

the subjects of it which may make a difference." It will be observed here that the learned judge draws a careful difference between an insufficient description in the specification and a false suggestion. In the cases cited below letters patent were held void for false suggestion (*k*). And the following cases are illustrations of the distinction drawn by Mr. Baron Parke:—*Lewis v. Marling* (*supra*) and *Haworth v. Hardcastle* (*l*). Also *Bainbridge v. Wigley* (*m*); *Hill v. Thompson* (*n*).

The **second recital** deals with the prayer of the application for the grant.

The **third recital** recites that a complete specification has been filed, particularly describing the nature of the invention. Here, again, a **false suggestion** will avoid the patent, so that if the complete specification is imperfect, the patent will be void upon two grounds, the one being the failure of consideration, and the other the false suggestion; and a false suggestion is equally fatal whether it is wilfully false or otherwise.

The **fourth recital** gives the common law motive for the grant, which is the encouragement of inventions for the public good. There will be something analogous to a false suggestion if the subject-matter of the patent be immoral or illegal, and hence the patent will at common law be void. By sect. 86 of the Act the comptroller may refuse to grant a patent for an invention of which the use would, in his opinion, be contrary to law or morality. A serious oversight in the Act appears to be that there is no appeal from the comptroller when he exercises the power given by this section.

(*k*) *Jessop's Case*, 2 H. Bl. 489;
R. v. Wheeler, 2 B. & Ald. 345;
Felton v. Greaves, 3 C. & P. 611.

(*l*) 1 Bing. N. C. 182.
(*m*) 1 Carp. P. C. 270.
(*n*) 1 Web. P. C. 239.

THE GRANT.

“ Know ye, therefore, that we of our especial grace, certain knowledge, and mere motion do by these presents, for us, &c., give and grant unto the said patentee our especial licence, full power, sole privilege, and authority, that the said patentee by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, make, use, exercise and vend the said invention . . . in such manner as to him or them may seem meet, and that the said patentee shall have and enjoy the whole profit and advantage from time to time accruing by reason of the said invention, during the term of fourteen years from the date hereunder written of these presents.”

This language is intended to preserve intact the **royal prerogative** to grant or withhold a patent—which right was by the common law absolute and undoubted. We have seen that this prerogative is carefully preserved by sect. 116 of the Act.

It is the granting portion of the letters patent which creates the property in the invention. We have seen that this species of property is purely artificial in its nature; it is the most equitable and natural method which the state can devise for the reward and encouragement of inventors; it is merely a right yielding nothing until the invention is made practically useful to humanity. **A trade mark** is also an exclusive right, but it **differs from a patent**, insomuch that it has not merit and the benefit of mankind as its consideration. A trade mark is only a right to guarantee the genuine origin of an article. Any one else may make the article, but they are only prevented from stamping it with the same mark. A patent prevents the public from making the article or using the invention. There is no property which partakes of the nature of an exclusive right save that of a patent, copyright, or trade

mark. There is no exclusive right in a **secret**. A man may only use a secret to his own profit so long as no one is in a position, by reason of knowing the secret, to use it. But the original possessor of a secret cannot, by any process of law, prevent a person from acquiring the knowledge of his secret, or, having acquired it, from making such use of it by publication or otherwise, as he may think proper (o). In *Newbury v. James* (p), although an agreement had been made **to preserve a secret**, the Court **refused to grant an injunction** on the ground that there was no means of enforcing it. Lord Eldon, L. C., said in *Williams v. Williams* (q), "So far as the injunction goes to restrain the defendant from communicating the secret upon general principles, I do not think that the Court ought to struggle to protect this sort of secrets in medicine. The Court is bound indeed to protect them in cases of patents to the full extent of what was intended by the grant of the patent, because the patentee is a purchaser from the public, and bound to communicate his secret to the public."

If the **plaintiff's secret**, however, be one which he **intends to patent**, and the defendant has acquired the information during the progress of experiments, or from the confidence of the plaintiff, he will not be allowed to make such use of the knowledge so acquired as to subsequently invalidate the plaintiff's patent, or to take out a patent for the invention himself, and if he do, he will be liable in damages to the plaintiff (r). It will be observed that the word "patentee" is used in the grant; the old form was, "to the said John Smith, his executors, administrators or assigns;" a "patentee" is, under the 46th section, construed as being "*the person for the time being entitled to the benefit of a patent*;" we shall see presently

(o) *Canham v. Jones*, 2 Ves. & B. 218.

(p) 2 Mer. 446.

T.

(q) 3 Mer. 157.

(r) *Smith v. Dickenson*, 3 B. & P. 630.

that this includes assignees, executors and administrators, together with receivers and trustees in bankruptcy, but the subject of the devolution of patent rights is too extensive and important to be dealt with under this head.

THE PROHIBITION.

The prohibition in the patent commands "all our subjects, that they do not at any time during the continuance of the said term of fourteen years either directly or indirectly make use or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence or agreement of the said patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of this our royal command, and of being answerable to the patentee according to law for his damages thereby occasioned."

It is very difficult to understand the form of letters patent which is appended to the Act of 1883. It is presumed that the Act was intended to amend, simplify and codify the law of patents. The form above quoted is an imitation of forms previously in use. It is not easy to understand what the "penalties" referred to in the prohibition are, and how are they to be put in force or recovered? The Act certainly does not mention penalties as a form of punishment for infringers.

THE CONDITIONS.

We find in the "conditions" that the grant is to be avoided "if it should appear to us, &c., or six or more of our Privy Council, that this our grant is contrary to law

or prejudicial or inconvenient to our subjects generally, or that the said invention is not a new invention as to the public use and exercise thereof within our United Kingdom of Great Britain and Ireland and Isle of Man, or that the patentee is not the first and true inventor thereof within this realm as aforesaid." This proviso raises some questions of importance. The only proceedings mentioned in the Act for the repeal of letters patent are proceedings in the High Court of Justice. What is the proceeding before "six of our Privy Council"? It can scarcely be believed that reference is here made in a new codifying Act to the old prerogative claim of power to revoke, which has not been put in practice for two hundred and fifty years. If it be intended to have such a system of avoiding patents, surely it would be well to provide for it in a more certain manner than merely to mention it as one of the conditions in the patent itself. In the next place we find here, for the first time, an intimation that "**novelty**" means novelty within the kingdom; in the recitals of the patent it is recited as being novelty universally, and throughout the Act itself we find that "novelty" is not limited to novelty within the kingdom. Again, we find here for the first time the inventor described as "the first and true inventor **within this realm.**" In the Act and in the recitals of the patent he is described as the "first and true inventor." We have shown that the omission of the words "within this realm" makes an immense difference not only in the class of persons who may be grantees of letters patent, but also in the nature of the evidence of "prior user" which may be given in an action either for infringement or revocation. The ambiguity of the form of letters patent which is given, and the by no means clear provisions of the Act upon these matters, will in all probability result in a plentiful crop of litigation (s).

(s) See *Marsden v. The Saville* Ex. D. 203, and *Rolls v. Isaacs, Street, &c., Co., Limited*, L. R., 3 L. R., 19 Ch. D. 268.

The next proviso is one for the determination of the patent in the event of the prescribed fees not being paid, and the last provides for the supply of the patented article for the use of the public service on reasonable terms. This proviso in no way binds the Crown if the patented article should be required for the public service to purchase it from the patentee upon reasonable terms and conditions.

Prior to the Act of 1883 letters patent did not operate as against the Crown. The Crown might make use of the invention without in any way recognising any rights of the inventor or patentee (*u*). But should the Crown have employed a contractor, as distinguished from a servant, to manufacture the patented article, the usual proceedings for infringement might be brought against the contractor, since he is the person using the patent, and not the Crown. There being two methods of infringing; first, making and vending; and secondly, using. The contractor infringes by doing the first, and it makes no difference that the Crown also infringes by using the invention (*x*).

This case was subsequently affirmed in the House of Lords. Lord Hatherley said, "The Crown has no right to authorize others who are not their officers, servants, or agents, to use a patented invention without a license from the patentee;" and Lord Selborne added, "I agree with the Court of Queen's Bench that this decision (*Feather v. R.*) is not to be extended by any reasoning from the convenience of the Crown, or of the public service, or from any idea that it practically comes to the same thing, whether the Crown manufactures itself or gives orders to other manufacturers."

The right of the Crown to use a patented invention for the public service without being under any obligation to remunerate the inventor has been abolished by sect. 27 of the Act of 1883.

(*u*) *Feather v. R.*, 6 B. & S. 257. *Arms Co.*, L. R., 10 Q. B. 130;
 (*x*) *Dixon v. The London Small* L. R., 1 App. Cas. 641.

(1) "A patent shall have to all intents the like effects as against her Majesty the Queen, her heirs and successors, as it has against a subject.

(2) "But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors (y), or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the Treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the Treasury after hearing all parties interested."

Sect. 44 deals with the acquisition by the Secretary of State for War of any inventions dealing with instruments or munitions of war, and with the non-publication of specifications describing such inventions, and generally with the preservation for the public benefit of the secret of them.

THE CONSTRUCTION.

"And lastly, we do by these presents for us, our heirs and successors, grant unto the said patentee that these our letters patent shall be construed in the most beneficial sense for the advantage of the said patentee." These words are inserted in the patent for the purpose of preventing the common rule of construction of grants of the Crown when founded upon a petition being read most strongly against the grantee. This favourable construction will not, however, in any way save the validity of the patent if it can be shown to have been granted upon a false suggestion

(y) *Dixon v. London Small Arms Co., supra.*

CHAPTER VIII.

THE DEVOLUTION OF A PATENT.

WE have seen that a “**patentee**” is “the person for the time being entitled to the benefit of a patent.” This includes the first inventor and any person or persons in whom the patent may have become vested by operation of law or by assignment.

The property of a patent passes, **by operation of law**, when the patentee dies or becomes a **bankrupt**. Upon the **death of** a patentee his interest in the property passes to his executors or administrators as the case may be in the like manner to the rest of his personal estate. Any step which in the Act is required to be taken by the patentee, may be taken by the executor or administrator, and sect. 34 of the Act provides that—“(1) *If a person, possessed of an invention, dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.*” This undoubtedly, seeing the terms of the grant itself, will mean his legal **personal representative**. Some letters patent of the Crown (not for inventions) have a limitation to heirs or heirs male, such, for instance, as patents of nobility. The Act proceeds—“(2) *Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.*”

If the patentee becomes bankrupt the property in the patent will pass to his receiver, trustee or assignee in

bankruptcy (*a*). It is doubtful whether the doctrine of apparent possession can be said to affect a patent right. The Lord Chancellor, in 1812, seems to have thought that it did (*b*). This, however, can hardly be quoted as an authority. The persons in whom the patent vests, by reason of bankruptcy, are placed in all respects in the position of the original patentee, and may sue in respect of infringements (*c*).

The second method of devolution is **by assignment, *inter vivos***. This may be done either by absolute assignment of the whole of the patent, or by absolute assignment of the patent right for a limited area, or by assignment by way of mortgage, or by the grant of licenses.

The right of the original inventor to assign the exclusive right which has been granted to him is recognised in the patent itself, which is granted to the said A. B., his executors, administrators or assigns. Without these words of limitation the property in the patent right would be merely personal, attaching to the person of the first inventor and becoming extinguished by his death.

The patent itself being a deed the **assignment must be also by deed (*d*)**. So, also, **licenses should be under seal**, the prohibition in the grant itself being "without the consent, license or agreement of the said patentee in writing under his hand and seal."

A license granted by a patentee, but not under seal, is, however, not void in the sense that the licensee, having used the patent, is not bound to pay the royalties contracted for. In *Chanter v. Dewhurst* (*e*), it was held that the defendants having obtained the license they had bargained for, and kept it, were bound to pay for it; and

(*a*) *Hesse v. Stevenson*, 3 B. & P. 565, also *Bloxam v. Elsee*, 9 D. & R. 215; *M'Alpine v. Mangnall*, 15 L. J., C. P. 298.

(*b*) See *Ex parte Granger*; God-

son on Patents, 2nd ed. p. 225.

(*c*) *Bloxam v. Elsee*, *supra*.

(*d*) Co. Lit. 9 b, 172 a.

(*e*) 12 M. & W. 823.

secondly, that the license was not void as not being under seal. Baron Alderson said: "The defendants, in making the machine in question, are merely acting as agents for the patentee . . . in my opinion a license, for this purpose, need not be under seal."

Although the words of the grant are "under his hand and seal," the document is not a deed since it need not be delivered as a deed, nor need it be stamped as such (*f*).

By sect. 36 of the Act, "a patentee may **assign** his patent **for any place** in or part of the United Kingdom or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only." Having assigned a patent, the original patentee cannot manufacture the patented article, and when an action is brought against him by his assignee he cannot set up that the patent was not valid; **he is estopped by his deed** (*g*), that is by the deed of assignment, but when the assignment is by operation of law there is no such estoppel. In *Cropper v. Smith* (*h*), in 1873 Letters Patent for improvements in lace machines were granted to H., who, in 1877 went into liquidation and the patent was sold by the trustee to the plaintiffs. H. afterwards entered into partnership with S., and this action was brought against S. and H. to restrain them from infringing the patent, held that H. was not estopped from disputing the validity of the patent either by matter of record, on the ground that the letters patent were of record; or by deed, by reason of the specification being under his seal; or by matter *in pais* on the ground of the statements in his petition to the Crown, there being nothing to show that the plaintiffs bought on the faith of those statements. (But see Bankruptcy Act 1883, sect. 50, subsect. 5.) It is probable that there is estoppel by record between the Crown and the grantee of letters patent (*i*).

(*f*) *Chunter v. Johnson*, 14 M. & W. 408.

(*g*) *Oldham v. Langmead*, cit. in

Hayne v. Maltby, 3 T. R. 439.

(*h*) L. R., 26 Ch. D. 700.

(*i*) Per Fry, L. J. at p. 712;

Where the plaintiff, fraudulently asserting that he had a right to a patent, induced the defendant to come to terms with him for a license to use that patent, the defendant, in an action upon that agreement, is not estopped from alleging the want of title in the plaintiff as a defence (*k*). But it would be otherwise in the absence of fraud and where both parties are innocent, in that case the assignee or licensee would not be allowed to set up as a defence the want of title of the assignor or licensor (*l*).

In *Bowman v. Taylor and others* (*m*), the plaintiff sued the defendants for the non-payment of certain royalties due from the defendants to the plaintiff under a license under seal for the use of the plaintiff's patent. The defendants defended on the grounds (1) that the invention was not a new invention, (2) that the plaintiff was not the first and true inventor, (3) that the specification was not sufficient—pleas which in effect endeavoured to put in issue the validity of the plaintiff's title. Upon demurrer, Taunton, J., said, "The law of estoppel is not so unjust or absurd as it has been too much the custom to represent. The principle is, that where a man has entered into a solemn engagement by deed under his hand and seal as to certain facts, he shall not be permitted to deny any matter which he has so asserted. The question here is, whether there is a matter so asserted by the defendant under his hand and seal that he shall not be permitted to deny it in pleading. It is said that the allegation in the deed is made **by way of recital**, but I do not see that a statement such as this is the less positive because it is introduced by a 'whereas.' Then the defendant has pleaded that the supposed invention in the declaration and letters patent mentioned was not nor is a new invention. These words 'was not nor is a new in-

affirmed House of Lords, 10 App. Cases 249. See also *London and Leicester Hosiery Co. v. Griswold*, Griffin P. C. p. 154.

(*k*) *Hayne v. Maltby*, 3 T. R. 438.

(*l*) See *Taylor v. Hare*, 1 Web. P. C. 292, 293.

(*m*) 2 A. & E. 278.

vention' must be understood in the same sense as the words 'had invented' in the recital of the deed set out in the declaration, and must refer to the time of granting the patent, and if the invention could not then be termed a new invention, it could not, I think, have been truly said in the deed, that the plaintiff 'had invented' the improvements in the sense in which the deed uses the words. 'Then the plea directly negatives the deed, and comes within the rule that a party shall not deny what he has asserted by his solemn instrument under hand and seal.' The learned judge then proceeds to distinguish *Hayne v. Maltby* (n), but for some reason does not refer to the element of **fraud** in that case, which certainly would take it out of the operation of the doctrine of estoppel.

Where, however, the **license is not under seal** there will be **no estoppel**, and the defendant may show the invalidity of the plaintiff's patent by way of showing failure of consideration (o).

Besseman v. Wright (p) was decided on the ground of partial as against total failure of consideration, and has no reference to the doctrine of estoppel, although it seems sometimes to have been thought that it had.

In *Clark v. Adie* (q), James, L. J., said, "A licensee cannot under any pretence whatever bring his licensor into litigation as to the novelty of any part of the patent." This case was afterwards affirmed in the House of Lords (r). But it appears that if the license has been determined prior to the expiration of the term of the patent the ex-licensees may contest the validity of the patent, notwithstanding the covenants or recitals in the license (s). In giving judgment, Lord Cottenham said, "That is exactly coming to the point which I put, whether, at law, the party was estopped from

(n) 3 T. R. 438.

(o) *Chanter v. Leese*, 1 Web. P. C. 295.

(p) 6 W. R. 719.

(q) L. R., 3 Ch. D. 144.

(r) L. R., 2 App. Cas. 423.

(s) *Neilson v. Fothergill*, 1 Web. P. C. 287.

disputing the patentee's right, after having once dealt with him as the proprietor of that right. And it appears from the authority of that case (*Hayne v. Maltby* (t)), and from the other cases, that from the time of the last payment (i.e. expiration of license), if the manufacturer can successfully resist the patent right of the party claiming the rent, that he may do so in answer to an action for the rent for the use of the patent during that year." The language is not clearly reported, but this appears to mean—to an action for the use and occupation, so to speak, of the patent after the expiration of the license.

The following cases have been decided uniformly, and show that parties to a deed of assignment or license are estopped from denying the validity of the patent, and that there is no implied **warranty** on the part of the assignor or licensor. *Cutler v. Bower* (u), *Smith v. Scott* (x), *Walton v. Lavater* (y), *Norton v. Brooks* (z), *Crossley v. Dixon* (a).

Where the license is by parol and has been acted upon, and so long as the licensee has thought fit to claim the benefit of it, he is estopped from denying the validity of the patent, but no term being fixed for the duration of the verbal license he may determine it at any time (b). As to estoppel by judgment, see *Goucher v. Clayton* (bb).

When the defendant has assigned his patent to the plaintiff, he cannot afterwards deny the validity of his own patent—*Walton v. Lavater, supra*. A licensee cannot take advantage of a judgment obtained by third parties against the patentee declaring the patent bad (c). But a licensee,

(t) 3 T. R. 438.

(u) 11 Q. B. 973.

(x) 6 C. B., N. S. 771, and 28 L. J., C. P. 325.

(y) 8 C. B., N. S. 162.

(z) 7 H. & N. 499.

(a) 10 H. L. Cas. 293.

(b) *Crossley v. Dixon*, 32 L. J. Ch. 617.

(bb) 34 L. J. Ch. 239.

(c) *The Grover and Baker Sewing Machine Co. v. Millard*, 8 Jur., N. S. 713.

in an action by the patentee, may claim to place the most **favourable construction** on the specifications, which will support the validity of the patent, if another construction would make it bad (*d*).

An assignment of patent rights in a **partnership** dissolution deed will estop the retiring partner from subsequently setting up the invalidity of the patent by way of defence to an action brought by his late partners (*e*). But where the plaintiff and defendant had been partners, and had worked as such the defendant's patent, there being no deed between the plaintiff and defendant which inferred the validity of the patent, held that plaintiff was not estopped from denying the validity of the patent (*f*). And where partners are joined as defendants in an action for infringement, and one is assignor of the patent, the other is not debarred from setting up the pleas of invalidity (*g*).

Fraudulent agreements for the assignment of patents, such, for instance, as bubble patents, will be set aside (*h*). But in the absence of fraud the agreement will be enforced, and it is no defence to the action that the plaintiff has not invented the alleged invention (*i*).

Executors may assign a patent prior to registration of the probate (*k*).

Specific performance of an agreement to assign letters patent may be decreed (*l*). Even though the agreement be to assign patents for future inventions (*m*).

Licenses differ from assignments, in that the patentee

(*d*) *Trotman v. Wood*, 16 C. B., N. S. 479.

(*e*) *Chambers v. Crichley*, 33 Beav. 374.

(*f*) *Axmann v. Lund*, L. R. 18 Eq. 330; 22 W. R. 789.

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

(*h*) *Lovell v. Hicks*, 2 Y. & C. 46.

(*i*) *Smith v. Buckingham*, 18 W. R. 314.

(*k*) *Ellwood v. Christy*, 10 Jur., N. S. 1079.

(*l*) *Lewin v. Brown*, 14 W. R. 640.

(*m*) *Printing and Numerical Registering Co. v. Sampson*, L. R. 19 Eq. 462; 44 L. J., Ch. 705.

granting a license does not part with his whole interest, but grants merely a right to use the patent for the whole term or any portion of the whole term. The license may be exclusive or otherwise.

Sect. 22 of the Act of 1883 provides for the granting of **compulsory licenses**.

“If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licenses on reasonable terms—

“(a) The patent is not being worked in the United Kingdom ; or,

“(b) The reasonable requirements of the public with respect to the invention cannot be supplied ; or

“(c) Any person is prevented from working or using to the best advantage an invention of which he is possessed, the Board may order the patentee to grant licenses on such terms as to the amount of royalties, security for payment or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.”

These provisions are entirely novel ; “(a) and (b)” are capable of being reasonably construed, as to “(c)” it is difficult to understand how the Board of Trade will come to a decision as to whether “a person is prevented from working or using, to the best advantage, an invention of which he is possessed.” The “invention” must be protected by letters patent (see the construction given in sect. 46).

The proceedings under sect. 22 will be regulated by rules to be made by the Board of Trade in pursuance of the power given by sect. 101, sub-sect. 1 (g), and sub-sects. 3, 4 and 5.

Money paid by a licensee for royalties cannot be recovered when it is ascertained that the patent was void *ab initio* (n). And if the licensees have kept the

(n) *Taylor v. Hare*, 1 B. & P. (N. R.) 260.

license and used it, the licensor can recover from them the agreed royalties, although the patent may have been void and the license not under seal (o). But otherwise, if the licensor knew from the first that the patent was void (p). But if the consideration for the money paid is that an application for a patent should be made and a license to use the patent granted, no application being made for the patent, there is a total failure of consideration, and the price paid may be recovered (q). **A license is not assignable (r).** A license to a man and his assigns means a license with power to licensee to sub-license (*idem*). A licensee may covenant not to manufacture without applying the patented invention; such a covenant is not in restraint of trade (s). **A license may be created by parol,** but if no time is fixed for its duration it may be determined at will, and after the determination there will be no estoppel to the ex-licensee to dispute the validity of the patent (t). A patentee having granted a license cannot prevent anyone **vending the articles** which have been made in pursuance of the license (u). And an inventor selling the patented article abroad cannot restrain its importation and sale in this country. Although an assignee of the patent in this country might restrain the importation of an article made by the original inventor or his assignee abroad (x). **A latent ambiguity in a license by deed may be explained by parol evidence in the same manner as other deeds (y).** A licensor may in the license deed stipulate for a forfeiture in the event of royalties not

(o) *Chanter v. Dewhurst*, 12 M. & W. 823.

(p) *Chanter v. Leese*, 4 M. & W. 295.

(q) *Knowles v. Bovill*, 22 L. T. N. S. 70.

(r) Per Maule, J., in *Bower v. Hodges*, 22 L. J., C. P. 198.

(s) *Jones v. Lees*, 1 H. & N. 189.

(t) *Crossley v. Dixon*, 10 H. L. Cas. 293; L. J., 32 Ch. 617, H. L.

(u) *Thomas v. Hunt*, 17 C. B., N. S. 183.

(x) *Betts v. Willmott*, L. R., 6 Ch. 239.

(y) *Roden v. The London Small Arms Co.*, 46 L. J., Q. B. 213.

being paid (z), but such forfeiture may be waived (a). The licensor may also agree that he will take all necessary steps to support the validity of the patent (b).

Sect. 23 of the Act provides :—“(1) *There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licenses under patents and of amendments, extensions and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed; (2) the register of patents shall be primâ facie evidence of any matters by this Act directed or authorized to be inserted therein; (3) copies of deeds, licenses and any other documents affecting the proprietorship in any letters patent or in any license thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.*”

By sect. 85, “**There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust, express, implied, or constructive.**” Sect. 87, as amended by sect. 21 of the Patents, &c., Act, 1888, provides for the entry in the register at the request of the person becoming entitled, of any assignment or transmission of interest. The person registered shall have power to deal with such interest as he has registered, absolutely: “*Provided that any equities in respect of such patent, &c., may be enforced in like manner, as in respect of any other personal property.*” Sect. 88, as amended by sect. 22 of the Patents, &c., Act, 1888, deals with the inspection of registers, and the obtaining of certified copies. By sect. 89 sealed copies are to be received in evidence.

(z) *Tielens v. Hooper*, 5 Ex. 830.

(b) *Henderson v. Mostyn Copper*

(a) *Warwick v. Hooper*, 3 M. & Co., L. R., 3 C. P. 202.

Sect. 90, as amended by sect. 23 of the Patents, &c., Act, 1888, empowers the Court (High Court of Justice) to order the alteration of the registers, upon the application of persons aggrieved, and upon sufficient cause shown. The comptroller may himself correct errors in registers which are merely of a clerical nature, sect. 91.

The comptroller may refuse to enter upon the register of patents a document dated before the patent, upon the ground that it does not contain a sufficient proof of title (c).

Sect. 35 of the **Act of 1852**, after providing for the registration of proprietors, assignments, &c., of patents, proceeded: "Provided always, that, until such entries shall have been made, the grantee or grantees of letters patent shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such letters patent, and of all licenses and privileges thereby given or granted."

It will be observed that the Act of 1883, quoted above, **materially differs from this enactment.** Hence *Chollett v. Hoffman* (d), and *Hassall v. Wright* (e), will not now apply.

Prior to the Act of 1883, the High Court of Justice exercised jurisdiction to alter and amend the register of patents (f).

The register should be amended whenever a fraudulent entry has been made. A patentee assigned half a patent to A., and afterwards he assigned the whole to B. by deed, reciting that he had already granted a license to work and use to A. B.'s assignment was first registered:—Held, that B. had **constructive notice** of A.'s rights, and an entry was ordered to be made in the register that the license referred to in B.'s assignment was the deed of assignment to A., subsequently entered (g).

(c) *In re Parnell's Patent*, 5 P. O. R. 126. (f) *In re Morgan's Patent*, 24 W. R. 245.

(d) 7 Ell. & B. 686.

(g) *In re Mosey's Patent*, 25

(e) L. R. 10 Eq. 509; 40 L. J., Ch. 145. Beav. 581.

CHAPTER IX.

EXTENSION OF TERM OF PATENT.

SECT. 25 of the Act of 1883 provides :

“(1) **A patentee** may, after advertising in manner directed by any rules made under this section his intention to do so, present a **petition to her Majesty in Council**, praying that his patent may be extended for a further time; but such petition must be presented at least six months before the time limited for the expiration of the patent.”

“A patentee” is by section 46 construed as “the person for the time being entitled to the benefit of a patent,” therefore a mortgagee who is unpaid must be joined for the purpose of petitioning for an extension (a).

The period of six months limited by this sub-section will not apply to patents granted before the 1st Jan. 1884. With regard to such patents the provisions of 5 & 6 Will. IV. c. 83, will apply, and applications for extension may be made at any time prior to the expiration of the patent; this is by reason of the 113th section of the Act of 1883 (aa). But once a patent is extended it becomes a new patent, and the whole of the Act of 1883 applies to it (b).

“(2) Any person may **enter a caveat** addressed to the Registrar of the Council at the Council Office, against the extension.

