 11 R. P. C. 190; *Lyon v.*

Goddard, (1894) 11 R. P. C. 113.

(*n*) *Welsbach Incandescent Gas Light Co., Ltd. v. Keegan*, (1899) 17 R. P. C. 44.

(*o*) *Dick v. Haslam*, (1891) 8 R. P. C. 196; *Edison-Bell Phonograph Co. v. Smith*, (1894) 11 R. P. C. 164.

(*p*) See *Incandescent Gas Light Co. v. Sluce*, (1900) 17 R. P. C. 173.

(*q*) R. S. C. (1883) Order lxvii. r. 1; *Taylor v. Roe*, 68 T. R. 213; *re Evans*, 9 T. R. 109; *Hall v. Trigg*, (1897) L. R. 2 Ch. at p. 222; *Incandescent Gas Light Co. v. Morgan*, (1889) 17 R. P. C. 44; *Incandescent Gas Light Co. v. Riemer*, (1900) 17 R. P. C. 378.

order served must be accurate in every particular. (r) A **Perpetual Injunction.** plaintiff desiring the committal of the defendant for breach of an interim or perpetual injunction must be careful to perfect his evidence before moving, for should he fail a subsequent application on the ground of better evidence, in respect of the same alleged breach, will most probably be refused in accordance with the maxim, *nemo debet bis vexari pro una et eadem causa.* (s) It is to be observed that there is a distinction between the procedure on attachment and committal. In the latter, which is the appropriate remedy when a defendant has done something which the Court has ordered him not to do and therefore applies to breach of an injunction in a patent case, service of the order is not absolutely necessary, and a defendant may be committed if the Court is satisfied that the order was brought to his knowledge, although not formally served upon him. In the case of attachment, which is the appropriate remedy where a defendant has failed to do something which the Court ordered him to do, the procedure requires the service of the order by producing the original or an office copy, and leaving an accurate copy with the person served. (t)

The following circumstances illustrate the necessity for accurate proof of the fact of infringement. An injunction was granted, and the defendant undertook to continue a previous undertaking not to part with infringing articles in his possession or under his control in this country, and the plaintiff on motion to commit failed to show that certain articles alleged to have been parted with, in breach of the undertaking, were, in fact, in the possession of, or under the control of, the defendant on the date on which the injunction was obtained, the Court refused an order for committal, but gave no costs, on the ground that the circumstances were suspicious and the plaintiff was justified in bringing on the motion. (u)

There may be cases in which a breach of an injunction of the Court is not only justifiable but a positive duty. Thus, *James, L.J.*, in reference to a case in which the majority of the Court of Appeal confirmed an injunction restraining the master of a ship from using certain patented pumps, with

Breach of injunction may under certain circumstances be justifiable.

(r) *Re Holt*, (1879) L. R. 11 Ch. D. 168.

(s) See, e.g., *Badische Anilin und Soda Fabrik v. Thompson*, (1904) 21 R. P. C. 469.

(t) R. S. C. (1883) Order lxvii. r. 1;

see also *re Holt*, (1879) L. R. 11 Ch. D. 168; *Incandescent Gas Light Co. v. Sluce*, (1900) 17 R. P. C. 173.

(u) *Edison-Bell Phonograph Co. v. Smith*, (1894) 11 R. P. C. 164.

Perpetual Injunction. which the ship was exclusively fitted, said: "In the absence of the owners it appears to me that the Court could not make a mandatory injunction as to the equipment of the ship. And, that being so, I cannot concur in granting an injunction to restrain the master from doing what it appears to me to be his plain duty to do. Whatever appliances there may happen to be on board, however they came there—pumps, anchors, fire extinguishers, stolen or not stolen, pirated or not pirated—it is his bounden duty to use them according to the exigencies of navigation for the safety of ship, cargo, and life. To the master when out at sea (injunction or no injunction) *salus navis est suprema lex*. And, for myself, I believe that a master would be practically as safe in disobeying an injunction under a pressing emergency as he would be in shooting a mutineer. And in my opinion, if a single life was lost through the master's neglect to use such appliances, the injunction would be no defence to an indictment for manslaughter." (x)

It is doubtful whether, on a motion for sequestration against a company and committal against the directors for breach of a perpetual injunction, the Court has power to order an account of profits or the delivering up of the infringing articles. (y)

It is a complete answer to a motion for committal for breach of a perpetual injunction restraining infringements of a patent to show that, since the injunction, the patent has expired, and that the acts complained of were done subsequently to such expiration, (z) or that, since the injunction was granted, the specification has been amended and so the injunction has become inoperative. (a)

Expiry of the patent is an answer to a motion for committal.

Acts done since injunction granted, which are different in nature though similar to those in respect of which the injunction was granted.

When the defendant after injunction does something different to what he did before injunction, and the plaintiff wishes to restrain him on the ground that in the opinion of the plaintiff it is an infringement, the usual way to raise the question is by motion to commit, (b) or in the case of a limited company sequestration against the company and attachment against the directors. (c) In one such case, where it appeared that the article complained of was different

(x) *Adair v. Young*, (1879) L. R. 12 Ch. D. 21; see also *Basset v. Graydon*, (1897) 14 R. P. C. 701.

(y) *Spencer v. The Ancoats Vale Rubber Co.*, (1889) 6 R. P. C. 67.

(z) *Daw v. Eley*, (1867) L. R. 3 Eq. 497.

(a) *Dudgeon v. Thompson*, (1879)

L. R. 3 App. Cas. 34.

(b) *Plimpton v. Spiller*, (1877) L. R. 4 Ch. D. 286; *Lancashire Explosives Co. v. Roburite Explosives Co.*, (1896) 13 R. P. C. 435.

(c) *Hattersley v. Hodgson*, (1904) 22 R. P. C. 229.

from that in respect of which the injunction was originally granted, the Court, being of opinion that the new article was also an infringement, but not deciding the question, did not make an order for committal, but, upon the plaintiff giving an undertaking as to damages, granted an injunction restraining the manufacture of the new article until further order, and this course was subsequently approved of by the Court of Appeal. (d) In another case (e) the Court, taking the view that the alteration made by the defendants was still an infringement of the patent, made an order for sequestration against the defendant company. And in other cases (f) the Court dismissed the motion with costs on the ground that what the defendant did was no infringement.

Perpetual
Injunction.

Any publication which tends to influence the result of a pending suit is reprehensible, and may involve the writer in the consequences of a contempt of Court; (g) but if a party to the suit submits to have the matter discussed in the public papers and enters into the arena of public discussion he cannot afterwards complain that this has been done. (h) It is not a contempt of Court to publish, after a judgment has been obtained, advertisements asking for evidence of the anticipation and publication of the subject-matter of the patent, (i) or for subscriptions towards the expenses of an appeal. (k) But it is a contempt for either party by advertisements to issue a representation of an *ex parte* statement of proceedings in Court for the purpose of his own profit. (l)

Contempt of
Court.

Solicitor and client's costs may, on a motion to commit for breach of an injunction, be given to a successful plaintiff, (m) but not to a successful respondent. (n)

Solicitor and
client's costs.

Where it appeared that the acts complained of had not been done vexatiously, but in the probable belief—an erroneous one—that the defendants were entitled to do what they did,

(d) *Plimpton v. Spiller*, (1876) L. R. 4 Ch. D. 286.

(e) *Hattersley v. Hodgson*, (1904), 22 R. P. C. 229.

(f) *Lancashire Explosives Co. v. Roburite Explosives Co.*, (1896) 13 R. R. C. 435; *Schermutz v. Pain*, (1901) 18 R. P. C. 529.

(g) *Daw v. Eley*, (1868) L. R. 7 Eq. 49; *In re Cheltenham and Swansea Railway Carriage and Waggon Works*, (1839) L. R. 8 Eq. 580; *Brodribb v. Brodribb*, (1886) L. R. 11 Pr. D. 66; *Butler v. Butler*, (1888) L. R. 13 Pr.

D. 73.

(h) *Daw v. Eley*, (1868) L. R. 7 Eq. 61; *British Vacuum Cleaner Co., Ltd. v. Suction Cleaners, Ltd.*, (1904) 21 R. P. C. 300.

(i) *Plating Co. v. Farquharson*, (1881) L. R. 17 Ch. D. 49.

(k) *Ibid.*

(l) *Edlin v. Pneumatic Tyre and Brook's Cycle Agency (No. 2)*, (1893) 10 R. P. C. 317.

(m) *Plating Co. v. Farquharson*, (1881) L. R. 17 Ch. D. 49.

(n) *Ibid.*

Account or solicitor and client's costs were refused, but costs on the
 Damages— higher scale were given. (o)
 General.

ACCOUNT OR DAMAGES.

Account or
 damages may
 be awarded to
 a successful
 plaintiff,

General.—A plaintiff who succeeds in showing that his patent rights are valid and subsisting, and that they have been infringed, is usually entitled, not only to an injunction restraining the defendant from continuing the infringements complained of, but also to an account of profits made by the defendant by means of his wrongful acts, or damages against him in respect of the infringements committed. In England the Court will not allow an inquiry as to damages or an account of profits to be prosecuted till the plaintiff has established his title to the patent and the fact of infringement, (p) though this does not appear to be the invariable rule in Scotland. (q)

but he cannot
 have both
 against
 the same
 defendant,

An inquiry as to damages and an account of profits are not reconcilable, for, if an account be taken of profits, the infringement is thereby condoned. (r) A plaintiff therefore cannot have both an account and damages against the same defendant; he must choose one or the other, (s) and this rule applies to every case of infringement. (t)

though he may
 have an
 account
 against one
 defendant and
 damages
 against
 another.

As regards different defendants to the same action, or to consolidated actions, the plaintiff may have an account of profits against one of such defendants and damages against the other. (u) It has never been held that an account directed against a manufacturer of a patented article licenses the use of that article in the hands of all purchasers. The patent is a continuing patent, and there is no reason why the article should not be followed in every man's hand, until the infringement is got rid of. So long as the article is used, there is continuing damage. (x)

(o) *Spencer v. The Ancoats Vale Rubber Co.*, (1889) 6 R. P. C. 46, 68.

(p) *De la Rue v. Dickinson*, (1857) 3 K. & J. 388; *Rolls v. Isaacs*, (1878) W. N. 37; *Fennessy v. Clark*, (1888) L. R. 37 Ch. D. 184.

(q) See *Brown v. Evered*, (1904) 21 R. P. C. 501.

(r) *Neilson v. Betts*, (1871) L. R. 5 H. L. 22, per Lord Westbury.

(s) *Neilson v. Betts*, (1871) L. R. 5 H. L. 22; *Watson v. Holliday*, (1882) 30 W. R. 747; *Siddell v. Vickers*, (1892) 9 R. P. C. 153, 162.

(t) *De Vitro v. Betts*, (1873) L. R. 6 H. L. 319; *Vidi v. Smith*, (1854) 3 E. & B. 969; *Holland v. Fox*, (1854) 3 E. & B. 977.

(u) *Penn v. Bibby*, *Penn v. Fernie*, (1866) L. R. 3 Eq. 308; 36 L. J. Ch. 277; *United Telephone Co. v. Walker*, (1887) 4 R. P. C. 67; *Boyd v. Tootle Broadhurst, & Co.*, (1894) 11 R. P. C. 175.

(x) Per Page Wood, V.C., *Penn v. Bibby*, *Penn v. Jack*, *Penn v. Fernie*, (1866) L. R. 3 Eq. 308; 36 L. J. Ch. 277.

When the action is brought in the early days of the patent, before the patentee has established a course of dealing in the patented article, the successful plaintiff would probably prefer an account of profits, because of the difficulty he would, under such circumstances, have in showing the damage he has sustained by the wrongful acts of the defendant. On the other hand, as a rule, when the plaintiff has an established course of business in the patented article, it is more to his interest to elect to take damages in lieu of an account of profits, because of the great difficulty there always is in taking the account of profits due to the infringement of patent rights. Thus Lord *Lindley*, then *Lindley*, L.J., in *Siddell v. Vickers*, (y) in stating his experience in matters of account, used the following words of warning: "I do not know any form of account which is more difficult to work out, or may be more difficult to work out, than an account of profits. One sees it—and I personally have seen a good deal of it—in partnership cases, when the capital of a deceased or out-going partner has been left in the trade; an account has been directed of the profits made in respect of capital, which is something like the profits made in respect of an invention, and the difficulty of finding out how much profit is attributable to any one source is extremely great—so great that accounts in any form very seldom result in anything satisfactory to anybody. The litigation is enormous, the expense great, and the time consumed is out of all proportion to the advantage ultimately attained; so much so that in partnership cases, I confess, I never knew an account in that form worked out with satisfaction to anybody. I believe in almost every case people get tired of it, and get disgusted. Therefore, although the law is that a patentee has a right to elect which course he will take, as a matter of business he would generally be inclined to take an inquiry as to damages rather than launch upon an inquiry as to profits." (z)

Account or
Damages—
General.

When damages
are preferable
to an account
of profits, and
vice versa.

There is a well-marked distinction between an account of profits and an inquiry as to damages, which must not be lost sight of in dealing with particular cases, and which arises from the fact that there is no necessary relationship between the two. Thus in some cases the greater the profit made by the infringer the less may be the damages sustained by the

Distinction
between an
account of
profits and an
inquiry as to
damages.

(y) (1892) 9 R. P. C. 162.

Coal Gas Retort Co. v. Mayor, &c., of
Salford, (1897) 14 R. P. C. 471

(z) See also *Crossley v. Derby Gas
Co.*, (1829) 1 W. P. C. 119; *Automatic*

Account or Damages—General. patentee, and in other cases the less the profit accruing to the infringer the greater the damage inflicted upon the patentee, *e.g.*, where the infringer undersells the patentee he may be satisfied with a very small profit with the object of ultimately getting the trade in his own hands, but the damage thereby inflicted upon the patentee may be very great. (*a*)

Order by agreement for payment of a proper royalty is sometimes preferable to an account or damages.

Where a plaintiff is not desirous of taking an inquiry as to damages it is sometimes well for the parties to agree to an order for an inquiry as to what would be a proper royalty, and that such sum should be accepted in lieu of damages. Such a course may save endless expense and time as against an account of profits in the ordinary way. (*b*)

Effect of delay in bringing the action.

An unexplained delay in bringing action may affect a plaintiff's right to an account of profits, or damages, if the circumstances are such as to establish leave and licence on the part of the plaintiff, or that the plaintiff stood by and knowingly allowed the defendant to proceed and expend money in ignorance of the fact that he had rights and meant to assert them (*c*). The effect may be to bar the plaintiff's right altogether, (*d*) or limit it to damages or profits, made since the commencement of the action; (*e*) for it is a principle of equity that a party who claims a right shall not lie by, and, by his silence or acquiescence, induce another to go on expending his money and incurring risk, and afterwards, if profit be made, come and claim a share in that profit without having been exposed to the losses which might have been sustained. (*f*)

Account or damages may be awarded notwithstanding that the plaintiff is not entitled to an injunction.

An account of profits or an inquiry as to damages may now be had, notwithstanding the fact that the plaintiff is not entitled to an injunction, *e.g.*, where the action is commenced or judgment is delivered after the expiration of the patent, (*g*) or there is proof of the infringement of at least one of several patents owned by the plaintiff and governing all known

(*a*) Per Chitty, J., *Howard v. Tweedales*, (1896) 13 R. P. C. 214.

(*b*) *Automatic Coal Gas Retort Co. v. Mayor, &c., of Salford*, (1897) 14 R. P. C. 471.

(*c*) *Proctor v. Bennis*, (1887) 4 R. P. C. 330.

(*d*) *Ibid.*; and see *Crossley v. Derby Gas Co.*, (1829) 1 W. P. C. 120; *Harrison v. Taylor*, (1865) 11 Jur. N. S. 408; *Parrot v. Palmer*, (1834) 3 M. & K. 632, 640.

(*e*) See *Sayers v. Collyer*, (1885) L. R. 28 Ch. D. 103; *Ford v. Foster*, (1872)

L. R. 7 Ch. App. Cas. 611, 627; *Beard v. Turner*, (1866) 13 L. T. N. S. 746.

(*f*) *Crossley v. Derby Gas Co.*, (1829) 1 W. P. C. 120; *Parrot v. Palmer*, (1834) 3 M. & K. 640.

(*g*) *British Insulated Wire Co. v. Dublin United Tramway Co.*, (1899) 17 R. P. C. 14; *Kane v. J. Boyle & Co.*, (1901) 18 R. P. C. 325; 21 & 22 Vict. c. 27, s. 2; 36 & 37 Vict. c. 65, s. 16; *Betts v. Gallais*, (1870) L. R. 10 Eq. 392; R. S. C. (1883) Order xv. r. 1; *York v. Stowers*, (1883) W. N. p. 174.

methods of production of a certain article but doubt as to the particular patent or patents infringed. (*h*) Formerly the Court of Chancery acted upon the rule that the right to an account was ancillary to the right to an injunction, and if an injunction could not be granted, *e.g.*, if the patent had expired before, (*i*) or during, (*k*) the litigation, or there was no evidence of any intention on the part of the defendant to repeat the infringement, (*l*) the plaintiff could not have an account, (*m*) but must be left to his remedy at law, which consisted of damages, (*n*) except in the case of fraud. (*o*) Lord Cairns' Act empowered the Court of Chancery to award damages, and any division of the High Court is now entitled to award damages or grant an account of profits independently of any right on the part of the plaintiff to an injunction; (*p*) but, of course, subject to the provisions of the statute of limitations, and it would appear that the Court of the County Palatine of Lancaster has now a similar jurisdiction. (*q*)

Account or
Damages—
General.

When an account of profits or an inquiry as to damages is ordered the account or the inquiry, in the absence of provision to the contrary, extends to all infringements committed within six years before action brought (*r*) and goes up to the date of the assessment, if the cause of action is a continuing one, as the infringement of a subsisting patent is; (*s*) and articles manufactured for export must be brought into the inquiry. (*t*)

Account of
profits or
inquiry as to
damages
usually goes
up to the
assessment.

As a rule, where a plaintiff has become possessed of the patent by assignment, the assessment is only ordered from the date of the registration of the assignment. (*u*)

Assessment
where the
plaintiff is an
assignee.

But where it appeared that the plaintiff has taken over a business and certain patents, and succeeded to the rights of

(*h*) *Saccharin Corporation, Ltd. v. Quincy*, (1900) 17 R. P. C. 337; but see p. 394 *ante*.

(*i*) *Smith v. G. W. Ry. Co.*, (1854) Macr. P. C. 209; *S. C. Kay*, 417.

(*k*) *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.*, (1858) 4 K. & J. 727; but see *Fox and Dellestable*, (1866) 15 W. R. 194.

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

(*m*) *Smith v. G. W. Ry. Co.*, (1854) Macr. P. C. 203; *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.*, (1858) K. & J. 727.

(*n*) See *Bailey v. Taylor*, (1829) 1 Russ. & M. 73, 75; *Parrott v. Palmer*, (1834) 3 M. & K. 632, 642.

(*o*) *Crossley v. Derby Gas Co.*, (1829) 1 W. P. C. 119.

(*p*) *Elmore v. Pirrie*, (1887) 57 L. T. N. S. 333; 46 & 47 Vict. c. 57, s. 30; Vol. II. p. 215; *Sayers v. Collyer*, (1884) L. R. 28 Ch. D. 108; R. S. C. (1883) Order xv. r. 1; *York v. Stowers*, (1883) W. N. 174.

(*q*) 53 & 54 Vict. c. 23, s. 3; 21 & 22 Vict. c. 27; 36 & 37 Vict. c. 66, s. 16.

(*r*) *Davenport v. Rylands*, (1365) L. R. 1 Eq. 308.

(*s*) R. S. C. (1883) Order xxxvi. r. 58; *Fritz v. Hobson*, (1880) L. R. 14 Ch. D. 542. As to ascertainment of damages in Queen's Bench Division, see R. S. C. (1885) Order xxxvi. r. 57.

(*t*) *Lyon v. Goddard*, (1894) 11 R. P. C. 113.

(*u*) *Ellwood v. Christy*, (1865) 18 C. B. N. S. 494.

Account or Damages—General.

Assessment does not extend to infringements committed within certain periods.

Time within which amount found due is to be paid.

Disclosure by the defendant of number of infringing articles sold and names and addresses of his customers and also prices.

their predecessors, they were held to be entitled, in estimating the damages and loss of sales consequent on the competition of the defendants, to take into account the total quantities sold by the defendants before the plaintiffs acquired such business. (*x*)

The account of profits or inquiry as to damages does not include anything due to infringements committed within certain periods of time unless the Court otherwise directs, viz.—

- (1) Infringements prior to the publication of the complete specification. (*y*)
- (2) Infringements prior to an amendment of the specification, unless the Court is satisfied that the original claim was framed in good faith and with reasonable skill and knowledge. (*z*)
- (3) Infringements committed after a failure to make any payment in respect of keeping the patent on foot within the prescribed time and before the enlargement thereof. (*a*)

The order for the account or inquiry as the case may be, usually states the time within which the amount found due must be paid after it has been duly certified; (*b*) but sometimes the time within which such payment is to be made is reserved for further consideration, (*c*) and the costs of taking the account or instituting the inquiry are usually so reserved. (*d*)

On an account of profits or an inquiry as to damages the defendant must disclose the number of the infringing articles he has made, and the names and addresses of the persons to whom and the prices at which he has sold them, in spite of the fact that he thereby exposes his customers to attack

(*x*) *United Horseshoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 401, 417.

(*y*) p. 583; Vol. II.; p. 207 *ante*.

(*z*) Vol. II. pp. 78, 209; 46 & 47 Vict. c. 57, s. 20. *Semble* this section would include an account of profits as well as damages. In *Wenham Gas Co. v. Champion Gas Lamp Co.*, (1890) 7 R. P. C. 313, the inquiry was limited to damages in respect of infringements since the date of amendment. In *Hopkinson v. St. James's Electric Lighting Co.*, (1893) 10 R. P. C. 43, an account of profits was allowed from the date of the patent, the patentee having stated in evidence that he had framed the original claim in good faith with reasonable skill

and knowledge. For form of Order, see *Brooks v. Lycett*, (1903) 20 R. P. C. 392.

(*a*) 46 & 47 Vict. c. 57, s. 17, sub-s. 4 (*b*); Vol. II. p. 208.

(*b*) *Westinghouse v. Lancashire and Yorkshire Ry. Co.*, (1884) 1 R. P. C. 253; 11 W. R. 852; *Young v. Fernie*, *Bovill v. Crato*, *Needham v. Oxley*, *Cunningham v. Colling*, *Seton*, 4th ed. p. 355.

(*c*) *Hocking v. Fraser*, (1886) 3 R. P. C. 7; *Betts v. Noel*, *Seton* 4th ed. p. 355; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302; *Pemberton*, 4th ed. p. 484.

(*d*) *United Telephone Co. v. Fleming*, (1886) 3 R. P. C. 282; *United Telephone Co. v. Patterson*, (1889) 6 R. P. C. 140.

from the plaintiff, and himself to a consequent loss of trade. (e) Account or Damages—Account.

The very object for which the plaintiff desires the names of the defendant's customers may be to enable him to follow the infringing articles in the hands of such customers.

When in the case of a defendant company in liquidation the order is drawn up in the usual form against the company only, a motion to commit the liquidator for non-compliance, notwithstanding that he was appointed before trial, will fail. (f)

Account.—When the plaintiff elects to take an account of profits he establishes a different relationship between himself and the defendant to that which exists between them on an inquiry as to damages. In the former case by electing to take an account of profits he condones the infringement, (g) and adopts that which was done by the defendant, (h) and claims for himself the profits made by the infringer from the use of the invention; in the latter case the defendant is treated all through the inquiry as a wrongdoer. Thus by electing to take an account it may be said that the plaintiff constitutes the defendant his agent as regards the acts whereby he, by the use of the invention, has made a profit or the reverse, and the question always is what in profit or loss was the result of the course of conduct actually pursued by the defendant, and not what might have been the profit had he pursued a different line of conduct. Consequently, the plaintiff is not entitled to an account of, and compensation for, the actual losses he may have sustained through the wrongful acts of the defendant; he is only entitled to an account and payment over to him of the actual profits, if any, derived from the defendant's use of the invention, (i) and, if the defendant has made profit by the illegal use of the patented invention, the fact that he might have made a profit otherwise—*e.g.*, by the sale of articles not manufactured by a machine the subject-matter of the patent—is quite immaterial. (k) The true test

Difference in relationship of the plaintiff to the defendant on the taking of an account to that which exists between them on an inquiry as to damages.

(e) *Murray v. Clayton*, (1872) L. R. 15 Eq. 115; *American Braided Wire Co. v. Thompson* (No. 2), (1888) 5 R. P. C. 375; *United Telephone Co. v. Walker*, (1887) 4 R. P. C. 66; *Leather-Cloth Co. v. Hirschfeld*, (1863) 1 H. & M. 295; *Adair v. Young*, (1879) L. R. 11 Ch. D. 136; 12 Ch. D. 13; *Powell v. Birmingham Vinegar Brewery Co.*, (1896) 14 R. P. C. 1; *Saccharin Corporation v. Chemical and Drugs Co.*, (1900) 17 R. P. C. 612.

(f) *Saccharin Corporation v. Chemical and Drugs Co.*, (1900) 17 R. P. C. 743.

(g) *Neilson v. Betts*, (1871) L. R. 5 H. L. 22.

(h) *American Braided Wire Co. v. Thompson*, (1890) 7 R. P. C. 158.

(i) *Ellwood v. Christy*, (1865) 18 C. B. N. S. 494.

(k) *United Horseshoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 401.

Account or
Damages—
Account.

of comparison is to take the ratio of the profit derived when the invention was used to the profit which would have been derived had the defendant used that which, looking at all the circumstances of the case, he would most probably have used had he not illegally adopted the invention. (*l*)

Profits of
defendant's
business before
infringement
as well as
since.

On the taking of the account the defendant may be compelled to disclose the profits arising from his business before he commenced to manufacture the articles to which the patent refers by the application of the patented process or machine, as well as since, if such information is necessary to put the Court in a position to estimate what proportion of the total profits made by him since the commencement of the infringement is due to his wrongful acts. (*m*)

Extent of
account of
profits.

An inquiry as to profits made by an infringer extends to all profits, including those which accrued since the defendant became aware of the plaintiff's claim to the patent, as well as those which accrued before he became aware of such claim. (*n*)

The account also extends, not merely to the profits made by the sale of the pirated article, but also to all profits incidentally derived from its use. For example, where a defendant was sued for the infringement of a patent for gas-meters, and was ordered to account for profits made by him, the account was made to include the benefit derived by way of saving effected by the use of the piratical gas-meters. (*o*)

It would appear that if the plaintiff desires an account of collateral profits he must prove that such profits have been received; (*p*) and an account will not be directed when it is clear that no profits whatever have been made. (*q*)

Production of
books and
administration
of interroga-
tories.

When an order for an account of profits is made against a defendant, he may be compelled to produce his books, and interrogatories may be administered, notwithstanding a pending appeal. (*r*)

Bankruptcy of
defendant.

In the bankruptcy of a defendant the amount found due on

(*l*) *Siddell v. Vickers*, (1892) 9 R. P. C. 152.

(*m*) *Siddell v. Vickers*, (1889) 6 R. P. C. 464.

(*n*) *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302, 308; *United Horseshoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 401.

(*o*) *Crossley v. Derby Gaslight Co.*, (1829) 1 W. P. C. 119; see also *House-*

hill Co. v. Neilson, (1843) 1 W. P. C. 697 *n*.

(*p*) *Bacon v. Spottiswoode*, (1839) 1 Beav. 382.

(*q*) *Bergmann v. McMillan*, (1881) L. R. 17 Ch. D. 423; *Sanitas Co. v. Condy*, (1887) 4 R. P. C. 530.

(*r*) *Saxby v. Easterbrook*, (1872) L. R. 7 Ex. 207.

an account of profits made by the infringement of a patent can be proved, as it is a liquidated debt. (s)

Account or Damages—
Damages.

Where the plaintiff is in the habit of supplying to his customers a complete instrument at a fixed royalty, and that instrument consists of patented and non-patented parts, it is proper, in estimating the amount to which he is entitled, to deduct from the royalty a sum in consideration of the non-patented portion of the infringing instrument, (t) though no deduction is allowed in respect of the defendant's property in the patented part. (u) Consequently, where the plaintiff elects to claim profits made by an unauthorised use of his invention it becomes material to ascertain how much of it was actually appropriated, in order to determine what proportion of the net profits realised by the infringer was attributable to the use of the plaintiff's invention. (v)

Plaintiff in the habit of supplying on royalty articles consisting of patented and non-patented parts.

Damages.—Before Lord Cairns' Act there was no jurisdiction in the Court of Chancery to give damages, and the old form of decree always gave the plaintiff an account of profits, but by Lord Cairns' Act jurisdiction was conferred on the Court to give damages, and in *Hills v. Evans* (y) Lord Westbury pronounced a decree giving the plaintiff both damages and profits, which course was held to be wrong in *Neilson v. Betts* (z) and *De Vitre v. Betts*, (a) in which the House of Lords settled finally that the successful plaintiff in an action of infringement of a patent is entitled, at his election, to damages or an account of profits, but not to both, which is the state of the law now. (b) This relief may be obtained in either division of the High Court, (c) or in the Court of the County Palatine of Lancaster. (d)

Damages in lieu of an account of profits.

Before a plaintiff can be entitled to an inquiry as to damages, it is incumbent on him to show that he has in fact sustained some damage which is not merely nominal, (e) *i.e.*, the plaintiff must show that he has sustained pecuniary loss, and, as far

(s) *Watson v. Holliday*, (1882) 30 W. R. 747; 31 W. R. 536; 52 L. J. Ch. 543; Bankruptcy Act, (1883) s. 37.

(t) *United Telephone Co. v. Walker*, (1887) 5 R. P. C. 61, 63.

(u) *Ibid.*; see p. 509 *post*.

(z) *United Horseshoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 412.

(y) (1862) 4 De G. F. & J. 288.

(a) (1871) L. R. 5 H. L. 1; 40 L. J. Ch. 317.

(b) (1873) 6 H. L. 319; 21 W.

R. 705.

(b) Per Lindley, L.J., *Siddell v. Vickers*, (1892) 9 R. P. C. 162.

(c) p. 497 *ante*.

(d) p. 497 *ante*.

(e) *Dicks v. Brooks*, (1880) L. R. 15 Ch. D. 39; *United Telephone Co. v. Sharples*, (1885) 2 R. P. C. 28; *Sanitas Co. v. Condy*, (1887) 4 R. P. C. 530; *Cole v. Saqui*, (1888) 5 R. P. C. 489, 496; *Webb Lamp Co. v. Atkinson*, (1902) 19 R. P. C. 599.

Account or Damages— Damages. as the nature of the case may permit, the amount of that loss. (*f*) Sometimes, however, it may be evident that the plaintiff has sustained substantial damage, though it is not possible to fix any sum as to the exact quantum. In such cases it is proper and the practice of the Courts, by guess-work to award such a sum as from the circumstances of the case appears fair. (*g*) Thus, by way of illustration, if it can be proved that the necessary consequence of an injurious act, *e.g.*, infringement of a patent, is to damage the reputation of the patented article or process, and so to interfere with its general and extended use, very substantial damages might be recovered, though it might be impossible to put a figure on the loss. (*h*)

Assessment is not affected by amount accepted from non-litigants. Measure of damages.

The rate at which the plaintiff has accepted compensation for damages from non-litigants does not govern the assessment of the amount recoverable by action from the defendant. (*i*)

The measure of damages to which a successful plaintiff is entitled is the actual loss sustained by him by reason of the unlawful acts of the defendant, which loss must be the natural and direct consequence of the defendant's acts, (*k*) *i.e.*, the question is by how much would the plaintiff have been better off if there had been no infringement, (*l*) and the essential principle should always be borne in mind that the action is one not to punish the infringer, but to compensate the patentee, (*m*) and the Court properly compensates him with a liberal hand at the expense of the wrongdoer. (*n*) Thus, the whole moneys which an infringer has contracted to pay to a third party for the supply of a definite number of infringing articles (some of which have not been delivered) do not form the measure of damage sustained by the patentee, since he is only entitled to damages in respect of such articles as have actually been delivered. (*o*) The plaintiff is not entitled

(*f*) *Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre Co.*, (1898) 15 R. P. C. 406; 16 R. P. C. 215.

(*g*) See *Ungar v. Sugg*, (1891) 8 R. P. C. 388; 9 R. P. C. 117.

(*h*) See *Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre Co.*, (1898) 15 R. P. C. 406; 16 R. P. C. 212, 215.

(*i*) *Boyd v. Tootal Broadhurst, & Co.*, (1894) 11 R. P. C. 175.

(*k*) *United Telephone Co. v. Walker*, (1887) 4 R. P. C. 67; *Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre Co.*, (1899) 16 R. P. C. 212, 214.

(*l*) *Boyd v. Tootal Broadhurst, & Co.*, (1894) 11 R. P. C. 175; *Penn v. Jack*, (1867) L. R. 5 Eq. 81; 37 L. J. Ch. 136; *Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre Co.*, (1899) 16 R. P. C. 212, 214.

(*m*) See *Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre Co.*, (1899) 16 R. P. C. 215.

(*n*) *Ibid.*; *British Motor Syndicate. Ld. v. John Taylor & Son, Ld.*, (1899) 17 R. P. C. 189, 723.

(*o*) *British Insulated Wire Co. v. Dublin United Tramways Co.*, (1899) 17 R. P. C. 14.

to receive anything in respect of the annoyance and vexation he experiences from the necessity of having to establish his right in a Court of law, the award of the costs of the action being the only way the Court will attempt to recompense him in respect of such annoyance and vexation, (p) though he may be entitled to a substantial sum in respect of damage to the reputation of his patented article or process. (q)

Account or
Damages—
Damages.

It is, therefore, clearly important to establish what is the plaintiff's usual course of dealing with the invention—*e.g.*, the price at which he usually sells the patented article, or the amount of royalties he generally accepts from licensees authorised to use the invention.

When the patentee of machinery, who does not grant licences, claims damages from an infringing manufacturer who competes with him by selling the same class of goods as those made by the patented machine and in the same market, the profit made by the infringer is of no consequence. However large his gains, he is only liable in nominal damages so long as his illegal sales do not injure the trade of the patentee; and however great his loss he cannot escape from liability to make full compensation for the injury which his competition may have occasioned. Every sale of goods manufactured without licence by patented machinery is, and must be, treated as an illegal transaction in a question with the patentee; and its inherent illegality is not affected by the circumstance that the infringement consisted in using a small and, it may be, the least useful part of the invention. (r)

Damages when
it is not the
plaintiff's usual
course of busi-
ness to grant
licences.

If a part only of the actual article sold by the defendant is an infringement and the article sold by the defendant is of a substantially cheaper and lower grade than that usually manufactured and sold by the plaintiff under the patent, the Court ought in estimating the quantum of damage by no means to conclude that all the sales effected by the defendant would have been, but for the wrongful acts of the defendant, effected by the plaintiff at the price he charges for the higher grade article or at all. In such circumstances the Court is obliged to arrive at and adopt the best conclusion it can, upon the facts of the case, as to what quantity of the patented articles the plaintiff has been prevented from selling in consequence of the infringing articles being put upon the market and so

(p) *United Horseshoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 410, 416; 5 R. P. C. 260.

(q) *See supra.*

(r) *See Lord Watson's judgment in United Horseshoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 413; 5 R. P. C. 267.

Account or determine the quantum of profit which the wrongful acts of
 Damages— the defendant have prevented the plaintiff from realising. (s)
 Damages.

In *Gavioli v. Shepherd*, (t) in which case the defendant was the user and not the manufacturer of the infringing article, the Court came to the conclusion upon the facts that, if he had not bought the cheap infringing article, he would not have bought the plaintiff's more costly article, and, therefore, the plaintiff had not suffered any damage at all. In this case the order was in the form "whether any and what damages have been sustained or incurred by the plaintiff, &c.," and not in the usual form, "what damages the plaintiff has sustained." (u) It is submitted, nevertheless, that some damage should have been found due—if necessary by guesswork (v)—since every unlicensed user must be a damage to the patentee. (x)

In *Dunlop Pneumatic Tyre Co. v. Green* (y) it appeared that the defendant, who was a manufacturer of bicycles, supplied the plaintiffs' patented tyre with second grade machines, and it was proved that the plaintiffs supplied their tyre with all grades of machines. Under these circumstances the Court refused to interfere with the finding of the master, which awarded a substantial sum as the measure of damage.

In estimating the amount of damages to which a successful plaintiff is entitled, the Court recognises that every sale without licence of a patented article must be a damage to the patentee, and the inquiry is in the form, "what damage the plaintiff has sustained," not "what damage, if any." In the case of infringement of trade mark all the world are entitled to make the article, but not to brand it with the plaintiff's mark; but in the case of a patent every manufacture or sale of the article is necessarily a damage to the patentee. (z) The actual profit derived by the defendant is not in all cases necessarily the measure of the plaintiff's loss, for it cannot always be ascertained with arithmetical precision what, in the ordinary course of business, would have been the amount of the plaintiff's sales and profits. When the product of the patented process or machinery or the patented article itself is a new and special article which cannot be successfully

(s) *Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre Co.*, (1899) 16 R. P. C. 209, 212, 215, 216; *Dunlop Pneumatic Tyre Co. v. Gunn*, (1900) 17 R. P. C. 234.

(t) (1899) 17 R. P. C. 157.

(u) p. 502 *ante*.

(v) See p. 502 *ante*.

(x) See *infra*.

(y) (1900) 17 R. P. C. 234.

(z) See per Page Wood, V.C. *Davenport v. Rylands*, (1865) L.R. 1 Eq. 308

imitated without using the invention, the process of estimation is comparatively simple; but, on the other hand, it is quite the reverse when this is not the case. An allowance is made to the plaintiff in respect of loss of sales caused by the defendant's competition, and at the same time the defendant is entitled to strike off a moderate percentage as representing sales due to increased activity in the trade produced by the rivalry of two competitors, if that is the relationship of the parties. (a)

Account or
Damages—
Damages.

If a patentee whose patent is being infringed reduces the price at which he sells the patented articles, in order to be able to undersell the infringer, although in an action for damages he may be entitled to the benefit of all sales made by the infringer as if they were made by himself, so that he will get all the profit so made by the infringer, yet he will not be entitled to recover the difference between the original and reduced price, when the reduction is not a natural and direct consequence of the infringer's acts, and is therefore too remote. (b)

Reduction of
price by the
plaintiff.

But when it can be shown that the plaintiff has not reduced his price below that of the infringing defendant, and that the plaintiff's reduction has been consequent upon the defendant's, the Court, in estimating the amount of damages, will consider that the plaintiff, but for the defendant's wrongful acts, would have made all the sales effected by the defendant at the original and not at the lowered price. (c) A reduction, however, may be allowed to the defendant in consideration of the increase of sales by reason of the diminution of price, as also by reason of his business connection. (d)

When it is the plaintiff's usual course of business to grant licences, the measure of damage becomes the loss of royalties sustained by him through the defendant's acts; that is to say, the profit rent and royalties for the entire period during which the infringing article was in the hands of the defendant, whether it was or was not in use during the whole of that time. (e) Since the plaintiff deems himself fully compensated

Damages when
it is the plain-
tiff's usual
course of busi-
ness to grant
licences.

(a) *United Horseshoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 401, 413, 417; *Ellwood v. Christy*, (1865) 18 C. B. N. S. 494; *Penn v. Jack*, (1866) L. R. 5 Eq. 81; *Alexander v. Henry*, (1895) 12 R. P. C. 360.

(b) *United Horseshoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 401; 5 R. P. C. 260.

(c) *American Braided Wire Co. v. Thompson*, (1890) 7 R. P. C. 47, 152; (1890) W. N. 68; L. R. 44 Ch. D. 274; *Alexander v. Henry*, (1895) 12 R. P. C. 360.

