

Toward the opp. the sum  
of 3gn in respect of his costs a  
direct. The said sum to be paid  
by the opp. In the event of  
application being made to  
have this order made a Rule  
of the Court, Toward the said A.B.  
a further sum of 3gn to be paid  
by the said A.B., but no application  
to be made to make this order  
a Rule of the Court until the  
expiration of 14 day from the  
date of this order

Ed. H. 14.

decision on opp. to 9424<sup>10</sup>

Brinson v. Clark LJ 32 NS 290

See also Law of R.P.C. 1958

Opposition a ground de publication  
Statutebook Book 10  
XXVI R.P.C. 14,

See also page.

Appeals Tribunal  
, Judge.

date of the decision appealed against, and must state the nature of such decision. The evidence used on appeal to the law officer must be the same as that used at the hearing before the Comptroller, save as to matters that have occurred or come to the knowledge of either party in the meanwhile, except with the leave of the law officer. The law officer shall, at the request of either party, order the attendance at the hearing of the appeal, for the purpose of being cross-examined, of any person who has made a declaration in the matter in question, unless, in the opinion of the law officer, there is good ground for not making such an order.

The law officer will not allow the question of fraud to be raised for the first time on appeal (c).

(c) *Huth's Application*, 1884, Griff. P. C. 292.

## CHAPTER IX.

## AMENDMENT OF SPECIFICATIONS.

IN previous chapters we have seen that the specification may be amended before publication as a result of the procedure on application and acceptance or on account of opposition to the grant. We now have to deal with cases in which the applicant or patentee desires to amend the specification after publication. The extent to which this may be done and the procedure are regulated by sects. 21 and 22 of the Act of 1907 and rules 60—67 of 1908.

History of  
law.

The history of the law on this matter is, however, instructive. There are several reported cases showing that at common law mere clerical errors in a specification might formerly be amended by the Master of the Rolls and the Lord Chancellor upon petition, but these amendments were strictly limited to verbal or clerical errors arising from mistake or inadvertence (*a*). In *Re Gare's Patent* (1884, L. R. 26 C. D. 105), Brett, M.R., allowed amendments of clerical errors in a specification filed under sects. 27 and 28 of the Patents, &c. Act, 1852, and said: "The Master of the Rolls is of opinion that sect. 18 of the Patents, &c. Act, 1883, does not affect the power of the Master of the Rolls to allow amendments in a patent specification filed in pursuance of sects. 27 and 28 of the Patent Act, 1852, or which is otherwise to be considered as a record under the authority of the Master of the Rolls. So long as the specification is in the Patent Office, and before the patent is sealed, the Master of the Rolls considers that the proceedings of sect. 18 should be the only proceedings taken by anyone asking for amendment under that section."

It would appear from the words printed in italics that the

(*a*) *In re Sharp's Patent*, 1840, 1 W. P. C. 649; *In re Johnson's Patent*, 1877, L. R. 5 C. D. 503.

jurisdiction of the Master of the Rolls is still intact with reference to amendments after sealing.

In *Re Berdan's Patent* (1875, L. R. 20 Eq. 346), it was held that where a disclaimer had been filed without the consent of the patentee, the Master of the Rolls had jurisdiction without bill filed to order it to be taken off the file.

Sect. 70 gives to the Comptroller power to correct any clerical error in or in connection with an application for a patent on payment of the prescribed fee.

We have seen that a patent for a very meritorious invention may be utterly vitiated by the patentee claiming something which is not new; so, also, a patent might be rendered void by reason of innocent misdescription or misrepresentation.

The common law power of amendment being found insufficient for the purposes of justice in such cases, the Act 5 & 6 Will. IV. c. 83, was passed, enabling "*any person who as grantee, assignee, or otherwise, hath obtained, or shall hereafter obtain, letters patent, &c.,*" with the leave of the law officer, to disclaim any part of the "title of the invention or of the specification, stating the reason for such disclaimer;" or to, with such leave as aforesaid, "enter a memorandum of any alteration in such title or specification (not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent), &c., &c." The case of *Spilsbury v. Clough* (1842, 2 Q. B. 466) having very much limited the meaning of the words of the statute, printed above in italics, the Act 7 & 8 Vict. c. 69, was passed, giving power to the original patentee, or his assignees, or both jointly, in the event of any interest in the patent remaining in the original patentee, to file a disclaimer or memorandum of alteration.

It will be observed that prior to the Act of 1883 any disclaimer or amendment made by the patentee was entirely at his own peril, and that in any subsequent action involving the validity of the patent objection might be taken to the disclaimer or amendment on the ground that it really extended the patent beyond its original limits.

The provisions of sect. 21 of the Act of 1907 (following The Act of 1907.

sect. 18 of the Act of 1883 as amended by sect. 5 of the Act of 1886) are as follows.

Sub-sect. 1 provides:—

(1) “An applicant or a patentee may at any time, by request in writing left at the Patent Office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of, and the reasons for, the proposed amendment.”

When the Comptroller-General has not required an amendment, all amendments by the applicant or patentee from the date of lodging the complete specification (save those made under sect. 22 to be considered hereafter) must be made under sect. 21.

“The patentee,” as has been pointed out in a previous chapter, means the person for the time being entitled to the benefit of the patent, while “the applicant” means the person whose patent has not yet been sealed, but whose complete specification has been lodged.

Amendments  
after publica-  
tion under  
sect. 21.

Directly the specification is accepted it becomes open to public inspection (see sect. 9), and therefore the application to amend will have to be made under sect. 21. The case of *Jones' Patent* (Griff. P. C. 313), which is otherwise badly reported and ambiguous, makes this clear. The practice of the Patent Office is to allow amendments under sects. 6, 7 and 8 before acceptance.

Permissible  
amendments.

We will deal firstly with the nature of permissible amendments and refer later to the practice.

Nature of  
permissible  
amendments.

(6) “No amendment shall be allowed that would make the specification as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment.”

It will be observed that the amendments are to be by disclaimer, correction or explanation, provided the amendment does not cause the specification to claim an invention substantially larger or different. The Act of Will. IV., after using the words “disclaimer” and “alteration,” provided that no extension should take place in the “exclusive right” granted by the letters patent.

It was always a question of great difficulty whether or not a

*As to amendment of Sec. 91 application  
See Re W.E.C. x LII R.P.C. 281.  
Scope as originally application not as final  
grant.*

disclaimer or alteration extended the "exclusive right" of the patentee. For instance, if in his original specification, after describing several improvements in a process of manufacture, he proceeded to claim them all, and it should turn out that one of his improvements was old, the whole patent was bad and the patentee had no exclusive right at all; if he then disclaimed the objectionable portion, his patent became good as to all the rest. There was clearly, therefore, an extension of the exclusive right, notwithstanding that this was the very case the statute was passed to meet. In *R. v. Mill* (1850, 20 L. J. C. P. 24), Mr. Justice Maule's view of the Act of Will. IV. was: "Whereas there were previously many small and trifling objections by which, if they were sustained against any one of many important inventions, the whole was avoided. In such cases amendments may now be made by means of a disclaimer."

Romilly, M.R., in the same case at the Rolls (14 Beav. 315), said: "It is proper they (patentees) should be allowed to correct errors in their patents by removing from the specification parts which are not material or substantial, or which they have since discovered not to be new inventions; but this power ought to be exercised with great care and discretion." There is a case reported in *Macrory's Patent Cases*, at p. 116, where Sir Richard Bethell, when Solicitor-General, allowed a patentee to enter a disclaimer, the effect of which was to enable him to claim for a combination, the original claim being for the several parts of the described invention. When afterwards he became Lord Westbury he described the words of this statute as vague and indefinite, and said: "Possibly they mean that the patent must not, by the operation of the disclaimer, be made to include or comprehend something which was not originally contained in the patent. The invention claimed may be reduced or diminished, but it must not be extended or enlarged." (*Foxwell v. Bostock*, 1864, 4 De G. J. & S. 306.)

The case of *Ralston v. Smith* (1860, 11 H. L. C. 223) shows the difficulty which the Courts had in reconciling a disclaimer which might make a patent valid which was void *ab initio*, with the prohibition against extending the exclusive right. The



judgment of Lord Chelmsford, as reported, is remarkable for its cautious vagueness, and the care which seems to have been exercised not to lay down anything approaching to a general principle.

Under the Acts of 1883 and 1907 it is not the exclusive right which must not be extended, but the invention must not be substantially larger or different.

Cases to  
illustrate.

The case of *Dellwick's Patent* (1898, 15 R. P. C. 682) is instructive on this point. The inventor had originally described improvements in incandescent mantles for gas lighting, in which he enumerated a long list of metallic oxides which might be used to coat the mantles, and he described an elaborate theory of the behaviour of the mantles so treated, attributing it partly to the relative conducting powers of the mantle and the coating. His claim was: "The herein-described process of treating incandescents which are non-conductors of heat, such as the oxides of calcium, magnesium, aluminium, zirconium, and similar metals of this group, or compounds of these oxides, by covering or saturating them with a coating of refractory oxide of a heavy metal or metals."

The proposed amendments were to cut out all the description of the theory, the words "non-conductors of heat" and "similar metals of this group" in the claim, and to substitute for the words "with a coating of refractory oxide of a heavy metal or metals" the words "with a coating of chromium oxide," chromium oxide being one of the coatings in the list set out in the body of the specification.

Sir Robert Finlay, S.-G., held that the amendments were permissible, since an inventor is not bound to set forth an accurate theory, nor, indeed, any theory of the behaviour of his invention, and said: "It is perfectly true in this case that the patentee desires to throw a very large part of his cargo overboard, but I confess that I think for all that it is a case of disclaimer. It may be a case of disclaiming six-sevenths, or nine-tenths, or ninety-nine hundredths of what was contained in the original patent, but for all that he is not introducing anything new; he is merely retaining one of the elements

which formed the subject of the alleged invention contained in the original patent.”

But where a claim is for a combination, an alteration of that combination will mean that the claim will be for a different invention. Nature of combination unalterable.

The case of *Parkinson's Patent* (1896, 13 R. P. C. 509) is an instructive example of a disclaimer which would have made the claim not wider, but different from what it originally was. The claim originally was for the combination of A. and B. to operate on a new principle. It was found that the principle and the combination of A. and B. for effecting it were well known. The proposed amendment was to disclaim the mere combination of A. and B., and to claim A. and B. in combination with the other portions of the apparatus. Sir R. Finlay, S.-G., said: “To my mind the specification as amended, if this application were allowed, would be for something substantially different from what the patent originally claimed . . . the patentee claims the combination of the sieve with the side deposit surfaces, tapering or not tapering. . . . What would be the effect of the patent as amended? It would be really for a new combination: for the combination of the sieve and side deposit surfaces with the other parts of the apparatus indicated by the words in the proposed amendment: ‘Other portions of the apparatus substantially in the manner hereinbefore described, so as practically to free the escaping air from particles of dust.’ That may or may not be a good claim, but to my mind it is perfectly impossible to say that it is not substantially different from the naked claim . . . for the combination of the sieve with side deposit surfaces.”

Where there are in the original specification two claims for A. and for B. respectively, it is not permissible to amend by substituting for these claims one for A. and B. in combination, since the combination is a different invention. The case of *Kelly v. Heathman* (1890, 45 C. D. 256; 7 R. P. C. 343 (b)), which seems to have been at one time considered an authority to the contrary, was explained by Sir E. Carson, S.-G., in his

(b) And see *Bateman and Moore's Patent*, 1854, Macr. P. C. 116.

decision in *Hattersley and Hodgson's Patent* (1904, 21 R. P. C. 233). Mr. Justice North had held in the former case that there was no objection in that particular case to the amendment, but he so decided upon the ground that even before amendment there was a claim to a combination, though not happily expressed, and that the amendment amounted to nothing more than a correction or explanation, which is, of course, admissible.

In *Johnson's Patent* (1896, 13 R. P. C. 659), Sir R. Webster said: "On previous occasions I have expressed my view that the words of sub-sect. 1 of sect. 18 of the Act of 1883, 'by way of disclaimer, correction, or explanation,' were meant to refer to disclaiming something which was originally wrongly inserted, or to explaining something which requires explanation, having regard to the statement made in the first instance by the patentee. It must be remembered that the whole of this sub-section is subject to the words 'not substantially larger than or substantially different from the invention claimed. . . .'" Disclaimer is not to be used solely for the mere purpose of turning an insufficient description into a sufficient description. Of course, it is to be used for the purpose of turning an ambiguous specification into a clear specification, but not for the purpose of turning an insufficient description into a sufficient, especially if the amendment introduces subsequent knowledge."

Explanation may only be of original statements.

Not insertion of subsequent discovery.

Therefore "correction or explanation" does not include amendment by the insertion of subsequently ascertained knowledge; it is only allowed for the purpose of explaining more clearly the meaning of the patentee at the time when he patented his invention, that is, to correct and explain the enunciation of his invention as he intended originally to give it.

In the case of *Beck and Justice's Patent* (Griff. L. O. C. 10), the specification described "improvements in nozzles for the escape of steam or gases under pressure." The proposed amendment included directions for modifying the invention for use in gas engines. Gas engines were not mentioned in the original specification, and it was admitted that the amendment was

rendered necessary by the development of them, which had since taken place. The amendment was not allowed.

Sir R. Webster, A.-G., said: "My idea of the function of an explanation within sect. 18 is to explain more clearly what is necessary to understand the meaning of the patentee at the time he patented the invention. I do not think it is intended that he should put in subsequently ascertained knowledge."

Where no reason was shown by the patentee for requiring the amendment, in the case of a specification which on the face of it was sufficient without it, the law officer refused the application (c).

Sufficient reason must be given.

In *Hampton and Facer's Patent* (Griff. L. O. C. 15), the applicants desired to insert a statement in their specification imputing disadvantage to former patents. The Solicitor-General refused the application on the ground that he was not at all satisfied that the faults imputed to those patents did in reality exist.

An amendment which in effect amounts practically to the re-writing of the whole specification will not be allowed (d), nor an amendment which abandons the original substantive claim and limits the invention to a subordinate and unimportant alternative (e).

Re-writing of specification not allowable.

The law officer will allow an amendment which upon a fair interpretation tends to limit the scope of the original specification, and where a specification is clearly capable of two constructions the patentee by amendment can limit himself to one of them (f).

Under this section there is no power either to amend the title or the provisional specification. When a complete specification is filed with a narrower title than the provisional, the proper course for the Comptroller-General to adopt is to amend the

No power to amend title or provisional.

(c) *Morgan's Patent*, Griff. L. O. C. 17; *Nordenfelt's Patent*, Griff. L. O. C. 18.

(d) *Nairn's Patent*, 1891, 8 R. P. C. 444; *Garnett's Application*, 1899, 16 R. P. C. 154; *Crist's Application*, 1903, 20 R. P. C. 475 (see p. 165, ante).

(e) *Heath and Frost's Patent*, Griff. P. C. 310; *Crist's Application*, 1903, 20 R. P. C. 475.

(f) *Rylands' Patent*, 1888, 5 R. P. C. 665; see also other instances, *Mills' Patent*, 1850, 10 C. B. 379; *Higgins' Patent*, 1859, 8 H. L. C. 550.

title of the provisional (such amendment, however, must be in the nature of excision only) or to give the applicant liberty to insert a disclaiming clause in the complete specification and assimilate the title of the complete to that of the provisional (*g*).

THE PRACTICE ON AN APPLICATION FOR LEAVE TO AMEND.

Practice reasons.

Under the Act of Will. IV., when a patentee sought to disclaim, it was necessary that he should give his reasons for the proposed disclaimer, but he was not compelled to state reasons for a proposed alteration. Under the present statute he must give his reasons for any amendment, whatever the form of the amendment may be. The reasons will, of course, vary with each case—*e.g.*, that the patentee has discovered that parts of the invention claimed are not new, or are useless, or that certain phrases and terms as originally used need explanation, or that parts of the machine or process as described will not work.

The reasons for an amendment form no part of the amendment itself (*h*).

If the reasons do not disclose any ground on which the amendment ought to be allowed, the application will be dismissed (*i*); but the amendment will not be refused merely on the ground that the reasons given for it are not conclusively sufficient (*k*).

Sir E. Clarke, S.-G., in *Lang's Patent* (1890, 7 R. P. C. at p. 471), summed up the jurisdiction of the law officer under the 18th section of the Act of 1883 in the following words: "I do not doubt that I have power to allow any amendments, whether of the letterpress of the specification, or of the drawings, or by way of adding drawings, if drawings have not in the first instance been appended to the specification, necessary to define the disclaimer which it is desired to make."

No prohibition to law officer.

Prohibition will not lie to the law officer in the exercise of

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| <p>(<i>g</i>) <i>Dart's Patent</i>, Griff. P. C. 307.</p> <p>(<i>h</i>) <i>Cannington v. Nuttall</i>, 1871, L. R. 5 H. L. 205, 227, 228.</p> | <p>(<i>i</i>) <i>Nordenfjell's Patent</i>, Griff. L. O. C. 18.</p> <p>(<i>k</i>) <i>Ashworth's Patent</i>, Griff. L. O. C. 6.</p> |
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his discretion under this section (*Van Gelder's Patent*, 1889, 6 R. P. C. 22).

By sub-sect. 2 of sect. 21 “*the request, and the nature of such proposed amendment, shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment.*”

In *Ashworth's Patent* (Griff. L. O. C. 7), Sir H. Davey, S.-G., said: “The section (18 (2) of the Act of 1883) does not in terms say the reasons are to be advertised, but probably the reasons are a part of the request.” It is not the practice, however, to advertise the reasons. The practice is regulated by rules 60 to 67 of 1908.

The section says that “any person” may oppose. This is, of course, limited in exactly the same manner as an opposition entered to a grant (see p. 156). The opponent.

(3) “*Where such a notice is given the Comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case.*”

The Comptroller exercises the power to impose conditions given in express terms to the law officer under sub-sect. 5 (l). Power of Comptroller to impose conditions.

But in the case of applications for leave to amend patents granted since the Act of 1883 conditions will not be imposed except under special circumstances.

In *Allen's Patent* (1887, Griff. L. O. C. 3), application was made to amend a specification dated 1885. The opponents asked that a condition should be imposed that Allen should not bring any action or bring any proceedings whatever against them or any of their customers, &c., in respect of any articles which had been sold or contracted to be sold prior to the amendment. Sir E. Clarke, S.-G., having consulted Sir R. Webster, A.-G., gave the following decision: “I have carefully considered the question whether, in allowing this amendment, I ought to impose any condition as to the bringing of actions for infringement prior to the date of the amendment. This appears to be the first case in which that question has come up

(l) *Pietschmann's Patent*, Griff. P. C. 314; *Andrew v. Crossley*, 1892, 9 R. P. C. at p. 168.

for decision in respect of patents issued since the passing of the Act of 1883. In several cases which came before the law officer shortly after the passing of this Act I find that they imposed, as a condition of the amendment, that no action should be brought for infringements prior to 1st January, 1884. An examination of these cases, as reported in Griffin's P. C., shows that the reason for their so doing, and in each case (whatever its date) referring back to the 1st January, 1884, was, that they doubted whether sect. 20 would avail to protect persons who were sued for infringements alleged to have been committed prior to the passing of the Act. No such question arises here. This patent was dated 20th October, 1885, and if after amendment an action is brought for a prior infringement, it is clear that the Court will have to decide whether the matters referred to in sect. 20 (sect. 23 of the Act of 1907) have been established to its satisfaction. I do not think that I am entitled to substitute my own opinion for that of the Court. Again, I do not think that I could in strictness attach this as a condition to the allowance of this amendment. I could only require an undertaking from the applicant, as was required by Sir H. James, A.-G., in the *Westinghouse Case*. If he were to refuse to give such an undertaking, I do not feel myself entitled by that refusal to deprive him of the opportunity of protecting the real invention described in his specification by a disclaimer of that which I am satisfied he does not mean to claim. I therefore do not think I can properly impose this condition" (m).

In *Ashworth's Patent* (Griff. L. O. C. 6), Sir H. Davey, S.-G., said: "If I saw, or if there was any evidence before me, that the patent had been used for the purpose of endeavouring to obtain a monopoly larger than that which the specification as amended claims, I should consider that a special circumstance. If, for example, the patentees had been threatening persons and endeavouring to prevent persons from making or selling wire hardened and tempered in a mode different from that which is claimed, I should consider that a special circum-

(m) Followed in *Pitt's Patent*, 1901, 18 R. P. C. 478.

stance, and under those circumstances, as far as I am personally concerned, I should impose the condition that no action should be brought for anything done at any time before the amendment."

The nature of the conditions imposed by the Court will be discussed at p. 187. They are the terms which the Comptroller and the law officer will also impose in suitable cases.

The specification is considered to be amended from the moment that leave to amend is given, and the conditions imposed, if any, agreed to (*n*); no written undertaking by the applicant is necessary, although it is the practice in the Patent Office to require some such undertaking as conclusive evidence of the agreement (*o*), since the written assent precludes the patentee from alleging that he did not accept the condition (*p*).

The Comptroller may take evidence viva voce in the same manner as on an opposition. Evidence and costs.

The power of the Comptroller to grant costs is expressly conferred by the 39th section, that of the law officer by sect. 40.

In *Ashworth's Patent* (Griff. L. O. C. 6), the law officer refused to grant costs to the applicant although successful, on the ground that the specification was so loosely framed, it was natural that rival traders should oppose an application for leave to amend.

In *Lake's Patent* (Griff. L. O. C. 16), which was an unopposed application for leave to amend, the applicants appealed to the law officer against the decision of the Comptroller-General. Sir R. Webster, A.-G., allowed the appeal on the ground that a doubtful amendment ought to be allowed, but refused to give costs against the Comptroller. "In fact," he said, "I may say that I think it would be better, as a matter of practice, that in the absence of very special circumstances the Comptroller-General should neither give nor receive costs."

In *Morgan's Patent* (Griff. L. O. C. 17), which was a successful appeal to the law officer from the decision of the Comptroller-General, application was made for the return of

(*n*) *Andrew v. Crossley*, 1892, 9 R. P. C. 165.

(*p*) *Ibid.* at p. 169; see also *Re Berdan*, 1875, L. R. 20 Eq. 346.

(*o*) *Ibid.* at p. 168.



the stamp on the notice of appeal. Sir R. Webster, A.-G., refused this application on the ground that he considered the case to be one in which the Comptroller-General was quite right in declining to allow the amendment in the first instance and to leave it to the law officer.

Leave to  
amend con-  
clusive.

By sub-sect. 7, corresponding to sub-sect. 9 of sect. 18 of the Act of 1883, "*leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud (q); and the amendment shall be advertised in the prescribed manner, and shall in all Courts and for all purposes be deemed to form part of the specification.*"

The result of this enactment is that the amended specification stands in the place of the old specification, and its validity must be determined in the same way and on the same footing as though it were the original specification.

Until the decision of the House of Lords in *Moser v. Marsden* (1896, 13 P. O. R. 24) there had been considerable doubt as to the effect of this enactment, and numerous cases had been decided upon the question of whether, when a specification had been amended so as to include in the amended portion something that was itself invalid, the amendment only or the whole patent would be invalid (*r*). These cases are no longer of importance, and until further enactment the law on the point is definitely settled.

Lord Watson said (at p. 31): "In my opinion, the very object of the Act of 1883 was to make an amended claim, when admitted by the proper authorities, a complete substitute, to all effects and purposes, for the claim originally lodged by the patentee. The validity of the amended claim must therefore be determined in the same way, and on the same footing, as if it had formed part of the original specification; and the claim as it stood before amendment cannot be competently referred to, except as an aid in the construction of its language after amendment."

(q) See *In re Berdan's Patent*, 1875, L. R. 20 Eq. 346; 44 L. J. Ch. 544.

(r) See the 3rd edition of this

book, and *Foxwell v. Bostock*, 1864, 4 De G. J. & S. 298; *Gaulard and Gibbs*, 1890, 7 R. P. C. 367; *Van Gelder's Patent*, 1889, 6 R. P. C. 22.

In *Hattersley v. Hodgson* (1906, 23 R. P. C. 192), the House of Lords looked at the portions of the specification which had been deleted by amendment to assist them in construing the remaining portions. No formal pronouncement to this effect appears in the report, but the general consensus of opinion is to the effect that the action of the law lords has now established the practice on this point, and that a judgment in the Court below in another case (s) and in the Court of Appeal in the same case (t), in which it was decided that the deleted portions might not be looked at for the purpose of construing the remaining portions, are virtually overruled.

Use of deleted portions in construction.

In *Cropper v. Smith* (1884, 1 R. P. C. 254; L. R. 28 C. D. 148) (u), the Comptroller having declined leave to amend a specification by reason of the 10th sub-section of sect. 18 on the ground that an appeal was pending to the House of Lords from a decision of the Court of Appeal, declaring the patent in question invalid, and that such appeal was "an action for infringement or other legal proceeding," application was made to the Court under sect. 19. Chitty, J., held that the words "other legal proceedings" applied to a petition for revocation, and that the words "action for infringement" referred to an action before judgment, and consequently that the appeal to the House of Lords did not deprive the Comptroller of the power of amending the specification under sect. 18.

In *Brooks v. Lycett's Saddle and Motor Co.* (1904, 21 R. P. C. 651), notice of trial in an action for infringement had been given. An order was obtained for the action to stand over generally, with liberty to either party to restore, in order for a settlement to be arrived at. The negotiations proved abortive, but nothing more was done for two years, when the plaintiffs applied to the Comptroller for leave to amend their specification under sect. 18, which leave was granted. The defendants afterwards applied to restore the infringement action to the list. On the trial of the action it was contended that this amendment was invalid, as the action had been

(s) *Jandus Arc Lamp Co. v. Arc Lamp Co.*, 1905, 22 R. P. C. at p. 290.

(t) 1904, 21 R. P. C. at p. 524.

(u) See also *Lawrence v. Perry*, 1885, 2 R. P. C. at p. 188.

“pending” at the time. Mr. Justice Farwell decided that this was so, and allowed the action to stand over with leave to the defendants to apply, under sect. 19.

In *Codd v. Bratby* (1884, 1 R. P. C. 209), liberty to amend under sect. 19 was given upon terms by the Court after a previous refusal by the Comptroller under sect. 18, but the applicant was ordered to pay the costs of the application to the Comptroller.

Where the application for leave to amend has been made under sect. 18 the subsequent institution of legal proceedings does not suspend the application pending before the Comptroller (x).

When legal proceedings are pending.

(8) “*This section shall not apply when and so long as any action for infringement or proceeding before the Court for the revocation of a patent is pending*” (corresponding to sub-sect. 10 of sect. 18.)

Power of Court to amend.