“(3) If her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council,

(a) *Church's Patent*, Griffin P. C. App. Cas. 589 ; 53 L. J., P. C. 84.
256. (b) *Cocking's Patent*, 2 P. O. R.

(aa) *Branden's Patent*, L. R. 9 151.

the said Committee shall proceed to consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel on the petition.

“(4) The Judicial Committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case.

“(5) If the Judicial Committee report that the patentee has been inadequately remunerated by his patent, it shall be lawful for her Majesty in Council to extend the term of the patent for a further term, not exceeding seven, or, in exceptional cases, fourteen years; or to order the grant of a new patent for the term therein mentioned, and containing any restrictions, conditions, and provisions that the Judicial Committee may think fit.”

It is the practice to grant a new patent, such new patent being subject to the conditions in the Act of 1883 (c).

“(6) It shall be lawful for her Majesty in Council to make from time to time rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.

“(7) The costs of all parties of and incident to such proceedings shall be in the discretion of the Judicial Committee; and the orders of the Committee respecting costs shall be enforceable as if they were orders of a division of the High Court of Justice.”

These provisions have made **no substantial alteration in the law.** Prior to the Act 5 & 6 Will. IV. c. 83, there was no power in the Crown to extend the duration of letters patent, and should an inventor have desired to

apply for an extension of the term of his grant, he could only do so by applying for and obtaining a **special Act of Parliament** in his favour. The Act of Will. IV., and the amending Act of 2 & 3 Vict. c. 67, introduced the method of petitioning and obtaining an extension to the Privy Council.

It had been found that the procedure to obtain an Act upon each occasion, when an extension was sought, was too costly and cumbrous, hence the modern course of procedure was devised.

This being shortly the origin of the jurisdiction of the Privy Council, at first an impression gained that the Privy Council were to put themselves in the position of Parliament, and not in that of a court of law, in considering the claims of applicants who appeared before them; that they were to weigh the claims of the **public interest** very heavily in the balance as against the inventor. In *Re Soame's Patent* (cc) Lord Brougham said: "If this case were to be disposed of upon the ground which in arguing such cases have sometimes been assumed to be the fit one, that there must not only be merit and benefit to the public, and (which is essential) a want of sufficient remuneration in the course of using the patent; but that, moreover, the case is to be tried here as on a bill in parliament introduced to prolong the patent; then, I apprehend, there can really be no doubt whatever that in this case no bill would ever have passed through the two houses of parliament."

The true construction is, however, not so severe as that, although still sufficiently severe. In *Re Morgan's Patent* (d) Lord Brougham said: "It is by no means their (the Privy Council) course to put themselves precisely in the situation of the Legislature, and never to grant an extension where an Act of Parliament would not have been obtained. At

(cc) 1 Web. P. C. 729.

(d) 1 Web. P. C. 737.

the same time there are some limits to this. 'They are to look to a certain degree at the position in which they are placed, and to consider that they here represent the Legislature, and that they are invested with somewhat similar powers of discretion to those exercised formerly by the whole three branches of parliament.'

Such is the spirit in which the Privy Council will approach the subject of an extension, not benevolently to the applicant, but still with not so stern a regard to the interests of the public as parliament would entertain.

In considering their decision the Privy Council will consider:—

1. The nature and merits of the invention in relation to the public.
2. The adequacy or inadequacy of the profits made by the inventor as such.
3. The circumstances of the case.

In *Re Erard's Patent (dd)* Lord Lyndhurst said: "In cases of this kind we expect a very strong case of hardship to be made out as well as a strong case upon the utility of the invention;" and the same privy councillor in *Soame's case (e)* said, "We consider the invention as very meritorious, the result of a great deal of labour, care, and science, and that it is extremely useful in its effects. We are satisfied by reasonable evidence that the party has sustained very considerable loss, and under these circumstances we think that the period ought to be extended."

It will be observed that the three considerations for the Privy Council laid down by the Act of 1883 are almost identical to the grounds of extension as given by Lord Brougham in *Re Derosne's Patent (f)*: "The parties must show in the first place some invention, in the next place a benefit to the public, and in the third place that they have not had adequate remuneration."

(dd) 1 Web. P. C. 557.

(e) 1 Web. P. C. 729.

(f) 2 Web. P. C. 4.

It is immaterial whether or not the application is opposed. The Privy Council will require every necessary ground for extension to be **strictly proved** before they advise an extension (*g*), and this even though the Crown through the attorney-general consents (*h*).

“The merit of an **importer** is less than of an inventor. We are sitting judicially, and it is an argument against the patent that it is imported and not invented. I do not say it takes away the merit, but it makes it much smaller (*i*).”

Extension of the term will be granted to **assignees**, as they have, so to speak, purchased the merit of the original inventor, but the argument against importers will apply with equal force against assignees (*j*).

“Merit” here means the consideration which has been given to the state for the patent; it does not mean the merit of the inventor, but the **merit of the consideration** which he has given. An inventor may have diligently worked for years in a most deserving manner, and yet have produced an improvement of the most trifling nature—the merit of the person in this case will not be considered. On the other hand, the invention, although a great one, may have been handed to him from abroad without thought or trouble on his part. This is what Lord Brougham contemplates when he says that the merit of an importer is less than that of an inventor. Again, the invention may have been a very simple one, produced by an inventor with a moment of thought, and yet of great importance to the world. This latter case would be one of merit—simplicity of an invention being an element of its value (*k*).

(*g*) *In re Perkin's Patent*, 2 Web. P. C. 6.

(*h*) *In re Cardwell's Patent*, 10 Moo. P. C. C. 488.

(*i*) Per Lord Brougham, *In re*

Soame's Patent, 1 Web. P. C. 729.

(*j*) See *In re Napier's Patent*, 13 Moo. P. C. C. 543.

(*k*) *In re Muntz' Patent*, 2 Web. P. C. 113.

In *Bailey's Patent* (*kk*), Lord Blackburn said: "What the statute says is that the judicial committee shall, in considering their decision, have regard to the *nature and merits of the invention* before that evidence has been called which shows what can hardly be disputed, viz., that the invention which is the subject of the patent, is a beneficial invention; but as to the petitioner showing that there was any *special or peculiar advantage* in the invention in relation to the public to entitle the patentee to the large reward of an extension of his patent, their lordships are of opinion that he has totally failed to do so."

The Privy Council will not inquire into the **novelty or utility** of a patent, except in so far as such novelty or utility may form elements in the consideration of the merit of the invention (*l*).

Non-user of the patent creates a strong presumption against the merit of an invention, which presumption can only be rebutted by the strongest evidence (*m*). But the same objection being raised *In re Hughes' Patent* (*n*), the application was granted after strong and unanswered evidence of merit, though the patent had not been used in England during the whole term (*o*).

In *Re Betts' Patent* (*p*) Lord Chelmsford said, "Dobbs' specification may have given the petitioner the idea of the possibility of uniting the two metals of tin and lead, and may thus have deprived him of the merit of originality. But in Dobbs' hands the discovery was barren; the petitioner, however, who followed out his suggestion, and after repeated experiments gave it a practical application, is the

(*kk*) Griffin P. C. at p. 254.

(*l*) *In re Saaby's Patent*, L. R., 3 P. C. 292; *Stewart's Patent*, 3 P. O. R. 7.

(*m*) See *In re Allan's Patent*, L. R. 1 P. C. 507, where an application was rejected on that

ground.

(*n*) L. R., 4 App. Cas. 174.

(*o*) See also *In re M'Dougal's Patent*, L. R., 2 P. C. 1, and *In re Herbert's Patent*, L. R., 1 P. C. 399.

(*p*) 1 Moo. P. C. C., N. S. 49.

manufacturer, but will consider the gross amount of profits (*u*). In this case Lord Brougham said: "We cannot weigh in golden scales the proportions between manufacturers' profits and patentees, but we must take it in the gross, and apply our minds as men of the world, men of business—neither unfairly towards the inventor, nor extravagantly and romantically towards him in his favour—neither against him pressing, nor in his favour straining. We must ascertain whether he has, in the eyes of men of ordinary but enlightened understandings, judging fairly between him and the public, had a sufficient remuneration."

The ground of this view of the case appears to be that the possession of the patent has placed the manufacturer in an advantageous position in obtaining orders (*x*).

In the accounts which the patentee must file upon an application for an extension, when he is a **manufacturer of the patented article** he should, so far as possible, distinguish profits as a manufacturer from profits as a patentee (*y*); and in cases where it can be shown that the reasoning in *Johnson's case* (*supra*) does not apply, he will be allowed to deduct his profits as a manufacturer before an estimate is taken of his profits as a patentee (*z*).

But where he ascribed two-thirds of the profits to the manufacturer, and only one-third to the patent, it was held to be unreasonable (*a*).

It will be observed that the cases quoted above appear to conflict with the principles laid down by Lord Brougham in *Muntz's case* (*b*). These words cannot be read as meaning that no regard whatever will be paid to the fact, that a great portion of the patentees' plant, expenditure,

(*u*) *In re Muntz's Patent*, 2 Web. P. C. 113.

(*x*) *In re Johnson's Patent*, 8 Moo. P. C. C., N. S. 282.

(*y*) *In re Betts's Patent*, 1 Moo. P. C. C., N. S. 49.

(*z*) *Ib.*

(*a*) *In re Hill's Patent*, 1 Moo. P. C. C., N. S. 258, and *Duncan & Wilson's Patent*, 1 P. O. R. 257.

(*b*) 2 Web. P. C. at page 120.

or time, is devoted to the business of an ordinary manufacture, from which some profits would be derived, even if no patent were in existence, but that no attempt will be made to go into minute details of figures. The profits will be treated in gross, and then their lordships will apply their general knowledge, as men of the world, in coming to a conclusion as to how much the patentee has received from the profits of his invention.

In estimating profits, a deduction will be allowed for the **expenses of experiments** in bringing the invention to perfection (*c*). And also in respect of the **costs of litigation** necessary to maintain the validity of the patent, and to restrain infringers (*d*). But not where actions have been compromised, improvidently, and costs abandoned without sufficient reason (*e*). The **expenses of taking out the patent** will be allowed as a deduction (*f*). So also will the **expenses incurred in bringing the invention in general public use** (*g*). And a deduction will be allowed in respect of the **personal expenses of the patentee**, and by way of salary for the exclusive devotion of his time in bringing the patent into practical operation and public notice (*h*). A patentee residing in America, for the purpose of getting the patented article into general use in England, employed **an agent**, and allowed him half profits. This half was allowed to be deducted (*i*).

But, on the other hand, the patentee must add to his profits the profits arising out of the manufacture of the patented article, even though intended for exportation (*k*). So also he must add the **profits** which have been made by

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| (<i>c</i>) <i>In re Bates' Patent</i> , 1 Web. P. C. 739, and <i>In re Kay's Patent</i> , 1 Web. P. C. 568. | P. C. 573. |
| (<i>d</i>) <i>In re Galloway's Patent</i> , 1 Web. P. C. 724. | (<i>g</i>) <i>In re Galloway's Patent</i> , supra. |
| (<i>e</i>) <i>In re Hills' Patent</i> , 1 Moo. P. C. C., N. S. 258. | (<i>h</i>) <i>In re Carr's Patent</i> , L. R., 4 P. C. C. 539. |
| (<i>f</i>) <i>In re Roberts' Patent</i> , 1 Web. P. C. C. 441. | (<i>i</i>) <i>In re Poole's Patent</i> , 4 Moo. P. C. C., N. S. 452. |
| | (<i>k</i>) <i>In re Hardy's Patent</i> , 6 Moo. P. C. C. 441. |

his licensees (*l*). And in *Re Johnson's* patent, Lord Justice James said: "Their lordships are of opinion, that where the question to be considered is, whether an invention has been sufficiently remunerated or not, in taking into consideration the remuneration received, they must have regard to the remuneration which the invention has brought in to the patentee or the person who claims the right of the patentee, *whether it be in one country or another.*"

We have seen by sub-section 6 of the section of the Act of 1883, now under consideration, the rules of the Privy Council, which have been heretofore in force, are to continue until amended or altered.

Rule 9 is as follows:—"A party applying for an extension of a patent . . . must lodge at the council office six printed copies of the specification, and also four copies of the **balance sheet of expenditure and receipts** relating to the patent in question, which accounts are to be proved on oath before the lords of the committee at the hearing." This must be done within one week of the hearing: rule 10.

The judicial committee will not enter into the accounts in a case for extension unless they have been filed in accordance with this rule (*m*).

But in exceptional cases, the filing of perfect accounts may be excused (*n*). Where the estate of a deceased patentee was of little value, and no accounts had ever been kept, the petitioner, the administratrix and widow of the patentee, was examined to prove an allegation in the petition, to the effect that not only had there been no profits, but a considerable loss (*o*).

The **account** of profit and loss ought to be **clear and**

(*l*) *In re Trotman's Patent*, L. R. 1 P. C. 118; 3 Moo. P. C. C., N. S. 488.

(*m*) *In re Johnson's and Atkinson's Patent*, L. R., 5 P. C. 87; and

see *In re Yates' and Kellett's Patent*, L. R. 12 App. Cas. 147.

(*n*) *In re Lowe's Patent*, 10 Jur. 363.

(*o*) *In re Heath's Patent*, 8 Moo. P. C. C. 217.

precise (*p*). The application will be refused if the petitioner's accounts are unsatisfactory (*q*). The accounts furnished by the petitioner not containing sufficiently full and accurate information in respect of the patent, or the remuneration received by him, the judicial committee declined to recommend a prolongation of the term (*r*). In one case, the accounts being *prima facie* unsatisfactory, the judicial committee directed the question of accounts to be taken before considering the merits of the invention (*s*). And where the accounts were *prima facie* satisfactory, the petitioners were allowed to prove the merits of the invention before going into the accounts (*t*). The books of the petitioner in respect to profits arising from his patent having been lost during his bankruptcy, the account of profit and loss was taken upon his own evidence (*u*). This was an exception to the general rule, which is, that evidence will not be received from the petitioner.

Where a patentee, whether English or foreign, has obtained **foreign patents**, they **should be stated** in a petition for prolongation, and the fullest information afforded as to the profits thereof. A patentee should preserve the clearest evidence of everything which has been paid or received on account of the patent. Whether or not his remuneration has been adequate, his furnishing a satisfactory account is a condition precedent to his obtaining an extension of his term (*v*), and no alteration has been made in this respect by sect. 25, sub-sect. 4 of the Act of 1883 (*x*).

(*p*) *In re Betts' Patent*, 1 Moo. P. C. C., N. S. 49.

(*q*) *In re Trotman's Patent*, 3 Moo. P. C. C., N. S. 488.

(*r*) *In re Clark's Patent*, 7 Moo. P. C. C., N. S. 255.

(*s*) *In re Wield's Patent*, L. R., 4 P. C. 89.

(*t*) *In re Houghton's Patent*, L. R.

3 P. C. 461 ; 7 Moo. P. C. C., N. S. 309.

(*u*) *In re Hutchinson's Patent*, 14 Moo. P. C. C. 364.

(*v*) *In re Adair's Patent*, L. R., 6 App. Cas. 176.

(*x*) *Newton's Patent*, 9 App. Cas. 592.

The third head of subjects to be inquired into, upon an application for prolongation, consist of the various grounds of objections to an extension which have been allowed hitherto by the committee, and which are included in the general term used in sub-sect. 4, viz., "**All the circumstances of the case.**"

That the invention has not been brought into **public use** is a good ground of objection (*y*). So is **negligence** on the part of the patentee **in restraining infringement** (*z*). That the **invention was practically useless** as originally described in the specification, but was subsequently made practicable by subsequent improvements, introduced from abroad, is also a good ground for objection (*a*). But, otherwise, where the invention was useful and meritorious, in its original form, subsequent improvements form no ground in support of objection (*b*). When the non-profitable use of the patent has been caused by the fault of the patentee himself, objection will be allowed (*c*). So also where a patentee has **delayed, intentionally**, putting his invention into practice, unless he can show that shortness of funds, or other reasons, placed it out of his power to avoid the delay (*d*).

We have seen that the novelty or utility of a patent will not be inquired into, except so far as they bear upon the merit of the invention. Nor will the validity of the patent be inquired into, excepting in cases where it is **obvious the patent is invalid**. In *Re Hills' Patent* (*e*), Sir J. T. Coleridge said: "Their lordships have not in these cases been in the habit of trying the validity of patents. They will not, of course, recommend the extension of a patent

(*y*) *In re Pinkus' Patent*, 12 Jur. 233.

(*z*) *In re Simister's Patent*, 1 Web. P. C. 721; also *In re Pinkus' Patent*, supra.

(*a*) *In re Woodcroft's Patent*, 1 Web. P. C. 740.

(*b*) *In re Galloway's Patent*, 1 Web. P. C. 724.

(*c*) *In re Patterson's Patent*, 6 Moo. P. C. C. 469.

(*d*) *In re Norton's Patent*, 1 Moo. P. C. C., N. S. 339.

(*e*) 1 Moo. P. C. C., N. S. 258.

which is manifestly bad ; but, on the other hand, they will not generally enter into questions of doubtful validity. They lay aside, therefore, the questions of **want of novelty** and **want of utility**, so far as they affect the validity of the patent. Indeed the learned counsel for the opponents disclaimed, and very properly, any intention of impeaching its validity directly ; but they contended that, both with respect to the novelty and the utility of the invention, the degree of merit to be attributed to the petitioner ought to be taken into account ; and in their lordships' judgment they are right in that contention. Unless the patent be very clearly invalid, so that it would be altogether nugatory to prolong that patent, the court usually has been rather inclined to assume that the patent may be a good patent, and so leave the question to any legal consideration that may arise in a contest between the parties who are interested in it" (*f*).

An illustration of what is meant by the patent being clearly bad is given in *Re M'Innes' Patent* (*g*). The patent was for a metallic soap to be used for the purpose of preserving metals from rust. The specification was very widely worded. Sir W. Earle said, "Their lordships taking into consideration with reference to the public interest that the individual substance for the application of which the patent is sought to be prolonged is not specially defined, every kind of metallic soap being within the limits of the specification, are of opinion that many questions affecting the patent might be raised if any metallic soap was used by the public in ignorance of the specification being as wide as it is. On the whole, therefore, their lordships are of opinion that they ought not to recommend her Majesty under such circumstances to grant a prolongation."

In consequence of sect. 25 of the Patent Law Amendment Act, 1852, and of sect. 7 of 16 & 17 Vict. c. 115,

(*f*) Per Lord Langdale, M. R.,
In re Pinkus' Patent, 12 Jur. 233.

(*g*) 5 Moo. P. C. C, N. S. at
p. 78.

which provided that letters patent obtained in the United Kingdom for patented foreign inventions should not continue in force after the expiration of the foreign patent, and that any prolongation of letters patent should be made subject to that condition. **An inquiry into foreign patents and their duration was always an essential element of the proceedings before the Privy Council (h).**

These Acts are, however, specifically repealed, and by sect. 45, sub-sects. 2 and 3, of the Act of 1883 it is provided, "*Every patent granted before the commencement of this Act, or on an application there pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licenses. In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.*"

Thus it will be seen that after the commencement of the Act any prolongation of letters patent will be made regardless of foreign patents or their duration, saving with regard to the profits thereof, *ante*, p. 155.

Prior to the Act of 1883 it had been held, in a series of cases, that **executors and administrators** of a grantee of letters patent might petition for an extension (*i*). So might the assignee of a patent, even though a public company (*k*). So might the executor of an assignee (*l*).

(h) *In re Bodmer's Patent*, 8 Moo. P. C. C. 282; *In re Aubé's Patent*, 9 Moo. P. C. C. 43; *In re Newton's Patent*, 15 Moo. P. C. C. 176; *In re Betts' Patent*, 1 Moo. P. C. C., N. S. 49; *In re Poole's Patent*, 4 Moo. P. C. C., N. S. 452; *In re Normand's Patent*, 6 Moo. P. C. C., N. S. 477; *In re Winan's Patent*, 8 Moo. P. C. C.,

N. S. 306; *In re Johnson's Patent*, 8 Moo. P. C. C., N. S. 282; *In re Blake's Patent*, L. R., 4 P. C. 535.

(i) *In re Heath's Patent*, 8 Moo. P. C. C. 217.

(k) *In re Norton's Patent*, 1 Moo. P. C. C., N. S., 339.

(l) *In re Bodmer's Patent*, 1 Moo. P. C. C. 469.

The Act of 1883 gives a **patentee** the right to petition, and, bearing in mind that the **definition of the word patentee** is by sect. 46, "*Any person for the time being entitled to the benefit of a patent,*" it will be observed that the greatest latitude is given as to persons who may petition. The committee will still regard different classes of petitioners in different lights.

In *Re Norton's Patent*, quoted above, Sir John Romilly, then Master of the Rolls, said, "Under the late statute, 7 & 8 Vict. c. 69, s. 4, a person is not excluded from applying for an extension of a patent upon the ground of his being the assignee of the patent; but it must always be borne in mind that the assignee of a patent does not, unless under peculiar circumstances, apply on the same favourable footing that the original inventor does. The ground that the merits of the inventor ought to be properly rewarded, in dealing with an invention which has proved useful and beneficial to the public, does not exist in the case of an assignee, unless the assignee be a person who has assisted the patentee with funds to enable him to perfect and bring out his invention, and has thus enabled him to bring it into use."

And in *Re Pitman's Patent (m)* Sir J. W. Colvile said: "There are no doubt cases in which their lordships have granted applications by the assignees of the patentee for extension of the term, and have also considered, in some respects, the expenses incurred by the assignee in bringing the patent into notice, and for the merit as it may be said of the assignee in patronizing the patentee, and in pushing the patent into notice; but the general rule which their lordships entertain in applications on the part of assignees is, as was stated by Lord Brougham in *Re Morgan's Patent (n)*, that by so doing 'they are, though not directly yet mediately and consequentially, as it were, giving a benefit to the inventor, because, if the assignee is not

(m) 8 Moo. P. C. C., N. S. 293.

(n) 1 Web. P. C. 737.

remunerated at all, it might be said that the chance of the patentee of making an advantageous conveyance to the assignee would be materially diminished, and consequently his interest damnified. For this reason consideration has been given to the claims of the assignee who has an interest in the patent.'”

There is no case showing that an extension has ever been granted to licensees; but it may be suggested that at any rate *exclusive* licensees are “persons for the time being entitled to the benefit of a patent,” although, of course, very exceptional circumstances indeed would have to be shown to warrant an extension to them.

It is difficult to estimate the effect of sect. 36 of the Act of 1883 upon this branch of the subject. Sect. 36 provides that: “*A patentee may assign his patent for any place in or part of the United Kingdom or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.*”

Will the Privy Council, on the application of an assignee for a portion of the kingdom, extend the patent for that portion, or must all parties to the patent join in the petition?

It is evident that whilst one district assignee of an electric light patent, for example, may have been amply remunerated, another may not have been remunerated at all, owing to the action of local authorities or other matters entirely beyond the assignee's control. How could the committee in justice refuse the latter an extension? On the other hand, how could they grant it to the other?

Then again, if a patent may be extended for one district and not for another, we shall have the enormous practical difficulties and public inconveniences of an article being patented in one county and free in another, a state of affairs which, we venture to say, would be intolerable to the public.

Any person may enter a **caveat against the extension,**

and may be heard at the bar in support of their opposition ; and where unreasonable opposition is offered, they will be ordered to pay the petitioner's costs (*o*). But where the opposition is well founded and successful, costs will be allowed to the opposing party (*p*). If the petition be **abandoned, costs will be given to opposers**, and they need not give the petitioner notice of their intended application for the same (*q*). Where the petitioner had fairly and honestly stated his case, both the things against and the things for him in his petition, and the inquiry had been prolonged by the opposition, the costs of the opposition refused, although the petition had been dismissed on the ground of sufficient remuneration.

Where two or more parties have opposed the petition separately and successfully, the committee will sometimes order a **fixed sum** to be paid by the petitioner to the opponents, to be apportioned between them in lieu of saddling him with several separate sets of **taxed costs** (*r*). We thus see that, whilst on the one hand an unwarranted application for an extension may be very costly, unreasonable opposition may be equally so.

An extension of a patent having once been granted, the Privy Council have no jurisdiction to entertain a petition for a **further prolongation**, their power being exhausted ; and this objection may be taken by an opposing party, even though omitted from the objections filed by them (*s*).

The rules of practice to be observed upon application for extensions of letters patent will be found hereafter.

(*o*) *In re Downton's Patent*, 1 Web. P. C. 565.

(*p*) *In re Westrupp and Gibbins' Patent*, 1 Web. P. C. 554.

(*q*) *In re Bridson's Patent*, 7 Moo. P. C. C. 499. See, however, *In re Milner's Patent*, 9 Moo. P. C. C. 39.

(*r*) *In re Jones's Patent*, 9 Moo. P. C. C. 41. Also *In re Hills' Patent*, 1 Moo. P. C. C., N. S. 258, and *In re Wield's Patent*, 8 Moo. P. C. C., N. S. 300 ; *Newton's Patent*, 9 App. Ca. 592.

(*s*) *In re Goucher's Patent*, 2 Moo. P. C. C., N. S. 532.

CHAPTER X.

CONFIRMATION.

THE statute 5 & 6 Will. IV. c. 83, provided a remedy for cases of hardship, such as, where an invention had been invented or used and subsequently abandoned before the date of the patent in a manner unknown to the patentee at the time of his application. There would be a sufficient prior user to invalidate the patent, and yet there would be great merit probably in the patentee, and a great benefit to the public. The patentee might petition the Privy Council to confirm the patent, that is, to declare it valid, notwithstanding such prior user. The proceedings on such a petition were similar to those upon a petition for extension.

The Act of 1883 repeals the statute 5 & 6 Will. IV. c. 83, and with it all proceedings for confirmation; and this method of clothing an invalid patent with validity is abolished. A perusal of sect. 45, sub-sects. 2 and 3, shows that this applies to patents existing at the commencement of the Act, as well as to those to be hereafter applied for and granted.

It is not strictly the purpose of a law work to criticise the enactments of the legislature, saving in their construction and application from an administrative point of view, otherwise a great deal might be said as to the advisability of abolishing that which was intended for and operated merely as a relief under very hard and exceptional circumstances.

CHAPTER XI.

REMEDIES OF THE PATENTEE AND OF THE PUBLIC—ACTION
FOR INFRINGEMENT.

AN action for infringement is the remedy which the patentee has, and the means which is given to him for enforcing his patent privileges.

The courts are bound to take notice of the patent, and are bound to give legal effect to it, provided it cannot be shown to have been granted contrary to law.

PARTIES TO THE ACTION.

The Act of 1883 gives no directions as to what persons may be **plaintiffs or defendants** in an action for infringement, and therefore leaves the question of the parties to the action as it was before the passing of the Act.

The **original grantee**, it is obvious, so long as he has not parted with the whole of his interest in the patent, may be a plaintiff. And so may the **assignee** of a patent (*a*), even though he has acquired the right by assignment of two separate moieties, and the party sued is the original grantee (*b*).

The **assignee of a portion** of a patent may sue for an infringement of that part. Erle, C.J., in giving judgment in *Dunnicliff v. Mallett* (*c*), said: "The question is

(*a*) *Electric Telegraph Co. v. N. S.* 162.
Brett, 10 C. B. 838.

(*c*) 7 C. B., N. S. 209.

(*b*) *Walton v. Lavater*, 8 C. B.,

whether an assignment of part of a patent is valid. I incline to think that it is. It is every day's practice for the sake of economy to include in one patent several things which are in their nature perfectly distinct and severable. . . . Being therefore inclined to think that a patent severable in its nature may be severed by the assignment of a part, I see no reason for holding that the assignee of a separate part which is the subject of infringement may not maintain an action." The plaintiff in such an action would not be allowed to sever his part from the rest of the patent, and he would be liable to be defeated if it could be shown that the patent in any of its parts was void. But, on the other hand, he would have to show that his part alone would have been sufficient to support a patent, *i.e.*, that it contains a new and useful invention. Sect. 33, however, of the Act of 1883, provides, "*Every patent . . . shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.*"

By sect. 36, "*A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.*" The **assignee for a district** will be in a position to bring an action for infringement, but it is obvious that the infringement must be within his district, otherwise he will be unable to prove damage.