(d) *Ibid.*

(e) *United Telephone Co. v. Walker*, (1889) 4 R. P. C. 63; *English and American Machinery Co. v. Union*

Account or
Damages—
Damages.

by the usual royalty charged in cases in which he has granted a licence, such sum is the proper measure of compensation where the manufacture or use has been carried on without his leave. (*f*)

And where the plaintiff is in the habit of granting licences he cannot claim by way of damages a manufacturing profit, or any sum beyond the ordinary royalty; moreover, he will not be entitled to recover anything from the manufacturer if he has received the full royalty from the user. (*g*) And, further, it cannot always be taken for granted that the licences which it is presumed the plaintiff would have granted, had the defendant not infringed, would have been in force till the expiration of the patent; with regard to the duration of such supposed licences, the Court must make the best estimate it can, having regard to all the circumstances of the case, *e.g.*, the average duration of licences granted by the plaintiff about the time the defendant's acts were committed. (*h*)

A patentee who has obtained an injunction cannot be compelled to accept from an infringer desirous of continuing the use of the invention the same royalties he accepts from other and licensed users. (*i*)

Damages may
be recovered
either against
a manufacturer
or a user, or
both, until the
full amount
has been
recovered.

Damages for infringement may be recovered against either a manufacturer or a user, or both, until the full measure of damage, which is the total loss of the profit which the plaintiff would have made had the infringing machine been supplied by him, has been recovered. (*k*)

For example, if a patentee obtains an injunction and damages against an infringing manufacturer, and the manufacturer does not pay the damages, it is open to the patentee to claim from a purchaser of the manufacturer what is due to him by way of damages in respect of the purchase of infringing machines; (*l*) and the acceptance by the plaintiff of *agreed*

Boot and Shoe Machine Co., (1895) 13 R. P. C. 64; see Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre Co., (1898) 15 R. P. C. 405; 16 R. P. C. 212.

(*f*) See Penn v. Jack, (1867) L. R. 5 Eq. 83.

(*g*) *Ibid.* 81.

(*h*) English and American Machinery Co. v. Union Boot and Shoe Machinery Co., (1895) 13 R. P. C. 64.

(*i*) Penn v. Bibby, (1866) L. R. 3 Eq. 310, 312; Penn v. Jack, (1867) L. R. 5 Eq. 81.

(*k*) Penn v. Bibby, (1866) L. R. 3

Eq. 308; Penn v. Jack, (1867) L. R. 5 Eq. 81; United Telephone Co. v. Walker, (1889) 4 R. P. C. 63; United Horseshoe and Nail Co. v. Stewart, (1888) L. R. 13 App. Cas. 401, 408; American Braided Wire Co. v. Thompson, (1890) 7 R. P. C. 47, 152; Boyd v. Tootal Broadhurst, & Co., (1894) 11 R. P. C. 175; British Motor Syndicate v. John Taylor & Sons, (1900) 17 R. P. C. 728.

(*l*) Cropper v. Smith, (1883) L. R. 24 Ch. D. 305, 312; British Motor Syndicate v. John Taylor & Sons, (1900) 17 R. P. C. 728.

damages from an infringing manufacturer of the patent article in respect of *his* wrongful acts, does not preclude the plaintiff from following the article in the hands of a purchaser from such manufacturer and claiming damages from him, for the payment of agreed damages by the manufacturer does not necessarily make the article "free" in the hands of a purchaser; (*m*) but if the damages payable by a manufacturer under an order against him are calculated upon the basis that he is to be held liable for the full loss caused to the patentee by the manufacture and sale of the infringing articles in question such articles do become "free" in the hands of purchasers from the manufacturer, who cannot be subjected to any liability in respect of them. (*n*) A plaintiff's right to damages against a defendant user is not affected by the fact that the user had no notice of the patent; (*o*) such a user cannot be heard to say that, if he had had notice of the patent, he might have bought articles other than those which infringe the patent and which would have done as well for him. (*p*)

Account or
Damages—
Damages.

In cases where it appears that the defendant has infringed during the interval between a former decision adverse to the validity of the patent and its reversal on appeal, and further, that the defendant's wrongful acts were committed on the strength of that former decision, it is submitted that the defendant would be allowed to give evidence on this point in reduction of damages. (*q*)

Damages in
respect of
infringements
committed on
the strength of
a judgment
adverse to the
patent.

It is open to question whether a Judge of the Chancery Division has jurisdiction to order an inquiry as to damages to be referred to a Judge and jury. (*r*)

Reference of
inquiry to a
Judge and
jury.

Where the plaintiff in an action for the infringement of a patent claimed the costs of a former action against the same defendant, which it was alleged was discontinued owing to false evidence on the part of the defendant, the Court held that the proper course was to strike out those paragraphs of the statement of claim which referred to the costs of the former action, and to leave the plaintiff at liberty to bring a separate action in respect of them, and intimated that such action ought to be brought in the Queen's Bench Division. (*s*)

Costs of a
former discon-
tinued action.

(*m*) *United Telephone Co. v. Walker*, (1887) 4 R. P. C. 63, 67.

(*n*) See *ibid.*

(*o*) *Boyd v. Tostal Broadhurst, &c.*, Co., (1894) 11 R. P. C. 147.

(*p*) *Ibid.*

(*q*) p. 384 *ante*; *Arkwright v. Nightingale*, (1785) 1 W. P. C. 61.

(*r*) *American Braided Wire Co. v. Thompson*, (1888) 5 R. P. C. 696.

(*s*) *United Telephone Co. v. Tasker*, (1889) 6 R. P. C. 38.

Destruction or Delivery up of Infringing Articles.

Where damages, though claimed in the pleadings, were by an oversight not asked for at the trial, special leave was given, on subsequent motion by the plaintiff, to vary the minutes of the decree by adding an inquiry as to damages. (*t*)

Omission to ask for damages at the trial.

DESTRUCTION OR DELIVERY TO PLAINTIFF OF INFRINGING ARTICLES.

Power of the Court to order the destruction or delivery to the plaintiff of infringing articles.

In addition to an injunction restraining the defendant from infringing the patent in future, and an account of profits or damages at his option, a successful plaintiff in an action for infringement may under the present practice obtain an order of the Court directing an inquiry as to how many of the infringing articles are in the possession of the defendant, and ordering further that all such articles shall be destroyed in the presence of the plaintiff or delivered up to him, (*u*) or that they shall be delivered up or destroyed. (*x*) It is to be observed that the practice of the Court in granting orders for the delivering up or destruction of the defendant's goods is of modern growth and does not rest upon any statutory penalty of forfeiture for infringement. No forfeiture of goods can rest upon a grant of letters patent. (*y*) Some authorities have thought it doubtful whether the Court has jurisdiction to make an order for the delivering up of the defendant's goods to the plaintiff, and argued that a defendant whose goods are compulsorily taken or destroyed by the plaintiff, though under an order of the Court, has a right of action under sec. 4 of the Statute of Monopolies in respect of an illegal forfeiture. It is submitted, however, that this view is erroneous, first, because sec. 4 of the Statute of Monopolies does not apply to patents granted after the date of that Statute, (*z*) and, secondly, because the Court in ordering the delivery up to the plaintiff of the defendant's goods does not

(*t*) *Edison v. Holland*, (1888) 5 R. P. C. 483.

(*u*) *Betts v. De Vitre*, (1865) 34 L. J. Ch. 289, 291; S. C. 11 Jur. N. S. 9, 217; Seton, 4th ed. p. 354; *Washburn and Moen Manufacturing Co. v. Patterson*, (1884) 1 R. P. C. 157, 162; *Tangyo v. Stett*, (1865) 14 W. R. 386; *Frearson v. Loe*, (1878) L. R. 9 Ch. D. 48, 67; *Otto v. Steel*, (1886) 3 R. P. C. 109, 120; *Empress of Austria v. Day*, (1851) 3 De G. F. & J. 217; *Young v. Fernie*, (1866) L. R. 1 H. L. 63; *Pemberton*

4th ed. p. 484; *Edison v. Holland*, (1888) 5 R. P. C. 483.

(*x*) *Badische Anilin und Soda Fabrik v. Levinstein*, (1883) L. R. 24 Ch. D. 176; *Plimpton v. Malcolmson*, Seton, 4th ed. p. 354.

(*y*) *Waltham v. Austin*, 8 Co. Rep. 125a, 127b; 2 Inst. 47; *Horne v. Ivy*, 1 Sid. 441; 1 Vent. 47; *Hastings' Patent*, Noy, 183.

(*z*) See *Peck v. Hinder*, (1898) 15 R. P. C. 113; 14 Times L. R. 161.

proceed on the footing that the order passes the property in the goods from the defendant to the plaintiff, but makes the order as a protection to the patentee against the goods being used by the defendant who has been found guilty of an intention to use them. As was stated by *Cotton, L.J.*, in *Vavasseur v. Krupp*, (a) "the property in articles which are made in violation of a patent is, notwithstanding the privilege of the patentee, in the infringer if he would otherwise have the property in them. The Court in a suit to restrain the infringement of a patent does not proceed on the footing that the defendant proved to have infringed has no property in the articles; but, assuming the property to be in him, it prevents the use of those articles, either by removing that which constitutes the infringement, or by ordering, if necessary, a destruction of the articles so as to prevent them from being used in derogation of the plaintiff's rights—not on the footing that there is no property in the defendant. The Court cannot proceed to give that relief and interfere with the articles unless it has before it the person entitled to the articles in question, and has as against the person power to adjudicate that the articles are made or used in infringement of the plaintiff's rights."

Destruction or Delivery up of Infringing Articles.

In a case where the statement of claim prayed for the delivery up and destruction of all infringing articles in the power or control of the defendants, *Bacon, V.C.*, declined to make the order at the trial, but reserved the question for consideration after an account of profits had been taken. (b)

The order for delivery up or destruction usually fixes a time within which the infringing articles are to be delivered up or destroyed. (c)

Where a defendant is found to have infringed a patent for an invention consisting of a new combination of old parts, the Court will probably grant an injunction restraining the user of the infringing machines, but refuse to order their destruction, on the ground that the parts may be separated and used for other purposes, and the order will give liberty to the plaintiff to mark the infringing machines so as to be able to follow them at any time. (d)

Form of order.

When an infringing article is composite.

(a) (1878) L. R. 9 Ch. D. 360.

(b) *Hocking v. Fraser*, (1886) 3 R. P. C. 7.

(c) *Otto v. Steel*, (1886) 3 R. P. C. 120; *Washburn and Moen Manufacturing Co. v. Patterson*, (1884) 1 R. P.

C. 191.

(d) *Needham v. Oxley*, (1878) 8 L. T. N. S. 604; 11 W. R. 852; *Pemberton*, 4th ed. p. 485; *Seton*, 4th ed. pp. 352, 353.

Costs.

—

Under the following circumstances, an order for delivery up was refused:—The infringing machines consisted of two distinct parts, one of which was an infringement of the patent, and the other was not; the machines had been manufactured abroad and imported into this country, and the defendants dismantled them and kept the separate parts stored in a warehouse. (*e*) Also where the infringing part was a portion of a complicated apparatus the defendant was not ordered to deliver up the whole machine on his undertaking to remove the infringing part. (*f*)

Loss caused to defendant.

The destruction of an infringing article may cause a loss to the defendant considerably greater than the cost of such infringing article, as, for example, where the infringing article is used in combination with other things which do not infringe, and the article cannot be detached without destroying the whole machine—*e.g.*, the filament in an *Edison* incandescent electric lamp which was held to infringe the *Cheesborough* patent, and an order for the destruction of which was obtained. (*g*) This loss is part of the risk an infringer incurs when he invades a patentee's right. (*h*)

Costs.

Discretion of Court or Judge.

Subject to the Judicature Acts and the Supreme Court Rules, 1883, the costs of and incident to all proceedings in the Supreme Court are in the discretion of the Court or Judge, provided that where any action, cause, matter, or issue is tried with a jury, the costs shall follow the event, unless the Judge by whom such action, cause, matter, or issue is tried, or the Court, shall for good cause otherwise order. (*i*) Consequently the costs of an action for infringement of a patent are in the discretion of the Judge of any division of the Supreme Court in which the action is tried.

If either party desires that certain costs should be disallowed, he should apply accordingly to the Judge at the trial. The taxing master rightly allows costs which fall within the Judge's order—*e.g.*, the plaintiff's costs occasioned by the defence of a defendant against whom the action was settled

(*e*) *United Telephone Co. v. London and Globe Telephone and Maintenance Co.*, (1884) L. R. 26 Ch. D. 766, 776.

(*f*) *Automatic Weighing Machine Co. v. Feasby*, (1893) 10 R. P. C. 442.

(*g*) *Edison v. Holland*, (1888) 5 R. P. C. 459, 483.

(*h*) *United Telephone Co. v. Walker*, (1887) 4 R. P. C. 67.

(*i*) R. S. C. (1883) Order lxxv. r. 1.

before trial are payable by another defendant against whom judgment is obtained with costs for the plaintiff. (*k*)

Costs.

On taxation, however, no costs will be allowed to either party in respect of any particular which the Court or a Judge has not certified as being reasonable and proper. (*l*) And in case the plaintiff succeeds in an action in respect of a patent, the validity of which has been certified by the Court or a Judge to have been questioned in a former action for infringement, he is entitled to have his full costs, charges, and expenses, as between solicitor and client, unless the Court or a Judge trying the case certifies that he ought not to have the same. (*m*)

Necessity for certificate of particulars, and validity.

In the words of Sir George *Jessel*, M.R. : "Where a plaintiff comes to enforce a legal right, and there has been no misconduct on his part, or omission or neglect which could induce the Court to deprive him of his costs, the Court has no discretion, and cannot take away the plaintiff's right to costs. There may be misconduct of many sorts : for instance, there may be misconduct in commencing the proceedings, or some miscarriage in the procedure, or any oppressive or vexatious mode of conducting the proceedings, or other misconduct which will induce the Court to refuse costs ; but where there is nothing of the kind the rule is plain and well settled, and is as I have stated it." (*n*)

As we have seen, a plaintiff is not bound to apply to the defendant for the relief he seeks before commencing action, (*o*) and ignorance on the part of the defendant is no defence to an action for infringement. (*p*) Neither of these grounds will determine the Court to refuse the plaintiff his costs, if he succeeds in the action and is not otherwise disqualified. (*q*)

Ignorance does not exempt from liability to pay costs.

Although a defendant admits infringement and promises to discontinue the acts complained of and not to repeat them, the plaintiff is not bound to rely on such promises, but may obtain the injunction of the Court or such other relief as may

When defendant admits and undertakes to discontinue infringement.

(*k*) *Badische Anilin und Soda Fabrik v. Hickson*, (1906) 23 R. P. C. 149.

(*l*) 46 & 47 Vict. c. 57, s. 29, sub-s. 6; Vol. II. p. 215; *Longbottom v. Shaw*, (1889) 6 R. P. C. 513. This provision does not apply to the Court of the County Palatine of Lancaster, as that Court is not a Court within the meaning of 46 & 47 Vict. c. 57, s. 29 (6); see Vol. II. p. 215 *post*.

(*m*) 46 & 47 Vict. c. 57, s. 31; Vol. II. p. 215.

(*n*) *Cooper v. Whittingham*, (1880) L. R. 15 Ch. D. 504.

(*o*) p. 386 *ante*.

(*p*) p. 336 *ante*.

(*q*) *Wittman v. Oppenheim*, (1884) L. R. 27 Ch. D. 260; *Upmann v. Forrester*, (1883) L. R. 24 Ch. D. 231; *Burgess v. Hateley*, (1859) 26 Beav. 249; *Cooper v. Whittingham*, (1880) L. R. 15 Ch. D. 504; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302; *Collins v. Walker*, (1859) 7 W. R. 222.

Costs.
—

be necessary. (*r*) In such a case, if the defendant would avoid the costs of the action he must, at the time he admits the infringement, offer to pay all the costs incurred up to that period. (*s*)

Where the plaintiff failed to prove infringement, though the defendant admitted a discontinued infringement before action and offered to pay what was reasonable, the plaintiff was condemned in the costs of the action. (*t*)

A defendant who admits infringement must, in order to escape costs, if the plaintiff proceeds to an injunction, not merely promise not to repeat the infringement, but he must admit and offer to pay the amount of his liability. Thus, where a defendant had merely promised not to repeat the infringement, the plaintiff was held to be entitled not only to an injunction but to his costs of the suit. (*u*)

Again, defendants, who merely offered to remove certain infringing portions of a machine but gave no promise not to use them again and did not offer to pay the costs of the action already incurred, were ordered to pay the costs the plaintiff was put to in order to obtain an injunction. (*x*) And in an action in the Palatine Court, where infringing machines had been disused for five years previous to the commencement of the action, and had been removed from the defendants' premises, the plaintiffs obtained their costs on proof of the infringement, which was denied, and this although there was no threat on the part of the defendants to renew the infringement. (*y*) The Court of Appeal, however, held that in the absence of any evidence of an intention on the defendants' part to continue the wrongful acts an injunction ought not to have been granted, and dismissed the action, but, owing to the defendants' conduct of their case, without costs in the Court below, although they gave the defendants the costs of their successful appeal. (*z*)

When plaintiff's conduct is oppressive.

Oppressive conduct on the part of the plaintiff will induce the Court to deprive him of his costs, even though he succeed in the action. Thus, where a defendant at the hearing

(*r*) p. 386 *ante*.

(*s*) *Burgess v. Hateley*, (1859) 26 Beav. 249; *Geary v. Norton*, (1846) 1 De G. & S. 9, 12; *Fradella v. Weller*, (1831) 2 Russ. & M. 247; *Nunn v. D'Albuquerque*, (1865) 34 Beav. 595; *Colburn v. Simms*, (1843) 2 Hare, 543; *Jenkins v. Hope*, (1895) 13 R. P. C. 57.
(*t*) *Fletcher v. Glasgow Gas Co.*,

(1887) 4 R. P. C. 386.

(*u*) *Geary v. Norton*, (1846) 1 De G. & S. 9.

(*x*) *United Telephone Co. v. London and Globe Telephone and Maintenance Co.*, (1884) 1 R. P. C. 117.

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

(*z*) 6 R. P. C. 538.

submitted to a perpetual injunction, and it appeared that the defendant had ignorantly infringed the patent, but had previously to the commencement of the action offered to deliver up to the plaintiff all profits he had made by selling the infringing articles, and to sell all such articles remaining in his possession to the plaintiff at a fair valuation, but the plaintiff nevertheless continued the action, the Court gave him no costs. (a)

Costs—
Discontinu-
ance.
—

Discontinuance.—Where the plaintiff seeks leave by summons or otherwise to discontinue the action, the Court imposes such terms as to costs as under the circumstances seem reasonable. (b) Leave of the Court to discontinue is not necessary before delivery of defence, nor after the receipt thereof before taking any other proceeding in the action save any interlocutory application, but the plaintiff is bound to pay the defendant's costs. (c) Where the plaintiff discontinues rightly without the necessity for leave after the delivery of defence, the Court will not certify the particulars of objections unless the circumstances are such that the Court can say it knows enough about the case to justify it in doing so. (d)

When plaintiff
discontinues
action.

The omission by the plaintiff to deliver a reply when due, and his permitting the defendant to give notice of trial is not "taking any other proceeding in the action" within the meaning of R. S. C., Order xxvi. r. 1.

A plaintiff who discontinues is entitled to commence a fresh action against the same defendant in respect of the same cause of action, unless it be a term of an order allowing discontinuance that no such fresh action shall be brought. (e) An application to stay the taxation of the costs in a first action till after the trial of a second action would only be acceded to under exceptional circumstances. (f)

A defendant cannot withdraw his defence, or any part thereof, without leave upon terms as to costs and otherwise. (g)

(a) *Nunn v. D'Albuquerque*, (1865) 34 Beav. 595.

(b) *Boake, Roberts & Co. v. Stevenson*, (1894) 12 R. P. C. 228; *Wilcox and Gibbs' Sewing Machine Co. v. Janes*, (1897) 14 R. P. C. 523; *Bethell v. Gage*, (1897) 14 R. P. C. 699; *Chamberlain and Hookham, Ld. v. Mayor, &c., of Huddersfield*, (1901) 18 R. P. C. 454; *Kerr v. Crompton*, (1901) 19 R. P. C. 9; *Brooks v. Lycett*, (1902) 19 R. P. C. 166.

(c) R. S. C., Order xxvi. r. 1.

(d) *Ashworth v. Horsfall*, (1903) 21 R. P. C. 48; *Wilcox and Gibbs' Sewing Machine Co. v. Janes*, (1897) 14 R. P. C. 523; L. R. [1897] 2 Ch. 71.

(e) *Haskell Golf Ball Co., Ld. v. Hutchison*, (1905) 22 R. P. C. 208; *Haskell Golf Ball Co. v. Hutchison (No. 2)*, (1905) 22 R. P. C. 477; cf. *Consolidated Pneumatic Tool Co., Ld. v. Churchill & Co., Ld.*, (1905) 22 R. P. C. 209.

(f) *Ibid.*

(g) *Ibid.*

Costs—
Separate
Issues.
Apportion-
ment.

Separate Issues.—It is provided by R. S. C., 1883, Order LXV. r. 2, that where issues of fact and law are raised upon a claim or counterclaim the costs of the several issues respectively, both in law and fact, shall, unless otherwise ordered, follow the event. This rule does not apply to an action founded on infringement of patent right only. It applies to cases in which there are distinct causes of action, *e.g.*, where action is brought in respect of an alleged infringement of patent right and a passing off. (*h*)

Strictly speaking, there is only one issue in an action of infringement, viz., whether the defendant has infringed the plaintiff's legal right; (*i*) but it is customary to speak of the separate questions of validity and infringement on the assumption of validity as distinct issues. It is in this sense that the above questions are described in the following pages as separate issues.

Issues
abandoned at
the trial.

The costs of issues raised by either party, but abandoned at the trial, are usually given against the party who raised them; (*j*) though this rule does not necessarily apply where a party fights an issue till late in the trial and then gives it up on the ground that he is willing to depend upon some other issue. (*k*)

Apportion-
ment of costs.

Apportionment.—In considering the question of the apportionment of costs in patent cases, it will be well to divide the decisions into two classes—

- I. Those in which the validity of the patent was either not contested, or was established.
- II. Those in which the patent was declared invalid.

I. *Where the plaintiff succeeds in upholding the validity of the patent, but fails to prove the fact of infringement, it appears to be the general rule that the Court will apportion the costs.*

Thus, in a case in which the plaintiff succeeded on the question of validity, and the defendant on that of infringement, *Bacon, V.C.*, apportioned the costs, saying: "The costs of the suit, as far as relates to the futile attempt to dispute the plaintiff's right to a patent invention, must be borne by the

(*h*) See *Haskell Golf Ball Co. v. Hutchison*, (1906) 23 R. P. C. 129.

(*i*) See *Haskell Golf Ball Co. v. Hutchison*, (1904) 22 R. P. C. 130.

(*j*) *Thompson v. The American*

Braided Wire Co., (1889) 4 R. P. C. 316.

(*k*) *New Inverted Incandescent Gas Lamp Co., Ltd. v. Globe Light, Ltd.*, (1905) 22 R. P. C. 439, 440.

defendant. The costs of the plaintiff's futile attempt to restrain the defendant from doing that which I think by law he is entitled to do, his patent not being an imitation or piracy of the plaintiff's, the plaintiff must pay him, and the one set of costs must be set off against the other." (l)

Costs—
Apportionment.
—

In an action brought for the infringement of two separate patents, the jury found some of the issues affecting the validity of the patents for the plaintiff and others for the defendant, and it was finally ordered "that the costs be left to abide the event of the several findings for the plaintiff and the defendant company respectively, in respect of the said two letters patent, and that the said costs be taxed on the higher scale, and that the plaintiff do recover nothing against the defendants, save and except the costs of the issues on which he has obtained judgment, and that, save as aforesaid, the defendant company do recover their costs of suit from the plaintiff. (m)

And in another instance the action was dismissed with costs, but the Court directed that the plaintiff should have his costs, which were incurred by reason of the defendant disputing the validity of the patent. (n) In one case the Court of Appeal awarded the general costs to the defendant, but gave the costs of the issue of novelty, which was not decided, to neither side. (o)

In an action in which the defendants appealed from a judgment for the plaintiff with costs, and the taxed costs were by consent paid into court pending an appeal, the Court of Appeal, without going into any other question, decided the issue of infringement in favour of the defendants, and dismissed the appeal with costs. On a subsequent application by the defendants for the repayment of the costs paid by them into Court, the Vice-Chancellor of the Palatine Court held that the plaintiff was not entitled to an apportioned part of these costs, attributable to points other than infringement, on which he had succeeded at the trial; and that the costs must be paid out of court without waiting for the result of an appeal to the House of Lords. (p)

(l) *Simmonds v. Hitchman*, (1885) L. R. 29 Ch. D. 417; see also *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 297; see also *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.*, (1897) 14 R. P. C. 776, 777.

(m) *Westinghouse v. Lancashire and*

Yorkshire Ry. Co., (1884) 1 R. P. C. 229, 254.

(n) *Nordenfelt v. Gardner*, (1884) 1 R. P. C. 61, 75.

(o) *Needham v. Johnson*, (1884) 1 R. P. C. 49, 59.

(p) *Boyd v. Horrocks*, (1889) 6 R. P. C. 528.

Costs—
Apportionment.

Where the House of Lords reversed the decision of the Court below on the issue of validity, and held that the patent was good, but upheld the finding that the defendant had not infringed, the appeal was dismissed, but no costs were given. (*q*)

In an action which was dismissed, on the ground of no infringement, without going into the validity of the patent, and costs were given to the defendant, but no certificate was asked for as to the reasonableness and propriety of the particulars of objections, (*r*) the plaintiff sought, without success, by taking out a summons to review the taxation, to set off the costs he had incurred by obtaining evidence to meet the defendant's objections. (*s*) The plaintiff's contention was that the defendant's particulars were "improper, vexatious, or unnecessary" within the meaning of R. S. C., Order LXV. rr. 7, 27, sub-r. 20, and that he was, therefore, entitled to the costs occasioned by them. The Court, however, held that the taxing-master had rightly disallowed the defendant's costs of his particulars of objection, not because they were "improper, vexatious, or unnecessary," but simply because there had been no certificate, and it was a condition precedent, before the plaintiff could succeed, that he should show the costs of such particulars were disallowed on the ground that they were "improper, vexatious, or unnecessary."

Sometimes when the plaintiff succeeds on the issue of validity, but fails on the issue of infringement, though the plaintiff gets the chief part of the costs relative to validity, yet he does not get them all. The costs of some of the particulars of objections may be given to the defendant on the ground that such particulars were reasonable and proper and necessary for the purpose of defining the ambit of the claim. (*t*)

The proper form of order when the plaintiff is given the costs of the issue of validity, and the defendant the general costs of the action, was discussed in *Shoe Machinery Co. v. Cutlan*. (*u*)

(*q*) *Moore v. Bennett*, (1884) 1 R. P. C. 129.

(*r*) See p. 518 *post*.

(*s*) *Garrard v. Edge*, W. N. (1890) pp. 43, 68.

(*t*) *Nobel's Explosives Co. v. Anderson*, (1894) 11 R. P. C. 128.

(*u*) (No. 2), (1896) 13 R. P. C. 148, 398; see also *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.*, (1897) 14 R. P. C. 775, 776; *White v. Hartley*, (1902) 20 R. P. C. 265.

II. *There is no general rule as to the apportionment of costs where the plaintiff fails to uphold his patent, but is successful on the issue of infringement.*

Costs—
Apportionment.

The Court has a discretion in the matter which is exercised according to the circumstances of each case. (x) It is proper for the Court, if, after hearing the evidence, it comes to the conclusion that issues were unnecessarily raised, to apportion the costs of those issues; but the Court will not apportion the costs of issues which have never been heard in consequence of a decision having been come to at the outset of the case against the validity of the patent. (y)

In some cases where the defendant has impeached the patent on more than one ground, but has not been successful on all, and the plaintiff has succeeded on the issue of infringement, the costs of the issues affecting the validity of the patent on which the defendant has failed have been given to the plaintiff, and the other costs of the action to the defendant. (z)

A rule was stated by *Fry, J.*, in *Wegman v. Corcoran*, (a) to the effect that where the plaintiff fails on the issue of validity, but succeeds on other issues, the Court gives the general costs of the action to the defendant, but as regards certain issues raised by the one side or the other, the Court apportions the costs according to the success of the parties.

This rule was approved and applied by the Court of Appeal in *Badische Anilin und Soda Fabrik v. Levinstein*. (b) In this case *Bowen, L.J.*, said: "I am of opinion, in this case, that the plaintiffs should have the costs occasioned by the issues raised by the particulars of breaches, and that in respect of all the other costs the costs in the action should follow the usual result, and be awarded to the successful party. It seems to me that without laying down any hard-and-fast line, or trying to fetter our discretion at a future period in any other case, we are acting on a sensible and sound principle, namely, the principle that parties ought not, even if right in the action, to add to the expenses of an action by fighting issues in which they are in the wrong. It may be very

(x) *Kaye v. Chubb*, (1887) 4 R. P. C. 289, 300, 303.

(y) *Blakey v. Latham*, (1887) 6 R. P. C. 184, 190.

(z) *Pooley v. Pointon*, (1885) 2 R. P. C. 167; *Lawrence v. Perry*, (1885)

2 R. P. C. 179; *Lawrie v. Baker*, (1885) 2 R. P. C. 213; *Lister v. Norton*, (1886) 3 R. P. C. 199.

(a) (1879) 27 W. R. 357.

(b) (1885) L. R. 29 Ch. D. 366, 418, 420.

Costs—
Certificates as to
Particulars.

reasonable as regards their own interest, and may help them in the conduct of the action, that they should raise issues in which in the end they are defeated; but the defendant who does so does it in his own interest, and I think he ought to do it at his own expense." (c)

This rule is by no means universally followed. (d) Some Judges have, however, held that a plaintiff who has failed to substantiate his patent, but has succeeded on the issue of infringement, may be deprived of his costs of that issue, on the ground that in the opinion of the Court the issue was not sufficiently distinguished from the rest of the case, (e) or that the costs of the issue were trifling, (f) or on the ground that there can be no infringement of an invalid patent, and that it is consequently impossible for the plaintiff to succeed on the issue of infringement if the patent is bad. (g) In one case where the infringement was admitted and the defendant succeeded on the ground of want of novelty he was awarded the costs of the anticipations proved and the plaintiff the costs of the issue of infringement, but no other costs. (h)

Certificate of
particulars is
necessary on
taxation.

Certificates as to Particulars.—It is provided by sec. 29 sub-s. 6 of the Act of 1883 (i) that on taxation of costs regard shall be had to the particulars delivered by the plaintiff and the defendant, and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a Judge to have been proven or to have been reasonable and proper, without regard to the general costs of the case.

When the Court simply gives the successful party the costs of the action, it becomes the duty of the taxing-master to tax the costs just as he would tax the costs of any other action except that he must not allow costs in respect of those particulars as to which no certificate has been given, and this principle must be applied to the taxation of the costs of

(c) (1885) L. R. 29 Ch. D. 419; see also *Boyd v. Horrocks*, (1889) 6 R. P. C. 152, 162; *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate*, (1894) 11 R. P. C. 638; 12 R. P. C. 258, 303; *Haslam v. Hall*, (1888) 5 R. P. C. 23; *Kane v. Guest*, (1899) 16 R. P. C. 443.

(d) See, e.g., *Haskell Golf Ball Co. v. Hutchison*, (1905) 22 R. P. C. 479; 23 R. P. C. 301.

(e) *Guilbert-Martin v. Kerr*, (1887) 4 R. P. C. 23.

(f) *Kaye v. Chubb*, (1887) 4 R. P. C. 289.

(g) *Edison v. Holland*, (1888) 5 R. P. C. 483; *Blakey v. Latham*, (1888) 6 R. P. C. 29; *United Telephone Co. v. Harrison*, (1882) L. R. 21 Ch. D. 720.

(h) *Bennington v. Hill*, (1891) 8 R. P. C. 327; cf. *Westley Richards v. Perkes*, (1893) 10 R. P. C. 194; see also *Kane v. Guest*, (1899) 16 R. P. C. 443.

(i) Vol. II. p. 215.

expert evidence and proof of facts not admitted upon notice to admit. (*k*)

If either party omits to ask at the trial for a certificate as to the reasonableness and propriety of his particulars, it is submitted that he may obtain it afterwards on summons in chambers, (*l*) or on motion in Court; (*m*) but he will be cast in the costs of such summons or motion. (*n*)

In the event of the Court of Appeal reversing the decision of the Court below, the Court of Appeal has power to and will grant a certificate as to proof of, or the reasonableness and propriety of, the particulars. (*o*) Where the Court of Appeal reversed the decision of the Court below as to the validity of a patent, and granted a certificate as to some of the particulars of objections, *Cotton, L.J.*, said, in reference to sec. 29 of the Act of 1883: "I do not think that the Court of Appeal is the Court pointed at in that section, nor that the Judge in the Court of Appeal is the Judge pointed at; it must mean the Judge of the High Court who hears the matter originally, or a Divisional Court of the High Court. But in the Court of Appeal we ought to make such order as in our opinion the Judge who heard the case ought to have made—the Judge from whom the appeal is. In this case we thought he ought to have dismissed the action, and then, of course, he ought to have considered what particulars were proven, or reasonable and proper. In our opinion we ought to do that, as he has not done it, and could not do it, having regard to the conclusion at which he arrived. That has really been done in several patent cases which have been before this branch of the Court, and, that being so, we ought in our opinion to grant a certificate stating what particulars were reasonable and proper." (*p*)

The House of Lords on the same principle has a similar jurisdiction. (*q*)

The Court of the County Palatine of Lancaster is not a Court, nor is the Vice-Chancellor a Judge within the meaning of sec. 29 sub-s. 6 of the Act of 1883, (*r*) but it must be

Costs—
Certificates as to
Particulars.

Omission to
ask for certifi-
cate at the
trial.

Power of Court
of Appeal and
House of Lords
to grant a
certificate of
particulars.

(*k*) See *Haskell Golf Ball Co. v. Hutchison*, (1906) 23 R. P. C. 129.

(*l*) Judicature Act, 1873, s. 39; R. C. S. (1883) Order xlv. rr. 2, 17, 18; Order liv. r. 1.

(*m*) *Rowcliffe v. Morris*, (1886) 3 R. P. C. 145.

(*n*) *Duckett v. Sankey*, (1899) 16 R. P. C. 359.

(*o*) *Cole v. Saqui*, (1889) 6 R. P. C. 41, 45; *Humpherson v. Syer*, (1887) 4 R. P. C. 416.

(*p*) *Cole v. Saqui*, (1889) 6 R. P. C. 45.

(*q*) *Morris v. Young*, (1895) 12 R. P. C. 465.

(*r*) *Proctor v. Sutton Lodge Chemical Co.*, (1888) 5 R. P. C. 184.

Court of the
County Pala-
tine of
Lancaster.

Costs—
Certifi-
cates as to
Particu-
lars.

Certificate as to
particulars is
granted in
two distinct
cases.

remembered that his Honour has power over the costs of particulars irrespective of any certificate. (s) It is his Honour's practice to certify the particulars in respect of which the parties are to receive costs or otherwise. (t)

It is to be observed that the Act of 1883 (u) provides that the Court may grant the certificate as to particulars in two distinct cases—*i.e.*, (1) when the particulars have been proven, and (2) where in the opinion of the Court or a Judge they were reasonable and proper. Neither party to an action of infringement can, whether the action is brought to trial or is discontinued at an earlier stage, be allowed the costs of his particulars on taxation except he is provided with the certificate of the Court or a Judge as to them; (x) except the action be discontinued under such circumstances that the leave of the Court is necessary under R. S. C., Order xxvi., and the Court makes payment of costs of particulars as though they had been certified a condition of leave to discontinue. (y) The provisions of sec. 29 of the Act of 1883 as to certificates of particulars are different in this respect to those of the somewhat analogous section of the repealed Act of 1852, which were only applicable when there had been an actual trial in Court, and, consequently, under that Act, when the action was discontinued, or judgment was allowed to go by default, or the action was dismissed for want of prosecution, no certificates were given, but the costs of particulars were dealt with in the ordinary way. (z) Now, however, in all cases when the Court has not the materials necessary to enable it to grant the certificate, the successful party is, consequently, deprived of the costs of his particulars. (a) The power of the Court to grant the certificate on the ground that the particulars were reasonable and proper applies as well to the particulars of

(s) *Parnell v. Mort, Liddell & Co.*, (1885) L. R. 29; Ch. D. 325; 2 R. P. C. 55; *Garnett v. Bradley*, (1878) L. R. 3 App. Cas. 944.

(t) *Cheetham v. Oldham*, (1890) 7 R. P. C. 124; *Horrocks v. Stubbs*, (1886) 3 R. P. C. 240; *Parnell v. Mort, Liddell & Co.*, (1885) L. R. 29 Ch. D. 325; 2 R. P. C. 55; see also 53 & 54 Vict. c. 23, s. 3.

(u) s. 29, sub-s. 6.

(x) *Middleton v. Bradley*, (1895) 12 R. P. C. 390.

(y) *Chamberlain and Hookham v. Mayor, &c., of Huddersfield*, (1901) 18 R. P. C. 457; *Kerr v. Crompton*, (1901)

19 R. P. C. 9.

(z) *Batly v. Kynock*, (1875) L. R. 20 Eq. 632; *Rothwell v. King*, (1887) 4 R. P. C. 397; *Greaves v. The Eastern Counties Ry. Co.*, (1859) 1 E. & F. 961; 28 L. T. Q. B. 290; *Stevens v. Keating*, (1850) 1 Mac. & G. 659.

(a) *Middleton v. Bradley*, (1895) 12 R. P. C. 390; *Mandleberg v. Morley*, (1893) 11 R. P. C. 1; 12 R. P. C. 35; *Wilcox and Gibbs' Sewing Machine Co. v. Janes*, (1897) 14 R. P. C. 524; *New Invented Incandescent Gas Lamp Co., Ltd. v. General Incandescent Co., Ltd.*, (1905) 22 R. P. C. 614.

breaches as to the particulars of objections. (b) And where a defendant admits infringement and the validity of the patent is established the Court will certify the particulars of breaches. (c)

Costs—
Certifi-
cates as to
Particu-
lars.

The question arises whether, when the action is actually brought to a trial, but the case of the plaintiff breaks down on account of the patent being clearly proved to be void, or on an admission of one of the plaintiff's witnesses, (d) or on the evidence offered by the defendant, or because the plaintiff offers no evidence, (e) and the defendant is consequently not afforded an opportunity of proving his particulars, the Court can give a certificate that such particulars were reasonable and proper, and so enable him to obtain the costs of them. (f) The rule is that the Court will only certify with regard to such of the particulars as the materials before the Court at the time the certificate is asked for enable it to say have either been proven or are reasonable and proper, (g) and where the Court disposes of the action on one point it will not hear the case further for the purpose of deciding whether the other particulars should be certified or not, (h) nor will it act in a subsequent case upon a decision as to similar particulars certified by the Court in a prior case between different parties. (i)

Certificate
when action is
not tried out
on all the
issues raised.

Rule that
Court will only
certify such
particulars as
the materials
before the
Court enable it
to say are
reasonable and
proper.

The working of this rule in practice is well illustrated by the course pursued by the Court under the various circumstances hereafter detailed. Where the plaintiff's particulars alleged four distinct breaches, but no evidence was given as to one of them, and the plaintiff obtained the costs of the action, the certificate was confined to the particulars which had been proved. (k) Where the plaintiffs failed in their action on the ground of the invalidity of the patent being established by one of their own witnesses, judgment was given for the defendants without their being called upon to

(b) *Kane v. Guest*, (1899) 16 R. P. C. 443.

(c) *British Motor Traction Co. v. Sherrin*, (1901) 18 R. P. C. 275.

(d) *The Germ Milling Co. v. Robinson*, (1886) 3 R. P. C. 254.

(e) *American Steel and Wire Co. v. W. T. Glover & Co., Ltd.*, (1902) 19 R. P. C. 111; *Acetylene Illuminating Co. v. United Alkali Co.*, [1902] 1 Ch. 494.

(f) *Longbottom v. Shaw*, (1888) 5 R. P. C. 497; (1889) 6 R. P. C. 143.

(g) *Mandleberg v. Morley*, (1895) 12 R. P. C. 35, and cases there referred to; *Middleton v. Bradley*, (1895) 12 R. P. C. 390; *Wilcox and Gibbs'*

Sewing Machine Co. v. Janes, (1897) 14 R. P. C. 524; *Bethell v. Gage*, (1897) 14 R. P. C. 699; *New Inverted Incandescent Gas Lamp Co., Ltd. v. General Incandescent Co., Ltd.*, (1905) 22 R. P. C. 614; but see p. 523 *post*.