22. “*In any action for infringement of a patent or proceedings before a Court for the revocation of a patent the Court may by order allow the patentee to amend his specification by way of disclaimer in such manner, and subject to such terms as to costs advertisement or otherwise, as the Court may think fit :*

“*Provided that no amendment shall be so allowed that would make the specification, as amended, claim an invention substantially larger than, or substantially different from, the invention claimed by the specification as it stood before the amendment, and where an application for such an order is made to the Court notice of the application shall be given to the Comptroller, and the Comptroller shall have the right to appear and be heard, and shall appear if so directed by the Court.*”

Different from power under Act of 1883.

This section introduces a new procedure. Under sect. 19 of the Act of 1883 the patentee could apply to the Court for leave to apply at the Patent Office for leave to amend by way of disclaimer. The Court is now given power to amend, and the procedure at the Patent Office is abolished.

The practice under this section is regulated by Order LIII<sub>A</sub>, rule 23, of the Rules of the Supreme Court (Appendix). The

(x) *Woolfe v. The Automatic Picture Gallery Co.*, 1903, 20 R. P. C. 177.

application must be advertised, and persons desiring to oppose are entitled to be heard. The Comptroller must be served with notice, and may be heard. The reason for this procedure is, that, although disclaimers only are allowable, it sometimes occurs that an amendment which in form is a disclaimer is in effect an alteration in the nature of the invention claimed (y). And it is to be noticed that while an action is pending the amendments made with the sanction of the Court are limited to disclaimer. This is no mere slip in the wording of the Act, which is strictly applied, and amendment by way of correction or explanation is not allowed (z).

Disclaimer  
only.

The section gives an absolute discretion to the Court or judge in imposing conditions upon which leave to amend will be granted, and the Court of Appeal "will not interfere with the exercise of that discretion unless they can clearly come to the opinion that in their view that discretion was exercised absolutely wrongly" (a).

Power to  
impose  
conditions.

In *Bray v. Gardner* (1887, 4 R. P. C. at p. 44), Lord Justice Lindley said: "I do not understand that there is any form of order which is invariably to be followed in all cases when application is made under sect. 19. It appears to me that whenever leave is given to amend under sect. 19 of this Act care ought to be taken that no injustice is done to the defendant by reason of the amendment, if amendment is made, or if leave to apply for it is granted. Adequate protection may be given to the defendant in various cases in various forms."

The order made in *The Ludington Cigarette Machine Co., Ltd. v. Baron Cigarette Machine Co., Ltd.* (1900, 17 R. P. C. at p. 746), and supported by the House of Lords, has, however, often been followed (b).

(y) *E.g., Lane Fox v. The Kensington, &c., Electric Lighting Co.*, 1892, 9 R. P. C. at p. 419; *Alsop's Patent*, 1907, 24 R. P. C. 684.

1887, 4 R. P. C. at p. 42; *Lang v. Whitecross Wire and Iron Co.*, 1890, 6 R. P. C. at p. 574; 7 R. P. C. 389; *Ludington Cigarette Machine Co. v. Baron Cigarette Machine Co.*, 1900, 17 R. P. C. at p. 747.

(z) *Owen's Patent*, 1898, 15 R. P. C. 755.

(b) See *Alsop's Patent*, 1906, 23 R. P. C. 79.

(a) Per Lord Esher, M.R., in *Allen v. Doulton*, 1887, 4 R. P. C. at p. 383; see also *Bray v. Gardner*,

In *Corrigal v. Armstrong, Whitworth & Co.* (1903, 20 R. P. C. at p. 524), the order was drawn up as follows: "The plaintiff by his counsel disclaiming any relief in respect of anything done by the defendants prior to the amendment hereinafter ordered, this Court doth order that the plaintiff be at liberty to apply at the Patent Office for leave to amend the specification No.        of        by way of disclaimer, and after such disclaimer to amend the statement of claim and the particulars of breaches within fourteen days. And it is ordered that the defendants do have liberty, if so advised, to put in an amended defence and particulars of objections within fourteen days from the delivery of the amended statement of claim. And it is ordered that the costs of this application and the costs of and occasioned by the said amendment be the defendants' costs in any event. And it is ordered that all further proceedings in this action be stayed until the amendment of the plaintiff's specification is allowed or until further order."

In *Chatwood's Patent* (1899, 16 R. P. C. at p. 373), the Court followed the order made in *The Haslam Foundry Co. v. Goodfellow* (1888, L. R. 37 C. D. 118; 5 R. P. C. 28). In that case the pleadings had been delivered, and nothing remained to be done but to prepare the evidence for trial, when the plaintiffs asked for leave to apply to amend. The application was granted on the following terms:—"The plaintiffs to pay, in any event, the costs of the application, and the costs of the action up to and occasioned by the disclaimer, except only so far as the proceedings in the action might be utilised for the purpose of the trial. The plaintiffs and defendants to be allowed to make the necessary amendments in the pleadings after disclaimer. The plaintiffs to undertake forthwith to amend their pleadings in accordance with the amendment, or to consent to the action being dismissed with costs."

Statutory  
consequence  
of amendment  
in respect of  
damages.

The condition which prevents the patentee from seeking relief in respect of acts done prior to the amendment will not invariably be followed. It is to be remembered that the public are afforded considerable protection by sect. 23 (corresponding to sect. 20 of the Act of 1883):—

*“Where an amendment of a specification by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction, or explanation, unless the patentee establishes to the satisfaction of the Court that his original claim was framed in good faith and with reasonable skill and knowledge.”*

In *Geipel's Patent* (1903, 20 R. P. C. 545) (a petition for revocation) the patent was held bad because one of the methods illustrated for carrying the invention into effect was found to be unworkable, and leave was given to apply to amend by disclaiming this portion. The petitioner had made use of the useful portion of the invention. Leave was also given to apply to amend by striking out a portion which rendered the patent bad for disconformity. Buckley, J., in considering this state of affairs, said: “If the man whom I have, in the sense in which I have expressed the word, called an infringer, has availed himself of that part of the patent which will by disclaimer become good, is it fair, as between a person who will become the patentee and that infringer, that he should be allowed to go on and sell goods made in infringement of that which is going to be, I suppose, hereafter a valid patent? If he has availed himself . . . of the other parts of the patent, and the original claim was framed in good faith and with reasonable skill and knowledge, . . . it seems to me that it is fair that there should be room to restrain him, or those who are dealing with his goods, from disposing of the goods thus made”; and the learned judge left the patentee free to bring actions, subject to the liability to failure if at the trial of such actions it could be shown that the original specification was not framed in good faith and with reasonable skill and knowledge (c).

As factor in  
imposition of  
terms.

In *Armstrong's Patent* (1896, 13 R. P. C. 501), leave to apply to amend was refused on the ground that there would be nothing left to support a patent after the proposed amendment should have been made. The Court of Appeal (1897, 14

(c) Followed in *Klaber's Patent*, 1908, 25 R. P. C. at p. 334 (under the Act of 1907).

R. P. C. 747) refused to interfere with the judge's discretion, and, moreover, agreed with his view of the matter.

Liberty to amend under sect. 22 will not be given after judgment (*d*), since the patentee is then free to act under sect. 21.

In *Hopkinson v. St. James and Pall Mall Electric Light Co.* (1893, 10 R. P. C. at p. 62), judgment was given for plaintiff with the usual relief. The defendants referred to sect. 20 of the Act of 1883, and asked that the account of profits should be kept only from the date of the amended specification. Romer, J., refused the application, and said that "he thought it was clear from the evidence which was before him that the plaintiff's original claim was framed in good faith and with reasonable skill and knowledge." The relief afforded by the Act is seldom granted, and the onus of proof of the circumstances under which the original specification was framed is entirely on the shoulders of the patentee (*e*).

In *Kane and Pattison v. Boyle* (1901, 18 R. P. C. at p. 338), Byrne, J., said: "I think that what the patentee has to establish is that in his original specification he meant and intended to claim that which he had invented, and no more. . . . If the inventor has knowingly sought to include a field of subject matter beyond that which he knows he has invented, I think he cannot be regarded as having framed his claim in good faith within the meaning of this particular section, and I am of opinion, in the present case, that he meant and intended that which his original specification says, namely, to make a larger claim than that which he knew he was entitled to; and, secondly, I think he has failed to establish, to my satisfaction, that his original claim was framed in good faith and with reasonable skill and knowledge within the meaning of that expression in the section. I believe that the power given by this section of the Act to award further damages has been exercised in one case only in the immense number of cases in which, since the passing of this section, amendments must

(*d*) *Lawrence v. Perry*, 1885, 2 *Machinery Co. v. A. Fussel & Co.*, R. P. C. 180; Griff. P. C. at p. 148. 1908, 25 R. P. C. 368.

(*e*) See *The British United Shoe*

They reference be made to unamended Spec. or to  
reasons for amendment. *Auster v Perfecta Note*  
XLI R.P.C. 483.



have been allowed and actions have been brought upon the amended patents.”

The effect of sects. 18—20 of the Act of 1883 is summed up in the judgment of A. L. Smith, J., in *Re Hall and Others* (1888, 5 R. P. C. at p. 312): “Sect. 18 gives power to a patentee, when he finds out the blunder in the specification himself, to seek leave to amend his specification by way of disclaimer, correction, or explanation, and he can go *proprio motu* to the Comptroller, and say, ‘I want to amend the blunder I have got in my specification as regards disclaimer, correction, or explanation.’ Then there are a series of sub-sections showing what the Comptroller is to do; how notice is to be given; what has to be done, and how other parties may come in and object; and the last sub-section, it seems to me, is most natural: ‘The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.’ That means this, that where a patent is in litigation he should not go behind the back of the other party and get these amendments and set himself quite right. . . . What would happen if that had remained there? After litigation had been commenced, if there had been no section 19, the patentee, as soon as the writ was issued, would be fixed, no matter what small technical blunder there might be in his specification. But what the legislature says is this—and I read sect. 19 as a proviso to sect. 18—‘Provided always that a judge or the Court may give liberty,’ but only liberty . . . to the patentee to apply at the Patent Office for leave to amend his specification by way of disclaimer.”

## CHAPTER X.

## DEVOLUTION, ASSIGNMENT AND LICENSES.

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.

Devolution on death.

**Devolution.**—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. 43 of the Act provides that—“(1) if the person claiming to be inventor 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, means his legal personal representative (a).

Death of co-grantee.

Prior to the Act of 1907, if one of two co-patentees died, his interest passed to the survivor, unless their relations had been modified by contract. By sect. 37, however, it is provided as follows as regards patents granted to two or more persons jointly after January 1, 1908:—“Where, after the commencement of this Act, a patent is granted to two or more persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a license without their consent, and if any such

As to grants after January, 1908.

(a) See *Edmund's Patent*, Griff. P. C. 281.

person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate" (b). As regards patents granted before the Act the law will remain unchanged.

As to grants after January 1st, 1908.

Some letters patent of the Crown (not for inventions) have a limitation to heirs or heirs male; such, for instance, as patents of nobility.

If the patentee becomes bankrupt the property in the patent will pass to his receiver, trustee, or assignee in bankruptcy (c), and a patent granted to a bankrupt prior to his discharge will vest in the trustee in bankruptcy (d). 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 (e).

Bankruptcy.

Where a patentee dies intestate and leaving no heirs, his patent, together with the rest of his property, will vest in the Crown. And the same result will occur if a limited liability company be dissolved without having assigned the patent (f). An interesting question arises as to whether merger would take place, the patent franchise being re-absorbed by the Crown (g). If this were so the Crown would have no power to enforce a patent, which no longer existed as against third parties, and the monopoly would have come to an end, as is the case where a patent is surrendered under sect. 26, sub-sect. 3 (h). In any case it is essential for a purchaser of a patent from a company in liquidation to obtain an assignment from the liquidator before the company is dissolved.

Dissolution of limited company.

Merger.

The rights conferred by letters patent being of an incorporeal nature, it would appear that a patent cannot be seized by the sheriff under a writ of *fi. fa.* (i). The proper course is to apply

Not seizable by sheriff under *fi. fa.*

(b) As to the right of each joint grantee to sue for infringement, see p. 198.

215.

(c) *Hesse v. Stevenson*, 1803, 3 B. & P. 565. See also *Bloxam v. Elsee*, 9 D. & R. 215; *McAlpine v. Mangnall*, 1846, 15 L. J. C. P. 298.

(f) *In re Taylor's Agreement Trusts*, 1904, 2 Ch. 737; 21 R. P. C.

713. See also *In re Higginson and Dean*, 1899, 1 Q. B. 325.

(d) *Hesse v. Stevenson*, 1803, 3 B. & P. 565.

(g) See *In re Taylor's Agreement Trusts*, supra.

(h) See Chap. XII.

(e) *Bloxam v. Elsee*, 9 D. & R. L.P.

(i) See judgment of Farwell, J., in *British Mutoscope and Biograph*

for the appointment of a receiver with power to sell the letters patent and notify the Comptroller of the appointment and apply for the same to be registered.

#### ASSIGNMENT.

**Assignment.**      **Assignment.**—Patent rights may be transferred 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 patentee to assign the exclusive right which has been granted to him is recognised in the patent itself in the recital “. . . the said inventor (hereinafter together with his executors, administrators, and assigns, or any of them, referred to as the said patentee). . . .”

**Agreement to assign.**      An assignment must be by deed to convey the legal estate (*k*), but a parol agreement to assign will be specifically enforceable in equity. An agreement to assign will depend upon the ordinary rules relating to contract as to specific performance, and consideration, etc. It does not alter the proprietorship of a patent, but it gives the right in equity to have the proprietorship altered in law (*l*); and this is so even when the patent was not at the date of the contract actually taken out by the vendor, provided, at least, that he was then entitled to make an application for the same (*m*). The usual conditions of an equitable assignment will apply, and a legal assignee without notice may claim priority (*n*).

**Equities.**

The assignment of patent rights to a company is usually preceded by an agreement between the patentee and the promoters, by which the latter agree to procure incorporation of the future company and the execution by the company of a scheduled form of contract with the patentee, by which the

*Co. v. Horner*, 1901, 18 R. P. C. at p. 179.

(*k*) *Co. Lit.* 9 b, 172 a; *Stewart v. Casey*, 1892, L. R. 1 Ch. 113; 9 R. P. C. 9.

(*l*) Bowen, L.J., in *Stewart v. Casey*, 1892, L. R. 1 Ch. at p. 116.

(*m*) *Cogent v. Gibson*, 33 Beav. 557.

(*n*) *E.g.* as in *Wapshare Tube Co., Ltd. v. Hyde Imperial Rubber Co.*, 1901, 18 R. P. C. 374, and see p. 216, post.

patentee shall agree to assign the letters patent to the company. The assignment of the patent to the company usually takes place after the payment of the purchase price.

Where the patent has not been granted at the date of the agreement to assign, a clause is inserted by which the vendor agrees to take all necessary steps to obtain it.

After an assignment by deed has been executed the assignee becomes "the patentee" within the definition of the Act, and his rights against the public, including the assignor unless specially limited by the terms of the assignment, are the same as those which the assignor had, and the latter may be restrained from infringing.

An assignee with notice of previous licenses takes subject to those licenses, otherwise he is not bound by them, and may restrain the persons purporting to manufacture under them. Consequently it is of great importance that licenses should be immediately registered, but a licensee who has an express notice of a prior equitable assignment of the patent may be restrained from using the invention by the assignee even though the registration of the assignment is subsequent to the registration of the license (o).

Notice of  
previous  
licenses.

Where an assignee of a patent covenants with the assignor for himself and his assigns that he will work the patent and pay certain royalties thereon to the assignor, a subsequent assignee with notice takes the patent subject to those covenants, as was said by Jessel, M.R., in *Werderman v. Société Générale d'Electricité* (1881, 19 C. D. at p. 252): "It is a part of the bargain that the patent shall be worked in a particular way and the profits be disposed of in a particular way, and no one taking with notice of that bargain can avoid the liability." It must be remembered that in such a case there is no privity of contract between the assignor and the second assignee, but the rights of the assignor are analogous to a vendor's lien, and the second assignee cannot hold the rights which he has acquired without also fulfilling the obligations which may be said to attach to those rights, and consequently the terms of the original assign-

(o) *Hassall v. Wright*, 1870, L. R. 10 Eq. 509; *The New Ixion Tyre* and *Cycle Co. v. Spilsbury*, 1898, 2 Ch. 484.

ment become a matter of great importance. In *Dansk Rekybriffel Syndikat Aktieselskab v. Snell* (1908, 2 Ch. at p. 136), Neville, J., said: "The obligation to fulfil the terms of the agreement, being with regard to the assignees not personal, but attached to the property which they acquired with notice of the terms upon which it was held by their assignor, disables them from holding the property without fulfilling the terms. It appears to me that such an interest of the vendor, if not properly described as a vendor's lien, is closely analogous to it. The question involved is whether, upon the true construction of the original assignment, it was intended that the vendor should retain a charge upon the property, or that he should part with the property completely, looking solely to the personal liability of the purchaser to pay the consideration" (p).

Covenants not implied to pay renewal fees.

Unless it be specially so provided the assignment does not *per se* cast on either party the obligation of maintaining the patent by paying the fees (q).

Nor to work invention.

And by analogy there is no implied obligation to work the patented invention in this country to an extent necessary to avoid revocation under sect. 27 of the Act of 1907. Express covenants should be entered into for this purpose (r).

Assignment of part of patent.

There may be an assignment of a distinct part of a patent right, but now that patents are not issued for more than one invention this form is seldom required. An assignee of a part is entitled to sue for an infringement without joining the persons who are interested in the remaining part or parts (s).

Mortgagee cannot sue.

A mortgagee, although an assignee, is not entitled to sue infringers. This right remains vested in the mortgagor as the "patentee" (t).

Rights of co-patentees inter se.

Where a grant of letters patent has been made to two or more persons, or has been assigned by the original patentee to two or more persons, each of the co-grantees or co-assignees has the right to use the invention for his own profit without

(p) See also *Bagot Pneumatic Tyre Co. v. Clipper Pneumatic Tyre Co.*, 1901, 1 Ch. 157.

(q) *Re Railway and Electrical Appliance Co.*, 1888, L. R. 38 C. D. 597.

(r) See Appendix.

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

(t) *Van Gelder, Apsimon & Co. v. Sowerby Bridge Co.*, 1890, 7 R. P. C. 208

incurring the liability to account to his co-owners for the profits which he may make. In *Steers v. Rogers* (1893, 10 R. P. C. at p. 251), Lord Herschell, in delivering the judgment of the House of Lords, said: "Letters patent do not give the patentee any right to use the invention; they do not confer a right to manufacture according to his invention. That is a right which he would have equally effectually if there were no letters patent at all; only in that case all the world would equally have the right. What the letters patent confer is the right to exclude others from manufacturing in a particular way, and using a particular invention. When that is borne in mind it appears to me impossible to hold, under these circumstances, that where there are several patentees, either of them, if he uses the patent, can be called upon by the others to pay to them a portion of the profits which he makes by that manufacture, because they are all of them entitled, or perhaps any of them entitled, to prevent the rest of the world from using it."

The rights of co-owners *inter se*, prior to the Act of 1907, were summed up by Lindley, L.J., in his book on Partnership (u): "In the case of a patent belonging to several persons in common, each co-owner can assign his share, and sue for an infringement (x); and can also work the patent himself, and give licenses to work it, and sue for royalties payable to him for its use (y); and it is now settled that he is entitled to retain for his own benefit whatever profit he may derive from the working, although it is perhaps still open to question whether he is not liable to account for what he receives in respect of the licenses" (z). But the mutual obligations of co-owners as to the grant of licenses have been placed beyond doubt by sect. 37 of the Act of 1907: "Where, after the commencement of this Act, a patent is granted to two or more

(u) 5th ed. p. 62.

(x) *Dunncliffe v. Mallett*, 1859, 7 C. B. N. S. 209; *Dent v. Turpin*, 1861, 2 J. & H. 139; 30 L. J. Ch. 495; *Sheehan v. Great Eastern Railway*, 1881, L. R. 16 Ch. D. 59, 63.

(y) *Sheehan v. Great Eastern Railway*, 1881, L. R. 16 Ch. D. 59.

(z) *Mathers v. Green*, 1865, L. R. 1 Ch. 29; *Russell's Patent*, 1857, 2 De G. & J. 130.

*persons jointly, they shall, unless otherwise specified in the patent, be treated for the purpose of the devolution of the legal interest therein as joint tenants, but, subject to any contract to the contrary, each of such persons shall be entitled to use the invention for his own profit without accounting to the others, but shall not be entitled to grant a license without their consent, and if any such person dies, his beneficial interest in the patent shall devolve on his personal representatives as part of his personal estate."*

It is to be noted that this only applies to patents granted after January 1st, 1908.

**Co-owner may sue.**

The grounds upon which one co-owner can sue for infringement of the patent without joining the other co-owners are clearly set out in the judgment of Page-Wood, V.-C., in *Dent v. Turpin* (1861, 30 L. J. Ch. 496). The law as therein expressed is that although he may sue alone, the Court will not grant a decree for further relief than that which is purely personal to himself, that is to say, he may have an injunction against the infringer, but he will only receive that portion of the damages to which the Court may think he is entitled; this would seem to show that he is only entitled to such portion of the damages as bears a relation to his interest in the patent. And it would appear that the other co-owners should be joined if possible in order that an account may be taken of the amount due to all the co-owners, without having recourse to a series of actions (a).

In *Smith v. L. & N. W. Ry. Co.* (1853, 8 El. & B. 74), it was decided that the right of co-owners to damages for infringement was a joint right, and on the death of one the survivor was entitled to recover the whole. It is submitted that the effect of sect. 37 is to overrule this decision, for a right to damages is certainly a "beneficial interest in the patent," and if this be so, the right to the share of the amount recovered would accrue to the personal representatives of the deceased.

**Partnership.**

Where a sole patentee worked the patent in partnership with another for some years, during which time they were extensively advertised as joint patentees, it was held that the

(a) See *Bergmann v. Macmillan*, 1881, 17 Ch. D. 423.



partner of the sole patentee thereby acquired such an interest in the patent as to enable him to work it independently after the partnership had expired (*b*), but this would not be the case if it were a term of the partnership that the patent rights in the invention should belong exclusively to one of them (*c*).

Where a grant is made to more than one person it is usual to divide the interests, as the power which each grantee has to work the invention himself without accounting is highly inconvenient. Provision may thus be made for accounts, granting licenses, survivorship, and many other matters.

A patent may be vested in trustees, who may sue for infringement in their own names, subject to the power of the Court to order the cestuis que trust to be joined (*d*).

**Covenants for improvements and in restraint of trade.**—An agreement by the vendor of a patent to assign to the purchaser all patent rights that he may subsequently acquire of a like nature to the patent then sold is not contrary to public policy and will be upheld. And a covenant by the vendor not to make or sell the invention at all, nor the product obtained by the invented process, even though obtained in a different manner, is good. As Jessel, M.R., said in *Printing and Numerical Registering Co. v. Sampson* (1875, L. R. 19 Eq. at p. 464), the purchasers are entitled to say: "We cannot buy on any other terms because otherwise we are exposed to the instantaneous, or almost instantaneous, competition with the inventor with the benefit of his previous experience." As in all contracts which involve the restraint of trade, their validity depends upon whether they extend further than is necessary to protect the reasonable rights of the other party under the particular circumstances in question (*e*).

Covenants for improvements and in restraint of trade.

Covenants for the assignment of future improvements require to be very carefully drawn. The ambit of the assignee's rights depends entirely upon the construction of the contract (*f*).

Should be carefully drawn.

(*b*) *Kenny's Patent Button-Holing Co. v. Somerrell*, 1878, 38 L. T. 878; 26 W. R. 786.

(*c*) See *Armann v. Lund*, 1874, L. R. 18 Eq. at p. 336.

(*d*) R.S.C. Order XVI., rule 8.

(*e*) See *Nordenfelt v. The Maxim Nordenfelt, &c., Co.*, 1894, A. C. 535; *Mouchel v. Cubitt & Co.*, 1907, 24 R. P. C. 194.

(*f*) *Valveless Gas Engine Co. v. Day*, 1899, 16 R. P. C. 97.

In some cases it may be that only such improvements as would involve an infringement of the original patent may be intended; in others it may be desired to secure for the assignee any further inventions of the assignor relating to the particular art. As a rule, if the term "improvements" only is used, it is submitted that what is meant is such an improvement as would be an infringement of the original patent (*g*). This view is supported by the use of the word in sect. 19, subsect. 1, of the Act of 1907, which deals with "patents of addition."

**Estoppel.**

**Estoppel.**—Having assigned a patent, the original patentee cannot manufacture the patented article; should he do so, and an action for infringement be brought against him by his assignee, he may not set up the defence that the patent is invalid; he is estopped by his deed (*h*), 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* (1884, L. R. 26 Ch. D. 700; 2 R. P. C. 17), letters patent for improvements in lace machines were granted to H. in 1873, 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, s. 50, sub-s. 5.) It is probable that there is estoppel by record between the Crown and the grantee of letters patent (*i*), but this would only be against the subject, since no estoppel operates against the Crown.

(*g*) *Davies v. Curtis & Harvey, Ltd.*, 1903, 20 R. P. C. 561. See *Linotype & Machinery, Ltd. v. Hopkins*, 1908, 25 R. P. C. 349, 665.

(*h*) *Bowman v. Taylor*, 1834, 2

A. & E. 278; *Franklin Hocking v. Hocking*, 1889, 6 R. P. C. 69; and see 1 W. P. C. 290—295.

(*i*) Per Fry, L. J., L. R. 26 Ch. D.

at p. 712.

Upon assignment of a patent without a warranty the assignee may not, in an action upon the contract for the purchase price, set up the invalidity of the patent as a defence, since there is no implied warranty of validity (*k*); so that the question to be decided in each case is: "Did the defendants buy a good and indefeasible patent right, or was the contract merely to place the defendants in the same situation as the plaintiff was in with reference to the alleged patent?" (*l*). An express covenant for the validity of the patent will, of course, remove the estoppel, and the assignee may rely on this in answer to an action for the purchase-money (*m*).

Warranty of validity.

Where the plaintiff purports to assign the exclusive right of selling certain things for the manufacture of which a patent had been obtained, there is in such case an implied warranty that the patent is a valid one, since otherwise it would be impossible to assign such exclusive right (*n*).

It may be here noted that upon the sale of an article there is no implied warranty that it is not an infringement of any existing patent (*o*), and it may from this be inferred that, in an assignment of a patent or a license under a patent, there is no implied warranty that the manufacture or sale of articles made under the patent will not infringe any other patent. On the other hand, if the assignor or licensor concealed the fact, it being within his knowledge, it is possible that the contract might be rescinded on the ground of fraud.

No implied warranty against infringement.