One of several joint owners of a patent may bring an action in his own name to restrain infringement, or for damages, without joining his other co-owners (*d*), and he may sue alone for an account of profits, and for payment to

(*d*) *Sheehan v. Great Eastern Dent v. Turpin*, 2 J. & H. 139.
Rail. Co., L. R., 16 Ch. D. 39 ;

the plaintiff of such part of such profits as the plaintiff should be entitled to.

Abinger, C.B., in *Derosne v. Fairie* (e), said that "a mere licensee could maintain no action against anyone else for the infringement of a patent." He might, however, use the name of the grantor of the license for the purpose provided he were an **exclusive licensee** (f).

A mere licensee would have no exclusive right to use the invention; he is only a person who is permitted to use it. The grantor of such a license might grant a dozen other such licenses without prejudicing the rights of the licensee; but an exclusive licensee has a right of property in the monopoly, and stands very much in the same position as an assignee for a district. The term exclusive, as applied to a licensee, meaning exclusive within an area.

When the exclusive licensee finds it necessary to protect his rights by bringing an action in the name of the licensor he is liable to give the licensor security for the costs (g) which, in the event of defeat, the licensor would have to pay. The right, however, to assign for particular districts will make this branch of the subject unimportant, since exclusive licenses were only a scheme for the purpose of, in effect, assigning for districts.

The **assignees or trustees** in bankruptcy of a patentee may maintain action for infringement in their own name (h), and so may the **executors or administrators** of a patentee.

As defendants, a person physically using a patented invention is liable, such as a **contractor** (i). When a person in the position of a **servant** uses a patented invention, the master, in law, is the person who physically uses

(e) 1 Web. P. C. 154.

(h) *Bloxam v. Elsee*, 6 B. & C.

(f) *Renard v. Levinstein*, 2 Hem. & M. 628.

169.

(g) *Evans v. Rees*, 2 Q. B. 334; *Spicer v. Todd*, 1 D. P. R. 306.

(i) *Denley v. Blore*, 38 Lond. Jour. 224.

the invention as well as the servant, and the master may be sued. If a servant uses an invention in the course of his employment the master is liable, even though the master has told the servant to avoid infringing the patent (*k*). The **directors of a company** whose servants infringe an invention are personally liable (*l*).

An architect specifying the use of a patented invention is not liable (*m*).

Aliens infringing a patent in this country by vending or otherwise are liable if they come within the jurisdiction of the courts (*n*). A person ordering goods to be made in England which are an infringement of a patent, although intended for exportation to him abroad, infringes the patent. "He that causes or procures to be made may be well said to have made himself." Per Tindal, C. J. (*o*).

(*k*) *Betts v. De Vitre*, L. R., 3 Ch. App. Cas. 429.

(*l*) *Ibid.*

(*m*) *Denley v. Blore*, 38 Lond. Jour. 224.

(*n*) *Caldwell v. Vanvliessen*, 9 Hare, 415.

(*o*) *Gibson v. Brand*, 11 L. J., C. P. 177.

CHAPTER XII.

THE CAUSE OF ACTION—INFRINGEMENT.

THE infringement of a patent is the doing that which the patent prohibits from being done (*a*). The words of the Royal Command are as follows: "We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years, either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, license or agreement of the said patentee in writing under his hand and seal, on pain, &c."

There is no duty cast upon a patentee to inform persons that what they are doing amounts to an infringement of his patent, and he is not estopped by omitting to give such information, although he knew of the infringement, from subsequently bringing his action (*b*).

The **question of infringement** or no infringement is one of fact, and therefore **is for the jury** (*c*). But this refers to the mere infringement alone within the meaning of

(*a*) *Walton v. Bateman*, 1 Web. P. C. 613.

(*b*) *Proctor v. Bennis*, 36 Ch. D.

(*c*) *Walton v. Potter*, 1 Web. P. C. 585; *De la Rue v. Dickenson*, 7 E. & B. 738.

Tindal, C. J., in *Muntz v. Foster* (*d*), when he told the jury that “for the purpose of inquiring whether the defendants have infringed the patent or not, we are to assume that it is a good patent, that no objection arises either to the nature of the grant or the specification which has been enrolled by the plaintiff.”

If the patent is invalid there can be no infringement in the sense that a patent which has no legal existence cannot be infringed. But assuming that it has a legal existence, the question is for the jury. This explains the apparently contradictory decision in *Curtis v. Platt* (*e*) in the House of Lords. The question of infringement was there taken as involving the validity of the patent.

It is equally an infringement whether the defendant acted in **ignorance** of the plaintiff's patent or not. In *Heath v. Unwin* (*f*), Parke, B., delivering the judgment of the Court, said:—“There was therefore no intention to imitate the patentee's invention, and we do not think the defendant can be considered to be guilty of any indirect infringement if he did not intend to imitate at all.” This judgment certainly gives an erroneous impression of the law, and Shadwell, V.-C., when the same case came before him (*g*), said:—“The party complaining of the act is not the less prejudiced by it because it was committed unintentionally; and my opinion is that, if a party has done an act that is injurious to the rights of another (though without any intention of doing him an injury) he is answerable for the consequences.” In *Stevens v. Keating* (*h*) the Lord Chancellor disapproved of the case in the Court of Exchequer; “and I must decline to act upon the principle which it lays down.”

Subsequently, when *Heath v. Unwin* came before the House of Lords, the opinion of the judges being taken,

(*d*) 2 Web. P. C. 99.

(*e*) L. R. 1 H. L. 337; 35 L. J.,
Ch. 852.

(*f*) 14 L. J., Ex. at p. 156.

(*g*) 15 Sim. 553.

(*h*) 1 Mac. & G. 659.

Parke, B. (i), acknowledged the error into which the Court had fallen, and approved of *Stevens v. Keating*.

In *Stead v. Anderson* (k), Wilde, C.J., tersely puts it:—
“The question of infringement depends not on what the defendant intends, but on what he does.”

So it is **immaterial whether the defendant was aware** that the thing was patented or not, since in law every person in the realm is taken to have notice of a patent in the same way that he is taken to be aware of the law (l).

And the converse is also sound—if a person intending to infringe a patent does not in fact do so, he will not be taken to have infringed (m).

In *M'Cormick v. Gray* (n) the specification, after describing several parts of reaping machines, including some cutting blades of peculiar construction, claimed: “The construction of reaping machines according to the improvements before described—that is to say, the constructing and placing of holding fingers, cutting blades, and gathering reels, respectively, as before described, and the embodiment of those parts as so constructed and placed, all or any of them in machines for reaping purposes, whether such machines are constructed in other respects as before described, or however else the same may in other respects be constructed.”

The defendant made and sold cutting blades similar to those described by the plaintiff's patent, which were *capable of being used* in the plaintiff's reaping machine. Bramwell, B., in giving judgment, said:—“A man could not make the blade of a knife without infringing this person's patent, because you may intend to put it into a machine, or you may not. I think it is a very clear case, and I am satisfied there is no difference between making a thing with one

(i) 25 L. J., C. P. at p. 19; 5 T., N. S. 245.
H. L. Cas. 505.

(k) 2 Web. P. C. 156.

(l) *Walton v. Lavater*, 29 L. J.,
C. P. 275; *Curtis v. Platt*, 11 L.

(m) *Newall v. Elliott*, 10 Jur.,
N. S. 954.

(n) 31 L. J., Ex. 42.

intent and making it with another, because I always understood, that if a man may do a thing, he may do it with whatever intent he pleases." It will be observed, that in this case, to make the knives was no infringement, and there was no evidence of the defendant having applied them to reaping machines (*o*).

Thus we see that infringement, as taken apart from the question of validity, is a matter of fact, and that intention is not material to the conclusion.

To prove infringement, it must be shown that there is a **substantial resemblance** (*p*). The infringement must be of a part for which the patent was granted, and not merely of a part described in the specification (*q*).

A patented article sold by a patentee carries with it the right of being used and sold anywhere (*r*).

It is impossible to surmise how the Courts will deal with sect. 36 of the Act of 1883, which enables a patentee to assign his patent for any place or part of the kingdom as effectually as if the patent were originally granted to extend to that place or part only.

Supposing a patentee to assign a patent for making brushes for London to A, and for Liverpool to B. Will the purchaser of brushes from A in London be infringing the rights of B by using the brushes in Liverpool, and will he be liable to an action? If he is not liable to be sued, of what use is the right of assignment for a part only, since the assignee, for one place, could make the brushes in that place, and sell them universally to the detriment of assignees for other places.

The amount of prior user which will be sufficient to invalidate a patent, differs considerably from the amount of **user** which will be held to infringe a patent: "these

(*o*) See, however, *Bancroft v. Warden*, Romilly's Notes of Cases, 103.

(*p*) *Stead v. Anderson*, 2 Web. P. C. 151.

(*q*) *Croll v. Edge*, 19 L. J., C. P. at p. 264.

(*r*) *Betts v. Willmott*, L. R., 6 Ch. App. Cas. 239.

are different questions, depending on wholly different considerations, the one upon the extent of previous knowledge, the other upon the effect of the grant" (s).

In *Barlow v. Baylis* (t) the patent was for "improvements in manufacturing metal nuts, and in machinery for stamping, forging and rolling the same." Action for infringement; defence anticipated by Berry. It was contended by the plaintiff that Berry's machine would not work. Brett, J., in summing up to the jury, said:—"Now the first question about Berry's machine which I will ask you is this: Was Berry's ever a machine or invention in this sense, that a workman could, from his specification and drawings, make the machine described by him so that it would, more or less badly, do the work required of it? because, in my opinion, if it would not, I do not say perfectly, but if it would not do the work required of it, it was not an invention at all, or a machine in a business sense. . . . I put the words 'more or less badly,' because I do not think that if the only defect in the machine was some defect in the levers which any workman could find out at once, if it would make a nut, though badly, that would not prevent it from being a machine."

The jury found that Berry's machine would not do the work more or less badly. Judgment for plaintiffs. Judgment upheld by the Court of Common Pleas.

In *Brereton v. Richardson* (u), infringement of a patent for "a new and improved tricycle," alleged prior user by Jackson and his family; reply that this was merely an experimental user. Field, J., said:—"Their driving to Cheam, Worcester Park, and Malden, going about on business night and day, and for pleasure; and the public notoriety which the thing had excited in the neighbourhood, so that it was called 'Jackson's patent threshing machine,' all

(s) Per Turner, V.-C., in *Caldwell v. Vanlissengen*, 9 Hare, 428; *Newton v. Grand Junction Rail.*

Co., 5 Ex. 331.

(t) Griffin P. C. at p. 44.

(u) 1 P. O. R. 166.

satisfy me that, provided I am right in holding that the thing was substantially the same, it was publicly used. A question of difficulty occurred to my mind as to what degree of public user is enough when you have to deal with a thing like that. I quite understand that if there were at this moment an axle running under an omnibus which I could not see, it might or might not be a public user. I think it would be a public user." Action dismissed with costs.

We have seen that by sect. 33 of the Act of 1883, a patent may still contain more than one claim, and in such a case, provided every claim which is made is valid, a patent may be infringed by infringing any one claim. In *Gillett v. Wilby* (x), Coltman, J., said :—" If they are all new (the parts claimed), and the defendant has infringed any one of them, it will be sufficient to support the action, and it is not necessary that he should have infringed them all." In *Newton v. The Grand Junction Rail. Co.* (y), Pollock, C.B., said :—" But in considering the question of infringement, all that is to be looked at is, whether the defendant has pirated a part of that to which the patent applies ; and if he has used that part for the purposes for which the patentee adapted his invention, and for which he has taken out his patent, and the jury are of opinion that the difference is merely colourable, it is an infringement," and in *Sellers v. Dickenson* (z), the same judge said :—" There may be an **infringement by using so much of a combination as is material** . . . if a portion of a patent for a new arrangement of machinery is in itself new and useful, and another person, for the purpose of producing the same effect, uses that portion of the arrangement, and substitutes for the other matters combined with it another mechanical equivalent, that would be an infringement of the patent."

" Where a patent is for a combination of two, three,

(x) 9 Car. & P. 336.

(y) 5 Ex. 331.

(z) 5 Ex. 324.

or more old inventions, a user of any of them would not be an infringement of the patent; but where there is an invention consisting of several parts, the imitation or pirating of any part of the invention is an infringement of the patent" (a).

Speaking of this case in *Clark v. Adie* (b), James, L.J., said:—"Upon the authority of *Smith v. L. & N. W. Railway Co.*, it has been strongly contended before us that whenever there is a patent for a combination, that patent gives protection, not indeed to every distinct thing that enters into the combination, but to every combination, arrangement and aggregate of two or more of those distinct things, even although such subordinate combination is not expressly or impliedly claimed in the specification. This, in our opinion, is so startling a violation of every principle of patent law, that we doubt whether we could follow any authority, short of the House of Lords, in applying such a doctrine. If a patent for a combination of several parts is in reality a patent, and gives really a monopoly for every combination of any two or more of those parts, then it follows, from the very first principle of patent law, that if any conceivable combination of any two or more parts was old, the patent would be bad. On the other hand, if the patentees say, 'No, we do not claim to protect every combination of those parts, but only those subordinate combinations, or parts of the combination, which are new and useful,' then such a claim would be entirely inconsistent with the leading case of *Foxwell v. Bostock* (c), which, we may be permitted to say, is as good sense as it is sound and intelligible law . . . I will state what we conceive to be the real principle which

(a) Per Campbell, C. J., in *Smith v. L. & N. W. Rail. Co.*, 2 E. & B. 76; *The Patent Bottle Envelope Co. v. Seymer*, 5 C. B., N. S. 172.

(b) L. R., 10 Ch. App. Cas. 674.
(c) 12 W. R. 723. See also *Harrison v. Anderston Foundry Co.*, pp. 98—99, *supra*.

underlies the case of *Lister v. Leather* (d), and which reconciles it with the other cases, and with general principles, and common sense. A patent for a new combination or arrangement is to be entitled to the same protection, and on the same principles, as every other patent. In fact every, or almost every patent, is a patent for a new combination. The patent is for the entire combination, but there is, or may be, an essence or **substance of the invention** underlying the mere accident of form, and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact, whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination."

In *Nordenfelt v. Gardner* (e), Brett, M.R., said:—"The machine which is challenged may have that combination actually without any variance at all. If so, it is obvious that the challenged machine is an infringement, or it may have that combination with some alteration. The alteration of a combination as it seems to me may be by addition or subtraction, or substitution of parts. Any one of these alters the combination. If the alteration, whether it be by addition, or subtraction, or substitution, be merely colourable, then the two machines are substantially the same; although not mathematically exactly the same, they are substantially the same; and in any case, notwithstanding such colourable alteration, there may be an infringement. An *alteration by addition* may be an improvement, but then that will leave the whole of the original combination, and add something to it. If such an alteration of the combination be made, it seems to me that no good patent can be made with regard to the new machine except by claiming the invention as an improvement, and by showing distinctly what the addition is so as to show what the improvement is. An *alteration by subtraction*, if it were

(d) 8 E. & B. 1004.

(e) 1 P. O. R. 65.

more than a colourable subtraction, would, as it seems to me, alter the combination. It would not be a combination of the same things, it would be a combination of different things; and if the combination were altered by a material subtraction, I should think that it was a new combination. But an *alteration by substitution*, that is, by substitution of one of the material elements of the original combination, must to my mind be a new combination. The second combination, then, is a combination of different things from the first. There is a taking away of one of the elements, and a material element of the old combination, and a putting in of a new material element which is different from any of the elements of the former."

Where, however, the **application** by the defendant of a portion of the invention of the plaintiff is **for a different object**, and with a view of carrying out a principle totally newly discovered by the defendant, and which was unknown to the plaintiff, there is no infringement, although at first sight there appears to be some similarity of process (*f*).

We have seen that sect. 5, sub-sect. 5, provides that a complete specification must conclude with a distinct statement of the invention claimed; so that, if the invention be a combination, it must be so stated; if for parts, they must be claimed. There is no **infringement** if the defendant cannot be shown to have infringed, directly or indirectly, **a part or parts of the claim** (*g*). In *Lister v. Leather* (*h*) it was held that a valid patent for an entire combination, or for a process, gives protection to every part that is new and material, for the purpose of effecting that particular combination or process, without any express claim of particular parts, and notwithstanding that parts of the combination are old. In future, if any parts are

(*f*) *Newton v. Vaucher*, 6 Ex. 859. See also *Morewood v. Tupper*, 3 C. L. Rep. 718.

(*g*) *Jackson v. Wolstenhulmes, Griffin* P. C. 134.

(*h*) 8 E. & B. 1004.

desired to be protected, as well as the combination or process, the claim will have to be so drawn as to include those parts.

The jury will always have to consider whether the infringing machine process or combination is a **substantial imitation** (i). No fine lines can be drawn as to what amounts to substantial imitation. In *Clarke v. Adie* (k), in the House of Lords, Lord Blackburn said :—“ I incline to agree with what was said in the Exchequer Chamber in the case of *Lister v. Leather* (l), that you cannot decide in the abstract whether the using of two parts, A and B, of a combination of A, B, and C is or is not using part of that invention, nor can you decide in the abstract the other question, which was somewhat discussed in the case of the sewing machine (*Foxwell v. Bostock*) (m), whether or no the specification shows that A or B is sufficiently claimed as a part of the invention or not. I do not think that either of those questions can be decided in the abstract. I would wish, like the Exchequer Chamber in *Lister v. Leather*, before deciding it, to have before me the nature of the machine, in order that I may see what A, B, and C are, and what is their relation to each other.”

In *Parkes v. Stevens* (n), James, V.-C., said :—“ The authority of that case (*Lister v. Leather*) has been pressed upon me as if it really established this, which would be a most startling proposition, that a patent for a combination or arrangement would be a distinct patent for everything that was new and material and that went to make up the combination . . . the judgment if read well will be found to give no warrant whatever for such, I must call it, baseless notion. The law is summed up thus. The cases establish that a valid patent for an entire combination for a process gives protection to each part thereof that is

(i) *Thomas v. Foxwell*, 5 Jur. N. S. 39.

(k) L. R., 2 App. Cas. 335.

(l) 8 E. & B. 1004.

(m) 12 W. R. 723.

(n) L. R., 8 Eq. 358.

new and material *for that process*, which is really nothing more than stating in other words that you not only have no right to steal the whole, but you have no right to steal any part of a man's invention ; and the question in every case is a question of fact—is it really and **substantially a part of the invention** " (o). This judgment was affirmed on appeal (p).

If a man in the course of producing an improved combination substantially uses a combination which already forms the subject of a patent he thereby infringes the patent, notwithstanding that the combination he is making has a different end in view than that which has been patented (q).

But, on the other hand, where a patent is for a combination a person who takes a new and material part of the combination, but **not for a similar or analogous purpose** to that to which it was applied in the patent, does not infringe the patent (r).

If the invention be for a combination or process whereby an already well-known object is produced, it will be no infringement to make **another combination**, even of the **same materials** (provided they be also old and well-known), for the purpose of attaining the same object, for the patent is for the *means* of attaining the object, and if other means are employed there is no infringement. The patent is also for the *method* of combining the old and well-known materials, and if **another method** is adopted there is no infringement (s).

When the defendant has set himself to work to **evade the plaintiff's patent** by fraudulently making a colourable

(o) See also *Wright v. Hitchcock*, L. R., 5 Ex. 37; on the other side *White v. Fenn*, 15 W. R. 348.

(p) 5 Ch. Ap. Cas. 36.

(q) Per Lord Westbury in *Cannington v. Nuttall*, L. R., 5 H. L.

T.

at p. 230.

(r) *Lister v. Eastwood*, 9 L. T., N. S. 766.

(s) *Curtis v. Platt*, in the House of Lords, 35 L. J., Ch. 852; L. R., 1 H. L. 337.

imitation, or substituting a mechanical or chemical equivalent, the cases show that the Courts will look strictly at what he has done, and will take care that he does not overstep the line which he is endeavouring to keep within.

The question of fraudulent evasion is, as we have shown, one of fact. "A slight departure from the specification, for the purpose of evasion only, would, of course, be a fraud upon the patent; and therefore the question will be, whether the mode of working by the defendant has or has not been essentially or substantially different" (*t*).

In *Dudgeon v. Thompson* (*u*) Lord Cairns makes strong objection to the use of the term **colourable imitation**, in connection with the infringement of patents, and proceeds:—"If there is a patented invention, and if you, the defendant, are found to have taken that invention, it will not save you from the punishment or from the restraint of the Court, that you have, at the same time that you have taken the invention, dressed it up colourably, added something to it; taken, it may be, something away from it, so that the whole of it may be said, as is said in this injunction, Here is a machine, which is either the plaintiff's machine, or differs from it only colourably. But underlying all that there must be a taking of the invention of the plaintiff. There used to be a theory in this country, that persons might infringe upon the equity of a statute, if it could not be shown that they had infringed the words of the statute; it was said that they had infringed the equity of the statute, and I know there is by some confusion of ideas, a notion sometimes entertained that there may be something like an infringement of the equity of a patent. My lords, I cannot think that there is any sound principle of that kind in our law; that which is protected is that which is specified, and that which is held to be an infringement

(*t*) Per Dallas, J., in *Hill v. Thompson*, 1 Web. P. C. 242.

(*u*) L. R., 3 App. Cas. at p. 43.

must be an infringement of that which is specified. But I agree it will not be the less an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist, and yet the thing protected by the specification be taken notwithstanding."

Summing up the cases, therefore, we come to this. Strictly speaking, there is no such thing as a colourable imitation: either the defendant has infringed the thing specified or he has not. At the same time there is an essence or substance to every invention underlying the mere accident of form or words. If the defendant has imitated and adopted the **essence of the invention** he will not be allowed to escape because he has not adopted the form or words in which the essence of the invention is clothed (*x*).

There is a description of imitation which is produced by the substitution of **chemical or mechanical equivalents**. To the unscientific eye there is a total dissimilarity between the infringing machine or process and the original; but, none the less, it is a mere imitation—it is a robbery of the ideas and intentions of the first inventor, but a robbery conducted in a scientific manner.

We have seen that a patent cannot be granted for the

(*x*) *Thorn v. The Worthing Skating Rink Co.*, L. R., 6 Ch. D. 415; *Flower v. Lloyd*, W. N. 1877, p. 132; *Barrett v. Vernon*, 45 L. T. (N. S.) 755; *Bailey v. Robertson*, L. R., 3 App. Cas. 1055. And the older cases, *Bovill v. Moore*, Dav. P. C. 405; *Forsyth v. Riviere*, 1 Web. P. C. 97; *R. v. Lister*, Web. P. L. 80; *Minter v. Wells*, 1 Web. P. C. 130; *Morgan v. Seaward*, per Alderson, B., 1 Web. P. C. 171; *Walton v. Potter*, 1 Web. P. C. 586; *Neilson v. Harford*, 1 Web. P. C. 310; *Walton v. Bateman*, per Cresswell, J., 1 Web. P. C. 616; *Muntz v. Foster*, per Tindal, C. J., 2 Web. P. C. 101; *Russell v. Ledsam*, 14 M. & W. 580; *Gamble v. Kurtz*, 3 C. B. 425; *Stead v. Anderson*, 2 Web. P. C. 156; *Unwin v. Heath*, 25 L. J., C. P. 8; *Curtis v. Platt*, 35 L. J., Ch. 852; *Murray v. Clayton*, L. R., 7 Ch. App. Ca. 585.

discovery of a mere principle (*y*), but that, if the principle when discovered is at the same time applied, a valid grant may be made for the application of the principle. The essence of the patent is the fact of applying the newly-discovered principle to a particular end. Now a mechanical or chemical **equivalent is another method** of producing the same result, a method which a skilled mechanic or chemist, having once seen the original invention, could at once suggest and apply without the necessity of any inventive power whatever. Equivalents may be substituted for parts as well as for the whole invention, so that it may happen that a patent is taken out which consists of three parts. An equivalent may be substituted for each part, so that in effect the whole invention may be changed and yet there may be a most flagrant infringement.

Take, for instance, the case of *Stevens v. Keating* (*z*). Here the patent was for the manufacture of cement. The cement was made from gypsum (sulphate of lime) by admixing it with pearlash (carbonate of potash) and sulphuric acid. Chemically, the effect was this: Sulphate of potash was produced; this, combined with the sulphate of lime, produced a double salt, which, when submitted to a high temperature and subsequently ground to a fine powder, constituted the cement. The principle of this discovery was that sulphate of lime combined with salts of potash or soda, and when so combined, produced a substance which set very hard. The defendant substituted for the pearlash and sulphuric acid a chemical equivalent, borate of soda (borax), and heated that with gypsum, producing in the same manner a double salt, and with the same resulting property of setting. This was properly held to be an infringement.

“Equivalents which are not known at the time of the patent as equivalents and afterwards are found to answer

(*y*) Ante, p. 23.

(*z*) 2 Web. P. C. 181.

the same purpose, are not included in the specification. They are new inventions." Per Baron Parke (a).

In *Russell v. Cowley* (b) the invention claimed was that of bringing to a welding heat a long piece of iron of the proper quality; after having turned up its edges and drawing it through a hole of the proper size of the intended tube, so as to compress together the edges and give it a complete circular form. The defendants turned up the skelp, and, after heating it in the furnace, passed it through two rollers with grooves:—Held, that the two rollers with grooves were a mere mechanical equivalent for the hole through which the iron was passed under the patent (c).

In *Curtis v. Platt* (d), Wood, V.-C., said:—"Where the thing is wholly novel and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machine for effecting the same object, to see whether or not they are merely colourable contrivances for evading that which has been before done. When the object itself is one which is not new but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before has a right to extend very largely the interpretation of those means which he has adopted for carrying it into effect. Because otherwise that would be to say that the whole world is to be precluded from achieving some desirable and well known object which everybody

(a) *Unwin v. Heath*, 2 Web. Pat. Cases, 314.

(b) 1 Web. P. C. 463.

(c) See also *Jupe v. Pratt*, 1 Web. P. C. 146; *The Electric Telegraph Co. v. Brett*, 10 C. B. 838; *Hancock v. Moulton*, Johnson's Patentees' Annual, 3rd ed.

208; *Bateman v. Gray*, Mac. P. C. 102; *Simpson v. Holliday*, 20 Newton's Lond. Journ. (N. S.) 111; *United Telephone Co. v. Harrison, Cox, Walker & Co.*, L. R., 21 Ch. D. 720.

(d) L. R., 3 Ch. D. 136 (note).

has had in view for years. In such a case it may be said that the means taken are simply mechanical equivalents for the means previously adopted for arriving at the same object."

There are three ways in which a patent may be infringed :—

1. By making the patented article or working the process.

2. By using.

3. By selling.

BY MAKING.

A person may infringe a patent by making the article himself, or by his agent, or by his servants. The agent and servants, it is true, will be considered as equally infringing the patent, and actions may be brought against them individually, but that in no way absolves the person who employs them for that purpose. In *Sykes v. Howarth* (e) a patent consisted of the application of cards or strips of leather covered with wire or rollers at "wide distances." A person who contracted to clothe rollers and supplied to a "nailer" cards of such width that when applied to the rollers they must of necessity leave wide spaces, and who himself paid the nailer, was held to have infringed the patent, though he alleged that his business was that of a card-maker only and did not include the nailer's work. In giving judgment, Fry, J., said :—"I have come to the conclusion that the nailer must be deemed to have been the agent, for the purpose of nailing on, of the defendant . . . there is a contract to clothe in the manner prescribed by the particulars given to the defendant, and that contract was carried into effect by a person paid by the defendant—the defendant himself receiving the total

(e) L. R., 12 Ch. D. 826.

amount for which he contracted. The consequence is that in my judgment all the defences fail."