(h) *Boyd v. Horrocks*, (1889) 6 R. P. C. 162; *Longbottom v. Shaw*, (1889) 6 R. P. C. 143; *Mandleberg v. Morley*, (1895) 12 R. P. C. 35.

(i) *New Inverted Incandescent Gas Lamp Co., Ltd. v. General Incandescent Co., Ltd.*, (1905) 22 R. P. C. 614.

(k) *Colo v. Saqui*, (1888) 5 R. P. C. 489, 497.

Costs—
Certificates as to
Particulars.

go into their defence, and the Judge held that he must decide which of the particulars of objection were reasonable and proper in regard to the case so far as it had gone, and a certificate was granted to the defendant in respect of those particulars only which the Judge specifically mentioned. It was also held that the plaintiffs not being entitled to any costs, they were not entitled to any certificate in respect of their particulars of breaches. (*l*) And where at the trial the plaintiff's case broke down on account of his first witness in cross-examination being unable to distinguish the alleged invention from a previous specification, and the action was accordingly dismissed, the defendant was allowed a certificate which was limited to the particulars involved in the decision of the Court. (*m*)

In a somewhat recent case, where the plaintiff's first witness admitted in cross-examination that what the patentee and also the defendant actually did was not the alleged invention claimed and the case broke down accordingly, the witness was, by permission of the Judge, recalled and asked a further general question with reference to all the particulars of objections, and, upon his answer, the Judge certified as to all the particulars. (*n*) Where the action was dismissed with costs, because the plaintiff did not offer any evidence, the Judge refused to certify as to the particulars of objections. (*o*) And similarly, where at the trial the plaintiffs abandoned their case as to several patents sued on, but proceeded on one patent, the Court refused to certify as to the particulars relative exclusively to the abandoned patents. (*p*) Where a case broke down on account of the impossibility of supporting the first claim of the patent, and the action was dismissed without the defendants being called on, *Kay, J.*, refused to give a certificate with regard to the particulars of objections, but gave costs on the higher scale and liberty to apply with regard to the costs of the particulars of objections. (*q*) On

(*l*) *The Germ Milling Co. v. Robinson*, (1886) 3 R. P. C. 254.

(*m*) *Griffin v. Feaver*, (1889) 6 R. P. C. 396; see also *Albo-Carbon Light Co. v. Kidd*, (1887) 4 R. P. C. 535; *Oddy v. Smith*, (1888) 5 R. P. C. 503; *Slazenger v. Feltham*, (1889) 6 R. P. C. 130; *Boyd v. Horrocks*, (1889) 6 R. P. C. 152, 162; *Siddal and Hilton, Ltd. v. Wood*, (1904) 21 R. P. C. 232.

(*n*) *Pegamoid, Ltd. v. British Leather-Cloth Manufacturing Co., Ltd.*, (1901)

18 R. P. C. 317. See also *Cooper Patent Anchor Rail Joint Co., Ltd. v. London County Council*, (1906) 23 R. P. C. 296.

(*o*) *American Steel and Wire Co. v. W. T. Glover & Co., Ltd.*, (1902) 19 R. P. C. 112.

(*p*) *Acetylene Illuminating Co. v. United Alkali Co.*, [1902] 1 Ch. 494.

(*q*) *Rowcliffe v. The Longford Wire, Iron, and Steel Co.*, (1887) 4 R. P. C. 281, 288.

the other hand, in another case, where the same learned Judge at the end of the plaintiff's case intimated that he would not call on the counsel for the defendant, and gave judgment in his favour, he not only refused a certificate in regard to the particulars of objections, but also refused to give liberty to apply. (r) On taxation of the costs in the latter case the taxing-master allowed the costs relating to or governed by the defendant's particulars, including the costs of the witnesses; but the Judge, on summons, varied the master's order by disallowing those costs, on the ground that the words of the Act are precise, and that as no certificate had been granted at the trial they could not be allowed. (s) *Kay, J.*, in giving his decision, said: "There might well be a case where the matter was decided against the plaintiff without calling upon the defendant's counsel, and yet the Court, relying upon the evidence obtained by the defendant by cross-examining the witnesses, might think it right to look at the particulars of objections, and allow the costs of such particulars as were in fact made out by the cross-examination. I can quite understand that case occurring, and therefore I do not say that there might not be, in such a case as this, or in a similar case like that which I have just described, propriety in the Court looking into the particulars of objections, and saying whether they were reasonable or not, having regard to the specification." (t) Since these remarks were uttered there have been cases (u) in which the Court, being satisfied on the materials before it, has granted the certificate as to particulars of objections, though judgment was obtained before the defendant had an opportunity of giving any evidence; and the certificate has been given in chambers by *Stirling, J.*, after discontinuance, where he was satisfied on the documents that the particulars of objections were reasonable and proper. (x)

A certificate that the plaintiff's particulars of breaches were reasonable and proper has been given in several cases where judgment was entered for the plaintiff in default of appearance

Costs—
Certificates as to
Particulars.

(r) *Longbottom v. Shaw*, (1888) 5 R. P. C. 497, 502.

(s) *Longbottom v. Shaw*, (1889) 6 R. P. C. 510; *Garrard v. Edge*, (1889) 6 R. P. C. 372, 563; (1890) 7 R. P. C. 139; but see *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.*, (1897) 14 R. P. C. 776.

(t) (1889) 6 R. P. C. 513.

(u) *Heyes v. Hallmark*, (1891) 9 R.

P. C. 25; *Lees v. West London Cycle Stores*, (1892) 9 R. P. C. 300; *Singer v. Rudge Cycle Co.*, (1894) 11 R. P. C. 463, 585; *Mandleberg v. Morley*, (1895) 12 R. P. C. 35; 64 L. J. Ch. 245; *Pegamoid, Ld. v. British Leather Cloth Co., Ld.*, (1901) 18 R. P. C. 317.

(x) *Lee v. Wigan, & Co.*, (1895) L. 568, not reported, see *Annual Practice* (1906), p. 887.

Costs—
Certifi-
cates as to
Particu-
lars.

by the defendant. (*y*) A certificate as to particulars of objections was given in the Palatine Court where the defendant moved to dismiss the action for want of prosecution, and there was affidavit evidence sufficient to satisfy the Court that the particulars were reasonable. (*z*) When the defendant does not appear or does not defend, the Courts incline to act on the assumption that the defendant's conduct amounts to an admission that as against him the plaintiff's statements must be taken to be correct, and the particulars, or such of them as can be dealt with on this assumption, are reasonable and proper. (*y*)

Particulars not
proved under
a specific
objection but
necessary to
determination
of another
issue.

There is the authority of the Court of Appeal for the statement that notwithstanding that the party giving particulars has not an opportunity of proving, or fails to prove the specific objection under which the detailed particulars may be ranged, it is the practice of the Court, owing to the difficulty of doing justice as regards costs in any other way, to certify such particulars as are material to the decision of some other issue in the action. (*b*) Thus the certificate has been given as to some of the defendant's objections, though the patent was not held invalid on the special grounds alleged, because such particulars were necessary for the purpose in one case of defining the ambit of the plaintiff's claim, (*c*) and in another case, for the purpose of deciding the issue of disconformity between the specifications. (*d*) And a certificate has been given where the issue of invalidity was abandoned by the defendant late in the trial and he was successful on the issue of non-infringement. (*e*)

Action in
respect of
several
patents.

When the action is brought in respect of the infringement of several patents, and succeeds as to some but fails as to others, the Court will certify as to the particulars on which either party has succeeded, but will refuse to certify as to the particulars on which he failed. (*f*)

(*y*) *Pneumatic Tyre Co. v. J. Parr & Co.*, W. N. (1896) 88; *Pneumatic Tyre Co. v. Chisholm*, (1896) 13 R. P. C. 488; *Brooks v. Hall*, (1903) 21 R. P. C. 29; *Saccharin Corporation, Ltd. v. Skidmore*, (1903) 21 R. P. C. 31; *Saccharin Corporation, Ltd. v. Hay*, (1905) 22 R. P. C. 212.

(*z*) *Bates v. Horsfall*, (1905) 22 R. P. C. 519.

(*b*) See *Castner-Kellner Alkali Co., Ltd. v. Commercial Development Co., Ltd.*, [1899] 1 Ch. 803; 16 R. P. C. 275.

(*c*) *Jardine v. King, Mendham &*

Co., (1896) 13 R. P. C. 428; *Nobel's Explosives Co. v. Anderson*, (1894) 11 R. P. C. 128; see also *Osmonds v. Balmoral Cycle Co.*, (1898) 15 R. P. C. 522.

(*d*) *Castner-Kellner Alkali Co., Ltd. v. Commercial Development Co., Ltd.*, [1899] 1 Ch. 803; 16 R. P. C. 275.

(*e*) *New Inverted Incandescent Gas Lamp Co., Ltd. v. Globe Light Co., Ltd.*, (1905) 22 R. P. C. 431.

(*f*) *Brooks v. Lamplugh*, (1897) 15 R. P. C. 33.

Certificate of Validity.—It is provided by sec. 31 of the Act of 1883 that “in an action for infringement of a patent the Court or a Judge may certify that the validity of the patent came in question; and if the Court or a Judge so certifies, then, in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses, as between solicitor and client, unless the Court or Judge trying the action certifies that he ought not to have the same.” (g)

Costs—
Certificate of Validity.

Effect of certificate of validity given in a prior action.

The certificate may be given notwithstanding the fact that the patent has expired at the date of the judgment. (h)

As we have seen, (i) the validity of the patent may be called in question in an action brought to restrain the continuance of threats of proceedings in respect of infringements, but it is doubtful whether a certificate can be given in such an action under the above power. (k)

Threats action.

Under the Act of 1852, which authorised the Court to certify that the validity of the patent had been questioned, and provided that in a subsequent (l) suit or action touching such patent a plaintiff armed with the certificate of the Court given in a previous action might recover treble costs, if he was successful, it was enacted that such certificate might be given in evidence in any proceeding by *scire facias* to repeal the patent. (m) It is to be observed, however, that there is no corresponding provision made by the Act of 1883 or any subsequent Act with regard to the certificate in reference to a petition for revocation of the patent, which is the modern substitute for the proceeding by *scire facias*. (n)

Petition for revocation.

It is submitted that the Court of Appeal, if it reverses a decision of the Court below against the patent, has power to grant a certificate that the validity has come in question, though it is not a “Court” within the meaning of the section. It is the duty of the Court of Appeal to make such order as the Judge who heard the case ought to have made, and, in the event of the Court of Appeal reversing the decision below on the question of validity, it is presumed that a certificate would be granted, on the ground that the finding should have

Power of Court of Appeal and House of Lords and Court of the County Palatine of Lancaster to grant a certificate of validity.

(g) 46 & 47 Vict. c. 57, s. 31. For forms of Certificate, see Seton, 4th ed. p. 1661; Pemberton, 4th ed. p. 482.

(h) *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.*, (1897) 14 R. P. C. 776.

(i) p. 384 ante.

(k) p. 328 ante.

(l) *Bovill v. Hadley*, (1864) 17 C. B. N. S. 435.

(m) 15 & 16 Vict. c. 83, s. 43.

(n) p. 291 ante.

Costs—
Certificate
of Validity.

been the other way. (o) The House of Lords also for the same reason has a similar jurisdiction. (p)

Should the Court of Appeal or House of Lords not grant the certificate, application for one may be made to the Judge of the Court below who tried the case. (q) In a case under the old Acts the Court of Appeal refused a certificate, but gave the appellant leave to apply to the Judge below. (r)

The Court of the County Palatine of Lancaster is not a Court within the meaning of the Act of 1883, (s) but it is submitted that the Chancery of Lancaster Act, 1890, (t) gives power to the Vice-Chancellor, or the Court of Appeal on appeal from his judgment, to grant a certificate entitling the plaintiff to solicitor and client's costs if successful in a subsequent action.

Omission to
ask for certifi-
cate of validity
at the trial.

If a certificate that the validity of the patent was called in question is not asked for at the trial, it may probably be obtained by subsequent summons in chambers, (u) or on motion in Court. (x)

If a certificate be granted there is no appeal, as it is not a judgment or order against which an appeal lies. (y)

It seems that the grant of a certificate is discretionary in the Court or Judge. (z)

But in a case in which the result of the judgment was that the patent was invalid as regarded one claim, but that if the specification could be amended by omitting that claim the patent would be valid as to the remainder, *Stephen, J.*, granted a certificate that the validity had come in question, but made no reference to the finding on the point, and his Lordship stated that he could not refuse to certify the fact of the validity having been questioned. (a) It must be observed that in the case last referred to the decision of *Stephen, J.*, was to the effect that the patent was valid to a certain extent, and the case is no authority for the proposition that the certificate should be given when the Court merely decides that the patent

(o) R. S. C. (1883) Order lviii. r. 4; *Cole v. Saqui*, (1889) 6 R. P. C. 45; *Humpherson v. Syer*, (1887) 4 R. P. C. 416.

(p) *Morris v. Young*, (1895) 12 R. P. C. 465.

(q) *Cropper v. Smith*, 2 R. P. C. 61.

(r) *Otto v. Linford*, (1881) 46 L. T. N. S. 35.

(s) *Proctor v. Sutton Lodge Chemical Co.*, (1888) 5 R. P. C. 184.

(t) 53 & 54 Vict. c. 23, s. 3.

(u) Judicature Act, 1873, s. 39; R.

S. C. (1883) Orders liv. and lv.

(x) *Rowcliffe v. Morris*, (1886) 3 R. P. C. 145.

(y) *Haslam v. Hall*, (1888) L. R. 20 Q. B. D. 491; (1888) 5 R. P. C. 144; *Cropper v. Smith*, (1885) 2 R. P. C. 63.

(z) 46 & 47 Vict. c. 57, s. 31.

(a) *Haslam v. Hall*, (1888) 5 R. P. C. 28; *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 113, 120; *Badische Anilin und Soda Fabrik v. La Société des Usines du Rhône*, (1897) 14 R. P. C. 892.

is bad and gives no decision as to what would be the result of an amendment of the specification. In such a case it would appear clear that the certificate should be refused. (b)

It was held under the Act of 1835 that no certificate ought to be given when no evidence on the question of validity was offered, and judgment was entered for the plaintiff by consent; (c) but where the defendant offered evidence against the novelty of the invention, which failed, and was prevented from offering further evidence affecting the validity of the patent on other grounds, it was held that a certificate ought to be given. (d)

And under the Act of 1883, where a defendant by his pleadings denied the validity of the patent, but did not appear at the trial, *Kay, J.*, holding that sec. 31 of the Act of 1883 only applied when the patent is established in a case contested in Court, refused to grant a certificate; (e) and *Buckley, J.*, under similar circumstances, adopted the same course, (f) though on a subsequent occasion, where the defendant appeared by counsel at the trial but took no part in it, he granted the certificate, (g) and under like conditions *Farwell, J.*, permitted the plaintiff to give evidence shortly as to the validity of the patent, and then granted the certificate. (h) *Kekewich, J.*, in the absence of authority to the contrary, granted the certificate, (i) and pointed out that if a defendant, by non-appearance at the trial, could deprive a successful plaintiff of the right to a certificate as to the validity of the patent, the plaintiff might be put to the trouble of proving it all over again. And *Day, Farwell, and Channell, JJ.*, and the Irish Master of the Rolls, in more recent cases, followed the course adopted by *Kekewich, J.* (k) Also, where a case was settled by a compromise between the parties, *Collins, J.*, granted the certificate on the ground that the validity had undoubtedly been brought in question, though the parties had arranged

Costs—
Certificate
of Validity.

—
Certificate
when no
evidence on
issue of
validity is
offered.

(b) See *Acetylene Illuminating Co., Ltd. v. United Alkali Co., Ltd.*, (1902) 19 R. P. C. 234.

(c) *Stocker v. Rodgers*, (1843) 1 Car. & K. 99.

(d) *Gillett v. Wilby*, (1839) 1 W. P. C. 270.

(e) *Peroni v. Hudson*, (1884) 1 R. P. C. 261, 263; *Stocker v. Rodgers*, (1843) 1 Car. & K. 99.

(f) *Webb Lamp Co. v. Atkinson*, (1902) 19 R. P. C. 599.

(g) *Consolidated Pneumatic Tool Co. v. Churchill & Co.*, (1905) 22 R. P. C. 367.

(h) *Chadburn's (Ship) Telegraph Co. v. Robinson*, (1905) 22 R. P. C. 468.

(i) *Haydock v. Bradbury*, (1887) 4 R. P. C. 74.

(k) *Edison-Bell Phonograph Corporation v. Edison Phonograph Co.*, (1893) 11 R. P. C. 33; *Acetylene Illuminating Co. v. Midland Acetylene (Parent) Syndicate*, (1900) 17 R. P. C. 534; *Welsbach Incandescent Gas Light Co. v. Krumm*, (1901) 18 R. P. C. 211; *Welsbach Incandescent Gas Light Co. v. John McGrady & Co.*, (1901) 18 R. P. C. 51.

Costs—
Certificate
of Validity.

between themselves how it was to be decided, (*l*) and *Cozens-Hardy, J.*, granted the certificate where the issue of validity was raised on the pleadings, but no evidence on that issue was offered at the trial. (*m*) *Byrne, J.*, on the other hand, refused the certificate where the issue was raised and denied on the pleadings, but judgment for an injunction was given by consent. (*n*)

Certificate of
validity may
be given
though plain-
tiff fails on the
issue of
infringement.

It is not necessary that the plaintiff should be completely successful in the action to obtain a certificate of validity. The certificate has been given in many cases where the plaintiff, though successful on the issue of validity, has failed on that of infringement. (*o*)

Certificate
where defen-
dant admits
validity on a
certain con-
struction of the
specification.

There does not appear to be any case in which a certificate of validity has been given where the defendant has admitted the validity of the patent upon a certain specific construction of the specification, found by the Court to be the true construction, which excludes the alleged infringement from the claim; and in such a case it is submitted that no certificate would be given. (*p*) If, however, the defendant should, besides admitting validity, subject to a proviso as to construction, alternatively plead invalidity upon another construction, and succeed with reference to the special construction without arguing his case upon the other construction, it is submitted the Court might grant the certificate, though the case of validity was not contested in Court. (*q*)

Certificate of
validity should
be pleaded in a
subsequent
action.

Where a certificate of validity has been granted in a previous action, it will not usually be granted again at the conclusion of a subsequent action. (*r*) And if it is desired to claim solicitor and client's costs, the certificate ought, strictly speaking, to be pleaded in the subsequent action, though they may be given if the writ and statement of claim ask for them. (*s*)

Meaning of
"subsequent
action."

An action commenced but not determined at the time a certificate in another action is obtained is not a subsequent

(*l*) *Delta Metal Co. v. Maxim-Nordenfelt Guns and Ammunition Co.*, (1891) 8 R. P. C. 247.

(*m*) *Leeds Forge Co. v. Deighton's Patent Flue and Tube Co.*, (1901) 18 R. P. C. 233.

(*n*) *Cloughton v. Foster*, (1903) 21 R. P. C. 17.

(*o*) *Tweedale v. Ashworth*, (1890) 7 R. P. C. 426; 8 R. P. C. 49; 9 R. P. C. 121; *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.*, (1897) 14 R. P. C. 776; *Morrison v. Asplen*, (1904) 21 R. P. C. 557.

(*p*) *Morris v. Young*, (1895) 12 R. P. C. 464, 465.

(*q*) *Haydock v. Bradbury*, (1887) 4 R. P. C. 74; *Edison-Bell Phonograph Corporation v. Edison Phonograph Co.*, (1893) 11 R. P. C. 33; *Delta Metal Co. v. Maxim-Nordenfelt Guns and Ammunition Co.*, (1891) 8 R. P. C. 247; *Morris v. Young*, (1895) 12 R. P. C. 465.

(*r*) *Edison v. Holland*, (1888) 6 R. P. C. 285.

(*s*) *Pneumatic Tyre Co. v. Chisholm*, (1896) 13 R. P. C. 488.

action for infringement within the meaning of sec. 31 of the Act of 1883, and the plaintiff cannot claim solicitor and client's costs on the production of the certificate and record of the first determined action. (t)

Costs—
Certificate
of Validity.
—

Under the Act of 1852 the order on a motion for a new trial of an action subsequent to one in which a certificate of validity had been obtained was held not to be a "decree, decretal order or final judgment," and the plaintiff was not entitled to full costs. (u) It is submitted that such an order, or an order on motion to commit for breach of an injunction, would not be a "final order or judgment" within sec. 31 of the Act of 1883, and, therefore, under the present practice the plaintiff could not on the strength of a certificate of validity claim solicitor and client's costs, if successful in resisting a motion for a new trial, or obtaining an order for committal for breach of an injunction. (x)

It is to be noticed that the Act of 1883 provides that a plaintiff possessed of a certificate that the validity of his patent has been questioned is, in a subsequent action on obtaining a final order or judgment, to have his costs as between solicitor and client, *unless the Court or a Judge trying the action certifies that he ought not to have the same.* Therefore, it is left to the discretion of the Court to deprive a successful plaintiff in a subsequent action of his full costs, if it is of opinion that he ought not to have them. The object of the enactment was to prevent patentees being put under the necessity of bringing repeated actions to determine their rights after the patent has been once established. There are many circumstances under which it might be improper that a plaintiff succeeding in a subsequent action should have solicitor and client costs, notably if it is proved that the first action was collusive (y) or vexatious, (z) or the defendant is otherwise able to discharge the burden which is on him of showing cause why he should not pay solicitor and client costs. (a)

Solicitor and client costs are not always given though a certificate of validity has been obtained in a prior action.

(t) *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, (1889) 6 R. P. C. 120; *Automatic Weighing Machine Co. v. International Hygienic Society*, (1889) 6 R. P. C. 480; *Saccharin Corporation v. Anglo-Continental Chemical Works*, (1900) 17 R. P. C. 320; [1901] 1 Ch. 417; *Penn v. Bibby*, (1866) L. R. 3 Eq. 308; *Bovill v. Hadley*, (1864) 17 C. B. N. S. 435.

(u) *Bovill v. Goodier*, (1866) Griff.

L. O. C. 49.

(x) *Spencer v. The Ancoats Vale Rubber Co.*, (1889) 6 R. P. C. 46, 48.

(y) *Davenport v. Rylands*, (1865) L. R. 1 Eq. 309.

(z) *Proctor v. Sutton Lodge Chemical Works*, (1888) 5 R. P. C. 184.

(a) *United Telephone Co. v. Patterson*, (1889) 6 R. P. C. 142; *United Telephone Co. v. St. George*, (1886) 3 R. P. C. 339.

Costs—
Certificate
of Validity.
——

The intention seems to be to protect patentees from being harassed by having to support their patents again after they have been contested and declared valid, and not to affect the question of the costs of the issue of infringement where the evidence before the Court is totally distinct from that which was presented in the former action, or there are other substantially new questions to be decided with reference to the patent or the specification.

For instance, where a certificate as to validity had been obtained, *Pearson, J.*, in a subsequent action, refused to give full solicitor and client costs on the ground that the patent was attacked on grounds which were not raised in the prior proceedings, but he granted the plaintiff a fresh certificate of validity, specifying to what extent the patent had been questioned. (*b*) But *Romer, J.*, gave solicitor and client costs where in the subsequent action the patent was unsuccessfully contested on a point of ambiguity of specification which was not raised on the former occasion; (*c*) and *Byrne, J.*, gave solicitor and client costs in a subsequent action on the express ground that the defendant had contested the ambit of the patent. (*d*)

In a case under the Act of 1852, where the validity of the patent was subsequently contested on different grounds, Lord *Hatherley*, then Vice-Chancellor *Page Wood*, refused to give solicitor and client costs, on the ground that the former action was not conclusive as to the validity of the patent, for, after the plaintiff had obtained the judgment of the House of Lords in his favour, the Court of Queen's Bench directed a new trial, which, however, did not take place, in consequence of a compromise between the parties. (*e*)

Solicitor and
client costs
when defen-
dant does not
dispute
validity.

The fact that a defendant does not deny the validity of the patent, but only disputes the question of infringement, will not necessarily induce the Court to deprive a plaintiff who holds a certificate of validity of full solicitor and client costs; (*f*) but, on the other hand, the plaintiff, though armed

(*b*) *Otto v. Steel*, (1886) 3 R. P. C. 109, 120.

(*c*) *Automatic Weighing Machine Co. v. Fearby*, (1893) 10 R. P. C. 447; see also *Dunlop Pneumatic Tyre Co. v. New Ixion Tyre and Cycle Co.*, (1898) 15 R. P. C. 389; 16 R. P. C. 16.

(*d*) *Dunlop Tyre Co. v. Wilson*, (1900) 17 R. P. C. 336.

(*e*) *Betts v. De Vitre*, (1864) 11 Jur. N. S. 11.

(*f*) *The United Telephone Co. v.*

Pattinson, (1889) 6 R. P. C. 140; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302, 308; *Pneumatic Tyre Co. v. West London Rubber and Tyre Co.*, (1898) 15 R. P. C. 129; *Fabriques de Produits Chimique de Thau et de Malhouse v. Lafitte*, (1899) 16 R. P. C. 61; *Welsbach Incandescent Gas Light Co. v. Daylight Incandescent Mantle Co.*, (1899) 16 R. P. C. 354; *Saccharin Corporation v. Dawson*, (1902) 19 R. P. C. 172.

with a certificate that the validity of his patent was questioned in a prior action, will not be awarded full solicitor and client costs in a subsequent action where the only question raised is one of infringement, and the necessity for the subsequent action arises, in the opinion of the Court, from the lax manner in which the patentee's specification was drawn, (*g*) or the specification being clear, the defendant has a plausible case on non-infringement; (*h*) or there are other special reasons which induce the Court, in the exercise of its discretion, not to allow solicitor and client costs. (*i*)

Public Authority.—A public authority party to an action of infringement, if successful, is, under the provisions of the Public Authorities Protection Act, 1893, entitled to solicitor and client costs, if the provisions of that Act apply. (*k*) The provisions of the Act extend not only to a public body acting as principals in the execution of an Act of Parliament or public duty or authority, but also to the individual subordinates carrying out their mandates. (*l*)

Party and Party Costs.—It is of great importance to litigants who are unsuccessful that they should not be oppressed by having to pay an excessive amount of costs; and it is a rule that the costs chargeable under a taxation, as between party and party, are only those necessary to enable the adverse party to conduct the litigation; any charges merely for conducting litigation more conveniently may be called luxuries, and must be paid by the party incurring them. (*m*)

Experts' Fees.—When scientific evidence is necessary, proper fees to experts will be allowed; (*n*) but only the fees of experts which relate to qualifying to give evidence in the particular case and to attendance in Court for the purpose of giving

Costs—
Public
Authority.
Party and
Party
Costs.
Experts'
Fees.
—

(*g*) *Automatic Weighing Machine Co. v. International Hygienic Society*, (1889) 6 R. P. C. 480; *Automatic Weighing Machine Co. v. National Exhibitions Association*, (1891) 8 R. P. C. 352.

(*h*) *Saccharin Corporation v. Dawson*, (1902) 19 R. P. C. 172.

(*i*) See *Welsbach Incandescent Gas Light Co. v. Daylight Incandescent Mantle Co.*, (1899) 16 R. P. C. 354. In this case the point that the subsequent action was necessitated by the lax manner in which the patentees' specification was drawn was not urged upon the Court. The defendant appealed upon the whole case, and the appeal was allowed with costs in the Court of Appeal and below, 17 R. P.

C. 141.

(*k*) See *Chamberlain and Hookham, Ltd. v. Mayor, &c., of Bradford*, (1900) 17 R. P. C. 762; *Chamberlain and Hookham, Ltd. v. Mayor, &c., of Huddersfield*, (1901) 18 R. P. C. 456; *Harrop v. Mayor of Ossett*, [1898] 1 Ch. 525; *North Metropolitan Tramways Co. v. London County Council*, [1898] 2 Ch. 145; *British Thomson-Houston Co. v. Mayor of Manchester*, (1903) 20 R. P. C. 471.

(*l*) *Bostock v. Ramsey Urban District Council*, [1900] 1 Q. B. 357.

(*m*) *Smith v. Buller*, (1874) L. R. 19 Eq. 475.

(*n*) *Ibid.* 473; *Batley v. Kynock*, (1875) L. R. 20 Eq. 632; *Musgrave v. Hicks*, (1886) 3 R. P. C. 49.

Party and
party costs.

Scientific evi-
dence and
experts' fees.

Costs—
Drawings
and Models.

Three
Counsel.
Shorthand
Notes.

—
Drawings and
models.

evidence should be allowed. Fees which relate to experiments performed to educate an expert apart from the special case should be disallowed. (*o*)

Drawings and Models.—An allowance may also be made in respect of the preparation of drawings or models when they are required; (*p*) but the Court will not order such drawings and models to be given up to the party ordered to pay the costs of them. (*q*) If the drawings and models are not really necessary, no allowance will be made in respect of them on taxation—*e.g.*, where drawings were only used for the purpose of being affixed to the margin of copies of evidence supplied to counsel, the costs of their preparation were disallowed, although the opposite party had asked for and been supplied with copies of them. (*r*)

Three Counsel. **Three Counsel.**—The costs of three counsel may sometimes be allowed it, (*s*) but this should only be done when the case is one of multifarious issues and matters on which different minds might be properly employed, as it were dividing the labour among counsel, they should not be allowed in cases, though of great difficulty, where it is necessary for each counsel to get up the whole case. (*t*)

Shorthand
notes.

Shorthand Notes.—A Judge has no power in the absence of arrangement to order shorthand notes of the evidence to be taken. (*u*) Where shorthand notes are taken it is the usual and proper course for the parties to agree beforehand that the costs of them shall be costs in the cause, or to make some other mutual arrangement as to them. When this is not done the Court will sometimes give the costs of the shorthand notes as part of the costs in the action, and the

(*o*) *Leonardt v. Kallé*, (1895) 12 R. P. C. 306.

(*p*) *Batloy v. Kynock*, (1875) L. R. 20 Eq. 632; *Musgrave v. Hicks*, (1886) 3 R. P. C. 49; *Horrocks v. Stubbs*, (1886) 3 R. P. C. 221.

(*q*) *Horrocks v. Stubbs*, (1886) 3 R. P. C. 241.

(*r*) *Smith v. Buller*, (1875) L. R. 19 Eq. 473.

(*s*) *Incandescent Gas Light Co. v. Sunlight Incandescent Gas Light Co.*, (1896) 13 R. P. C. 347; *Mounet v. Beck*, (1897) 14 R. P. C. 850; *Pneumatic Tyre Co. v. Ixion Patent Pneumatic Tyre Co.*, (1897) 14 R. P. C. 875; *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône*, (1897) 14 R. P. C. 892; *Palmer Tyre, Ltd. v. Pneumatic Tyre Co.*,

(1899) 16 R. P. C. 496; *Bradford Dyers Association v. Bury*, (1901) 19 R. P. C. 127; *Patent Exploitation, Ltd. v. American Novelty and Manufacturing Co., Ltd.*, (1903) 20 R. P. C. 704; *Haskell Golf Ball Co. v. Hutchison*, (1905) 22 R. P. C. 478; 23 R. P. C. 301; *Farbenfabriken vormals Friedrich Bayer v. Chemische Fabrik von Heyden*, (1905) 22 R. P. C. 501.

(*t*) *Leonardt v. Kallé*, (1895) 12 R. P. C. 306.

(*u*) *Hilleary v. Taylor*, (1887) L. R. 36 Ch. D. 262; *Nobel's Explosives Co. v. Anderson*, (1894) 11 R. P. C. 129. As to the relationship between Judges notes and shorthand notes, see *Gammons v. Singer Manufacturing Co.*, (1904) 22 R. P. C. 129.

necessary application should be made at the trial. (*x*) But such an order is only made in exceptional cases. (*y*)

The costs of a shorthand note of a judgment appealed from will generally be allowed by the Court of Appeal. (*z*)

Inquiry as to Damages.—Where a plaintiff succeeds in obtaining an inquiry as to damages or an account of profits, and also obtains the general costs of the action, the Court, as a rule, will not give the costs of the inquiry as well as general costs of the action, but will reserve them, in order that the Judge before whom the inquiry is directed may have full control over the costs, and see that they are not unreasonably exaggerated. (*a*)

But where an undertaking and inquiry as to damages is directed on a successful application for an interim injunction, the usual order provides for the costs, (*b*) and they are not generally reserved. (*c*)

It is the duty of the officer of the Court before whom an inquiry as to damages or an account of profits is heard to take notes of the evidence, and if shorthand notes are taken no costs of them will in the absence of agreement between the parties be allowed. (*d*)

Costs on Higher Scale.—It is provided (*e*) that costs on the higher scale may be allowed either generally in any cause or matter, or as to the costs of any particular application made or business done, in any cause or matter, if on special grounds arising out of the nature and importance or the difficulty or urgency of the case, the Court or a Judge shall, at the trial or hearing, or further consideration of the cause or matter, or at the hearing of any application therein, whether the cause or

Costs—
Inquiry
as to
Damages.
Costs on
Higher
Scale.

—
Inquiry as to
damages.

Costs on the
higher scale.

(*x*) *Earl De La Warr v. Miles*, (1881) L. R. 19 Ch. D. 80; *Bowen v. Centaur Cycle Co.*, (1891) 8 R. P. C. 113; *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 333; *Incandescent Gas Light Co. v. Sunlight Gas Lamp Co.*, (1896) 13 R. P. C. 346; *Monnet v. Beck*, (1897) 14 R. P. C. 850; *Pneumatic Tyre Co. v. Ixion Patent Pneumatic Tyre Co.*, (1897) 14 R. P. C. 875; *Castner-Kellner Alkali Co. v. Commercial Development Corporation*, (1899) 16 R. P. C. 275; *Palmer Tyre Co., Ltd. v. Pneumatic Tyre Co., Ltd.*, (1899) 16 R. P. C. 496.

(*y*) *Ibid.*; *Kelly v. Bayles*, 18 L. R. 13 Ch. D. 693.

(*z*) *Collyer v. Isaacs*, (1882) 45 L. T. N. S. 567; 30 W. R. 71; *London and*

South-Western Ry. Co. v. Groom, (1881) L. R. 20 Ch. D. 589; *Woodward v. Sansom*, (1887) 4 R. P. C. 178.

(*a*) *Stark v. Midland Ry. Co.*, (1881) L. R. 16 Ch. D. 81; *United Telephone Co. v. Fleming (No. 2)*, (1886) 3 R. P. C. 282; *Moss v. Malings*, (1886) 3 R. P. C. 379; *United Telephone Co. v. Faulkner*, (1886) 3 R. P. C. 282 *n.*; *Cole v. Saqui*, (1888) 5 R. P. C. 497; *Needham v. Oxley*, *Seton*, 4th ed. p. 353.

(*b*) *Burdett v. Hay*, (1863) 4 De G. J. & S. 41; *Seton*, 4th ed. p. 172.

(*c*) *Rothwell v. King (No. 2)*, 4 P. O. B. 76.

(*d*) *Unguar v. Sugg*, (1892) 9 R. P. C. 113.

(*e*) S. C. R. (1883) Order lxx. r. 9.

Costs—
Costs on
Higher
Scale.
—

matter shall or shall not be brought to trial or hearing, or to further consideration (as the case may be), so order; or if the taxing officer, under directions given him for that purpose by the Court or a Judge, shall think that such allowance ought to be so made upon such special grounds as aforesaid.

Costs on the higher scale may be given by the Court of Appeal, although refused by the Court below; but the Court of Appeal does not usually allow them, there being no special reason for doing so. (*f*)

Where an action was of a complicated nature, the Court, considering that special industry and learning and much time and expense had been employed in preparing it for trial, directed the taxing-master to allow all or any part of the plaintiff's costs on the higher scale if he thought fit; (*g*) and costs on the higher scale have been allowed in many patent cases, on the ground that the case of the successful party being of exceptional difficulty has involved a protracted examination of witnesses, the calling of expert evidence, or the preparation of drawings and models, (*h*) whether the patent has been previously supported or not; though costs on the higher scale have been refused where complications of the case were due to the unfortunate wording of both an original and an amended specification, (*i*) and in many other cases.

Where costs on the higher scale have been asked for, on the ground that the defendant submitted to an injunction, (*k*) or that important questions were raised, (*l*) or that the defendant did not appear at the trial, (*m*) they have been refused; and it would appear that the fact that the damages claimed

(*f*) *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 310.

(*g*) *Fraser v. Province of Brescia Steam Tramways Co.*, (1887) 56 L. T. N. S. 771; 3 Times R. 587.

(*h*) *Westinghouse v. L. & Y. Ry. Co.*, (1884) 1 R. P. C. 103; *Easterbrook v. F. G. W. Ry. Co.*, (1885) 2 R. P. C. 212; *Watling v. Stevens*, (1886) 3 R. P. C. 43; *Otto v. Steel*, (1886) 3 R. P. C. 120; *Wouham v. May*, (1887) 4 R. P. C. 310; *Kaye v. Chubb*, (1887) 4 R. P. C. 289; *Ellington v. Clark*, (1888) 5 R. P. C. 528; *Edison v. Holland*, (1888) 5 R. P. C. 459; *Blakey v. Latham*, (1889) 6 R. P. C. 29; *Automatic Weighing Machine Co. v. International Hygienic Society*, (1889) 6 R. P. C. 475; *Tweedale v. Ashworth*, (1890) 7 R. P. C. 426; *Farbenfabriken*

vorm F. Bayer & Co., (1891) 8 R. P. C. 389; *Hopkinson v. St. James's and Pall Mall Electric Light Co.*, (1892) 10 R. P. C. 46; *Edison-Bell Phonograph Co. v. Smith*, (1894) 11 R. P. C. 161; *Hookham v. Johnson*, (1897) 14 R. P. C. 525; *Haskell Golf Ball Co. v. Hutchison*, (1905) 22 R. P. C. 478; but see *Leonardt v. Kallé*, (1895) 12 R. P. C. 120.

(*i*) *Wenham Gas Co. v. Champion Gas Lamp Co.*, (1890) 7 R. P. C. 313.

(*k*) *Hudson v. Osgerby*, (1884) 32 W. R. 566.

(*l*) *Grafton v. Watson*, (1884) 51 L. T. N. S. 141; *Cardiff Steamship Co. v. Barwick*, (1885) 53 L. T. N. S. 56.

(*m*) *Peroni v. Hudson*, (1884) 1 R. P. C. 261.

amount to a large sum is not sufficient reason for directing the costs to be taxed on the higher scale. (n) Stay Pending Appeal.

Where an application is made at the trial for costs on the higher scale which is refused, the question may be reserved till after the taxation, and liberty given to apply, so that the successful party may have an opportunity of showing that he has suffered an injustice, if such be the fact, by the taxation having been made on the lower scale. (o)

STAY PENDING APPEAL.

If the party who has been unsuccessful in a patent action intends to enter notice of appeal he may sometimes succeed in obtaining an order from the Court staying the proceedings on the judgment till the hearing and determination of the appeal, (p) though a stay is by no means the general rule. (q) Stay is not usual.

The application must in the first instance be made to the Court below and not to the Appellate Court; (r) but if the Court below refuse to make an order staying proceedings, an application may be made to the Appellate Court, and an application of this nature is not properly an appeal motion, and need not be brought within twenty-one days after the refusal of the Court below. (s) Application for a stay.

Sometimes, pending an appeal, the Court in its discretion will grant a stay of an injunction on the undertaking of the defendant to keep an account, (t) or will grant a stay for a time sufficient to allow of the defendant giving notice of appeal and making an application to the Court of Appeal to stay the injunction or to advance the appeal and stay the injunction till the hearing; (u) and where there is a special Circumstances which induce the Court to grant a stay.

(n) *Spettigue's Trusts*, (1884) 32 W. R. 385; *The Horace*, (1884) L. R. 9 P. D. 86.

(o) *Crampton v. The Patents Investment Co.*, (1888) 5 R. P. C. 282, 404.

(p) *Adair v. Young*, (1879) L. R. 11 Ch. D. 136; *Woodward v. Sansom*, (1886) 3 R. P. C. 366; *Humpherson v. Syer*, (1887) 4 R. P. C. 189; *Proctor v. Bennis*, (1887) 4 R. P. C. 363; *Otto v. Steel*, (1886) 3 R. P. C. 121.

(q) *Edge v. Johnson*, (1892) 9 R. P. C. 142; *Lancashire Explosives Co. v.*

Roburite Explosives Co., (1895) 12 R. P. C. 483.