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 (*p*). But where the plaintiff and defendant had been partners, and had worked

(*k*) *Hall v. Conder*, 1857, 26 L. J. C. P. 138; 2 C. B. N. S. 22; *Smith v. Buckingham*, 1870, 21 L. T. N. S. 819; *Liardet v. Hammond Electric Light Co.*, 1883, 31 W. R. 710. 41; *Henderson v. Shiels*, 1907, 24 R. P. C. 108.

(*l*) Per Cresswell, J., in *Hall v. Conder*, 1857, 26 L. J. C. P. at p. 143 a. (*n*) *Chanter v. Leese*, 1838, 5 M. & W. 698; *Hall v. Conder*, 1857, 26 L. J. C. P. at p. 143. (*o*) *Montforts v. Marsden*, 1895, 12 R. P. C. 266.

(*m*) *E.g.* as in *Nadel v. Martin*, 1903, 20 R. P. C. 721; 23 R. P. C. 33 Beav. 374. (*p*) *Chambers v. Critchley*, 1864, 33 Beav. 374.

as such the defendant's patent, there being no deed between the plaintiff and defendant which inferred the validity of the patent, it was held that plaintiff was not estopped from denying the validity of the patent (*q*). 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 (*r*).

An assignor of a patent cannot be restrained from giving evidence in an action for infringement brought by the assignee against a third party, although such evidence should tend to prove that the patent is in fact bad (*s*). And he is at liberty to show that the ambit of the claims of the patent assigned is not as wide as the assignee alleges (*t*).

#### LICENSES.

##### Licenses.

Licenses differ from assignments, in that the patentee granting a license does not part with his whole interest, but grants merely a right to use the invention for the whole term or any portion of the whole term, that is merely a right to do that which without a license could not be done except by violating the monopoly granted to and still vested in the licensor (*u*).

##### Licensee cannot sue.

A licensee, whether under a general or an exclusive license, cannot sue infringers (*x*); the person in whom the legal interest in the patent is vested must be joined, and it is usual to insert covenants by which the licensor agrees to proceed against infringers or to allow his name to be joined.

Licenses may be voluntarily granted by the patentee, or they may be compulsory under an order of the Court (*y*). In this chapter we shall deal with voluntary licenses only.

An exclusive license grants the sole right to put the invention into practice, and the licensor covenants not to grant licenses

(*q*) *Armann v. Lund*, 1874, L. R. 18 Eq. 330; 22 W. R. 789.

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

(*s*) *London and Leicester Hosiery Co. v. Griswold*, 1886, 3 R. P. C. 251.

(*t*) *Hocking v. Hocking*, 1889, 6 R. P. C. 69.

(*u*) *Heap v. Hartley*, 1889, 6 R. P. C. at p. 499.

(*x*) *Heap v. Hartley*, 1889, 6 R. P. C. 495.

(*y*) See Chap. XII.

to any other person during the continuation of the license ; and unless he reserves to himself a right to manufacture he may be restrained from so doing by his licensee.

A general license leaves to the licensor the power to grant other licenses in respect of the same invention.

A limited license may contain restrictions as to time, place, or manner of use of the invention.

It would appear from the words of the prohibition contained in the grant—"without the consent, license or agreement of the said patentee in writing under his hand and seal"—that licenses should be under seal ; but at the end of the patent occur the words, "but nothing herein contained shall prevent the granting of licenses in such manner and for such consideration as they may by law be granted." Therefore, provided it can be proved that there is an agreement to grant a license, no matter how made, it will be acted upon, and neither party can be excused on the ground that it is not under seal (z).

Form of license.

An agreement to grant a license for a fixed term may be specifically enforced (a). But an agreement to grant a license at will could not be enforced.

A mere license in writing does not require a stamp, but if it amounts to an agreement to pay by royalties or otherwise a stamp is required (b). A license by deed requires a ten shilling stamp and an ad valorem stamp on the consideration money, or the minimum royalty prescribed, and this is the case even though the license is to work the invention abroad under a foreign patent (c).

Stamps.

By the prohibition the public are to refrain from making, using or vending. These terms require examination, as they have not the same meaning. A license to "use and exercise" have not the same meaning.

Ambit of license: exercising, using, making, vending.

(z) *Chanter v. Dewhurst*, 1844, 12 M. & W. 823 ; 13 L. J. Ex. 198 ; *Chanter v. Johnson*, 1845, 14 M. & W. 408 ; *Crossley v. Dixon*, 1863, 10 H. L. C. 293 ; *Postcard Automatic Supply Co. v. Samuel*, 1889, 6 R. P. C. 560 ; *Tweddale v. Howard*, 1896, 13 R. P. C. 522.

(a) E.g. as in *Brake v. Radermacher*, 1903, 20 R. P. C. 631.

(b) *Wilson v. Union Oil Mills*, 1892, 9 R. P. C. at p. 62.

(c) *Smelting Co. of Australia v. Commissioners of Inland Revenue*, 1897, 1 Q. B. 175.

conveys the fullest rights, including that of importation (*d*). A license to make does not imply a license to use or vend (*e*). But a license to make and vend will imply a license to the purchaser to use and vend (*f*).

An inventor, by himself or his agent, unreservedly selling the patented article abroad cannot restrain the importation and sale of articles so sold in this country (*g*). But the assignee of the English patent could restrain the importation of articles sold abroad, prior to the assignment, by a person who had been the owner of the English patent (*h*); and a license under a foreign patent to manufacture abroad and sell abroad does not imply a license under the corresponding British patent to import articles so manufactured or sold into this country (*i*). And if the patentee assigned his English patent at a date later than that of the importation of articles sold abroad under the patentee's foreign patent, the assignee could not restrain their continued use, since the sale by the patentee would have implied a license to use and sell as wide as his own right at the date of the sale.

x **Sub-licensing.** Whether a licensee may sub-license or assign depends upon the terms of the contract, but in the absence of such terms the license would appear to be personal only (*k*). Should the patentee accept royalties from the person acting with the authority of the licensee, he will be estopped from denying that the license was assignable (*l*).

No implied covenant to pay fees.

It is not an implied term of a license that the patentee will maintain the patent in force by paying the fees; express covenants should be entered into on this point (*m*), and a

(*d*) *Dunlop Pneumatic Tyre Co. v. North British Rubber Co.*, 1904, 21 R. P. C. 161.

(*e*) *Basset v. Graydon*, 1897, 14 R. P. C. 701.

(*f*) *Thomas v. Hunt*, 1864, 17 C. B. N. S. 183; *Badische Anilin und Soda Fabrik v. Isler*, 1906, 1 Ch. 605; 1906, 2 Ch. 443.

(*g*) *Betts v. Wilmott*, 1870, L. R. 6 Ch. 239.

(*h*) *Ibid.* at p. 244.

(*i*) *Société Anonyme des Manufactures de Glaces v. Tilghmann's Patent Sand Blast Co.*, 1883, L. R. 25 Ch. D. at p. 9.

(*k*) *Lawson v. Donald Macpherson & Co.*, 1897, 14 R. P. C. 696.

(*l*) *Ibid.*

(*m*) *Mills v. Carson*, 1893, 10 R. P. C. 9; see also *Ward v. Livesey*, 1888, 5 R. P. C. 102; *Cutlan v. Dawson*, 1897, 14 R. P. C. 249 and Appendix.

covenant to pay renewal fees cannot be implied from a covenant for quiet enjoyment (n).

Similarly no covenant can be implied binding the licensee to manufacture in this country to an extent necessary to avoid revocation under sect. 27 of the Act of 1907 (q.v.), and express covenants to this effect should be inserted in an exclusive license (o).

Nor to work invention.

Licenses usually contain clauses which empower either party to revoke the arrangement after due notice; but, apart from such a clause, the question of the power of revocation by the licensor gives rise to some difficulty. It is quite clear that a mere license without a contract may be revoked at will. It is clear also that revocation of a license granted as the consideration in a contract will give a right to an action for damages for breach of that contract. But will the licensee be restrained from manufacturing after the revocation? It would appear from the judgment of Lindley, L.J., in *Guyot v. Thompson* (1894, 11 R. P. C. at p. 552), that the general intention of the parties must be looked to, and that where there are mutual obligations to be fulfilled, or, in other words, where the granting of the license is part of a contract, the licensor may not revoke. Moreover, it has been noticed above (p) that an agreement to grant a license for a fixed term may be specifically enforced, but an agreement to grant a license at will could not be enforced.

Power to revoke license.

**Estoppel.**—Unless the licensor has covenanted for the validity of the patent in express terms, the licensee will be estopped from alleging its invalidity in answer to an action for royalties. An express warranty of validity will, of course, negative estoppel (q).

Estoppel.

Express warranty of validity.

In *Bowman v. Taylor and Others* (1884, 2 A. & E. 278; 1 W. P. C. 292), 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

(n) *In re Railway and Electric Appliances Co.*, 1888, 38 Ch. D. 597.

(o) See Appendix.

(p) P. 203.

(q) *Wilson v. Union Oil Mills Co., Ltd.*, 1892, 9 R. P. C. 57; *Mills v. Carson*, 1893, 10 R. P. C. at p. 17.

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 (2 A. & E. at p. 291): "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 invention' 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* (3 T. R. 438), 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.

In the case of *Lawes v. Purser* (1856, 6 E. & B. 930), the license was not under seal, and the licensee was held to be estopped from alleging the invalidity of the patent, and in *Crossley v. Dixon* (1863, 10 H. L. C. 293) the same principle was held to apply in the case of a mere verbal license.

In *Adie v. Clark* (L. R. 3 Ch. D. at p. 144), 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 (L. R. 2 A. C. 423). 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; for example, in the case of an agreement between a patentee and a manufacturer to the effect that the manufacturer shall pay to the patentee a fixed royalty on each patented article made, there being no stipulation as to the length of time during which the arrangement shall last, and no annual minimum, it is within the power of the licensee to determine the license, and in answer to an action for damages on any articles made by him after such determination, but not before, he may plead the invalidity of the patent (r).

Where, however, the license was for a specified term of four years, and the patent was revoked within that period, the licensees were nevertheless held liable for royalties on the patented process during the remainder of the term of the license (s).

In *Cheetham v. Nuthall* (1893, 10 R. P. C. 321), it was provided that the license should determine if the patent should be declared invalid: in an action brought by the licensor against a third party for infringement, the patent was held to be invalid, but this judgment was reversed by consent; the defendant after due notice continued to work under his license, and it was held that he was still liable to pay royalties for the use of the invention.

*Mills v. Carson* (1893, 10 R. P. C. 9) was an action for royalties due under an indenture made between the patentee *W. Notley* of the one part, and the defendants *J. A. Carson* and *D. Coleman Defries* of the other part, whereby an exclusive license to use the invention was granted to the defendants. One of the terms of the agreement was that the patentee or

(r) *Crossley v. Dixon*, 1863, 10 H. L. C. 293; *Redges v. Mulliner*, 1893, 10 R. P. C. 21.

(s) *African Gold Recovery Co., Ltd. v. Sheba Gold Mining Co., Ltd.*, 1897, 14 R. P. C. 660.

his assigns would, at the request of the defendants, take proceedings against any person infringing the patent; and it was further agreed that "if the said *W. Notley* should at any time omit or refuse to take such proceedings as aforesaid, and if the said letters patent should become void or ineffectual by reason of any such omission or refusal on the part of the said *W. Notley*, or by reason of the said invention not being novel, or being an infringement of other letters patent, then the payment of the said annual sum under the indenture should cease and determine." Relying upon this condition, the defendants set up the defence that the invention was not new; it was held that they were estopped from doing so, and that the words, "by reason of the said invention not being novel," meant, if it was proved not to be novel in an action brought for infringement by the patentee at the instigation of the defendants.

But where the defendant took a license from the plaintiff to work his invention "subject to the result of an inquiry into the validity of the patent," and after the expiration of six months refused to continue to work the plaintiff's process on the ground that the patent was bad, it was held, in an action for royalties under the agreement, that it was open to the defendant to contest the validity of the plaintiff's patent (*t*).

Licensee may contend for limited construction.

The licensee may refer to the state of public knowledge at the date of the patent for the purpose of showing what is the true ambit of the claim (*u*), and he may, following the analogy of lessor and lessee, show that the patent in question has in fact expired (*x*).

Fraud negatives estoppel.

Fraud is practically the only plea which a licensee can put forward in an action brought against him for the recovery of royalties, but this must be distinctly pleaded (*y*); beyond that

(*t*) *Wilson v. Union Oil Mills Co.*, 1903, 20 R. P. C. 561.  
1892, 9 R. P. C. 57.

(*u*) *Adie v. Clark*, 1876, L. R. 2 A. C. 423; *Young and Beilby v. Hermand Oil Co., Ltd.*, 1892, 9 R. P. C. 373; see also *Neil and Others v. Neil*, 1903, 20 R. P. C. at p. 223; *Davies v. Curtis & Harvey*,

(*x*) *Muirhead v. Commercial Cable Co.*, 1894, 11 R. P. C. 317; 12 R. P. C. 39.

(*y*) *McDougall v. Partington*, 1890, 7 R. P. C. at p. 223; *Ashworth v. Law*, 1890, 7 R. P. C. at p. 234.

the only reply that is left to the licensee is that he has not worked the patent in question (z).

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 (a). But it would be otherwise in the absence of fraud and where both parties are innocent; in that case neither the assignee nor licensee would be allowed to set up as a defence the bad title of the assignor or licensor (b).

An assignee of a share of the profits is entitled to an account of the profits from the person by whom they are payable; but the account should be taken once for all in the presence of all the persons interested; the licensee is not bound to account to the assignor and to each assignee of a share separately (c).

As to licenses and assignments to a Government department, see p. 13, *ante*.

#### LIMITED LICENSES.

Some observations are necessary upon what are known as "limited licenses," and the effect of the Act of 1907 in restricting the power of the patentee to impose terms of limitation. It had been decided that a "patentee had a right, not merely by sale without reserve to give an unlimited right to the purchaser to use, and thereby to make in effect a grant from which he could not derogate, but might attach to it conditions, and if those conditions were broken, then there was no license, because the license was bound up with the observance of the conditions" (d). Consequently the patentee might license the user of his patented article, but might attach the condition that it was to be used only in connection with some other article sold by him. In the cases of *The Incandescent Gas*

Limited  
licenses.

(z) *Clark v. Adie*, L. R. 2 App. Cas. 423, 435.

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

(b) *Taylor v. Ware*, 1 W. P. C. 292.

(c) *Bergmann v. Macmillan*, 1881, L. R. 17 Ch. D. 423.

(d) *Kennedy, J., in The Incandescent Gas Light Co., Ltd. v. Brogden*, 1899, 16 R. P. C.

Knowledge  
of conditions  
when neces-  
sary.

*Light Co., Ltd. v. Cantelo* (1895, 12 R. P. C. 262), and *The Incandescent Gas Light Co., Ltd. v. Brogden* (1899, 16 R. P. C. 179), the article the subject of the patent was an incandescent mantle, and the condition imposed was that the mantle was to be used only upon gas burners supplied by the patentees, and upon no other burners. It was held that such conditions might lawfully be imposed, and that the license to use was to that extent a limited one. It has been pointed out above (p. 204) that the sale of an article by the patentee or by his agent implies a full license to use and to resell. Consequently it was necessary for the patentee in an action against a purchaser for infringement by breach of such conditions to prove that the license was limited, and that the terms thereof were communicated to the purchaser, otherwise he would not be bound by them. In the first of the cases above cited the agent did not bring the limitation to the notice of the purchaser; in the second case the agent did communicate the limitation to the purchaser. In the case, however, of the sale by the patentee to a licensee with a limited license, a purchaser from such licensee (as opposed to an agent) is bound by the limitations in the license, whether he knew of them or not. This point was explained by Buckley, J., in *The Badische Anilin und Soda Fabrik v. Isler* (1906, 1 Ch. at p. 610): "If the patentee sells, imposing no restriction or condition upon his purchaser at the time of sale, he cannot impose a condition subsequently by delivery of the goods with a condition endorsed upon them or upon the package in which they are contained. Unless the purchaser knows of the condition at the time of purchase and buys subject to the condition, he has the benefit of an implied license to use free from condition. But suppose the purchaser buys, not from the patentee, but from a licensee, the patentee may have attached to his license any conditions he pleased, and if he did attach a condition, then upon principle it seems to me that nothing (so far as license as distinguished from estoppel is concerned) can turn on the question whether the purchaser from the licensee knew of the condition or not. If a person innocently uses a patented invention not knowing that there is a patent, he is none the less an infringer,

and if a person innocently buys a patented invention from a licensee and uses it not knowing that there are limits on the license, I conceive that he is equally an infringer."

The device of the "limited license" was gradually developed into a machine by means of which Letters Patent for certain kinds of inventions were made to produce commercial profits independently of any royalty that might adequately have rewarded the ingenuity of the inventor or the enterprise of the capitalist. It became customary (particularly in the world of labour-saving machinery) for the patentee to lease such machinery on hire to the manufacturer, and to stipulate that, in addition to paying a royalty, the manufacturer should use in his factory no machinery of any kind other than that supplied by the patentee, and further that the manufacturer should purchase from the patentee the raw material used in connection with his factory. Another stipulation was to the effect that the leasing contract should endure between the parties for a term of years longer than that of the Letters Patent.

Abuse of  
limited  
licenses.

By sub-sect. 1 of sect. 38 of the Act of 1907 it was enacted:—

*"It shall not be lawful in any contract made after the passing of this Act in relation to the sale or lease of, or license to use or work, any article or process protected by a patent to insert a condition the effect of which will be—*

Statutory  
change of law.

(a) *"to prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees; or*

(b) *"to require the purchaser, lessee, or licensee to acquire from the seller, lessor, or licensor, or his nominees, any article or class of articles not protected by the patent;*

*and any such condition shall be null and void, as being in restraint of trade and contrary to public policy."*

The definitions in clauses (a) and (b) of the kinds of conditions which are to be void are modified by sub-sect. 5, which is as follows:—

- (5.) “*Nothing in this section shall—*
- (a) “*affect any condition in a contract whereby a person is prohibited from selling any goods other than those of a particular person; or*
- (b) “*be construed as validating any contract which would, apart from this section, be invalid; or*
- (c) “*affect any right of determining a contract or condition in a contract exercisable independently of this section; or*
- (d) “*affect any condition in a contract for the lease of or license to use a patented article, whereby the lessor or licensor reserves to himself or his nominees the right to supply such new parts of the patented article as may be required to put or keep it in repair.*”

Respects in which law remains unchanged.

The consequence of sub-sect. 1 and of par. (a) of sub-sect. 5 is that a patentee may supply patented goods on sale or hire on condition that the purchaser or hirer does not *sell* any other goods than those supplied by the patentee whether patented or not, but the purchaser or hirer may not be restricted in any way from *using* goods other than those supplied by the patentee.

The consequence of par. b of sub-sect. (1) and of par. (d) of sub-sect. 5 is to leave the right of deriving profits from the repair of the patented article in the hands of the patentee.

By par. (b) the common law rule as to contracts in restraint of trade is left untouched, and licenses limiting the price at which the patented article may be sold (*e*), or the quantities which may be sold at one time (*f*), are still valid.

Condition not necessarily invalid.

But it is most important to notice that contracts of the kind mentioned are not invariably to be deemed invalid. The evil that was aimed at by the statute only existed in the case of a purchaser or licensee who was practically compelled to enter into such a contract, and it was not the purpose of the section to interfere with contracts which had been voluntarily entered into by parties who had the opportunity clearly laid before them of purchasing or hiring upon different terms. Accordingly sub-section 1 concludes with this proviso:—

(e) See p. 246.

*Soda Fabrik v. Isler*, 1906, 1 Ch.

(f) See *The Badische Anilin und* 605; 2 Ch. 443.

*“ Provided that this sub-section shall not apply if—*

- (i) *“ the seller, lessor, or licensor proves that at the time the contract was entered into the purchaser, lessee, or licensee had the option of purchasing the article or obtaining a lease or license on reasonable terms, without such conditions as aforesaid ; and*
- (ii) *“ the contract entitles the purchaser, lessee, or licensee to relieve himself of his liability to observe any such condition on giving the other party three months’ notice in writing and on payment in compensation for such relief in the case of a purchase of such sum, or in the case of a lease or license of such rent or royalty for the residue of the term of the contract, as may be fixed by an arbitrator appointed by the Board of Trade.”*

It is suggested that one way of reducing the risk of such a condition being set aside would be to recite in the agreement an alternative offer to the purchaser or hirer and to recite that the purchaser, although deeming such terms to be reasonable, nevertheless preferred to enter into the agreement as herein provided. This would at all events cast the onus of proof on to the licensee. In the event of the contract providing for compensation, such compensation cannot be fixed in the agreement as liquidated damages, but will be such as the arbitrator appointed by the Board of Trade may fix.

Contracts made before the passing of the Act are to be deemed valid save in so far as they were invalid at Common Law, but may be terminated, and the party terminating becomes liable to pay compensation :—

Contracts  
made before  
Act.

(2) *“ Any contract relating to the lease of or license to use or work any patented article or patented process, whether made before or after the passing of this Act, may at any time after the patent or all the patents by which the article or process was protected at the time of the making of the contract has or have ceased to be in force, and notwithstanding anything in the same or in any other contract to the contrary, be determined by either party on giving three months’ notice in writing to the other party ; but where any such notice is given determining any contract made before the passing of this Act, the party giving the notice shall be*

*liable to pay such compensation as failing agreement may be awarded by an arbitrator appointed by the Board of Trade.*

(3) *“ Any contract made before the passing of this Act relating to the lease of or license to use or work any patented article or process and containing any condition which, had the contract been made after the passing of this Act, would by virtue of this section have been null and void may, at any time before the contract is determinable under the last preceding sub-section, and notwithstanding anything in the same or any other contract to the contrary, be determined by either party on giving three months’ notice in writing to the other party, but where any such notice is given the party giving the notice shall be liable to pay such compensation as, failing agreement, may be awarded by an arbitrator appointed by the Board of Trade.”*

**Whole contract may be terminated.**

It is to be noticed that the whole contract may be terminated, and not the condition only.

**Basis of compensation.**

No directions are given as to the proper basis upon which such compensation shall be fixed, and it is to be remembered that cases in which decisions have been given upon the assessment of statutory compensation have invariably been based upon the wording of the particular statute and its general intention. There is no definition of “ compensation ” universally applicable. In a case in which the writer of these observations recently took part, counsel on behalf of those who gave the prescribed notice sought to establish the proposition that the policy of this statute was merely to award such a sum beyond that already paid under the lease as would reasonably reward the lessors, having regard to the merit and value of the patent right, plus such a sum as would yield them a reasonable profit as manufacturers. Counsel for the lessors argued that the compensation payable should be the purchase price of an annuity for the remainder of the term during which the contract would have endured, of an annual value equal to the average annual value during the period during which the rental had actually been paid, thus taking the value of the contract to the lessor as the basis of compensation. The arbitrator awarded a sum less than such purchase price, but considerably more than that suggested by the lessee. As, in



accordance with custom, no reasons were given with the award, it is not possible to say what principle was followed, but the sum awarded was such as to indicate that the view contended for by the lessor was probably the correct one. Until a case is stated for the Court no definite rule can be laid down.

Sub-sect. 4 of sect. 38 is of a penal nature, and will probably effectually prevent patentees from inserting such oppressive conditions in future contracts:—

Defence in  
infringement  
action.

*“The insertion by the patentee in a contract made after the passing of this Act of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force.”*

It is to be noticed that the defence is available to any defendant, and is not limited to a party to the contract.

#### THE REGISTER.

Sect. 28 of the Act of 1907 (corresponding with sect. 23 of the Act of 1883) provides:—

The register.

(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 existing at the commencement of this Act shall be incorporated with and form part of the register of patents under this Act; (3) the register of patents shall be primâ facie evidence of any matters by this Act directed or authorised to be inserted therein; (4) 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.”*

The practice of the Patent Office with regard to registration is regulated by rules 82 to 94 of 1908.

By sect. 66, *“There shall not be entered in any register kept under this Act, or be receivable by the Comptroller, any notice of*

Notice of  
trust not  
registrable.

Equities may  
be enforced.

Doctrine of  
notice.

*any trust, express, implied, or constructive.*" Sect. 71 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 or design may be enforced in like manner, as in respect of any other personal property.*"

Lindley, M.R., in *New Ixion Tyre Co. v. Spilsbury* (1898, 2 Ch. at p. 488; 15 R. P. C. at p. 571), said, referring to this proviso: "That lets in the whole doctrine of notice and the equitable consequences of it. That proviso cannot be cut down. When it says, 'any equities in respect of such patent,' it cannot mean registered equities. You do not want a proviso for that, because you have got that before. It means that any equitable rights in any person in respect of such patent may be enforced in like manner as in respect of any other personal property. What are they? Those rights are that they can be enforced in equity against all persons who have taken with notice."

In *In re Morsey's Patent* (1858, 25 Beav. 581), 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.

Registration does not amount to notice to the whole world, so where the grant of an exclusive license for a district had been entered on the register, it was held that this did not by itself amount to notice so as to affect an innocent purchaser outside of that district bringing his purchase within the district in violation of the rights of the licensee. But it was also decided that the exclusive licensee had no cause of action, and this was the real reason for the dismissal of the action (g).

Sect. 67 deals with the inspection of registers, and the

(g) *Heap v. Hartley*, 1888, 5 R. P. C. 603; 6 R. P. C. 495.

obtaining of certified copies. By sect. 79 sealed copies are to be received in evidence.

The effect of these sections is to prohibit the entry upon the register of simple notices of trusts, but any other documents affecting the proprietorship of the patent, whether by creating trusts or otherwise, are not to be excluded (*h*). In *Stewart v. Casey* (1892, 9 R. P. C. 9) the owners of two patents employed C. about their patents and wrote to him that, in consideration of his services, they agreed to give him one-third share of the patents, to take effect from the date of the letter. The original Letters Patent were subsequently put into C.'s hands for the purpose of a sale which fell through. C. retained the Letters Patent, and caused an entry to be made on the register of patents of the above-mentioned letter. An entry was also made in the register of proprietors that C. claimed an interest in the patents under this document. It was held that the letter was properly registered, it being a document affecting the proprietorship of the patents, and although an assignment of a patent should be by deed, yet an agreement to assign is an equitable assignment, and consequently may be entered on the register under the section, but the documents containing the agreement and entered on the register must be complete, and, of a nature that specific performance of the agreement could be enforced, since otherwise no legal or equitable interest in the patent or proprietorship thereof would pass (*i*). For example, in *Fletcher's Patent* (1893, 10 R. P. C.) X., the owner of a patent, wrote a letter to Y. agreeing to give him an exclusive license for the duration of the patent, "provided always that you pay me a royalty, of the amount to be mutually agreed upon between us." X. and Y. subsequently disagreed. Y. contended that the royalties had been verbally agreed upon; this was disputed by X. Y. applied to register the letter. It was held that the letter was not registrable.