We have seen that it is an infringement to colourably imitate an invention. It is no infringement to make, use, or vend the elements which afterwards enter into the combination. In *Townsend v. Haworth* (*f*), Jessel, M. R., said:—"The chief of these chemical substances are substances which are perfectly well known, and most of them are common substances; they are all old chemical compounds, and there is no claim in the patent at all except for the peculiar use of these chemical compounds for the purpose of preserving the cloth from mildew. No judge has ever said that the vendor of an ordinary ingredient does a wrong if the purchaser coming to him says, 'I want your compound because I want to preserve my cloth from mildew. I wish to try the question with the patentee.' No one would doubt that that sale would be perfectly legal. You cannot make out the proposition that any person selling any article, either organic or inorganic, either produced by nature or produced by art, which could in any way be used in the making of a patented article, can be sued as an infringer, because he knows that the purchaser intends to make use of it for that purpose."

The working and making must be by way of using the invention, as distinguished from **experimenting** with it, so as to operate as an infringement. In *Higgs v. Godwin* (*g*) the patent was for obtaining a commercially saleable manure by treating sewage with slaked lime. The defendant used the process by way of experiment to purify

(*f*) L. R., 12 Ch. D. 831, note.

(*g*) E. B. & E. 529. See also *Jones v. Pearce*, 1 Web. P. C. 122, and *Muntz v. Foster*, 2 Web. P. C. 93 and 96; *Holmes v. L. & N. W. R. Co.*, 12 C. B. 831; *Nobel's Explosives Co. v. Jones*, 8 App. Cases

at pp. 10 and 13; *Von Heyden v. Newstadt*, 14 Ch. D. 230; *Betts v. Nielson*, 6 N. R. 221; *Wright v. Hitchcock*, L. R., 5 Ex. 37; *Sykes v. Howarth*, L. R., 12 Ch. D. 826.

water—Held no infringement. In *Frearson v. Loe (h)*, Jessel, M. R., adverting to this branch of the subject, said:—“The other point raised was a curious one and by no means free from difficulty, and what occurred with regard to that was this: that the defendant at various times made screw blanks, as he said, not in all more than 2 lbs., by various contrivances, by which no doubt screw blanks were made; according to the plaintiff's patent of 1870, as well as that of 1875, they seem to have been an infringement of both. He said he did this merely by way of experiment, and no doubt if a man makes things merely by way of *bonâ fide* experiment, and not with the intention of selling and making use of the thing so made for the purpose of which a patent has been granted, but with the view of improving upon the invention, the subject of the patent, or with a view of seeing whether an improvement can be made or not, that is not an invasion of the exclusive rights granted by the patent. Patent rights were never granted to prevent persons of ingenuity exercising their talents in a fair way. But if there be neither using nor vending of the invention for profit, the mere making for the purpose of experiment and not for a fraudulent purpose ought not to be considered within the meaning of the prohibition, and if it were, it is certainly not the subject for an injunction.”

To purchase infringing articles for the purpose of instructing pupils and to enable them to pull them to pieces and put them together again, is not mere experimental user and amounts to infringement (*i*).

It will be remembered that prior to the Act of 1883 letters patent did not operate as against the Crown; questions sometimes arose as to whether persons acting in the **service of the Crown** might manufacture a patented article or use a patented process.

(h) L. R., 9 Ch. D. 48.

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

When the persons using the invention were servants of the Crown, and acting in pursuance of their duty as servants, they were protected; but if they were contractors contracting with the Crown they were not protected, but stood in exactly the same position as other subjects (*k*).

Sect. 27 of the Act of 1883 provides that a patent should bind the Crown, but that the Crown may use the invention "by agents or *contractors*" on terms to be before or after the use agreed upon.

BY USING.

It frequently occurs that very fine questions arise as to what constitutes **using** a patented invention. The general rule may be thus stated: That if the defendant has put the invention to the purpose for which it was intended he has used it in this country. In the case of *Nielson v. Betts* (*l*), in the House of Lords, the facts were as follows: Betts, the plaintiff in the suit, was the patentee of an invention for the manufacture of capsules for the purpose of covering bottles of liquid (wine, beer, or otherwise), and protecting them from the action of the atmosphere. Betts' patent did not extend to Scotland. Nielson and his co-appellants, defendants in the suit, were persons who bottled beer in Glasgow for the Indian market. They bottled the beer and covered it with capsules, which were made in Germany in pursuance of Betts' specification. The beer was shipped by the appellants in vessels which called at Liverpool to complete their cargoes; on some occasions the beer was transhipped in England, but no cases of beer were opened, nor was any of the beer sold in this country. Held, by the House of Lords, that, inasmuch as the object of Betts'

(*k*) *Dixon v. The London Small Arms Co.*, L. R., 10 Q. B. 130, and L. R., 1 App. Cas. 632, reversing decision of Court of Appeal, L. R., 1 Q. B. D. 384; also *Feather v. R.*, 6 B. & S. 257.

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

invention was to make a capsule that would preserve the beer, whilst the beer was in England it was being preserved by the use of Betts' invention, and consequently that there was an infringement of the patent. Lord Chelmsford, in giving judgment in the Court below, said :—"It is the employment of the machine or article for the purpose for which it was designed which constitutes its active use, and whether the capsules were intended for ornament or for protection of the contents of the bottles upon which they were placed, the whole time they were in England they may be correctly said to be in active use for the very objects for which they were placed upon the bottles by the vendors. If the beer, after being purchased in Glasgow, had been sent to England, and had been afterwards sold here, there can be no doubt, I suppose, that this would have been an infringement, because it would have been a profitable user of the invention, and I cannot see how it can cease to be a user because England is not the final destination of the beer."

The case of *Nobel's Explosives Co. v. Jones, Scott & Co. (m)*, is instructive upon the question of user. The subject of the plaintiff's patent, dynamite, is a mechanical compound of nitro-glycerine and infusorial earth. The compounding of nitro-glycerine in this manner is done for and effects the purpose of rendering it less liable to explosion from concussion. The object of the patent was, therefore, to enable nitro-glycerine to be kept and handled with safety. Held, by Bacon, V.-C., that the mere storage of dynamite made abroad, and only landed in this country for the purpose of transshipment, amounted to an infringement of the plaintiff's patent. This decision was reversed in the Court of Appeal, but upon another point, to be mentioned presently, and without in any manner impugning the correctness of the Vice-Chancellor's decision on this question.

(m) L. R., 17 Ch. D. 721. See *Cambridge v. Richardson*, 6 Ves. 689. also *The Universities of Oxford and*

In the case of *Caldwell v. Vanvliссengen* (n), it was held by Turner, V.-C., that **foreign ships coming into British ports**, fitted with screw propellers, which were made in pursuance of the specification of an English patent, thereby infringed the patent. If the injunction which was granted be carefully read, it will be found to amount to a restraint from propelling the vessels with the propellers, not from having the ships merely fitted with them. Legally speaking, the user of propellers differs from that of capsules or dynamite in this important respect, that the one is in use only when in motion; the others are at use, the one when merely affixed to the bottles, and the other when merely in possession. Subject to the applicability of the arguments adduced in the case of dynamite, it is submitted that **mere possession**, unaccompanied with user, does not constitute an infringement of letters patent, unless the possession is of such a character as to import a **threat to use**. But in *The United Telephone Co. v. The London Globe Telephone Co.* (o), Bacon, V.-C., said: "That the defendants are in possession of instruments made in infringement of the plaintiff's patent is confessed by them and placed beyond the possibility of question, and that of itself gives to the plaintiffs a right to ask for an injunction to restrain the defendants from making use of that which by their own confession is an unlawful possession, and would be, if used, I presume, an unlawful use . . . the defendants excuse themselves . . . next on the ground that it is not their intention to use them. If it is not their intention to use the instruments, then the injunction asked for can do them no harm. That would not be enough to dispose of the case, but it is the right of the plaintiffs to have an injunction against the defendants who have the means to the extent of 800 machines of injuring their patent rights."

(n) 21 L. J., Ch. 97.

(o) 26 Ch. D. 766.

In the case of *Adair v. Young* (*p*), certain pumps, which were an infringement of the plaintiff's patent, were fitted on board a British ship. There was no evidence of their having been used. Held, by the Court of Appeal, that there had been no infringement, but as there was **evidence of an intention to use** the pumps, an injunction would be granted against the use of the pumps.

Sect. 43 of the Act of 1883 provides:—“(1) *A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of Her Majesty's Courts in the United Kingdom or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.* (2) *But this section shall not extend to vessels of any foreign state of which the laws authorize subjects of such foreign state, having patents or like privileges, for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its Courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign state.*”

A patent is not infringed by being used on board an English vessel abroad (*q*).

In the case of *Nobel's Explosives Co. v. Jones & Scott* (*r*), mentioned above, the Court of Appeal reversed the decision of Vice-Chancellor Bacon, on the grounds that the defendants had not infringed the plaintiff's patent, they having merely acted as Custom House agents for the transshipment of the dynamite, and their functions being confined to

(*p*) L. R., 12 Ch. D. 13.

N. S. 954.

(*q*) *Newall v. Elliott*, 10 Jur.,

(*r*) 17 Ch. D. 721.

obtaining papers necessary for such transshipment, and that they never had any ownership in or exercised any control over the dynamite.

This decision shows that the Courts will not recognize that a person infringes a patent by **aiding and abetting**, so to speak, another to do so. There must be some actual infringement on the part of the defendant (s).

SELLING.

A person infringes letters patent who sells the patented article within this realm. It is a putting in practice of the invention within the terms of the grant.

Lending is not selling (t).

The **purchase** of the patented article is not of itself an infringement of the patent, nor is the **mere possession**, since these do not come within the prohibition in the grant, which is against making use of, or putting in practice, the said invention (u).

This is always with exceptions such as in the case of dynamite, where the mere possession involves *ex necessitate* the use ; and the **importation** of the patented article will not of itself amount to an infringement.

The possession of the patented article, combined with **exposure for sale**, if no sale is in fact effected, is no infringement (x).

But the making of the patented article, as we have seen, is an infringement, whether a sale was effected, or attempted or not (y).

Where the patent is for a process the manufacture of an article by the process abroad and sale in this country

(s) See also *Townsend v. Howarth*, L. R., 12 Ch. D. 831 ; *Sykes v. Howarth*, 12 Ch. D. 826.

(t) *United Telephone Co. v. Henry, Griffin*, P. C. 228.

(u) See *Minter v. Williams*, 1

Web. P. C. 135.

(x) *Ibid.*

(y) *Muntz v. Foster*, 2 Web. P. C. 101 ; *Oxley v. Holden*, 8 C. B. (N. S.) 666.

is an infringement. In *Elmslie v. Boursier* (z), Sir W. M. James, V.-C., said :—“ It is said that tinfoil can be made by the plaintiff’s process at less cost than by the old method ; and it is conceded that nobody in England can use the plaintiff’s process of making cast tinfoil as distinguished from rolled tinfoil without a license from the plaintiff. If that cannot be done in England it would be a very strange thing if a person in England could send an order to some one in France, get the same thing manufactured there in exactly the same way, and bring it here so as to compete with the person to whom the Crown has granted ‘ the whole profit, benefit, commodity, and advantage ’ arising from the patent. It would be a short mode of destroying ‘ every profit, benefit, commodity, and advantage ’ which a patentee could have from such a thing, if all that the man had to do was to get the thing made abroad, import it into this country, and then sell it here in competition with the English patentee.”

In *Walton v. Lavater* (a) Erle, C. J., said :—“ But it appears to me that the main purpose of the patent is to give the profit to the patentee, and that the main mode of defeating that purpose would be by selling the patented article ; and it seems to me that without proof of the making of the article by the infringer, evidence that he sold the patented article for profit would be good evidence upon which a jury might find that he had infringed the patent. With respect to the defendant not being liable, because the articles were imported from abroad, I should say that, even if it was a simple case of importation, without any proof of knowledge of the article being patented or of the infringement, it would be sufficient evidence of infringement that the defendant had imported and sold” (b).

(z) L. R., 9 Eq. at p. 222.

(a) 29 L. J., C. P. 275.

(b) See also *Wright v. Hitch-*

cock, L. R., 5 Ex. 37 ; 39 L. J., Ex. 97.

Selling known chemical substances with knowledge of and with a view to their being used for the purpose of infringing a patent is no offence, provided the vendor takes no actual personal part in the infringement (c).

A patentee selling the patented article sells with it the right of free disposition as to that article, and if he sells the article in France, the purchaser may import and sell it in England. Lord Hatherley, in *Betts v. Willmott* (d), said:—"Inasmuch as he has the right of vending the goods in France, or Belgium, or England, or in any other quarter of the globe, he transfers with the goods necessarily the license to use them wherever the purchaser pleases. When a man has purchased an article he expects to have the control of it, and there must be some clear and explicit agreement to the contrary to justify the vendor in saying that he has not given the purchaser his license to sell the article, or to use it wherever he pleases *as against himself*."

Where the defendants were owners of patents in Belgium and England for an invention for making glass lamp globes by a deed executed in Belgium, granted a license to the plaintiffs to manufacture under their invention in Belgium but not elsewhere. The plaintiffs under this license having manufactured articles in Belgium and sold them in England, it was held by the Court of Appeal, affirming Pearson, J., that the grant of the license to use the patent in Belgium did not imply permission to sell the manufactured article in England in violation of the defendants' English patent (e).

And when the patentee has assigned his patent in France and kept it to himself in England, the French assignee may not, nor may a purchaser from him import and

(c) *Townsend v. Haworth*, L. R., 12 Ch. D. 831; *Sykes v. Howarth*, L. R., 12 Ch. D. 826.

(d) L. R., 6 Ch. App. Cas. at p. 245.

(e) *Société Anonyme des Manufactures de Glaces v. Tielghman's Patent Sand Blast Co.*, 25 Ch.

D. 1.

vend or use the goods made in France in England (*f*). In this case the sale of the article can only imply such license as the vendor himself has, and the vendor has no right to sell in England.

Conversely, if the patentee had assigned his patent rights in England, he could not manufacture in France and sell in England, and the sale of an article in France would carry with it no implied right to import into or sell in England. But if the rights under the patent are vested in one and the same person for both France and England, or if there are no monopoly rights in France but only in England, the patentee could make and sell in France and ^{could not} restrain the purchaser from selling or using the article in England, unless indeed there was a special agreement for that purpose; and then such agreement could not be held to attach to the article so as to prevent any person in whose hands it might come from importing it (*g*).

(*f*) See the rule laid down in *Caldwell v. Vanvlissengen*, 9 Hare, 415.

(*g*) *Betts v. Willmott*, 6 Ch. App. Cas. 239.

CHAPTER XIII.

THE REMEDY—INJUNCTION.

THE remedy sought or granted in an action for infringement may consist of an injunction, together with an account of sales and profits, or damages.

The judicature acts and the rules which have been made for the governing of the practice of the courts have introduced great changes in the method of procedure. The old practice of moving for an injunction by a suit in the Court of Chancery, and of trying the validity of the patent at common law has disappeared ; and in its place the patentee seeking to enforce his rights commences but **one action in which he claims, and if entitled to, obtains every remedy** which was formerly granted to him by the dual process.

Every patentee proceeding against an infringer must prove the validity of his patent and his title to an injunction ; that being so, and the right to the injunction hanging so completely upon the question of validity, it is obvious that the new procedure and the new power of both divisions of the High Court of Justice to grant complete and sufficient remedies and to try every question is of great advantage to persons in possession of patent rights.

There are two forms of injunction, the interlocutory injunction and the perpetual injunction.

The interlocutory injunction stands very much upon the same footing, and will be granted for similar reasons

and upon the same conditions that an injunction was formerly awarded by the Court of Chancery when an action was directed to be tried at common law.

The perpetual injunction is granted after trial, and binds the parties against whom it is granted during the continuation of the term of the patent.

An interlocutory injunction will be granted whenever there has been such **working, user and enjoyment** of the patent rights by the patentee as will satisfy the Court that there are strong *prima facie* reasons for acting on the supposition that the patent is valid.

Lord Eldon, in the case of the *Universities of Oxford and Cambridge v. Richardson (a)*, said:—"It is then said in cases of this sort the universal rule is that if the title is not clear at law the Court will not grant or sustain an injunction until it is made clear at law. With all deference to Lord Mansfield, I cannot accede to that proposition so unqualified. There are many instances in my own memory in which this Court has granted or continued an injunction to the hearing under such circumstances. In the case of patent rights, if the party gets his patent and puts his invention in execution and has proceeded to a sale, that may be called possession under it; however doubtful it may be whether the patent can be sustained, this Court has lately said **possession under a colour of title** is ground enough to enjoin, and to continue the injunction, till it shall be proved at law that it is only colour and not real title."

And in *Gardner v. Broadbent (b)* Sir J. Stuart, V.-C., said:—"I wish it to be understood that the law of the Court is that laid down by Lord Eldon in the *Universities of Oxford and Cambridge v. Richardson*."

There having been a trial as to the validity of the patent, which has terminated in favour of the patentee, will be

(a) 6 Ves. 689.

(b) 2 Jur., N. S., 1041.

considered by the Court sufficient reason for granting an interlocutory injunction.

Where the patentee has worked and enjoyed the patent for many years without dispute, an interlocutory injunction will be granted. In *Dudgeon v. Thompson* (c) Jessel, M. R., said :—“The Court can grant an injunction before the hearing where the patent is an old one and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the Court to say that, as against the defendant himself, there is no reason to doubt the validity of the patent.”

So in *Betts v. Menzies* (d), Wood, V.-C., said :—“The law of this Court is, that where the patentee has had long enjoyment, then he shall have an injunction to protect his rights until trial, even although his rights under his patent be doubtful.” On the other hand, we find Lord Westbury laying it down in *Hills v. Evans* (e) :—“It is the habit and the rule of the Court not to grant that injunction (to restrain infringement), at all events until the hearing, and **not to make it perpetual unless the legal validity of the patent has been conclusively established.**”

Sometimes an application for an interim injunction is advisable where there has not been long user of the patent, or a decision in favour of the patentee. In such cases the plaintiff must be prepared to give *prima facie* satisfactory evidence of the validity of his patent (f).

These decisions certainly appear contradictory, but

(c) 30 L. T. R., N. S. 244 ;
also *Russell v. Cowley*, 2 Coop.
C. C. 59 (n.) ; but see *Crosskill v.*
Evory, 10 L. T. 459.

(d) 3 Jur., N. S. at p. 358. See
also *Davenport v. Goldberg*, 2 H.
& M. 282 ; *Penn v. Bibby*, 3 L. J.,
Eq. 308 ; *Muntz v. Foster*, 2 Web.

P. C. 95.

(e) 4 De G., F. & J. at p. 289.

(f) *Gardner v. Broadbent*, 2
Jur., N. S. 1041 ; *Davenport v.*
Jepson, 1 N. R. 173 ; *Renard v.*
Levinstein, 10 L. T., N. S. 177 ; and
cases quoted at pp. 218—220, *infra*.

perhaps this principle may be gleaned from them—that the Court will consider the **balance of convenience** in each particular case. If it should appear that irremediable injury will be sustained by the defendant if an injunction goes which may afterwards appear unfounded, the Court will require a very strong case to be made out by the plaintiff before granting such an injunction (*g*), and the converse would equally appear.

In *Bickford v. Skewes* (*h*), Shadwell, V.-C., said:—“I have nothing to do with any other case than the case before me.”

The Court will not infrequently **grant or refuse the injunction** until the hearing **upon terms**; the terms on the plaintiff being that he shall be answerable in damages, or on the defendant that he shall keep an account of the material manufactured, or of the articles sold, in pursuance of the patent process. And in considering which course should be adopted the Court will be influenced chiefly by the balance of convenience and the probability of injury to either side (*i*).

In *Plimpton v. Spiller* (*k*), James, L. J., said:—“The Court, not forming an opinion very strongly either one way or the other whether there is an infringement or not, but considering it as a fairly open question to be determined at the hearing, and not to be prejudiced by any observations in the first instance, reserves the question of infringement as one which will have to be tried at the hearing and which it will then have to consider. There will always be, no doubt, the greatest possible difficulty in determining what is the best mode of keeping things *in statu quo*—for that is really what the Court has to do, to keep things *in statu quo*—until the final decision of the question; and then, of course, the Court says, ‘We will not stop a going

(*g*) *Neilson v. Forman*, 2 Coop. 61 (n.).

(*h*) 1 Web. P. C. 213.

(*i*) *Neilson v. Thompson*, 1 Web.

P. C. 278; *Bridson v. M'Alpine*, 8 Beav. 229.

(*k*) L. R., 4 Ch. D. 289.

trade. We will not adopt a course which will result in a very great difficulty in giving compensation on the one side or on the other. We have to deal with it as a practical question, in the best way we can.' I think, on the whole, that the Master of the Rolls has made the right order, viz., by granting the injunction and putting the plaintiff upon an undertaking to abide by such order (if any) as to damages as the Court may think fit to make if he should ultimately turn out to be in the wrong, and that it would not be right in this case merely to put the defendant upon the terms of keeping an account which, I conceive, might be a very clumsy and inefficient mode of recompensing the plaintiff if he should turn out ultimately to be in the right." In the same case the present Master of the Rolls, Sir W. B. Brett, said :—" There will be a hardship on the one side or on the other, and the question is on which side does the balance appear to lie? Now, if the trade of a defendant be an old and established trade, I should say that the hardship upon him would be too great if any injunction were granted. But where, as here, the trade of the defendant is a new trade, and he is the seller of goods to a vast number of people, it seems to me to be less inconvenient and less likely to produce irreparable damage to stop him from selling, than it would be to allow him to sell and merely keep an account, thus forcing the plaintiff to commence a multitude of actions against the purchasers."

Injunctions are now granted pursuant to the Judicature Act, 1873, sect. 25, sub-sect. 8 :—" A mandamus or an injunction may be granted, or a receiver appointed, by an interlocutory order of the Court in all cases in which it shall appear to the Court to be just or convenient that such order should be made; and any such order may be made, either unconditionally or upon such terms and conditions as the Court shall think just; and if an injunction is asked either before, or at, or after the hearing of any

cause or matter, to prevent any threatened or apprehended waste or trespass, such injunction may be granted, if the Court shall think fit, whether the person against whom such injunction is sought is or is not in possession under any claim of title or otherwise, or (if out of possession) does or does not claim a right to do the act sought to be restrained under any colour of title; and whether the estates claimed by both, or either of the parties, are legal or equitable.”

It will be observed that this section confers upon the Court very wide limits within which, in its discretion, it may grant injunctions. It sweeps away a great deal of the technical rules which had been from time to time laid down by the Court of Chancery for the granting of injunctions, and it practically substitutes for them the opinion of the judge trying each particular action as to the balance of convenience upon a consideration of the facts of the case.

The basis of an injunction is the threat actual or implied on the part of the defendant, that he is about to do an act which is in violation of the plaintiff's rights; so that not only must it be clear that the plaintiff has rights, but also that the defendant has done something which induces the Court to believe that he is about to infringe those rights.

The fact that he has been guilty of an infringement of the patent rights will, under circumstances, be evidence that he intends to continue his infringement, but whether he has actually infringed the patent or not, it will be sufficient if he has **threatened to infringe it**. Actual infringement is merely evidence upon which the Court implies an intention to continue in the same course.

In *Frearson v. Loe* (*j*), Jessel, M. R., said:—“I am not aware of any suit or action in the Court of Chancery which has been successful on the part of a patentee, without

(*j*) L. R., 9 Ch. D. at p. 65.

infringement having been proved ; but, in my opinion, on principle there is no reason why a patentee should not succeed in obtaining an injunction without proving actual infringement. I think for this reason : where the defendant alleges an intention to infringe, and claims the right to infringe, the mischief done by the threatened infringement of the patent is very great, and I see no reason why a patentee should not be entitled to the same protection as every other person is entitled to claim from the Court from threatened injury, where that threatened injury will be very serious. No part of the jurisdiction of the old Court of Chancery was considered more valuable than that exercise of jurisdiction which prevented material injury being inflicted, and no subject was more frequently the cause of bills for injunction than the class of cases which were brought to restrain threatened injury, as distinguished from injury which was already accomplished. It seems to me, when you consider the nature of a patent right, that where there is a deliberate intention expressed, and about to be carried into execution, to infringe certain letters patent under the claim of a right to use the invention patented, the plaintiff is entitled to come to this Court to restrain that threatened injury. Of course it must be plain that what is threatened to be done is an infringement."

The actual infringement of the patent is taken by the Court to imply an intention to continue the infringement, notwithstanding any promises not to do so, and an injunction will be granted. Vice-Chancellor Shadwell, in *Losh v. Hague* (*k*), said :—" If a threat had been used, and the defendant **revokes the threat**, that I can understand as making the plaintiff satisfied ; but if once the thing complained of has been done, I apprehend this Court interferes, notwithstanding any promise the defendant may make not to do the same thing again."

(*k*) 1 Web. P. C. 200.

If the fact of actual infringement is relied upon, and not a mere threat, it will be necessary to show very clearly that what has been done amounts to an infringement. In *Hancock v. Moulton* (*l*), it was held that the evidence must be so perfect, that if it were a motion to commit for the breach of an injunction, the Court would commit upon it. If the evidence of infringement is conflicting, either by reason that it is denied that the acts complained of were done, or that such acts as were done did not amount to an infringement of the patent, the Court should not grant an interim injunction before the hearing of the action (*m*).

If the evidence relied upon for the injunction is the sale by the defendant of the patented article, and not the manufacture, the plaintiff must show that such patented article was not made by himself or his licensees (*n*).

In the case of *Adair v. Young* (*o*), the defendant was the captain of a ship which was fitted with certain pumps which were an infringement of the plaintiff's patent. No act of using the pumps was proved; but it was shown that the ship was not supplied with other pumps. It was held that the possession of the pumps under such circumstances, although not of itself amounting to an infringement, was evidence upon which the Court would act that the defendant intended to use the pumps, should occasion require. And the Court, Brett and Cotton, L. JJ., James, L. J., dissenting, granted an injunction.

Lord Justice James, in giving his reasons for dissenting, said:—"I think that an injunction ought not to be granted against a man unless he has done something which he ought not to have done, or permitted something which he ought to have prevented. Now, a master who comes on board ought not to be answerable on the ground that, when

(*l*) M. Dig. 506.

(*m*) *The Electric Telegraph Co.*
v. *Nott*, 2 Coop. 41.

(*n*) *Betts v. Willmott*, L. R.,

6 Ch. App. Cas. 239.

(*o*) L. R., 12 Ch. D. 13.

he takes the command, there is on board a pump which infringes the patent. He does not, owing to his qualified possession, become at once an infringer. He had no power to take a pump out of the ship ; he had nothing to do with putting it there, and he was not wrong in allowing it to remain there, for he could not lawfully remove it. An injunction, therefore, can only be granted on the principle of *quia timet*, and in applying that principle I think that it would be a right exercise of the discretion of the Court not to grant an injunction against a master who has done nothing wrong when there is no difficulty in finding and suing the owner of the ship."

The Court, however, seem to have been of opinion that the ground upon which an injunction should be granted is not whether the defendant has done anything wrong or not, but whether there was evidence of an intention to use the patented invention. The Court held that the circumstances of the case showed an intention in the captain to use the invention.

No injunction will be granted where the patentee has **not proceeded with reasonable speed** to prosecute infringers (*p*). But in cases where there are several infringers he is not justified in commencing a vast multitude of actions and applying for injunctions in each (*q*). His proper course is to "select that which he thought the best in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction. He might write at the same time to all the others who were *in simili casu*, and say to them ; 'Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise I shall proceed against you by way of interlocutory injunction ; and if you will not object on the ground of delay, I do not mean to file bills against all of you at once.

(*p*) *Losh v. Hague*, 1 Web. P. Beav. 1.
C. 201 ; *Bacon v. Jones*, 4 My. & Cr. 438 ; *Bridson v. Benecke*, 12
(*q*) *Foxwell v. Webster*, 3 N. R. 103, at p. 180.