(r) *Otto v. Lindford*, (1880) L. R. 18 Ch. D. 394; *Cropper v. Smith*, (1883) L. R. 24 Ch. D. 305.

(s) *Cropper v. Smith*, (1883) L. R. 24 Ch. D. 305.

(t) *Hocking v. Fraser*, (1886) 3 R. P. C. 7; *North British Rubber Co. v. Gormully, Jeffery & Co.*, (1896) 13 R. P. C. 691; 14 R. P. C. 283.

(u) *Leeds Forge Co. v. Deighton's Patent Flue and Tube Co.*, (1901) 18 R. P. C. 240.

Stay Pending Appeal.

reason (*x*) the Court, in view of an appeal, orders the taxation of costs, and, if the appeal is not heard before the completion of the taxation, the money to be paid over on the personal undertaking of the solicitor to return it in the event of the appeal succeeding; (*y*) but though this is frequently done it is not the usual order, (*z*) and the refusal of a solicitor to give an undertaking, in the absence of an order, is not a special circumstance entitling the unsuccessful party to a stay. (*a*) Neither is it usual to stay an inquiry as to damages or the taking of an account pending an appeal, (*b*) though frequently a stay is granted in respect of an order for the delivery up or destruction of the defendant's goods. (*c*)

Costs of application for a stay.

Usually the costs of an application for an order to stay proceedings have to be borne by the party making it in any event; (*d*) but sometimes they are made costs in the appeal. (*e*) Where the plaintiffs obtained a judgment granting a perpetual injunction restraining infringement and an account of profits, and the defendant entered an appeal, and moved for an order staying proceedings under the order for an account, the Court thought that, under the circumstances, the proper course was to advance the appeal, but as the plaintiff thereby obtained a benefit the costs of the application should be costs in the appeal. (*f*)

(*x*) *Pneumatic Tyre Co. v. East London Rubber Co.*, (1897) 14 R. P. C. 590.

(*y*) *Ticket Punch Register Co. v. Colley's Patents*, (1895) 12 R. P. C. 10.

(*z*) Per Lindley, L.J., *Badische Anilin und Soda Fabrik v. Johnson*, (1897) 14 R. P. C. 418.

(*a*) *John Vasey, Ltd. v. Walker, Mitchell & Co.*, (1899) 606.

(*b*) *Chadburn v. Mechan*, (1895) 12 R. P. C. 135; *Evans and Taunton, Ltd. v. Hoskin and Sowell, Ltd.*, (1901) 21

R. P. C. 682; *Hyam v. Terry*, (1880) 29 W. R. 32.

(*c*) *English and American Machinery Co. v. Union Boot and Shoe Machine Co.*, (1894) 11 R. P. C. 142; *Howes v. Wobber*, (1895) 12 R. P. C. 470.

(*d*) *Cooper v. Cooper*, (1875) L. R. 2 Ch. D. 493; *Merry v. Nickalls*, (1873) L. R. 8 Ch. App. Cas. 205.

(*e*) *Adair v. Young*, (1879) 11 Ch. D. 6.

(*f*) *Adair v. Young*, (1879) L. R. 11 Ch. D. 136.

INDEX.

INDEX.

ABANDONMENT OF APPLICATION

on, for a patent before advertisement of acceptance of the complete specification the specifications are not published, 145: ii. 13
except in cases under the Convention, ii. 13, 257

ABANDONMENT OF OPPOSITION

does not entitle applicant to succeed, ii. 27

ABRIDGMENTS OF SPECIFICATIONS

publication of, ii. 217
powers of Board of Trade as to, ii. 236

ACCEPTANCE

of application for patent, ii. 6
notice of, ii. 12
effect of, ii. 12
advertisement of, ii. 305
of complete specification, ii. 18
when, must take place, ii. 18
extension of time for, ii. 18
form of application for, ii. 372
effect of, ii. 18, 207
advertisement of, ii. 18
specification is open to public inspection on, ii. 18
no guarantee of validity, ii. 18

ACCESSION OF BRITISH GOVERNMENT

to International Convention, ii. 302
declaration of, ii. 303

ACCIDENT

result of, may be good subject-matter, 6, 32

ACCOUNT—*See also* ACCOUNT OR DAMAGES

assignee of share in profits is entitled to an, from licensee, ii. 112
defendant usually ordered to keep an, when an interlocutory injunction is refused, 439
necessary on petition for extension—*see* EXTENSION OF TERM OF PATENT of fees, salaries, &c., in Comptroller's annual report, ii. 237

ACCOUNT OR DAMAGES

power conferred on Court by Act of 1883 as to, in action of infringement, ii. 215
successful plaintiff may claim, at his election, 494
but not both against same defendant, 494, 501
account against one defendant and damages against another, 494
when damages are preferable to an account of profits and *vice versa*, 495
order, by agreement, for a royalty is sometimes to be preferred to an account or damages, 496

ACCOUNT OR DAMAGES—(continued)

- successful plaintiff may claim, at his election—(continued)
 - distinction between an account of profits and an inquiry as to damages, 495
 - the greater the profit the less may be the damage, and the less the profit the greater may be the damage, 495
- expiry of patent before conclusion of action, 496
- delay and its effect on right to, 496
- plaintiff may be entitled to, though not to an injunction, 496
- omission to ask for, at the trial, 508
- assessment, 497
 - usually extends to acts done within six years prior to action, 497
 - usually goes up to the conclusion of the inquiry, 497
 - is limited to acts done during the lifetime of the patent, 496
 - plaintiff an assignee, 497
 - articles manufactured for export, 497
 - infringements committed within certain periods are not included in, 498
 - prior to publication of complete specification, 498
 - prior to amendment of specification unless the Court is satisfied that the original claim was framed in good faith and with reasonable skill and knowledge, 498
 - after failure to pay fees and before enlargement of time for payment, 498
 - time for payment of amount found due after, 498
 - proof in bankruptcy for amount found due, 500
 - discovery on, of number of infringing articles sold and prices, 498
 - names and addresses of defendant's customers, 498
- account of profits, 499
 - relationship between plaintiff and defendant on the taking of an, 499
 - plaintiff only entitled to actual profits made by defendant's use of the invention, 499
 - true test of profits, 499
 - comparison between profits of defendant's business before and after infringement, 500
 - when plaintiff is in the habit of supplying on royalty articles consisting of patented and non-patented parts, 501
 - scope of, 500
 - against manufacturer does not licence patented article in hands of all purchasers, 494
 - production of documents on order for an, 500
 - interrogatories on order for an, 500
- damages, 501
 - plaintiff must prove damage in fact, before he can be entitled to an inquiry as to, 501
 - usual form of order as to, 504
 - limitation of inquiry as to, in an action on several patents, 487
 - may be recovered against a manufacturer or user, or both, until the full measure has been recovered, 494, 506
 - effect of acceptance of agreed, from manufacturer, 506
 - in respect of infringements committed after a judgment adverse to the patentee and before its reversal on appeal, 507
 - in respect of infringements before amendment of specification, 498: ii. 79, 209
 - in respect of loss of reputation to a patented article, 502
 - reference of an inquiry as to, to a judge and jury, 507
 - in action at the instance of one of several co-owners, ii. 112
 - measure of, 502
 - importance of plaintiff's usual course of dealing with the invention, 503
 - when plaintiff's usual course of business is to grant licences, 503
 - when plaintiff's usual course of business is not to grant licences, 505
 - every sale without licence is a damage to the patentee, 503
 - profit derived by defendant is not necessarily a, 504

ACCOUNT OR DAMAGES—(continued)

damages—(continued)

measure of—(continued)

- contract for supply of infringing articles as, 502
- difficulty in arriving at, when product sold might have been made by process or machine other than the plaintiff's, 505
- reduction of price by the plaintiff, 505
 - consequent on defendant's underselling, 505
 - reduction allowed to defendant in respect of increased sale and business connection, 505
- infringement forming part only of article sold by defendant, 503
- not affected by amount accepted from non-litigants, 502
- user without notice of the patent, 507
- annoyance and vexation caused by necessity for litigation does not affect, 503
- costs of former discontinued action, 507
- cost of inquiry as to, 533
- usually reserved, 533

ACCOUNTS

See EXTENSION OF TERM OF PATENT

ACQUIESCENCE—See also LACHES

- effect of, on right to interlocutory injunction, 427, 428, 430
- as a bar to a perpetual injunction to restrain infringement, 487
- as a total bar to account of profits or damages, 496
- as a partial bar to account of profits or damages, 496
- as a ground for damages in lieu of injunction, 428, 487

ACTION OF INFRINGEMENT—See WRIT; STATEMENT OF CLAIM; PARTICULARS OF BREACHES; DEFENCE; PARTICULARS OF OBJECTIONS; DISCOVERY; INSPECTION; CONSOLIDATION OF ACTIONS; TRIAL; NEW TRIAL; INJUNCTION; ACCOUNT OR DAMAGES; DESTRUCTION OR DELIVERING UP; COSTS

- remedies of patentee in respect of infringements, 333
- two distinct kinds of, 339
 - one based on actual infringement, 339
 - the other on threatened infringement, 400
- proceedings before commencement of, 385
 - usual course, 386
 - plaintiff not bound to rely on promise of an infringer not to repeat infringement, 386
 - Court does not usually notice negotiations prior to action, 386
 - proper course when there are several different infringers, 385
- which is a defence to an action to restrain threats of legal proceedings, 318
- does not lie in respect of infringements committed before acceptance and publication of complete specification, ii. 12
- more than one patent may be put in suit, 394
- commenced after expiration of the patent, 496
- "passing off" may be sued for in, 334
 - also infringement of copyright, 334
- recovery of royalties may be asked for alternatively in, ii. 155
- registration of assignment condition precedent to right to sue, *quæry*, ii. 128
- survival of right of, to tenant in common, ii. 111
- amendment of specification after, ii. 82
- discontinuance of, 513, 520
- effect of failure to prove infringement in one, upon a second, in respect of same patent but against different defendant, 385

ACTION TO RECOVER ROYALTIES

See ROYALTIES

ACTION OF REDUCTION

- proceedings for revocation are in Scotland in the form of an, 293

ACTION TO RESTRAIN THREATS OF LEGAL PROCEEDINGS
See THREATS OF LEGAL PROCEEDINGS

ACTS

See STATUTES

ADDITION

See COMBINATION

ADDRESS

correction of, 293

ADDRESS FOR SERVICE

must accompany application, ii. 305
 also notice of opposition, ii. 308

ADEQUATE REMUNERATION

See EXTENSION OF TERM OF PATENT

ADMINISTRATOR

may apply for patent, 5
 may petition for extension of term of patent, ii. 162

ADMISSION OF INFRINGEMENT

effect of, and undertaking not to repeat on the costs of action, 511
 also on plaintiff's right to an injunction, 483

ADVANTAGE

production of a new, is not *per se* sufficient to support a patent, 67, 79,
 83, 98

ADAPTIVE SKILL

mere, in manufacture is not invention, 42

ADVERTISEMENT

of acceptance of application, ii. 305
 of acceptance of provisional specification, ii. 305
 of acceptance of complete specification, ii. 18, 305
 of request for leave to amend specification, ii. 85
 of amendment of specification, ii. 209, 311
 of intention to present petition for extension, is necessary, ii. 168
 in the *London Gazette*, 168
 and other papers, ii. 168
 when petitioner is resident abroad, ii. 169
 equitable assignee's name, if co-petitioner, must appear in the advertisements of, ii. 169
 form of, ii. 413
 of day fixed for hearing of petition for extension, ii. 169
 form of, ii. 485
 threats of legal proceedings made by, 309

AFFIDAVIT

for use under Act of 1883, form of, ii. 307
 in support of order for inspection, 450, 451
 further, of documents, 448
 of advertisement of intention to present a petition for extension must accompany the petition, ii. 169
 made from information and belief, 437

AGENT—See also PATENT AGENT

any one may act as an ordinary agent in the matter of obtaining a patent,
 ii. 3
 application cannot be signed by, ii. 2
 forms subsequent to application may be signed by, ii. 2
 appointment of, form of, ii. 348
 rights of, of assignor when the right to use the invention is reserved, ii. 110
 licensee manufacturing by his, ii. 142

AGENT—(continued)

mere, cannot maintain action of infringement in his own name, 388
 of Crown authorised to use invention on terms, ii. 145
 of foreign inventor may be patentee, 19
 of prior patentee cannot oppose grant of patent, ii. 35
 infringement by, 389

ALIEN

as patentee, ii. 19
 rights of, ii. 19
 enemy cannot be patentee, 20
 query patent could be held in trust for, 20
 communications from abroad by, 16

ALLOWANCES

mentioned in Comptroller's annual report, ii. 237
 to credit of petitioner for extension—*See* EXTENSION OF TERM OF
 PATENT

AMBIGUITY

See LICENCE ; SPECIFICATIONS

AMBIT OF CLAIM

for carrying a new principle into effect, 51
 for carrying an old principle into effect, 53
 for a process, 62
 licensee not estopped from disputing, ii. 148, 149
 affected by documents which do not amount to publications, 153, 285
 may extend to proportions of ingredients not specifically mentioned, 212
 may extend to essence of invention though not specifically mentioned,
 280
 fixed by patentee, 335
 what is outside, is disclaimed, 336

AMENDMENT—*See also* AMENDMENT OF THE SPECIFICATIONS

of application may be required by Comptroller, ii. 7, 204
 of application which comprises more than one invention, ii. 8
 of notice of opposition to grant of patent, ii. 25
 of particulars of breaches, 396
 of particulars of objections, 413, 302
 of documents not provided for by Acts of 1883-1902.. ii. 315

AMENDMENT OF THE SPECIFICATIONS

patent otherwise void may sometimes be cured by, ii. 62
 second amendments,
 original specification not considered on application for, ii. 72
 are discouraged, ii. 89
 necessity for, should be avoided, ii. 62
 not necessarily evidence of prior invalidity, ii. 65
 adverse consequences of, ii. 62
 discretion of Comptroller and law officer as to allowing, ii. 65
 prohibition does not lie to Comptroller or law officer, ii. 65
 leave to amend, no guarantee of validity, 65
 is conclusive, ii. 88
 except in case of fraud, ii. 88
 as evidence of prior invalidity, ii. 65
 effect of application for, by defendant to action under s. 32 of Act of
 1883.. 313
 amended specification takes the place of the original, ii. 66
 disconformity after amendment is fatal, ii. 65
 notification of, to be entered on Register of Patents, ii. 56
 advertisement of, ii. 209, 311
 delay may be a bar to, ii. 77
 drawings may be inserted on, ii. 78
 after action for infringement, ii. 82
 after order for revocation, ii. 82

AMENDMENT OF THE SPECIFICATIONS—(continued)

- after action adverse to defendant removes the estoppel in a subsequent action, 408
- injunction obtained before, cannot be enforced after, 490: ii. 82
- actions after, in respect of infringements committed before, ii. 78
 - statutory provisions as to, 209
- certain amendments only are allowable, ii. 64
 - defects inconsistent with intention to fully specify the invention cannot be cured by, ii. 69
 - extension or substantial variation of claim by amendment is not allowable, ii. 65, 71, 72
 - law officer's decision is final as to fact of, ii. 66
 - practice when opposition in doubtful cases, ii. 67
 - examples, ii. 68
 - imputations of disadvantages in prior patents are not allowable on amendment, ii. 66
 - allowable amendments, ii. 63
 - prior to Act of 1883.. ii. 63
 - under Act of 1883.. ii. 64
 - no action or petition pending, ii. 64
 - pending action for infringement or petition for revocation, ii. 65
 - disclaimer, ii. 70
 - definition of, ii. 70
 - object of an allowable, ii. 70
 - which removes an ambiguity is allowable, ii. 72
 - e.g.*, a limitation to one of two possible meanings, ii. 73
 - rule in *Seed v. Higgins*, ii. 73
 - which removes an insufficiency of specification is not allowable, ii. 72
 - but *query* in case of communicated inventions, ii. 72
 - which extends the claim is not allowable, ii. 71
 - i.e.*, which extends the total grant as distinct from the extension of an individual claim, ii. 71
 - is not a claim to residue, ii. 74
 - residue is not construed by, ii. 74
 - but reference may be had to the original, ii. 75
 - word, construed narrowly in s. 19 of Act of 1883.. ii. 90
 - correction and explanation, ii. 75
 - good reason for, must be shown, ii. 75
 - function of a legitimate, ii. 76
 - ambiguity may be removed by, ii. 76, 77
 - but specification cannot be rewritten, ii. 76
 - or subsequently acquired information added, ii. 76
 - insertion of drawing may be allowed, ii. 78
 - clerical errors, ii. 76
 - jurisdiction of Master of the Rolls in matter of, ii. 76
 - s. 18 of Act of 1883 applicable whether patent is sealed or not, ii. 77
- conditions for the benefit of the public are sometimes imposed when leave is given for, ii. 78
 - e.g.*, no action to be brought in respect of infringements committed before a certain date, ii. 78
 - effect on continued user of article made prior to date fixed, ii. 78, 80
 - or in respect of particular infringements, ii. 78
 - to protect persons who have embarked capital on the strength of an imperfect patent, ii. 79
 - right to bring actions on patents not the subject of the application is not affected by, ii. 80
 - marking of articles in respect of which no action is to be brought, ii. 80
- when leave for, has been given, action for infringement may be founded on the amended specification, though the amendment has not been actually made, ii. 81
- retrospective effect of, ii. 81

AMENDMENT OF THE SPECIFICATIONS—(continued)

retrospective effect of—(continued)

use of amended specification in proceedings pending at the time of amendment, ii. 81

practice as to,

before acceptance of complete specification, ii. 16, 17

after acceptance of complete specification, but before patent is sealed, ii. 17, 29, 49, 62

at hearing of applications for patents before law officer, ii. 29, 49

after patent is sealed, ii. 62

no action for infringement or petition for revocation pending, ii. 83

s. 18 of Act 1883 applies, ii. 83

applicant, who may be, ii. 85

request, must be signed by, ii. 85

reasons for, must be stated in writing, ii. 69

but form no part of the specification when amended, ii. 70

nor is leave refused merely on ground of insufficiency of statement of, ii. 70

advertisement of, ii. 85

opposition, ii. 86

notice of, necessary, ii. 86

locus standi of opponent, ii. 87

postponement of opposition to grant of a patent till hearing of, ii. 63

evidence, ii. 86

when and how to be filed, ii. 86

hearing, ii. 86

personally or by agent, ii. 84

objection to *locus standi* of opponent, ii. 87

decision when there is no opponent or opponent does not appear, ii. 88

appeal from Comptroller, ii. 86, 87

law officer's decision is final, ii. 87

Comptroller may be heard on, ii. 88

leave to amend is conclusive, ii. 88

except in case of fraud, ii. 83

costs, ii. 88

Comptroller has no power over, ii. 88

law officer has control over, ii. 88

pending action or petition, ii. 89

Comptroller does not usually give or receive, on appeal, ii. 89

return of stamp on appeal, ii. 90

effect of commencement of action for infringement or, petition for revocation before application under s. 18 is disposed of, ii. 92

pending action for infringement or proceeding for revocation, ii. 90

meaning of, ii. 91

amendment by mere disclaimer only is allowable, 307 : ii. 92

s. 19 of Act of 1883 applies, ii. 92

leave of the Court or a Judge is necessary, ii. 93

"Court" defined, ii. 92

powers of Court of Appeal and House of Lords, ii. 92

how obtained, ii. 93

notice of motion for leave of Court or a Judge, ii. 895

plurality of applications in same action or petition, ii. 94

several actions or petitions pending, ii. 94

discretion of a Court or a Judge, ii. 94, 99

refused when it is clear the proposed disclaimer would not validate the patent, ii. 100

no rules as to terms imposed when leave is granted, ii. 95

terms imposed in particular cases, ii. 95

when Court does not impose terms the Comptroller or law officer does not usually do so, ii. 100

AMENDMENT OF THE SPECIFICATIONS—(continued)

practice as to—(continued)

after patent is sealed—(continued)

pending action for infringement or proceeding for revocation—
(continued)

s. 19 of Act of 1883 applies—(continued)

leave of the Court or a Judge is necessary—(continued)

procedure after leave of the Court or a Judge has
been obtained, ii. 100action or petition commenced after application made under
s. 18 of Act of 1883.. ii. 93

form of application for leave to amend, ii. 355

form of opposition to amendment, ii. 856

order for leave to amend pending action for infringement,
ii. 444

pending petition for revocation, ii. 445

AMOUNT OF INVENTION*See* SUBJECT-MATTER**ANALOGOUS APPLICATION***See* NEW USE OF OLD APPLIANCES**ANALOGOUS USE**

prior, may or may not be publication, 116

ANTICIPATION—See also NOVELTY ; PUBLICATION

distinction between, and publication, 117

distinction between, and issue of subject-matter, 460

statement of desirability of a result is not an, 111

mere scientific curiosity is not, 111

combination capable of yielding an unobserved result is no, of an invention
which consists in perceiving and utilising it, 111what would be an infringement, if of later date than a patent, is not
necessarily an, 152prior document is no, unless all essential features of the invention are
disclosed, 151

combined effect of different prior documents, 154

mosaic of extracts from different prior documents no, 155

APPEAL

from Comptroller to law officer

practice on, ii. 323—*See* LAW OFFICERS' RULES

from judgment in action of infringement, 482

procedure on, 482

security for costs of, 482

when appellant is bankrupt, 483

fresh evidence on, 306, 416, 483

amendment of particulars so as to admit, 416

issues abandoned below are not allowed to be raised, 484

effect of defendant's right to petition for revocation, 306

costs of, 483

decision on fact as well as law may be reversed on, 485

decision of several points on, when one is sufficient, 485

practice as to, 486

particulars of objections may be considered on, though only issue is
infringement, 485

new trial may be ordered on, 481

stay of proceedings pending, 535

absence of plaintiff abroad insufficient ground for postponing, 583

judgment for appellant with costs, 486

form of notice of, to Court of Appeal, ii. 400

APPLICANT FOR PATENT

any person may be an, alone, 4: ii. 4

if he can make the necessary declaration, 4

who may be a joint, 4

disagreement as to form of specification by joint applicants, ii. 18

APPLICANT FOR PATENT—(continued)

- foreigner who has previously applied abroad, ii. 19
 - preference given to, 8: ii. 19
- form of application must be signed by, ii. 2
- entitled to notice of opposition, ii. 24
- alien enemy, 20
- infant, 5
- legal representative of deceased inventor, 5
- lunatic, 5
- married woman, 5
- joint inventors should all be, 12
- persons disqualified from being, 19
- rival applicants, ii. 34
- death of, before sealing of patent, 5
- rights of, after acceptance of complete specification and before sealing of patent, ii. 12

APPLICATION FOR PATENT—See also APPLICANT FOR PATENT; SPECIFICATIONS; OPPOSITION

- statutory provisions for, ii. 202
 - forms of, ii. 345-349
- interest of an inventor in the invention before making, ii. 105
- delay in making, effect of, 133: ii. 102
- delay in making, is undesirable, 133: ii. 102
- joint inventors must concur in the same, 12
- in fraud of true and first inventor, ii. 55
- by legal representative of deceased true and first inventor, 5
- subsequent, before a prior, is sealed for the same invention, ii. 17
- concurrent, ii. 33
- form of, must be signed by the applicant, ii. 2
 - subsequent forms may be signed by an agent, ii. 2
- how to be made, ii. 4
 - invention original, ii. 4
 - communicated from abroad, ii. 4
 - partly original and partly communicated from abroad, ii. 4
- to be left at, or sent by post to, the Patent Office, ii. 4
 - with a declaration and specification, ii. 5
 - provision for persons incapable of making declaration, ii. 5
 - specification may be provisional or complete, ii. 5
 - form of declaration to be used, ii. 5
- one invention only should be included in, ii. 6
 - inclusion of more than one invention is no objection to validity, ii. 6
- abandonment of,
 - specifications are not published on, 145: ii. 13
 - except in cases under the Convention, ii. 13, 257
- conditions may be imposed on grant of patent, ii. 28—see also CONDITIONS
- examination and acceptance of, ii. 6
 - examiners appointed by statute, ii. 6
 - reference of application to, ii. 6
 - duties of, ii. 6
 - reports of, are not published, ii. 16
 - Comptroller acts on report of, ii. 7
 - and may require amendment of the specification, ii. 7
 - appeal to law officer from Comptroller's decision, ii. 7
 - practice on, ii. 7
 - costs of, ii. 8
 - objections which may be taken by Comptroller, ii. 6
 - as to title, ii. 8
 - as to inclusion of more than one invention, ii. 8
 - test of one invention, ii. 9
 - example of amendment by limitation to one invention, ii. 9
- notice of acceptance of, ii. 12
 - effect of, ii. 12
- advertisement of acceptance of, ii. 305
- rights of foreigner, who has applied abroad, as to, ii. 19
 - foreign corporation, ii. 19, 21

APPLICATION FOR PATENT—(continued)

rights of foreigner, who has applied abroad, as to—(continued)

are personal, ii. 21

only foreigner who has actually applied abroad is recognised, ii. 21

effect of abortive application abroad, ii. 21

practice under s. 103 of Act of 1883.. ii. 22

minor differences in English and foreign specification allowable,
ii. 22

second, in respect of same invention, ii. 17

costs,

Comptroller no statutory power over, ii. 28

law officer has statutory power over, ii. 28

APPORTIONMENT

of costs in action of infringement, 514

when plaintiff succeeds on validity, but fails on infringement, 514

when plaintiff fails on validity, but succeeds on infringement, 517

ARBITRATION ACT, 1889

applies to patent actions, 473

arbitration between parties before action no estoppel, 411

ARKWRIGHT'S CASE

contrasted with Dolland's case and Tennant's case, 116

ARMS (ROYAL)

unauthorised use of, incurs a penalty, ii. 12

ART

subject-matter must be an, 24

producing vendible articles, 25

not to be used for illegal purposes, 25: ii. 6, 232

rediscovery of a lost, as subject-matter, 118

interpretation of terms of, 144, 265, 266, 267, 268, 284, 458

ARRANGEMENT OF PARTS

general, may be subject-matter, 50

distinguished from a principle, 50

ASSESSOR

trial of action of infringement with aid of an, 474

power of Court to order, 474

Court must order, on request of either party, 474

hearing of petition for revocation with aid of an, 305

remuneration of, 474

statement by, of his opinion to the Court, 474

effect of opinion of, on judgment of the Court, 474, note (k)

ASSIGNEE

included in the term "patentee" as used in the grant, ii. 105

account of profits or inquiry as to damages where plaintiff is an, 497

under no obligation to maintain the patent, 107

covenants for protection of co-owners are advisable on an assignment of a
patent, 109

of share in profits entitled to an account from a licensee, 112

equitable, of exclusive licensee not estopped from disputing the patent, 150

from liquidator of limited company, 126

rights of, 122

as to action of infringement, 122

quæry registration a condition precedent, 122

amendment of specification, ii. 85, 123

petition for extension of term of patent, ii. 123, 163

not so favourably received as original patentee on, 163

who has advanced capital for the development of the invention

is more favourably received on, than one who has not, ii. 164

under prior patent has *locus standi* to oppose a grant of a subsequent

patent, ii. 34

death of, ii. 125

ASSIGNMENT OF PATENT

- origin of power to assign, ii. 101
 - consists in the terms of the grant, ii. 105
 - rights of an author, ii. 101
 - rights of an inventor, ii. 101
 - monopoly exists only by virtue of the grant, ii. 105
 - interest in an invention before the grant of a patent, ii. 105
 - form of letters patent, ii. 105, 378
- to corporations, ii. 106
- for a district, ii. 106
 - difference between legal interest of an assignee and a licensee, ii. 109
- to Secretary of State for War, ii. 108
- different inventions included in one patent, ii. 109
- to several assignees, ii. 110
 - rights of co-owners, ii. 111
- account of profits or damages where there has been an, ii. 497
- does not fix assignee with obligation to maintain the patent, ii. 107
 - i.e.*, to pay renewal fees when consideration is a royalty, ii. 107
- equitable, may arise from conduct, ii. 107
- exclusive licence may amount to an, ii. 143
- estoppel on, ii. 115
- future inventions, ii. 113
- partnership may be created by, ii. 124
- precedent of an, ii. 378
- warranty on, ii. 118
 - with notice of licences, ii. 122
 - with notice of covenants, ii. 121
- may be by deed or act and operation of law, ii. 106
 - by deed, ii. 106
 - no particular form of words necessary, ii. 106
 - consideration, ii. 107
 - covenants in restraint of trade, ii. 109
 - covenant to assign future improvements, ii. 113
 - covenants for protection of co-owners, ii. 111
 - reservation to assignor of right to use the invention, ii. 110
 - agents of assignor, ii. 110
 - form of, ii. 378
 - by act and operation of law, ii. 125
 - death of grantee or assignee, ii. 125
 - death of person possessed of unpatented invention, ii. 125
 - bankruptcy, ii. 125
 - patent granted to undischarged bankrupt, ii. 126
 - seizure by sheriff under writ of *fi. fa.*, ii. 127
- registration of, ii. 127
 - should be immediate, ii. 128
 - practice on, ii. 128
 - quæry* condition precedent to right to sue, ii. 128
 - quæry* has a retrospective effect, ii. 129
- subject to agreement for licence, ii. 122

ASSIGNOR

- covenants in restraint of trade by, ii. 109
- reservation of right to use the invention by, ii. 110
- estoppel,
 - recitals and covenants may effect an, ii. 115
 - from denial of title as against assignee, ii. 116
 - but not from denial of a particular construction of the specification, ii. 116
 - no, against assisting a defendant with evidence, ii. 117
 - of, of licensee as against assignee, 409: ii. 148

ASSISTANT

- employment of, by first and true inventor, 12

ASSIZES

- trial of action for infringement at, 478
- hearing of petition for revocation at, 305

ATTACHMENT

difference between procedure on, and committal, 491

ATTORNEY-GENERAL—See also LAW OFFICER

fiat of, when necessary for presentation of petition for revocation of letters patent, 292, 294
 how obtained, 295
 may be given *nunc pro tunc*, 296
 form of memorial to obtain, ii. 411
 form of, ii. 411
 costs of obtaining, 296
 practice when, is necessary and hearing comes on without it, 296
 may oppose petition for extension of term of patent without notice, ii. 172
 always appears at hearing of petition for extension of term of patent, ii. 173
 but does not give or claim costs, ii. 194

AUTHOR

rights of an, as compared with those of an inventor, ii. 101

BANK HOLIDAY

Patent Office closed on, ii. 315
 Register of Patents closed to inspection on, ii. 316
 leaving documents, paying fees, &c., at Patent Office on, ii. 54, 235

BANKRUPTCY

proof in, of amount found due on taking of account of profits or damages, 500
 devolution of patent on, of patentee, ii. 125
 assignment by trustee in, does not effect an estoppel against a bankrupt patentee in an action brought by the assignee, ii. 118
 patent granted to an undischarged bankrupt, ii. 126
 right of undischarged bankrupt to fruits of an unpatented invention, ii. 126
 action by undischarged bankrupt, 126

BENEVOLENT CONSTRUCTION

of the grant, 277
 of specifications, 273

BOARD OF TRADE

power of, to make and alter rules regulating business of Patent Office, ii. 236
 power of, as to registration of Patent Agents, ii. 249, 338
 power of, to appoint and remove Comptroller and other officers, ii. 232
 Comptroller acts under superintendence and direction of, ii. 232
 power of, to require models on payment, ii. 217
 power of, to regulate fees, ii. 212
 proceedings of, ii. 255
 certificate of, conclusive evidence, ii. 255
 exhibitions certified by, 132: ii. 217, 247
 powers of, in reference to compulsory licences, ii. 136, 137
 form of petition to, for compulsory licence, ii. 358
 how powers of, may be exercised, ii. 255

BODY CORPORATE

may be patentee, 20
 but not alone, 20
 except in case of foreign corporation, 20: ii. 19
 may be an assignee, ii. 106
 and registered as such, ii. 106

BONA FIDES

See SPECIFICATIONS. THREATS OF LEGAL PROCEEDINGS

BREACHES

See PARTICULARS

BRITISH POSSESSION

definition of, ii. 242

BURDEN OF PROOF*See EVIDENCE***CAPITALIST**

may obtain interest in the invention from the first, 4

CARRIER*See INFRINGEMENT***CATALOGUES**

relating to inventions, published by Comptroller, ii. 217

CAVEAT

any person may enter a, against the extension of the term of a patent, ii. 170

CERTIFICATEof Comptroller is *prima facie* evidence, ii. 234

form of, ii. 367

of Board of Trade as to exhibitions, 132: ii. 217, 247

of particulars

necessary on taxation of costs in action on infringement, 513

but not on petition for revocation, 308, 525

query in action to restrain threats, 328

omission to ask for, at the trial, 519

power of Court of Appeal and House of Lords to grant, 519

practice of Court of County Palatine of Lancaster as to, 519

is granted (1) when particulars have been proven; (2) when in the opinion of the Court or a Judge they were reasonable and proper, 520

whether the particulars are of breaches or objections, 520

when defendant admits infringement, 521

when action is discontinued, 513

when action not tried out on all issues, 521

rule that Court will only certify such particulars as materials before the Court enable it to say are reasonable and proper, 521

illustrations of the working of the rule, 521

particulars not proved under a particular issue but necessary to determination of another issue, 524

action in respect of several patents, 524

of payment of renewal fees, ii. 613

form of, ii. 360

form of application for, ii. 360

of Secretary of State for War to effect that invention should be kept secret, ii. 108

of validity, 525

effect of, on costs of subsequent petition for revocation, 525

effect of, on costs of subsequent action, 525—*see Costs*—Solicitor and clients

effect of, in subsequent action to restrain threats of legal proceedings, 328, 525

meaning of "subsequent action," 528

should be pleaded in subsequent action, 528

powers of Court of Appeal and House of Lords as to, 525

discretion of Court or Judge as to allowing solicitor and client's costs on the strength of, 529

illustrations of exercise of, 530

when subsequent defendant does not dispute validity, 530

when may be given, 525

after expiry of the patent, 525

in absence of evidence on issue of validity, 527

where plaintiff fails on issue of infringement, 528

where defendant admits validity on a certain construction of the specification, 528

query in action to restrain threats, 525

on petition for revocation, 525

form of, ii. 403

CESTUIS QUE TRUST

right of, to sue in respect of infringement, ii. 113
 may be made party to action commenced by trustee, ii. 113

CHEMICAL INVENTION

publication of highly scientific, 152
 infringement of patent for, 369

CHRISTMAS DAY

Patent Office closed on, ii. 315
 Register of Patents not open to inspection on, ii. 313
 leaving documents, paying fees, &c., at Patent Office on, ii. 54, 235

CIRCULARS

threats of legal proceedings by, 309, 314, 317

CLAIM

See SPECIFICATIONS

CLASSES OF INVENTIONS, 43**CLERICAL ERRORS**

See ERRORS

CLERK OF FOREIGN INVENTOR

may be patentee, 19

COKE, SIR EDWARD

chapter of monopolies by, 26
 commentary on ss. 5 and 6 of Statute of Monopolies, 26
 commentary by, on words "mischievous to the State by raising the prices of commodities at home," in 21 Jac. 1, c. 3, s. 6.. 159

COLONIES

prior use in, no bar to English patent, 135
 provisions under Acts of 1883 for, and India, ii. 233

COLOURABLE IMITATION

infringement by, 339, 363
 is infringement though substitution of equivalents may not be, 363
 objection to the use of the terms "colourable," "colourably," 339

COMBINATION

is subject-matter, 67
 if result is new, better or cheaper article, 69
 whether parts are new or old, 67, 71
 immateriality of novelty of parts, 71
 merit largely depends on result produced, 67
ratio decidendi of the cases, 67
 new combination may consist in
 omission of a part or parts from an old combination, 71
 addition to an old combination, 71
 substitution of new equivalents for old parts, 71, 73
 examples of patents void for substitution of known equivalents, 78
 rearrangement of old parts, 72, 367, 368
 infringement of patent for, 349—*see also* INFRINGEMENT
 by taking substance, 350
 special claim for subsidiary part, 351
 by substitution of equivalents, 353
 not known at the date of the patent, 353
 effect of public knowledge on question of, 354
 two classes of cases, 356
 Curtis *v.* Platt as type of one class, 356
 Proctor *v.* Bennis as type of the other class, 358
 correct application of the doctrine of, is a matter of difficulty in some cases, 366
 illustrations, 367

COMBINATION—(continued)

infringement of patent for—(continued)

by substitution of equivalents—(continued)

colourable imitation is infringement though substitution of equivalents may not be, 339, 363

new parts of new, are subject-matter for separate patents or claims, 71, 256

COMMERCIAL SUCCESS

as a test of invention, 9, 12, 32

not necessarily evidence of utility, 466

want of, not necessarily evidence of non-utility, 466

COMMERCIAL UTILITY

as it affects validity, 163, 466

COMMISSION

credited to petitioner on application for extension of term of patent, ii. 183

COMMITTEE OF LUNATIC

declaration by, 5

COMMON KNOWLEDGE

effect of, on question of invention or no invention, 39, 103, 155, 418, 460

effect of, on construction of specification, 283, 285, 354, 467

as objection to validity, 418

how the plea should be raised, 419

distinction between issue of, and prior publication, 420

limitation as to what may be referred to under plea of, 420

particulars of, not requisite if ambit of claim only and not validity of patent is attacked, 419, 467

COMMON LAW

declaration of, by Statute of Monopolies, 1

cases on subject-matter prior to Statute of Monopolies, 23

novelty as a requisite at, 105

preserved by Statute of Monopolies, 107

utility a, requisite, 157

COMMUNICATION

by one to another in the realm not subject-matter, 18

made abroad may be subject-matter, 18

patents granted under Act 1883 for, 18

by one foreigner to another abroad good subject-matter, 19

foreigner's application for patent, ii. 19

rights under s. 103 of Act 1883 are personal, ii. 21

amendment of specification in case of, invention, ii. 72

extension of term of patent in case of, invention, ii. 165, 183, 187

sufficiency of specification in case of, invention, 19

COMMUNICATOR

as true and first inventor when the invention is a foreign one, 16

the invention is made in the realm, 18

extension of term of patent on petition of, ii. 165, 183, 187

COMPANY

"person" includes, ii. 242

may be registered as proprietor, 20

as sole patentee, 20

may be joint original patentee, 20

as petitioner for extension of term of patent, ii. 164

directors of, personally liable for infringement, 389

patent owned by limited, vests in Crown on dissolution of, ii. 126

COMPLETE SPECIFICATION

See SPECIFICATIONS

COMPTROLLER

- as defined by Act of 1883.. ii. 242
 - is appointed by the Board of Trade, ii. 232
 - may be removed by Board of Trade, ii. 232
 - acts under superintendence and direction of the Board of Trade, ii. 232
- certificate of, *prima facie* evidence, ii. 59, 234
- discretion of Crown as to granting patents is exercised through the, ii. 1
 - on the report of examiners with regard to acceptance of applications, ii. 7
 - subject to appeal to the law officer, ii. 7
 - practice on, ii. 7
 - power to refuse patent for invention to be used for illegal or immoral purpose, ii. 6, 232
- no inquiry as to age, coverture, or sanity of an applicant by, 5
- hearing of opposition by, ii. 26
- reopening of cases decided by, ii. 29, note (*m*)
- discretion of, as to amendments of specifications, ii. 65
 - does not usually impose terms when the Court has not done so under s. 19 of Act 1883.. ii. 100
- exercise of discretionary power of, subject to appeal, ii. 7, 234
- form of notice that hearing before, will be attended, ii. 364
- form of certificate of, ii. 367
- power of, to take direction of law officer, ii. 234
 - to refuse application or to require amendment, ii. 7, 232
 - to impose conditions on granting leave to apply to amend specifications, ii. 78
 - to correct clerical errors, ii. 77
 - none over costs of proceedings on application for patent, ii. 8
 - to require amendment of specification on report of examiner, ii. 14
 - to allow amendment of specification at hearing of application for a patent, ii. 49
 - none over costs of application for leave to amend specification, ii. 88
- required to publish illustrated journal and report of cases, ii. 55
 - also annual report, ii. 237

COMPULSORY LICENCES

- statutory provisions as to, ii. 137
- patentee may be compelled to grant, ii. 136
- obligation of patentee to use invention or allow others to do so, 161, 174
- Board of Trade considers petition for, ii. 137
- form of application for grant of, ii. 357
- form of petition for grant of, ii. 358
- form of opposition to grant of, ii. 359
- grounds for grant of, ii. 137
- practice on application for, ii. 139
- revocation of patent in lieu of, ii. 137
- practice as to, ii. 139
 - rules, ii. 313, 332
- enforcement of order for, ii. 138