**Registrable documents.**

**Agreement must be complete.**

Sect. 72 empowers the Court (High Court of Justice) to order the alteration of the registers, upon the application of

**Power to amend entries.**

(*h*) *Stewart v. Casey*, 1892, 9 R. P. C. 9; see also *In re Fletcher's Patent*, 1893, 10 R. P. C. 252.

(*i*) *Fletcher's Patent*, 1893, 10 R. P. C. 252; *Haslett v. Hutchinson*, 1891, 8 R. P. C. 457.

persons aggrieved, and upon sufficient cause shown. The application is made by motion, and notice must be given to the Comptroller, who is entitled to appear and to be heard. The Comptroller may himself under sect. 70 correct errors in the registers which are merely of a clerical nature.

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, but it would appear that if that objection does not apply, the fact that the document is dated prior to the date of the patent is not in itself a bar to registration (*k*). Needless to say, until the patent is granted the registration cannot be effected.

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."

Necessity of registration of assignment.

It will be observed that the Acts of 1883 and 1907, quoted above, do not contain these words. Hence, it is submitted, *Chollett v. Hoffman* (*l*) and *Hassall v. Wright* (*m*), which laid down the rule that an assignee could not sue infringers unless the assignment was registered, are not applicable to the present law (*n*).

(*k*) *Parnell's Patent*, 1888, 5 R. P. C. 126.

(*l*) 1857, 7 Ell. & B. 686.

(*m*) 1870, L. R. 10 Eq. 509; 40 L. J. Ch. 145.

(*n*) See, however, the contrary view expressed by Mr. Frost in the 3rd edition of his work, Vol. II. at p. 129.

Extension under Sec 18 Act 1907 as amended  
Sec 7. Act 1919. Re Brown, Patent xxxvii R.P.

1. Brown's Patent xxxviii R.P. 23

2. re Davidson xxxviii R.P. 145

- Gaskin

## CHAPTER XI.

### EXTENSION OF THE TERM OF A PATENT.

PRIOR to the year 1835 a patentee who desired an extension of the term of his patent had to apply for a private Act of Parliament, the grant by the Crown being limited to the period of fourteen years fixed by the Statute of Monopolies. By the Act 5 & 6 Will. IV. c. 83, amended by 2 & 3 Vict. c. 67 and by sects. 2 and 3 of 7 & 8 Vict. c. 69, and re-enacted by sect. 25 of the Act of 1883, the Crown was enabled to prolong the term for seven, or in exceptional cases for fourteen, years upon the advice of the Judicial Committee of the Privy Council, which was given jurisdiction to hear petitions. By sect. 18 of the Act of 1907 the power to hear petitions and to grant prolongation is transferred to the High Court, but the considerations which are to guide the tribunal in arriving at a decision remain the same. The judgments here cited are for the most part judgments of the Privy Council, but they are applicable to petitions to the Court.

History of  
practice.

Sect. 18 is as follows:—

(1) “ *A patentee may, after advertising in manner provided by rules of the Supreme Court his intention to do so, present a petition to the Court praying that his patent may be extended for a further term, but such petition must be presented at least six months before the time limited for the expiration of the patent.* ”

The Act of  
1907.

(2) “ *Any person may give notice to the Court of objection to the extension.* ”

(3) “ *On the hearing of any petition under this section the patentee and any person who has given such notice of objection shall be made parties to the proceeding, and the Comptroller shall be entitled to appear and be heard, and shall appear if so directed by the Court.* ”

(4) “ *The Court, in considering its decision, shall 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 it appears to the Court that the patentee has been inadequately remunerated by his patent, the Court may by order extend the term of his patent for a further term not exceeding seven, or in exceptional cases fourteen, years, or may order the grant of a new patent for such term as may be specified in the order and containing any restriction, conditions, and provisions the Court may think fit.”*

**Judge's decision final.**

By sect. 92, sub-sect. 2, all petitions which “*by virtue of this Act*” are to be presented to the Court are to be presented to a judge to be selected by the Lord Chancellor, and his decision is to be final. A petition for prolongation is “*by virtue of this Act*” to be presented to the Court.

**Grounds for extension.**

The transference to a judicial authority of powers which had formerly been exercised by Parliament gave rise in the beginning to some doubts as to the spirit in which petitions should be approached. In *Soame's Patent* (1843, 1 W. P. C. 733), Lord Brougham said: “If this case were to be disposed of upon the ground which in arguing such cases has 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; but their lordships have always considered that it was with the view of affording a better remedy, not only cheaper and easier, but better in this respect: that there might be cases which never would have prevailed on the legislature to make a new personal law prolonging a monopoly, which nevertheless might seem meritorious enough in respect of the individual, beneficial enough in respect of the public, and deficient enough in remuneration to justify interference, which nevertheless, had they been presented in the form of a petition to Parliament, would have failed to procure an Act. Proceeding therefore

upon this ground, that it is not necessary to show there is case enough for an Act of Parliament, their lordships are of opinion that in this case there may be sufficient ground for granting a very moderate extension of the term" (a). The considerations laid down by the Act of 1883, and again by the Act of 1907, are almost identical with those given by Lord Brougham in *Derosne's Patent* (1844, 2 W. P. C. 4): "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."

It is immaterial whether or not the application is opposed. The Privy Council required every necessary ground for extension to be **strictly proved** before they advised an extension, and this even though the Crown through the Attorney-General consented (b). **Must be strictly proved.**

The **utmost good faith** is required to be observed in framing the petition for prolongation. In addition to setting forth the accounts, the nature of which we shall consider later, the petition should state the whole history of the case and everything bearing on the matter. In *Ferranti's Patent* (1901, 18 R. P. C. 518), for example, it transpired at the hearing that the petitioner had long ago parted with a substantial interest in his invention, and this fact was not disclosed in the petition. Prolongation was refused without any further investigation (c). And the circumstances relating to any foreign patents which may have been obtained must be set forth with great strictness (d). **Uberrima fides required.**

The **conduct of the petitioner** in placing the invention before the public is one of the circumstances which will be considered; and so where false statements are made as to profits in the prospectus of a company floated for the purpose of manufacturing under the patent, this was a ground for refusing prolongation (e). **Conduct of petitioner considered.**

(a) And see *Morgan's Patent*, 1843, 1 W. P. C. 739. 1898, 15 R. P. C. 17; *Ferranti's Patent*, 1901, 18 R. P. C. 518.

(b) *Cardwell's Patent*, 1856, 10 Moo. P. C. C. 488. (d) *Pitman's Patent*, 1871, L. R. 4 P. C. 84; 8 Moo. P. C. N. S. 293.

(c) See also *Horsey's Patent*, 1884, 1 R. P. C. 226; *Standfield's Patent*, (e) *Lawrence's Patent*, 1892, 9 R. P. C. 89



Merit of the invention.

The merit of the invention does not mean the merit of the inventor, which must be considered separately (*f*), 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 inventor in such a case will not be considered.

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 (*g*).

In *Bailey's Patent* (1884, 1 R. P. C. at p. 3), 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 in relation to the public. Upon 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."

Degree of merit required.

To sustain a petition for prolongation, a greater degree of merit must be shown than that which would be sufficient to support the patent in a Court of law (*h*).

Novelty of invention immaterial.

The Court will not inquire into the novelty or utility of an invention, except in so far as such novelty or utility may form elements in the consideration of the merit of the invention, save in the case of obvious invalidity.

In *Saxby's Patent* (1870, L. R. 3 P. C. 294), Lord Cairns said: "In point of fact, it is not the practice of this tribunal to decide upon the novelty or utility of a patent; and although they would, of course, abstain in any case from prolonging a

(*f*) See *Hill's Patent*, 1863, 1 Moo. P. C. N. S. 264.

(*g*) *Muntz's Patent*, 1846, 2 W. P. C. at p. 119.

(*h*) Per Sir W. Grove, *Stoney's Patent*, 1888, 5 R. P. C. 520; see also *Saxby's Patent*, 1870, L. R. 3 P. C. 292, 294.

patent which was manifestly bad, yet, in one point of view, they are in the habit, in taking into account that which may be termed the question of utility, to consider not that amount of utility which would be necessary to support a patent, but that kind of utility which might more properly be described as merit. Upon that question it is the habit of this tribunal to consider whether the invention brought before them is one of that high degree of merit which, if everything else were satisfactory, would entitle the patentee to a prolongation."

In *Stewart's Patent* (1886, 3 R. P. C. at p. 10), Lord Monks-well said: "Their lordships do not propose to determine the validity or invalidity of the patent on this occasion; but they are satisfied that the invention, whether or not it may have sufficient novelty to sustain the patent, upon which they give no opinion, has been so far anticipated by previous patents and by actual user of machines in this country as to deprive the invention of that degree of novelty which would be necessary in order to justify their lordships in advising her Majesty to prolong its term."

Save as  
affecting  
merit.

In *Johnson's Patent* (1908, 25 P. P. C. at p. 723, Mr. Justice Parker said: "The consideration which supports the grant of the monopoly granted by Letters Patent being in fact the disclosure of something of value to the public, it is only where this value largely exceeds the benefit derived by the patentee from his invention that the patentee can be said to have been inadequately remunerated; but, even where this inadequacy exists, there may be other circumstances sufficient to induce the Court to refrain from exercising its power. The first question, therefore, which arises on a petition for extension is the nature of the disclosure contained in the specification. For, without deciding first on the nature of the disclosure made, it would be impossible to form an opinion on its value to the public. For the purpose of determining the nature of the disclosure made and its value to the public, questions of novelty and subject-matter, though not directly in issue, are necessarily of considerable materiality, for, without considering what was already known at the date of the Letters Patent, it is impossible to arrive at any adequate

conception of the nature of the disclosure made by the patentee, and, in the same way, the value of this disclosure to the public cannot be altogether independent of the extent of inventive ingenuity required to arrive at the thing disclosed. While, therefore, it would be wrong to allow detailed scientific evidence such as is usual in actions for infringement or petitions for revocation, evidence as to novelty or subject-matter cannot be altogether excluded. It is the duty of the petitioner at the outset to bring to the notice of the Court all that may in any way affect the judgment of the Court in these matters. The length to which the petitioner's witnesses should be cross-examined, and the extent to which an objector should be allowed to bring evidence impeaching the validity of a patent on the ground of want of novelty or subject-matter, must be left to the determination of the judge who hears the petition having regard to the nature of the individual case. As a general rule, if, after hearing the evidence of the petitioner's witnesses, there be in the opinion of the Court a *prima facie* case for upholding the validity of the patent in respect of novelty and subject-matter, the Court need not, in my opinion, investigate the matter further. It is always open to an objector to challenge the validity of a patent in proceedings more appropriate for that purpose. The Court on a petition for prolongation ought, in my opinion, to pay especial attention to the fact that the thing disclosed may be minute compared with the sum total of what was known before, and yet may be the *sine qua non* of the successful application of existing knowledge, and thus falls within the category of great inventions."

Nor in  
validity.

In *Lane Fox's Patent* (1892, 9 P. O. R. 412), a Court of First Instance held the patent invalid; while an appeal from that decision was pending, a petition for prolongation was brought, the Committee decided to hear the petition on the ground that it was not their duty to look into the validity of the patent, and the decision of the Court was one which might not be upheld and therefore in no way binding (i).

(i) And see *Heath's Patent*, 1853, 2 W. P. C. 257; *In re Stoney's Patent*, 1888, 5 R. P. C. 522.

In *Burlingham's Patent* (1898, 15 R. P. C. 195), counsel admitted at the hearing that one of the claims in the specification was invalid; the Committee did not decide upon the effect of this admission and dismissed the petition upon other grounds.

And the Committee will not hear an objection to the validity of the patent on the ground of non-payment of fees (*k*).

Non-user of the invention for the whole or a great part of the period of the grant creates a strong presumption against the merit of an invention, which presumption can only be rebutted by the strongest evidence (*l*). But the same objection being raised in *Hughes' Patent* (1879, L. R. 4 A. C. 174), the application was granted after strong and unanswered evidence of merit, though the patent had not been used in England during the whole term (*m*).

Effect of  
non-user.

In *Semet and Solvay's Patent* (1895, 12 R. P. C. 10), the invention consisted in an improved apparatus for coking and distilling coal. For some time it was found impossible to obtain any practical introduction of the invention into the country, partly by reason of expense and partly owing to the prejudices of the manufacturers. Lord Watson said: "The invention appears to their lordships to be one which from its very nature cannot reasonably be expected to come at once, or within a short period, into general use. Its adoption necessitates the destruction of existing and the erection of new apparatus, and will therefore, in all probability, be gradual, as the old-fashioned apparatus wears out." The prolongation was granted (*n*).

In *Pieper's Patent* (1895, 12 R. P. C. 292), the invention consisted in an improved expansion gear for steam engines. Prolongation was refused on several grounds, one being that no steps were taken to push the invention for two and a half

(*k*) *Dolbear's Patent*, 1896, 13 R. P. C. 203.

(*l*) *Allan's Patent*, 1867, L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 443; *Dolbear's Patent*, 1896, 13 R. P. C. 203; *Henderson's Patent*, 1901, 18 R. P. C. 449.

(*m*) See also *Wright's Patent*, 1839, 1 W. P. C. 575; *Herbert's Patent*, 1867, L. R. 1 P. C. 399; 4 Moo. P. C. N. S. 300; *Southby's Patent*, 1891, 8 R. P. C. 433.

(*n*) And see *Thompson's Patent*, 1902, 19 R. P. C. 565.

Conduct of  
inventor in  
pushing  
invention.

years after the date of the patent. Lord Watson, dealing with this as a reason for the refusal, said: "Looking at the progressive amounts obtained from year to year under the English patent, it is by no means clear that if due activity had been shown in making the invention known to persons who were likely to use it in this country, there might not have been, during the last year or two's currency, a sum which, added to those which have actually been obtained, might have amounted to adequate remuneration."

The principle upon which these cases were decided was approved in *Henderson's Patent* (1901, 18 R. P. C. 449), and in *Johnson's Patent* (1908, 25 R. P. C., at p. 727) Mr. Justice Parker said:—

"As this is the first petition under sect. 18 of the Act of 1907, I think it may be useful to add a few further observations. In the first place, I do not consider that the reasons given by the petitioner for not bringing his invention prominently before British manufacturers are at all satisfactory. His attitude of mind appears to have been that, if he could not persuade his own firm to give his invention a trial, he certainly would be unable to persuade anyone else, either in America or in England. This may have been quite true with regard to the invention in question, but it is, in my opinion, incumbent on a patentee who invokes the discretionary power conferred by sect. 18 to prove that he has done all a patentee could do to launch his invention on the British market. If an invention be of that large value to the public which alone will justify the term of the patent being extended—and there is certainly a chance, and I should say a reasonable chance, of someone being found in this country enterprising enough to give it a trial—the least that can be required of the patentee is to show that he has made an effort to find such a person. The petitioner had been able to convince himself of the value of his process, and I cannot ignore the possibility that with reasonable effort he might have convinced others."

In *Roper's Patent* (1887, 4 R. P. C. 201), an extension was granted although the invention had not been pushed during a period of eight years, the reason for the delay being

the serious ill-health of the patentee produced by a railway accident.

Where part of the invention is sufficiently meritorious and part not so, an extension of the term will be granted for the meritorious part only (*o*).

The mere fact that the invention has been considerably improved upon since it was patented is not a reason for refusing prolongation (*p*).

Subsequent improvement no bar to prolongation.

But where a patent had been taken out for the subsequent improvements, and remuneration had been derived therefrom, this was held to be a reason amongst others for refusing a prolongation (*q*), and if the invention in its original form was useless, it would be a ground for refusal.

Save as affecting remuneration.

The degree of merit together with the circumstances which in the future are likely to tend to the proper remuneration of the patentee are taken into consideration in determining for what period the patent shall be prolonged. Sub-sect. 5 of sect. 18, following the Act of 1883, allows an extension “*not exceeding seven, or, in exceptional cases, fourteen years.*”

Period of prolongation.

In *Stoney's Patent* (1888, 5 R. P. C. 518), the patent was for improvements in sluice or flood gates, and enabled a very small amount of power to move gates which had theretofore required the expenditure of great force. Sir William Grove said: “There is one other matter which has always been considered by this Court, and that is that the invention is not one which would promote itself. This is not a case like that of some of those little improvements in forks or knives, in fireplaces, or things of that sort, which, if once known, the public will necessarily have for their own convenience. On the contrary, this is an invention which only appeals to a small number of minds, is only used in a small number of cases, and requires a considerable outlay, and consequently is not an invention of daily use, nor one of that class which rapidly gets

Exceptional merit.

(*o*) *Balmer's Patent*, 1849, 8 Moo. P. C. C. 282; *Lee's Patent*, 1856, 10 Moo. P. C. C. 226; *Church's Patent*, 1886, 3 R. P. C. 95; *Joy's Patent*, 1893, 10 R. P. C. 89.

(*p*) *Galloway's Patent*, 1843, 1 W. P. C. 727; *Soame's Patent*, 1843, 1 W. P. C. 734.

(*q*) *Nussey and Leachman's Patent*, 1890, 7 R. P. C. 22.

into general use ; it is exceptional therefore in that respect. . . . Now, in the case of a common application such as I have spoken of, . . . if by some means it has been ignored by the public and the patentees come before the Court for a prolongation of their patent, the mere advertisement of the petition would materially assist and start the invention, . . . and would probably lead to its getting into rapid application, and to its becoming rapidly remunerative to the patentees. But this is not an invention of that description. It is from its nature an invention which cannot be very largely used, and which only applies to peculiar cases, namely, where sluices are wanted for large bodies of water to regulate the flow of that water, and to do it without friction and without substantial leakage. It can therefore only be profitably applied, at all events, in certain large undertakings, which must be few and far between. . . . Under those circumstances my lords think that this is an exceptional case within the meaning of the statute, and that there should be a prolongation for the term of ten years.”

The Act gives a patentee the right to petition, and, bearing in mind that the definition of the word patentee is by sect. 93, “*The person for the time being entitled to the benefit of a patent,*” it will be observed that some latitude is given as to persons who may petition.

Persons  
entitled to  
petition,  
merits of.

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 (*r*). So might the assignee of a patent (*s*), even though a public company. So might the executor of an assignee (*t*); so also any person having merely an equitable interest in the patent (*u*); an unpaid mortgagee should be joined as a party (*x*).

But the Court, in addition to considering the merit of the invention, consider that of the petitioner.

“The merit of an importer is less than of an inventor. We

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|--|---|
| ( <i>r</i> ) <i>Heath's Patent</i> , 1853, 8 Moo.  | P. C. C. 468.                                     |
| P. C. C. 217; 2 W. P. C. 247.                      | ( <i>u</i> ) <i>Noble's Patent</i> , 1850, 7 Moo. |
| ( <i>s</i> ) <i>Norton's Patent</i> , 1863, 1 Moo. | P. C. C. 191.                                     |
| P. C. N. S. 339.                                   | ( <i>x</i> ) <i>Church's Patent</i> , 1886, 3     |
| ( <i>t</i> ) <i>Bodmer's Patent</i> , 1849, 6 Moo. | R. P. C. 95.                                      |

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" (*y*).

Where it appeared that the imported invention had great commercial value, and that the petitioners had embarked a large capital in bringing the patent into use, whereby they had sustained a loss of nearly 10,000*l.*, an extension for six years was granted (*z*).

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 (*a*).

Merit of  
assignee.

In *Norton's Patent* (1863, 1 Moo. P. C. N. S. 339), 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" (*b*).

And in *Pitman's Patent* (1871, 8 Moo. P. C. N. S. 293, L. R. 4 P. C. 84), 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 patronising the

(*y*) Per Lord Brougham, *Soame's Patent*, 1843, 1 W. P. C. at p. 733.

(*z*) *Berry's Patent*, 1850, 7 Moo. P. C. C. 187.

(*a*) See *Napier's Patent*, 1861, 13 Moo. P. C. C. 543. See also

*Norton's Patent*, 1863, 1 Moo. P. C. N. S. 339; *Pitman's Patent*, 1871, L. R. 4 P. C. 84; 8 Moo. P. C. N. S. 293.

(*b*) And see *Finch's Patent*, 1898, 15 R. P. C. 674.



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 *Morgan's Patent* (1843, 1 W. P. C. 737), that by so doing 'they are, though not directly, yet immediately and consequentially, as it were, giving a benefit to the inventor, because, if the assignee is not 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.'"

In *Hopkinson's Patent* (1897, 14 R. P. C. 5), the petitioners were the inventor and a company who had purchased the patents from an assignee of the inventor. It appeared that the inventor himself had been well remunerated in the course of the transactions. Lord Hobhouse dealt with the questions of principle involved and the authorities which illustrate them, and said: "Their lordships consider that they would be departing both from authority and from sound principle if they were to hold that this company occupies the position of an inventor who has been inadequately remunerated. The company entered upon a purely commercial speculation, which, unluckily for them, has, up to the present time, proved unremunerative. They did not assist to perfect or bring out the invention. They purchased it out and out from a prior assignee of the inventor, who has, in one way or another, been well paid, and has now no claim or interest to ask for an extension" (c).

In *Houghton's Patent* (1871, L. R. 3 P. C. 461), however, where the petitioning company had spent large sums in trying to make the invention known and in bringing it into public use, and the patentee was a holder of a considerable number of shares, the patent was prolonged.

Where the petitioner is an assignee conditions may be imposed in favour of the original inventor. In *Herbert's*

(c) And see *Barff and Bower's Henderson's Patent*, 1901, 18 R. P. C. Patent, 1895, 12 R. P. C. 383; 453.

*Patent* (1867, L. R. 1 P. C. 399), the petition was presented by the patentee and the assignees of a part share conjointly; while the petition was pending the patentee died; the Committee permitted the hearing to proceed, and granted an extension, subject to a condition that the assignees should hold a moiety on behalf of the widow of the patentee. **Interests of applicant considered.**

In *Whitehouse's Patent* (1838, 1 W. P. C. 473) (*d*), the inventor was a mechanic in the employ of the petitioner. The petitioner was the assignee of the patent, and had expended large sums of money on the necessary plant and machinery. An extension was granted for six years, on condition that the petitioner secured to Whitehouse an annuity of 500*l.* during the term of the patent.

The interests of the public will also be considered, and in the event of the petition being granted terms may be imposed. In *Hardy's Patent* (1849, 6 Moo. P. C. C. 441), the patentee was obliged to sell the patented articles at a certain fixed price, and no more. In *Lyon's Patent* (1894, 11 R. P. C. 537), an extension was granted upon the condition that the petitioner should grant licenses on the same terms to all persons, and the royalty receivable was limited. In *Shone's Patent* (1892, 9 R. P. C. 438), where the petitioners had been obliged by stress of circumstances to grant an exclusive license, the exclusive licensees were co-petitioners, but were compelled to renounce the license in so far as it was exclusive as a term of renewal. **Interests of public considered.**

A grant by the patentee of an exclusive license to work his invention, together with a covenant to continue such exclusive license in the event of a renewal being granted, is a good ground of objection to the prolongation (*e*); but where the licensee had no rights to the exclusive use of the patent during any period of prolongation that might be granted, and it did not appear that the interests of the public had been in any way affected by the grant of the exclusive license, it was held that this was no objection to the petition for extension (*f*), and in *Shone's Patent* (1892, 9 R. P. C. 438), an extension was granted subject to the **Effect of exclusive license.**

(*i*) See also *Hardy's Patent*, 1849, Moo. P. C. C. 488.  
6 Moo. P. C. C. 441.

(*f*) *Darby's Patent*, 1891, 8

(*e*) *Cardwell's Patent*, 1856, 10 R. P. C. 380.

condition that the exclusive licensee abandoned all right and benefit under the license.

Inventions  
worked  
abroad.

The Act of 1908 provides for the revocation of patents for manufactures wholly or mainly carried on outside the United Kingdom. This enactment introduces a new policy into English patent law, and it may well be that the Court will in future more carefully consider the extent to which the manufacture may be a benefit to the public in the sense of giving employment to British labour. To a certain extent this aspect of the matter was not ignored before the Act. In *Johnson's Patent* (1871, L. R. 4 P. C. at p. 80) James, L.J., said: "The merits of the case, so far as regards the English patent, appear to their lordships to be nil. The patentee, by taking out a patent in England, has in effect secured to himself a monopoly during a period of fourteen years of the sale of articles manufactured in America, and exported from America here, which would have been manufactured there and exported to this country quite in the same way if no English patent had been taken out, but with this difference, that the patentee would not have had the monopoly of his patent, and would not, therefore, have had any opportunity of securing the monopoly of prices. The merits, therefore, so far as regards the introduction of the invention into this country, seem to their lordships to be nothing."

Sufficiency of  
remunera-  
tion.

"Merit" is a vague term. Different persons have different ideas as to wherein it consists. Each case that comes before the Court must of necessity, therefore, be decided upon the facts of that particular case. It is otherwise with the other necessary condition for an extension, viz., the inadequacy of the remuneration of the inventor. Here figures can be dealt with, and a nearer approach to uniformity of decision obtained. It is possible, therefore, to gather from the various decisions a reasonably accurate set of rules for the guidance of the applicant for an extension on the ground of the inadequacy of the remuneration.

The sufficiency of the remuneration will be estimated with a view to the importance of the invention and the benefit the public have derived from it. That which would be ample remunera-

tion for one patent would be considered inadequate for another. Refining sugar by filtering it through animal charcoal was an invention of great value and importance. The patent was extended for six years on the ground that although there had been a considerable profit it bore no relation to the great merit of the invention (g).

The account of profit and loss must be clear and precise.

In *Wüterick's Patent* (1903, 20 R. P. C. 286), Lord Macnaghten said: "That the accounts presented to them have been honestly kept, and have been honestly made out by the accountant, their lordships do not doubt, nor do they doubt that the accountant has done his best to present the accounts to them in an intelligible form; but still the fact remains that their lordships are unable to discover from the accounts put before the Committee what is the remuneration that the patentee has actually received. What a patentee intending to come for prolongation of his patent ought to do is stated very plainly in a judgment of Lord Chelmsford in *Betts' Patent* (1862, 1 Moo. P. C. N. S. 49). It was repeated by Lord Cairns in perhaps stronger language in *Saxby's Patent* (1870, L. R. 3 P. C. 294; 7 Moo. P. C. N. S. 82), and it has been recently repeated in a judgment delivered by Lord Davey in the matter of *Henderson's Patent* (1901, 18 R. P. C. 449)."

Accounts  
must be clear.