Am I to understand that you make no objection of that kind? If you do not object I shall file a bill against only one of you.' I do not think any court could complain of a patentee for taking the course I am suggesting" (r).

Where machines have been manufactured or articles made in infringement of patent rights, an injunction will be granted to prevent their use or sale even after the patent has expired (s).

The injunction falls with the **expiration of the patent** (t).

After trial and judgment, and upon application for a perpetual injunction, when the nature of the infringing matter will permit of it, an order will be made that the articles (machinery or otherwise) **be delivered up to the plaintiff or destroyed** (u). This was done in *Plimpton v. Malcolmson* (supra); the reference to this cause is M.R., 28th Jan., 1876, B. 381. An inquiry will, when necessary, be directed as to the articles manufactured which are in the defendant's possession, and that they be destroyed, *Betts v. De Vitre*, V.-C. W., 1865, A. 119. The defendant will also be ordered to make discovery upon oath of the articles or machinery which he may have in his possession, and which infringe the plaintiff's patent, so that they may be delivered up and destroyed; this was done in *Tangye v. Scott*, V.-C. W., 12th Feb., 1866, B. 461. **The right of property in the articles** which infringe the patent remains

(r) Per Sir W. Page-Wood, V.-C., *Bovill v. Crate*, L. R., 1 Eq. at p. 391. See also *Hancock v. Moulton*, M. Dig. 506; *Smith v. The London and South Western Rail. Co.*, Kay, 408.

s) *Crossley v. Beverley*, 1 Web. P. C. 119; *Crossley v. The Derby Gas Light Co.*, 4 L. J., Ch. 25. See

also *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.*, 4 K. & J. 727.

(t) *Daw v. Eley*, L. R., 3 Eq. 496.

(u) *Frearson v. Loe*, L. R., 9 Ch. D. at p. 67; but see *United Telephone Co. v. London & Globe Telephone Co.*, 26 Ch. D. at p. 776.

in the infringer, although the Court may order the articles to be destroyed (*x*).

These mandatory orders are never made except after trial, and when the plaintiff has fully established to the satisfaction of the Court the validity of his patent and the fact of the defendant's infringement.

An injunction having been granted to restrain the defendant from infringing a patent for the manufacture of telephones: It was held to be a breach of the injunction to sell the separate parts of the patented telephones which anyone might put together (*y*).

DAMAGES.

In addition to an injunction, the defendant may be entitled, when there has been actual infringement as distinguished from an intention to infringe, to either damages or an account of sales and profits.

He is **not entitled to both damages and an account**, but he must elect which he will take (*z*). An account of sales and profits amounts to a condonation of the infringement (*a*).

The **measure of damage** is the loss which the plaintiff has actually sustained, irrespective of the costs of the action. The question of damages is not synonymous with an account of profits, the basis of calculation being entirely different. In calculating damages, the Court will not take into account any **manufacturer's profit** which the plaintiff might have made (*b*). But it is submitted that considera-

(*x*) *Vavasseur v. Krupp*, L. R., 5 H. L. 1; *Needham v. Oxley*, 11 W. R. 852.

(*y*) *United Telephone Co. v. Dale*, 25 Ch. D. 778. (a) Per Lord Westbury, *Neilson v. Betts*, *supra*.

(*z*) *De Vitre v. Betts*, L. R., 6 H. L. 319; *Neilson v. Betts*, (b) *Penn v. Jack*, L. R., 5 Eq. at p. 86.

tion should be had where the patentee is the manufacturer, and has granted no licenses, to the damage which he has sustained by reason of the **commercial competition** to which he has been subjected.

In estimating damages, the Court will inquire into the **extent of infringement** and the amount of goods manufactured by the defendant, care being taken to distinguish this inquiry from that as to sales and profits. In the one case the quantity of business is inquired into, in the other the amount of profit. It is evident that the smaller the price at which the articles have been sold, the greater the damage to the patentee by reason of the market depreciation of the profits to be made by his invention by reason of the competition.

In *Betts v. De Vitre (c)*, Sir W. Page-Wood, V.-C., said :—“ I confess it appears to me that if the damages are to be assessed, it would be proper to take the identical course that was taken in *Hills v. Evans*, for this reason, that damages of this description, namely, damages for the infringement of a patent where there has been no license granted at any time for the use of that patent, can only be ascertained on those very vague and guess-like data which, it appears, juries have been obliged to act upon in ascertaining what the actual loss has been that has occurred to a patentee by the user by some wrongdoer of his patent right. The difficulty one sees must be very great where there are no licenses existing. Where there are licenses existing, the difficulty would be next to nothing, because you would simply ascertain the amount sold, and fix the wrongdoer with that amount.”

In *Penn v. Jack*, licenses had been granted, and the same Vice-Chancellor fixed the amount of damage at the amount which would have been received had the defendant been working under a license.

In the *United Horse-nail Co. v. Stewart* (*d*), a Scotch case, the Lord Ordinary (Kinneir) said:—"It appears to me to be a fair enough ground for estimating their damages to take the whole profits which they would have made upon the sales actually made by the defenders, if the defenders had not interfered so as to prevent the pursuers effecting those sales themselves. That would mean the difference between the cost of manufacture and the prices at which they were selling at the time to their agent." The learned judge proceeded to state that damages by way of compensation for competition were reasonable enough, but that in the particular case before him the evidence did not justify such damages.

Where licenses have been granted, no account will be taken of profits which have been lost by reason of competition (*e*).

Where bills to restrain the infringement of a patent have been filed against both the person who manufactures, and the person who uses the article, and issues of fact have been found for the plaintiff, it is the right of the plaintiff to have, not only an account against the manufacturer, but also damages against the person using the article, wherever it be found (*f*).

In aid of the inquiry as to damages, directed by the judgment for a perpetual injunction, **the defendant must give full discovery**, and will be required to set out the names and addresses of the persons to whom machines, made in infringement of the patent have been sold; but not the names of the agents concerned in the transaction (*g*).

(*d*) Griffin P. C. 217; see as to measure of damages based upon special conditions, *United Telephone Co. v. Walker*, 56 L. T. 508.

(*e*) *Penn v. Jack*, L. R., 5 Eq.

at p. 85.

(*f*) Head note to *Penn v. Bibby*, L. R., 3 Eq. 308.

(*g*) *Murray v. Clayton*, L. R., 15 Eq. 115.

ACCOUNT OF SALES AND PROFITS.

In cases where it is deemed to the advantage of the plaintiff, he may elect, in lieu of damages, to take an account of sales and profits ; that is, to condone the infringement upon the footing that the defendant has been acting as the plaintiff's agent in selling or using the invention.

The plaintiff will not, however, be allowed to claim an account **if he has tacitly permitted the defendant to infringe his patent**, relying upon an ultimate account of profits. In *Crossley v. The Derby Gas Light Co.* (*h*), Lord Brougham said :—“ It is a principle of equity, that a party who claims a right should not lie by, and by his silence or acquiescence induce another to go on spending his money and incurring risk, and afterwards, if profit has been made, come and claim a share in that profit without having ever been exposed to share in the losses which might have been sustained. Upon this the defendants rely ; but it was to be considered, on the other hand, whether the plaintiff did not explain the delay which has taken place, and whether the conduct of the defendants has not been such as to lull the plaintiff's suspicions to sleep.”

Prior to the Judicature Acts it was held a rule in Courts of Equity, that in consequence of the terms of 21 & 22 Vict. c. 27, no relief could be awarded for damages or an account, unless an injunction could be granted at the same time. All other relief being merely incidental to the injunction (*i*). Thus, where a **patent had expired** after bill filed, but before an injunction could be granted, the Court declined to consider the question of damages (*k*). But now, in pursuance of sect. 24, sub-sect. 6, of the Judicature Act, 1873, a Court of Equity may give full relief ; and so, wherever a court of

(*h*) 1 Web. P. C. 120.

& J. 727.

(*i*) *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.*, 4 K.

(*k*) *Betts v. Gallais*, L. R., 10 Eq. 392.

law would, prior to the passing of the Act, have granted damages or an account, similar orders will be made by either branch of the High Court of Justice, irrespective of the question of injunction.

Where it appears at the trial that **the defendant has made no profit**, although the plaintiff may be entitled to damages, he will not be entitled to an account (*l*).

Where the defendant has acted in ignorance of the patent, and before action has offered to submit to an account and to pay to the plaintiff the amount of profits, the Court should exercise its discretion in disallowing costs (*m*), although it may grant the injunction. In such a case the plaintiff will proceed to an account at his peril, running the risk of nothing being found due.

The practice of the Courts as to injunctions, damages, and accounts, will be dealt with hereafter under the head of "Practice."

(*l*) *Bacon v. Spottiswoode*, 1 Beav. 387.

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

CHAPTER XIV.

REVOCATION.

WE have seen that the patentee has his remedy in an action for infringement. The public has also a remedy by petition for revocation.

Sect. 26 of the Act of 1883 provides :—

“ (1) *The proceeding by **scire facias** to repeal a patent is hereby **abolished**.*

“ (2) ***Revocation** of a patent may be obtained on petition to the Court.*

“ (3) *Every ground on which a patent might, at the commencement of this Act, be repealed by **scire facias** shall be available by way of defence to an action for infringement, and shall also be a ground of revocation.*

“ (4) *A petition for revocation of a patent may be presented by :—*

“ (a) *The Attorney-General in England or Ireland, or the Lord Advocate in Scotland.*

“ (b) *Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland.*

“ (c) *Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims.*

“ (d) *Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee.*

“(e) Any person alleging that he, or any person under or through whom he claims an interest in any trade, business, or manufacture, had publicly manufactured, used, or sold within this realm before the date of the patent anything claimed by the patentee as his invention.

“(5) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered.

“(6) Particulars delivered may be from time to time amended by leave of the Court or a judge.

“(7) The defendant shall be entitled to bring in and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply.

“(8) Where a patent has been revoked on the ground of fraud the comptroller may, on the application of the true inventor, made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.”

Practically speaking, scire facias had fallen into desuetude before the passing of this Act ; other methods of disputing the validity of patents were found, or thought to be, more to the advantage of persons opposing them. It is presumed, however, that the new procedure will find more favour, being simpler, more speedy, and more similar to the ordinary action for infringement than the old action of scire facias.

The grounds upon which a patent may be revoked are similar to those upon which it might have been can-

celled by scire facias (a). These are in the Fourth Institute said to be: “*Firstly*, when the king by his letters patent doth grant by several letters patent one and the selfsame thing to several persons, the former patentee shall have a scire facias to repeal the second patent; *secondly*, when the king granteth anything that is grantable upon a false suggestion, the king by his prerogative jure regio may have a scire facias to repeal his own grant. When the king doth grant anything which by law he cannot grant, he jure regio (for the advancement of justice and right) may have a scire facias to repeal his own letters patent.”

And it was held in *Sir Oliver Butler's case* (b), that “where a patent is granted to the prejudice of the subject, the king, of right, is to permit him on his petition to use his name for the repeal of it in a scire facias at the king's suit, and to hinder multiplicity of actions upon the case.”

Thus it will be seen that formerly any person might, on behalf of the public, proceed by scire facias to repeal a patent, although security for costs was required. Sub-sect. 4 of sect. 26 has very considerably narrowed and limited this general right.

Practically speaking, any ground which may be set up as a defence to an action for infringement may be employed as a ground for revocation—such as that the person to whom the letters patent were granted was not the first and true inventor, or that the invention was not new or useful, or that it was not true that the invention had not been practised before, or that the said invention did not come within the meaning of the words “a new manufacture,” or that the specification was insufficient and did not disclose the nature of the invention.

The petition is to be presented to the High Court of Justice in England or in Ireland. By sect. 109 it is provided: (1) “*Proceedings in Scotland for revocation of a*

(a) 4 Inst. 88.

(b) 2 Vent. 344.

patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only." And in respect to Ireland we find that, by sect. 110, "*All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.*"

The general result of these sections seems to be that the proceeding for revocation may be taken in any part of the United Kingdom, and that the question may be dealt with by the Courts of either portion independently; so that it will be possible for letters patent to have been cancelled so far as England is concerned, and yet to continue in force for Scotland and Ireland, and vice versâ.

It will be observed that in sect. 26, sub-sect. 4 (c and d), "*Any person alleging that he, &c. . . . may petition,*" and by sub-sect. (3), any ground which might be available for scire facias may form the ground for revocation.

In *Re Avery's Patent* (c), it was held by Stirling, J., and the Court of Appeal, that this applied only to cases of actual fraud, and would not be extended to questions of mistake, though the consequences might be to deprive the inventor of his patent rights. Cotton, L. J., said:—"If it is made out that the present petitioner, Avery, is a person who brings himself within that clause, and *satisfies the Court* that the patent was obtained in fraud of his rights, then we should have to go into the other question, namely, whether the patent is or is not good" (at p. 325), "an act, to be 'in fraud of his rights,' to my mind must involve an attempt by the agent to deprive the principal of something, or to gain for himself something at the expense of his principal."

(c) L. R., 36 Ch. D. 307.

We have dealt with the several grounds of revocation in previous chapters, under the title of Infringement, and it will be unnecessary to do more here than to refer the reader to them. In a subsequent chapter will be found the practice to be observed in the course of proceedings for revocation.

CHAPTER XV.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

SECTS. 103 and 104 of the Patents, &c., Act, 1883, give power to the Crown to enter into arrangements with foreign and colonial governments with respect to the mutual protection of patent rights. And, in respect to any foreign State which has entered into such arrangements, any person who has applied for protection for any invention in any such State shall be entitled to a patent for his invention in priority to other applicants, and such patent shall have the same date as the date of the *application* (a) in such foreign State, provided that the application for letters patent in this country is made within seven months from the date of the application for protection in such foreign State.

Then follows a provision that a patent granted under such circumstances shall not entitle the patentee to bring actions in respect of infringements which may have happened prior to the date of the acceptance of his final specification.

It will be dangerous for persons to adopt foreign discoveries or inventions before the expiration of the seven months from the date of the foreign application: for, in the event of a patent being applied for under this section, the whole of the capital invested in the adoption of such invention may be found to have been lost. Regard particularly being had to the fact that by sub-sect. 2 any use

(a) Patents, &c., Act, 1885, sect. 6.

of the invention in this country within the seven months by any number of persons will in no way invalidate the patent rights subsequently obtained; and that the persons who have used the invention will not have obtained any vested rights to continue the use of the invention.

The application for a patent under this section must be made in the same manner as ordinary applications. The section only applies with respect to such foreign States with respect to which her Majesty shall from time to time, by Order in Council, declare them to be applicable, and so long only in the case of each State as the Order in Council shall continue in force with respect to that State.

Where it is made to appear to her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions patented in this country, her Majesty may, by Order in Council, apply the provisions of the last preceding section, with such variations or additions, if any, as to her Majesty in Council may seem fit, to such British possession.

Orders in Council in pursuance of this section shall have the like effect as if the provisions they contain had been incorporated in the Act.

Practice.

CHAPTER I.

ACTION FOR INFRINGEMENT.

AN action for infringement is commenced **by writ** issued out of the High Court of Justice.

Subject to the special provisions of the Patent, &c., Act, the rules of the Supreme Court apply to actions for infringement of patents and petitions for revocation (*a*).

The writ may be endorsed merely **for damages** for infringement, *or for an account* of sales and profits, *and* it may be endorsed for an injunction claiming that the defendant may be restrained from continuing to infringe the patent (*b*), and for a mandatory order that the defendant may be ordered to deliver up to the plaintiff the articles made in infringement of the patent which are in his custody or power, or in the custody or power of his servants or agents, so that they may be broken up or destroyed (*c*). The plaintiff may not claim both an account of sales and profits and damages for infringement; the two claims being inconsistent, since, if an account is taken, the infringement is condoned (*d*).

Service of a writ in Scotland for an infringement in England will be allowed (*e*).

(*a*) Haddan's Patent, 54 L. J. Ch. 126; Griffin, P. C. 108.

(*b*) Form, p. 287.

(*c*) Form, p. 287. See *Tangye v. Stott*, 14 W. R. 386; *Betts v. De Vitre*, 34 L. J., Ch. 289.

(*d*) Per Lord Westbury in *Neilson v. Betts*, L. R., 5 H. L. 1. See

also *De Vitre v. Betts*, L. R., 6 H. L. 321; *Needham v. Oxley*, 11 W. R. 852. But see *Hills v. Evans*, 4 De G. F. & J. 288.

(*e*) *Speckhart v. Campbell, Achnach & Co.*, Solicitors' Journal, Feb. 2, 1884.

CHAPTER II.

PARTIES.

THE parties to the writ may be—as **plaintiffs**, any person for the time being entitled to the benefit of the patent. **An ordinary licensee** cannot be plaintiff, as he is merely licensed to use, and not entitled to any monopoly ; but an **exclusive licensee** may sue, using the name of the grantor of the licence in the action (*a*). **An assignee** may sue in his own name, even though he has acquired the right by assignment of two separate moieties, and the party sued is the original grantee (*b*). An assignee of a portion of a patent may be plaintiff (*c*) ; so, also, it is submitted, may an assignee for a place or part of the United Kingdom, under sect. 36 of the Act of 1883. **Assignees or trustees under a bankruptcy petition** may sue (*d*), and an assignee may maintain an action, although the assignment has not been registered (*e*). One of several joint owners may recover (*f*), **and one of several co-owners** of a patent has a right to sue alone for the recovery of profits due for the use of a patent ; and an objection by a defendant that other persons should have been joined as plaintiffs should be made promptly under Rules of Court

(*a*) *Renard v. Levinstein*, 2 H. & M. 628.

(*b*) *Walton v. Lavater*, 8 C. B., N. S. 162 ; *Electric Telegraph Co. v. Brett*, 10 C. B. 838.

(*c*) *Dunncliffe v. Mallett*, 7 C. B., N. S. 209.

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

(*e*) *Hassall v. Wright*, L. R., 10 Eq. 509.

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

1875, Ord. XVI. rules 13 and 14, and may not be postponed till the hearing, where no impediment exists to raising the objection at once (*g*).

A mere agent to introduce, sell, and grant licences for the use of a foreign patent in this country is not entitled to take proceedings to restrain infringement (*h*).

As defendants, all persons physically infringing, or threatening to infringe, the patent may be joined. An **architect**, specifying the use of a patent, should not be joined, but the **contractor** doing the work may (*i*). The **directors of a company** may be sued in their personal capacity for an infringement by the servants of the company (*k*). Where the principals are out of the jurisdiction, the court will restrain the manager or workmen (*l*).

(*g*) *Shehan v. Great Eastern Rail. Co.*, L. R., 16 Ch. D. 59. Jour. 224.

(*h*) *Adams v. North British Rail. Co.*, 29 L. T., N. S. 367. Ch. 441.

(*i*) *Denley v. Blore*, 38 Lond. 804; 12 L. T., N. S. 489. (*k*) *Betts v. De Vitre*, L. R., 3 W. R. 13.

(*l*) See *Betts v. Neilson*, 13 W. R. 804; 12 L. T., N. S. 489.

CHAPTER III.

INTERLOCUTORY INJUNCTION.

An interlocutory injunction may be granted **ex parte**, after the issue of the writ, and before service. An **ex parte** injunction will only be granted when it can be shown that great injury will accrue to the plaintiff by delay, and when he can clearly establish his title and the fact of infringement (*a*). Interlocutory injunctions are always upon terms as to damages (*b*).

Notice of motion having been given, an interlocutory injunction will be granted after appearance, or with leave, upon notice of motion to be served with the writ.

By sect. 25 of the Judicature Act, 1873, sub-sect. 8 :
“A mandamus or an injunction may be granted, or a receiver appointed by an interlocutory order of the Court, in all cases in which it shall appear to the Court to be just or convenient that such order should be made ; and any such order may be made either unconditionally or upon such terms and conditions as the Court shall think just ; and if an injunction is asked either before, or at, or after the hearing of any cause or matter to prevent any threatened or apprehended waste or trespass, such injunction may be granted if the Court shall think fit, whether the person against whom such injunction is sought is or is not in possession under any claim of title or otherwise, or (if out of possession) does or does not claim a right to do the act

(*a*) *Gardner v. Broadbent*, 2 Jur.,
N. S. 1041.

(*b*) *Graham v. Campbell*, L. R.,
7 Ch. D. 490.

sought to be restrained under any colour of title ; and whether the estates claimed by both or either of the parties are legal or equitable.”

Ord. L. rule 6, directs that : “ An application for an order under sect. 25, sub-sect. 8, or under rules 2 or 3 of this order, may be made to the Court or a judge by any party. If the application be by the plaintiff for an order under the said sub-sect. 8, it may be made either *ex parte* or with notice”

A master of the Queen’s Bench Division has no power to grant an injunction. Order LIV. rule 12.

An interlocutory injunction will only be granted when there is a fair **primâ facie case of validity**. This may be made out by long undisturbed enjoyment, or by the question having been previously tried in a court of law (*c*), or where the defendant has admitted the validity of the patent (*d*), or is so placed in his relationship to the patentee as to be estopped from denying its validity (*e*).

In *Hayward v. The Pavement Light Co.* (*f*), Kay, J., said, when granting an interlocutory injunction, “ The invention has been patented so long ago as 1871, and the validity of the patent has been established by the Court of Appeal.”

In *Jackson v. Needle* (*g*), Baggallay, L.J., said, “ The Court abstains from interfering by injunction in the case of a recently dated patent where there is really a substantial question to be tried.” See also the law and authorities quoted *ante*, p. 194 *et seq.*

(*c*) *Dudgeon v. Thompson*, 22 W. R. 464 ; *Plimpton v. Malcolmson*, L. R. 20 Eq. 37 ; *Collard v. Allison*, 4 My. & Cr. 487 ; *Stephens v. Keating*, 2 Ph. 333 ; *Bridson v. McAlpine*, 8 Beav. 229 ; *Bridson v. Benecke*, 12 Beav. 1, and cases quoted *supra*, under the head “ Injunction.”

(*d*) *Dircks v. Mellor*, 26 Lond. Jour. 268.

(*e*) *Clarke v. Fergusson*, 1 Giff. 184.

(*f*) *Griffin*, P. C. 124.

(*g*) *Griffin*, P. C. at p. 133. See also *Lister v. Norton*, *Griffin*, P. C. 148.

The injunction may be **refused upon terms** that the defendant keep an account *pendente lite* (*h*). But it is open to the plaintiff to show that if he succeeds the defendant's position is such that he will be unable to pay the damages or the amount of the account (*i*).

The evidence to be used upon an application for an interlocutory injunction is upon affidavit.

The affidavit should clearly point out in what the alleged infringement consists (*k*). If the plaintiff is the first inventor, he must distinctly swear to the fact, as also to the novelty and utility of the invention, and to the due filing of a sufficient specification (*l*). If the plaintiff is an assignee he must swear to the best of his belief (*m*). The affidavits in either case must state the facts as at the time of swearing, and it is not sufficient to swear that the invention was believed to be new when the patent was granted (*n*). An injunction granted prior to statement of claim will be dissolved if the statement of claim when delivered does not agree with the affidavits upon which the injunction was granted (*o*).

In the Chancery Division it is the practice to hear applications for interlocutory injunctions as motions in Court. In the Queen's Bench Division the application is heard by the Judge in Chambers upon a summons.

Forms of injunction upon undertaking as to damages (*p*), and of order refusing injunction upon terms (*q*), will be found in the Appendix.

(*h*) *Jones v. Pearce*, 2 Coop. 58; *Mitchell v. Barker*, 39 Lond. Jour. 531; *Muntz v. Grenfell*, 2 Coop. 61 (n.).

(*i*) *Newall v. Wilson*, 2 De G., M. & G. 282.

(*k*) *Hill v. Thompson*, 3 Mer. 624; *Betts v. Willmott*, L. R., 6 Ch. 239.

(*l*) *Hill v. Thompson*, 3 Mer.

624; *Startz v. De la Rue* (per Lord Lyndhurst), 5 Russ. 329; *Whitton v. Jennings*, 1 Dr. & S. 110.

(*m*) *Gardner v. Broadbent*, 2 Jur., N. S. 1041.

(*n*) *Hill v. Thompson*, 3 Mer. 624.

(*o*) *Stockin v. Llewellyn*, 3 L. T. 33.

(*p*) Form 6, p. 290.

(*q*) Form 7, p. 291.

CHAPTER IV.

STATEMENT OF CLAIM.

THE Rules of Court of 1853 have rendered the form of pleadings of less importance than hitherto. Ord. XIX. rule 26, provides: "No technical objection shall be raised to any pleading on the ground of any alleged want of form;" but by rule 27 the power of the Court to strike out pleadings on the grounds that they are unnecessary, scandalous, or embarrassing, is preserved.

Ord. XIX. rule 4, requires all material facts to be pleaded, and prohibits the pleading of evidence. Rule 5 is as follows:—"The forms in Appendices (C., D., and E.), when applicable, and when they are not applicable forms of the like character, as near as may be, shall be used for all pleadings, and where such forms are applicable and sufficient, any longer forms shall be deemed prolix, and the costs occasioned by such prolixity shall be disallowed to or borne by the party so using the same, as the case may be."

The forms mentioned relate to pleadings in an action for the infringement of a patent, but there is no provision made for the case where infringement has only been threatened, nor for the case when a mandatory order or an account of sales and profits is required (*a*).

It will be observed that the statement of claim in patent cases, which is rendered obligatory by Ord. XIX. rule 5, contains no allegation as to the matters going to constitute the validity of the patent, nor does it give the date, time, or place of the infringement; but it refers to the particulars of breaches which are delivered "herewith."

(*a*) See Form, p. 294.

CHAPTER V.

PARTICULARS OF BREACHES.

Particulars of breaches were required to be delivered in every action for the infringement of a patent by sect. 41 of the Patent Law Amendment Act, 1852; and now by sect. 29 (1) of the Act of 1883, it is provided:—“*In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or a judge at any subsequent time, particulars of the breaches complained of; (4) at the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement, or objection of which particulars are not so delivered; (5) particulars delivered may be from time to time amended by leave of the Court or a judge.*”

Particulars of breaches are particulars of the times, places, occasions, and manner in which the plaintiff says the defendant has infringed his letters patent. **The defendant must have full, fair, and distinct notice of the case to be made against him** (a). In *Batley v. Kynock* (b), Sir James Bacon, V.-C., said: “All that is required and provided by the Patent Law Amendment Act, 1852, which has made no alteration in the practice to be observed in these cases, is that the defendants shall not be taken by surprise, and it is the duty of the judge to take care that by the particulars of breaches they shall have full and fair notice of the case that they will have to meet.”

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

(b) L. R., 19 Eq. at p. 231.

It had undoubtedly prior to the passing of the Patent Law Amendment Act, 1852, been the practice of the Courts to compel plaintiffs to give particulars of breaches, and the cases which were then decided as to the sufficiency of particulars are applicable now; for then, as now, the object was that the defendant should be warned with reasonable certainty of the case that was to be made against him.

The following clause was ordered to be struck out of the amended particulars (c): "And the plaintiffs state these particular instances by way of example only, and not so as to preclude them from proving any of the infringements mentioned in the former particulars of breaches."

If the particulars delivered are too general the defendant should apply **for further and better particulars.**

If at the trial evidence is tendered which comes within the literal meaning of the particulars it will be admitted, notwithstanding that the particulars are too general, as **the defendant should have objected to the particulars,** and not wait until the trial to take his objection (d).