CONDITIONS

- of grant of patent, 174: ii. 102
 - non-compliance with, a ground of revocation, ii. 297
- special, may be imposed by Comptroller or law officer on application, ii. 28
- licence limited by, ii. 142
- infringement by breach of, 377

CONSENT

- judgment by, 480
- revocation by, 305

CONSIDERATION

- disclosure of invention and means of performing it as, for a patent, 105, 112, 158, 166, 174
- for a patent is entire, 112
- partial failure of, for patent is fatal to validity, 112, 166

CONSIDERATION—(continued)

- novelty as part of, for a patent, 105
- utility as part of, for a patent, 157
- not necessary for licence by deed, 147 .
- no restriction as to, for licence, 147
- usual, for licence, 147

CONSIGNEE

- of goods shipped from abroad, defendant to action of infringement, 391

CONSOLIDATION OF ACTIONS

- can be obtained only at the instance of the defendants, 481
- several actions on the same patent, 480
- several actions by different plaintiffs against the same defendant, 481
- time for, 481
- how to be effected, 481

CONSTRUCTION

- of letters patent, 331
- of specifications —see SPECIFICATIONS

CONTEMPT OF COURT

- breach of injunction a, 490
 - motion for committal, 490
 - proof necessary on, 490
 - expiry of patent, an answer to, 492
 - is procedure whereby to determine whether acts done since injunction, similar though not the same as those done before, are a breach of the injunction, 492
 - solicitor and client's costs on, 493
- advertisements relative to *ex parte* statements in Court which are, 493
 - advertisements and statements relative to evidence and expense of trial or appeal which are not, 493
- effect of s. 32 of Act of 1883 on rule as to comment pending litigation, 316
- publications tending to influence result of pending suit, 493

CONTRACT

- breach of, no justification for infringement of patent, 331
- for supply of infringing articles as measure of damage, 502
- distinction between construction of a, and a specification, 207
- patent considered as of the nature of a, 106, 172, 202, 331

CONTRACTORS

- of Crown authority, right to use invention on terms, ii. 145

CONVENTION (INTERNATIONAL)—See INTERNATIONAL CONVENTION

- for protection of industrial property, ii. 235
 - final protocol, ii. 297
 - accession of her Majesty's Government to, ii. 302
 - declaration of acceptance of, ii. 303

CO-OWNERS OF PATENT

- should be joint petitioners on application to amend a specification, ii. 85
 - but amendments may be allowed in absence of unregistered, ii. 85
- covenants for protection of, ii. 111
- disputes between, on an application for extension of the term of a patent, ii. 182
- rights of,
 - to sue in respect of infringements, ii. 111, 113
 - to sue in respect of royalties, ii. 112, 113
 - to personal use of the invention, ii. 113
 - to grant licences, ii. 113
 - trustee and *cestuis que* trust, ii. 113
 - original cograntees, ii. 110

COPIES

- of accounts on petition for extension, ii. 171
- of deeds, licences, &c., to be supplied to Comptroller, ii. 212

COPIES—(continued)

- sealed, to be received in evidence, ii. 233
- certified, of documents in Patent Office, ii. 313
- of Patent Office publications, presentation of, ii. 235

CORPORATION—See BODY CORPORATE

- sole as patentee, 20
- may be joint patentee, 20
 - but not sole original patentee, 20
 - except in case of invention communicated from abroad, 20
- may be assignee, ii. 106
 - and registered as such, ii. 106

CORRECTION

See AMENDMENT OF THE SPECIFICATIONS

COSTS

- of application for patent
 - Comptroller has no power over, ii. 29
 - law officer has power over, ii. 29
- of amendment of specification, ii. 88, 195
- of opposition to grant of patent, ii. 29
- of action to restrain threats of legal proceedings, 330
 - caused by trying action in two forms, 330
- of action of infringement, 510
 - effect of House of Lords judgment with costs, 486
 - discretion of the Court or a Judge, 510
 - ignorance of the patent does not exempt from liability, 511
 - circumstances which will induce the Court to deprive a successful plaintiff of, 512
 - defendant admitting and undertaking to discontinue infringement, 512
 - oppressive conduct on the part of the plaintiff, 512
 - discontinuance, 513
 - apportionment of, 514
 - where plaintiff succeeds on validity but fails on infringement, 514
 - where plaintiff fails on validity but succeeds on infringement, 517
- drawings, 532
- inquiry as to damages, 533
 - usually reserved, 533
- expert's fees, 531
- further and better particulars, 412
- interest on, returned as result of an appeal, 486
- issues, abandoned at the trial, 514
 - separate, 514
- motion to commit for breach of injunction, 493
- models, 532
- on the higher scale, 533
 - illustrations of cases in which, are given, 534
 - on appeal though refused below, 534
 - reservation of question as to, till after taxation, 535
- party and party, 531
- scientific evidence, 531
- security for, of appeal, 482
 - when appellant is bankrupt, 483
- shorthand notes, 532
 - usual agreement as to, 532
- solicitor and client's, 529
 - Public Authority entitled to, 531
 - not always given though certificate of validity has been obtained in a former action, 529
 - discretion of the Court or a Judge, 529
 - illustration of exercise of the, 530
 - when defendant does not dispute validity, 530

COSTS—(continued)

of action of infringement—(continued)

taxation

- agreed inspection, 451
- certificate of particulars, 518
 - is necessary on taxation, 518
 - omission to ask for, at the trial, 519
 - power of Court of Appeal and House of Lords to grant, 519
 - practice of Court of County Palatine of Lancaster, 519
 - is granted (1) where particulars have been proven; (2) where in the opinion of the Court or a Judge they were reasonable and proper, 520
 - where action is discontinued, 521, 523, 524
 - in case of judgment by default, 523
 - where action is not tried out on all the issues, 521
 - rule that Court will only certify such particulars as the materials before the Court enable it to say are reasonable and proper, 521
 - illustrations of the working of the rule, 521
 - particulars not proved under a specific issue but necessary for the decision of another issue, 524
 - action in respect of several patents, 524
 - certificate of validity in former action and its effect on costs of a subsequent action, 525, 528
 - should be pleaded in subsequent action, 528
 - meaning of "subsequent action," 528
 - discretion of taxing-master as to, pending appeal, ii. 155
 - of fresh evidence on appeal, 583

of three counsel, 532

of interrogatories, 443

must be secured, 443

of petition for revocation, 308

respondent out of jurisdiction cannot be compelled to give security for, 304

certificate of particulars is not necessary on taxation, 308, 525

of threats action, 330, 525

COUNSEL

joint petitioners for revocation must appear by same, 305

only two on each side heard on petition for extension, ii. 170

unless opponents have distinct and separate interests, ii. 170

costs of three, 532

COUNTY COURT

no jurisdiction to try actions in which the validity of a patent is in issue, 473

action to recover royalties may be brought in, 473

COURT

as defined by Act of 1883.. 292: ii. 242

leave of, or a Judge is necessary for the amendment of specifications pending action of infringement or petition for revocation, ii. 90

how obtained, ii. 93

terms usually imposed on application for, ii. 95

power of, to compel inspection, 542

rectification of Register of Patents by, ii. 59

COURT OF APPEAL

discretion of, as to admitting evidence not within the particulars, 455

jurisdiction of, to grant certificate of particulars, 519

jurisdiction of, to grant certificate of validity, 525

COURT OF COUNTY PALATINE OF LANCASTER

jurisdiction of, to try patent actions, 473

to grant leave to apply to amend specifications pending action or petition, ii. 92.

to grant an account of profits or inquiry as to damages, 501

COURT OF COUNTY PALATINE OF LANCASTER—(continued)

jurisdiction of, to try patent actions—(continued)

- to certify as to particulars, 519
- to grant certificate of validity, 526
- to hear petition for revocation, 292

COVENANTS

- acceptance of royalties from infringers and breach of, not to grant further licences, ii. 143
- assignment with notice of, ii. 121
- usual, inserted in licences, ii. 142, 147
- recovery of royalties paid without knowledge of breach of, ii. 154
- estoppel in virtue of, implying validity, ii. 148
- in restraint of trade by assignee and their enforcement, ii. 109
- to assign future improvements, advisable for protection of assignee, ii. 113
 - difficulties in drafting and interpretation of, ii. 114
- for protection of co-owners, advisable on assignments, ii. 111
- for title, to grant licences, and for validity are not implied by law, ii. 150

COVERTURE,

- no inquiry as to, on application for patent, 5

CRANE *v.* PRICE

- decision in, doubtful on the facts, 55

CROWN

- discretion of, in matter of granting patents, ii. 1
 - exercised through Comptroller-General and law officers, ii. 1
 - not suspended during minority or incapacity of the sovereign, ii. 1
- authority of, to grant an extension of the term of a patent, ii. 157—*see*
EXTENSION ON TERM OF PATENT
- patent binds the, ii. 145, 214
 - but the Crown has the right to use of inventions on terms, ii. 145
 - procedure to question authority of, or its officers to use an invention,
ii. 146
- patent owned by limited company vests in, on dissolution of the company,
ii. 126
- no merger when a patent vests in the, ii. 126

CURTIS *v.* PLATT

- type of case to which doctrine of infringements by substitution of equivalents is inapplicable, 356, 366
- facts in, 356
- rule in, 358
 - instances of application of, 356 (*j*), 360

CUSTOM HOUSE AGENT

- liability of, in respect of importation of infringing goods, 332

CUSTOMERS

- disclosure of defendants, 446
- notice by plaintiff to defendant's, in infringement action, 316
- threats to, 313
- disclosure of defendant's, on inquiry as to damages, 498
 - motion to commit liquidator for non-compliance with order for, 499

DAMAGES

See ACCOUNT OR DAMAGES; THREATS OF LEGAL PROCEEDINGS

DATE OF LETTERS PATENT

- letters patent bear date as of the day of application, 187: ii. 53, 207
 - except in case of patents granted to foreigners under s. 103 of Act of 1883, which may be ante-dated to date of application abroad, ii. 19

DEATH

- of person possessed of an invention for which no application for a patent has been made, 5: ii. 125
- of person possessed of an invention in respect of which an application for a patent has been made, 5: ii. 207

DECLARATION

- necessary, on application for a patent, 4 : ii. 5
 - provision for persons incapable of making, ii. 5
 - by legal representative of deceased inventor, 5
 - by first importer, 17
- statutory, for use in Patent Office, ii. 5
 - how to be made and subscribed, ii. 5
 - exempt from stamp duty, ii. 6
 - on opposition to grant of patent, ii. 25
 - times for leaving at Patent Office, ii. 25, 26
 - copies of, to be furnished to opposite party, ii. 26
- of acceptance of accession of British Government to International Convention, ii. 303
- that patentee holds as trustee, 16
- of invalidity may probably be obtained in special circumstances, 291

DEDUCTIONS

See EXTENSION OF TERM OF PATENT

DEED

- assignments of patents must be by, failing act and operation of law, ii. 106
 - no particular form of words necessary, ii. 106
- licences by, ii. 132
- necessity for a formal, is question of construction in cases of executory agreements for licences, ii. 133

DEFENCE

- in action of infringement, 401
 - two main defences are open, 401
 - denial of infringement, 401
 - denial of validity, 401
 - alternative pleas of no infringement and acts done under licence are not allowable, ii. 152
 - breach of contract by plaintiff no, 401
 - ignorance no, 337
 - intention no, 336
 - all grounds of, should be stated, 401
 - relation of, to particulars of objections, 402
 - particulars do not stand in the place of pleas, 402
 - and cannot go outside pleas, 402
 - denial of validity on the grounds stated in the particulars of objections is sufficient, 402
 - grounds on which invalidity may be pleaded, 402
 - patentee not true and first inventor, 402
 - invention not subject-matter, 403
 - invention not new, 404
 - invention not useful, 403
 - prior grant, 404
 - insufficiency of specification, 405
 - disconformity, 406
 - any ground on which the patent might, prior to 1884, have been repleaded by *scire facias*, 403
 - fresh issues may, on leave, be raised during the progress of the action, 406
 - estoppel of defendant from denying the validity of the patent, 406
 - arbitration between parties before action, 411
 - decision in former action, 406
 - parties to subsequent action not the same as parties to the former, 406
 - specification amended after former action removes estoppel, 408
 - defendant having submitted to an injunction, 408
 - defendant a licensee, 409
 - defendant an assignor, 409
 - may deny ambit of claim, 409
 - or particular construction of specification, 409 : ii. 116
 - defendant a former partner of the plaintiff, 410
 - agreement between the parties, 410

DEFENCE—(continued)

in action of infringement—(continued)

estoppel of defendant from denying the validity of the patent—(contd.)

assignment by trustee in bankruptcy does not necessarily estop
original patentee, 411

some co-defendants may be estopped whilst others are not, 411

defendant may be estopped on motion for interlocutory injunc-
tion, though not at the trial, 410

inspection for purpose of preparing, 451

precedents of, in action of infringement, ii. 390

in action to restrain threats of legal proceedings, ii. 406

DEFENDANT

to infringement action, 389

not appearing at trial, 479

DEFECTS

what allusions to, in prior inventions are allowable in subsequent speci-
fications, ii. 44

DEFINITIONS

anticipation and publication, 117

British possession, ii. 242

Comptroller, ii. 242

Court, the, ii. 242

Court of Appeal, ii. 242

disclaimer, ii. 70

distinct statement of invention claimed, 249

foreign application, ii. 19

"improvements" as used in title, 73, 117

industrial property, ii. 297

infringement, 335

injunction, in Scotland, means interdict, ii. 220

invention, ii. 220

law officer, ii. 242

legislature, ii. 242

manufacture, 23

novelty and discovery, 116

ordinary skilful workman, 217

patent, ii. 220

"patents" as used in International Convention, ii. 297

patentee, 220

"person" includes "body corporate," ii. 19, 242

"prescribed," in reference to Act of 1883.. ii. 242

public knowledge, 108

public use, 126

"subsequent action," in reference to costs, 528

subject-matter

exhaustive definition of, not possible, 43

by Statute of Monopolies, 3

by Court of King's Bench, 26

"summary conviction" in Ireland, ii. 242

Treasury, the, ii. 242

utility, 162

DEGREE

invention may consist in, 42

DELAY—See LACHES

in applying for a patent is undesirable, 133

in sealing a patent, 52

may be bar to amendment of specification, 77

effect of, on right to account or damages, 496

disentitles plaintiff to interlocutory injunction, 423

what amounts to, 429

may sometimes be explained, 429

examples, 429

no bar to perpetual injunction, 487

DESIGNS

statute law as to, ii. 220

DESTRUCTION OR DELIVERY TO PLAINTIFF OF INFRINGING ARTICLES

power of Court to order, 508
 as alternative remedies, 508
 when infringing article is composite, 509
 marking of infringing articles, 509
 loss caused to defendant by, 510
 question as to, may be reserved, 509
 form of order for, 509

DETAILS

improvements in, made by servant of inventor, 15
 mentioned in complete and provisional specifications may differ, 184, 189
 effect of variations in, on question of infringement, 366

DIRECTOR OF COMPANY

may be personally liable for infringements, 389

DISCLAIMER—See AMENDMENT OF SPECIFICATIONS; OPPOSITION TO GRANT OF PATENT

claim is by implication a, 250: ii. 74
 amendment of specification by, ii. 70
 definition of, ii. 70
 object of allowable, ii. 70
 removal of ambiguity, ii. 72
e.g., limitation to one of two possible meanings, ii. 73
 rule in *Seed v. Higgins*, ii. 73
 insufficiency of specification may not be cured by, ii. 72
 but *query* in the case of communicated inventions, ii. 72
 extension of claim by, is not allowable, ii. 71
i.e., extension of total grant, ii. 71
 sealed copy of, in Patent Office is evidence, ii. 239
 at hearing of opposition to grant of a patent Comptroller sometimes effects the principle that no claim is allowed which is wide enough to include something already patented, by requiring a general or special, ii. 41
 grounds on which required, ii. 42, 46
 general disclaimers are more usual than special, ii. 45
 when special disclaimers are requisite, ii. 44-48
 difference in effect of general and special disclaimer, ii. 48
 difference between a special disclaimer and a general disclaimer in terms of opponent's claim, ii. 48
 opponent seeking special disclaimer must adjure evidence of the state of knowledge, ii. 45

DISCONFORMITY—See also IMPROVEMENT; SPECIFICATIONS; VARIANCE

meaning of, 190
 is fatal to validity, 190
 whether before or after amendment, 191: ii. 65
 if case is doubtful patent should be sustained, 192
 a ground for refusing an application for a patent, ii. 50
 true way to decide questions of fact as to, 191
 effect of detailing advantages in the provisional specification, 192
 illustrative cases of patents held void for, 193
 illustrative cases in which objection of, failed, 196

DISCONTINUANCE

of action of infringement, 513, 521

DISCOVERY

not every, is subject-matter, 29
 distinction between, and invention, 29
 distinction between, and novelty, 116

DISCOVERY—(continued)

in action of infringement, 440-454

interrogatories, 440

may be administered notwithstanding necessity for particulars, 440

must be limited to facts enabling interrogating party to prove his case, 440

as to fact of infringement, 446

fishing, are not allowable, 441

irrelevant, are not allowable, 440

plaintiff and defendant have an equal right to discovery, 442

when discovery a matter of indifference to party against whom it is sought, 442

or cannot help the interrogating party till he obtain judgment, 442

rule that "he who answers must answer fully," 443

neither party can be compelled to put a construction on the specification in answer to, 446

when complete answer cannot be given without oracular demonstration, 446

names and addresses of alleged prior users, 446

defendant's customers, 446

disclosure of processes used by alleged infringer, 446

as to documents not disclosed in original affidavit, 448

costs of, must be secured, 443

right to, may depend on prior decision of an issue, 443

trade secrets and, 444

privileged communications, 445

communications between patentee and patent agent not, 445

communications between patentee and his solicitor are, 445

production of documents, 447

documents not disclosed in original affidavits, 448

further affidavit of documents, 448

interrogatories as to, 449

effect of limited order for, 449

on an account of profits or an inquiry as to damages

number of infringing articles sold with the prices, 498

names and addresses of defendant's customers, 498

profits of defendant's business before as well as after infringement, 500

on petition for revocation

as in action of infringement, 302

time for application for, 304

DISMISSAL

of subsequent action after judgment in earlier action, 335

DOCUMENTS—See also AFFIDAVIT

publication by, 140

foreign books, 141

a question of fact, 142

document may be public property the moment it is written, 144

terms of art may have different meanings in different, 144

document which points away from the patentee's claim, 145

description of a useless machine no publication of useful one, 154

provisional specifications, 145

no necessity to prove that prior description has been put in practice, 146

mere suggestion is not publication, 147

general statement as to a class, 153

sufficiency of description necessary to amount to publication, 148

document though no publication may narrow the ambit of patentee's claim, 153

DOCUMENTS—(continued)

publication by—(continued)

a question of fact—(continued)

difference between a prior document and a prior machine or a publication, 141

several different documents taken together, 151

mosaic of extracts from, 155

highly scientific inventions, 152

evidence as to, 462

notice to admit is necessary, 463

proof of documents not admitted, 463

production of, 447

documents not disclosed in original affidavit, 448

further affidavit of, 448

interrogatories as to, 449

effect of limited order for, 449

discovery of relevant, 448

amendment of, by Comptroller, ii. 315

may be sent by post to Patent Office, ii. 295

provisions as to day for leaving at Patent Office, ii. 295

sealed copies of, in Patent Office are evidence, ii. 293

size, &c., of, for use in Patent Office, ii. 320

DOLLOND'S CASE

authority on law of true and first inventor, 8

contrasted with Tennant's case and Rex v. Arkwright, 8, 116

DRAWINGS

both provisional and complete specification must be accompanied by, if required, 186

both specifications may be accompanied by the same, ii. 247

complete specification may refer to the, which accompany the provisional, ii. 247

errors in, corrected by letterpress, 288

not published unless application is accepted, ii. 246

amendment of, ii. 7, 78

amendment of specification by insertion of new, ii. 78

costs of, in action of infringement, ii. 7

effect of, on construction of specifications, 287

as aiding description and limiting claim, 288

references to drawings may or may not be restrictive, 251, 252

powers of Board of Trade as to, ii. 236

size and preparation of, for use in the Patent Office, ii. 320

transmission of certified copies of, ii. 235

publication by, 153

DUE DILIGENCE—See THREATS OF LEGAL PROCEEDINGS

action not prosecuted with, a ground for dissolving an interlocutory injunction, 440

DUPLICATES

of letters patent, ii. 55

of specifications, &c., ii. 236

DURATION

See EXTENT AND DURATION OF LETTERS PATENT

DUTIES

payment of, in respect of patents assigned in consideration of a royalty, ii. 107

payable in respect of patents, ii. 449

payable in reference to registration of patent agents, ii. 448

EDINBURGH MUSEUM OF SCIENCE AND ART

transmission of certified copies of specifications, &c., to, ii. 295

EMPLOYER

- not entitled to invention made by employee, 14
- but is entitled to details worked out by employee, 15
- suggestions made by employee, 15

ENGLAND

- revocation of letters patent in, effect of, 292

ENLARGEMENT OF TIME

- for payment of fees, ii. 313, 315
 - form of application for, ii. 361
- for leaving and accepting specifications, ii. 305
 - forms of application for, ii. 371, 372
- for doing other acts prescribed by Patent Rules, 1903. ii. 315
- for appealing to law officer, ii. 323

EQUITY

- no infringement on, of a patent, 336

EQUIVALENTS

- substitution of known, not subject-matter, 73
- substitution of new, is subject-matter, 73
- examples of patents void as being merely for the substitution of one known, for another, 73
- prior use of, may or may not be publication, 118
- importance of, in questions relating to opposition to grant of patents, ii. 89
- effect of words "or any mechanical equivalent," 283 (note)
- infringement by use of, 352
 - doctrine of, not applicable in all cases, 354, 366
 - equivalents not known at date of patent, 353
 - effect of public knowledge on question of, 354
 - two classes of cases, 355
 - Curtis v. Platt as type of one class, 356
 - Proctor v. Bennis as type of the other class, 358
 - difficulty in deciding in which class a particular case falls, 360
 - correct application of doctrine of, a matter of difficulty sometimes, 354, 366
 - illustrations, 367
 - chemical patents and, 369
 - use of ingredients in proportions outside those claimed, 370

ERRORS

- in specifications
 - effect of, on sufficiency, 223
 - if corrected by other parts are not fatal, 288
 - if apparent are not fatal, 289
 - if not apparent are fatal, 289
 - which amount to false suggestion are fatal, 289
 - construction of, by the Court, 288
 - clerical
 - power of Comptroller to correct, ii. 77
 - power of Master of Rolls to correct, ii. 76
 - delay in applying to correct, ii. 77
 - form of request for correction of, ii. 366

ESSENCE OF INVENTION

- should be specifically claimed, 280
- may be protected though not specifically claimed, 280

ESTOPPEL

- of assignor
 - recitals and covenants by, which affect an, ii. 115
 - as against assignee from denying title to convey, ii. 116
 - but not a particular construction of the specification, ii. 116
 - no estoppel from assisting defendant with evidence, ii. 117
 - assignment by trustee in bankruptcy does not estop bankrupt patentee, 411: ii. 118
 - of licensee as against his assignee, 409: ii. 148

ESTOPPEL—(continued)

- of defendant to action of infringement from denying validity, 406
 - decision in former action, 406
 - different parties, 406
 - amendment of specification after action removes estoppel, 403
 - prior submission to injunction, 403
 - agreement between parties, 410
 - assignment by trustee in bankruptcy, 411
 - defendant assignor, 409
 - defendant licensee, 409
 - defendant a former partner of plaintiff, 410
 - some joint defendants may be estopped whilst others are not, 411
 - may operate on motion for interlocutory injunction though not at the trial, 410
- of licensee, ii. 135, 148
 - from denying validity of patent in action by licensor, ii. 148
 - but not if licence not under seal unless acted on, ii. 150
 - or if licensee is only equitable assignee of exclusive licensee, ii. 150
 - no, against denial of ambit of licence, ii. 148
 - or ambit of patentee's claim, ii. 149
 - may be subject of special covenant, ii. 150
 - terminates with the licence, ii. 151
- licence to construct only may operate as an, against third party with notice, ii. 149
- no, against petitioner for revocation in respect of an unsuccessful action for infringement, 306

EVIDENCE

- action of infringement, 454
 - necessary on application for interlocutory injunction, 427-440
 - necessary to obtain an order for inspection, 450
 - necessity for evidence of actual damage, 501
 - when defendant does not appear at the trial, 454
 - confined to the particulars, 454
 - except by leave of Court or a Judge, 454
 - not within the particulars, 455
 - discretion of Judge as to, 455
 - discretion of Court of Appeal as to, 455
 - particulars not objected to are construed widely, 456
 - and such evidence is admitted as is within their literal meaning, 455
- of assignee, 456
 - interest in validity of patent may affect, 456
- of licensee admissible in action brought by patentee, 456
 - though action is for benefit of the licensee, 457
- expert, 457
 - necessity for, and value of, 457
 - limit of admissibility of, 458
 - costs of, 531
- rebutting, 460
 - evidence by way of rejoinder to, 463
- proof of documents filed in Patent Office, ii. 233
 - necessary to prove
 - grant of patent, 459
 - scope of invention claimed, 459
 - issue of true and first inventor, 459
 - effect of previous failures on, 12
 - issue of subject-matter, 460
 - novelty and utility not conclusive evidence of invention, 40
 - simplicity is not conclusive evidence of lack of invention, 40
 - new, better and cheaper article as evidence of invention, 12
 - issue of novelty, 461
 - plaintiff must give *prima facie* evidence of, 461
 - onus* then on the defendant, 461

EVIDENCE—(continued)

- action of infringement—(continued)
 - necessary to prove—(continued)
 - issue of novelty—(continued)
 - documents as evidence of publication, 462
 - necessity for notice to admit documents, 463
 - proof of documents not admitted, 463
 - sealed copies of documents filed at Patent Office are evidence, ii. 233
 - not necessary to prove patentee's knowledge of prior document, 142
 - proof of public right of access to, is sufficient, 142
 - not necessary to prove actual use of prior published invention, 146
 - common knowledge
 - as objection to validity, 418
 - how plea should be raised, 419
 - distinction between issue of, and prior publication, 420
 - particulars of, not requisite if ambit of claim only and not validity of patent is attacked, 467
 - rebutting evidence may be given by plaintiff on, 462
 - recalling witnesses, 463
 - evidence of person who has knowledge of plaintiff's specification, 150, 472, 464
 - models as evidence on, 464
 - issue of utility, 464
 - user or non-user by the public as evidence on, 165, 466
 - commercial success, 163, 466
 - patent for an improvement is not evidence of lack of utility in the original, 76
 - issue of sufficiency of specification, 466
 - plaintiff must give some evidence on, 466
 - onus then on defendant to establish insufficiency, 467
 - amendment of specification as evidence of prior invalidity, 313: ii. 65
 - issue of infringement, 467
 - a mixed question of law and fact, 265, 467
 - common knowledge directed to, may be given without particulars, 467
 - multiplicity of expert evidence not admissible on, 468
 - effect of prior construction of specification by Court of Equal Jurisdiction, 469
 - defendant himself a patentee, 470
 - necessity for proof that alleged infringement was not committed by agents or under licence of the plaintiff, 470
 - or that an alleged licence was given under misapprehension, 471
 - when it is sufficient for the plaintiff to make out a *prima facie* case on, 471
 - facts which are *prima facie* evidence of infringement, 471
 - defence that alleged infringement in a trade secret, evidence given *in camera*, 472
 - when *onus* is on plaintiff to prove that infringing article was not made by his authority, 472
- fresh evidence on appeal, 306, 416, 483
 - amendment of particulars so as to admit, 416
 - issues abandoned below not allowed to be raised on, 483
 - effect of defendant's right to petition for revocation, 306
 - costs of, 416
- opposition to grant of patent, ii. 25
- petition for extension, ii. 173
 - formal proofs may be taken by clerk of Privy Council, ii. 173
- petition for revocation, 304
 - confined to particulars, 301
 - except by leave of Court or a Judge, 302
 - trial on affidavit evidence, 304

EVIDENCE—(continued)

- statutory provisions as to giving in, and effect as, of,
 - Board of Trade Orders and Certificates, 472: ii. 237
 - Patent Office copies and certificates of specifications, disclaimers and other documents or extracts from them, 472: ii. 233, 234
 - Register of Patents, 472: ii. 212
 - Seal of the Patent Office, 472: ii. 206, 232

EXAMINATION

- of application, ii. 6
- of complete specification, ii. 14

EXAMINERS

- appointed under Act of 1833. . ii. 232
- application for patent is referred to, ii. 16
- duties of examiners, ii. 6
- Comptroller may refuse application on report of, ii. 6
 - or require amendment of specifications and drawings, ii. 6
- complete specification is referred to, ii. 14
 - and Comptroller may refuse it or require an amendment on report of, ii. 14
- search as to novelty, ii. 14
- reports of, are not published, ii. 16
- power of Court to order production of, ii. 16
- effect of, in cases of rival applications, ii. 17

EXECUTION

- against patent, ii. 127

EXECUTOR

- patent vests in, ii. 125

EXHIBITIONS (INDUSTRIAL OR INTERNATIONAL)

- protection of non-patented inventions exhibited at, 132: ii. 217, 247
- Patent Rules, 1903, as to, ii. 307
- form of notice of intended exhibition of an unpatented invention, ii. 355
- foreign corporation carrying on business by hiring a stand at, 380

EXISTING PATENTS

- provisions of Act of 1833 as to, ii. 219

EXISTING RULES

- provisions of Act of 1833 as to, ii. 241

EXPERIMENTAL USE

- and publication, 120
 - prior, though profitable is not necessarily fatal to validity, 124
 - law as to, stated by Tindal, C.J., 120
 - always a question of fact, 121
- and infringement, 373
 - use by way of *bonâ fide* experiment no infringement, 373
 - use for advantage is infringement, 374
 - e.g.*, use for instruction of pupils, 374

EXPERIMENTS

- law of anticipation by, 120
- unsuccessful, no publication, 120
- publication by, always a question of fact, 7, 121
- abandoned, *primâ facie* presumed to have been incomplete, 121
 - illustrative cases, 121
- when necessity for, renders a specification bad and when not, 214, 224
- expenses of, credited to petitioner for extension of term of patent, ii. 188
- inclusion in complete specification of results of, made during period of provisional protection, 189

EXPERT

- evidence of, and its value, 457
- costs of, 531: ii. 331

EXPERT—(continued)

- multiplicity of, evidence not admissible, 468
- form of order for reference to independent, during action, ii. 446
- form of order for experiments before, and his report to the Court thereon, ii. 446

EXPLANATION

See AMENDMENT OF SPECIFICATIONS

EXTENSION OF TERM OF PATENT

- Crown has authority to grant an, ii. 157
- is a matter of favour and not of right, ii. 166, 192
 - and Crown is not bound to act on the recommendation of the Judicial Committee, ii. 192
- only one period of, in respect of the same patent, ii. 193
- cannot be demanded *ex debito justitiæ*, ii. 174
- when same invention is patented abroad, ii. 187
- procedure for, prior to 1835 was by special Act of Parliament, ii. 158
 - between 1835 and 1884 was by way of petition to Privy Council, ii. 158-161
 - Lord Brougham's Act, ii. 158
 - 2 & 3 Vict. c. 67.. ii. 159
 - 7 & 8 Vict. c. 69.. ii. 159
 - 15 & 16 Vict. c. 83.. ii. 160
- procedure for, since 1884 is by way of petition under s. 25 of Act of 1883.. ii. 161
 - practice is governed by Privy Council Rules, 1898, and Privy Council Rules made under Lord Brougham's Act, ii. 161
 - s. 25 of the Act of 1883.. ii. 161
- petitioner, ii. 162
 - who may be, ii. 162
 - original patentee, ii. 162
 - legal personal representative, ii. 162
 - assignee, ii. 162
 - not so favourably received as original patentee, ii. 163
 - who has advanced capital for development is more favourably received than one who has not, ii. 163
 - companies, ii. 164
 - importer, ii. 165
 - not so meritorious as an original inventor, ii. 165
 - exclusive licensee should be a co-petitioner, ii. 165
 - quæry* mortgagee, ii. 123
- petition, ii. 165
 - cognate patents may be included in one, ii. 165
 - requisites of, ii. 165
 - full disclosure of all essential facts must be made, ii. 166
 - examples, ii. 166
 - amendments may be made, ii. 167
 - how, ii. 167
 - absence of statutory, affects jurisdiction of the Committee, ii. 167
 - but not so non-compliance with the rules, ii. 167
 - advertisement of intention to present, is necessary, ii. 168
 - in *London Gazette*, ii. 168
 - and other papers, ii. 168
 - petitioner resident abroad, ii. 169
 - precedent of, ii. 413
 - affidavit of advertisement must accompany the petition, ii. 169
 - must be proved before petition is heard, ii. 169
 - otherwise Judicial Committee has no jurisdiction, ii. 170
 - Judicial Committee may dispense with the prescribed mode of, ii. 170
 - name of equitable assignee must appear in, ii. 169
 - service of, on all opponents is necessary, ii. 171

EXTENSION OF TERM OF PATENT—(continued).

procedure for, since 1884 is by way of petition unders. 25 of Act of 1883—(continued)

petition—(continued)

time limit for presentation of, ii. 167

six months before the natural expiration of the patent, ii. 168

and one week after last requisite advertisement in the *London Gazette*, ii. 168

how to be printed, ii. 172

documents necessary to be lodged at the Council Office before hearing of, ii. 169

precedents of, ii. 415

opposition

any person may enter a *caveat*, ii. 170

interest in the patent is not essential, ii. 170

Attorney-General always appears at the hearing, ii. 173

and may oppose without notice, ii. 173

opponent is entitled to notice of day fixed for hearing and to copy of the petition, ii. 171

also, at his own expense, to all papers lodged in reference to the petition, ii. 171

also to notice of any special application by the petitioner, ii. 171

all opponents must be served, ii. 171

objections

copies of, must be lodged by opponent at Council Office, ii. 171

how notices of opposition, &c., are to be printed, ii. 172

compliance with rules may be dispensed with, ii. 172

precedent of, ii. 414

grounds of

extension detrimental to public interest, ii. 174, 175

grant of an exclusive licence, ii. 175

may be surmounted by licensee renouncing, ii. 175

patent *prima facie* invalid, ii. 176

invention not meritorious, ii. 175

part only meritorious, ii. 176

validity highly doubtful for some specific reason, ii. 176

invention not useful, ii. 177

no benefit accrued or likely to accrue to the public, ii. 180

small public user, ii. 178

no likelihood of future user by the public, ii. 180

patentee sufficiently rewarded, ii. 180

accounts insufficient, ii. 182

assignee's profits not disclosed in, ii. 185, 186

licensee's profits not disclosed in, ii. 186

profits derived from foreign patents not disclosed in, ii. 187

patentee has not used his best endeavours to develop the invention, ii. 181

disputes between co-owners have retarded the development of the invention, ii. 182

patentee has permitted open infringements, ii. 181

prior extension of term, ii. 193

accounts

when to be lodged by the petitioner, ii. 182

requisites of, ii. 182

must be full, clear, and accurate, ii. 182

must disclose whole profit and loss from the patent, ii. 182

made by the patentee as such, ii. 185

other patents for similar inventions, ii. 166

foreign patents for same invention, ii. 166, 187

items which may be credited to the patentee, ii. 188

expenses of experiments, legal proceedings, salaries, and commissions, ii. 188

manufacturer's profits as distinct from patentee's profits, ii. 189

- EXTENSION OF TERM OF PATENT—(continued)**
 procedure for, since 1884 is by way of petition under s. 25 of Act of 1883—(continued)
 accounts—(continued)
 requisites of—(continued)
 must disclose whole profit and loss from the patent—(contd.)
 made by the patentee as such—(continued)
 items which may be credited to the patentee—(contd.)
 personal remuneration for time devoted to pushing invention, ii. 190
 items not allowed, ii. 188
 assignee's profits, ii. 186
 licensee's profits, ii. 186
 foreign patents, profits on, ii. 186
 rule in Pitman's case, ii. 186
 profits on articles made expressly for exportation abroad, ii. 187
 absence of books may sometimes be explained, ii. 183
 losses sometimes need not be proved with strict accuracy, ii. 184
 how, should be kept from the first, ii. 184
 effect of keeping and rendering accounts on a wrong system, ii. 185
 balance at end of each year should be struck, ii. 186
 to disclose ratio of increase or diminution of profit from year to year, ii. 186
 copies of, how obtained, ii. 171
 precedents of, ii. 424
 grounds on which Judicial Committee recommend extension, ii. 174
 all the circumstances of the case are to be considered, ii. 174, 187
 practice with regard to inventions also patented abroad, ii. 187
 probable benefit to the petitioner and injury to the public is important, ii. 163
 no extension is recommended unless the original patentee would be directly or indirectly benefited, ii. 164
 merit, ii. 176-180
 prima facie proof of validity must be given, ii. 176
 validity is not decided by the Committee, ii. 176
 though it is always material on the fact of merit, ii. 176
 invention must be proved to be independently meritorious, ii. 176
 only part meritorious, extension may be limited to, ii. 176
 nature of merit necessary to be proved, ii. 177
 merit of utility as distinct from merit of ingenuity is essential, ii. 177
 test of utility for purpose of extension, ii. 178
 non-user by the public, ii. 178
 presumption of non-utility arising from, may be rebutted in certain cases, ii. 179
 patent for an improvement is not proof of want of utility in original, 76
 probability of future user by the public must be established, ii. 180
 from point of view of the public, ii. 193
 of an importer is less than that of an original inventor, ii. 165
 insufficient remuneration, ii. 180-190
 benefit accrued to or likely to accrue to the public is to be considered with that derived by the patentee, ii. 180
 patentee must have used his best endeavours to develop the invention, ii. 181
 e.g., he must not have permitted open infringements, ii. 181
 disputes between co-owners retarding development, ii. 182
 adequate remuneration, what is, ii. 182

EXTENSION OF TERM OF PATENT—(continued)

procedure for, since 1884 is by way of petition under s. 25 of Act of 1883—(continued)

hearing of the petition, ii. 172

application for a day for, ii. 169

must be made by the petitioner, ii. 169

and advertised when fixed, ii. 169

precedent of advertisement, ii. 415

usual order fixing a day for hearing, ii. 170

postpones hearing if the patent has a considerable time to run, ii. 170

discretion of the Committee is absolute, ii. 174

parties may appear personally or by counsel on, ii. 172

not more than two counsel are heard on either side, ii. 172

unless opponents have distinct and separate interests, ii. 172

Attorney-General always appears on, ii. 173

when there is no opposition, ii. 173

pending proceedings affecting the validity of the patent, ii. 173

utility usually dealt with before adequacy of remuneration, ii. 173

formal proofs may be taken by the clerk of the Committee, ii. 173

new grant, ii. 190

Crown gives effect to the recommendation of the Judicial Committee by means of a, ii. 190

which is subject to the same conditions as the expired grant, ii. 191

to whom, may be made, ii. 191

no fresh specification need be filed on, ii. 191

is in the nature of a graft on the old one, ii. 191

and open to the same objections, ii. 177, 191

conditions are frequently imposed on a, where requisite, ii. 191

in the interest of the original patentee, ii. 191

or his representatives, ii. 191

for the benefit of persons other than the original patentee, ii. 191

for the benefit of the public generally, ii. 192

as to date of commencement and expiry when there are cognate patents, ii. 192

security for performance of conditions is usually required, ii. 193

Crown has authority only to make one, in respect of the same patent, ii. 193

duration of, cannot exceed fourteen years, ii. 193

usually limited to not more than seven years, ii. 193

but sometimes a longer period is recommended, ii. 193

registration of order for, ii. 193

costs, ii. 193

Attorney-General does not ask for and is not ordered to pay, ii. 194

discretion of the Committee as to, ii. 193

practice as to, ii. 193

taxation of, ii. 172

EXTENSION OF TIME

for payment of fees, ii. 54, 313

form of application for, ii. 361

for leaving and accepting specifications, ii. 305

forms of application for, ii. 371, 372

for doing other acts prescribed by Patent Rules, 1903.. ii. 315

for appealing to law officer, ii. 323

EXTENT AND DURATION OF PATENT

geographical extent, ii. 53

duration, ii. 53

usual, ii. 53

is conditional on payment of fees, ii. 54

enlargement of time for payment of fees, ii. 54, 313

revival of patent void for own payment of fees, ii. 54

EXTENT AND DURATION OF PATENT—(continued)

duration—(continued)