In *Hughes' Patent* (1898, 15 R. P. C. 371), the petitioner had kept no books, but shortly before the presentation of the petition he had marked upon certain cheques drawn upon his private account approximately the amounts expended by him in working the patent. Upon these materials the accounts accompanying the petition were made up by the accountant. There were no vouchers or other corroboration. Prolongation was refused.

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 (h). And where the accounts were prima facie satisfactory, the petitioners

(g) *Derosne's Patent*, 1844, 2 W. P. C. 1; *Newton's Patent*, 1861, 14 Moo. P. C. C. 156. (h) *Wield's Patent*, 1871, L. R. 4 P. C. 89.

were allowed to prove the merits of the invention before going into the accounts (*i*). 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 (*k*). This was an exception to the general rule, which is, that evidence will not be received from the petitioner; but in the absence of the books, without reasonable excuse, everything will be taken most strongly against the petitioner (*l*).

Perfect accounts sometimes excused.

But in exceptional cases, where a strong prima facie case has been made out, the filing of perfect accounts may be excused (*m*). 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 (*n*).

And where the invention was of exceptional merit, and it was clear that a loss of about 8,000*l.* had been incurred, it was held that extreme accuracy in the accounts was unnecessary (*o*).

Should the accounts filed in the first instance be unsatisfactory, an adjournment of the hearing will sometimes be granted to allow the petitioner to amend (*p*), but good reason must be disclosed, as otherwise the petition will be dismissed (*q*).

Patentee's distinguished from manufacturer's profits.

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; and the profits that he would in any case have made in his capacity of a manufacturer will not be taken as patentee's profits (*r*). But in some cases

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| ( <i>i</i> ) <i>Houghton's Patent</i> , 1870, L. R. 3 P. C. 461; 7 Moo. P. C. N. S. 309.  | P. C. C. 217; 2 W. P. C. 247.  |
| ( <i>k</i> ) <i>Hutchinson's Patent</i> , 1861, 14 Moo. P. C. C. 364.   | ( <i>o</i> ) <i>Darby's Patent</i> , 1891, 8 R. P. C. 380, 384.  |
| ( <i>l</i> ) <i>Lawrence's Patent</i> , 1892, 9 R. P. C. 85; see also <i>Yates and Kellett's Patent</i> , 1887, L. R. 12 A. C. 147; 4 R. P. C. 150. | ( <i>p</i> ) <i>Johnson and Atkinson's Patents</i> , 1873, L. R. 5 P. C. 87.   |
| ( <i>m</i> ) <i>Lowe's Patent</i> , 1846, 10 Jur. 363.  | ( <i>q</i> ) <i>Newton's Patent</i> , 1884, L. R. 9 A. C. 592; 1 R. P. C. 177; <i>Yates and Kellett's Patent</i> , 1887, L. R. 12 A. C. 147; 4 R. P. C. 150. |
| ( <i>n</i> ) <i>Heath's Patent</i> , 1853, 8 Moo.   | ( <i>r</i> ) See Lord Brougham's remarks in <i>Galloway's Patent</i> , 1843, 1 W. P. C. at p. 729.   |

the very fact of the ownership of the patent will be sufficient to greatly increase the number of orders he will receive as a manufacturer, and such matters will be taken into account in considering the remuneration. In *Saxby's Patent* (1870, L. R. 3 P. C. 295), Lord Cairns said: "It has been decided more than once by this Committee (s) that where the patentee is also the manufacturer, the profits which he makes as manufacturer, although they may not be in a strict point of view profits of the patent, must undoubtedly be taken into consideration upon a question of this kind. It is obvious that in different manufactures there will be different degrees of connection between the business of the applicant as a manufacturer and his business or his position as the owner of a patent. There may be patents of some kind which have little or no connection with the business of a manufacturer, and there may be patents of a different kind, where there is an intimate connection with the business of the manufacturer; that the possession of the patent virtually secures to the patentee his power of commanding orders as a manufacturer."

The same remarks apply to the reckoning of losses. In *Also losses.* *Thornycroft's Patent* (1899, 16 R. P. C. 202), the owners of the patent, which was granted for a new form of marine boiler, had constructed boilers for ships built by other firms, and on these there had been a profit. They also built a vessel (the "Speedy") themselves, and equipped her with boilers. On this vessel the firm made a great loss, and in estimating the loss they divided the total loss between the boilers and the vessel without the boilers in proportion to their relative cost; thus obtained, the loss attributable to the boilers was about 5,000*l.* Lord Davey said: "It appears, however, on cross-examination, that the tenders for the 'Speedy' . . . contained separate prices for the boilers and for the boat, and the difference between the contract price and the actual cost of the boilers of the 'Speedy' was 688*l.* only. Their lordships think that the proportion of loss attributed to the boilers is ascertained on a fallacious principle. . . . No explanation whatever has been

(s) See *In re Betts' Patent*, 1862, and *Robinson's Patent*, 1896, 13 1 Moo. P. C. N. S. 49, also *Willans* R. P. C. 550.

offered why this large loss was incurred in building boats fitted with the patent boilers for themselves, while a handsome profit was made on supplying the boilers for boats built by other builders. In the absence of any explanation, the facts proved are consistent with the existence of some error of judgment, miscalculation, or other defect in the petitioners' mode of carrying on their business of boat-building."

Deduction  
allowed.

In estimating profits, a deduction will be allowed for the expenses of experiments in bringing the invention to perfection (*t*).

The expenses of taking out the patent will be allowed as deduction (*u*). So also will the expenses incurred in bringing the invention into general public use (*x*). 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 (*y*). The amount allowed will depend on the circumstances of the case (*z*), but it must be quite clear to what extent the patentee has given his time (*a*). 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 (*b*), but where the relations between the inventor and the agent were those of partners, the share of the agent had to be brought into account as profits (*c*). And deductions will also be allowed 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*).

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| ( <i>t</i> ) <i>Bate's Patent</i> , 1836, 1 W. P. C. 739, n.;                              | ( <i>b</i> ) <i>Poole's Patent</i> , 1867, 4 Moo. P. C. N. S. 452; L. R. 1 P. C. 514.   |
| <i>Kay's Patent</i> , 1839, 1 W. P. C. 572; <i>Davies's Patent</i> , 1894, 11 R. P. C. 28. | ( <i>c</i> ) <i>Pieper's Patent</i> , 1895, 12 R. P. C. 292.  |
| ( <i>u</i> ) <i>Roberts' Patent</i> , 1839, 1 W. P. C. 575.                                | ( <i>d</i> ) <i>Kay's Patent</i> , 1839, 1 W. P. C. 572; <i>Galloway's Patent</i> , 1843, 1 W. P. C. 729; <i>Betts' Patent</i> , 1862, 1 Moo. N. S. 62. |
| ( <i>x</i> ) <i>Galloway's Patent</i> , supra.   | ( <i>e</i> ) <i>Hill's Patent</i> , 1863, 1 Moo. N. S. 258.   |
| ( <i>y</i> ) <i>Carr's Patent</i> , 1873, L. R. 4 P. C. 539.                               |   |
| ( <i>z</i> ) <i>Bailey's Patent</i> , 1884, 1 R. P. C. 2.                                  |   |
| ( <i>a</i> ) <i>Turner's Patent</i> , 1885, 2  |   |

The profits of persons interested in the patent, such as part assignees or free licensees (*f*), must be shown, but not necessarily those made by licensees who pay a royalty (*g*). Profits of interested parties.

And in *Johnson's Patent* (1871, L. R. 4 P. C. 75), Lord Justice James said: "Their lordships are of opinion that, where the question to be considered is, whether an invention has been sufficiently remunerative 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 to the patentee, *whether it be in one country or another*" (*h*).

Probable future profits must also be taken into account. In *Johnson's Patent* (1908, 25 R. P. C. at p. 727), Mr. Justice Parker said: "For the purpose of considering whether a patentee has been inadequately remunerated I am of opinion (1) that profits on his corresponding foreign patents as well as on his English patents must be taken into account, and (2) that some allowance ought properly to be made for profits *which, though not yet received, will in all probability be received* in respect of both the English and the foreign patents before their expiration. The petitioner in the present case admits a realised profit in respect of the American patent of some 7,500*l.*, and in respect of the English patent of over 1,000*l.* Unless something very unforeseen happens, he will receive further profits in respect of both the English and American patents, and he anticipates that under the American patent his receipts will be very considerable—more, in fact, than he has yet realised in America. Under these circumstances I am not satisfied that he can be said to have been inadequately remunerated, having regard to the nature and character of his invention." Future profits and foreign patents.

Where the patent has been granted on a communication from abroad it must be established that the foreign inventor has been insufficiently remunerated, or at least sufficient

(*f*) *Thomas' Patents*, 1892, 9 R. P. C. 367, 373. 1866, L. R. 1 P. C. 118; 3 Moo. P. C. N. S. 488.

(*g*) *Thomas' Patents*, 1892, 9 R. P. C. 367; cf. *Trotman's Patent*, (h) See also *Hardy's Patent*, 1849, 6 Moo. P. C. C. 441.



information must be given to enable the Court to form an opinion as to his position in the matter (i).!

Sect. 25 of the Patent Law Amendment Act, 1852, 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; consequently an inquiry into foreign patents and their duration was always an essential element of the proceedings before the Privy Council (k). The lapse of a foreign patent the date of which was subsequent to the date of protection obtained in England for the same invention did not affect the English patent, and was no objection to its prolongation (l).

This Act, however, was specifically repealed, and by sect. 45, sub-sects. 2 and 3 of the Act of 1883, it was provided:—

*“Every patent granted before the commencement of this Act, or on an application then 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.”*

Dealing with this repeal and its effect, Lord Watson, in *Semet and Solvay's Patent* (1895, 12 R. P. C. 17), said: “But the lapse or expiry of foreign patents remains, as it always has been, one of the circumstances which must necessarily be considered. . . . In cases where the prolongation of a patent would place the inhabitants of Great Britain and Ireland at a disadvantage in competition with the subjects of a foreign

(i) *Peach's Patent*, 1802, 19 R. P. C. 65.

(k) *Bodmer's Patent*, 1849, 8 Moo. P. C. C. 282; *Newton's Patent*, 1862, 15 Moo. P. C. C. 176; *Betts' Patent*, 1862, 1 Moo. P. C. N. S. 49; *Johnson's Patent*, 1871, 8 Moo. P. C. N. S. 282; L. R. 4 C. P. 75.

(l) *Betts' Patent*, 1862, 1 Moo. P. C. N. S. 49; *Poole's Patent*, 1867, 4 Moo. P. C. N. S. 452; *Adair's Patent*, 1881, L. R. 6 App. Cas. 176; 50 L. J. P. C. 68; but see *Blake's Patent*, 1873, L. R. 4 P. C. 535; 9 Moo. P. C. N. S. 373.

State, that circumstance must militate strongly against its extension. Whether the disadvantage, either certain or probable, ought to outweigh the right of the patentee to obtain a renewal upon other grounds, must always be a question of degree, to be decided according to the special circumstances of each case (*m*). But the profits derived from foreign patents must be set out clearly, as they are considered with 'all the circumstances of the case'" (*n*).

The practice is regulated by rule 3 of Order LIII. A (see *Practice. Appendix*), which, "taken in connection with the rules of the Supreme Court which (by rule 2) are made applicable, forms in itself a code by which all questions relating to petitions for the extension of patents ought to be governed as to matters of practice" (*o*).

The practice is substantially similar to that under the Privy Council Rules, and it is anticipated that the cases herein referred to decided by the Privy Council will guide the Court.

Two or more patents might be made the subject of one petition (*p*). The Attorney-General appears on behalf of the Comptroller and the Board of Trade. His duty is as much to assist and instruct the Court as to oppose, and indeed only to oppose when in his judgment prolongation should not be granted (*q*).

Any person may give notice of opposition, which must be lodged and served before the day named in the petitioner's advertisements as that on which he intends to apply for a day to be fixed for hearing the petition, and no extension of the time will be granted unless good reason is shown (*r*). The petitioner must then serve a copy of the petition upon the objector, who within three weeks of such service must serve upon the petitioner "particulars of objections" (rule 3 (1)).

(*m*) And see *Pieper's Patent*, 1895, L. R. 3 P. C. 421; *Johnson's and Atkinson's Patent*, 1873, L. R. 5

(*n*) *Newton's Patent*, 1884, 1 P. C. 87; *Church's Patent*, 1886, R. P. C. 177; *Barff and Bower's Patent*, 1895, 12 R. P. C. 385. 3 R. P. C. 95.

(*o*) *Parker, J., in Johnson's Patent*, 1888, 5 R. P. C. 522.

(*p*) *Parker, J., in Johnson's Patent*, 1908, 25 R. P. C. at p. 544. (*q*) *Stoney's Patent*, 1888, 5 R. P. C. 522.

(*r*) *Hopkinson's Patent*, 1896, 13 R. P. C. 114.

In *Johnson's Patent* (1908, 25 R. P. C. 542), among other matters, the objector stated that the alleged invention "was not novel." A summons was taken out for further and better particulars, and Parker, J., said: "It . . . appears to me that rule 3 (l) is drawn in such a way as to give the Court considerable latitude as to what particulars it may in any particular case be necessary and proper for the objector to give. On the one hand, I do not think it would be at all desirable that a bona fide objector should be bound down by objections given at an early stage of the proceedings, or rather particulars of the objections given at an early stage of the proceedings, because he might acquire some valuable evidence on, say, the question of novelty which it would be his duty at a subsequent stage to communicate to the Court on behalf of the public (s). On the other hand, it would be only fair, having regard to the nature of the proceedings, that he should be tied down, and accordingly that provision is made in the rule. In considering what particulars of the objections, on which he is entitled to rely and of which he gives notice, he ought to give in the document which states the grounds of his objection, I think that really the considerations which apply are those considerations which apply to pleadings generally. It is, in my opinion, only fair that a petitioner should at the earliest possible stage get to know what it is alleged prevents his patent from being considered novel or from having subject-matter. . . . If any prior user is intended to be relied on, some particulars of that prior user ought to be given, and it ought not to be sprung upon the petitioner at the trial. . . . Similarly, if there has been anticipation by a document, he ought to be informed what that anticipation is, because the existence of that anticipation may lead him to withdraw his petition."

The Crown may rely on prior publications without giving any notice (rule 3 (t), and see note (d)).

The Court may give costs to or against opponents (rule 3 (u)). Where the petition had been very honestly prepared

(s) See *Ball's Patent*, 1879, L. R. 4 1886, 3 R. P. C. 9; *Livet's Patent*, App. Cas. 171; *Stewart's Patent*, 1892, 9 R. P. C. 327.

and the invention was of merit, but the petition was dismissed on the ground that the petitioner had been sufficiently remunerated, and the effect of the opposition had been merely to prolong the inquiry, costs were refused the opponent (*t*).

Under rule 3 (*v*), following the Privy Council practice as laid down in *Wield's Patent* (1871, L. R. 4 P. C. 92; 8 Moo. P. C. N. S. 300), the Court will not, save under special circumstances, grant more than one set of costs amongst all the opponents.

Whether the petition be opposed or not, the petitioner must formally prove his case (*u*).

Rule 3 (*s*), corresponding to rule 7 of the old Privy Council rules, enables the Court to excuse petitioners and opponents from compliance with the rules and to give such directions in matters of procedure and practice as it shall consider just and expedient (*x*). This does not, however, enable the Court to excuse non-compliance with statutory requirements (*y*).

The Privy Council in *Goucher's Patent* (1865, 2 Moo. P. C. N. S. 532) decided that, having once granted an extension, they had no power to entertain a petition for a further extension under the laws then in force. The reasoning is applicable to the present law and was followed by Parker, J., in *Thompson's Patent* (No. 2) (1909, 26 R. P. C. 673).

It is the practice for the Court to make an order for a new grant for the further term specified and containing such terms and conditions as may be imposed.

(*t*) *Muntz's Patent*, 1846, 2 14 R. P. C. 643 (extension of time for advertising).  
W. P. C. 122.

(*u*) *Darby's Patent*, 1891, 8 (y) *Adam's Patent*, 1899, 16  
R. P. C. 383. R. P. C. 1.

(*x*) See, e.g., *Lindon's Patent*, 1897,

## CHAPTER XII.

### THE REMEDY OF THE PUBLIC AGAINST THE PATENTEE.

#### COMPULSORY LICENCE AND REVOCATION.

THE monopoly enjoyed by the patentee and the consequent restraint of trade for his benefit render necessary certain provisions for the protection of the public in cases where it can be shown that the monopoly has been improperly obtained, or where though properly granted it has subsequently been misused. Accordingly the Act of 1908 gives certain remedies to the public against the patentee, some of which are entirely new. They may be briefly set forth before being considered at length.

#### Summary of remedies.

- (a) Under sect. 24, where the reasonable requirements of the public with respect to the patented invention are not satisfied, or a trade is prejudiced by unfair conditions attached to the purchase, hire, or use of the articles the subject of the invention, the Court may order a compulsory licence upon just terms, or if this remedy be not sufficiently drastic it may revoke the patent.
- (b) Under sect. 25, if the patent is invalid for any reason it may be revoked by the Court. And any ground on which a patent may be revoked under this Act by the Comptroller or as an alternative to the grant of a compulsory licence is also a ground of revocation under this section.
- (c) Any person who would have been entitled to oppose the grant may within two years from the date of the patent apply to the Comptroller to revoke the patent on any ground on which it might have been opposed.
- (d) If the patented invention is not sufficiently manufactured or carried on, any person, after the expiration

of four years from the grant, may apply to the Comptroller to revoke the patent under sect. 27.

- (e) Any ground on which a patent might have been revoked either by the Comptroller or by the Court, and especially the fact that the invention is wholly or mainly worked abroad, is by sect. 25 made a defence to an action for infringement.
- (f) A defendant in an action for infringement of a patent, if entitled to present a petition to the Court for the revocation of the patent, may, under sect. 32, without presenting such a petition, counterclaim for the revocation of the patent.
- (g) If the patentee inserts in any contract made after the passing of the Act any of certain onerous conditions specified in sect. 38, this fact is available to the defendant under sect. 38, sub-sect. 4, as a defence to any action for infringement which he may bring while such contract remains in force.

#### PETITION FOR COMPULSORY LICENCE OR REVOCATION.

Under the Act of 1883, where the patentee abused his monopoly in such a manner that (1) the patent was not being worked in the United Kingdom; or (2) the reasonable requirements of the public with respect to the invention were not satisfied; or (3) any person was prevented from working or using an invention of which he was possessed, the Board of Trade might be petitioned to order the patentee to grant a compulsory licence upon such terms as the Board might deem reasonable. The Board appointed a referee, who heard the parties and reported to the Board, but every case so dealt with resulted in a compromise, the order made was by consent, and the terms thereof were never published. There are only a few cases reported of the enactment having been put in force.

By sect. 3 of the Act of 1902 the provisions of the Act of 1883 with respect to compulsory licences were repealed. The petition was thereafter to be referred to the Judicial Committee of the Privy Council, who might order a compulsory licence, or in cases where the Committee were of opinion that the granting

Sect. 24.  
Compulsory  
licence or  
revocation.  
History of  
law.

of licences would be an inadequate remedy they might revoke the patent.

The provision in this enactment for revocation of the patent marked a change in the attitude of the law towards the privileges conferred by letters patent, and probably a reversion to the earlier policy of the Crown. In Mr. J. W. Gordon's learned work on "Compulsory Licences," published in 1899, the history of the law is discussed in a most interesting manner. The author points out that it is only in comparatively recent times that the Courts have adopted the view that the abuse of his privileges by the patentee has been deemed no ground for invalidating the patent (a).

No cases are reported of the Act of 1902 having been put into force.

By the Act of 1908 the Court has been substituted for the Judicial Committee of the Privy Council.

The first two sub-sects. of sect. 24 are as follows :—

(1) "*Any person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a compulsory licence, or, in the alternative, for the revocation of the patent.*

(2) "*The Board of Trade shall consider the petition, and if the parties do not come to an arrangement between themselves the Board of Trade, if satisfied that a primâ facie case has been made out, shall refer the petition to the Court, and, if the Board are not so satisfied, they may dismiss the petition.*"

Petition  
referred to  
Court.

It is to be noticed that this remedy is only available to a "person interested," which indicates that only persons directly affected by the abuse of the monopoly will be heard. The rules compel the petitioner to state his interests on the face of his petition, and to verify them by declaration.

The grievance, which must be shown by the petitioner to entitle him to the remedy, is indicated more clearly in sub-sect. 5 :—

(a) See, e.g., *Badische Anilin und Soda Fabrik v. W. G. Thompson & Sons*, 1904, 21 R. P. C. 478.

“(5) *For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied—*

“(a) *if by reason of the default of the patentee to manufacture to an adequate extent and supply on reasonable terms the patented article, or any parts thereof which are necessary for its efficient working, or to carry on the patented process to an adequate extent or to grant licences on reasonable terms, any existing trade or industry, or the establishment of any new trade or industry in the United Kingdom, is unfairly prejudiced, or the demand for the patented article or the article produced by the patented process is not reasonably met; or*

“(b) *if any trade or industry in the United Kingdom is unfairly prejudiced by the conditions attached by the patentee before or after the passing of this Act to the purchase, hire, or use of the patented article or to the using or working of the patented process.*”

The provision for the circumstances set forth in clause (b) is new and is intended to attack the system of limited licences which have been in vogue during the last ten years or so (b). It must be remembered that by sect. 38 of the Act (see Chap. X.) certain restrictive and burdensome covenants, which were until the passing of this Act often made use of in licences, are declared to be void as being in restraint of trade if inserted in contracts made after the passing of the Act. Such covenants are thus specified by the section:—

Onerous conditions in licences.

“(a) *to prohibit or restrict the purchaser, lessee, or licensee from using any article or class of articles, whether patented or not, or any patented process, supplied or owned by any person other than the seller, lessor, or licensor or his nominees; or*

“(b) *to require the purchaser, lessee, or licensee to acquire from the seller, lessor or licensor, or his nominees, any article or class of articles not protected by the patent.*”

Now such covenants being void *ab initio*, it is clearly not to

Will apply to legally

(b) See, e.g., *The Incandescent Gas Light Co. v. Cantelo*, 1895, 12 R. P. C. 262. Chap. X.



valid conditions.

these that clause (b) of sub-sect. 5 applies; it is apparently contemplated that the kind of oppressive condition aimed at by sub-sect. 5 (b) of sect. 24 may legally be quite binding, such, for example, as the stipulation for a minimum price at which the patented article may be sold, in which case it might be possible to show either that the trade in that article was unfairly prejudiced, or that manufactures in which the article was used could not be carried on under reasonable conditions. Again, it might be that the patentee imposed restrictions as to price upon one licensee which he dispensed with in the cases of other licensees. In such cases compulsory licences at a reasonable price might be ordered.

Sub-sect. 3 empowers the Court to order the patentee to grant licences upon such terms as it may think just, or if it is of opinion that the reasonable requirements of the public will not be satisfied by the grant of licences, it may revoke the patent—

*“ Provided that an order of revocation shall not be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default.”*

It will be seen that the Court has extensive power to prevent abuse of the patentee's monopoly; and, on the other hand, the requirements which a patentee has to fulfil are sufficiently elastic to prevent hardship.

The evil arrived at is not that with which sect. 27 is designed to deal. Here the patentee is required to license or to lose his patent because the public cannot obtain the invention on reasonable terms. Sect. 27 is for the purpose of preventing the public choice from being restricted to foreign supplies only and enabling manufacturers to manufacture at home for home and foreign markets without unreasonable hindrance.

“ Satisfactory reasons ” for default.

What is necessary to constitute a “ satisfactory reason ” for the default is difficult to imagine, but it will certainly be more difficult to establish than a “ satisfactory reason ” under sect. 27; it is not easy, however, to see how a case of such abuse could be so serious as to be incurable by a compulsory licence. Perhaps revocation would be justified as a punishment for

misfeasance in the past. One might suppose, for example, a case in which the invention consisted in the artificial manufacture of what had previously been obtained from nature, such as indigo. The patentee might put the artificial product on the market at such a price as to cause all the natural sources to be abandoned and their industries to be ruined; and then when there was no further competition he might raise the price of his own product to an oppressive degree. Such an abuse (*i.e.*, in raising the price) might justify revocation.

The enforcement of the order for a compulsory licence is no longer effected by mandamus as under the Act of 1883. By sub-sect. 6 it is enacted:—

Enforcement  
of order.

*“An order of the Court directing the grant of any licence under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a licence and made between the parties to the proceeding.”*

The practice in presenting the petition to the Board of Trade is regulated by rules 68—74 of the Patents Rules, 1908 (see Appendix). Practice.

The practice before the Court is dealt with in Rule 7 of Order LIII. A (c). Sub-sect. 4 of sect. 24 of the Act is as follows:—

*“On the hearing of any petition under this section the patentee and any person claiming an interest in the patent as exclusive licensee or otherwise, shall be made parties to the proceeding, and the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.”*

The law officer will of course represent the public and will call the attention of the Court to any terms in the proposed compulsory licence which might tend to give the petitioner any unfair advantage over other traders, and any circumstances which might justify revocation of the patent.

The decision of the judge is final, and there is no appeal (see sect. 92) (c).

(c) See Appendix.

Revocation  
under  
sect. 25.

REVOCATION UNDER SECTION 25.

Under sect. 25:—

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

“(2) *Every ground on which—*

“(a) *a patent might, immediately before the first day of January, one thousand eight hundred and eighty-four, have been repealed by scire facias; or*

“(b) *a patent may be revoked under this Act either by the Comptroller or as an alternative to the grant of a compulsory licence;*

*shall be available by way of defence to an action of infringement and shall also be a ground of revocation under this section.”*

The Act of 1883 abolished the proceeding of *scire facias*, which had already fallen into desuetude, and had substituted the petition for revocation.

Expired  
patent.

The Court of Appeal in *The North Eastern Marine Engineering Co. v. Leeds Forge Co.* (1906, 23 R. P. C. 529) seemed to be of opinion that a petition would lie to revoke an expired patent.

By sect. 30, sub-sect. 9, no petition for revocation will lie in respect of a patent granted for an invention which the Secretary of State has certified should be kept secret in the interest of the public service.

Grounds of  
Revocation.

The grounds upon which a patent may be revoked are those upon which it might have been cancelled by *scire facias*. These are in the Fourth Institute (p. 88) said to be: “*Firstly, when the king by his letters patent doth grant by several letters patent one and the self-same 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* (about 1680,

2 Vent. 344) 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 of the Act of 1883 (re-enacted as sub-sect. 3 of sect. 24 of the Act of 1907) very considerably narrowed and limited this general right.

There is no such remedy as a declaration of invalidity, and if it is desired to establish invalidity it is necessary to petition for revocation (*d*).

Nearly every 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.