The plaintiff having delivered particulars of breaches specifying certain sales by the defendant of rollers, and in particular to Shaw and Smith, the defendant, in answer to interrogatories, admitted sales to Hirst. Fry, J., in giving judgment, said: "In this case I think I must admit the evidence tendered in respect of Hirst's case. It is said that in respect of those cases which are not mentioned by name in the particulars of breaches, the plaintiff cannot give evidence. It may be that the particulars were not sufficient, or tended to embarrass. But the defendant did not apply for amended particulars, according to the case of *Hull v. Bolland*. It appears to me I have to inquire what is the meaning of the particulars. I find the case of Hirst

(c) *The Patent Type Founding Co. v. Richards*, 2 L. T., N. S. 359. (d) *Hull v. Bolland*, 25 L. J., Ex. 304.

is within the literal meaning of the particulars. If I had found that the case of Hirst was likely to create surprise, or likely to introduce any point not raised by *Smith's* or *Show's* case, I should probably have given an opportunity to the defendant to bring fresh evidence. I have asked whether there is any witness not here whom the defendants would desire to bring in respect of Hirst's case, and have received no satisfactory answer on that point, and must assume there is no such witness" (e).

When the patent consists of two or more processes, or distinct and separable inventions, **particulars of breaches should distinguish which of the processes** it is alleged has been infringed, and should particularly indicate what parts of the defendant's machine or manufactured article are claimed to constitute an infringement; but when the process was one entire invention, the Court declined to compel the plaintiff to point out the particular parts of the specification which were alleged to be infringed. Jervis, C.J., said: "If the two processes described in the specification are wholly distinct from each other, and the defendant's process may be an infringement of the one and not of the other, he ought to have better particulars; but if the whole is substantially one process, he is not entitled to them . . . We must not make the particulars more complicated than the specification (f)."

In *Elsey v. Butler* (g), an action for infringement of a patent for "improvements in the manufacture of lace, in twist lace machinery, and in apparatus employed therein," the following particulars of breaches were held by Pearson, J., to be sufficient:—"The defendant has infringed by the production in a twist lace machine, or in twist lace machines, of lace fabrics in the manner described in the

(e) *Sykes v. Howarth*, L. R., 12 Eq. 826.

(f) *Talbot v. La Roche*, 15 C. B. 310. See also *The Electric Tele-*

graph Co. v. Nott, 4 C. B. 462, and *Tilghman's Sand Blast Co. v. Wright*, Griffin, P. C. 216.

(g) Griffin, P. C. 96.

specification of the said patent, page 3, line 22 to page 9, line 39, or in a manner only colourably differing therefrom; and by the use of the improved combination of apparatus therein described, and also in particular by the production in a twist lace machine, or in twist lace machines, of fabric known as 'Double tie Swiss Net' in the manner described in the specification of the said patent, page 6, line 57 to page 7, line 38, or in a manner only colourably differing therefrom, and by the use of the improved combination of apparatus therein described."

Further particulars of breaches will sometimes be postponed to discovery on the ground that the defendant knows the breaches which he has committed better than the plaintiff (*h*).

Particulars of breaches, as we have seen, may also be ordered in actions which are not strictly actions for the infringement of patents; this is done under the ordinary jurisdiction of the Court (*i*). In an action charging that the defendant falsely and maliciously wrote and told persons who had bought certain machines of the plaintiffs that the machines were infringements of his, the defendant's patents, the defendant having pleaded not guilty, the Court ordered the defendant to deliver particulars, showing in what parts the plaintiff's machines were an infringement of the defendant's patents, and pointing out by reference to the page and line of the defendant's specifications, which part of the inventions therein described he alleged to have been infringed (*k*).

(*h*) *Russell v. Hatfield, Griffin*, P. C. 269.
P. C. 204.

(*k*) *Wren and others v. Weild*,

(*i*) *Perry v. Mitchell*, 1 Web. L. R., 4 Q. B. 213.

CHAPTER VI.

STATEMENT OF DEFENCE.

The statement of defence in patent actions is now, under the Rules of the Supreme Court, 1883, a very brief and concise document, giving no particulars or details whatever, and remitting the plaintiff to the particulars of objections, and the answers to the interrogatories for information as to the case which is to be made against him. Under Ord. XIX. rule 5, the form given in Appendix (D.) sect. VI. is rendered obligatory. That form merely gives headings of defence which is all that is to be allowed; for instance:—“(1) That the defendant did not infringe the patent; (2) The invention was not new; (3) The plaintiff was not the first and true inventor; (4) The invention was not useful; (5) The patent was not assigned to the plaintiff.” And to these might be added:—That the title did not disclose the nature of the invention (*a*); that the title, the provisional specification, and the complete specification, or any two of them, did not substantially refer to the same invention (*b*); that the specification was not sufficient (*c*); that the claim in the specification was not sufficient to distinguish what was new from what was old (*d*); that the patent was obtained in fraud of the defendant, as, for instance, when a person employed to carry out or assist in experiments, applies for letters patent himself, or where the patentee has obtained the invention from the confidence of the defendant.

(*a*) Ante, p. 60 et seq.

(*b*) Ante, p. 67 et seq.

(*c*) Ante, pp. 86—94.

(*d*) Ante, p. 95 et seq.

It will be observed that any one of these defences will be sufficient to constitute a complete defence to the action ; and that the greater portion of them are of a nature to require elaborate and costly evidence to prove or disprove them. Too much care cannot, therefore, be taken in preparing a statement of defence to avoid setting up defences which it is not expected will be satisfactorily proved at the trial, regard being had to the provisions of the Rules of 1883 as to costs ; otherwise, even if the defendant succeeds in the action, he may be mulcted in heavy costs to the other side.

A statement of defence alleged that if the specification were construed so as to make the defendant an infringer, the claims of invention would be bad for want of novelty, as including matters described in certain specifications (stating them). North, J., refused to strike out par. 2 under Ord. XIX. rule 27 ; the Court of Appeal dismissed the appeal with costs (*e*).

A statement of defence admitted infringement in ten instances and no more, the plaintiffs elected to move for judgment upon such admissions ; held that they were entitled to an enquiry as to damages as to these ten instances of infringement and no more, and that all evidence as to any other instances of infringement alleged to have been committed by the defendant must be excluded (*f*).

Where the defendants in an action for infringement have been indemnified by another person or Company, such other person or Company may be joined as a third party under Ord. XVI. rule 48, of the rules of the Supreme Court (*g*).

(*e*) *Hocking v. Hocking*, Griffin,
P. C. 129.

(*f*) *United Telephone Co. v.*
Donohoe, 31 Ch. D. 399.

(*g*) *Edison and Swan United*
Electric Light Co. v. Holland, L. R.,
33 Ch. D. 497.

CHAPTER VII.

PARTICULARS OF OBJECTIONS.

SECT. 21, sub-sect. (2) of the Act of 1883, provides:—
“The defendant must deliver with his statement of defence, or by order of the Court, or a judge at any subsequent time, particulars of any objections on which he relies in support thereof; (3) If the defendant disputes the validity of the patent, the particulars, delivered by him, must state on what grounds he disputes it; and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him; (4) At the hearing, no evidence shall, except by leave of the Court, or a judge, be admitted in proof of any alleged infringement or objection, of which particulars are not so delivered; (5) Particulars delivered, may be from time to time amended, by leave of the Court, or a judge; (6) On taxation of costs, regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particulars 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.”

This last sub-section will make it imperative upon the plaintiff or defendant, who has succeeded in an action, to obtain a certificate from the judge who has tried the case that each one of the particulars delivered by him

has been proved or was reasonable and proper. It will be observed that the words of the section are "*shall not* be allowed any costs;" this leaves no discretion in the Court except as to certifying.

Ord. XIX. rule 6, of the Rules of the Supreme Court, 1853, provides: "In all cases in which the party pleading relies on any misrepresentation, fraud, breach of trust, wilful default, or undue influence, and in all other cases in which particulars may be necessary beyond such as are exemplified in the forms aforesaid, particulars (with dates and items if necessary) shall be stated in the pleading: provided that if the particulars be of debt, expenses, or damages, and exceed three folios, the fact must be so stated, and a reference to full particulars already delivered or to be delivered with the pleading."

It is not easy to reconcile the practice under this rule with the language of the 29th sect. of the Patent Act, or, indeed, with the form of defence given in the form to the rules quoted above. Ord. XIX. rule 6, provides that particulars shall be incorporated with the pleading; on the other hand, the form and the Patent Act seem to indicate a separate document. Hitherto the practice has been to deliver a separate document, and it is apprehended that when the balance of convenience is considered the Courts will hold that in respect of a patent action the practice has remained unchanged.

The particulars of objection may allege that the invention was not new at the date of the patent. It is not necessary for every one of two or more defendants defending in the same interest to deliver particulars of objections (a).

Particulars of breaches must be distinguished from particulars of objection for want of novelty. In the latter case the particular instances may not be within the

(a) *Smith v. Cropper*, 10 App. Cas. 249, reversing 26 Ch. D. 700.

knowledge of the patentee and must be specified, in the former, the defendant must know whether and in what respect he has been guilty of infringement (*b*).

Particulars stated that "A particular improvement had been used by A. B. (giving names and addresses), and divers other people within this kingdom and elsewhere." The judges struck out the words "and divers other people" (*c*).

The words "carriage builders generally throughout Great Britain" do not sufficiently comply with the statute, nor do the words "used and applied by carriage builders generally;" and the words "in or near London, in or near Liverpool, &c., and in or near various other of the principal towns of Great Britain," are too general (*d*).

Vice-Chancellor Sir W. Page-Wood said in *Morgan v. Fuller* (*d*): "An allegation of general user does not of course admit of being met precisely The real object is to secure to both parties a fair trial" (*e*).

In *Flower v. Lloyd* (*f*), Field, J., said: "I cannot follow the cases which have been cited; we have advanced in our ideas since they were decided (*g*). If the defendants knew that their processes have been used by other persons in London and Birmingham, besides those specified, they must know the persons by whom they have been used, and must give more specific information. I do not say that they need give the name and address of every such person, but they must give fair information. If they can give no further information, the words in question are useless, and too indefinite, and must be struck out."

Prior user.—The objection on the ground of prior user

(*b*) *Ledgard v. Bull*, 11 Ap. Cas. 648, P. C. Web. P. C. 544; *Holland v. Fox*, 1 C. L. R. 440; *Palmer v. Cooper*,

(*c*) *Fisher v. Dewick*, 1 Web. P. C. 551 (n.). 9 Ex. 231.

(*d*) *Morgan v. Fuller*, L. R., 2 Eq. 297. 860.

(*e*) See also *Jones v. Berger*, 1 652; *Palmer v. Wagstaff*, 8 Ex. 840.

(*f*) Solicitors' Journal, 1876, p.

(*g*) *Bentley v. Keighley*, 7 M. & G.

must state the time and place when such user occurred ; but it will be observed that **the persons by whom used** is not mentioned in sub-sect. (3). The Act, however, does not direct that such particulars shall not be required. The Patent Law Amendment Act, 1852, sect. 41, required that the place of prior user should be given, and was silent as to times or persons. Notwithstanding this, in *Palmer v. Cooper* (h), Baron Alderson went even further than to require the names of the persons who had used the invention, and the **present addresses** of such persons were ordered to be given, "As otherwise the plaintiff would not know where to go for his evidence." The object of particulars is, in the words of Tindal, C.J. (i), "Not, indeed, to limit the defence, but to limit the expense of the parties, and more particularly to prevent the patentee from being upset by some unexpected turn of the evidence. Under the fifth section (5 & 6 Will. 4, c. 83), therefore, it was intended that the defendant should give an honest statement of the objections on which he means to rely." In *Palmer v. Cooper* (h), Parke, B., said : "The defendant's particulars ought to give the plaintiff such information as will enable him to make the necessary inquiries at the place named."

It will be evident, therefore, that there are cases where to omit giving the names and addresses of the persons who are alleged to have anticipated the invention would be to supply the plaintiff with objections which would be practically useless.

There are cases where the names and addresses have been refused. In *Carpenter v. Walker* (k), the objections

(h) 9 Ex. 231. See also *Bulnois v. Mackenzie*, 4 Bing. N. C. 132 ; *Galloway v. Bleaden*, 1 Web. P. C. 268 (n.).

(i) *Fisher v. Dewick*, 1 Web. P. C. 267.

(k) 1 Web. P. C. 268 (n.).

stated that the invention had been used by "the defendant and divers persons." It was refused to order the defendant either to give the names and addresses of the "divers persons," or to have those words struck out.

It may be argued that the reason of such refusal was that a disclosure was required of the witnesses and case of the defendant. It is obvious that, although it is a recognized principle that one litigant shall not be permitted to inquire as to what witnesses the other is about to call at the trial, still that by far the more important principle is that neither party should be taken by surprise, and that the plaintiff should have a fair opportunity of critically examining every alleged anticipation which may be attempted to be established against him.

It does not of necessity follow that persons who have anticipated the invention should be the only and necessary witnesses of such anticipation. On the whole, therefore, it is submitted that names and addresses of such persons should be given in particulars of objections.

General words are inadmissible in particulars; for instance, expressions such as "and divers other people" (*l*), and "Inter alia at Sheffield, Birmingham, and London" (*m*). But in *Bentley v. Keighley* (*n*), Mr. Justice Maule, under special circumstances, allowed the words "and others" to be sufficient.

When the allegation of the defendant is that the patent is void by reason of a portion of the described invention being old, the particulars should clearly distinguish which part is alleged to be old, as well as the times and places of prior user (*o*).

(*l*) *Fisher v. Dewick*, 1 Web. P. C. 551 (n.); *Galloway v. Bleaden*, 1 Web. P. C. 268 (n.).

(*m*) *Holland v. Fox*, 1 W. R. 448; 1 C. L. R. 440.

(*n*) 7 M. & G. 652. See also *Jones v. Berger*, 1 Web. P. C. 549.

(*o*) *Heath v. Unwin*, 10 M. & W. 684; *Russell v. Ledsam*, 11 M. & W. 647.

Evidence will be admitted at the trial, provided the language of the particulars of objections is large enough to admit it; for instance, if the plaintiff has allowed such words as "and elsewhere" to stand until the trial, the defendant will be allowed to give evidence of prior user **anywhere** (*p*). The proper course for the plaintiff to take should the defendant deliver vague particulars is to issue a summons before a judge in chambers for further and better particulars, or, in the alternative, to have the objectionable words struck out (*q*).

In *Sugg v. Silber* (*r*), Mellish, L. J., said:—"The authorities cited by Mr. Cave were cases where objections had been taken to the notices of objection at the time when they were delivered, and further and better particulars were asked for. In my opinion there is a very large difference between a case where a judge has been applied to and has ordered further particulars in order to state an objection more specifically, and a case where at the trial the plaintiff asserts that the defendant ought to be prevented from availing himself of an objection. It is perfectly obvious that, if Mr. Cave was right in saying that the two questions are the same, and that wherever the Court would order further particulars because the objection had not been particularly specified, it would also hold that the party was precluded from raising it at the trial. Nobody would be foolish enough to apply to a judge for further particulars."

Although the objections did not specifically point out that the invention consisted of several claims, yet the objection that the invention is not the subject-matter of a patent, is sufficient to open the objection that the whole, or some particular part of it, is not the subject-

(*p*) *Hull v. Bolland*, 25 L. J., C. 551 (n.); *Carpenter v. Walker*, Ex. 304; *Sykes v. Howarth*, L. R., 1 Web. P. C. 268 (n.); *Holland v. Fox*, 1 C. L. R. 440.

(*q*) *Fisher v. Dewick*, 1 Web. P. (*r*) L. R., 2 Q. B. D. 495.

matter of a patent, and that consequently the patent is bad (s).

The defendant may, by leave of a Court or judge, from time to time, and upon such terms as under the circumstances of the case may be deemed equitable, amend the particulars which he has delivered; this is done by summons.

Page-Wood, V.-C., in *Penn v. Bibby* (t), permitted a defendant in his amended particulars, to preface his statement of the specific instances of alleged prior user, with the words "amongst other instances" in order to give him an opportunity to apply for leave to re-amend by inserting any further instances of prior user which he might discover.

Liberty to amend particulars of objections at the trial was given upon terms in *Renard v. Levenstein* (u); but in *Moss v. Malings* (x), North, J., refused leave, and said:—"I could only grant it if the defendant showed that he could not, with reasonable diligence, have discovered the new facts sooner. This he has not done. I must, therefore, refuse the application."

The terms upon which amendment is permitted are, first, that the plaintiff should be at liberty, if he pleases, to discontinue the action, and to be in the same position as to costs, as if the proposed amended particulars had been delivered in the first instance (y), and, secondly, that the defendant should be put under such terms as to costs, as to the judge or Court seem just. The particulars of objections give notice to the plaintiff of the case which is to be made against him; thereupon he may discontinue or not,

(s) See also *Hull v. Bolland*, 1 H. & N. 134; and *Neilson v. Harford*, 1 Web. P. C. 331.

(t) L. R., 1 Eq. 548.

(u) 11 L. T. at p. 506.

(x) 33 Ch. D. 603.

(y) *Baird v. Moule's Patent*

Earth Closet Co., L. R., 17 Ch. D. 139 (n.); and *Aveling v. Maclaren*, same page; also *Edison Telephone Co. v. India Rubber Co.*, L. R., 17 Ch. D. 137; and *Ehrlich v. Ihlee*, 56 L. T. 819.

as he pleases, paying defendant's costs. The defendant should not be permitted to keep back his most salient objections, and so to entice the plaintiff to proceed and incur costs, and then to amend his particulars at the last moment.

A form of order for further particulars will be found in the Appendix (z).

The defendant will not be allowed at the hearing of the action to introduce **evidence of prior user, not disclosed in the particulars of objection**, although such evidence may have only come to his knowledge since the delivery of the particulars of objection. His proper course is to obtain leave by summons or by serving short notice of motion **for leave to amend**, when an order will be made upon the terms mentioned above; and with an added term to delay the trial should it appear just that the plaintiff should have time to investigate the new evidence (a).

Objections on the ground of **prior publication** stand very much upon the same footing as those on the ground of prior user.

If the prior publication is alleged to be in books or newspapers, the plaintiff is entitled to be told the name of the book or newspaper, and to give such details of the books or newspapers as will enable them to be found and identified by the plaintiff (b).

In *Fowler v. Gaul* (c), the defendants, by their particulars of objections, alleged (inter alia), "5. That the alleged invention was published prior to the patent by certain patents and the specifications thereof (naming them); 8. The plaintiff's specification claims some of the matters specified or patented in certain specifications (naming them)." The District Registrar, affirmed subsequently by

(z) Page 298.

(a) *Daw v. Eley*, L. R., 1 Eq. 38.

(b) *Jones v. Berger*, 5 M. & G.

208; *Palmer v. Cooper*, 9 Ex. 231.

(c) *Griffin*, P. C. 99. See also *Harris v. Rothwell*, *Griffin*, P. C.

109.

the Judge in Chambers and Divisional Court, ordered "better particulars, showing in detail what part or parts of the patents or specifications respectively referred to in the 5th and 8th objections showed prior publication, and what parts were relied on as being claimed by the plaintiff's specification. In default of delivery, objections 5 and 8 to be struck out."

In *Plimpton v. Spiller* (*d*), the particulars were—"before the date of the alleged letters patent the alleged invention had been published in England in the 'Commissioners of Patents Journal,' of the 6th February, 1863, and in the 'Scientific American,' of the 24th January, 1863, and in drawings and sketches deposited in the Patent Office library, in July, 1865." Mr. Justice Field directed that the defendant should amend his particulars by stating the **date of the American patent**, and in whose name it had been granted. And also by giving the **pages of the publications** mentioned, but not the lines. And also by giving such written details as would enable the drawings mentioned to be identified, and to state whether the drawings were or were not contained in books, and what books. Notice of objections, on the ground that the grantee of the letters patent was not the first and true inventor, does not stand upon the same footing as objections on the ground of prior user or publication. Sect. 29, sub-sect. 3, does not require the defendant to state more than generally on what grounds he objects, and a statement that his objection is that the **plaintiff was not the true inventor**, that is, that the consideration did not move from him, will be sufficient, care being taken to distinguish this objection from that of prior user or publication.

When the objection is, that the grantee was not the true inventor, the Court will not require the defendant to

(*d*) 20 Solicitors' Journal, 1876, p. 860. See also *Flower v. Lloyd*, same reference.

say who was the true inventor (*e*). The fact upon which the objection is based, is the want of consideration, not the fact of some one having performed the invention before. The performance of the invention by some one else before the patent would not, of necessity, invalidate the patent. As, for instance, if it were done in secret; but if the invention was communicated to the grantee, the patent would be void for want of consideration. Now the foundation of the objection is, the fact of that communication, and the knowledge of this, and the time and place of it, might be within the patentee's knowledge only, and might not be extracted from him until in the witness box.

The objection that the specification is insufficient is enough without explaining in what way it is insufficient (*f*). A litigant could scarcely be required to argue his case on paper before he went into Court, and the sufficiency or insufficiency of a specification is to a great extent a matter of mere argument.

In *Jones v. Berger* (*g*), it was held that objections that the specification "did not sufficiently distinguish between what was old and what was new," and that the inventor "did not disclose the most beneficial method with which he was then acquainted of practising his said invention," were sufficient.

We have seen that Ord. XIX. rule 6, requires **particulars in case of fraud** to be delivered with the statement of defence.

Fraud is a valid objection to a patent. The practice of the Court is to require accurate and detailed particulars of any fraudulent acts alleged. The species of "fraud, covin, or misrepresentation" should be given (*h*).

When the objection is on the ground of **want of con-**

(*e*) *Russell v. Ledsum*, 11 M. & W. 647. But see *Jones v. Berger*, 5 M. & G. 208; 1 Web. P. C. 544.

(*g*) 5 M. & G. 208.

(*f*) *Heath v. Unwin*, 10 M. & W. 647.

(*h*) *Russell v. Ledsum*, 11 M. & W. 647.

formity between the provisional and complete specification, "the defendant ought to give such particulars as would inform the plaintiffs of the nature and scope of this objection of nonconformity. This does not mean that the defendants must furnish the plaintiffs with the heads of what the defendants' argument will be at the trial, but only such information as the plaintiffs may reasonably require in order to know precisely the nature of the case that will be raised against them. Each case must depend on its own circumstances." Per Cotton, L. J. (*i*), C. A. And when the objection is the insufficiency of the specification, the defendant must condescend to particulars of insufficiency (*k*).

(*i*) *Anglo-American Brush Light Corporation v. Crompton*, 34 Ch. D. 152; 56 L. J. Ch. 167; Griffin, P. C. 34.

(*k*) *Crompton v. Anglo-American Brush Light Corporation*, 35 Ch. D. 283; 56 L. J. Ch. 802; 57 L. T. 291.

CHAPTER VIII.

INTERROGATORIES.

ORD. XXXI. rule 1, of the Rules of the Supreme Court, 1883, provides that either party to an action, with leave of the Court or a judge, may interrogate the other party.

Interrogatories must be relevant to the issue, and will not be allowed to be used for the purpose of cross-examination. Since it is not possible to say precisely what the issues between the parties are before the statement of defence is delivered, neither party, except under special circumstances, will be allowed to interrogate until that stage of the action has been reached (*a*).

Rule 26 provides that 5*l.*, or some further sum, should be brought into Court by the party desiring to interrogate before he shall be at liberty to do so.

The general rules as to interrogatories in ordinary actions apply equally to actions for infringement.

The plaintiff may interrogate the defendant, and the defendant must **answer as to what infringement** he has been guilty of ; and he must disclose, if asked, the names and addresses of all persons, whether in England or abroad, from whom he may have received money for the use of articles alleged to be made in infringement of the patent (*b*).

In *Lister v. Norton* (*c*), the defendants put in a defence

(*a*) *Mercier v. Cotton*, L. R., 1 426 ; *How v. McKernan*, 30 Beav. Q. B. D. 442. 547.

(*b*) *Crossley v. Stewart*, 1 N. R. (c) *Griffin*, P. C. at p. 149.

denying infringement, and the plaintiff interrogated the defendants, and asked in one interrogatory whether the defendant's firm had not sold imitation sealskins (the patent being for "Improvements in the manufacture of velvets and of pile fabrics in imitation of seal skin and other similar materials") to certain firms, naming sixteen firms. This interrogatory the defendants declined to answer, on the ground that the information was not *bond fide* sought for the purposes of the action. Chitty, J., ordered an answer to the interrogatory, unless within fourteen days the defendant admitted infringement.

In a petition for revocation under sect. 26, interrogatories will be allowed to be administered by the petitioner to the respondent, inquiring into the manufacture, use, and sale of the patented article prior to the date of the patent (*d*).

Where a defendant alleged that his process was secret, he was bound to answer whether he used the materials mentioned in the specification, and whether he used any additional materials, but not to disclose the proportions in which he used the specified materials, or what the additional materials were (*e*).

When there is nothing to show that the defendant has infringed the patent, and he has denied on oath having infringed the patent, the plaintiff will not be permitted to interrogate as to the articles made and sold by the defendant, there being nothing to show that the articles sold infringe the patent. If *Lea v. Saxby* (*f*) be read, this proposition will be seen to follow.

Crossly v. Tomey (*g*) was an action to restrain infringement. The defendant in interrogatories was required to state whether he was not making articles in all respects identical with those of the plaintiff, and to set forth in what respects they differed, and by what process they were made.

(*d*) Haddan's Patent, 54 L. J. R. 665.
Ch. 126.

(*f*) 32 L. T., N. S. 731.

(*e*) *Renard v. Levinstein*, 3 N.

(*g*) L. R., 2 Ch. D. 533.

It was held that the defendant, who alleged prior user by himself and others, had sufficiently answered by stating that, save so far as the articles manufactured by him before the date of the patent were similar to those of the plaintiff, the articles he now made differed from those made by the plaintiff, but he could not show in what they differed without ocular demonstration. It was also held in this case, that when the defendant alleged prior user by other persons, he was bound to set forth the names of some of those persons. In the argument of this case, it appears that some confusion existed as to the necessary requirements of particulars of objections and answers to interrogatories. It must be remembered that the answers to interrogatories are on oath, and it can never have been intended by the legislature, when the stringent requirements of particular objections were created, that the defendants should be obliged to swear to these particulars; the penalty upon giving particulars, which at the trial he is not prepared to prove, is that he is mulcted in costs. But it was never intended that he should be prohibited from giving particulars, which, although based upon mere suspicion, he may hope to prove at the trial, perhaps out of the plaintiff's own mouth (i).

It appears that Chitty, J., has ordered a plaintiff (patentee) to answer interrogatories with reference to documents which passed between himself and his patent agent at the time the specification was prepared, notwithstanding that the patent agent was also acting in the matter as plaintiff's solicitor and that privilege was claimed (k). In the same case interrogatories which sought to compel the plaintiff to particularize the alleged breaches by stating what parts of the plaintiff's specification were infringed by the defendants (the defendants having in answers to interrogatories disclosed what they had done)

(i) See, however, *Finnegan v. James*, as to answers to interrogatories, L. R., 19 Eq. 72.

(k) *Mosely v. The Victoria Rubber Co.*, Griffin P. C. 163.

were disallowed on the ground that the defendants could for themselves compare the plaintiff's specification with what they admitted they had done.

In *Bovill v. Smith* (l), the following interrogatory was disallowed, "Does not the defendant allege that the plaintiff's invention was publicly used within this realm before the date of the plaintiff's patent? Set forth particularly when, and in what place or places, and in what manner, does the defendant allege that the plaintiff's invention, or any or what part thereof, was publicly used within this realm before the date of the plaintiff's patent." Sir W. Page-Wood, V.-C., said that the plaintiff was not entitled to enquire generally into the way in which the defendant shaped his case in order to find out whether some of the persons alleged by him to have used the process before the date of the patent, were the persons against whom the plaintiff had succeeded in other suits, though he might have asked if the process was the same as that used by A. B., or any one person specifically named, who had been a defendant in some former suit.

A defendant who submits to answer must answer fully: he cannot, by denying the plaintiff's title, escape answering. Discovery of title deeds and of professional communications form an exception. The plaintiff and defendant had both patents for making gelatine; the plaintiff interrogated as to the article manufactured by the defendant, and as to the names and addresses of the customers, and as to prices and profits. The defendant denied all infringement. He said he had made his article according to his own, and not according to the plaintiff's, patent, and he declined to give an account of such article. Held, that notwithstanding his denial, he was bound to do so (m). It is doubtful whether this case would be followed

(l) L. R., 2 Eq. 459. See also *Daw v. Eley*, 2 H. & M. 725.