- application in fraud of true and first inventor, ii. 55
- adverse decision does not annul a patent, ii. 55

EXTRACTS FROM REGISTER OF PATENTS

- any person may obtain, ii. 59
- sealed, are evidence, ii. 59

FALSE SUGGESTION

- invalidates a patent, 297
 - e.g.*, as to novelty, 118
 - utility, 166, 168
 - correct specification, 202, 204
- a ground of revocation, 297
- distinction between false representation and false statement, 295

FALSIFICATION

- of entries in Register of Patents, ii. 61

FAST (PUBLIC)

- days observed as
 - Patent Office closed on, ii. 315
 - Register of Patents not open to inspection on, ii. 313
 - leaving documents, paying fees, &c., at Patent Office on, ii. 54

FEEES

- statutory provisions as to, ii. 212
- payment of, is necessary to validity, ii. 54
- revival of patent void for non-payment of, ii. 54
- enlargement of time for payment of, 54, 313
 - form of application for, ii. 361
- list of, in reference to the registration of Patent Agents, ii. 448
- list of, on and in connection with letters patent, ii. 449

FLAT

See ATTORNEY-GENERAL

FIDUCIARY COMMUNICATION

- effect of, on novelty, 131

FIERI FACIAS

- writ of, entitles sheriff to sell patented article, ii. 127
- sheriff cannot sell patent under, ii. 127

FIRST AND TRUE INVENTOR

See TRUE AND FIRST INVENTOR

FOREIGN APPLICATION

- meaning of, ii. 22
- practice on, ii. 22
- must be made in same manner as an ordinary application, ii. 20
- patentee in respect of, ii. 20, 22
- provisions as to, confer no rights in respect of communicated inventions, ii. 21
 - i.e.*, rights thereby conferred are personal, ii. 21
- allowable difference between English and foreign specification on, ii. 22
 - description in English not in foreign specification, ii. 23
 - claim in English not in foreign specification, ii. 23
- retrospective effect of order in Council as to, ii. 20

FOREIGN PATENT

- extension of English patent for invention, subject of, ii. 187
- reference to, necessary on petition for extension of English patent, ii. 186

FOREIGN SOVEREIGN

- position of, as regards infringement, 382

FOREIGN VESSELS

in British waters, use of patented invention in, 381

FOREIGNER

may be patentee, 4

patents were granted to, prior to Act of 1883.. 4

when entitled to priority, 8, 18: ii. 19

concurrent application by, 8

communication by one, resident abroad to another is good subject-matter, 19

liability of, in this country in respect of infringement, ii. 382, 390

rights of, on application for patent under International Convention of 1884.. ii. 21

are personal, ii. 21

corporation, ii. 19

effect of abortive application abroad, ii. 21

practice on applications under provisions of s. 103 of Act of 1883.. ii. 22

minor differences in English and foreign specifications allowable, ii. 22

as opponent to grant of English patent, ii. 33

as defendant to action of infringement, 390

FORM

See SHAPE

FORMS

form of patent, ii. 373

application for patent, ii. 345

application for patent for invention communicated from abroad, ii. 347

application for patent under international and colonial arrangements, ii. 349

provisional specification, ii. 350

complete specification, ii. 351

opposition to grant of patent, ii. 353

notice that hearing before the Comptroller will be attended, ii. 354

application for amendment of specification, ii. 355

opposition to amendment of specification, ii. 356

application for compulsory grant of licence, ii. 357

petition for compulsory grant of licences, ii. 358

opposition to compulsory grant of licence, ii. 359

application for certificate of payment or renewal, ii. 360

application for enlargement of time for payment or renewal fee, ii. 361

request to enter name upon the register of patents, ii. 362

request to enter notification of licence or other document in the register of patents, ii. 363

application for duplicate of patent, ii. 364

notice of intended exhibition of an unpatented invention, ii. 365

request for correction of clerical error, ii. 366

certificate of Comptroller, ii. 367

notice of alteration of an address in register, ii. 368

application for entry of order of Privy Council in register, ii. 369

appeal to law officer, ii. 370

application for extension of time for leaving a complete specification, ii. 371

application for extension of time for acceptance of a complete specification, ii. 372

notice of desire to have patent sealed, ii. 375

appendices to Patent Agents' Rules, 1889.. ii. 376

assignment of letters patent, ii. 378

licence to use patented invention, ii. 380

mortgage of letters patent, ii. 383

action of infringement

indorsement on writ, ii. 386

statement of claim, ii. 387

particulars of breaches, ii. 389

defence, ii. 390

particulars of objection, ii. 393

notice of motion for interlocutory injunction, ii. 396

FORMS—(continued)

- action of infringement—(continued)
 - notice of motion for leave to amend a specification pending action for infringement, ii. 395
 - judgment after trial of action, ii. 396
 - judgment affirmed on appeal, ii. 401
 - judgment varied on appeal, ii. 403
 - certificate of validity, ii. 402
 - notice of appeal to Court of Appeal, ii. 400
- action to restrain threats of legal proceedings
 - indorsement on writ, ii. 404
 - statement of claim, ii. 404
 - defence, ii. 406
 - reply, ii. 407
 - rejoindre, 408
- extension of letters patent
 - advertisement of intention to present petition, ii. 412
 - caveat, ii. 412
 - notice of objections, ii. 414
 - advertisement of day fixed for hearing of petition, ii. 415
 - petition for extension of letters patent, ii. 415
 - accounts to accompany petition for extension, ii. 424
- revocation of letters patent
 - petition for revocation, ii. 409
 - memorial to obtain fiat of Attorney-General, ii. 411
 - fiat of Attorney-General, ii. 411

FOXWELL v. BOSTOCK

- rule in, 244
- explanation of, 245

FRANCHISE

- patent is a, 473

FRAUD

- application for patent in, of true and first inventor, ii. 55
- abroad no prejudice to applicant for patent for a communicated invention, ii. 82
- of rights of another, meaning of, 294
- defence of action to recover royalties, ii. 154
- ground for revocation, 294, 300
 - must be strictly proved, 301
 - if patent revoked, new patent may be granted to inventor, 300
- judgment obtained by, 481

GENERAL DISCLAIMER

See AMENDMENT OF SPECIFICATIONS

GENERAL PUBLIC KNOWLEDGE

See COMMON KNOWLEDGE

GENERAL WARNING

See THREATS OF LEGAL PROCEEDINGS

GOOD FRIDAY

- Patent Office closed on, ii. 315
- Register of Patents not open to inspection on, ii. 313
- leaving documents, paying fees, &c., at Patent Office on, ii. 54

GOVERNMENT CONTRACTOR

- may be sued for infringement, ii. 146

GRANT

- practice on, of patents regulated by Act of 1883 and rules thereunder, ii. 2
- effect of, of patent, 105
- opposition to, of patent—see OPPOSITION

GRANTEE

- true and first inventor must be one, 4
- several persons may be, 4
- person other than true and first inventor may be one, 4
- married woman, 5
- infant, 5
- lunatic, 5
- legal representative of deceased person, 5
- on death of, patent vests in executor or administrator, ii. 125
- persons not capable of being, 19
- interest in patent of co-grantees, ii. 110

HIDDEN PROPERTY OF MATTER

- application of newly discovered, is good subject-matter, 50, 98
- examples, 58

HILL v. EVANS

- rule in, as to sufficiency of description necessary in an anticipatory document to render it a publication, 148
- explained, 148

HOLIDAY

See **BANK HOLIDAY**

HOUSE OF LORDS

- jurisdiction of, to grant certificate of particulars, 519
- jurisdiction of, to grant certificate of validity, 525
- no original jurisdiction to grant leave to amend a specification pending action or petition, ii. 92
- effect of judgment of, with costs, 486

IGNORANCE

- no defence to action of infringement, 336
- does not exempt from liability to pay costs, 511

ILLEGAL MONOPOLIES

- suppressed by Statute of Monopolies, 2
- Acts for suppression of certain, prior to Statute of Monopolies, 1

ILLEGAL PURPOSE

- power of Comptroller to refuse patent for invention to be used for, ii. 6, 232

ILLUSTRATED JOURNAL

- publication and sale of, of patents, ii. 55

IMMORAL PURPOSE

- power of Comptroller to refuse patent for invention to be used for, ii. 6, 232

IMPORTATION

- of article made abroad and its effect on novelty, 137
- infringement by, 375, 390

IMPORTER

- first, is true and first inventor, 17-19
 - even though he did not actually make the invention, 17
 - and is not a meritorious importer, 19
- may petition for extension of term of patent, ii. 162, 165
 - but is not considered so meritorious as an original inventor, ii. 165

IMPROVEMENT

- in details during provisional protection, 187, 189, 198
 - inclusion of, in complete specification, 184, 189, 198, 238
 - made by servant belong to master, 15
- may be good subject-matter, 75
 - as consisting in an addition to, omission from or rearrangement of old parts, 75
 - if it is the outcome of invention, 75, 77

IMPROVEMENT—(continued)

- may be good subject-matter—(continued)
 - amount of improvement does not affect validity of patent for, 79
 - nor does lack of utility in a prior construction, 171
- claim must be limited to, in case of patent for, 76, 228, 242
- legality of patents for, 75
- patent for, is no evidence of lack of utility in an original invention, 76
- licence of patentee of an original invention may be necessary for use of an, upon it, 75
- mere use of known machine in a more beneficial manner is not a patentable, 78
- mere adaptation of a well-known idea is not a patentable, 79
- mere working direction is not a patentable, 77 .
- of which patentee was ignorant at the date of patent, 289
- validity of patents used for obstructing, 100
- covenant to assign future, not contrary to public policy, 118
 - and is advisable for protection of an assignee of letters patent, 114
 - difficulties in drafting and interpretation of, 114
 - what is an infringement of, is not necessarily an improvement on a prior patent, 114
- meaning of "improvements" as used in titles, 79, 177, 287
- effect of "improvement" in the title on construction, 79, 177, 287
- use of substance of patented invention together with an, is infringement, 343

INABILITY

- declaration on behalf of person under, ii. 5

INDEMNITY

- person who has given an, to defendant may be allowed to take part in the action, 391
- validity of agreement of, 391

INDEX, ETC.

- of specifications prior to Act of 1883.. ii. 217.
- under Act of 1883.. ii. 217

INDORSEMENT OF WRIT

- form of, in action of infringement, ii. 386
- form of, in action to restrain threats of legal proceedings, ii. 404

INDUSTRIAL PROPERTY

- See INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY

INFANT

- may be patentee, 5
 - validity of patent granted to, alone, 5
- declaration on behalf of, ii. 5

INFRINGEMENT

- a mixed question of law and fact, 265, 467
- breach of contract no justification for, 381
- consideration of question of, apart from the patent, 56
- criterion of novelty and, are not the same, 343
- definition of, 335
- description not amounting to a publication might if carried out subsequently to a patent be an, 152
- no proceedings for, until patent actually sealed, 383
- no, if patent is void, 401
- no, unless saleable article is produced, 25
- no, unless what is claimed is taken, 257, 335, 345
 - ambit of claim may be limited, 335
 - claim really a disclaimer, 336
- importance of ascertaining the essence of the invention as claimed, 336, 340

INFRINGEMENT—(continued)

modes of—(continued)

of a combination—(continued)

by substitution of equivalents—(continued)

chemical patents and infringement, 869

use of ingredients in proportions outside those claimed,
870

manufacture of separate parts, 371

sale of separate parts, 371

restoration of patented instrument, 373

grant of licence to work under an infringing patent, 371

importation, 375, 390

loan of patented article, 377

manufacture without proof of sale, 373

obtaining orders on commission for a foreign manufacturer, 375

ordering the construction of patented article, 371

possession, 380

sale of patented article or articles made by patented process or
machine, 375notwithstanding *locus* of manufacture, 375

manufacturer resident abroad who is also an importer, 390

exposure for sale, 376

by purchaser from unrestricted licensee, 377

in breach of conditions of a licence, 377

in this country to foreign customer, 375

transshipment of goods, 382

the property of a foreign sovereign, 382

Custom House agents and the, 382

transportation for sale abroad, 383

use of patented article, 374; 379, 380: ii. 134

at instigation of patentee no infringement, 371

if made under licence, is no infringement, 375: ii. 134

in breach of limited licence, 377

licence given under misapprehension, 471

for purpose analogous to that specified by the patentee, 193, 379

claim may be limited to a particular user, 379

for purpose totally distinct from that specified by the patentee, 380

in British vessel, 381

in foreign vessels within jurisdiction of British Courts, 381

not as such forming an ingredient of final product, 375

notwithstanding authority to construct, 379

prior to sealing of the patent, 383

by way of *bonâ fide* experiment is no infringement, 373

for advantage, 374

use for instruction of pupils is, 374

pecuniary profit is not condition precedent to liability, 375

INGENUITY

See SUBJECT-MATTER

INJUNCTION

in Scotland means "interdict," ii. 220

interlocutory

in action of infringement

power of the Court or a Judge under Act 1883 as to, 427: ii. 215

how obtained, 427

ex parte application, 430rule in *Hill v. Thompson*, 430

usual course, 431

Court endeavours to keep things *in statu quo* on application for,
427*primâ facie* case of validity and infringement must be established
on application for, 427

disputed compromise may form a bar to, 427

acquiescence disentitles to, 427

what amounts to, 428

- INJUNCTION—(continued)**
 interlocutory—(continued)
 in action of infringement—(continued)
 acquiescence disentitles to—(continued)
 delay may sometimes be explained, 429
 examples, 429
 defendant working under a patent of which plaintiff had knowledge before action brought, 429
 defendant the agent of a person who could establish a case of *laches*, 430
 defendant working under patent of his own, 429
 delay in pending action ground for refusal of, in subsequent action, 428
 validity of patent an important factor on application for, 431
 patent recent and validity not established the injunction is refused, 431
 presumption in favour of validity arises from long uninterrupted enjoyment, 432
 no necessity to state patent has not been disputed, 433
 but actual user must be proved, 433
 and proved to have been uninterrupted, 433
 length of uninterrupted active enjoyment sufficient to raise presumption of validity, 433
 patent once established is regarded as valid, 434
 appeal pending, 435
 judgment wrongly obtained, 435
 certificate of validity on judgment by default or consent, 435
 prior interdict in Scotland, 435
 award of an arbitrator, 435
 degree of doubt as to fact of infringement an important factor on application for, 436
 Court considers itself bound by construction of specification in prior proceedings, 436
 injunction refused in cases of real doubt, 436
 quantum of doubt and question of convenience or inconvenience to the parties, 436
 affidavits made from information and belief and their effect, 437
 is granted if infringement is established and presumption is in favour of validity, 436
 indemnity of defendant by plaintiff as a condition of grant of, 437
 inability of defendant to satisfy plaintiff's claim induces Court to grant, 438
 procedure when there is an independent case against the grant of, 438
 motion ordered to stand over till the trial, 439
 on refusal of, defendant is usually ordered to keep an account, 439
 not usually granted if defendant voluntarily offers to keep an account and is able to satisfy plaintiff's claim, 439
 dissolved on application of defendant if action not prosecuted with due diligence, 440
 form of notice of motion for, ii. 396
 in action to restrain threats, 310, note (*h*), 325
 how and when obtained, 310, note (*h*), 325
perpetual
 in action of infringement
 power conferred on the Court or a Judge by Act of 1883 as to, ii. 215
 successful plaintiff usually entitled to, 486
 though not always, 386, 486
 no intention on part of defendant to continue infringement, 488
 by consent, 486
 though one defendant succeeds, 486

INJUNCTION—(continued)**perpetual—(continued)****in action of infringement—(continued)****by consent—(continued)**

withdrawal of consent given under mistake or surprise, 487

undertaking in lieu of, 486

acquiescence may induce the Court to refuse a, 487

laches though a bar to an interlocutory injunction may be none to a, 487

doubt as to which of several patents has been infringed, 487

expiry of patent before conclusion of action, 488

specific infringements may be exempted from a, 489

e.g., articles ordered before action brought when plaintiff elects to take an account of profits, 489

obtained before amendment of specification cannot be enforced after, 490: ii. 82

breach of, 490

is a contempt of Court, 490

motion to commit for, 490

proof necessary on, 490

expiry of patent an answer to, 492

solicitor and client's costs on, 493

justifiable under certain circumstances, 491

procedure to determine whether specific acts are a, 492

form of, ii. 397

prior secret use cannot be restrained by, 332

threatened infringements may be restrained by, 384

stay of, pending appeal, 489

licence in lieu of, 489

in case of several patents covering all known ways of making an article, 487

in action to restrain threats of legal proceedings, 309

scope of, 329

breach of, 329

INSPECTION

when complete specification is open to public, ii. 18

in case of foreigners application, ii. 357

in action of infringement, 449

provisions of Act of 1883 as to, 449: ii. 215

power to Court as to under R. S. C., 449

costs of agreed, 451

not a matter of right, 449

objects of, 449

evidence necessary to obtain an order for, 450

for purpose of preparing pleadings, 451

how obtained, 450

order for inspection may be made at any time, 452

usual form of order for, 452: ii. 445

conditions of order for, 452

against licensee not a party to the action, 452

delay no bar to, 452

power of Court to compel, 452

right to, may depend on prior determination of an issue, 452

trade secrets and, 452

samples may be ordered to be taken on, 453

of books, 454

of machines not belonging to but in power of either party, 453

independent inspector, 453

action founded solely on threats to infringe, 454

on petition for revocation, 304

time for application for, 304

INSTITUTE OF PATENT AGENTS

prosecutes in case of infraction of Register of Patent Agents' Rules, ii. 3

INTENTION

- of infringer is immaterial *qua* infringement, 336
- but not *qua* an injunction, 397, 488
- effect of, on costs of action, 397, 512
- patentee's, is no real guide to the construction of his specification, 270, 272

INTERDICT

- in Scotland means injunction, ii. 220
- may be obtained against Englishman or other foreigner, 393
- prima facie* evidence of validity on application for interlocutory injunction, 485

INTEREST

- recovery of, on unpaid royalties, ii. 155
- on costs returned in consequence of a successful appeal, 486

INTERLOCUTORY INJUNCTION

See INJUNCTION

INTERNATIONAL AND COLONIAL ARRANGEMENTS

- provisions of Act of 1883 as to, ii. 237
- provisions for Colonies and India, ii. 238

INTERNATIONAL CONVENTION for the protection of industrial property,
ii. 285

- objects of, ii. 285
- plenipotentiaries, ii. 285
- articles agreed upon, ii. 289
- union for the protection of industrial property, ii. 289
- legal remedies, ii. 289
- rights of subjects of States not forming part of the union, ii. 289
- right of priority of person who has applied for a patent in one of the contracting States, ii. 289
- importation and forfeiture, ii. 291
- registration of trade marks, ii. 291, 299
- nature of goods is no obstacle to registration of trade mark, ii. 291
- protection of trade name, ii. 291
- seizure of goods illegally bearing a trade mark or trade name, ii. 291
- goods falsely bearing name of a locality, ii. 293
- protection of patentable invention, &c., at exhibitions, ii. 293
- special government offices, ii. 293, 299
- international bureau, ii. 293, 299
- periodic revisions, ii. 293
- conferences, ii. 293
- special arrangements between contracting parties, ii. 295
- adherence to convention of other States, ii. 295
- subordination of convention to laws of the contracting States, ii. 295
- commencement of operation, ii. 295
- ratification, ii. 295
- "industrial property," meaning of, ii. 297
- "patents," meaning of, ii. 297
- expenses of international office, ii. 299
- final protocol to form part of convention, ii. 301
- accession of Her Majesty's Government to the convention, ii. 302
- declaration of acceptance of accession, ii. 303

INTERNATIONAL EXHIBITION

See EXHIBITIONS

INTERROGATORIES

See DISCOVERY

INVENTION

- definition of, 18, 22: ii. 220
- purely a question of fact, 31, 39
- decision in one case no guide to another, 39
- essential considerations, 32

INVENTION—(continued)

- difference between, and discovery, 29
- classes of, held good subject-matter, 43
- is necessary to support a patent, 31
 - mere scintilla is sufficient, 31
- effect of common or public knowledge on question of, or no, 89, 108, 154, 418, 460
- may be the result of accident, 32
 - example of accidental invention, 32
- may consist in
 - degree, 42
 - the omission of parts, 11
 - new application of old machine, 42
 - the apprehension of a new use of an old appliance, 84
 - the perception and utilisation of an unobserved result of an old combination, 111
 - the mere conception of an idea may be the merit of an, 33, 40, 47
 - production of a new thing which effects a result not previously attained, 88
 - putting together items of common knowledge, 41
 - selection of a member of a class, 41
 - selection of a particular size may be, 42
 - new method of using an old machine without structural alteration, 42, 57
- mere adaptation of old idea is not, 42
- mere adaptive skill in manufacture is not, 42
- mere discovery of theory of what was formerly done empirically is not, 57
- merely more skilful application of known tools or process is not, 42, 78
- mere use on a commercial scale of what has been previously used on a small scale is not, 58
- mere variation of proportions is not, 42
- mere alteration of shape is not, 42
- evidence of,
 - new, better, or cheaper article as, 12
 - immediate commercial success, 32, 39
 - simplicity is not evidence of lack of invention, 40
 - demand for an article is not necessarily, 32, 42
 - though demand was previously unsatisfied, 32
 - novelty and utility of an application is not conclusive, 39
- amount of, sufficient to support a patent, 31
 - mere scintilla of invention is sufficient, 31
 - authorities, 34
- assignable interest in an, before the grant of letters patent, ii. 105
- covenants to assign future, ii. 113
- effect of keeping an, secret, ii. 102
- international arrangements for protection of, ii. 237
 - in Colonies and India, ii. 238

INVENTOR—See TRUE AND FIRST INVENTOR

rights of an, as compared with those of an author, ii. 101

INVENTOR (DECEASED)

See DEATH

IRELAND

- reservation of remedies in, ii. 240
- general saving of jurisdiction of Courts in, ii. 240
- meaning in, of "summary conviction" in Patent Act of 1883...ii. 242
- revocation of letters patent in, 292

ISLE OF MAN

- application of Patent Acts to, ii. 240
- penalties for statutory offences in, ii. 13

ISSUES,

- fresh, may, on leave, be raised during progress of an action, 406

ISSUES—(continued)

- right of discovery may depend on prior decision of certain, 443
- also right to inspection, 452
- trial of, separately in action of infringement, 475
- advantages of, 476
- direction of, on application for rectification of Registrar of Patents, ii. 60, 233

JOINT APPLICANT

See APPLICANT FOR PATENT

JOINT INVENTORS

- must all be applicants, 12
- disagreement as to form of specification by, ii. 18

JOINT OWNERS

See CO-OWNERS OF PATENT

JOURNAL

- illustrated, of patents, publication of, ii. 155

JUDGMENT

- in action of infringement
 - motion for, on admission of facts, 479
 - motion for, on determination of issues, 479
 - by default, 479
 - by consent, 480
 - form of, judgment for plaintiff, ii. 396
 - form of, for defendant, ii. 399
 - form of, affirmed on appeal, ii. 401
 - form of, varied on appeal, ii. 402
 - effect of adverse, on the status of the patent, 303

JUDICIAL COMMITTEE

See EXTENSION OF TERM OF PATENT; PRIVY COUNCIL; PRIVY COUNCIL RULES

JURISDICTION

See COURT OF APPEAL; COURT OF COUNTY PALATINE OF LANCASTER; COUNTY COURT; HOUSE OF LORDS

JURY

- statutory provisions as to trial of proceedings for infringement or revocation of patent by, 473: ii. 214
- trial of patent actions by, is rare, 473
- and not usually desirable, 473
- but may be had if fraud or libel is alleged, 474

KING (THE)

- cannot be a patentee, 20

KING'S BIRTHDAY

- day observed as
 - Patent Office closed on, ii. 315
 - Register of Patents not open to inspection on, ii. 313
 - leaving documents, paying fees, &c., at Patent Office on, ii. 54, 235.

LACHES

- disentitles plaintiff to an interlocutory injunction, 427, 428
 - what amounts to, 428
 - delay may sometimes be explained, 429
 - examples, 429
 - defendant working under a patent of which plaintiff had knowledge before action brought, 429
 - defendant the agent of a person who could establish a case of laches, 430

LACHES—(continued)

- no bar to a perpetual injunction, 487
- may be total bar to account of profits or damages, 496
- partial bar to account of profits or damages, 496
- a ground for damages in lieu of injunction, 487

LANCASTER, COURT OF COUNTY PALATINE OF

- jurisdiction of, to grant leave to apply to amend specifications pending action or petition, ii. 92
- to grant an account of profits or inquiry as to damages, 501
- to certify as to particulars, 519
- to certify as to validity, 525
- to hear petition for revocation, 292

LAW OFFICER—See also LAW OFFICERS' RULES

- defined by Act of 1883 as Attorney-General or Solicitor-General for England, ii. 242
- right of appeal from Comptroller to, ii. 7, 27, 294,
- statutory provisions as to proceedings and costs before, ii. 216
- discretion of Crown as to grant of patents is exercised through, ii. 1
- hearing by, of appeals from Comptroller in opposition to grant of letters patent, ii. 27
- appeal to, from Comptroller on questions as to amendment of specifications, ii. 64, 208
- decision of, is final as to fact of enlargement of claim by a proposed amendment, ii. 66
- practice in doubtful cases, ii. 67
- does not lightly overrule Comptroller on question of *locus standi* of an opponent, ii. 86
- discretion of, in matter of amendment of a specification, ii. 65
- does not usually impose terms on application to amend under s. 19 of Act of 1883 if Court has not done so, ii. 100
- form of appeal to, ii. 370
- practice on appeal to, is regulated by LAW OFFICERS' RULES
- prohibition does not lie to, ii. 65
- power of, to examine witnesses on oath, ii. 216
- make rules, &c., ii. 216
- impose conditions on grant of patent, ii. 28
- impose conditions on granting leave to apply to amend specifications, ii. 78
- allow amendments of specifications at hearing of application for patent, ii. 49
- reopening of cases decided by, ii. 29 (*m*)

LAW OFFICERS' RULES,

- notice of intention to appeal to law officer, ii. 323
- requirement of, ii. 323
- copies of, and to whom to be sent, ii. 323
- papers to be remitted to law officer's clerk, ii. 323
- time within which notice of appeal must be given, ii. 323
- notice of time and place appointed for hearing, ii. 323
- to whom to be given, ii. 323
- evidence on appeal to law officer, ii. 324
- cross-examination of persons who have made declarations, ii. 324
- payment of witnesses, ii. 324
- power of law officer over costs, ii. 324
- order for payment of costs under s. 38 of Act of 1883.. ii. 324
- regulations as to documentary evidence, ii. 324
- sending notices or documents through the post, ii. 324

LEGAL PROCEEDINGS—See ASSESSOR; PARTICULARS; INSPECTION; CERTIFICATES; THREATS OF LEGAL PROCEEDINGS

- statutory provisions as to, ii. 214
- hearing with assessor, ii. 214
- delivery of particulars, ii. 215
- order for inspection, &c., in action, ii. 215

LEGAL PROCEEDINGS—(continued)

statutory provisions as to—(continued)

- certificate of validity questioned and costs thereon, ii. 215
- remedy in case of groundless threats of legal proceedings, ii. 215
- expenses of, may be credited to petitioner on application for extension of term of patent, ii. 188

LEGAL REPRESENTATIVE

- "patentee" as used in the grant embraces, ii. 105, 378
- meaning of, in Patent Act, 1893.. ii. 30
- of deceased inventor may be patentee, 5
- how application for patent must be made by, 5
- time within which application for patent must be made by, 5

LEGISLATURE

as defined by Patent Act, 1893.. ii. 242

LETTERS PATENT

See PATENT

LICENCE—See also COMPULSORY LICENCE; ROYALTIES

- origin of patentee's power to grant, ii. 131
- co-owner's power to grant, alone, ii. 132
- mortgagee's power to grant, ii. 132
- of original inventor may be necessary for use of an improvement, 75
 - assignee may be unable to use invention assigned without licence of a prior patentee, ii. 121
- agreement for, made prior to grant of patent, ii. 133
- sale of patented article by patentee, ii. 134
- an answer to action of infringement, 470, 472
 - but not if granted under misapprehension, 471
- classification of licences, ii. 134
- consideration for, no restriction as to, ii. 147
- Crown has right to use invention on terms, ii. 145
 - Government contractors, ii. 146
 - procedure to question Crown's right, ii. 146
- distinction between, to work under a foreign patent and unconditional sale of article made under both British and foreign patents, ii. 148
- stamps, ii. 134
- how may be granted, ii. 132
 - under seal, ii. 132
 - writing acted upon though not under seal, ii. 133
 - necessity for deed a question of construction in cases of executory agreements, ii. 133
 - parol agreement, ii. 133
- may be
 - assignable, ii. 144
 - assignability depends on terms, ii. 144
 - acceptance of royalties from assignee estops patentee from disputing assignability, ii. 145
 - compulsory, ii. 136
 - statutory provisions as to, ii. 137
 - patentee may be compelled to grant, ii. 136
 - upon petition of any person interested, ii. 136
 - if the reasonable requirements of the public have not been satisfied, ii. 136
 - obligation of patentee to use invention or licence others to do so, 161, 174
 - form of application for grant of, or revocation of patent, ii. 357
 - petition for grant of, or revocation of patent, ii. 358
 - opposition to petition for grant of, or revocation of patent, ii. 359
 - revocation in lieu of, ii. 137
 - practice as to, ii. 139
 - rules, ii. 313, 332
 - enforcement of order for, ii. 138

LICENCE—(continued)

may be—(continued)

- exclusive, ii. 142
 - geographical area, ii. 142
 - if irrevocable may operate as an assignment, ii. 143
 - but not if any interest in the patent is reserved to the licensor, ii. 143
 - grantor of, may be restrained from infringing the patent, ii. 143
- expressed, ii. 134
- general, ii. 141
 - effect of unrestricted, 377
- implied, ii. 134
- irrevocable, ii. 139
- limited, ii. 142
 - sale or user in breach of a condition is an infringement, 377
 - restrictions as to user may be placed on purchase of patented article by the patentee, 377
 - user in breach with notice is an infringement, 377
- non-assignable, ii. 144
 - precedent of, ii. 380
- revocable, ii. 139
 - licence coupled with an interest is not revocable at will, ii. 139
 - mere licence is revocable at will, ii. 140
 - provision for revocation, ii. 139
 - by one party only, ii. 140
 - deed not necessary for revocation, ii. 140
 - contract not to exercise power of revocation, ii. 141
- voluntary, ii. 136
- covenants, ii. 147
 - usual, ii. 147
 - not implied, ii. 150
 - absence of, for title and validity, ii. 150
- registration of, ii. 56, 152
 - not notice to all the world, ii. 59
- assignment with notice of, ii. 121
- purchase without notice of, 377

LICENSEE

- assignee of share in profits entitled to account from, ii. 112
- a competent witness for the patentee, 456 : ii. 150
 - though action is for the benefit of the licensee, 457
- cannot sue alone in respect of infringements, ii. 156
 - unless licence amounts to an assignment, ii. 156
- estoppel of, from denial of validity of patent against the licensor, 409 : ii. 148
 - from denying validity as against his assignee, 409 : i. 148
- in virtue of covenants or recitals implying validity of patent, ii. 409, 148
- no, if licence is not under seal, unless it is acted upon, ii. 150
- no, against equitable assignee of exclusive licensee, ii. 150
- no, against denial of ambit of licence, ii. 148
- no, against denial of ambit of patentee's claim, ii. 149
- right to dispute validity may be specially provided for, ii. 150
- terminates with the licence, ii. 150, 151
- licence to construct only may create an, against a third party with notice using a patented article, ii. 149
- licensee not entitled to sell articles as made under licence, ii. 149
- exclusive
 - right of, to restrain patentee from representing that articles sold are not made in accordance with the patent, ii. 144
 - should be co-petitioner on proceedings for extension of term of the patent, ii. 165
 - equitable assignee of, not estopped from denying validity against the patentee, ii. 150
- inspection against a, not party to an action against his licensor, ii. 150
- legal interest of a, compared with that of an assignee for a district, ii. 109

LICENSEE—(continued)

- plea of determination of licence in defence co action to recover royalties, ii. 150
- recovery of royalties by, paid without knowledge of breach of covenant by licensor, ii. 154
- rights of, to employ agent, ii. 142
- rights of, in reference to threats of legal proceedings, 314
- rights of vendee of, 377
- person may be both a, and an infringer, 379

LICENSOR

- not allowed to interfere with trade of licensee, ii. 148
- may sue alone in respect of infringements, ii. 156

LIQUIDATOR

- motion to commit, of defendant company, 499
- assignment of patent by, of limited company, ii. 126

LOAN

- may amount to publication, 134

LORD ADVOCATE

- revocation of patent in Scotland at instance of, 293
- revocation of patent in Scotland by persons authorised by, 293

LORD CHANCELLOR

- saving of existing rules made by, ii. 241

LOSS OR DESTRUCTION OF PATENT

- provisions as to, ii. 55

LOST ART

- rediscovery of, as subject-matter, 118

LUNATIC

- may be a patentee, 5
- statutory declaration may be made by committee of, ii. 5

MACHINE

- prior, as a publication of an invention, 141
- useless, is no publication of a useful one, 154

MAKING

- See* MANUFACTURE

MANUFACTURE

- definition of, 23, 60
- within the realm not a condition of the patent, 174
- infringement by, 371, 373
 - articles which may be used for purpose of infringement, 371
 - parts of a combination, 371

MANUFACTURER

- effect of acceptance of agreed damages from, 506
- non-payment of damages by, 506
 - damages may be recovered from user, 506
- and user may be sued in same action, 390

MARRIED WOMAN

- may be patentee, 4
- patent, separate estate of, 4

MASTER—See also SERVANT

- is not entitled to invention of his servant, 14
 - but is entitled to details worked out by his servant, 15
- effect of relationship of, and servant on issue of true and first invention, 12
 - cases illustrative of, 13
- liability of, for infringement committed by servant, 389

MASTER OF THE ROLLS

jurisdiction of, to amend clerical errors in specifications, ii. 76

MASTER PATENT

meaning of, 366

necessity for special reference in applicant's specification to opponents, ii. 45

MECHANICAL EQUIVALENTS

See EQUIVALENTS

MERGER

query whether there is a, when patent vests in the Crown, 126

MERIT

See EXTENSION OF TERM OF PATENT

METHOD—*See also* PROCESS

new, of using old machine may be invention, 42

claim may be for a, and not an apparatus though drawings are referred to, 251

claim mentioning a, nomination may be limited to use of a particular machine, 252

"MISCHIEVOUS TO THE STATE," &c.

commentary on the words, as used in the Statute of Monopolies, 159

MISDEMEANOUR

falsification of entry, &c., in Register of Patents is, ii. 61

punishment for, in Isle of Man, ii. 240

MISREPRESENTATION

a defence to action to recover royalties, ii. 154

MISTAKE

See ERRORS

MODELS

as evidence in action of infringement, 464

costs of, 532

authority of Board of Trade to require, on payment, ii. 217

MONOPOLIES—*See also* STATUTE OF MONOPOLIES

object for which many, were created prior to statute of, 1

oppressive, under Tudor sovereigns, 1

suppression of illegal grants of, 1

by Statute of Monopolies, 2: ii. 197

in new and useful inventions exempted from Statute of Monopolies, 3

remedy of persons aggrieved by illegal, 3

Coke on, 26

in inventions are created by grant of patent, ii. 104.