Under (b) the Court is given original jurisdiction to revoke a patent upon a petition alleging any facts which would have enabled the Comptroller to have revoked under sects. 26 or 27. It must be remembered that appeals from decisions of the Comptroller upon applications to revoke under sects. 26 and 27 lie to the Court. Sect. 92, sub-sect. 2, is as follows:—

*"Where by virtue of this Act a decision of the Comptroller is subject to an appeal to the Court, or a petition may be referred or presented to the Court, the appeal shall, subject to and in accordance with rules of the Supreme Court, be made and the petition referred or presented to such judge of the High Court as the Lord Chancellor may select for the purpose, and the decision of that judge shall be final, except in the case of an appeal from a*

(*d*) *The North Eastern Marine Engineering Co. v. Leeds Forge Co.*, 1906, 23 R. P. C. 529.

*decision of the Comptroller revoking a patent on any ground on which the grant of such patent might have been opposed."*

This section has been explained by the Patents and Designs Act, 1908 (8 Edw. VII., c. 4), passed expressly for that purpose. Sect. 1 of this Act is as follows:—

Right to  
appeal under  
sect. 25.

*"It is hereby declared that so much of sub-section (2) of section ninety-two of the Patents and Designs Act, 1907, as provides that the decision of a judge of the High Court to whom a petition is presented by virtue of that Act is to be final does not apply in the case of a petition for the revocation of a patent under section twenty-five of that Act."*

If therefore it is desired to carry the petition to the Court of Appeal and the House of Lords it should in most cases be presented to the Court under sect. 25 and not to the Comptroller in the first instance.

The Act makes a distinction between persons who are entitled to petition as of right and persons who must first obtain the fiat of the Attorney-General; by sub-sect. 3—

*"A petition for revocation of a patent may be presented—*

*"(a) by the Attorney-General or any person authorised by him; or*

*"(b) by any person alleging—*

Persons  
entitled of  
right.

*"(i.) that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims; or*

*"(ii.) 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; or*

*"(iii.) 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."*

It will be seen that it is necessary that one of the three grounds specified under clause (b) should be established in order to give the petitioner a locus standi unless he had previously obtained the fiat of the Attorney-General. But a person who is entitled to present a petition for revocation

without the necessity of first obtaining the fiat of the Attorney-General may rely upon any lawful ground whereby to impeach the validity of the patent in question, and is not confined to the ground upon which his title to present the petition is based (e).

If, however, the petitioner should fail to establish the ground which would have given him his locus standi, it is submitted that he cannot proceed upon the other grounds alleged by him, but must retire to obtain the fiat of the Attorney-General to enable him to allege such other grounds of objection. In *Max Müller's Patent* (1907, 24 R. P. C. 465) the petitioners proceeded without the fiat, alleging that certain persons through whom they claimed were the true and first inventors of the invention patented by the respondent, and relied also on other grounds affecting the validity of the patent. During the course of the trial it became doubtful whether the first ground of objection could be sustained. Parke, J., gave leave to the petitioners to apply for the fiat, which, if granted, was to be treated as having been granted *nunc pro tunc*, and directed that the petition should be treated as having been technically amended by inserting an allegation that the fiat had been obtained, and expressed a doubt as to whether the petitioners had any locus standi if the fiat were not granted. It is to be noticed, however, that if it were merely necessary to allege one of the grounds set forth in the sub-section in order to dispense with the fiat, without any obligation to prove it, no one would ever incur the expense and trouble of laying the case before the Attorney-General. In any case it is a useful measure of precaution to obtain the fiat. The hearing of the petition may be adjourned to enable the petitioner to apply for the fiat (f). The clauses defining the grounds which entitle a petitioner to proceed without the fiat are strictly construed, and care must be taken that the petition is framed under the proper clause.

The fiat of  
the Attorney-  
General.

*In re Avery's Patent* (1887, L. R. 36 C. D. 307; 4 R. P. C. 322) was a petition for revocation presented under clause (c)

(e) *Morgan's Patent*, 1888, 5 at p. 452; *Jameson's Patent*, 1902, R. P. C. 106. 19 R. P. C. at p. 250.

(f) *Dege's Patent*, 1895, 12 R. P. C.

(clause (i.) under the Act of 1907); 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." The petition consequently was dismissed, but without prejudice to the right of the petitioner to present a fresh petition framed under clause (d) (clause (ii.) under the Act of 1907).

In those cases in which a petition for revocation may be presented to the Comptroller with a subsequent appeal to the Court the fiat is not required if this course be adopted, though it would be necessary if the petition were presented direct to the Court in the first instance under sect. 25.

If the patent be revoked on the ground of fraud, the first and true inventor may apply to the Comptroller under sub-sect. 2 of sect. 15 for a patent to be granted to him in lieu thereof, but the Comptroller is not bound to accede to the application, and retains his discretion as in any ordinary application (*g*). This right will not apply where the petition is under clause (ii.) only.

To obtain  
the fiat.

In order to obtain the Attorney-General's fiat the following documents must be lodged with the Attorney-General's clerk:—

1. A memorial drawn up on judicature paper setting out the history of the case and the grounds upon which the application is based; where there have been proceedings taken for infringement, these and their result must be mentioned. This memorial must be accompanied by all specifications and documents referred to.

(*g*) *Norwood's Patents*, 1895, 12 R. P. C., per Stirling, J., at p. 219.

2. A declaration by the petitioner verifying the statements in the memorial; this also should be upon judicature paper.

3. Two copies of the proposed petition on brief paper.

4. Two copies of the particulars of objections.

5. A certificate by counsel on foolscap, that in his opinion the petition is a proper one for the grant of the fiat of the Attorney-General.

6. A certificate by a solicitor that the applicant is a proper person to present the petition, and that he is competent to answer the costs of all proceedings in connection with the petition.

7. A declaration by the applicant that the questions proposed to be raised by the petition are not and cannot be raised in any legal proceedings then pending in the United Kingdom.

The fees payable on lodging these documents amount to 2*l.* 13*s.* 4*d.*

The costs of obtaining the fiat are recoverable if the petition proves successful (*h*).

The seventh of the above-mentioned documents will not be required when it is proposed to counterclaim under sect. 32 for revocation in an action for infringement. Sect. 32 is as follows:—

*“A defendant in an action for infringement of a patent, if entitled to present a petition to the Court for the revocation of the patent, may, without presenting such a petition, apply in accordance with the rules of the Supreme Court by way of counterclaim in the action for the revocation of the patent.”* But it is to be noted that unless properly qualified a defendant must obtain the fiat of the Attorney-General for his counterclaim for revocation.

Counter-  
claim for  
Revocation.

This section introduces a new form of procedure. Formerly, if the defendant in an action for infringement desired the revocation of the patent sued on, he had to present a petition independently, and then apply for the two cases to be tried together.

If the defendant does not counterclaim and obtain the Estoppel.

(*h*) *Poulton's Patent*, 1906, 23 R. P. C. 571.



revocation of the patent, a judgment in an action for infringement either for or against the validity of a patent does not create an estoppel in a petition for revocation. In *The Shoe Machinery Co., Ltd. v. Cutlan* (1895, 12 R. P. C. 533) Smith, L.J., said: "We held in *Deeley's Patent* (1895, 12 R. P. C. 199) that in a petition for revocation of a patent there was no estoppel, because the person petitioning . . . stands as one of the public, and not as an individual; and although the person petitioning for revocation may be the same person against whom judgment has been given in a patent suit, there is no estoppel against him when he petitions, because he appears as one of the public" (i).

The Attorney-General has absolute discretion in granting or refusing his fiat; but cases are unlikely to arise in which the fiat will be refused (k). If the applicant shows sufficient interest, and makes out a good case, the Attorney-General will grant his fiat without hearing the patentee (l), but in some cases (e.g., as in *Martin's Patent*, Griff. P. C. 320, where the applicant was a licensee under the patent) he will direct notice to be given to the persons interested in the patent, and will hear both parties and give his decision in the ordinary way (m). Sir H. James, A.-G., decided that he had no power under sect. 38 of the Act of 1883 to give costs in these cases (n).

The form of the fiat of the Attorney-General will be found in the Appendix.

**Practice.**

The practice before the Court is partly regulated by Order LIII. A. By rule 11 the petitioner is bound to deliver particulars of the objections on which he intends to rely, and the degree of particularity required, and the consequences, so far as costs are concerned, are precisely the same as in the case of the particulars delivered in an action for infringement.

(i) And see *Re Lewis' Patent*, 1897, 14 R. P. C. 35; *Jameson's Patent*, 1902, 19 R. P. C. 252.

(k) Per A. L. Smith, L.J., in *The Shoe Machinery Co. v. Cutlan*, 1895, 12 R. P. C. 533.

(l) *Gaulard and Gibbs Patent*, Griff. P. C. 320; *Rothwell's Patent*,

Griff. P. C. 320.

(m) And see *Bell and Coleman's Patent*, Griff. P. C. 320; *Siddell's Patent*, Griff. P. C. 320; *Watling's Patent*, Griff. P. C. 320.

(n) *Martin's Patent*, Griff. P. C. 320.

By rule 12 the respondent is entitled to begin and give evidence in support of the patent, and if the petitioner gives evidence impeaching the validity of the patent the respondent is 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 of reply that the respondent is made practically plaintiff at the trial.

The usual practice is to allow the petition to appear in the petition list, nominally for hearing; a patent may be revoked at this stage when a clear case is made out (*o*). The order for revocation will, however, only be made in open Court and not in chambers, even though the respondent consent (*p*); but the usual course is for the judge to give directions as to the filing of an answer, and also as to interrogatories, inspection, discovery, &c., and the manner of trial, after which the petition stands adjourned.

A day should be fixed before which the petition is not to come on for trial, and the day should not be fixed earlier than that on which the parties will be ready (*q*).

It is advisable to ask for directions as to the persons to be served with the petition if there are any parties interested in the patent other than its actual owners, since it is possible that by serving licensees extra costs may be incurred, although such persons may have taken no active part in the trial at all (*r*). But all persons whose names appear upon the register as beneficially interested should be served.

Where an assignment had been executed after the petition had been presented, the name of the assignee was ordered to be substituted for that of the original respondent to the petition (*s*).

- (*o*) *Vaisey's Patent*, 1894, 11 R. P. C. 160.  
 R. P. C. 591. (*r*) See, e.g., *Brown's Patent*, 1907,  
 (*p*) *Clifton's Patent*, 1904, 21 24 R. P. C. 313.  
 R. P. C. 515. (*s*) *Haddan's Patent*, 1885, 2  
 (*q*) *Borrowman's Patent*, 1902, 19 R. P. C. 218.

Where the patentee or other person interested in the patent is out of the jurisdiction, notice should be given to such person by registered letter that the petition has been presented (*t*), as the Court will not decree the revocation of a patent without giving all interested parties an opportunity of being heard, but the mere fact that the patentee is out of the jurisdiction will not prevent the institution of proceedings for revocation (*u*).

A respondent residing out of the jurisdiction will not be ordered to give security for costs (*x*).

Order XXXI., rule 1, of the Rules of the Supreme Court gives power to the Court, or a judge, to permit interrogatories "in any cause or matter," to be delivered by either party to the other, and leave will be given to the respondent (called defendant in the Patent Act, 1883) to deliver interrogatories to the petitioner. Circumstances may arise when it would be just to permit the petitioner to examine the respondent. The rules as to interrogatories are similar to those in an action for infringement.

The petition may be tried at the assizes if convenient (*y*); but by sect. 31, sub-sect. 1, the trial is to be without a jury unless otherwise ordered. In modern practice patent actions are almost invariably tried in the Chancery Division.

The parties are entitled to have the petition heard with *vivá voce* evidence (*z*).

In cases where the patent was invalid on the ground of want of novelty in part, which defect might be cured by amendment, the Court usually followed the order made in *Deeley v. Perkes* (1896, 13 R. P. C. 581; 1896, L. R. A. C. 496), by which the

Amendment  
of specifica-  
tion.

- |   |   |
|---|---|
| ( <i>t</i> ) <i>Drummond's Patent</i> , 1889, 6 R. P. C. 576; L. R. 43 Ch. D. 80;   | 500.  |
| <i>La Compagnie Générale d'Eaux Minérales Trade Marks</i> , 1891, 8 R. P. C. 446; 1891, L. R. 3 Ch. 451; <i>F. King &amp; Co.'s Trade Mark</i> , 1892, 9 R. P. C. 350; 1892, L. R. 2 Ch. 462; <i>Kay's Patent</i> , 1893, 11 R. P. C. 279; <i>Goerz and Hoegh's Patent</i> , 1895, 12 R. P. C. 370; <i>Cerckel's Patent</i> , 1898, 15 R. P. C. | ( <i>u</i> ) <i>Ibid.</i>   |
|   | ( <i>x</i> ) <i>La Société Anonyme Trade Mark</i> , 1893, 10 R. P. C. 290; <i>Miller's Patent</i> , 1894, 11 R. P. C. 55. |
|   | ( <i>y</i> ) <i>Edmond's Patent</i> , 1889, 6 R. P. C. 355.   |
|   | ( <i>z</i> ) <i>Gaulard and Gibbs' Patent</i> , 1887, L. R. 34 C. D. 396; 56 L. J. Ch. 606; 56 L. T. 284.                 |

patent was ordered to be revoked unless within a given time the patentee applied at the Patent Office to amend by a specified disclaimer and unless such disclaimer was allowed.

This course was followed because if the order to revoke had not been made conditional, the Comptroller would have been unable to amend the specification of a patent which did not exist. This difficulty arose in *Deeley v. Perkes* (supra), and was thus surmounted.

Under sect. 22 the Court now has power in an action for infringement or petition for revocation to make an order amending the specification by way of disclaimer. By rule 23 of Order LIII.<sup>A</sup> the application to amend must be made by way of motion, and directions may be given by the judge as to advertisements, &c., and the Comptroller is to be notified. It is supposed that this procedure will take the place of the conditional order formerly made, and the Court will postpone judgment in order to give the patentee an opportunity to apply under the section. The order will be made subject to suitable terms. (See Chap. IX. on "Amendment.")

By sub-sect. 3 of sect. 26, *A patentee may at any time by giving notice in the prescribed manner to the Comptroller offer to surrender his patent, and the Comptroller may, if after giving notice of the offer and hearing all parties who desire to be heard he thinks fit, accept the offer, and thereupon make an order for the revocation of the patent.*

Surrender of  
patent.

This remedies an evil of long standing. Formerly there was no way of surrendering a patent. Consequently a patentee who had an invalid patent and who had no desire to utilise it, being aware of its deficiencies, might be put to the annoyance of having to submit to an order for revocation and to pay the costs of the petitioner even when the order was made by consent. The Comptroller need only hear such persons as he deems to have a right to be heard, and it is probable that only persons who have an interest in the existence of the patent will have the right to object, *e.g.*, exclusive licensees. But the Act makes no mention of the manner in which the interests of such persons are to be protected, as by compensation or otherwise, and it would be manifestly unfair to allow a patentee to

use the section to surrender a valuable patent as a weapon to bring a licensee to his knees on a subject of royalties. By sub-sect. 4 the decision of the Comptroller is made subject to appeal to the judge, and the decision of the judge is final. The procedure before the Comptroller is regulated by Patents Rule 77, and before the Court by Order LIII.A, rules 4, 5, 6.

Revocation  
under sect. 26  
by Comptroller.

#### REVOCATION BY THE COMPTROLLER UNDER SECT. 26.

Sub-sect. 1 of sect. 26 is as follows:—

*Any person who would have been entitled to oppose the grant of a patent, or is the successor in interest of a person who was so entitled, may, within two years from the date of the patent, in the prescribed manner apply to the Comptroller for an order revoking the patent on any one or more of the grounds on which the grant of the patent might have been opposed.*

*Provided that when an action for infringement or proceedings for the revocation of the patent are pending in any court, an application under this section shall not be made except with the leave of the Court.*

This remedy is limited to a particular class of persons, viz., those who would have been entitled to oppose. The necessary qualifications are dealt with in Chap. VIII., on "Opposition to the Grant." The time for making the application is limited, and amounts in effect to an extension of the time for opposition. The grounds for revocation are also limited, and are specified in sect. 11 and dealt with at p. 155. It is to be noticed that by sect. 92 an appeal lies to the judge of the High Court selected by the Lord Chancellor, "*and the decision of that judge shall be final, except in the case of an appeal from a decision of the Comptroller revoking a patent on any ground on which the grant of such patent might have been opposed.*" A difficulty is created by these words. If they are construed strictly it will follow that in a case where the Comptroller declines to revoke a patent and the judge either affirms or reverses his decision there is no further appeal; and, on the other hand, if the Comptroller revokes the patent, then whatever the view taken by the judge there is an

Appeal to  
Court.

Further  
appeals.

unlimited right of appeal. If, however the words are construed to mean "a decision of the Comptroller upon an application to revoke" (which is unlikely), then there is an unlimited right of appeal in any case.

Any ground on which the Comptroller may revoke is also a ground of revocation under sect. 25, and sect. 92, as explained by the Act 8 Edw. VII., c. 4, allows the fullest appeal in the case of a petition under that section. A further question arises therefore as to whether a decision of the Comptroller or of the judge on appeal will create a bar to further proceedings under sect. 25. We submit that no such bar exists, since the opponent under sect. 25 is a "member of the public."

The power of the Comptroller is limited by sub-sect. 2.

*The Comptroller shall give notice of the application to the patentee, and after hearing the parties, if desirous of being heard, may make an order revoking the patent or requiring the specification relating thereto to be amended by disclaimer, correction, or explanation, or dismissing the application; but the Comptroller shall not make an order revoking the patent unless the circumstances are such as would have justified him in refusing to grant the patent had the proceedings been proceedings in an opposition to the grant of a patent.*

Amendments here are not limited to disclaimer only as they are in actions for infringement and petitions under sect. 25. Consequently if the opposition be based on the ground that the specification does not sufficiently describe the invention or the manner in which it is to be performed, the patentee is to have an opportunity as far as possible to remedy the defect. But amendments, to be allowable, must not be of a character to make the invention substantially larger or substantially different from the invention as claimed before amendment (sect. 21, sub-sect. 6. See p. 174), and an insufficient description may not be turned into a sufficient description by adding new matter. What is permissible is the clearing up of ambiguous phrases, correction of erroneous theory, discrepancies between drawings and letterpress, &c. The remedy and the power to allow amendment of the specification are very important in view of the allegation that patents were

Power to  
amend  
specification

sometimes granted for chemical processes which were obtained on speculation with the view that means might subsequently be discovered for making them practical, to the hindrance of persons who in the meantime actually made practical discoveries in the same line. The proviso that the Comptroller is not to revoke unless the circumstances would have justified refusal of a grant, limits revocation to cases in which the ground of opposition is absolutely established beyond hope of cure by amendment. (See p. 159.)

Practice.

The practice before the Comptroller is regulated by rules 75—77 of the Patents Rules.

The practice on appeal to the judge is regulated by rules 4, 5, and 6 of Order LIII.A, and will be considered at the end of this chapter.

Revocation  
under  
sect. 27.

#### REVOCATION UNDER SECT. 27.

Prior to the Act of 1907 it had been decided that no obligation lay on a patentee to establish the manufacture of his invention in this country, and that he was at liberty to use his patent to suppress manufacture in this country, and to supply all demand for the patented article from abroad (a).

Sect. 27 of the Act of 1907 was passed to remedy this defect in the law. The enactment is to the effect that a patent may be revoked when it can be shown that the manufacture of the patented article is mainly or exclusively carried on abroad, unless the patentee can show some satisfactory reason why the manufacture is not carried on, or that it is carried on to an adequate extent.

The sub-section (1) is as follows:—“*At any time not less than four years after the date of a patent and not less than one year after the passing of this Act, any person may apply to the Comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.*” The Act says that “*any person*” may apply for revocation. The same

The  
applicant.

(a) *Badische Anilin und Soda Fabrik v. W. G. Thompson & Sons, Ltd.*, 1904, 21 R. P. C. 473.

expression was used in the Act of 1883, and again in the Act of 1907 when providing for opposition to the grant of a patent (*b*), and its literal meaning was not accepted. It was ruled that the opponent must be in some way directly interested in the proceedings, but the same construction will not be applied in proceedings for revocation under this section. The applicant need not be a person who is desirous of establishing a manufacture in this country. He may even be a common informer (*c*).

If the applicant for revocation succeeds in establishing that the manufacture is carried on exclusively or mainly abroad he establishes a *prima facie* case for the revocation of the patent and the onus then lies upon the patentee either to show that the statement is unfounded in fact or to justify the facts as alleged, within the meaning of the statute. It is submitted that if the patented invention is not manufactured anywhere at all, the applicant cannot succeed. Sub-sect. (2) commences with a statement of the possible grounds of justification:—  
*“The Comptroller shall consider the application and, if after inquiry he is satisfied that the allegations contained therein are correct, then subject to the provisions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the Comptroller may make an order revoking the patent. . . .”*

Therefore where some degree of manufacture is carried on in the United Kingdom but the bulk of it is carried on abroad, the patentee must show that the manufacture is carried on in this country to an adequate extent. No rules are given to guide the Comptroller or the judge (*d*) in construing these words.

“Adequate extent.”

The word “mainly” has been construed by Mr. Justice Parker in *Hatschek’s Patents*, 1909, 26 R. P. C. at p. 240, and it is clear that its meaning is not to express a mere numerical

(*b*) See p. 156, ante.

p. 239. (The judgment is printed in full in the Appendix.)

(*c*) *Application to Revoke Hatschek’s Patents*, 1909, 26 R. P. C. at

(*d*) See sub-sect. 4.



ratio. The learned judge said: "If the patented article be manufactured in the United Kingdom to as great an extent as can reasonably be expected having regard to the industrial development of other countries, I do not think any presumption against the patentee can fairly arise, nor do I think that the Legislature intended it should arise. The word 'mainly' is used in the sub-section in close connection with and as an alternative to the word 'exclusively,' and having regard to this fact, I do not think that a process or article can be said to be mainly carried on or manufactured abroad, merely because it is carried on or manufactured abroad to a somewhat greater extent than within the United Kingdom. . . . To come within the sub-section the disparity must, in my opinion, be greater than a mere small percentage, and indeed if the article be manufactured or the process be carried on within the United Kingdom, not only to a substantial extent, but to an extent as substantial as may reasonably be expected, having regard to what is done abroad, I do not think the state of circumstances is that contemplated by sub-section 1."

Meaning of  
"Demand."

It has been said that the penalties imposed by the Act are avoided if the patented article or process is manufactured or carried on to an extent "sufficient to satisfy the demand" in the United Kingdom, but it is submitted that if the word "demand" be used in the interpretation of this Act it should mean not merely "demand for the manufactured article," but more than this it must mean "demand for opportunity to manufacture." Cases may arise in which there may be no demand whatever for the manufactured article in this country, but the article which could easily be manufactured in this country for export, may be in great demand abroad. Wooden shoes may be instanced as an example. A foreign manufacturer might use a British patent to suppress the manufacture of wooden shoes in this country while supplying the demand in Holland entirely from a Dutch or German factory. It is submitted that in such a case the patent should be revoked. This view is to some extent supported by the words of the learned judge at p. 243 (q. v.).

Cases may, and probably will arise in which the patentee has no foreign patents, but the mere difference in cost of manufacture produced by the obligation to pay a moderate royalty to the patentee may force manufacturers for a foreign market to make such goods abroad. In such a case it would be hard to punish the patentee for merely insisting upon the reasonable recognition of his rights as a patentee, and in such a case the patent ought not to be revoked. The true test is, it is submitted, to inquire whether the patentee has used his monopoly unjustly to give a preference to the foreign manufacturer. In the case suggested the foreign manufacturer would have an advantage not by the wish of the patentee, but through the misfortune of the patentee in having no foreign patents.

Foreign  
advantage  
owing to  
Royalty only.

Questions have arisen as to the meaning of the words "adequate extent" when applied to the case of a patent which is granted for a small improvement or part of a complicated machine. It is suggested that only the patented portions of the machine are indicated. This view, although not supported by any direct decision, may to some extent be inferred from the decision in *Hatschek's Patent* (supra). In that case the patent had forty-five claims relating to different parts of a high-speed sewing-machine which was manufactured in America, and when brought over to this country certain unpatented accessories, not being necessary parts of the machine as a whole, were added to suit the peculiar requirements of British manufacturers. It was argued that the manufacture and adjustment of these parts would constitute manufacture "to an adequate extent." Dealing with this point the Comptroller said (at p. 56): "The first question which I have to decide is whether the patented article is manufactured in an adequate extent in the United Kingdom. For the purposes of this question, the accessories to the machine, which are alleged to be manufactured in this country, must, I think, be disregarded; for it is not suggested that any of them form part of the invention protected by the patent."

Where part  
only of  
machine is  
patented.

If the manufacture be not carried on in this country the onus lies on the patentee to give "satisfactory reasons" why

"Satisfactory  
reasons."

it is not so carried on. These words are more difficult to interpret (see Parker, J., in *Hatschek's Patents* at p. 241).

It is submitted that the purpose of the Act was not to punish a patentee for taking advantage of real economic advantages which may be obtained by manufacture abroad. But the allegation of such economic advantages must be definitely proved, and must not be a mere matter of probability, and moreover such economic advantages must result in a benefit to the consumer and not to the patentee only. Cases may arise of patents for processes, and for the product obtained, in which it would be well-nigh impossible to carry on the manufacture in this country owing to the fact that the necessary raw materials are unobtainable, or obtainable only at a very enhanced price. In such a case it would be manifestly unjust to deprive the patentee of his sole right of vending the product.

On the other hand, a patentee who alleged as his "reason" that his foreign manufacture had now become so well systematised and his foreign employees so skilled, that only a great increase in selling price would enable him to establish factories in this country, would have to make out a very strong case indeed to justify his action.

" . . . It can never, in my opinion, be sufficient for a patentee, defending himself under the section, to prove that he cannot now start an industry with any chance of profit. The question really is: could he have done so if he had used his monopoly fairly as between home and foreign trade, or if he had devoted the time and money which he has expended in developing a foreign industry to developing a home industry? It may well be that having developed the industry abroad and given foreigners several years' start, he may find it difficult, if not impossible, to develop an industry on the same lines here, and yet such an industry might well have arisen but for the preference he has given to foreign countries" (e).