(m) *Swinborne v. Nelson*, 16 Beav. 416.

now, for it is difficult to understand how the question could be relevant to the issue. It might be relevant after judgment, but before judgment the issue is, infringement or no infringement. The names of the customers could not bear upon this question.

After trial, and in pursuance of the terms of the judgment, if the plaintiff has been successful he is entitled to interrogate the defendant, or to require that the defendant "should make and file an affidavit stating what machines of the same construction as that supplied by him to A. or B., including such machines as are in his possession or power," see *Seton*, 4th ed., p. 352. The answer or affidavit of the defendant must be complete. In *Murray v. Clayton* (n), a patentee of improvements in brick-cutting machines, who was a manufacturer of the machines by an agent at the agent's works and not a licensor, having obtained a perpetual injunction against the defendants, (who were also manufacturers of brick-cutting machines), from infringement, the defendants were ordered to file an affidavit stating the number of machines made by them since the date of the patent, and the names and addresses of the persons to whom the same had been sold, and of the agents concerned in the transactions. Upon motion to vary the order, it was held, that the plaintiff was entitled to have discovery of the names and addresses of the purchasers but not of the agents concerned, there being nothing to show that any agents had been employed.

In answering interrogatories filed by a defendant for the examination of the plaintiff, the general rule applies that he who is bound to answer must answer fully (o).

Interrogatories for the examination of a plaintiff are on a different footing from those for the examination of a defendant in this respect, that a plaintiff is not entitled to

(n) L. R., 15 Eq. 115.

(o) *Hoffman v. Posthill*, L. R., 4 Ch. App. 673.

discovery of the defendant's case, but a defendant may ask any questions tending to destroy the plaintiff's claim (*p*).

In determining whether a question is one of fact, and, therefore, to be answered, it makes no difference that it is asked with reference to a written document (*p*).

A defendant in a suit for infringement of a patent in order to prove that there was no novelty in the plaintiff's patent, interrogated the plaintiff as to the inventions described in the specifications of various patents, and asked him to show in what respects they differed from his. The plaintiff declined to answer these interrogatories on the ground that the questions were **not questions of fact, and that they related to the plaintiff's case**; the defendant excepted to the answer, and the exceptions were allowed (*p*).

A plaintiff in a patent suit was required by interrogatories to set out a correspondence between himself and a third party, and also to state the particulars of the infringement of his patent on which he relied. He refused to answer these questions on the ground that the defendant might obtain an order in chambers to inspect the correspondence: and that he had sufficiently set out the particulars of the infringement in his bill. These answers were held to be sufficient (*p*).

We have set out the effect of this case at length, because it is founded upon and exemplifies in many ways the principle upon which a defendant may examine a plaintiff. Lord Justice Giffard, in giving judgment, said, "As regards the case of *Daw v. Eley* (*q*), it must be always remembered that that was the case of a plaintiff exhibiting interrogatories to a defendant, and it was there held that the plaintiff could not call on the defendant to set forth the particulars of his defence. But when you come to the case of a

(*p*) *Hoffman v. Posthill*, L. R., 4 Ch. App. 673. (*q*) 2 H. & M. 725.

defendant asking questions of a plaintiff, it is a very different thing. It is the defendant's business to destroy the plaintiff's case, and there the defendant has a right to ask all questions which are fairly calculated to show that the patent is not a good patent, or that what he alleges to be an infringement is not an infringement." Lord Justice Selwyn had said, "Our decision in this case will leave it entirely within the power of the learned Vice-Chancellor to order that all the costs occasioned by the interrogatories, the answer, the exceptions, the hearing the exceptions before him, and the hearing of this appeal, shall be dealt with as he, in his discretion, shall think fit; and if it shall appear that the power which the Court, for the purpose of justice and discovery, gives to the parties to administer interrogatories to each other has been abused, I have no doubt the learned Vice-Chancellor will take care that justice shall be done, and will make the party who is to blame pay all the costs of the improper exercise of this power."

CHAPTER IX.

INSPECTION.

SECT. 30 of the Patents, &c. Act of 1883, provides: "*In an action for infringement of a patent, the Court or a judge may, on the application of either party, make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon, as the Court or a judge may see fit.*"

The power to order an inspection was always assumed by the Courts; in *Bovill v. Moore* (a), Lord Eldon said: "There is no use in this Court directing an action to be brought, if it does not possess the power to have the action properly tried. The plaintiff has a patent for a machine used in making bobbin lace. The defendant is a manufacturer of that article; and, as the plaintiff alleges, he is making it with a machine constructed upon the principle of the machine protected by the plaintiff's patent. Now the manufactory of the defendant is carried on in secret. The machine which the defendant uses to make bobbin lace, and which the plaintiff alleges to be a piracy of his invention, is in the defendant's own possession, and no one can have access to it without his permission. The evidence of the piracy, at present, is the bobbin lace made by the defendant. The witnesses say that this lace must have been manufactured by the plaintiff's machine, or by a machine

(a) 2 Coop. Ch. Ca. 56 (n.); Dav. P. C. 361.

similar to it in principle. This is obviously in a great measure conjecture. No Court can be content with evidence of this description. There must be an order that plaintiff's witnesses shall be permitted before the trial of the action to inspect the defendant's machine, and to see it work."

The object which the Court has in view in all cases where an inspection is permitted, is to ensure that **the true facts of the case shall be carefully sifted**; but at the same time the Court will take care that the process of the law is not abused, and that an action for infringement shall not be made a means and lever for the discovery of other persons' secrets.

The Court requires before granting an order for inspection that a strong *prima facie* case shall be made out of infringement (*b*). And when the interests of justice require, the inspection will be granted to scientific witnesses, who will be required to keep any secrets which they may have discovered, and which do not affect the question of infringement (*c*). And in *Flower v. Lloyd* (*d*) the Court of Appeal strictly limited the inspection to scientific men, and excluded the plaintiff from being present.

In *Pigott v. The Anglo-American Telegraph Co.* (*e*), it was alleged that an inspection would disclose important secrets. Giffard, V.-C., in refusing an order to inspect, said: "Of late years greater readiness has been shown by the Equity Courts to allow inspection in patent cases than by the Courts of Common Law. But it has never been

(*b*) *Morgan v. Seaward*, 1 Web. P. C. 169; *Russell v. Cowley*, 1 Web. P. C. 458; *Bovill v. Moore*, *supra*; *Kynaston v. East India Co.*, 3 Swan. 248; *East India Co. v. Kynaston*, 3 Bl. Ap. Cas. 153; *The Germ Milling Co. v. Robinson*, 55 L. J. Ch. 287; 1 Griffin P. C. 103.

(*c*) See *Russell v. Crichton*, 1 Web. P. C. 667 (n.); 15 Dec. Ct. of Sess. 1270.

(*d*) W. N. 1876, 169, 230.

(*e*) 19 L. T., N. S. 46.

considered as a matter of right, nor have the Equity Courts considered themselves as precluded from exercising a proper discretion in applications of this description. The Court ought to be satisfied of two things: that there really is a case to be tried at the hearing of the cause, and that the inspection asked for is of material importance to the plaintiff's case *as made out by his evidence.*"

In *Batley v. Kynock* (*f*), Sir James Bacon, V.-C., said: "Upon the single point which is raised before me, there can be no doubt that the plaintiff in such a suit as this is entitled to an inspection of the means which the defendants employ in the manufacture of the articles alleged to be violations of the plaintiff's patent, when such **inspection is essential for the purpose of enabling the plaintiff to prove his case**; upon the materials before me that is not made out. There is no allegation by the plaintiff that he cannot make out his case without inspection. But there is on the part of the defendants a plain allegation that inspection is not necessary for the purposes of the suit; upon that only I must decide this question. I would rather not go into the other matters which have been referred to. The description in the specification and the allegation in the bill—but as I read both the description in the specification and the allegation in the bill—I find that the charge made by the plaintiff is that the cartridges, the right of manufacturing which is vested in him exclusively, have been imitated and copied by the defendant, and if that fact can be made out the plaintiff's case can be clearly established. The mode of making that out is by examination of the cartridges, the means by which they have been made, whether by a machine or hammer or a screw cannot signify in the least if the cartridges of the defendant when made are made upon the principle of the patent claimed by the plaintiff."

(*f*) L. R., 19 Eq. 91.

In *Drake v. Muntz Metal Co.* (g), before statement of claim application was made to Bacon, V.-C., that the defendants by their proper officer should make an affidavit verifying the machines and processes used by the defendant company in bending metal tubes since date of plaintiff's patent and for inspection. The Vice-Chancellor said that sect. 30 (*supra*) did not give him power to direct an affidavit to be made, but ordered inspection of the machines.

The Court, in the case of *The Patent Type Founding Co. v. Walter* (h), assumed the jurisdiction to order the defendant to deliver to the plaintiff a **sample of the type made by him so that the plaintiff might have the same analysed**, for the purpose of ascertaining whether the composition was similar to the plaintiff's patented composition.

In some cases where it is necessary, the Court will order the defendant and the plaintiff to give **mutual inspection**, and to show both the patented machine and the alleged infringement at work, and to permit either party to take away any of the work or samples of the work which has been done in their presence (i).

The application may be made on motion to the Court or by summons; it is usually made upon the application for an interim injunction, but it is immaterial at what stage of the proceedings the application is made. The evidence in support must be on affidavit, and a *prima facie* case of infringement must be made out, and that the inspection is material to the plaintiff's case.

Order L. of the Rules of the Supreme Court, 1883, contains some provisions as to inspection which must be noticed.

Rule 3 provides for the inspection of property and the

(g) 3 P. O. R. 43.

(h) 8 W. R. 353.

(i) *Davenport v. Jepson*, 1 N.

R. 307. See also *The Singer*

Sewing Machine Co. v. Wilson, 5

N. R. 505, and *The Germ Milling*

Co. v. Robinson, 55 L. J. Ch. 288.

taking of samples, or for "any observations to be made or experiment to be tried which may be necessary or expedient for the purpose of obtaining full information or evidence." Rule 4: "It shall be lawful for any judge, by whom any cause or matter may be heard or tried with or without a jury, or before whom any cause or matter may be brought by way of appeal, to inspect any property or thing concerning which any question may arise therein."

This last mentioned rule was introduced by the Rules 1883. Before, the parties must have consented to a view being had. In *Jackson v. The Duke of Newcastle (k)*, Lord Westbury said: "A judge is bound to pronounce his decision according to the evidence before him, but his inspection of the premises may bring him to a conclusion directly opposite to that which is established by the evidence."

(k) 33 L. J., Ch. 698.

CHAPTER X.

THE TRIAL.

The constitution of the Court which is to hear and determine patent actions is provided for by sect. 28, sub-sect. 1, of the Act of 1883. “*In an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall on the request of either of the parties to the proceeding, call in the aid of an assessor, specially qualified, and hear and try the case wholly or partially, with his assistance; the action shall be tried without a jury, unless the Court shall otherwise direct.*”

Under the old statute, either party had an absolute right to have the questions of fact decided by a jury, and the Court had no power to deprive them of this right (a).

Under the 57th sect. of the Judicature Act, 1873, the Court had power, without the consent of the parties, “in any such cause or matter requiring any prolonged examination of documents or accounts, or *any scientific* or local *investigation* which cannot, in the opinion of the Court, or a judge, conveniently be made before a jury, or conducted by the Court through its other ordinary officers, the Court or a judge may at any time, on such terms as may be thought proper, order any question or issue of fact, or

(a) *Sugg v. Silber*, L. R., 1 Q. B. D. 362.

any question of account arising therein, to be tried either before an official referee, to be appointed as hereinafter provided, or before a special referee to be agreed on between the parties; and any such special referee so agreed on, shall have the same powers and duties, and proceed in the same manner as an official referee. All such trials before referees shall be conducted in such manner as may be prescribed by rules of court, and subject thereto in such manner as the Court or judge ordering the same shall direct."

In the case of *Saxby v. The Gloucester Wagon Co. (b)*, Mr. Justice Hawkins was of opinion that a patent case was a case which required a "prolonged scientific examination," and consequently he remitted the action to that which he considered the most proper tribunal for difficult scientific questions, "*the official referee.*" We are inclined to think that sect. 28 of the Patent &c., Act, does away with this option. The words appear to read, "*The Court may employ an assessor, and shall do so on the application of either party, and shall try the case; and the action shall be tried without a jury, &c.*"

Ord. XXXVI. rule 5 of the Rules of the Supreme Court, provides, "The Court or a judge may direct the trial, without a jury, of any cause, matter, or issue, requiring any prolonged examination of documents or accounts, or any scientific or local examination which cannot, in their or his opinion, conveniently be made with a jury;" and rule 6: "In any other cause or matter, upon the application of any party thereto, for a trial with a jury of the cause or matter, or any issue of fact, an order shall be made for a trial with a jury." These rules, together with the provisions of sect. 28 of the Patent Act, would show that the better opinion probably is that, unless a judge or the Court otherwise orders, the constitution of the Court

(b) W. N. 1880, p. 28.

shall be a judge sitting without a jury, and with or without an assessor.

The grounds of application for a trial by jury would be that the evidence shows a **conflict of testimony** in material parts, or that **grave questions of credibility** are likely to arise, or that a **charge of fraud** is made against either party.

Mr. Hindmarsh, at p. 291 of his celebrated work, says: "Few causes require so much care and industry in preparing for trial as patent actions, in which very nice points of law and difficult questions of fact must often be decided between the parties; and it will frequently happen that a party will succeed or fail in obtaining a verdict according to the industry with which he has got up his case for trial. Properly to understand the questions raised in such actions and prepare the necessary proofs, a competent knowledge not only of law, but also of science in general and the useful arts, is essentially requisite."

It is no ground for **postponing the trial of an action for infringement** that a petition has been presented by the defendant or any other person under sect. 26 to revoke the patent.

We have seen that proceedings for revocation are similar to, and for the same purpose as, *scire facias* prior to the Act of 1883. In *Muntz v. Foster* (c) it had been held that the fact of a writ of *scire facias* being pending was no ground for staying the action for infringement. Tindal, C. J., said: "As a general rule, a plaintiff has a right to have his cause go on for trial according to the ordinary course of business. Special circumstances may exist upon which the Court may see fit to interfere; but the present does not appear to us to be a case in which we ought to interfere by staying the proceedings in the action."

(c) 2 Web. P. C. 93 (n.), 1 Dowl. & Low. 942.

The ground of this decision was that the plaintiff in the action for infringement, being defendant in the proceedings by *scire facias*, had not the conduct of those proceedings, and that the defendant in the action for infringement might delay them ; but where in *Patteson v. Holland* (d), an action for infringement had been tried, and a rule nisi for a new trial had been obtained and argued, and it appeared that another action was pending in that Court for another infringement of the same patent, and that a *scire facias* had been sued out to repeal the patent, the Court suspended their judgment upon the rule for a new trial, and ordered the trial of the other action to be postponed until after the trial of the *scire facias*.

And where a verdict had already gone for the Crown on *scire facias*, but a new trial was pending, the plaintiff was not permitted to proceed to trial with his action for infringement until the rule for the new trial in *scire facias* had been disposed of (e).

In an action for infringement the plaintiff has the **right of beginning and of replying**, notwithstanding that the burden of proof may really be on the defendant, as, for instance, where the case principally turns upon questions of prior user or prior publication, which are introduced by the defendant. It sometimes happened that this privilege, particularly in cases of conflicting evidence, was of great value, and for the purpose of snatching it from the plaintiff the defendant did not wait for the plaintiff to commence his action, but commenced proceedings himself by *scire facias* to repeal the patent, so as to place himself in the position of plaintiff. But, by sect. 26, sub-sect. 7, of the Act of 1883, it is provided that in cases where it is sought to **revoke a patent**, "*The defendant shall be entitled to begin and give evidence in support of the patent,*

(d) *Hindmarsh*, 293.

(e) *Smith v. Upton*, 6 M. & G. 251.

and if the plaintiff gives evidence impeaching the validity of the patent, the defendant shall be entitled to reply."

The plaintiff must give evidence of the issues, which he is bound to prove. It is for him to support his patent and to establish its validity. He must prove his patent if the grant be denied. This is done by producing the patent itself, with the great seal—or, under the Act of 1883, the seal of the Patent Office—attached to it; sect. 12, sub-sect. 2, provides that, "*A patent so sealed shall have the same effect as if it were sealed with the great seal of the United Kingdom*"; or under sect. 89, if it be not convenient or possible to produce the original, "*Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals.*"

If the plaintiff sues as assignee, or under any derivative title, and his title is denied, the entry from the register of patents may be proved in the manner suggested by the 89th section.

Under the 96th section "*a certificate purporting to be under the hand of the comptroller as to any entry, matter or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be primâ facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.*"

For instance, if an entry in the register is denied by the defendant, he may prove its omission by a certificate under the 96th section.

If the fact of infringement is denied, the plaintiff must

be ready with evidence that the defendant has made, used or sold the article or process, and any one of these acts will satisfy the allegation of infringement, whether the infringement was **intentional or not** (*f*). **Mere possession** unaccompanied by user, does not amount to infringement (*g*). Evidence that the **defendant has sold** articles made by a patented process, or by a patented machine, will be sufficient (*h*). If the defendant has **imitated the plaintiff's process**, or substituted chemical or mechanical equivalents, he will have infringed the patent (*i*), and the plaintiff must be ready with expert and other evidence to satisfy the Court that the defendant has substantially imitated his process or article. It is an infringement to import and use or sell a patented article; although it is **no infringement to merely import** and no more (*k*). If an article, by its appearance or properties, can be distinguished as having been made by a patented process, and the defendant will not permit the plaintiff to see how it is made, Lord Ellenborough held, that a *prima facie* case had been made out, which it was for the defendant to rebut (*l*). But the mere fact that there is a **similarity of appearance** between an article made by the patented process and the alleged infringement, is not sufficient: there must be reasonably satisfactory evidence that a similar article could not be produced in any other manner; that, in fact, it carries the footprint of the invention with it (*m*). It will be observed, that when **expert witnesses** are called for the purpose of proving infringement in this manner, they must be asked whether there is a similarity between the patented article

(*f*) *Stead v. Anderson*, 4 C. B. 806, and ante, p. 168.

(*g*) Ante, p. 189.

(*h*) *Wright v. Hitchcock*, L. R., 5 Ex. 37.

(*i*) Ante, p. 179.

(*k*) Ante, p. 189.

(*l*) *Huddart v. Grimshaw*, Davis, P. C. 288. See also *Betts v. Neilson*, L. R., 5 H. L. 11 and 12.

(*m*) See *Palmer v. Wagstaff*, 9 Ex. 494; 23 L. J., Ex. 217; 2 C. L. R. 1052; and *Davenport v. Richards*, 3 L. T., N. S. 504.

and the alleged infringement, and also whether there is any other process, except the patented process, which will produce that similarity; but they cannot be asked their opinion as to whether or not there has been infringement. That is a question for the jury, or the Court in the absence of a jury (n).

The Court will consider the circumstances of the case, the behaviour of the witnesses and their credibility, when considering the question of infringement or no infringement.

In *Clark v. Adie* (o), Lord Blackburn said:—"Whenever a man knowing for the first time of an invention, either by seeing a machine at work or by reading a specification, proceeds to do what he never did before, and takes a part of the invention, it is always a very strong *argumentum ad hominem* to say: You are, by the very fact of taking this, making evidence against yourself that it was a new invention; otherwise, why did you take it? You are making evidence against yourself that at all events the part you took was new, or why did you take it? and whenever there is a case of theft or stealing knowingly, that observation ought to have some weight, although I think in practice it has more weight given to it than it ought to have. But where there is a case of an innocent infringement of property, by an unwitting use of this sort, that observation can have no weight against the party in the slightest degree, and I think it ought not to have any."

The burden of proving infringement is strictly on the plaintiff, and if he does not satisfactorily prove it there is no necessity of entering upon the defendant's case on other matters. The plaintiff must always give evidence.

(n) Per Lord Wensleydale in *Seed v. Higgins*, 8 H. L. Cas. 550.

(o) L. R., 2 App. Cas. 337.

when the alleged infringement is the sale or use of an article, that it was not made by himself or his agents (*q*).

When the defendant alleges that there is a **defect or insufficiency in the specification**, the burden of proving that there is no such defect is on the plaintiff.

We have seen (*q*) that it is for the jury to say whether a specification is **sufficient or intelligible** or not : it is for the Court to place a **construction** upon the language used in the specification. The plaintiff must therefore be prepared with evidence of an expert character as to the sufficiency of the specification; and in selecting this evidence the plaintiff cannot be better guided than by the judgment of Sir George Jessel in *Plimpton v. Malcolmson* (*r*): he must not select eminent engineers or celebrated chemists as the persons to whom the specification must be intelligible, but he must choose "ordinary workmen" in the particular branch of trade to which the invention refers—"not a careless man, but a careful man, though not possessed of that great scientific knowledge or power of invention which would enable him by himself unaided to supplement a defective description or correct an erroneous description." He may, of course, call eminent engineers, but their evidence can only be, "placing myself in the position of an ordinary workman I think it would or would not be intelligible or sufficient to me." If the specification be not sufficiently clear to be understood by an ordinary workman (a witness for the plaintiff), witnesses will not be allowed to be called to explain the intention of the patentees, and the plaintiffs will be nonsuited (*s*).

Experiments conducted for the express purpose of manu-

(*p*) *Betts v. Wilmott*, L. R., 6
Ch. 239.

(*q*) *Ante*, pp. 72 and 73.

(*r*) L. R., 3 Ch. D. 531.

(*s*) *Brooks v. Ripley*, 2 Lond.
Jour. C. S. 35.

facturing evidence, with a view to litigation, are to be looked at with distrust (*t*).

The plaintiff must, if the matter be put in issue, prove that the title, provisional specification and complete specification, correspond and substantially describe the same invention (*u*).

If it is alleged by the defendant that the invention is illegal or useless, the burden of proof is on the plaintiff (*x*).

So the plaintiff must be prepared, if he intends to claim damages, and not on account, to prove the damage which he has sustained. If he has been in the habit of granting royalties, the amount of royalties to which he would have become entitled is the proper measure of his damages ; as to the measure of damages in other cases, see *ante*, p. 203 *et seq.*

When the **defendant pleads** that the grantee of the letters patent was **not the true and first inventor**, or **that the invention was not new**, it will be sufficient if the plaintiff gives some *primâ facie* evidence of novelty (*y*). It will be sufficient to call one or two persons acquainted practically with the trade to which the invention refers, to say that they never heard of it, or saw or heard of its having been put in practice or published before the date of the patent. Gibbs, C.J., said : " The first witness, a man of considerable experience, had never seen locks with the lips so perforated ; *primâ facie* that is good evidence ; but when the question is, whether this had existence previous to the patent, fifty witnesses proving that they never saw it before would be of no avail if one was called who had seen it and practised it " (*z*).

The plaintiff having given this *primâ facie* evidence, **the burden of proof** as to prior user or prior publication is

(*t*) *Young v. Fernie*, 4 Giff. 609. 606.

(*u*) *Ante*, p. 60 *et seq.*

(*x*) *Ante*, p. 255.

(*y*) *Turner v. Winter*, 1 T. R.

(*z*) *Manton v. Manton*, Dav. P. C. 350.

shifted to the defendant, and if he would invalidate the patent he must prove his case.

We have previously discussed what amounts to prior user and prior publication (*a*). The evidence which the defendant brings must be complete and satisfactory, and the question is one of fact.

If the defendant has succeeded in establishing a case against the plaintiff, the latter will be permitted before the defendant sums up, **to adduce rebutting evidence.** In *Penn v. Jack and Others* (*b*), Sir W. Page-Wood, V.-C., said: "I think the plaintiff is entitled to adduce evidence, in reply, for the purpose of rebutting the case set up by the defendants; and for this reason, that it is quite impossible for him to know what is the nature of the evidence which is to be produced. The defendants, who contest the validity of the invention, have in effect put in a plea denying the novelty of the plaintiff's patent; and the affirmative of the issue thus raised in reality rests with the defendants, who are not obliged to give the names of their witnesses. How can the plaintiff possibly meet such a case until he hears the evidence for the defence, and knows what their witnesses will prove? I should be very sorry to have to put the parties to all the expense and delay of a new trial, which I should have to direct, if this evidence were excluded. Besides which, the witnesses are at hand and ready, and the sensible and obvious course is to examine them now. The practice at common law is stated in Taylor on Evidence; and it appears that where, as here, several issues are joined, the plaintiff may content himself with adducing evidence in support of those issues which he is bound to prove, reserving the right of rebutting his adversary's proofs, in the event of the defendant establishing a *prima facie* case with respect to the issues which lie upon him. In support of this proposition, *Shaw v. Beck* (*c*) is

(*a*) Ante, pp. 35 and 41.

(*b*) L. R., 2 Eq. at p. 317

(*c*) 8 Ex. 392.

cited, where Parke, B., used the following expression : ‘ But Abbott, C.J., laid down what appears to me to be a more reasonable rule, by holding that the defendant was bound to prove his plea, and that the plaintiff might answer it by additional evidence.’ Other instances are also mentioned, all showing the wide discretion given to the judge in allowing evidence to be given by the plaintiff in reply. The plaintiff has put in his letters patent as formal evidence of his title. The defendants then plead want of novelty, and give, in proof of the issues thus raised by them, special evidence, which the plaintiff is entitled to rebut, by evidence, in reply. Regarding this case as one of an affirmative plea, the burden of proving which rests on the defendants, I feel bound to admit the evidence proposed to be given by the plaintiff in reply.”

Although the plaintiff may, as of right, rebut the case made by the defendant, upon any issue which rests with the defendant, where the plaintiff has given such rebutting evidence, **the defendant will not be allowed to strengthen the case which he had made by adducing further evidence** ; and this will apply with greater force when the defendant’s counsel has summed up the evidence which has been offered (*d*).

At the hearing of the action, **no objection will be allowed, either to the particulars of objections, or to the particulars of breaches**, and any evidence will be received which they are wide enough to admit of. If there is any vagueness or insufficiency in the particulars, the party requiring further information must apply for it to a judge in chambers, within reasonable time before the trial of the action ; but they will not be allowed to permit the opposite side to go to trial, and then to submit that, for want of sufficient particularity in the objection, the evidence is not admissible (*e*).

(*d*) *Penn v. Jack*, L. R., 2 Eq. W. 806 ; *Hull v. Bolland*, 1 H. & N. 134.
at p. 318.

(*e*) *Neilson v. Harford*, 8 M. &

In *Sykes v. Howarth* (*f*), the plaintiff delivered particulars of breaches in May, 1878, which stated that the defendant had at divers times between the 29th of May, 1879, and the commencement of the action, infringed the plaintiff's patent by the manufacture, or sale, or use of fancy rollers, and in particular by fancy rollers manufactured and sold by or covered with cards, by the defendant, for Messrs. Shaw and Mr. Smith. In July, 1878, the statement of defence was delivered. It stated, "The defendant has made and sold to Messrs. Samuel Shaw and Co. and Mr. Charles Smith, in the particulars of breaches in this action respectively mentioned, and to other persons, certain cards (in all six sets), which were all $2\frac{1}{2}$ inches in width;" and the defendant, in answer to interrogatories, disclosed the name of Hirst as one of the persons supplied with such sets of cards. Mr. Justice Fry admitted evidence in Hirst's case. He said: "The defendant did not apply for amended particulars, according to the case of *Hull v. Bolland* (*supra*). It appears to me I have to inquire what is the meaning of the particulars. I find that the case of Hirst is within the literal meaning of the particulars. If I had found that the case of Hirst was likely to create surprise, or likely to introduce any point not raised in Smith's or Shaw's case, I should probably have given an opportunity to the defendant to bring any fresh evidence." The learned judge would not have ruled that the plaintiff was prevented from giving the evidence in Hirst's case, but he would have allowed the defendant to rebut it.