MORTGAGE

form of, of letters patent, ii. 383

MORTGAGEE

not necessary party to action of infringement by mortgagor, 388

not entitled to petition for leave to amend specification, *query*, ii. 85, 123

can petition for extension, *query*, ii. 123

how entered on Register of Patents, ii. 123

licences granted by, in possession, ii. 132

MORTGAGOR

can maintain action of infringement without mortgagee, 388

MOTION FOR JUDGMENT

See TRIAL; JUDGMENT

- MUNITIONS OF WAR**—*See also* REVOCATION
assignment of patents for inventions of, to Secretary of State for War,
ii. 108
- MUSEUM (PATENT)**
control and management of, ii. 56
models for, how obtained, ii. 56
- NEW TRIAL**—*See also* TRIAL
how obtained, 481
particulars of objections on, 414
power of Court of Appeal to order, 481
course to pursue when judgment obtained by fraud, 481
- NEW USE OF OLD APPLIANCE**
may be subject-matter, 80
if not merely analogous to previous uses, 81
result of the cases, 81
novelty is not alone sufficient to support a patent for a, 83
nor is a mere advantage, 98
cases of void patents for, 84
cases of valid patents for, 99
application of newly discovered quality of matter, 98
- NOTICE**
of acceptance of application for patent, effect of, ii. 12
of acceptance of complete specification, effect of, ii. 18
of opposition to grant of patent, ii. 25
assignment with, of covenants and licences, ii. 121, 122
registration of licence not, to all the world, ii. 59
of appeal to Court of Appeal, ii. 400
of objections to extension of term of patent, ii. 414
- NOTICE OF MOTION**
for leave to amend a specification pending action of infringement, ii. 395
for interlocutory injunction, ii. 396
- NOVELTY**—*See also* ANTICIPATION; COMMON KNOWLEDGE; PUBLICATION;
PUBLIC USE; PUBLIC KNOWLEDGE
consideration of, is entire, 112
partial failure of, is fatal to validity, 112
want of, in a material part is fatal, 113
want of, in subsidiary part not fatal, 115
criterion of, and infringement is not the same, 348
distinction between, and discovery, 116
distinction between issue of, and subject-matter, 460
documentary publications and their effect, 140
always a question of fact, 142
different documents combined, 154
mosaic of extracts, 155
prior document to be fatal must disclose all essentials of the invention,
151
though actual user need not be proved, 146
sufficiency of a prior specification is not the crucial test of publi-
cation, 148, 150
exhibition at industrial or international exhibitions, 132
essential to validity, 105
essential to every claim, 112
fiduciary communications, 131, 140
general statement as to a class, 153
highly scientific inventions, 152
importation of article made abroad and its effect on, 137
loan of an article prior to application for a patent for it, 134
manufacture by person confidentially related to patentee, 134
not every, is subject-matter, 31, 108

NOVELTY—(continued)

- of application not conclusive evidence of invention, 89
- of result not necessarily conclusive evidence of novelty of process, 50
- personal communications made by the patentee and their effect, 140
- prior use, 107, 119
 - by persons other than patentee is fatal to validity, 107
 - by person in conjunction with the patentee, 107
 - in colony no publication, 135
 - of equivalents, 118
 - secret
 - by patentee himself, 125, 135
 - by persons other than the patentee, 136
- proof of, in action of infringement, 461
- provisional specifications as means of publication, 145
- public knowledge, 108
 - meaning of, 108
- public use, 126
 - meaning of, 126
 - use in public as distinguished from use by the public, 127
 - cases, 128
- publication without actual user is fatal, 146
- rediscovery of lost art, 118
- requisite at common law, 105
 - declared by Statute of Monopolies, 106
- sale of article prior to application for a patent for it, 133
- subsidiary claim to something old not necessarily fatal, 115, 260
- suggestion of an invention is not necessarily publication, 147
- test of, 109
 - per Hatherley, L.C., 110
 - per Westbury, L.C., 110

OATH

- power of law officer to examine witnesses on, ii. 216

OBJECTIONS

- See* PARTICULARS

OBSTRUCTION OF SUBSEQUENT IMPROVEMENTS

- validity of patents used for, 160

OBTAINING PATENT

- See* CROWN; PATENT AGENTS; APPLICATION; SPECIFICATION; OPPOSITION; SEALING THE PATENT; EXTENT AND DURATION OF PATENT

OFFENCES UNDER ACT OF 1883

- See* STATUTORY OFFENCES

OFFICERS AND CLERKS (PATENT OFFICE)

- appointment and removal of, ii. 232
- salaries of, ii. 232

OFFICIAL

- sometimes incapacitated from being patentee, 20

OFFICIAL SEARCH FOR NOVELTY

- is made by examiners, ii. 6

OMISSION

- of parts may constitute invention, 11

ONE INVENTION

- application for patent should comprise only, ii. 6
 - inclusion of more than, does not affect validity of patent if granted, ii. 6
- test of, ii. 9

ONE INVENTION (continued)

amendment to, that is required, ii. 6
 examples of amendments required in limit applications to, ii. 8

OPPOSITION TO GRANT OF PATENT

regulated by s. 11 of Act of 1900, ii. 83
 and Patent Rules, which apply to, ii. 83
 extension of time for, to be set from the first refusal, ii. 83
 withdrawal of, does not entitle applicant to proceed, ii. 87
 bogus, for purpose of obtaining date of issue, ii. 83
 form of, ii. 95
 notice of, ii. 95
 when and how to be given, ii. 95
 applicant is furnished with a copy of by the Comptroller, ii. 83
 amendment of, ii. 95
 evidence of opponent and applicant, ii. 83
 times within which statutory declarations may be filed at the Patent Office, ii. 95
 copies of statutory declaration to be delivered to opposite party, ii. 96
 effect of filing multiplicity of inconsistent statutory declarations, ii. 96
 effect of not filing, ii. 96
 closing of, ii. 96, 97
 limited to declarations filed in due course except with leave, ii. 96
 hearing, ii. 96
 time for, fixed by Comptroller, ii. 96
 notice of, to be given to the parties, ii. 97
 application by either party to be heard is necessary, ii. 97
 decision when neither party applies to be heard, ii. 97, 98
 practice as to the hearing, ii. 97
 notification to parties of Comptroller's decision, ii. 97
 appeal from Comptroller's decision to law officer, ii. 97
 evidence on, ii. 97
 cross examination of witnesses, ii. 99
 assistance of expert on, ii. 99
 opponent not obliged to furnish applicant with copy of notice of appeal, ii. 99
 conditions may be imposed by Comptroller or law officer, ii. 99
 patent is only refused if ground of opposition is proved, ii. 99
 in case of abandonment of, ii. 97
 costs, ii. 99
 grounds of opposition, ii. 94
 only three, are possible, ii. 94
 (1) Applicant has obtained the invention from the opponent or a person of whom he is the legal representative, ii. 94, 95
 legal representative, ii. 95
 issue of time and date invention is not open, ii. 95
 experiments of persons other than the applicant, ii. 95
 objection that succeed in part, ii. 95
 patent void if evidence conflicting, ii. 95
 employer and employed, ii. 95
 assignment of unpublished and unpublished inventions, ii. 95
 fraud committed abroad does not prejudice applicant in respect of a discontinued invention, ii. 95
 rights of foreign inventor, ii. 95
 opponent may be made joint grantee, if he invented part, ii. 95
 condition that opponent be made a joint grantee, ii. 95
 concurrent applications, ii. 95
 condition that grantee shall assign a share may be required in the interests of justice, ii. 95
 separate patents to rival applicants, ii. 95
 applicant's intention only an impeachment on opponent's, ii. 95
 fact that, that is required to be stated in applicant's specification, ii. 95

OPPOSITION TO GRANT OF PATENT—(continued)

grounds of opposition—(continued)

only three, are possible—(continued)

(2) the invention has been patented in this country on an application of prior date, ii. 24, 34

particulars of prior patent are requisite, ii. 309

locus standi of opponent on this ground may be questioned, ii. 34only persons having a direct interest in prior patents have *locus standi*, ii. 34assignee under prior patent has *locus standi*, ii. 34person whose complete specification has been accepted has a *locus standi*, ii. 36mere agent of prior patentee has no *locus standi*, ii. 35person about to work under a prior patent has a *locus standi*, ii. 35person having a *locus standi* may rely on specifications other than his own, ii. 35law officer does not lightly overrule Comptroller on question of *locus standi*, ii. 36only question is whether the invention has been already patented, *i.e.*, claimed, ii. 36, 37

in doubtful cases patent is allowed, ii. 36

prior description without claim is immaterial, ii. 37

e.g., a provisional specification, ii. 37

ambit of opponent's claim may be disputed, ii. 37

conjoint effect of several prior grants, ii. 38

patent is refused in cases of no appreciable difference between opponent's and applicant's claims, ii. 38

mechanical equivalents, ii. 39

question of infringement of prior patent is not considered, ii. 39

validity of prior patent is immaterial, ii. 39

notice of this ground of opposition must be distinct, ii. 39

claim by applicant to something not foreshadowed in provisional specification of prior patentee, ii. 40

expiration of prior patent is immaterial, ii. 40

means of giving effect to the principle that no claim is to be allowed which is wide enough to include something already claimed, ii. 41

disallowing a claim or ordering its modification, ii. 41

applicant should avoid necessity for amendment of claims, ii. 49

general or special disclaimers, ii. 41

legitimate objects for which, are ordered, ii. 46

difference in effect of, ii. 48

grounds on which required, ii. 42

general disclaimers are more usual, ii. 45

special disclaimers, ii. 43-48

principles upon which, are ordered, ii. 43

where requisite, ii. 44

opponent seeking, must give evidence of state of knowledge, ii. 45

not allowed when opponent has a practically concurrent application, ii. 44

appeal from Comptroller may be limited to question of special disclaimer, ii. 50

difference between, and a general disclaimer in terms of opponent's claim, ii. 48

agreement between parties as to the meaning of a specification, ii. 48

OPPOSITION TO GRANT OF PATENT—(continued)

grounds of opposition—(continued)

only three, are possible—(continued)

- (9) the complete specification describes and claims an invention other than that described in the provisional specification, and such other invention forms the subject of an application made by the opponent in the interval between the hearing of the provisional specification and the complete specification, ii. 24, 50
- disconformity and this ground of opposition, ii. 50
- object and effect of this ground, ii. 50
- duties of Comptroller and law officer when this ground is raised, ii. 50
- illustration of this ground, ii. 51

ORDER

- conditions of, for inspection, 452
- scope of, for account of profits, 497
 - for assessment of damages, 497
- effect of, for revocation of patent, 308
- form of, for revocation of patent, 308: ii. 83, 443
 - when all claims are bad, ii. 83
 - when some claims are good, ii. 85
 - when patent was obtained in fraud of rights of petitioner, 300
- for further and better particulars, ii. 443
- for leave to amend specification during action of infringement, ii. 444
- for leave to amend specification pending petition for revocation, ii. 445
- for inspection, ii. 445
- for reference to independent expert report to the Court during action of infringement, ii. 446
- for experiments before scientific expert and his report to the Court during action of infringement, ii. 446
- for an inquiry as to damages, 504
- proper, when defendant has paid money into Court and plaintiff succeeds in action of infringement, 440

ORDER IN COUNCIL

retrospective effect of, under s. 103 of Act of 1883.. ii. 20

PALATINE COURT (LANCASTER)

See COURT OF COUNTY PALATINE OF LANCASTER

PARLIAMENT

- rules to be laid before, ii. 236
- reports of Comptroller to be laid before, ii. 236
- special Act of, necessary to revive a lapsed patent, ii. 54

PARTICULARS

of breaches

- in action of infringement, 395
 - are necessary, 395
 - and must accompany statement of claim, 395
 - or be delivered, by order, subsequently, 395
 - evidence is restricted to, 395, 454
 - unless leave of Court obtained, 395, 454
 - amendment of, 396
 - further and better, 396
 - by order of Court or a Judge, 396
 - Court of Appeal, 396
 - must be reasonable and proper, 396
 - sufficient if with pleadings they give defendant notice of the case to be made against him, 396
 - must state how the patent has been infringed, 397
 - a user is entitled to fuller particulars than a manufacturer, 397

PARTICULARS—(continued)

of breaches—(continued)

in action of infringement—(continued)

must specify which claims have been infringed, 398

if necessary by reference to pages and lines of the specification, 398

though the claims need not be specially referred to, 398

specific instances of infringement must be alleged, 398

but certain general words may be allowable, 399

by way of example and not limitation, 399

when action is based solely on threats to infringe, 399

precedents of, ii. 389

in action to restrain threats of legal proceedings, 324

plaintiff may be entitled to, 324

of objections

on petition for revocation, 301

on petition for extension, are requisite, ii. 171—see EXTENSION OF TERM OF PATENT

in action to restrain threats of legal proceedings, 324

defendant may be entitled to, 324

in action of infringement, 412

are necessary, 412

when novelty is disputed, 412

or patent otherwise alleged to be invalid, 412

plaintiff may be required to give, when he disputes validity of a prior grant, 405

must be delivered with defence, 412

or by order, subsequently, 412

evidence limited to, 412, 454

discretionary power of Court or a Judge to admit evidence not within, 412, 454

do not stand in place of pleas, 402, 412

cannot go beyond pleas, 402, 412

must give more detailed information than the pleas, 402, 412

more detail is required in particulars of objections than in particulars of breaches, 412

amendment of, 413

terms usually imposed when leave given for, 414

order when plaintiff elects to continue before the terms of the order are settled, 416

in cases of amendments, 415

further and better, 412, 413

should be applied for without delay, 413

time for pleading after order for, 412

costs of, 412

form of order for, ii. 443

non-compliance with order for, 413

fresh particulars cannot be given under an order for, 413

but can be given at any time by leave of the Court or a Judge, 413

on new trial, particulars may be given which were not raised at the first trial, 414

further evidence on appeal, 416

objects of, 416

requisites of

reference to specific claims of plaintiff's specification, 417

as to true and first inventor, 417

as to subject-matter, 417

as to prior grant, 417

as to novelty, 418

must not be too general, 418

objections to general plea, 418, 420

general user may be stated in general but not too indefinite terms, 418, 420

common knowledge, 418

how objection should be raised, 419

- PARTICULARS—(continued)**
of objections—(continued)
in action of infringement—(continued)
requisites of—(continued)
as to novelty—(continued)
common knowledge—(continued)
specifications and rare books cannot be referred to
as anticipations under a plea of, 419
distinction between issue of, and prior publication,
420
specific prior users or publications, 422
difference between requisites of Acts of 1852 and
1888 respectively, 423
publication by prior specifications and printed books,
424
reference to pages and lines requisite, 425
reference to plaintiff's claims requisite, 425
as to disconformity, 417
as to insufficiency of specification, 425
greater detail required under Act of 1888 than formerly,
426
as to non-payment of fees, 426
precedents of, ii. 393
certificate as to, 518
is necessary on taxation of costs in action of infringement, 518
but not on petition for revocation, 308
query in action to restrain threats, 328
omission to ask for, at the trial, 519
power of Court of Appeal and House of Lords as to, 519
practice of Court of County Palatine of Lancaster as to, 519
is granted (1) when particulars have been proven; (2) when in the
opinion of the Court or a Judge they were reasonable and proper,
520
when action is discontinued, 521, 528
when action not tried out on all issues, 521
in case of judgment by default, 523
rule that Court will only certify such particulars as materials before
the Court enable it to say are reasonable and proper, 521
illustrations of the working of the rule, 521
though validity is not decided, the certificate may be given on the
ground that the particulars were necessary for the decision of
another issue, 521
action in respect of several patents, 524

PARTIES

- petition for revocation, 301
action of infringement
all persons interested in the patent should be, before the Court, 387
all co-patentees should be made, in action at instance of one, 387 :
ii. 112
misjoinder of, 388
nonjoinder of, 388
adding, 388
foreigner, 390
plaintiff, 387
agent, 388
assignee, 387
cestui que trust, 388
co-owner, 387
owner of distinct part, 387
licensor alone may be, ii. 156
but not so a licensee, ii. 156
unless the licence amounts to an assignment, ii. 156
married woman, 387
mortgagee, 388
mortgagor, 388

PARTIES—(continued)

action of infringement—(continued)

plaintiff—(continued)

patentee, 387

trustee, 388

transfer of plaintiff's rights pending action, 389

person who has no right to sue cannot amend by joining person entitled to sue, 388

defendant, 389

agent, 389

any person who takes part in an infringement, 389

company, 389

consignee of goods shipped from abroad, 391

director of a company, 389

firm as distinct from a partner, 389

foreign sovereign, 382

foreigner, 390

who is not an importer, 390

manufacturer and purchaser may be made co-defendants, 390

master, 389

principal, 389

servant, 389

user, 390

when different infringers must be made, to different actions, 391

separate actions must be brought against infringers of separate patents, 391

person who has indemnified the, may be allowed to take part in the action, 391

PARTNER

estoppel of former, from disputing validity of patent, 410

rights of, in patented invention, ii. 124

PARTNERSHIP

may be created by assignment of share in a patent, ii. 124

"PASSING OFF"

goods as and for those of a patentee or other person, 333

right of action in respect of, 333

claim for injunction to restrain infringement or in the alternative, 334

PATENT

viewed as a bargain between public and patentee, 106, 172, 202, 331

assignment of—*see* ASSIGNMENT

consideration necessary for grant of, 105, 112, 158, 166, 174

co-owners rights in, 110

date of, ii. 53

antedating, ii. 53

definition of, ii. 220

is a franchise, 473

is a chose in action, ii. 127

destruction of, ii. 216

duplicate of, ii. 55

form of application for, ii. 364

effect of grant of, 105, 290

expiry of, prior to judgment, 438, 496

extent of, ii. 53

extension of—*see* EXTENSION OF TERM OF PATENT

should be for one invention only, ii. 6

form of, ii. 373

how, is obtained—*see* OBTAINING PATENT

interpretation of, 331

former spirit of, 331

modern spirit of, 331

loss of, ii. 216

master, meaning of, 366

PATENT—(continued)

- pioneer, meaning of, 366
- registration of—*see* REGISTER OF PATENTS
- revival of lapsed, ii. 54
- revocation of—*see* REVOCATION
- sealing of, 51
- security of public against illegal, 334
- surrender of, ii. 130
- term of, ii. 53
 - conditional on payment of fees, ii. 54

PATENT AGENT—*See also* AGENT

- definition of, ii. 249
- usually employed by applicants for patents, ii. 2
- may sign documents other than the application or notice of abandonment
 - on behalf of applicant, ii. 2
- qualifications of, ii. 2
- registration of, ii. 3
 - fees, in reference to, ii. 448
- rules affecting—*see* REGISTER OF PATENT AGENTS' RULES
- communications between, and patentee are not privileged, 445
- no penalty for practising as a, without description as, ii. 3

PATENT MUSEUM

- control and management of, ii. 56, 217
- models for, ii. 56, 217

PATENT OFFICE

- and proceedings thereat, ii. 231
- hours of business, ii. 315
- officers and clerks, ii. 232
- seal of, ii. 232
- provision as to days for leaving documents at, ii. 235
- provision for closing, on certain days, ii. 235, 315
- transmission of certified printed copies of specifications, &c., ii. 235

PATENT RULES, 1903..ii. 304

- statutory force of, ii. 236
- short title, ii. 304
- commencement, ii. 304
- interpretation, ii. 304
- fees, ii. 304, 449
- forms, ii. 345—*see also* FORMS
- applications for patents, ii. 305
 - by representative of deceased inventor, ii. 305
 - address for service, ii. 305
 - order of recording, ii. 305
 - extension of time for leaving and accepting complete specification, ii. 305
 - notice and advertisement of acceptance, ii. 305
 - inspection of complete specification, ii. 306
- applications, under the International Convention, ii. 306
 - convention applications, ii. 306
 - foreign specification, &c., to accompany application, ii. 306
 - public inspection, ii. 306
 - proceedings, ii. 306
- size, &c., of documents, ii. 306
- drawings accompanying specifications, ii. 306
- statutory declarations and affidavits, ii. 307
 - form, &c., of, ii. 307
 - manner in which, are to be made, ii. 307
- industrial or international exhibitions, ii. 308
- exercise of discretionary powers by the Comptroller, ii. 309
 - notice of hearing, ii. 308
 - notice by applicant, ii. 308
 - Comptroller may require statement, &c., ii. 309

PATENT RULES, 1903—(continued)

- exercise of discretionary powers by the Comptroller—(continued)
 - decision to be notified to parties, ii. 808
- opposition to grants of patents, ii. 808
 - notice of opposition, ii. 808
 - copy for applicant, ii. 808
 - evidence in support of allegation that invention has been obtained from opponent, ii. 808
 - attendance of declarant on Comptroller, ii. 808
 - particulars of prior patent, ii. 809
 - opponent's evidence, ii. 809
 - applicant's evidence, ii. 809
 - evidence in reply, ii. 809
 - applicant's evidence if opponent does not leave statutory declarations, ii. 809
 - opponent's evidence, ii. 809
 - evidence in reply, ii. 809
 - closing of evidence, ii. 809
 - hearing, ii. 809
- amendment of specification, ii. 810
 - request for leave to amend, ii. 810
 - leave by order of Court, ii. 810
 - notice of opposition, ii. 810
 - copy for applicant, ii. 810
 - opponent's evidence, ii. 810
 - further proceedings, ii. 810
 - applicant's evidence of opponent's does not leave statutory declarations, ii. 810
 - further proceedings, ii. 811
 - requirements on amendment, ii. 811
- register of patents, ii. 811
 - entry of grant, ii. 811
 - entry in respect of convention application, ii. 811
 - alteration of address, ii. 811
 - request for entry of subsequent proprietorship, ii. 811
 - form and signature of request, ii. 811
 - particulars to be stated in request, ii. 811
 - production of documents of title and other proof, ii. 812
 - copies for Patent Office, ii. 812
 - body corporate, ii. 812
 - entry of orders of the Privy Council or of the Court, ii. 812
 - entry of date of payment of fees on issue of certificate, ii. 812
 - entry of failure to pay fees, ii. 812
 - entry of notification of licence, or other document, ii. 812
 - hours of inspection of, ii. 813
 - certified copies of documents, ii. 813
- payment of fees for continuance of patent, ii. 813
 - enlargement of time for, ii. 813
 - certificate of, ii. 813
- compulsory licences and revocation of payments, ii. 813
 - petition for grant of compulsory licence or revocation, ii. 813
 - to be left with evidence at Patent Office, ii. 814
 - opponent's evidence, ii. 814
 - evidence in reply, ii. 814
 - closing of evidence, ii. 814
 - power of Board of Trade to dismiss petition, ii. 814
 - arrangements between parties, ii. 814
 - reference of petition to Judicial Committee, ii. 815
- general, ii. 815
 - power of amendment, ii. 815
 - general power to enlarge time, ii. 815
 - power to dispense with evidence, ii. 815
 - hours of business, ii. 815
 - leaving documents, ii. 816
- agency, ii. 816
- repeal, ii. 816

PATENT RULES, 1905..ii. 317

statutory force of, ii. 296

short title, ii. 317

commencement, ii. 317

interpretation, ii. 317

application for patents, ii. 317

claims, ii. 317

one invention, ii. 317

application for separate patents by way of amendment, ii. 317

procedure under s. 1 of the Patents Act, 1902..ii. 318

power of Comptroller to post-date, ii. 318

provisional report in case of complete anticipation, ii. 318

time for leaving amended specification, ii. 318

extension of time, ii. 318

hearing by Comptroller under sub-s. 6..ii. 319

reference to prior specification, ii. 319

appeal, ii. 319

appeal to law officer, ii. 319

sealing of patent and payment of fee, ii. 319

fees, ii. 320

forms, ii. 320

size, &c., of documents, ii. 320

drawing accompanying specifications, ii. 320

general, ii. 321

requirements as to paper, ii. 321

size of drawings and arrangement of figures, ii. 321

drawings to be suitable for reproduction, ii. 321

drawings to bear name of applicant, &c., but no descriptive matter,
ii. 322

copies of drawings, ii. 322

marking of originals and true copies, ii. 322

delivery of drawings, ii. 322

provisional drawings used for complete specification, ii. 322

PATENTEE

definition of, ii. 220

who may be, 4

corporation, 20

sole, 20

foreigner, 4

infant, 5

legal representative of deceased inventor, 5

lunatic, 5

married woman, 5

person other than true and first inventor, 4

several persons jointly, 4

true and first inventor, 4

persons incapable of being, 19

alien enemy, 20

corporation alone cannot be patentee of an original invention, 20

corporation sole as such, 20

official persons sometimes, 20

the King, 20

evidence of, who has assigned, 456

in respect of foreign application, 18: ii. 19

not entitled to use word "patent" before his patent is sealed, ii. 12

obligation of, to use invention or licence others to do so, 161, 174

entitled to oppose grant of subsequent patent, ii. 24, 34

on bankruptcy of, patent vests in trustee, ii. 125

remedies of, for invasion of his rights, 331

communications between, and patent agent not privileged, 445

communications between, and solicitor privileged, 445

rights of co-patentees, ii. 110

may use invention without liability to account, ii. 113

power to grant licences, ii. 132

quæry without liability to account, ii. 132

PATENTEE—(continued)

rights of co-patentees—(continued)

- power to sue alone, ii. 111
- all co-patentees should be made parties in action at instance of one, 887: ii. 112
- co-patentees cannot dispose of each other's rights, ii. 118
- damages in action at instance of one co-patentee, ii. 112
- patent is granted at peril of, ii. 1

PATENTS ACTS, 1883-1902

- Patents Act of 1883..ii. 202
- Amendment Act of 1885..ii. 245
- Amendment Act of 1886..ii. 247
- Amendment Act of 1888..ii. 249
- Amendment Act of 1901..ii. 257
- Amendment Act of 1902..ii. 258

PAYMENT OF FEES

See FEES

PAYMENT OUT OF COURT

proper order for, when defendant has paid money into Court and plaintiff in infringement action is successful, 440

PENALTIES—See also STATUTORY OFFENCES

- for practising as a patent agent without registration, ii. 2
- for representing an article as patented which is not so, ii. 12
- for unauthorised use of royal arms, ii. 12
- for falsifying Register of Patents or copy therefrom, ii. 61

PERSON

under Act of 1883, includes a body corporate, ii. 242

PETITION

- for extension of term of patent, ii. 165—See EXTENSION OF TERM OF PATENT
- requisites of, ii. 165
- when, may be presented, ii. 167, 168
- amendment of, ii. 167
- advertisement of, ii. 168
 - affidavit of, ii. 169
- application for time for hearing, ii. 169
- proof of advertisements before hearing, ii. 169
- documents to be lodged with, ii. 169
- hearing of,
 - precedents of, ii. 415
- for revocation of letters patent, ii. 290—See REVOCATION; COMPULSORY LICENCES
 - who may present, ii. 291, 293
 - fiat of Attorney-General, when necessary for presentation of, ii. 295
 - how obtained, ii. 295
 - may be given *nunc pro tunc*, ii. 296
 - form of, ii. 409

PIONEER PATENT

See MASTER PATENT

“PITH AND MARROW”

- infringement by taking, of invention protected, 845
- objection to use of the term, 845
 - it may be lawful to take the, of an invention in one sense, 845
 - but never so to take its substance without licence, 845

PITMAN'S CASE

rule in, ii. 186

PLAN

mere, is not subject-matter for a patent, 25

PLEADINGS

in action of infringement,
 usual, 392
 trial without, 392
 inspection necessary for preparation of, 451
 forms of, ii. 386
 in action to restrain threats of legal proceedings, 323
 forms of, ii. 404
 in petition for revocation, 301, 302
 form of petition for revocation, ii. 409

POSSESSION

infringement by, 380

POST

applications for patents and notices, &c., by, ii. 4, 235
 service by sending through, proof of, ii. 235

PRECEDENTS

See FORMS

PREROGATIVE OF CROWN

saving for, by Act of 1883.. ii. 241

PRESCRIBED

definition of, ii. 242

PRESIDENT OF BOARD OF TRADE

exercises powers of Board of Trade, ii. 255
 certificate of, conclusive evidence, ii. 255

PRICE

reduction of, by patentee, effect on damages, 505
 reduction of, by defendant, effect on damages, 505

PRINCIPAL

as defendant to action for infringement, 389

PRINCIPLE

is not subject-matter, 43
 application of a, may be subject-matter, 44
 illustrations, 46
 if principle be new, means may be old, 51
 if principle and means be both new, means may be claimed separately,
 51
 distinction between a general arrangement and a, 50
 claim to all methods of application amounts to a claim to the principle, 45
 ambit of claim for carrying a new, into effect, 51
 ambit of claim for carrying an old, into effect, 53

PRINCIPLE OF THE INVENTION

meaning of, 340
 importance of determining, in questions arising on the patent, 340
 protected though not referred to in the claim, 280

PRIOR GRANT

a defence to an action on a patent, 404
 a ground for revocation, 297
 validity of, in case of concurrent applications, 405
 particulars of objections as to, 405

PRIOR USE

See NOVELTY; PUBLICATION; SECRET USER

PRIVILEGED COMMUNICATIONS

communications between patentee and patent agent not, 445

PRIVY COUNCIL

- revocation of patent by, 291 : ii. 136
- power of, to call in aid of an assessor, 305
- extension of term of patent upon petition to, ii. 161
- petition to, referred to Judicial Committee, ii. 161

PRIVY COUNCIL, RULES

RULES OF 1898..ii. 328

- advertisement of intention to petition under s. 25 of the Act of 1883.. ii. 328
- presentation of the petition and accompanying affidavits, ii. 329
- application for time for hearing and advertisement of the same, ii. 329
- documents to be lodged by petitioner at the Council Office, ii. 329
- caveats*, when to be entered, ii. 330
- service of petition, ii. 330
- copies of opponent's grounds of objections, when to be lodged, ii. 330
- obtaining copies of papers lodged at the Council Office, ii. 330
- how documents are to be printed, ii. 330
- taxation of costs, ii. 330
- non-compliance with rules, ii. 33
- right of audience of Attorney-General or other counsel for the Crown, 351

RULES OF 1903..ii. 332

- application to fix a time for hearing, ii. 332
- notice of application for hearing, ii. 333
- caveat*, ii. 333
- documents to accompany application for hearing, ii. 333
- time for hearing not to be less than four weeks from application for fixing the same, ii. 333
- statements in affidavits may be disputed upon hearing, ii. 334
- caveators* required to serve notice of objections on petitioner, ii. 334
- form of petition and other documents, ii. 334
- solicitors and agents, ii. 334
- applications for hearing to be addressed to Registrar of Privy Council, ii. 335
- power to excuse compliance with rules, ii. 335
- evidence, ii. 335
- reference of matters to be examined and reported on, ii. 335
- Attorney-General or other counsel on behalf of the Crown, ii. 335
- costs, ii. 336

OLD RULES, ii. 325

- advertisement of intention to petition under s. 2 of 5 & 6 Will. IV. c. 83... ii. 325
- advertisement of intention to petition under s. 4 of 5 & 6 Will. IV. c. 83... ii. 325
- time within which petition must be presented, ii. 326
- affidavits of advertisements to accompany petition, ii. 326
- service of petition, ii. 326
- notice of objections to be lodged at the Council Office, ii. 326
- obtaining copies of papers lodged at the Council Office, ii. 326
- costs, taxation of, ii. 326
- documents to be lodged at Council Office on petition for extension, ii. 327
- Crown to be represented at hearing, ii. 327

PROCESS—See METHOD

- may be subject-matter, 53, 61
- history of the cases, 53
 - Crane *v.* Price settled the law, 55
 - but decision in, is doubtful on the facts, 55
 - which consists merely in the omission of a step hitherto thought to be necessary, 61
- not so wide a term as "manufacture," 60
- not every novel, is good subject-matter, 56
- combination of one, with another, may be subject-matter, 72

PROCESS—(continued)

- consisting in application of hitherto hidden and unperceived property
may be good subject-matter, 58
- examples, 58
- discovery of theory of a, formerly carried out empirically is not subject
matter, 57
- objection to the term "patentable process," 59
- ambit of claim for a, which achieves a new result, 62
- ambit of claim for a, which achieves an old result, 62
- rights of discoverer of secret, 332
- discovery as regards trade secret, 444, 452

PROCTOR v. BENNIS

- type of case to which doctrine of infringement by substitution of equiva-
lents is applicable, 355, 358, 366
- facts in, 358
- rule in, 359
- instances of application of, 356, note (n), 360

PRODUCT

- may be good subject-matter, 64
- when claim for a product is good, 65
- when not, 65
- ambit of legitimate claim for new, 66
- ambit of claim for new means of producing an old, 67

PROFIT—See ACCOUNT OR DAMAGES

- does not render experimental user fatal to novelty, 124
- pecuniary, is not condition precedent to liability in respect of infringe-
ment, 375

PROLONGATION OF PATENTS

See **EXTENSION OF TERM OF PATENT**

PROPERTY

- in infringing articles remains in the infringer, 25, 509

PROPORTIONS,

- mere variation of, no invention, 42
- effect of statement of, on sufficiency of specification, 212
- claim may embrace, not stated, 212
- claim may be limited to specific, stated, 212, 335

PROPRIETORS

See **REGISTER OF PATENTS**

PROVISIONAL PROTECTION—See also SPECIFICATIONS

- statutory provision for, ii. 207
- nature and effect of, 187
- object of, 187
- applicant enjoys, against effects of publication, 131
- foreign applicant, 131
- legitimate developments of the invention during period of, 188
- always a question of fact, 189
- improvements in detail, 189
- when, should be claimed and when not, 233
- better and different methods, 189

PROVISIONAL SPECIFICATION

See **SPECIFICATIONS**

PUBLIC

- protection of, against illegal patents, 334

PUBLIC AUTHORITY

- entitled to solicitor and client costs if successful, 531

PUBLIC KNOWLEDGE

- meaning of, 108
 - per Jessel, M.R., 109
- test of novelty, 109
 - per Hatherley, L.C., 110
 - per Westbury, L.C., 110
- at date of specification may affect its construction, 283, 285, 354, 467
- effect of, on question of infringement by substitution of equivalents, 354
 - i.e.*, affects ambit of patentee's claim, 355
- effect of, on subject-matter, 39, 108, 155, 418, 460
- how objection of, should be raised, 419
 - specifications and rare books cannot be referred to under a general plea of, 419
 - distinction between plea of common knowledge and prior publication, 420

PUBLIC USE

- meaning of, 126
 - use in public as distinguished from use by the public, 127
 - cases, 128
- applicant for patent is provisionally protected against, 131
- prior, of one specimen sufficient to invalidate a patent, 126
- prior, in colony no publication, 135
- what amounts to publication by, 119
- unsuccessful experimental, no publication, 119
- prior, of completed invention though discontinued is fatal to validity, 121, 130
- abandoned, *prima facie* presumed to have been incomplete, 121
 - illustrative cases, 121
- prior experimental, though profitable is not necessarily fatal, 124
- prior use whether public or not by persons other than patentee invalidates the patent, 107, 136
- patentee cannot restrain a prior use public or otherwise, 332
- publication by description without actual, 146
- during period of provisional protection, 131

PUBLICATION—See also ANTICIPATION; NOVELTY

- must be clear to invalidate a patent, 7
- applicant for a patent is protected against his own, 131
 - protection afforded to foreign applicant, 131
- distinction between a prior machine and a document as a means of, 141
- distinction between issue of common knowledge and, 420
- distinction between, and anticipation, 117
- no, of specifications abandoned before acceptance of complete, 145: ii. 13
 - except in cases under the convention, ii. 13, 257
- documentary, 140
 - always a question of fact, 142
 - unless all essential features are disclosed, a prior document is no, 151
 - sufficiency of description in a prior document necessary to render it a, 148
 - rule in *Hill v. Evans*, 148
 - explained, 149
 - highly scientific inventions, 152
 - sufficiency of specification is not the crucial test of publication by it, 150
 - document which points away from patentee's claim is no, 145
 - description of a useless machine is no, of a useful one, 154
 - but it may affect the question of subject-matter, 460
 - general statement as to a class is no, of invention which consists in selecting a particular member, 153
 - proof of actual use of invention described in a prior document is not necessary, 146
 - proof that patentee saw document not necessary, 142
 - document sometimes public property the moment it is written, 144
 - suggestion merely in a document, 147
 - terms of art may differ in meaning in different documents, 144

PUBLICATION—(continued)

documentary—(continued)

- foreign books as, 141
- prior provisional specifications, as, 145
 - power of Court to order production of, 145
- no publication of reports of Patent Office examiners, ii. 18
- combined effect of different documents, 154
 - mosaic of extracts from different documents, 155
- drawing may be, 153
- exhibition at industrial or international exhibitions prior to application, 182
- by importation of article made abroad, 187
- what is not a, may narrow ambit of patentee's claim, 153
- what would be an infringement if of later date than a patent is not necessarily a, 152
- by loan, 184
- manufacture by person confidentially related to the patentee, 184
- by offering for sale, 193
- by personal communication, 140
- by prior experiment, 120
 - law as to, stated by Tindal, C.J., 120
 - a question of fact, 121
 - unsuccessful experiment, 119
 - abandoned user *prima facie* presumed to have been incomplete, 121
 - illustrative cases, 121
- by prior user, 119—*see also* PUBLIC USE
- by persons other than the patentee, 107, 136
- by person in conjunction with the patentee, 107
- analogous use may or may not be, 116
- prior user of equivalents as, 118
- prior use in a Colony no, 135
- prior public use though abandoned is fatal. 121, 122
- prior secret though profitable user no, 124, 135

PURCHASE

- infringement and, 377

PURCHASER—See also VENDEE

- defendant to action of infringement, 390
- damages from, from manufacturer, 506
- rights of—*see* INFRINGEMENT—sale
- no redress against unlicensed vendor in absence of express warranty, 320

REBUTTING EVIDENCE

- See* EVIDENCE

RECITAL

- estoppel in virtue of, implying validity of patent, ii. 149

RECTIFICATION OF REGISTER

- See* REGISTER OF PATENTS

REDISCOVERY

- query*, of a lost art is subject-matter, 118

REDUCTION, ACTION OF

- proceedings for revocation in Scotland are in the form of an, 293

REFEREE

- questions in action of infringement which may be referred to a, 477
 - illustrations, 477
- usual course as to report of a, and counsel's comments thereon, 477

REGISTER OF PATENT AGENTS' RULES

- RULES OF 1889.. ii. 337
 - register to be kept, ii. 337
 - contents of register, ii. 337

REGISTER OF PATENT AGENTS' RULES—(continued)

RULES OF 1889—(continued)

- printed copies to be published annually, and to be evidence of contents of register, ii. 337
- registrar, ii. 337
- registration of persons who were patent agents prior to the passing of Act of 1888.. ii. 338
- final qualifying examination for registration, ii. 338
- exemption of pupils and assistants from preliminary examination, ii. 338
- qualification of persons generally for registration, ii. 338
- final qualifying examination to be held by the Institute, ii. 339
- correction of names and addresses in the register, ii. 339
- erasure of names of deceased persons, ii. 339
- erasure of names of persons who have ceased to practice, ii. 339
- erasure of names for non-payment of fees, ii. 339
- registrar to act on evidence, ii. 340
- erasure of incorrect or fraudulent entries, ii. 340
- erasure of names of persons convicted of crimes, and persons found guilty of disgraceful conduct, ii. 340
- restoration of erased name, ii. 340
- inquiry by Board of Trade before erasure of name from register, ii. 341
- appeal to Board of Trade, ii. 341
- notice of appeal, ii. 341
- case on appeal, ii. 341
- transmission of notice of appeal to Board of Trade, ii. 341
- directions as to hearing of appeal, ii. 341
- notice of hearing of appeal, ii. 341
- hearing and decision of appeal, ii. 341
- fees, ii. 341, 447
- alteration of regulations, ii. 342
- report to Board of Trade, ii. 342
- definitions, ii. 342
- commencement, ii. 342
- title, ii. 342
- Board of Trade powers as to, ii. 3
- validity of, ii. 3
- infraction of, ii. 3
 - proper party to prosecute for, ii. 3

RULES OF 1891.. ii. 343

- transfer of powers and duties of Institute of Patent Agents to Chartered Institute, ii. 343
- saving rights, privileges, acts, appointments, and regulations under Rules of 1889.. ii. 343
- publication of register, ii. 344
- alteration of Appendix B, ii. 344
- commencement and citation, ii. 344

REGISTER OF PATENTS

- statutory provisions as to, ii. 212
- kept at the Patent Office, ii. 56
- former, to be deemed part of present, ii. 57
- prima facie* evidence of matters authorised to be entered thereon, ii. 57
 - certificate of Comptroller, ii. 59
- copies of documents affecting proprietorship of patents are to be supplied for entry on, ii. 56
- facts relating to ownership may be entered on, ii. 58, 60
 - but not legal inferences to be drawn therefrom, ii. 58, 60
- registration of amendments, ii. 56
 - notification of amendments of specifications to be entered on register, ii. 56
- registration of assignments, ii. 56, 127
 - should be immediate, ii. 128
 - practice on, ii. 128
 - quarry* condition precedent to right to sue, ii. 128
 - quarry* has a retrospective effect, ii. 129

REGISTER OF PATENTS—(continued)

- request for notification of applications to enter documents on, ii. 56
- registration of licences, ii. 152
 - all licences should be registered, ii. 152
 - not notice to all the world, ii. 59
- registration of mortgages, ii. 56, 123
 - how mortgagees are entered on register, ii. 128
- registration of orders
 - for extension of term of patent, ii. 193
 - for revocation of patent, 307
- notices of trusts, as such, cannot be entered on, ii. 58
 - but documents which affect the proprietorship, *e.g.*, equitable assignments can, ii. 58
- documents which create neither legal nor equitable interests cannot be entered on, ii. 58
- documents of earlier date than the patent, ii. 58
- not notice to all persons, ii. 59
- fee for each entry on, ii. 450—*see* FEES
- inspection of, ii. 59
- evidence of entries on, ii. 59
- rectification of, ii. 59
 - order in Council, ii. 60
 - by Court of a Judge, ii. 59
 - appeal from order for, made by, ii. 60
 - extension of term of patent, ii. 60, 193
 - order affecting validity or proprietorship of patent, ii. 60
 - in respect of proceedings in Scotland or Ireland, ii. 61
- falsification of, ii. 61
- form of request to enter name upon, ii. 362
- form of request to enter notification of licence on, ii. 363
- form of notice of alteration of address on, ii. 368
- form of application for entry of order of Privy Council on, ii. 369

REGISTRATION

See REGISTER OF PATENTS

REPAIRS

when executing, is an infringement, 373 : ii. 134

REPEALED ACTS

saving of past operation of, by Act of 1883.. ii. 241

REPORTS

- annual, of Comptroller, ii. 237
- of cases, publication and date of, ii. 55
- of examiners
 - are not published, ii. 16
 - power of Court to order production of, ii. 16
 - effect in cases of rival applications, ii. 17

REPUTATION

damages in respect of loss of, of a patented article, 502

RES JUDICATA

when parties to subsequent action are same as to prior action, 407 : ii. 82
but defendant may petition for revocation of patent, 306, 408

RESTRAINT OF TRADE

See COVENANTS

REVIVAL

of lapsed patent, ii. 54

REVOCAION

- of licence, ii. 139
 - provision for, ii. 139
 - by one party only, ii. 140
 - licence not coupled with an interest is revocable, ii. 140