It is manifest that the term "satisfactory reasons" must be applied with discretion, and that no definite rule can be laid down, and all the circumstances must be taken into consideration. One of such circumstances to be considered in the exercise

(e) Parker, J., in *Hatschek's Patents*, at p. 243.

of such discretion to impose the penalty of revocation must be the conduct of the patentee in his endeavours to push the establishment of manufactures or the execution of licences to British manufacturers. A view seems to have been held by some people that a perfunctory advertisement of willingness to treat, issued by a patent agent on behalf of his client, would suffice to show that the latter had done his best to push his invention. This view can no longer be held after the decision in *Hatschek's Patent* (supra). The Comptroller said (p. 9): "It seems to me impossible to hold that a patentee can relieve himself from the duty of manufacturing in this country by the mere insertion at any time of a few advertisements and the sending round to manufacturers of a few circulars to which no replies were received. The advertisements and offers in this case were, I may say, of the vaguest description. They gave no intimation of the terms on which the owners of the patents were prepared to treat, beyond the statement that such terms would be reasonable." On the other hand, it is most important that a patent should not be revoked if the patentee has made bona fide endeavours to get his patent taken up (*f*). Otherwise a poor inventor with a valuable invention might easily be swindled by a combination of dishonest manufacturers, who by deliberately causing the patented article to be manufactured abroad, but refusing support to it in the United Kingdom, could lay the basis of a claim for revocation in order to bring the inventor to his knees.

The Comptroller is not bound to revoke the patent immediately. Sub-sect. 2 continues thus: ". . . the Comptroller may make an order revoking the patent either—

(a) forthwith; or

(b) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom to an adequate extent

Suspension  
of order.

*Provided that no such order shall be made which is at variance*

(*f*) *Bremer's Patent and Högnier's Patent*, The Times, May 26th, 1909, p. 3.

*with any treaty, convention, arrangement, or engagement with any foreign country or British possession."*

And by sub-sect. (3) "*If within the time limited in the order the patented article or process is not manufactured or carried on within the United Kingdom to an adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured or carried on, the Comptroller may extend the period mentioned in the previous order for such period not exceeding twelve months as may be specified in the subsequent order."*

It is clear that a patentee must establish some very good ground for the suspension of the order of revocation. It is submitted that the main circumstance which should be taken into consideration is the patentee's own conduct in pushing the invention, having regard to his position and opportunities. At the conclusion of his judgment in *Hatschek's Patent* (supra) the Comptroller said: "The only step alleged to have been taken by the patentees with a view to compliance with the requirements of the section, before the application for revocation was made, was the issue of the vague and futile advertisements and offers above referred to during the last month of the year of grace allowed by the Act. If I were to allow any further opportunity to the patentees to comply with the requirements of the law I should be establishing a precedent, the practical result of which would be to encourage patentees to defer compliance with the requirements of the section until applications are made to revoke their patents."

On the other hand in *Weber's Patent* (1909, 26 R. P. C. 300), where the patentee had made bonâ fide attempts to induce manufacturers to consider his invention, the Comptroller (Mr. Temple Franks) gave him six months' grace.

The  
International  
Convention.

The proviso at the end of clause 2 is for the purpose of preserving the effect of article II. of the International Convention of 1902. By this clause the contracting States agree that "*the patent, in each country, shall not be liable to forfeiture on account of failure to utilise it, until after the expiration of at least three years from the date of the deposit of the application in the country concerned, and only provided the patentee cannot show reasonable cause for his inaction."*

By sub-sect. 4 a right of appeal is given to the Court:— **Appeal to Court.**  
 “Any decision of the Comptroller under this section shall be subject to appeal to the Court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.” By sect. 92, sub-sect. 2, the appeal lies to the judge selected by the Lord Chancellor, and his decision is absolutely final.

The practice before the Comptroller is regulated by rules **Practice.**  
 78—81 of the Patents Rules, 1908, as modified by the notice in the *Illustrated Journal* of May 12th, 1909 (see Appendix). The onus is on the applicant to establish a *prima facie* case. It is submitted that the patentee should be at liberty to state merely that “he does not admit the allegations in the declarations filed with the applications” so as to force the applicant to prove his case by evidence before the patentee is called upon for “particulars in answer” (g).

The practice before the Court is regulated by rules 4, 5, and 6 of Order LIII A.

Costs will not be granted against a patentee who promptly **Costs.**  
 submits to revocation (h).

The evidence before the Comptroller is to be by statutory declaration, but oral evidence may be heard in addition. The procedure as to costs is much the same as in an opposition. The appeal is brought by way of petition, and is set down as a witness action. Rule 7 says that the evidence used shall be that used before the Comptroller, and no further evidence shall be adduced without the leave of the Court. Leave to adduce further evidence will not readily be granted (h). It would seem, therefore, that only the declarations may be used, together with a shorthand note of the oral evidence.

If the person desiring to obtain revocation chooses to proceed **Procedure under sect. 25.**  
 under sect. 25 (see p. 248, ante) merely in order to obtain an unlimited right of appeal, it is probable that the Attorney-General would refuse the fiat (see p. 251, ante).

(g) *Bremer's Patent and Högner's Patent*, The Times, May 26th, 1909, p. 3. (h) *Taylor's Patent*, 1909, 26 R. P. C. 381.

*Weldons v. Quasi - Arc.* xxxix R.P.C 323  
*Horne v. Johnston Bros* xxxviii R.P.C 365.

## CHAPTER XIII.

### ACTION TO RESTRAIN THREATS.

SECT. 36 of the Patents Act, 1907 (corresponding to Sect. 32 of the Act of 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 infringement of the patent, any person 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 he has sustained thereby, if the alleged infringement, 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."*

Common law  
before 1883.

Prior to the Act of 1883, the proprietor of a patent might issue threats of proceedings for infringement broadcast without rendering himself liable to account for any of the damage which he might occasion thereby, provided such threats were made bonâ fide ; in such a case the only remedy open to an injured person was to apply for an injunction to restrain the patentee from continuing to threaten him, and in this he could only be successful after showing that the statements made were in fact untrue (a).

In the case of malicious threats an action for damages lay similar to that of slander of title, when the plaintiff would have to show that the threat made by the defendant amounted to a "malicious attempt to injure the plaintiffs by asserting a

(a) *Halsey v. Brotherhood*, 1880, L. R. 15 C. D. 514.

claim of right against his own knowledge that it was without any foundation" (b).

The object of sect. 32 of the Act of 1883 was to remedy the hardship we have described, namely, that of a man whose business is paralysed by the threats of the proprietor of a patent, without any opportunity being afforded him of putting the question to the test. The section is addressed to the case "of a patentee who causes damage by disseminating threats which he dare not or will not justify by an action, who is willing to wound but yet afraid to strike" (c).

Object of  
statutory  
change.

The old common law remedy still lies when the case is taken out of the statute by the proviso, and in such a case the plaintiff in the threats action must show that notwithstanding that the defendant has duly prosecuted an action for infringement such action was not brought *bonâ fide* (d).

The words "by circulars, advertisements, or otherwise" have given rise to a number of cases in which an interpretation has been put upon them, and in which the principle of the enactment is clearly illustrated. The cause of action is not similar to libel, and there is no question of publication; therefore the manner in which the threat is made is immaterial. In *Skinner v. Perry* (1893, 1 Ch. 413, 10 R. P. C. 1), the plaintiffs complained of two threats—one in the form of a letter to a third party, who had enquired of the defendants whether they thought that the plaintiffs' article of manufacture infringed the defendants' patent; the other contained in a letter from the defendants to the plaintiffs themselves in reply to similar enquiries. In giving judgment for the plaintiffs, Bowen, L.J., said: "Using language in its ordinary sense, it is difficult to see that an intimation ceases to be a threat because it is addressed to a third person in answer to an enquiry, or because it is addressed to the person himself. We are not dealing with

Nature of  
threats.

(b) Per Blackburn, J., in *Wren v. Wield*, 1869, L. R. 4 Q. B. at p. 737. *v. Perry*, 1893, 1 Ch. at p. 420; 10 R. P. C. at p. 5.

(c) Per North, J., in *Day v. Foster*, 1890, 7 R. P. C. at p. 60; see also Lindley, L.J., in *Skinner v. Royle*, 1887, 36 C. D. at p. 433; *Colley v. Hart*, 1890, 7 R. P. C. at p. 112.



libel or questions of publication—we are dealing with threats. If I threaten a man that I will bring an action against him, I threaten him none the less because I address that intimation to himself, and I threaten him none the less because I address the intimation to a third person” (e). And verbal statements will therefore probably be threats (f), and the use of the words “without prejudice” will not affect the matter (g).

**Bona fides of  
patentee  
immaterial.**

It is immaterial that the threat was made bonâ fide; the question to be considered is what the defendant said or did, and not what he intended; and if damage is occasioned by the circulation of a threat, it is no reply to an action to say that damage was not intended if the threatener does not bring himself within the shelter of the proviso at the end of the section (h).

In usual practice the defendant in a threats action has issued the threats in a solicitor’s letter, or by circular to purchasers from the plaintiffs who are the defendant’s rivals in trade.

**General  
warning is  
not threat.**

The publication of a general warning to the whole world—such as, “I have a patent for such and such a machine, proceedings will be taken against any person who infringes it”—will not be actionable, since this is no more than the patent itself says (i); but should such warning amount by implication to a suggestion that the manufactures of a certain person are infringements of the patent referred to, and be circulated in the trade to the detriment of such manufacturer, an action will lie under the section.

**Save when  
aimed at  
special  
manufacture.**

In *Challender v. Royle* (1887, L. R. 36 C. D. at p. 441, 4 R. P. C. at p. 375), Bowen, L.J., said: “Suppose that a manufacturer is making and issuing machines which the

(e) And see *Driffield Cake Co. v. Waterlow Mills Cake Co.*, 1886, 3 R. P. C. 46; L. R. 31 C. D. 638; *The Combined Weighing Machine Co. v. The Automatic Weighing Machine Co.*, 1889, 6 R. P. C. 502; 42 C. D. 66.

(f) See *Kurtz v. Spence*, 1888, 5 R. P. C. 160.

(g) *Ibid.*

(h) *Day v. Foster*, 1890, 7 R. P. C.

at p. 58; *Skinner v. Perry*, 1893, 10 R. P. C. at p. 8.

(i) *Johnson v. Edge*, 1892, 9 R. P. C. at p. 148; L. R. 1892, 2 Ch. 1; also *Challender v. Royle*, 1887, L. R. 36 Ch. D. at p. 441; 4 R. P. C. at p. 375; *Ungar v. Sugg*, 1891, 8 R. P. C. at p. 388; *Douglas v. Pintsch’s Patent Lighting Co.*, 1896, 13 R. P. C. at p. 610.

patentee considers to be infringements of his patent, and the patentee issued a threat really directed against the manufacture and sale of those machines, I do not think he could escape from the section by wording his notice in such terms that, according to the letter, it was only a general warning to all persons not to infringe his patent."

In the same case the same Lord Justice, in his judgment suggested that the language of the section would not apply to threats relating to future infringements. Commenting upon that portion of the Lord Justice's judgment in *Johnson v. Edge* (1892, 9 R. P. C. at p. 148), Lindley, L.J., said: "I should like to qualify that a little by saying that I think upon the true construction of this section, the section might apply to an intended infringement, provided that you could make out that the intended infringement, if carried out, would be an actual infringement." And Kay, L.J., in the same case, said: "I can easily conceive one case of future infringement which would come entirely within the mischief which this section was intended to provide against. For instance, take this case: suppose a man issued a circular saying, 'I have a patent for such and such an article; I understand that Messrs. A. & Co. have recently erected a large manufactory for the purpose of manufacturing articles, which, when made, will be an infringement of my patent.' Can it be said that a case like that would not come within the mischief intended to be provided against by this section? (k)."

"Any person aggrieved:"—The right of action under the section is not limited merely to the person threatened, but any person, such as a rival patentee, to whom damage is occasioned by the issue of the threats is entitled to relief; so where circulars were issued to the trade intimating that the articles manufactured and sold by the plaintiff were infringements of the defendants' patent and that proceedings would be taken against any person dealing with such articles, and in consequence injury was done to the plaintiff's business, it was held that the plaintiff was a person aggrieved and could

The person  
aggrieved.

(k) See also *Kurtz v. Spence*, 5 R. P. C. at p. 171.

maintain an action, although no threats were made to him personally (*l*).

Validity of patent may be in issue.

“If the alleged manufacture, &c. :”—In an action brought under this section the validity of the patent may be put in issue. In *Challender v. Royle*, Cotton, L.J., said: “In my opinion . . . the question whether the patent of the person making the threats is a valid patent must come into consideration if the plaintiff in the action seeks it, because I cannot see how, if a patent is invalid, there can be any act done in infringement of a legal right when the legal right depends only on the validity of that patent (*m*).

Defendant must be legal owner to succeed.

To constitute a defence to an action under this section, not only must it be shown that the act complained of was an infringement of the patent in question, but also that it was an infringement of the legal rights of the defendant, that is to say, the defendant must be the legal owner of the patent and not merely possessed of a beneficial interest; so in *The Kensington, &c., Electric Light Co. v. Lane-Fox Co.* (1891, 2 Ch. 573, 8 R. P. C. 277), where it appeared that an agreement had been entered into whereby the patentee had agreed to assign the patent alleged to have been infringed to the defendant company, but no assignment had in fact been executed, it was held that the defendants, having only a beneficial interest in the patent, had no legal rights in it capable of being infringed, and consequently the plaintiffs were entitled to judgment without entering into the consideration of the validity or invalidity of the patent.

The burden of proof.

Primâ facie the burden of proof is on the plaintiff that what he has done is not an infringement of the defendant's patent but the onus may easily be shifted on to the defendant, and the issues, including validity, will be tried as in an action for infringement (*n*).

(*l*) *Kensington, &c. Electric Lighting Co. v. Lane-Fox Co.*, 1891, 2 Ch. 573; 8 R. P. C. 277; see also *Burt v. Morgan*, 1887, 4 R. P. C. 278; *Johnson v. Edge*, 1892, 9 R. P. C. 142; L. R. 1892, 2 Ch. 1.

(*m*) 4 R. P. C. at p. 371; L. R.

36 Ch. D. at p. 435; see also *Kurtz v. Spence*, 1887, 4 R. P. C. 427; *Herrburger v. Squire*, 1888, 5 R. P. C. 581.

(*n*) *Challender v. Royle*, 1887, 4 R. P. C. at p. 371; L. R. 36 C. D. at p. 435.

“Provided that this section shall not apply, &c.”:—In this proviso lies the most important part of the section, and many points arise in its consideration of considerable difficulty. It is proposed to deal with it first in detail, after which the effect of the proviso as a whole will be more easily understood. To take the last portion first, it is necessary that the person making such threats should commence and prosecute an action for infringement of his patent; as has been pointed out above, the beneficial owner of a patent cannot shelter himself under the saving clause; for similar reasons an action brought by the legal owner for infringement of his patent will not be such an action as to entitle the beneficial owner to the benefit of the proviso in an action in restraint of threats brought against him by alleged infringers (o).

The proviso.

The infringement action.

Only legal owner may benefit by proviso.

The action must be in respect of infringements which were referred to in the threats circulated by the patentee. But it need not necessarily be against the person aggrieved by the threats (p), since in many cases an action could not be brought against him—where, for instance, the person aggrieved is a rival patentee who does not manufacture at all.

The action must be honestly brought on account of an infringement substantially similar to that which is the subject-matter of the threat, but it is immaterial whether the issue of validity is raised in the infringement action. In *Day v. Foster* (1890, 7 R. P. C. 54) the plaintiff, after threatening the defendant, who was a licensee under the plaintiff's patent, and also Messrs. Barrett and Elers, brought an action against the defendant for infringement and royalties; he being a licensee, was unable to dispute the validity of the patent, and consequently Messrs. Barrett and Elers were anxious to be joined as co-defendants to the action. This being refused by the plaintiff, they instituted proceedings under the section. North, J., held that the action of *Day v. Foster* was an action for infringement within the meaning of the proviso, and in

Validity need not be disputed.

(o) *Kensington and Knightsbridge Electric Co. v. Lane-Fox Co.*, 1891, 2 Ch. 573; 8 R. P. C. 277.

R. P. C. 363; 36 Ch. D. 425; and see *Combined Weighing Machine Co. v. Automatic Co.*, 1889, L. R. 42

(p) *Challender v. Royle*, 1887, 4 L.P.

Ch. D. 665. 2. v. 0 28A. PC 479.

accordance with the interpretation laid down by Cotton, L.J., in *Challender v. Royle* (supra): "That in order to bring the case within the proviso the action must be an honest action, honestly brought in order to test the validity of the patent, or the fact of infringement, whichever may be in question"; and in consequence held that the action for threats was vexatious, and directed that all further proceedings in it should be stayed.

Must be on same patent as threats.

The action for infringement must be brought in respect of the same patent and in respect of the same or substantially the same infringement. In *Dowson, Taylor & Co., Ltd. v. The Drosophore Co., Ltd.* (1895, 12 R. P. C. 95), where the threats action was in respect of four patents on which the defendant threatened, and the infringement action was in respect of one only of these four, the motion to stay the threats action was dismissed. In *Temler v. Stevenson & Sons* (1898, 15 R. P. C. 24) the defendants issued general threats in respect of three patents. In the action for infringement they sued on all three patents, but abandoned one of them in the statement of claim, and abandoned another after the particulars of objections had been amended, and as to the third they discontinued the action altogether after the particulars had been re-amended. Romer, J., said (at p. 31): "Of course considerations applicable to a case like this would not concern a case where there were special threats under separate patents. I am only dealing with a case like that before me, where the particular acts were done, not under a particular patent, but where there were only general threats that what the plaintiff was doing would be stopped because of the defendants' rights as patentees generally of the three patents. In this case, it seems to me that even if the action had been originally brought on the two patents alone, it would have brought them within the benefit of the proviso."

And for same infringement.

The same considerations apply to the issue of infringement (*q*). The case of *The Lycett Saddle Co., Ltd. v. Brooks*,

(*q*) *Combined Weighing Machine Machine Co.*, 1889, 6 R. P. C. 502; *Co. v. The Automatic Weighing* 42 Ch. D. 665.

*Ltd.* (1904, 21 R. P. C. 656), which deals with this point, requires some comment. The defendants in that case had issued threats with respect to three specific types of saddle called 'L 16,' 'L 5,' and 'L 14.' The plaintiffs issued their writ on November 19th, 1903. On May 9th, 1903, the defendants had issued a writ claiming damages for infringement by the manufacture of certain saddles, not specifically mentioning 'L 5,' 'L 14,' and 'L 16.' 'L 5' and 'L 14' were not manufactured at all when the action for infringement was commenced, and so could not have been included in the particulars of breaches. It would seem from the report that the learned judge considered that the saddles complained of in the infringement action and those the subject of the threats were of the same type, and he held that the case came within the proviso. The case was therefore decided upon a question of fact only, and is no authority for the proposition that the infringement sued for need not be the same as the act in respect of which the threats are made.

As is pointed out, the action must be brought bona fide (*r*), and the onus of proof rests on the other party to show that the action was not in fact an honest one (*s*), and so to bring the action for threats under the old common law rule requiring malice.

Bona fides  
essential.

"With due diligence commences and prosecutes."—In considering whether such an action is brought with due diligence, the time of issuing the threats, and not the time when the party bringing the action first knew of the acts which he alleges to be infringements, is the period to be looked at (*t*), and it is immaterial whether the action is brought before or after the commencement of the threats action (*u*).

Due  
diligence.

The Courts have refused to consider threats made after an

(*r*) *Challender v. Royle*, 1887, L. R. 36 Ch. D. at p. 439; 4 R. P. C. 363; *Colley v. Hart*, 1890, 7 R. P. C. at p. 112; 44 Ch. D. 179.

(*s*) *Colley v. Hart*, 1890, 7 R. P. C. at p. 112.

(*t*) *Challender v. Royle*, L. R. 36 Ch. D. at p. 437.

(*u*) *Combined Weighing Machine Co. v. Automatic, &c. Co.*, 1889, 6 R. P. C. 502; *Berliner v. The Edison-Bell Phonograph Co.*, 1899, 16 R. P. C. 336; *Haskell Golf Ball Co. v. Hutchison*, 1904, 21 R. P. C. 497.

action has been commenced for infringement, as contempt of court (*x*).

Where threats of proceedings were made by the patentee to another for the space of three years, after which continuous negotiations took place between the parties and further complaints made, it was held that an action for infringement brought on the termination of those negotiations by the patentee disclosed no lack of due diligence (*y*).

Infringe-  
ment action  
need not be  
successful.

The section does not require that the action should be prosecuted to a successful termination, and the extent to which the action must be prosecuted will depend largely on the circumstances of the case.

In *Colley v. Hart* (1890, 7 R. P. C. 101 ; 44 Ch. D. 179), the facts were as follows:—On September 15th, 1888, the defendant issued a circular threatening proceedings against the plaintiff, amongst others. On the 22nd of the same month the plaintiff commenced an action to restrain the threats of the defendant; on December 6th the defendant commenced an action for infringement against the plaintiff, and delivered particulars of infringement in February in the following year, and on May 13th delivered his statement of claim. On November 7th, after the close of the pleadings, but before trial, the defendant abandoned his action for infringement. It was held that this action had been prosecuted with due diligence within the meaning of the proviso in the section. In his judgment, North, J., said (7 R. P. C. at p. 111): “Under those circumstances, of course, he is exactly in the same position by discontinuing a hopeless action before trial as he would have been in if he had prosecuted it to trial, and had then failed. As failure at the trial would not have prevented the action being one within the proviso, so, in my opinion, the discontinuance before trial does not put him in a worse position than if he had carried it to trial.”

May be  
discontinued.

In *The English and American Machinery Co. v. The Gare Machine Co.* (1894, 11 R. P. C. 627), the facts were very

(*x*) *Dunlop Pneumatic Tyre Co. v. Hutchison*, 1904, 21 R. P. C. 497.  
*v. Clifton Rubber Co.*, 1902, 19 R. P. C. 527; *Haskell Golf Ball Co.*  
 (*y*) *Edlin v. Pneumatic Tyre, &c. Agency*, 1893, 10 R. P. C. 311.

similar to those in *Colley v. Hart* (supra), but in this case the defendants abandoned their infringement action before delivering their reply. It was held by Chitty, J., approving of the decision of North, J., in the earlier case, and upon the same grounds, that due diligence had been exercised in the prosecution of the action for infringement.

It is difficult to say how far the above reasoning might be carried, whether the mere serving of a writ would be held to amount to prosecuting with due diligence, or is it necessary to deliver a statement of claim? No doubt the circumstances of the case must be the guide. As has been pointed out above, bona fides is required, and if that is shown to be absent, no action would be sufficient; but if, on the other hand, the Court considers that the person making the threats did commence his action bona fide, and with due diligence, a very slight amount of prosecution, probably, would take the case out of the operation of the section.

But where the defendant showed great delay in taking proceedings for infringement, in accordance with his threats, and, further, it appeared that he only took such proceedings in order to escape from the liability to which he had exposed himself by reason of those threats, it was held that such proceedings were not sufficient to satisfy the proviso (z).

The question of "due diligence" is therefore one of fact.

The action for infringement may be raised by way of counterclaim, and it will be a question of fact whether such a claim is brought with sufficient diligence (a).

Infringement  
raised by  
counterclaim.

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, the stay upon the first action will be removed, and an injunction will be granted.

Stay of  
threats  
action.

In *The Fusee Vesta Co. v. Bryant and May* (1887, 4 R. P. C. 191), the action, which was one for infringement of the plaintiffs' patent, was stayed, pending the amendment by the plaintiffs of

(z) See, e.g., *Herrburger v. Squire*, 1888, 5 R. P. C. at p. 594. *Co. v. Albert Eadie Chain Co.*, 1899, 16 R. P. C. 318.

(a) *Appleby Twin Roller Chain*



their specification. During the stay, and prior to amendment, the plaintiffs circulated post-cards among the customers of the defendants, threatening legal proceedings. On a motion by the defendants for an injunction to restrain such threats, Kay, J., granted the injunction applied for to extend to the trial of the action, or further order, the plaintiffs to pay the costs of the motion.

The effect of commencing and prosecuting an action for infringement with due diligence is to nullify the whole of the section, that is to say, its provisions cease to apply, and the rights of the person threatened are confined to those which existed prior to the Act of 1883. What those rights were has already been indicated at the commencement of the present chapter. There it was pointed out that damages could only be recovered when the threats were malicious; but since the action to satisfy the proviso must be a bona fide one, and, in fact, it has been suggested that that action was required as a sort of test whether the threats were bona fide or not (*b*), it would be practically impossible to recover damages upon the plea that the threats were in fact malicious. The result is that in such a case the only course opened to persons threatened, where the action for infringement has been dropped, as in *Colley v. Hart* (*supra*), and the question of infringement never tested in the Court, is to apply for an injunction to restrain the further issue of threats; but it is doubtful whether such an injunction would be granted under the circumstances, since, it being presumed that the threats were bona fide (*c*), the abandonment of the proceedings for infringement would imply, of necessity, that those threats would not be continued, and injunctions are only granted where there is a probability of the continuance of the acts complained of. Moreover, in the event of the renewal of the threats, the right of action under the section would be revived.

Proper course  
to pursue.

Where an action for infringement has been commenced after the institution of proceedings under the section the proper course

(*b*) *Challender v. Royle*, 1887, L. R. 36 Ch. D. at p. 439.

(*c*) See *Dredye v. Parnell*, 1896, 13 R. P. C. at p. 393; *Incandescent*

*Gas Light Co. v. Sunlight Incandescent Gas Lamp Co.*, 1897, 14 R. P. C. at p. 188.

for the parties to pursue in the threats action was indicated by Kekewich, J. (*d*). The patentee should take steps to get rid of the threats action, or to put a stay upon it, so that no unnecessary cost should be incurred, and in that case, where it appeared that the patentees had insisted upon having the threats action set down for trial and disposed of, the learned judge, at the close of his judgment, said: "If I could with propriety make them (the patentees) pay the costs, I should be disposed to do so. I cannot do that. I dismiss the action; but I certainly shall dismiss it without costs."

But on a motion to stay an action for threats, on the ground that an action for infringement is being prosecuted, it must be shown that the letters patent, which are the subject-matter of the two actions, must be the same. So where the threats action was in respect of four patents on which the defendant threatened, and the infringement action was in respect of one only of these four, the motion to stay the threats action was dismissed (*e*). But where the defendant has threatened, on the strength of several patents, he is not compelled to use all of them in the infringement action (*f*) (see p. 274, *supra*).

The effect of the section, taken as a whole, is not to deprive a patentee of the power, or it may be termed the duty (*g*), of warning infringers before rushing into litigation; but it does limit that power to one class of patentees, that is to say, only a man who is in possession of a patent which he is willing and intends to support in a Court of law may threaten others with legal proceedings in respect of it. A. may be infringing through ignorance, B. through design, but both possibly would desist on receipt of a warning. But when an alleged infringer shows that, in spite of the warnings, he has no intention of desisting from the acts complained of, the patentee must put his threat

General effect  
of section.