These decisions must not be confused with a case where, for example, the particulars alleged infringement or prior user at London and Liverpool. In such a case no act of infringement or prior user would be admitted in evidence which did not occur at London or Liverpool, but if the words were London, Liverpool, or elsewhere, then the

(*f*) L. R., 12 Ch. D. 826.

evidence might extend to any part of the country, because any evidence would come within the strict meaning of the objections.

Upon the trial no evidence will be received in support of any issue which is not raised in the pleadings. In *Bovill v. Goodier* (*g*) it was held that an objection to the validity of a patent on the ground of the expiration of a foreign patent for the same invention, cannot be taken at the hearing of a suit to restrain the infringement of a patent unless it has been raised by the answer.

(*g*) L. R., 2 Eq. 195.

CHAPTER XI.

QUESTIONS FOR COURT AND JURY.

WE have seen that as a rule actions for the infringement of letters patent are directed to be tried before the Court without a jury. Still, under special circumstances, the parties, or either of them, may obtain an order to try before a jury. Under these circumstances it will still be material to consider what are the questions which the Court should leave to the jury, and which are left to the decision of the Court.

As to the specification. **The construction is for the Court (a)**; and the rules of construction are similar to those which govern the construction of other documents (b). In *Hills v. Evans* (c), Lord Westbury said: "It is undoubtedly true, as a proposition of law, that the construction of a specification, as the construction of all other written instruments, belongs to the Court; but a specification of an invention contains most generally, if not always, some technical terms, some phrases of art, some processes, and requires generally the aid of the light derived from what are called surrounding circumstances. It is, therefore, an admitted rule of law that the explanation of the words or technical terms of art, the phrases used in commerce, and the proofs and results of the processes which are described (and in a chemical patent the ascertainment of chemical equivalents), that all these are matters of fact upon which

(a) *Hills v. Evans*, 31 L. J., Ch. 457; *Seed v. Higgins*, 8 H. L. Cas. 561; *Bovill v. Pimm*, 11 Ex. 740.

(b) *Simpson v. Holliday*, 20 Newton's Lon. Jour. N. S. 105.

(c) 31 L. J., Ch. 457.

evidence may be given, contradictory testimony may be adduced, and upon which undoubtedly it is the province and the right of a jury to decide. But when these portions of a specification are abstracted and made the subject of evidence, and therefore brought within the province of the jury, the direction to be given to the jury with regard to the construction of the rest of the patent, which is conceived in ordinary language, must be a direction given only conditionally, that is to say, a direction as to the meaning of the patent upon the hypothesis or the basis of the jury arriving at a certain conclusion with regard to the meaning of those terms, the signification of those phrases, the truth of those processes, and the result of the technical procedure described in the specification. And so the rule is given by Parke, B., in delivering the judgment of the Court of Exchequer in the case, I think, of *Neilson v. Harford* (*d*). The language of the learned judge, which I adopt, is in these words: 'The construction of all written instruments belongs to the Court alone, whose duty it is to construe all such instruments as soon as the true meaning of the words in which they are couched and the surrounding circumstances, if any, have been ascertained as facts by the jury; and it is the duty of the jury to take the construction from the Court, either absolutely, if there be no words to be construed as words of art or phrases used in commerce, and no surrounding circumstances to be ascertained, or conditionally, when those words or circumstances are necessarily referred to them.' Now, adopting that as the rule in the comparison of two specifications, each of which is filled with terms of art and with the description of technical processes, the duty of the Court would be confined to this—to give the legal construction of such documents taken independently. But, after that duty is discharged, there would remain a most important function to be still performed,

(*d*) 8 M. & W. 806.

which is the comparison of the two instruments when they have received their legal exposition and interpretation ; and as it is always a matter of evidence what external thing is indicated and denoted by any description, when the jury have been informed of the meaning of the description contained in each specification, the work of comparing the two, and ascertaining whether the words, as interpreted by the Court, contained in specification A, do or do not denote the same external matter as the words, as interpreted and explained by the Court, contained in specification B, is a matter of fact, and is, I conceive, a matter within the province of the jury, and not within the function of the Court."

Epitomising this elaborate judgment. When the language used is that which has an ordinary and legal meaning the question is, what has the man said ? not what did he intend to say ? and, therefore, the Court will place the legal meaning on his words. When the language used is that which has no ordinary legal meaning, or which under different circumstances may have two or more ordinary legal meanings, the question is, as a fact, with what meaning did the writer use the words or expressions which he has used ? and that is a question which the Court should require the jury to solve. The matter could not be placed more lucidly than it is by Lord Westbury in the last dozen lines of the judgment which we have quoted.

It is for the jury to say whether the specification is **intelligible** (*e*) or not, and it is for the Court to direct the jury as to the class of persons to whom it must be intelligible (*f*).

It is for the jury to say whether the specification is **sufficient** or not, that is, whether it contains a sufficient description of the invention ; but it is for the Court to

(*e*) *Neilson v. Harford*, 1 Web. P. C. 295.

(*f*) See cases cited at p. 80 et seq.

inform the jury the degree of sufficiency which the law requires in specifications (*g*).

The novelty of the invention is a question for the jury. Questions of prior user or prior publication are always questions of fact, and it is for the jury to compare what has been done before and what is set up as being new, and to say whether or not they are identical. And so any document which is said to amount to prior publication must be construed by the Court, but it is for the jury to **compare it with the specification** and to say whether the described matter is the same or not (*h*).

The **utility of the invention is also for the jury**, subject to the directions of the Court as to the degree of utility which the law requires for the purpose of supporting the validity of a patent (*i*).

The question of infringement is for the jury. In *De la Rue v. Dickinson* (*k*), Campbell, C. J., said :—“ There may well be a case where the judge may and ought to take upon himself to say that the plaintiff has offered no evidence to be left to the jury to prove infringement, as if there were a patent for a chemical composition, and the evidence was that the defendant had constructed and used a machine for combing wool. But, if the evidence has a tendency to show that the defendant has used substantially the same means to obtain the same result as specified by the plaintiff, and scientific witnesses have sworn that the

(*g*) *Hill v. Thompson*, 1 Web. P. C. 235; *Bickford v. Skewes*, 1 Q. B. 938; *Neilson v. Harford*, 1 Web. P. C. 295; *Walton v. Bateman*, 1 Web. P. C. 621; *Beard v. Egerton*, 19 L. J., C. P. 38; *Wallington v. Dale*, 7 Ex. 888; *Parkes v. Stevens*, L. R., 8 Eq. 358, and L. R., 5 Ch. Ap. Cas. 36.

(*h*) *Cornish v. Keene*, 1 Web. P. C. 519; *Elliott v. Aston*, 1 Web.

P. C. 222; *Muntz v. Foster*, 2 Web. P. C. 107; *Spencer v. Jack*, 11 L. T., N. S. 242.

(*i*) *Hill v. Thompson*, 1 Web. P. C. 237; *Bloxam v. Elsee*, 1 C. & P. 565; *Cornish v. Keene*, 1 Web. P. C. 506; *Morgan v. Seaward*, 1 Web. P. C. 186; *Macnamara v. Hulse*, C. & M. 471.

(*k*) 7 E. & B. at p. 755.

defendant actually has used such means, the question becomes one of fact, mixed with law, which the judge is bound to submit to the jury."

In *Seed v. Higgins* (l), Lord Chelmsford in the House of Lords said:—"What the defendant had done in any case was of course a question of fact, but whether, on proof of certain acts having been done by a defendant, the plaintiff had any case to go to a jury, was a question for the judge" (m).

(l) 30 L. J., Q. B. at p. 317.

(m) See also *Walton v. Potter*, 1 Web. P. C. 586; *Macnamara v. Hulse*, Car. & M. 471; *Newton v. Grand Junction Rail. Co.*, 5 Ex.

331; *Stevens v. Keating*, 2 Web. P. C. 191; *Sellers v. Dickinson*, 5 Ex. 323; *Curtis v. Platt*, 35 L. J. Ch. 852.

CHAPTER XII.

CERTIFICATES.

SECT. 31 of the Patents, &c., Act, 1883, is as follows :—
“ 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.”

Similar provisions were contained in 5 & 6 Will. IV. c. 83, and also in the 43rd section of the Patent Law Amendment Act, 1883.

The object of these sections is to prevent patentees of important inventions being ruined by successive actions, which they are bound to bring to restrain infringements, manufacturers banding themselves together to defeat a patentee's rights in this manner.

The Act of William IV. cited above gave the patentee a right to treble costs, but this was taken away by 5 & 6 Vict. c. 97, which gave him full costs; and now, as we have seen, costs as between solicitor and client are substituted for full costs.

In *Otto v. Steel (a)*, Pearson, J., refused costs as between

(a) Griffin P. C. 182.

solicitor and client in a second action, after a certificate had been obtained in a first action, on the ground that the patent was **impeached on grounds substantially different** from those relied on in the first action.

To acquire the protection of the 31st section a certificate is requisite, and this should be applied for at the trial of the action, and the application must be made to the Court or judge who have tried the cause (*b*).

The Court have no power to order full costs "upon the first trial in which the validity of the patent came in question, the words of the statute being "in any subsequent action for infringement" (*c*).

Where several simultaneous actions have been brought, and one of them has been made a test action and proceeded with to trial, upon a certificate being given in that action it will not operate upon the others (*d*).

An action was compromised at the trial by a verdict being entered for the plaintiff in the action for 40s. damages and costs, with all usual certificates. Subsequently, upon an ex parte application, the judge endorsed on the record a certificate that the record in a certain action, wherein Bovill was plaintiff and Keyworth was defendant, and the certificate thereon endorsed was given in evidence at the trial of this action (*Bovill v. Hadley*), it was held that this certificate was improperly granted, the record and certificate in the former action not having been given in evidence, and it not being under the circumstances a "usual certificate" within the contemplation of the parties (*e*). Upon the trial of the second action the record of the first action with the endorsement must be produced, but not before the verdict, in such a manner as to prejudice the second trial (*f*).

(*b*) *Gillet v. Green*, 7 M. & W. 308.
347.

(*c*) *Penn v. Bibby*, L. R., 3 Eq. N. S. 435.
308.

(*d*) *Penn v. Fernie*, L. R., 3 Eq. 20.

(*e*) *Bovill v. Hadley*, 17 C. B.,

(*f*) *Newall v. Wilkins*, 17 L. T.

The certificate of the judge, which is granted for the purpose of affecting the costs in future cases, is one which cannot be given by consent. In obtaining this certificate **the plaintiff and the country are the parties, not the defendant**, and the judge is bound to protect the interests of the country and to see that the certificate is not given when the validity of the patent has not, in fact, been proved to the satisfaction of the Court; otherwise, there is nothing to prevent collusive actions being merely brought for the purpose of obtaining this valuable privilege—a privilege which can be used as an enormous lever, preventing persons from incurring the risk of a conflict with the patentee (*g*).

No appeal will lie from a granting or refusing to grant a certificate that the validity of the patent came in question; such appeal not being from a judgment or order within sect. 19 of the Judicature Act (*h*).

We have seen that the object of this section is to prevent the patentee from being repeatedly harassed by the validity of his patent being called in question in succession of actions. It does not appear ever to have been decided whether, when in a second action the validity of the patent is not called in question, but there is a mere denial of infringement, the section applies. It is submitted that such a case was not within the contemplation of the legislature, and that the judge should direct only party and party costs whenever the validity of the patent is not called in question.

Sect. 29 of the Act of 1883, after providing for the delivery of particulars of breaches and objections, enacts: “(6) **On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant, and they respectively shall not be allowed any**

(*g*) *Stocker v. Rodgers*, 1 C. & *gineering Co. v. Hall*, 20 Q. B. D. K. 99. 491.

(*h*) *Haslam Foundry and En-*

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."

Where the plaintiff is successful on some issues and the defendant on some the costs should be apportioned (*i*). In *Simmonds v. Hitchman*, noticed L. R. 29 Ch. D. at p. 417, costs were apportioned by Bacon, V.-C. In *Badische Anilin Fabrik v. Levinstein* (*k*), in the Court of Appeal, 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 the 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 reasonable with regard to 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. The order, therefore, I think ought to be as I have stated."

The certificates granted under this section must not be confused with the certificate under sect. 31. The object of sect. 29 is to provide what costs shall be payable in the action itself, and the object of sect. 31 is to provide for the costs of future actions.

Care must be taken at the trial to ask the judge to

(*i*) *Wegmann v. Corcoran*, L. R. 13 Ch. D. 65; 27 W. R. 357; *Young v. Rosenthal*, 2 P. O. R. 41.

(*k*) L. R., 29 Ch. D. at p. 418. See also *Pooley v. Pointon*, Griffin, P. C. at p. 200.

certify as to each particular breach mentioned in the particulars of breaches, and as to each particular objection, and no costs of witnesses, or of, and incidental to, such breach or objection, as is not specially certified for, will be allowed (*l*). The Court of the County Palatine cannot grant a certificate, not being a "Court" within the meaning of the Patent, &c., Act, 1883 (*m*), and this appears to be confirmed by sect. 26 of the Patents, &c., Act, 1888. The certificate is not a judgment or order under sect. 19 of Judicature Act, 1873, and therefore there is no appeal from the judge who grants or refuses it (*n*).

If an action is not tried out, it is obvious that a difficulty may arise as to costs, since the parties have had no opportunity to prove or disprove their particulars. In *Greaves v. The Eastern Counties Railway Co.* (*o*), it was held that where the defendant had delivered particulars of objections, and just before trial the plaintiff had abandoned his action, thus giving the defendant no opportunity of proving or disproving his objections, the defendant was entitled to the costs of the objections and of the witnesses, for the act did not apply, except where the cause came on for trial. It will be observed, however, that there is a difference between the language of the 43rd sect. of the Patent Law Amendment Act, 1852, and the language of the 29th sect. sub-sect. (6) of the Patents, &c. Act, 1883. In the former case the words were: "Shall not be allowed any costs in respect of any particular unless certified by the *judge before whom the trial was had to have been proved.*" Under the latter statute: "*Shall not be allowed any costs in respect of any particular delivered*

(*l*) *Honiball v. Bloomer*, 10 Exch. 538. See also *Losh v. Hague*, 5 M. & W. 387, and *Parnell v. Mort Leddell & Co.*, 29 Ch. D. 325.

(*m*) *Proctor v. Sutton Lodge Chemical Co.*, 5 P. O. R. 184.

(*n*) *Haslam v. Hall*, 5 P. O. R. 144.

(*o*) 1 E. & E. 961.

by them, unless the same is certified by the Court or a judge to have been proven, or to have been reasonable and proper." It is submitted that the practice under the new act when the action has not been tried is to take out a summons before a judge at chambers for a certificate, on the ground that the particulars were reasonable and proper; such summons should be supported by an affidavit, alleging that the plaintiff or defendant had reasonable grounds for believing that he would at the trial have been able to prove the particulars in respect of which application is made; but a certificate so granted will not operate in a manner to entitle the plaintiff to costs as between solicitor and client in any subsequent action.

Since the above was written the point in question has arisen in *Peroni v. Hudson* (*p*), where the defendant did not appear on the trial. Kay, J., gave a certificate that the plaintiff had proved his particulars, but refused to certify that the validity of the patent came in question, holding that sect. 31 only applied where the patent was established in a case contested in Court.

We have seen that since the Judicature Acts, the Common Law Division and the Chancery Division can either of them grant full relief in an action for the infringement of a patent, **granting both an injunction and damages, or an account.** In olden times the Common Law Courts merely inquired into damages, and if less than 40s. was recovered a question arose as to whether or not County Court costs should not alone be allowed; but now in every patent case an injunction may be granted, and this removes the case from the operation of 30 & 31 Vict. c. 142, s. 5.

The Rules of the Supreme Court, 1883, provide for cases where the **higher scale and lower scale of costs** are to be allowed; and in future, notwithstanding that an injunction

(*p*) Griffin, P. C. 183.

is granted, it will be necessary to ask the judge at the trial to certify for costs on the higher scale.

Order LXV. r. 8, provides: "In causes and matters commenced after these rules come into operation, solicitors shall be entitled to charge and be allowed the fees set forth in the column headed 'lower scale,' in Appendix N. in all causes and matters, and no higher fees shall be allowed in any case, except such as are by this order otherwise provided for; and in causes and matters pending at the time when these rules come into operation, to which the higher scale of costs previously in force was applicable, the same scale shall continue to be applied."

Rule 9.—"The fees set forth in the column headed 'higher scale' in Appendix N. 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 every application therein, whether the cause or 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 to him for that purpose by the Court or a judge, shall think that such allowance ought to be made upon such special grounds as aforesaid."

Sect. 49 of the Judicature Act, 1873, provides that there shall be no appeal as to costs; but this was held not to apply where the costs were a matter of right, and not discretionary (*q*). Under the Rules of Court, which were in operation prior to the 24th October, 1883, the question of higher or lower scale was a matter of right (*r*). Hence,

(*q*) *Turner v. Hancock*, C. A., 20
Ch. D. 303.

(*r*) Rules of S. C. Dec. 1875

in *Re Terrell* (s), the Court of Appeal held that there was an appeal, but now it will be observed that the order is in the absolute discretion of the judge, and, therefore, it is submitted there is no appeal.

The **directors of a limited company**, whose servants have infringed a patent, **may be ordered to pay costs personally**. Sir W. Page-Wood, in *Betts v. De Vitre* (t), said: "Where there is a wilful act against the rights of a patentee, after he has obtained a verdict, and the certificate of a judge, that his title came in question, all the world must be taken to know that that was fairly and completely tried and disposed of, and, if they infringe the patent, they infringe it with a liability for costs." The reasoning of this decision is not quite clear, and it is submitted that, should the question arise again, the opinion of the Court of Appeal might be taken on the subject, regard being had to the case of *Denley v. Blore* (u).

Judgment having been recovered, minutes of judgment should be prepared. The minutes will be in accordance with one or other of the precedents given hereafter. We have drawn attention in previous pages to those points which should be attended to in preparing these minutes. Care should be exercised when an account is directed to be taken that provision be made for the **payment of costs to the plaintiff up to and including the hearing**, otherwise the payment of all costs will be delayed until the final account has been taken, which in some cases has been known to amount to a delay of years.

(s) L. R., 22 Ch. D. 473.

(u) 38 Lond. Jour. 224.

(t) 11 Jur., N. S. 11.

CHAPTER XIII.

PRACTICE ON PETITION FOR REVOCATION.

THE Rules of the Supreme Court apply to a petition for revocation and the word plaintiff in Ord. XXXI. r. 1, includes petitioner (α).

All persons are not empowered to petition for revocation of a patent.

The parties who may petition are specified in sect. 26, sub-sect. 4, of the Patents Act, 1883.

The petition must be presented to the High Court of Justice.

A form of petition, applicable to such a case is given hereafter (b).

Sub-sect. (5). "*The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered.*"

The practice as to particulars is precisely similar to that in an action for infringement. It will, however, be observed that the judge has no power of certifying under sect. 31 that the validity of the patent came in question, nor will a certificate granted in a previous action for infringement affect the question of costs in proceedings for revocation, the words of sect. 31 being "*in any subsequent action for infringement.*"

(a) *Haddan's Patent*, 54 L. J. Ch. 126.

(b) Page 288.

Sect. 100 of the Judicature Act, defines "Pleading" as including any *petition* or summons, and also as including the statements, in writing, of the claims or demand of any plaintiff, and of the defence of any defendant thereto, and of the reply of the plaintiff to any counter-claim of a defendant.

Ord. XXXI. r. 1, of the Rules of the Supreme Court, gives power to the Court, or a judge, to permit interrogatories "*in any other cause or matter,*" to be delivered by either party to the other. It is presumed that leave will be given to the respondent (called defendant in the Patent Act, 1883) to deliver interrogatories to the petitioner, and circumstances may arise when it would be just to permit the petitioner to examine the respondent. The rules as to interrogatories will be similar to those in an action for infringement.

The respondent having entered an appearance to the petition, the same will be set down for trial.

There does not appear to be any provision that the petition should be verified by affidavit, or that the respondent should deliver an answer.

The respondent should be careful that the **particulars of objections are sufficiently precise and accurate**, otherwise he may be taken by surprise at the hearing (c). He may apply for further and better particulars in the same manner as in an action for infringement; and under sect. 26, sub-sect. (6), "*Particulars delivered may be, from time to time, amended by leave of the Court or a judge.*"

Sect. 28, sub-sect. (1), provides that the mode of trial of a petition for revocation shall be similar to that of an action for infringement.

And the parties are entitled to have the petition heard as *viva voce* evidence (d).

(c) Ante, p. 228 et seq.

34 Ch. D. 396; 56 L. J. Ch. 606;

(d) *Goulard and Gibbs' Patent*,

56 L. T. 284.

Sect. 26, sub-sect. 7. *“ The defendant shall be entitled to begin and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent, the defendant shall be entitled to reply.”*

The evidence which will be required of the respondent (defendant), in the first instance, will be very slight, and will be similar to that which he would give as to the validity of the patent were he plaintiff in an action for infringement. The petitioner will then have to prove the case he alleges in his petition and particulars, and the respondent has the right of reply. It is merely to preserve this right to reply, that the respondent is made practically plaintiff at the trial.

It is very doubtful whether sect. 29, sub-sect. (6), will be held to apply to petitions for revocation. Sub-sect. (1) of the same section, limiting, apparently, the operation of that section to actions for infringement, as distinguished from sect. 28, which deals with both actions for infringement and petitions for revocation.

CHAPTER XIV.

PRACTICE ON APPEAL.

UNDER Order LVIII. rule 4, the Court of Appeal has all the powers and duties as to amendment and otherwise of the High Court together with full discretionary power to receive further evidence upon questions of fact, such evidence to be either by oral examination in Court, by affidavit, or by deposition taken before an examiner or commissioner. Such further evidence may be given without special leave upon interlocutory application or in any case as to matters which have occurred after the date of the decision from which the appeal is brought. Upon appeals from a judgment after trial or hearing of any cause or matter upon the merits, such further evidence (same as to matters subsequent as aforesaid) shall be admitted on special grounds only, and not without special leave of the Court.

Leave to *amend particulars* of objections to letters patent was refused where the case had been argued throughout on the footing that no such amendment was necessary (a).

As to *further evidence* in *Hinde v. Osborne* (b), Lindley, L.J., said: "The power given to the Court of Appeal to hear fresh evidence is an extremely valuable one, and is given by Order LVIII. r. 4. I cannot understand that as meaning that the Court of Appeal ought to grant leave to

(a) *Cropper v. Smith*, 26 C. D. L. J., at pp. 710, 711.
700; but see remarks of Bowen, (b) *Griffin*, P. C. at p. 127.

adduce fresh evidence, simply because a man has failed at the trial and he thinks he can get more evidence, which, if he had got it before, would have enabled him to succeed on the trial. That cannot be. There must be some ground shown to satisfy the Court that there is some evidence now forthcoming, which, with due diligence, he could not have got, and it must, therefore, in accordance with the usual practice, be evidence, not merely swearing by affidavits or anything of that kind, but something in the nature of the production of a lost document, or something of that sort, which will not expose the parties to a mere flood of affidavits made up to meet the blots and defects which have been disclosed upon the first trial."

Pending an appeal an injunction will under some circumstances be suspended (c).

On appeal to the House of Lords it was held in a case where the Court of Appeal had held the specification bad and for the defendant on the infringement issue, but the House had reversed the decision on the specification and upheld it on the infringement issue, that each party must pay their own costs of the appeal (*d*).

(c) *Hocking v. Frazer*, Griffin, P. C. 129.

(d) *Moore v. Bennett*, Griffin, P. C. at p. 161.

CHAPTER XV.

ACTION FOR INJUNCTION TO RESTRAIN THREATS.

SECT. 32 of the Patents Act, 1883, provides, "*Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings, or liability in respect of any alleged manufacture in sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase, to which the threats related, was not, in fact an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats, with due diligence, commences and prosecutes an action for infringement of his patent.*"

The action mentioned in the proviso as taking a case out of the section need not be an action against the person who is suing to restrain the threats, but that an action for infringement honestly brought with reasonable diligence against any of the persons who have been threatened will if duly prosecuted satisfy the proviso (a).

Pending the trial of an action for the infringement of certain patents, the plaintiffs in the action issued advertisements stating that in consequence of the continued infringement of their patents by the defendants, they had commenced an action against them to restrain them from infringing such patents; and that actions would be commenced against all persons employing or using apparatus

(a) *Challender v. Royle*, 36 Ch. D. 425.

which was in accordance with the letters patent without the leave of the patentees. Held that the plaintiffs were not justified in issuing such advertisements notwithstanding sect. 32, *supra* (b).

Before this Act an injunction under some circumstances might have been granted (c).

This section would appear to give the threatened party the power of testing the validity of the patent.

But in an action commenced under this sect. 32 of the Act for an injunction to restrain a patentee from issuing threats of legal proceedings, Chitty, J., held that the validity of the patent could not be tried, the only issue in such an action being infringement or no infringement. The plaintiffs in their statement of claim alleged that the defendant's patent was invalid, and such allegation was ordered to be struck out (d).

No appeal was lodged from this decision until it was too late, subsequently upon application to amend by reinserting the allegations that the patent was invalid, the Court of Appeal expressed the opinion that the validity of the patent could be questioned under this section, and allowed the amendment upon terms that particulars of objection were delivered, and that the defendant, as to the validity of the patent, be at liberty to begin and reply (e), and the decision of Chitty, J., (*supra*) has since been directly overruled by the Court of Appeal (f).

In *Driffield &c., Pure Linseed Cake Co. v. Waterloo Mills, &c., Co.*, (g), such a course was evidently contemplated but was abandoned. Bacon, V.-C., held that the words "by circulars, advertisements, or otherwise," did not

(b) *Goulard v. Lindsay*, 56 L. T. 579.

506.

(c) *Société, &c., des Glaces v. Tilghman's, &c., Co.* 25 Ch. D. 1, and *Halsey v. Brotherhood*, 15 Ch. D. 514.

(d) *Kurtz v. Spence*, 33 Ch. D.

(e) *Kurtz v. Spence*, 36 Ch. D.

770. See also *Walker v. Clarke*, 56 L. J. Ch. 239.

(f) *Challender v. Royle*, 36 Ch. D. 425.

(g) 31 Ch. D. 638.

mean otherwise *ejusdem generis* with circulars or advertisements, and that a solicitor's letter was a sufficient threat, a perpetual injunction was granted, but a claim for damages disallowed.

This is neither an action for infringement under sect. 29 nor a petition for revocation under sect. 26, and therefore the provisions as to particulars of objections do not apply. The provisions of the Rules of the Supreme Court, 1883, as to particulars do not appear to be available for the obtaining of particulars of objections in such a case, it being remembered that the patentee is defendant; that the cause of action is not to establish the patent but to restrain threats, and that the patentee himself has to set up his valid patent by way of substantive defence. The patentee is at such disadvantage in such form of action that it is to his interest forthwith to commence an action for infringement, and to apply for a stay of the action brought against him (*h*).

Forms of indorsement to writ, &c., under this section, are given hereafter.

In *Barrett v. Barrett's Screw Stopper Co., Limited* (*i*), an action had been brought to restrain the issue of certain circulars containing threats against persons infringing defendant's alleged patent. The inventor had brought an action for infringement. Upon motion for interlocutory injunction to restrain the issue of the circulars, Pearson, J., adjourned the motion until the hearing of the action for infringement with liberty to apply and costs reserved.

If an action to restrain threats has been commenced and stayed pending an action for infringement, and the action for infringement is not prosecuted with due diligence, an injunction will be granted upon the first action and the stay removed (*j*). And in considering whether such an

(*h*) See *Kurtz v. Spence*, 36 Ch. D. 770.

(*j*) *Household v. Fairburn*, Griffin, P. C. 131.

(*i*) 1 Patent Office Reports, 9.