REVOCACTION—(continued)

of licence—(continued)

licence coupled with an interest is not revocable, ii. 139

deed not necessary for, ii. 140

contract not to exercise power of, ii. 141

of patent, 290

by consent, 305

when patent has expired, 291

effect of, in part of United Kingdom, 292

amendment of specification pending proceedings for, 307

amendment of specification after order for, ii. 82

certificate of validity when proceedings for, fail, 525

condition for, by sovereign on recommendation of Privy Council, 291

delivery up of revoked patent, 307

grant of fresh patent to petitioner, 300

order for, effect of, 308

form of, 304: ii. 83

when all claims are bad, ii. 83

when one or more claims are good, ii. 83

when patent was obtained in fraud of the rights of the petitioner, 300

registration of order for, 307

statutory provision for, ii. 213

in case of improvements in munitions of war, 293: ii. 219

petition for, 290

substituted for older procedure by *scire facias*, 291

jurisdiction of Court of County Palatine of Lancaster, 292

in Scotland action of reduction takes the place of, in England, 293

form of, ii. 409

petitioner for, 293

who may be, 293

unsuccessful defendant to action for infringement may be, 306, 408

when, must obtain the fiat of the Attorney-General in England or Ireland or the Lord Advocate in Scotland, 294

procedure to obtain fiat of the Attorney-General, 295

costs, 296

grounds for, 297

distinction between a false representation in the letters patent and a false statement in the specification, 298

inventions with the same objects, 299

cases of revocation on the ground of fraud on the petitioner's rights, 300

must be strictly proved, 300

patent may be granted to a petitioner who succeeds on this ground, 300

practice on petition for, 301

parties, 301

particulars of objections, 301—*see also* PARTICULARS

at hearing evidence confined to, 302

amendment of, 302

certificate as to, not necessary on taxation, 302

discovery

as in action of infringement, 302

time for application for, 304

inspection

time for application for, 304

interrogatories, 302—*see also* DISCOVERY; INSPECTION

service of petition, 302

out of the jurisdiction, 302

hearing, 304

mode and time of, 304

when case comes on without the Attorney-General's fiat, which is necessary, 296

petition is an action and tried like other actions, 304

REVOCACTION—(continued)

of patent—(continued)

practice on petition for—(continued)

hearing—(continued)

respondent's right to begin, 304

on affidavit evidence, 304

postponement of, pending action on the patent, 305

with witnesses, 304

with assessor, 305

without a jury, 305

at assizes, 305

when respondent consents to revocation, 305

when respondent does not appear, 305

joint petitioners must appear by same counsel, 305

old practice as to non-suits and postponements of actions of

infringement pending *scire facias*, 306

fresh evidence on appeal, 307

stay of proceedings pending appeal, 307

costs, 308

effect of certificate of validity in former action on, 525

RIVAL APPLICATIONS*See* APPLICANT; APPLICATION**ROYAL ARMS**

penalty for unauthorised use of, ii. 12

ROYALTIEScovenant to pay, can be enforced after declaration of invalidity of patent,
ii. 153acceptance of, from assignee estops patentee from disputing assignability
of licence, ii. 145

action to recover, ii. 153

may be founded on the contract, ii. 153

even though the patent has been declared void, ii. 153

fraud & defence to, ii. 154

misrepresentation & defence, ii. 154

determination of licence & defence to, ii. 150

relief in respect of infringement may be an alternative plea in, ii. 155

interest on unpaid royalties, ii. 155

when Court can only estimate royalties due, ii. 155

discretion of taxing-master pending an appeal, ii. 155

paid after, and without knowledge of, breach of covenant by licensor
may be recovered, ii. 154patentee is not bound to accept same, from an infringer as from other
persons, 506**RULES**Judicial Committee, —*see* PRIVY COUNCIL RULESLaw Officers', —*see* LAW OFFICERS' RULESPatent, 1903, —*see* PATENT RULES, 1903Patent, 1905, —*see* PATENT RULES, 1905Register of Patent Agents, —*see* REGISTER OF PATENT AGENTS'
RULES

saving for, existing at date of Act of 1883.. ii. 241

SALARIESmay be credited to petitioner on application for extension of term of
patent, ii. 188**SALE**

effect of, by patentee without restrictions, ii. 135

restrictions as to user may be imposed by patentee on, of patented
article, 377

user in breach of restrictions is infringement, if with notice, 377

when offering for, is publication, 133

SALE—(continued)

- of goods in fraud of a patentee or other person, 333
- of article manufactured without licence of patentee an infringement, 335, 375—*see* INFRINGEMENT
- by licensee with a restriction, 379
- exposure for, by unlicensed manufacturer does not imply warranty, 390
- of component parts of a combination, no infringement, 371—*see* INFRINGEMENT

SAMPLES

- order for inspection may authorise taking of, 453

SATURDAY

- leaving documents, paying fees, &c., at Patent Office, ii. 235

SAVING OF JURISDICTION

- by Act of 1883
 - Courts in Scotland, ii. 239
 - Courts generally, ii. 239
 - remedies in Ireland, ii. 239
 - past operation of repealed enactments, ii. 241
- by Act of 1888
 - things done under Act of 1883 prior to Act of 1888.. ii. 256

SCIENCE AND ART DEPARTMENT

- controls Patent Museum, ii. 56
- models may be required by, on payment, ii. 56

SCIENTIFIC ASSESSOR

- See* ASSESSOR

SCIENTIFIC EVIDENCE

- See* EVIDENCE

SCIRE FACIAS

- petition for revocation substituted for, 291
- any ground on which patents could be repealed by, is a ground for revocation, 297
- grounds for, 297

SCOPE OF INVENTION

- assignor not estopped from disputing, in action at instance of assignee, ii. 116
- importance in actions on the patent of ascertaining, claimed, 338, 340

SCOTLAND

- action of reduction is procedure for revocation of patent in, 293: ii. 239
- penalties for statutory offences in, ii. 12
 - summary proceedings in respect of, ii. 239
- practice as to particulars in patent action in, 395
- in, "injunction" means "interdict," ii. 220
- interdict may be obtained in, against Englishman or other foreigner, 393
- saving for Courts in, as to jurisdiction in patent matters, ii. 239
- general saving of jurisdiction of Courts in, ii. 239

SEAL

- of Patent Office, ii. 232
 - is, *qua* patents, equivalent to great seal of United Kingdom, ii. 51
 - time within which patents must be sealed with, ii. 51

SEALING THE PATENT

- time and manner of, ii. 51

SECRET—See also TRADE SECRETS

- effect of keeping an invention a, ii. 102
- assignment of, invention, ii. 104

SECRET PROCESS

- See* PROCESS; DISCOVERY; INSPECTION

SECRET USE

- effect on novelty of,
 - prior, by patentee himself, 125, 135
 - prior, by persons other than patentee, 136
- patentee cannot restrain a continuance of a, prior to date of patent, 382
- subject of a, may be subject-matter for a patent, 125, 135, 382
- Court will not attempt to protect a, ii. 104

SECRETARY OF STATE FOR WAR

- assignment of patents for inventions of munitions of war to, 108
- may order specifications of inventions assigned to him to be kept secret, ii. 108, 218
- contract by, binds his successors in office, ii. 108

SECRETARY TO BOARD OF TRADE

- may exercise powers of Board of Trade, ii. 255

SECURITY FOR COSTS

See Costs

SEED v. HIGGINS

- rule in, ii. 73

SELLERS v. DICKINSON

- rule in, 253

SERVANT—See also MASTER

- employment of, by an inventor, 12
- invention of, does not belong to master, 14
 - even though made in employer's time and by use of employer's tools, 16
 - but servant may be trustee of patent for master, 16
- as defendant to action of infringement, 389
- order of master does not justify, in infringing a patent, 389
- liability of master for infringement committed by his, 389

SERVICE—See also WRIT

- of petition for extension of term of patent, ii. 171
 - all opponents must be served, ii. 171
- of petition for revocation, ii. 302
 - out of the jurisdiction, ii. 302

SHAPE

- mere alteration of, is not invention, 42
- need not be described in specification, if form is not of the essence of the invention, 231

SHERIFF

- sale of patented article by, under *fi. fa.*, ii. 127
- cannot sell patent under *fi. fa.*, ii. 127

SHERIFF COURT

- prosecution for statutory offences under Patent Acts in, ii. 12

SHIP

- use of patented invention in British, 381
- use of patented invention in foreign, 381

SHORTHAND NOTES

- costs of, 532
- usual agreement as to, 532

SIZE

- selection of a particular, may be invention, 42
- of documents and drawings to be lodged at the Patent Office, ii. 320

SKILL

See WORKMAN

SLANDER

slanderos statements may be restrained apart from s. 82 of Act of 1883..
810

SOLICITOR

communications between patentee and his, are privileged, 445
but not *qua* patent agent, 445

SOLICITOR-GENERAL

"law officer" includes, ii. 242

SOLICITOR AND CLIENT'S COSTS

See Costs

SOVEREIGN

cannot be a patentee, 20
infringement by foreign, 382

SPECIAL REFERENCE

See OPPOSITION TO GRANT OF PATENT

SPECIFICATIONS—See also AMENDMENT OF THE SPECIFICATIONS

origin of, 172
copies of, to be kept on sale, ii. 55
if sealed, are evidence, 472: ii. 233, 234
transmission of certified, to various places, ii. 235
title, 175
virtually a concise statement of the invention, 175
defective, and validity, 175
defect in, may be remedied in body of the specification, 176
should conform to certain rules, 176
must not be too extensive, 176
must not be too narrow, 178
must not be vague or ambiguous, 179
must not misdescribe the invention, 179
must not contain a false suggestion, 180
must be comprehensive enough to include the invention, 181
objection may be taken to, on application for a patent, ii. 6—*see*
APPLICATION
provisional, ii. 182
abandoned, is not published by the Patent Office, 145: ii. 13
power of Court to order production of, 145
effect of publication of, 145
difference between, and complete, 182
is optional, 182: ii. 5
drawings may be required, 186: ii. 5
function of, 182
to avoid disputes as to what the invention was for which the
patent was granted, 183
in case of dispute the question is whether the complete is
excessive, 183
may go beyond the complete, 184
and cannot be impeached as too general, 184
and details referred to in provisional and complete may
differ, 184
and subordinate matters be dropped in the complete, 185
no method of carrying the invention into effect need be stated in, 183
all objects to which invention is applicable need not be stated, 183
provisional protection afforded by, 187
nature and effect of, 187
object of, 187
legitimate development of the invention during, 188
always a question of fact, 189
better and different methods discovered during provisional
protection, 189
improvements in details, 189
sufficiency of, 200
form of, ii. 350

SPECIFICATIONS—(continued)

complete

- if abandoned before acceptance is not published, 145: ii. 13
 - except in cases under the convention, ii. 13, 257
- acceptance of, no guarantee of validity, ii. 18
 - advertisement of, ii. 18
 - period in which acceptance must take place, ii. 18
 - form of application for extension of time for acceptance, ii. 372
 - effect of acceptance, 383: ii. 12, 207
- amended, takes the place of original, ii. 66
- amendment of, before acceptance, ii. 17
- amendment of, after acceptance but before seal, ii. 17
- difficult to draft, 200
- disagreement of joint applicants as to form of, ii. 18
- disconformity between, and provisional, 190. *See* VARIANCE.
 - meaning of, 190
 - fatal to validity, 190
 - amended complete, 191
 - true way to decide questions of fact as to, 191
 - in doubtful cases patent should be sustained, 192
 - effect of detailing advantages in the provisional, 192
 - illustrations of patents held void for, 193
 - illustrations of cases in which the objection as to, failed, 196
 - legitimate developments of the invention, if included in complete
 - do not produce, 188
 - application of invention to objects not contemplated at date of provisional, 183, 193
 - subordinate matters may be abandoned in complete, 185
 - details in complete may differ from those in provisional, 184
 - improvements in details, 189
 - better and different methods not mentioned in provisional, 189, 238
- drawings may be required, 186: ii. 203
 - same drawings may accompany both specifications, ii. 247
 - complete may refer to drawings which accompany provisional, ii. 247
- form of, ii. 351
- must be filed within six, or, upon leave, seven months from date of application, ii. 13
 - form of application for extension of time for filing, ii. 371
- open to public inspection after advertisement of acceptance, ii. 13
- proof of sufficiency of, 265, 466
- reference of, to an examiner before acceptance, ii. 14
 - duties of examiner on, ii. 14
- refusal of, on report of an examiner unless amendment be made, ii. 14
- object of, 199
- requisites of, 201
 - must be *bonâ fide*, 202
 - must not mislead by commission or omission, 202
 - false suggestion, effect of, 204
 - wrong theory of action, effect of, 202
 - must not describe or include methods or things which will not answer, 203
 - distinction between a false method and something useless, 203
 - misstatement of materiality of parts, 205
 - must not give problems to be solved, 204
 - though experiments may be necessary before succeeding, 214, 224
 - invention must be useful for object stated, 204
 - to sanguine statement as to quantum of useful result obtained, 203, 205
 - statement that invention is useful for purposes not specified, 205
 - illustrative cases, 205

SPECIFICATIONS—(continued)

complete—(continued)

requisites of—(continued)

must not be ambiguous, 207

want of clearness, or studied ambiguity, 207

perfect precision in language not possible, 207

meaning of terms is liable to change, 210

meaning at date of patent is the important point, 210

sufficiency of description a question of fact, 211, 220, 221

must not include what will not answer the purpose in view, 208, 222

e.g., proportions of substances mentioned, 212

or members of a class, 280

statement of requisite proportions of ingredients, 212

test of sufficiency, 214, 265, 466

when patentee is agent of foreign inventor, 19

when patentee is importer and also actual inventor, 19

ambiguity may be cured by disclaimer, *ii.* 72but insufficiency cannot be cured by disclaimer, *ii.* 72*quæry*, however, in cases of communicated inventions, *ii.* 72

when necessity for experiments before succeeding is fatal and when not, 214, 224

drawings may aid the description, 288

must be intelligible to an ordinary workman, 217

"ordinary workman" test, 217

sufficiency determined by, 266

statement of law as to ordinary workman test in a particular case, 218

per Parke, B., 218

per Jessel, M.R., 218

per Maule, J., 219

inventions which can be appreciated only by persons of great skill and knowledge, 219

sufficiency when persons of great skill and knowledge would be left in doubt, but others less skilled would succeed, 220

specifications are not addressed to persons wholly ignorant of the subject-matter, 220

persons to whom specifications are addressed are presumed to possess all the existing knowledge common to the trade, 221

but not mere, 221

inaccurate use of words may be explained by context, 222

errors which an ordinary workman would perceive and correct, 222

errors not apparent, 223

errors which amount to a false suggestion, 223

must particularly describe and ascertain the nature of the invention and how the same is to be performed, 225

a statutory as well as a common law requisite, 225

object of the invention must be disclosed, 227

disclosure as far as patentee's knowledge at the time extends is sufficient, 228

invention consisting of several parts, 228

must disclose the best method known to the patentee of carrying out the invention, 231

best method within patentee's knowledge, 231

not necessarily the best possible method, 233

nothing essential must be suppressed, 235

examples of specifications bad for suppression of essentials, 235

if invention is communicated from abroad best method communicated to patentee must be stated, 19

not necessarily best method known to foreign inventor, 19

SPECIFICATIONS—(continued)

complete—(continued)

requisites of—(continued)

must disclose the best method known to the patentee of carrying out the invention—(continued)

all processes claimed need not be equally successful, 237

no objection that patentee himself does not know which is commercially best, 237

when improvement discovered during period of provisional protection should be included and when not, 238

must distinguish what is old from what is new and claim only the latter, 241

if a combination is new, it is not necessary to distinguish new from old parts, 242

if subject-matter is an improvement, it must be distinguished from old parts, 242

i.e., specification must condescend upon the improvement and claim that only, 242

rule in *Foxwell v. Bostock*, 244

explanation of, 245

effect of not distinguishing new from old parts when both fall within the claim, 242

need not mention everything which will produce the desired result, 240

need not describe any step or process which is necessarily implied, 229

need not describe minutely any known thing to which it refers, 230

need not describe the form of a part referred to if form is not of the essence of the invention, 231

signature of, ii. 13

claim, 248

is by implication a disclaimer, 250

but disclaimer is not a claim to residue, ii. 74

effect of omitting an essential part, 250

ambit of

may be expressly limited, 335

does not extend to what might be, but is not claimed, 257, 335

illustration, 257

proportions not specifically stated may be within, 212

for carrying a new principle into effect, 51

for carrying an old principle into effect, 53

legitimate claim for new product, 66

legitimate claim for new means of producing an old product, 67

documents not amounting to publication may narrow, 153

effect of public knowledge on, 354

distinct, is in practice required, but not absolutely necessary, 248

security for the patentee, 248

may be drafted as patentee pleases so long as he does not interfere with existing rights, ii. 49

"distinct statement of the invention claimed," meaning of, 249

essence of invention should be referred to in, 280

but essence of invention is protected though not referred to in, 280

extension of, by amendment of specification, ii. 65-69

for anything old is fatal, 241

apparently and not really for something old, 241

but not when *appendant* as distinct from *in gross*, 115, 260

examples, 260

though some subordinate claims are fatal, 264

for a combination or process protects all parts new and material, 247

but distinct subordinate parts are not protected unless specifically claimed, 256

for use of old thing in a new combination, 70

for an improvement must not include the original, 242

for improvement in old things and combinations of old parts, nature of valid claim, 242

SPECIFICATIONS—(continued)

claim—(continued)

- for every mode of carrying out a principle is, to the principle itself, 45
- for general arrangement as distinguished from claim to a principle, 50
- for a new thing is not vitiated by a further claim to a use not itself subject-matter, 264
- improvements not known at the date of the patent, may not be included in a general claim, 24
- object of, 249
- “pioneer claim,” meaning of, 366
- rules to be observed in drafting, 250
- requisites of, 250
- statement of method of performing the invention in the form of a claim, 272
- speculative claim may be fatal, 254
 - ambiguity which includes what will not answer is fatal, 255
 - examples, 255
- too extensive a claim may be fatal, 251
 - claim to what patentee has not invented is fatal, 251
 - claim to something useless is fatal, 252
 - but not so a claim to something of small utility, 253
 - claim apparently for a class may by context be limited to certain members only, 277, 280
 - description of advantages common to what patentee has and has not invented, 258
 - claim to use of apparatus for analogous purposes, 253
- construction of
 - distinction between, a written contract and a specification, 207
 - necessity for, in legal proceedings, 265, 338
 - logically should be settled before other issues, 266
 - is for the Court; sufficiency is for the jury, 265
 - spirit in which, should be approached, 268
 - adopted in prior proceedings binds Court of equal jurisdiction, 436, 469
 - reference to original to aid, amended specification, ii. 75
 - opinion of scientific witness as to, 339, 458
 - of language used in specification, 266
 - terms of art and technical terms, 267
 - evidence to explain, 267
 - variation in meaning of, 268
 - effect of state of public knowledge at date of the patent on, 283, 285, 354, 467
 - question is what language used would lead a person to whom it is addressed to do, 284
 - i.e.*, when there is an ambiguity, 285
 - intention of patentee no real guide to, 270
 - interest of patentee is immaterial to, 269
 - must be logical, fair, and impartial, 270
 - doctrine that patentee would not intend to claim anything which would make the patent bad, 270
 - limit of, 272
 - Court not astute to find flaws, 272
 - benevolent construction, doctrine of, 273
 - ut res magis valeat quam pereat*, 274
 - limits of, 274
 - when claim can be interpreted in two ways Court adopts meaning which supports validity in preference to one which does not, 272, 276
 - i.e.*, in case of ambiguity Court endeavours to give effect to patentee's intention, 272
 - terms used in popular sense are not construed in accordance with their exact meaning, 277
 - an amended specification, ii. 75
 - claims are construed with reference to body of specification, 277
 - and after a consideration of it, 277
 - distinct effective meaning is if possible given to each claim, 280
 - redundant claims do not vitiate the patent, 280

SPECIFICATIONS—(continued)

construction of—(continued)

- claims are construed with reference to body of specification—(contd.)
 - essence of invention may be protected without specific mention in the claims, 280
 - claims by implication, 282
- disclaimer no aid to, of residue, ii. 74
 - but reference may be had to original, to aid amended specification, ii. 75
- drawings in relation to, 287
 - how far they may aid the description, 287, 288
 - references to, are not necessarily restrictive, 252
- effect of words "substantially as described," 282
 - "as described," 283 (n)
 - "as above described," 283 (n)
 - "as above set forth," 283 (n)
 - "substantially as set forth," 283 (n)
 - "other substances," 283 (n)
 - "any mechanical equivalent," 283 (n)
 - "analogous," 283 (n)
 - "more or less," 283 (n)
 - "or," 283 (n)
 - "improvements" (in the title), 79, 177
 - "causing," 283 (n)
 - "float," 283 (n)
 - "should," 283 (n)
- errors corrected by context, 288
 - which are apparent, 289
 - which are not apparent, 289
 - which amount to a false suggestion, 289
- prior publications, effect on, 285
- provisional cannot be called in aid of the, of the complete, 283, 289
 - or read to supply an omission from it, 289
 - but reference may be had to it to ascertain the real object of the invention, 283

STAMP,

- exemption of statutory declaration for use in Patent Office from, ii. 6
- assignments, ii. 107
- licences, ii. 134

STATEMENT OF ADDRESS FOR SERVICE

- must accompany application, ii. 305
- also notice of opposition, ii. 308

STATEMENT OF CLAIM

- action of infringement, 393
 - allegation of grant and title, 393
 - not necessary to allege novelty in, 393
 - or validity, 393
 - or to set out the specifications, 393
- disclaimer should be stated in, 393
- must disclose case sufficient to justify the relief asked for, 393
- several patents sued on in one action, 394
- certificate of validity should be pleaded in a subsequent action, 528
- precedents of, ii. 336
- action to restrain threats of legal proceedings, precedent of, ii. 404

STATUS

- effect of adverse decision on, of the patent, 308
- effect of order for revocation on, of the patent, 308

STATUTE OF MONOPOLIES

- a declaration of the common law as to patents for inventions, 1
- unrepealed portions of, 2: ii. 197
 - epitome of, 2
 - twofold effect of s. 6..22
- meaning of "manufacture" in, 23
- defines subject-matter, 22

STATUTES

- Statute of Monopolies, ii. 197
- Patent Designs and Trade Marks Act, 1883.. ii. 202
- Patent Designs and Trade Marks (Amendment) Act, 1885.. ii. 245
- Patents Act, 1886.. ii. 247
- Patent Designs and Trade Marks Act, 1888.. ii. 249
- Patents Act, 1901.. ii. 257
- Patents Act, 1902.. ii. 258
- Trade Marks Act, 1905.. ii. 262
- repealed by Act of 1883.. 243
- validity of patents which evade, 26

STATUTORY DECLARATIONS

- how, are to be made and subscribed for use in the Patent Office, ii. 5
- exempt from stamp duty, ii. 6
- on opposition to grant of patent
 - times for leaving, at Patent Office, ii. 25, 26
 - copies of, to be furnished to opposite party, ii. 26

STATUTORY OFFENCES,

- falsifying Register of Patents, or copy therefrom, ii. 6
- representation that an article is patented, when no patent has been granted, 131: ii. 12
 - no offence if complete specification has been accepted, ii. 12
 - when patent has expired, ii. 12
 - modes of representation, ii. 12
- unauthorised use of the royal arms, ii. 12
- penalties,
 - in Scotland, ii. 12
 - in Isle of Man, ii. 13

STAY OF PROCEEDINGS

- pending appeal, 535
 - not usual, 535
 - application for, 535
 - costs of, 536
 - circumstances which induce the Court to grant a, 535
 - stay of subsequent action pending appeal in prior action, 385

SUBJECT-MATTER—*See* COMBINATION; COMMUNICATION; IMPROVEMENT;

NEW USE OF OLD APPLIANCES; PRINCIPLES; PROCESS; PRODUCT

adaptation of old idea without invention, is not, 42

alteration of shape, 42

invention and, 30—*see* INVENTION.

some invention must have been expended, 31

what is invention—*see* INVENTION

a question of fact in each case, 31, 39

mere scintilla sufficient, 31, 34

presumption of expenditure of invention sufficient, 31, 32

accidental discovery, 22

degree, 42

novelty, 31

unsatisfied demand, 32

conception of an idea, 33

practical success, 32, 39

production of a new thing which effects a result not previously attained, 38

simplicity no bar, 40

selection of a member of a class, 41

use according to a new method, 42

new application, 41

mere adaptation, 42

mere alteration of shape or proportions, 42

mere application of old thing, 42

mere skilful application of known tool, 42

mere use of known machine in a new manner, 42

SUBJECT-MATTER—(continued)

- any manner of new manufacture, 22
- combinations of parts as, 67
 - when result is new, better, or cheaper article, 69
 - whether parts are new or old, 67, 71
 - immateriality of novelty of parts, 71
 - merit largely depends on result produced, 67
 - ratio decidendi* of the cases, 67
 - new combination may consist in
 - omission, 71
 - addition, 71
 - or substitution, 71
 - or arrangement of parts, 72, 367
 - definite arrangement of parts producing definite result, 368
 - substitution of equivalents for parts in old combination, 73
- common law authorities as to, 28
- conception of an idea may be, 33, 40
- defined by Jac. I. c. 8, s. 6.. 22
 - Courts and early text writers, 26
 - exhaustive definition not possible, 28
- description of useless machine is no publication of a useful one, 154
 - but may affect question of, 461, 462
- discovery of what was formerly done empirically is not, 57
- essential considerations as to, 32
- general arrangement may be, 50, 368
 - distinction between, and a principle, 50
- improvement may be, 75
 - may consist in addition to, omission from, or rearrangement of old parts, 75, 368
 - mere working direction is not a patentable improvement, 77
 - mere use of existing machine in a more beneficial manner is not a patentable improvement, 42, 56, 78
 - mere adaptation of a well-known idea is not a patentable improvement, 79
- new, better, or cheaper article as, 11, 69
- new method of using an old machine without structural alteration, 42, 56
- new use of old appliance may be, 42, 80, 98
 - apprehension of, may be invention, 84
 - mere, is not, 42, 56, 57, 78, 83
 - novelty of, is not alone sufficient to support a patent for a, 83
 - result of the cases, 81
 - examples of void patents for, 84
 - examples of valid patents for, 99
- must be an art, 24
 - producing vendible articles, 25
 - not to be used for illegal purposes, 25
- not every new and useful discovery is, 29
 - nor is every novelty, 31, 108
- principles *per se* are not, 43
 - applications of principles may be, 44
 - illustrations, 46
 - claim to a general arrangement distinguished from claim to a principle, 50
- process may be, 53
 - history of the cases, 53
 - law settled by *Crane v. Price*, 54
 - decision doubtful on the facts, 54
 - not every novel process is subject-matter, 56
 - process which results in increased yield of known products, 58
 - application of hidden or unperceived property of previously known thing, 58
 - examples, 58
- product may be, 64
 - when claim for, is good, 65
 - when claim for, is bad, 65
 - ambit of legitimate claim for new, 66
 - ambit of legitimate claim for new means of producing old, 67

SUBJECT-MATTER—(continued)

- proof of issue of, in action of infringement, 460
- proportion, mere variation of, is not, 42
- putting together items of common knowledge may be, 41
- rediscovery of lost art may be, 118
- selection of a member of a class may be, 41

SUBORDINATE CLAIM

- if include what is old are fatal, 241, 264
- unless *appendant* as distinct from *in gross*, 115, 260
- examples, 260

SUBORDINATE INTEGER

- not protected unless specifically claimed, 71, 256

"SUBSTANTIALLY AS DESCRIBED"

- effect of, and similar words in a claiming clause, 282

SUCCESS—See also COMMERCIAL SUCCESS

- a test of invention, 9, 12
- not necessarily evidence of utility, 466
- want of commercial, not necessarily evidence of non-utility, 466

SUFFICIENCY

- See SPECIFICATIONS

SUGGESTION

- mere, is not publication, 147

SUMMARY CONVICTION

- definition of, in Ireland, ii. 242

SUNDAY

- leaving documents, paying fees, &c., at Patent Office, ii. 235

SURRENDER

- of patent, may be made to the Crown, ii. 130
- effect of, ii. 130
- how to be made, ii. 130

TAXATION OF COSTS

- See Costs

TEMPERATURE

- infringement by use of chemical substances distilling over between defined, 338

TENNANT'S CASE

- authority on law of true and first inventor, 8
- result of, and Dolland's case, 8
- contrasted with Dolland's case and Arkwright's case, 116

TERM

- of patent, 53
- extension of—see EXTENSION OF TERM OF PATENT

TERMS OF ART

- may differ in meaning in different documents, 144
- expert evidence admissible to explain, 458
- interpretation of, 144, 265-268, 284, 458

THANKSGIVING DAY (PUBLIC)

- Patent Office closed on, ii. 316
- Register of Patents not open to inspection on, ii. 313
- leaving documents, paying fees, &c., at Patent Office on, ii. 54

THEORY

- of action no part of consideration for the grant, 58, 202
- discovery of, of what was formerly done empirically is not subject-matter,

- THREATS OF LEGAL PROCEEDINGS—See also SLANDER**
 as contempt of Court, 315, 316
 action to restrain, 309
 damages
 to be recoverable must result from the threat, 327
 in respect of rumours of legal disputes, 327
 falling off of plaintiff's general business, 327
 loss of contract, 328
 plaintiff failing to enforce a contract, 328
 plaintiff compelled to reduce price at which he accepts a contract,
 328
 assessment at trial preferable to an inquiry, 328
 law prior to Act of 1883 as to threats, 310
 bona fides, 310
 still governs cases within either of the saving clauses of s. 32 of the
 Act of 1883.. 310
 plaintiff may rely on old law or on right created by s. 32 of Act of
 1883.. 310
 if on old law his case as to *mala fides* should be disclosed on motion
 for injunction, 310, 311.
 statutory right created by s. 32 of Act of 1883.. 309
 bona fides of patentee is immaterial in action founded on, 312
 burden of proof, 312
 person aggrieved, who is, 313
 licensees and persons having only limited interests, 313
 what is a threat within, 314
 evil which s. 32 was intended to guard against, 314
 effect of "or otherwise" as used in s. 32.. 314
 nature of threats held to be within s. 32.. 315
 circular, advertisement or otherwise, 315
 solicitor's letter, 315
 private letter, 315
 without prejudice, 315
 answer to enquiry, 315
 indirect reference to patent, 315
 notice by plaintiffs to customers of defendant in an infringe-
 ment action, 316
 general warning to infringers, 317
 to effect that article made abroad is an infringement of
 British patent, ii. 148
 may become a threat, 318
 when use in a particular manner is not complained of, 318
 threat not withdrawn, 318
 continuance of threats after action for infringement com-
 menced, 315
 quæry threat relating to something intended to be done is
 within s. 32.. 317
 quæry threat made by licensees and persons having only a
 limited interest are not within the section, 317
 circulation of threats made by others, 329, 330
 the proviso to s. 32.. 318
 nature of infringement action which will secure the benefit
 of, 318
 action by equitable owner of patent will not do, 318
 action must be honestly brought and prosecuted, 319,
 320
 action against licensee for royalties, 320
 action against third party, 320
 counter claim, 320
 against whom it must be brought, 318
 not necessarily against person aggrieved, 319
 due diligence, 320
 action commenced before issue of threats, 321
 delay caused by negotiations, 321
 delay in taking up order for inspection, 322
 action discontinued by consent, 323

THREATS OF LEGAL PROCEEDINGS—(continued)

plaintiff may rely on old law or on right created by s. 32 of Act of 1883—(continued)

statutory right created by s. 32 of Act of 1883—(continued)

the proviso to s. 32—(continued)

nature of infringement action which will secure the benefit of—(continued)

due diligence—(continued)

action abandoned, 322

action unsuccessful, 322

action originally in respect of several patents but dropped as to some, 322

action in respect of "passing off" turned into action for infringement, 322

practice, 323

issues, 323

infringement,

of any legal rights of person making the threats, 323

persons not possessing legal rights, 315

patentee who has obtained leave to amend under s. 19 of Act of 1883.. 313

patentee who has applied but not actually obtained an amendment of specification, 313

validity of defendant's patent, 323

how pleaded, 323

certificate as to, 328

query can be given in the action, 328

pleadings, 323

precedent of endorsement of writ, 404

statement of claim, 404

defence, 406

reply, 407

rejoinder, 408

particulars, 324—*see also* PARTICULARS

of breaches, plaintiff may be entitled to, 324

of objections, defendant may be entitled to, 324

of alleged threats, 324

of patents relied on to support threats, 324

of agents by whom threats are alleged to have been made, 325

certificate as to, 328

query necessary on taxation, 328

injunction,

interlocutory, 325

prima facie case as to non-infringement or invalidity of defendant's patent must be made out on application for, 325

otherwise Court does not consider the balance of convenience to the parties, 325

considerations which influence the Court on applications for, 326

usual course where defendant brings an action for infringement, 325

ex parte applications for, 325

perpetual, 309

scope of, 329

breach of, 329

form of, 330 note (i)

costs,

ordinary jurisdiction of the Court applies to the general, 330

query certificate of particulars is necessary on taxation of, 328

TIME

See ENLARGEMENT OF TIME

TINDAL, C.J.

law as to true and first inventor stated by, 7

TITLE

See SPECIFICATIONS

TRADE

covenants by assignor in restraint of, legality of, ii. 109

TRADE MARKS

statute law as to, ii. 262

TRADE SECRET

discovery leading to disclosure of, 444

inspection leading to disclosure of, 452

defence that alleged infringement is a, evidence may be taken *in camera*, 472

TRANSHIPMENT

See INFRINGEMENT

TRANSMISSION

of patent by deed, ii. 106

of patent by act and operation of law, ii. 125

of certified copies of specifications to various centres, ii. 235

TRANSPORTATION

See INFRINGEMENT

TREASURY

in Act of 1883 means the Commissioners of Her Majesty's Treasury, ii. 242

TRIAL

action of infringement, 473

acceleration of, 478

at assizes, 478

by Court alone, usual, 473

jury rare, 473

e.g., when there is an allegation of fraud or libel, 474

aid of an assessor, 474

reference to a referee, 477

issues tried separately, 475

advantages of, 476

judgment

motion for, on determination of a separate issue, 479

on admission of facts, 479

by default, 479

by consent, 480

effect of, against validity of patent, 308

minutes of, should not include documents and evidence not produced, 480

forms of, ii. 396-402

certificates which should be asked for at the conclusion of, 480

TRUE AND FIRST INVENTOR,

agent of foreign inventor may be, 19

applicant within the realm having made an application for a patent abroad, 18

applicant is not, if invention was previously used, 6

or if it was taken from any published source of information, 6

communicator of invention made in the realm, first is, 16

communicator of invention made abroad, first is, 16

corporation, 20

sole, 20

declaration as to, on application, 4 : ii. 5

discovery made by several persons concurrently, 8

failure of others as evidence on issue of, 12

importer from abroad if first is, 17

need not be meritorious importer, 19

servant as distinct from master as, 14

TRUE AND FIRST INVENTOR—(continued)

- master as distinct from servant as, 12, 14
 - assistants may be employed, 12
 - when master is, and when servant is, 12, 14
- may be disqualified from being a patentee, 20
- meaning of, 6
- must have invented all for which he claims protection, 6
- patent invalid unless, is a grantee, 4, 5: ii. 5
- patents with similarity of object no objection on issue of, 10
- person who first discloses an invention is, 6
- person who first produces a successful result, 9
- person who first communicates what has not been enjoyed before is not necessarily, 7
- application in fraud of, ii. 55
- distinction between issue of, and prior use, 107
 - pleas must be raised separately, 107
- interest of, in an invention for which he intends to apply for a patent, ii. 105
- proof of issue of, in action of infringement, 459

TRUST

- notice of, as such, cannot be entered on Register of Patents, ii. 58
 - but documents affecting proprietorship can, ii. 58
- validity of patent granted in, for alien enemy, 20

TRUSTEE

- right of, to sue in respect of infringements of patents, ii. 113
- may be a patentee, ii. 113
- declaration that patentee holds as, for another, 16

TRUSTEE IN BANKRUPTCY

- actions of infringement by, ii. 125
- patent vests in, ii. 125

TUDOR SOVEREIGNS

- oppressive monopolies under, 1

TWEEDALE'S INVENTION

- as illustrating doctrine of infringement by use of equivalents, 360

UNDERTAKING

- in lieu of injunction by consent, 486

**UNION FOR THE PROTECTION OF INDUSTRIAL PROPERTY—
See INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL
PROPERTY**

- States constituting the, ii. 19
- provisions of s. 103 of Act of 1883 enabling British Government to join, ii. 19

UNPATENTED INVENTION

- interest of an inventor in, before grant of a patent, ii. 105
- death of person possessed of, 5: ii. 125
- secret use of, by the inventor, 125, 135
- secret use of, by person other than the inventor, 136, 332

USE—See also EXPERIMENTAL USE; PUBLIC USE; SECRET USE

- mere, of a known thing in a more beneficial manner is not subject-matter, 42
- prior, by persons other than the patentee invalidates the patent, 107
 - even though it was secret, 136, 332
- effect on validity of prior secret, by the patentee himself, 125, 135
- when, is an infringement, —see INFRINGEMENT
- patentee cannot restrain the continuation of a prior, secret or otherwise, 332
- as evidence of utility, 466

USER

damages for infringement may be recovered from a, or manufacturer or both until the full measure is obtained, 506
has no redress against unlicensed vendor in the absence of express warranty, 390

UTILITY

requisite to validity at common law, 157
preserved by Statute of Monopolies, 159
failure of, a ground of revocation, 297
different inventions included in one patent must each possess, 167
meaning of, in law, 162
not abstract utility, 162
or improvement from all points of view, 162
i.e., not comparative utility, 162
not necessarily commercial utility, 162
invention is useless unless it does what patentee states it will do, 164
and is useful in the form specified, 165
lack of utility in an essential part is fatal, 166
lack of utility in a non-essential part is no bar to validity, 169
examples, 170
lack of utility for one purpose within a general statement is not necessarily fatal, 169
quantum of utility is immaterial, 164
slight utility sufficient to support validity, 164
all modes or processes claimed need not be equally useful, 165, 237
essential parts may differ in utility, 170
of prior invention does not affect validity of patent for an improvement, 171
not always conclusive evidence of invention, 32, 39, 40
patents used solely for obstructing improvements, 160
patent for an improvement not proof of want of, in original invention, 76
proof of issue of, in action of infringement, 464

VALIDITY

amount of invention does not affect, 31
amount of improvement does not affect, 79, 164
certificate of, 525—*see also* COSTS
discretion of Court or a Judge as to, 526
effect of, on costs of subsequent action, 525
meaning of "subsequent action," 528
discretion of the Court or a Judge as to allowing solicitor and client's costs in a subsequent action, 529
illustrations of the exercise of the discretion, 530
when defendant does not dispute validity, 530
effect of, on costs of subsequent petition for revocation, 525
when may be given, 525
after expiry of patent, 525
in absence of evidence on issue of validity, 527
where plaintiff fails on issue of infringement, 528
where defendant admits validity on a certain construction of the specification, 528
jurisdiction of Court of Appeal, 525
Court of County Palatine of Lancaster, 525
House of Lords, 525
quæry can be given in action to restrain threats of legal proceedings, 328, 525
estoppel against licensee from disputing, *ii.* 148-152
leave to amend specification no guarantee of, *ii.* 65
novelty essential to, of patent, 105
of patents used solely for obstructing improvements, 160
of prior patent relied on in opposition to grant of subsequent patent is immaterial, *ii.* 39
proper specification essential to—*see* SPECIFICATIONS
title, effect of defective, on, 175, 176
utility essential to, 157

- VARIANCE**—*See* SPECIFICATIONS—disconformity—IMPROVEMENT
 between complete and provisional specifications, 188
 legitimate developments of the invention, 188
 what are, 188
 improvements in details, 189
 better and different methods, 189
 always a question of fact, 189
 disconformity, 190
 fatal to validity, 190
 between amended complete and a provisional specification, 191
 method of deciding questions of fact as to, 191
 effect of detailing advantages of the invention in the provisional
 specification, 192
 illustrative cases, 193
 applicant's course in case of doubt as to, 198
- VENDEE**—*See also* SALE
 defendant to action of infringement, 377
 rights of, without restrictions, 377 : ii. 134
 of licensee, right to resell, 377 : ii. 135
 damages recovered from, and also vendor, 506
- VESSEL**
 use of patented invention in British, 381
 use of patented inventions in foreign, 381
- WAR**
 Secretary of State for, empowered to acquire patents for certain inventions
 by assignment, ii. 108, 218
 special provisions as to immunity from revocation of patents for improve-
 ments in munitions of, 293
 Secretary of State for, may order specifications of inventions assigned to
 him to be kept secret, ii. 108, 218
 contract by Secretary of State for, binds successors in office, ii. 108
- WARRANTY**
 on assignment of letters patent, ii. 118
 may be express or implied, ii. 118
 in absence of, doctrine of *caveat emptor* applies, ii. 118
 no implied warranty that an assignee will be able to use the invention
 without licence of a third party, ii. 121
 statement that a patent is valuable and valid, ii. 121
 mere act of sale is no, against infringement, 391
- WATER TABBIES**
 accidental discovery of, 32
- WELCH'S TYRE PATENT**
 cases relating to infringement of, 347 (note)
- WITNESS**
See EVIDENCE ; LAW OFFICER ; LICENSEE ; OATH
- WORDS**
 effect of certain, on the construction of specifications, 232-233 (note)
- WORKMAN**—*See also* MASTER AND SERVANT
 employment of, by an inventor, 12
 no necessary confidential relationship between a, and his fellow, 16
 test of sufficiency of specification, 217, 266
- WRIT**
 form of indorsement on, in action of infringement, ii. 386
 in action to restrain threats of legal proceedings, ii. 404
 service of, in action of reduction, ii. 239
 service of, out of the jurisdiction in action of infringement, ii. 392

A. W. E. F.
 9/30/07

PRINTED BY
WILLIAM CLOWES AND SONS, LIMITED,
LONDON AND BECCLES.