(*d*) *Combined Weighing, &c. Co. v. Automatic, &c. Co.*, 1889, L. R. 42 Ch. D. 665. 1898, 15 R. P. C. 34; *Lyett Saddle Co. v. Brooks*, 1904, 21 R. P. C. 656.

(*e*) *Dowson-Taylor Co., Ltd. v. The Drosophore Co., Ltd.*, 1895, 12 R. P. C. 95. (*g*) Per Jessel, M.R., in *Halsey v. Brotherhood*, 1880, L. R. 15 Ch. D. at p. 517.

(*f*) *Temler v. Stevenson & Sons*,

into execution, by which means alone can he escape liability under the provisions of this section.

Interlocutory  
injunction.

In *Challender v. Royle* (1887, L. R. 36 Ch. D. at p. 435), upon the subject of an interlocutory injunction to restrain threats, Cotton, L.J., said: "I think, however, that before going to the proviso I ought, having regard to the judgment of the Vice-Chancellor, to state my opinion as to how the matter ought to be dealt with in an interlocutory application. As far as I understand the Vice-Chancellor, he seems to have considered that he could not enter, or that he need not enter, at this stage of the cause into the question whether the sale of the plaintiff's tap-unions was an infringement of the defendant's patent, or whether that patent was a valid patent, and that all he need consider was the balance of convenience and inconvenience as between these parties in granting or refusing the interlocutory injunction. I must express my dissent from that view. It is very true that in all cases of interlocutory injunction the Court does consider and ought to consider the balance of convenience and inconvenience in granting or refusing the injunction. But there is another and very material question to be considered—Has the plaintiff made out a *prima facie* case? That is to say, if the evidence remains as it is, is it probable that at the hearing of the action he will get a decree in his favour? Therefore, though I quite agree that the Court ought not on an interlocutory injunction to attempt finally to decide the question whether the act complained of is an infringement, or (if the question of the validity of the patent is raised) whether the patent is a valid one or not, yet in my opinion it ought to be satisfied that on one or both of these points the plaintiff in the action has made out a *prima facie* case, and unless the Court is so satisfied it would be wrong to grant an injunction merely on the ground that it cannot do the defendant any harm."

Where there was a serious conflict of testimony as to the fact of infringement, the Court refused to grant an interlocutory injunction (*h*).

(*h*) *Barney v. United Telephone Co.*, 1885, 2 R. P. C. 173.

In *Colley v. Hart* (1889, 6 R. P. C. 17), which was a motion for an interlocutory injunction to restrain threats, North, J., said: "When there is a doubt whether the thing does infringe what he calls his rights or not, the fact that the defendant refrains from bringing an action to assert his rights is a fact I cannot leave out of consideration in forming an opinion as to whether he has such rights or not."

The injunction being by far the more important remedy, it seldom occurs that a substantial sum in damages is asked for or granted. The form of injunction granted in *Mountain v. Parker and Smith* (1903, 20 R. P. C. at p. 774) is given in the Appendix. Form of injunction.

The best course is for the judge to assess the damages at the trial. They are usually problematical, and depend upon a general impression of the case rather than upon a close examination of figures, and the cost of a reference for inquiry would be as a rule quite out of proportion to the amount that could be awarded. See, for example, *Ungar v. Sugg* (1892, 9 R. P. C. 113) (i). Damages.

The defendant in an action under this section is entitled to particulars of the threats upon which the plaintiff relies (k), and if the validity of the patent is put in question the general rules relating to particulars of objections will apply (l). Those rules will be considered in detail hereafter. Particulars.

Where there was a doubt upon which patents the defendants had based their threats, the Court ordered that the defendants should deliver to the plaintiffs a list of such patents (m).

And where the plaintiffs alleged that the threats were made by the defendants' agents, it was held that the defendants were entitled to particulars of the names of those agents (n).

(i) But see *Skinner v. Perry*, 1894, 11 R. P. C. 406; *Hoffnung v. Salsbury*, 1899, 16 R. P. C. 375.

(k) *Law v. Ashworth*, 1890, 7 R. P. C. 86. age Co., 1888, 5 R. P. C. 329.

(l) *Ibid.*, and *Union Electrical Power Co. v. Electrical Power Storage Co.*, 1888, 5 R. P. C. 329; 38 Ch. D. 325.

(m) *Union Electrical Power Co. v. Electrical Storage Co.*, 1888, 5 R. P. C. 329; 38 Ch. D. 325. (n) *Dowson-Taylor v. The Drosophore Co.*, 1894, 11 R. P. C. 536.

(n) *Ibid.*, and *Union Electrical Power Co. v. Electrical Power Stor-*

## CHAPTER XIV.

### INFRINGEMENT OF LETTERS PATENT.

Royal Com-  
mand in  
Letters  
Patent.

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 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."

No duty to  
warn in-  
fringers.

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). If, however, the patentee were to falsely represent to a manufacturer that the wares manufactured by him were not an infringement of the patent, and thereby induced him to spend money on further manufactures or otherwise to place himself at a disadvantage, the conduct of the patentee would have amounted to acquiescence, and he could not succeed in an action for infringement (c).

(a) *Walton v. Bateman*, 1842, 1 Ch. D. 740.  
W. P. C. at p. 615. (c) *Ibid.* at p. 760.  
(b) *Proctor v. Bennis*, L. R. 36

The question of infringement or no infringement is one of fact (*d*), after the specification has been construed and its ambit determined as a matter of law (*e*). But this refers to the mere infringement alone within the meaning of Tindal, C.J., in *Muntz v. Foster* (1843, 2 W. P. C. 99), 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."

Infringement is question of fact.

If the patent be 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* (1866, L. R. 1 H. L. 337; 35 L. J. Ch. 852), in the House of Lords. The question of infringement was there taken as involving the validity of the patent.)

No infringement of invalid patent.

It is equally an infringement whether the defendant acted in ignorance of the plaintiff's patent or not. In *Heath v. Unwin* (1845, 14 L. J. Ex. at p. 156; 2 W. P. C. at p. 227), 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 subsequently, when *Heath v. Unwin* (1854, 25 L. J. C. P. at p. 19; 5 H. L. at p. 537) came before the House of Lords, the opinion of the judges being taken, Parke, B., acknowledged the error into which the Court had fallen.

Ignorance no excuse.

In *Stead v. Anderson* (1847, 2 W. P. C. at p. 156), Wilde, C.J., tersely puts it: "The question of infringement depends not on what the defendant intends, but on what he does."

Nor intention.

So it is immaterial whether the defendant was aware that the thing was patented or not, since in law every person in the realm

(*d*) *Walton v. Potter*, 1841, 1 W. P. C. at p. 586; *De la Rue v. Dickenson*, 1857, 7 E. & B. at p. 738. (c) See p. 104, supra.

is taken to have notice of a patent in the same way that he is taken to be aware of the law (*f*).

Save as to  
question of  
remedy.

The bona fides of the infringer does, however, affect the rights of the patentee with respect to the remedy which he may obtain (*g*).

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 (*h*).

In *M'Cormick v. Gray* (1862, 31 L. J. Ex. 42) 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 (at p. 48): "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 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.

Thus we see that infringement, as taken apart from the

(*f*) And see *Wright v. Hitchcock*, 1870, L. R. 5 Ex. at p. 47; *Young v. Rosenthal*, 1884, 1 R. P. C. at p. 39.

(*g*) See sect. 33 of the Act of 1907.

(*h*) *Newall v. Elliott*, 1864, 10 Jur. N. S. at p. 958; 13 W. R. at p. 18; see also *Saccharin Corporation v. Reitmeyer & Co.*, 1900, 17 R. P. C. at p. 612.

question of validity, is a matter of fact, and that intention is not material to the conclusion.

Proof of an intention to infringe, apart from actual infringement, may, however, justify an injunction to restrain such infringement (*i*).

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

The question as to what will or what will not amount to infringement, like many other points which arise in the law of letters patent, must depend upon the facts of each particular case, and the decision in one case cannot possibly bind the decision in another; consequently the consideration of decided cases is only useful as showing the principles which underlie the judgments in those cases.

In *Nobel's Explosives Co. v. Anderson* (1894, 11 R. P. C. at p. 127), Romer, J., said: "Several cases were cited to show the canons of construction on which the Courts have acted in different cases relating to infringements. But it is not necessary for me to deal with these cases in detail, for I desire emphatically to state that, in my view, one principle only governs all the cases, whether they relate to so-called 'master' patents, or patents dealing with discoveries in matter of principle, or to any other kind of patent; and that principle is this: In order to make out infringement, it must be established, to the satisfaction of the Court, that the alleged infringer, dealing with what he is doing as a matter of substance, is taking the invention claimed by the patent; not the invention which the patentee might have claimed if he had been well advised or bolder, but that which he has in fact and substance claimed on a fair construction of the specification" (and see p. 293, post).

One principle governs all cases.

But the consideration of the question of infringement is much simplified if one remembers that inventions may be divided roughly into two classes in respect to subject-matter (see p. 42, supra). Firstly there is that kind of invention which

But two classes of inventions.

(*i*) See Index, Cap. "Injunction."



consists in the discovery of a method of application of a new principle—here what has been invented is in effect the new principle, and, generally speaking, the Court will regard jealously any other method embodying that principle, for the patentee was not bound to describe every method by which his invention could be carried into effect. Secondly there is that kind of invention which consists in some particular new method of applying a well-known principle, and in this case the use of other methods is not contemplated by the patentee, and such will not fall within the ambit of his claim. It is important to remember that, as was pointed out by Romer, J., in the passage quoted above, the claim made by the patentee is the point to be considered, not the actual merit of the invention.

In the case above cited, in the Court of Appeal (1894, 11 R. P. C. at p. 527), Kay, L.J., in his judgment, said: "I think the law now is reasonably well settled. There are two classes of cases: one where a patentee has invented a new method of producing a known result, the other where he has invented a new result, and has described one method of producing it."

Claims to principles.

A difficulty of some theoretical interest, but of little practical importance, has arisen upon the question whether a claim to a method of carrying out a new principle will cover every other method of carrying out that principle (*k*). We venture to say "of little practical importance" because claims may be drafted which without being bald claims to a principle will nevertheless cover every method of carrying that principle into effect. In *Jupe v. Pratt* (1 W. P. C. at p. 146), in the course of the argument Alderson, B., said: "You cannot take out a patent for a principle. You may take out a patent for a principle coupled with the mode of carrying the principle into effect, provided you have not only discovered the principle but invented some mode of carrying it into effect. But then you must start with having invented some mode of carrying the principle into effect. If you have done that, then you are entitled to protect yourself from all the other modes of carrying the principle into effect, that being treated by the jury as

Baron Alderson's dictum.

(*k*) See p. 39, ante, for further discussion of this topic.

a piracy of your original invention." This statement of the law was approved by the House of Lords in *Chamberlain and Hookham, Ltd., v. Bradford Corporation* (1903, 20 R. P. C. at p. 684), and by Parker, J., in *The British United Shoe Machinery Co., Ltd., v. Simon Collier, Ltd.* (1908, 26 R. P. C. at p. 49), but when the words ". . . patent for a principle coupled with the mode . . ." are closely examined it is easy to see that they are liable to misinterpretation. Alderson, B., did not say that in such a case the specification could end with two distinct claims, one for the principle irrespective of its application, and the other for the method of application—his meaning is made clear by his observations in *Neilson v. Harford* (1 W. P. C. at p. 355). The dictum in *Jupe v. Pratt* and the subsequent observations in *Neilson v. Harford* were dealt with by Lindley and Cotton, L.JJ., in *The Automatic Weighing Machine Co. v. Knight* (1889, 6 R. P. C. 297). Lindley, L.J. (at p. 308), said: "The passage from *Jupe's* case goes rather further than the passage which I am going to read, and which I have always regarded as the best exposition I know of the law upon this subject. . . . It was in answer to the argument, I think, of Sir William Follett. Sir William Follett said: 'I say we do claim every vessel, every shape of vessel, closed vessel, in which air can be heated between the blowing apparatus and the furnace.' Then Mr. Baron Alderson says this, 'Then I think that is a principle if you claim every shape. If you claim a specific shape, and go to the jury and say that which the other people have adopted is a colourable imitation, then I can understand it. If you claim every shape you claim a principle. There is no difference between a principle to be carried into effect in any way you will, and claiming the principle itself. You must detail some specific mode of doing it. Then the rest is a question for the jury.' That, I take it, explains in short language the real state of the law as it at present stands." And in the same case Cotton, L.J., said, referring to the dictum in *Jupe v. Pratt*: "Those were the expressions used by Baron Alderson during the discussion, probably to meet something that was said by counsel, and did not express his full opinion. You can prevent anyone from

Criticised by  
Lindley, L.J.

using the same method of carrying that principle into effect, and you can prevent anyone from using only the same thing with a colourable difference. That is what we had to consider in *Proctor v. Bennis* (1887, 4 R. P. C. 333). Where there is a principle first applied in a machine capable of carrying it into effect, the Court looks more narrowly at those who carry out the same principle, and say they do it by a different mode, and looks to see whether, in effect, although the mode is not exactly the same, it is only a colourable difference, a mechanical equivalent for a substantial part of the patentee's invention being looked upon as a mere colourable difference, and, therefore, he being entitled to an injunction against that mode of carrying out his principle, which is only the same in substance as that which he patented, though there are colourable differences" (l).

No valid claim to principle.

It is submitted that a claim cannot be sustained for a bare principle or for every method of applying a principle whether that principle be new or old, but when the principle is new the Court will give a wide construction to the claim. The Court in every case will inquire in what the essence of the invention as claimed consists, and will hold the defendant to have infringed if he has taken the pith and marrow of the invention as claimed (m), and when the invention is merely for an improved mode of attaining an old object the pith of his invention is that particular improved method, and only by making use of that particular method will a man be held to have infringed; but when the invention is for a new method of attaining a new result, the novelty of the result itself is part of the merit of the invention and of the consideration given by the patentee in return for the grant; and, consequently, a man will be held to have infringed if he should have arrived at the same result by means of a process substantially the same as, or only colourably different from, that disclosed in the specification,

(l) And see the observations of Lord Esher, M.R., and Kay, L.J., in *Nobel's Explosives Co. v. Anderson*, 1894, 11 R. P. C. at pp. 525 and 527; and Halsbury, L.C., in *Ash-*

*worth v. English Card Clothing Co.* 1903, 20 R. P. C. at p. 797.

(m) *Clark v. Adie*, 1877, L. R. 2 App. Cas. at p. 320.

of the original invention (n). In other words there are two classes of invention, but only one principle governing the law of infringement.

In *Curtis v. Platt* (1863, L. R. 3 C. D. 136, n.), 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 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."

*Curtis v.  
Platt.*

In *Proctor v. Bennis* (1887, 4 R. P. C. at p. 355), Cotton, L.J., referring to the patent sued on in *Curtis v. Platt*, said: "It was specially to introduce improvements into the mechanical, means and arrangements which a previous patentee had used to obtain a well-known object in a well-known machine.

*Proctor v.  
Bennis.*

(n) *Curtis v. Platt*, 1863, L. R. 3 Ch. D. 136, n.; *Proctor v. Bennis*, 1887, 4 R. P. C. 333; *Ehrlich v. Ihlee*, 1888, 5 R. P. C. 437; *Automatic Weighing Machine Co. v. Knight*, 1889, 6 R. P. C. 297; *Thompson v. Moore*, 1889, 6 R. P. C. 426; *Tweedale v. Ashworth*, 1890-92, 7 R. P. C. 426; 8 R. P. C. 49; 9 R. P. C. 121; *Automatic Weighing Machine Co. v. National Exhibitions Association*, 1891, 8 R. P. C. 345; 9 R. P. C. 41; *Miller v. Clyde Bridge*

*Steel Co.*, 1892, 9 R. P. C. 470; *Ashworth v. Roberts*, 1892, 9 R. P. C. 309; *The Incandescent Light Co. v. De Mare*, 1896, 13 R. P. C. 301; *Consolidated Car Heating Co. v. Carne*, L. R. 1903, A. C. 509; 20 R. P. C. 745; *Ashworth v. English Card Clothing Co.*, 1903, 20 R. P. C. 790; *British Vacuum Cleaners v. Suction Cleaners Ltd.*, 1904, 21 R. P. C. 303; and many other cases.

Therefore in that case, in applying those words used by the judges, we must deal with the case before them and come to the conclusion, as I do, that what they meant was this, that where there is no novelty in the result, where neither the machine nor the result is new, there you must tie down the patentee, who claims an improvement in the machinery for producing in a known machine that result, strictly to the invention which he claims, and the mode of effecting the improvement which he says is his invention. But here the throwing coal on to the furnace by the intermittent radial action of a flap or door was new, and nothing of the kind had been done before. It is true there had been previous though imperfect machines for feeding furnaces automatically, but that had not been done previous to this machine by any intermittent radial action of a flap or door, as was done by the plaintiff, and apparently successfully done by him. In my opinion, therefore, these opinions expressed by the judges with reference to mere improvements in an old machine for an old purpose cannot lay down any law for a case like this, where the result of throwing coal on to the furnace by the intermittent radial action of the flap is first applied in a machine invented by the plaintiff. There was not only novelty in the machine, but there was novelty in the effect, and in the result to be produced by that machine."

There is no distinction whatever in principle between the two classes of cases. The question is invariably: "What is the subject-matter of the invention?" If the invention is the new result, it is not for the means of producing it only; on the other hand, if the invention is a new means of producing an old result, only substantial imitation of those means will infringe. (See Chapter IV., "Subject-matter.")

The kinds of invention which fall within the class of which *Proctor v. Bennis* is a type, sometimes called "pioneer" or master patents, and to which a wide construction will be given, are—

- (1) A method of application of a new principle.
- (2) A new machine, material, or process for a new purpose.

The *Curtis v. Platt* type, in which a narrow construction will be given, are—

- (1) The novel application of an old principle.
- (2) A new machine, material, or process for an old purpose.
- (3) An old machine for a new purpose.

“Combination” patents will be further considered with reference to certain special points, but whether they fall within the wide construction or the narrow construction class depends on the circumstances of each case, and the fact that they are combinations is immaterial on the question of principle.

In order to ascertain what the subject-matter of the invention is, it is necessary to construe the specification having regard to the state of knowledge in the trade at the time of the invention. (See p. 294, post, and p. 108, ante.)

Construction of the specification.

If a man has taken the pith of an invention, the fact that he has improved upon it is immaterial; he has nevertheless infringed (o).

Improvement does not negative infringement.

The principles that underlie the question of infringement, by taking a part only of the invention, were very fully and clearly considered by Mr. Justice Wills in *The Incandescent Gas Light Co. v. The De Mare Incandescent Gas Light System* (1896, 13 R. P. C. at p. 330). In his judgment the learned judge deals with the means by which the relative importance of different parts of the invention is to be ascertained, and consequently in what part the substance lies, as follows:—“In dealing with the question of construction, I have carefully avoided any reference to the relative importance of different parts of the invention. In dealing with the question of infringement, it is impossible not to consider them. Infringement is a question of fact for the jury, if there be one; and the question is not whether the substantial part of the process, said to be an infringement, has been taken from the specification; but the very different one, whether what is done, or proposed to be done, takes from the patentee the substance of his invention. What the thing invented is must be gathered from the specification

Infringement by taking part only.

(o) *Neilson v. Harford*, 1841, 1 W. P. C. at p. 310; *United Telephone Co. v. Harrison*, 1882, 21 C. D. at p. 740; *Ehrlich v. Ihlee*, 1888, 5 R. P. C. at p. 454; *Thomson v. Moore*, 1889, 6 R. P. C. at p. 436; *Wenham Gas Co. v. Champion Gas Co.*, 1892, 9 R. P. C. at p. 55; *Pilkington v. Massey*, 1904, 21 R. P. C. at p. 437.

Relative im-  
portance of  
parts.

alone, and the patentee cannot escape from the thing he has claimed as the standard, and the only standard with which to compare the alleged infringement, so as to see if it constitutes substantially the appropriation of the thing claimed. When, however, you come to make that comparison, how can you escape from considering the relative magnitude and value of the things taken and of those left or varied? It is seldom that the infringer does the thing, the whole thing, and nothing but the thing claimed by the specification. He always varies, adds, omits; and the only protection the patentee has in such a case lies, as has often been pointed out by every Court, from the House of Lords downwards, in the good sense of the tribunal which has to decide whether the substance of the invention has been pirated. It is contended by the defendants that what is important, and what is of subsidiary consequence, can only be gathered from the specification itself. I am satisfied that that neither is nor can be the law. . . . There are no means of ascertaining whether, notwithstanding additions or subtractions, the invention has been taken, except by seeing what they are worth as compared with the things which have been taken bodily from the invention." The earlier authorities of *Clark v. Adie* and *Proctor v. Bennis* were then analysed in detail.

The question of relative importance, therefore, remains one of fact to be decided on evidence. But in saying that the relative importance of parts of the invention is to be ascertained as a question of fact and by means outside a direct reference to the specification, the learned judge was clearly referring to cases in which the patentee has not given any indication of what he considers essential. Where, however, the patentee has expressly claimed some specific means of accomplishing an object, he will be tied down to that means, for it must be remembered that what is protected is what is claimed, and not all that is described (see p. 297, *post*). Bowen, L.J., in *Jackson v. Wolstenhulmes* (1884, 1 R. P. C. at p. 108), said: "It must be remembered that claims are for the security of patentees, to prevent it being said that the patentee has claimed more than can be really supported as his invention."

In *Dudgeon v. Thompson* (1877, L. R. 3 A. C. 44), 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 of 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 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."

An interesting case of an inventor limiting himself by his claim to something narrower than he had actually invented, and thereby failing to catch an infringer, is to be found in *The Incandescent Gas Light Co. v. The Sunlight Incandescent Gas Lamp Co.* (1896, 13 R. P. C. 333). The real nature of the discovery was that a skeleton of earthy oxides could be produced, which, when suspended in a Bunsen flame, formed an illuminant. The claim, however, was limited to the manufacture of such a skeleton of certain specified materials, and in a certain specified manner. The defendant skilfully avoided the patent by making use of the principle, but producing the



Infringement  
is of specified  
claim only.

skeleton of different substances, and manufacturing in a different manner. Lord Justice Romer said, in *Nobel's Explosives Co. v. Anderson* (1894, 11 R. P. C. at p. 128): "In order to make out infringement it must be established to the satisfaction of the Court that the alleged infringer, dealing with what he is doing as a matter of substance, is taking the invention claimed by the patent, not the invention which the patentee might have claimed, if he had been well advised or bolder, but that which he has in fact and substance claimed on a fair construction of the specification." In *Bunge v. Higginbotham* (1901, 18 R. P. C. at p. 206; 1902, 19 R. P. C. at p. 199), Kekewich, J., said on this point of the substance of the combination: "But in order to ascertain whether any part of the combination, which is absent in the alleged infringement, can be dispensed with so as still to hold the latter to be an infringement, one must go back to the specification, and one must hear what the patentee himself has said about it. . . . You must find whether he considers the one part which has not been taken to be an integral part of his invention, or perhaps it would be better to say an essential part of his invention."

How to  
approach  
infringement.

Lord Alverstone, L.C.J., in *The Presto Gear Case and Components Co. v. Orme, Evans & Co.* (1901, 18 R. P. C. at p. 23), said: "In patent cases I have always felt that there is a line of thought which is most likely to lead you to the right result in the speediest way. The first thing, assuming you understand the alphabet of the science or art, is to clearly understand what was the previous state of knowledge. Having got, either by agreement or deduction from the evidence, a clear view as to what was the previous state of knowledge, you must then construe the specification with reference to that, disregarding issues of novelty or subject-matter which may arise in the particular case, and you then have to consider whether or not the infringement comes within the fair meaning of the claims—not anything else, but the claims read in the light of the previous state of knowledge, and without altering the words unduly in favour of the patentee or infringer."

The cases in which a claim for a combination is alleged to be infringed do not differ in general principles from any other kind of infringement. But they are liable to give rise to difficulty under either of the following circumstances:—(a) A part only of the combination may be taken; or (b) A mechanical or chemical equivalent may be substituted for a portion of the combination.

Combinations  
how in-  
fringed.

In *Nordenfelt v. Gardner* (1884, 1 R. P. C. at p. 65), 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 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."

In *Clark v. Adie* (1875, 10 Ch. at p. 675), Lord Justice James said: "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." And when the same case reached the House of Lords (1877, 2 A. C. 320), Lord Cairns, L.C., said: "One mode of infringement would be a very simple and clear one; the infringer would take the whole instrument from beginning to end. . . . About an infringement of that kind no question could arise. The second mode would be one which might occasion more difficulty. The infringer might not take the whole of the instrument here described, but he might take a certain number of parts of the instrument described; he might make an instrument which in many respects would resemble the patent instrument, but would not resemble it in all its parts. And there the question would be, either for a jury or for any tribunal which was judging of the facts of the case, whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented, and whether in what he had done he had not really taken and adopted the substance of the instrument patented. And it might well be, that if the instrument patented consisted of twelve different steps, producing in the result the improved clipper, an infringer who took eight or nine or ten of those steps might be held by the tribunal judging of the patent to have taken in substance the pith and marrow of the invention, although there were one, two, three, four, or five steps which he might not actually have taken and represented upon his machine."

In *Sellers v. Dickenson* (1850, 5 Ex. at p. 324), Pollock, C.B., 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."

As in the case of other kinds of inventions, it will be seen that the materiality of the portion of a combination that has been taken by the infringer, *i.e.*, the question of whether that portion is or is not the pith and essence of the invention, is a question of fact to be decided by evidence (but see p. 292, *ante*). No fine lines can be drawn as to what amounts to substantial imitation. In *Clark v. Adie* (1877, L. R. 2 A. C. at p. 335), 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* (1858, 8 E. & B. 1004; 27 L. J. Q. B. 296), 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*, 1864, 12 W. R. 723), whether or not 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."

A patent for a combination is not infringed by taking separately the integers which are comprised in that combination. For some considerable time it was thought that the judgment in *Lister v. Leather* (1858, 8 E. & B. 1004) established the contrary proposition, but, as was pointed out by Fletcher Moulton, L.J., in his elaborate review of the authorities in *The British United Shoe Machinery Co., Ltd. v. A. Fussell & Sons, Ltd.* (1908, 25 R. P. C. at p. 653), the law on this

**Combination  
does not pro-  
tect integers.**

point was not correctly stated in that case, but was made clear by Lord Cairns in *Clark v. Adie* (1873, L. R. 2 A. C. at p. 321): "Suppose, my lords, that in a patent you have a patentee claiming protection for an invention consisting of parts which I will designate as A, B, C, and D; he may at the same time claim that as to one of those parts, D, it is itself a new thing, and that as to another of those parts, C, it is itself a combination of things which possibly were old in themselves, but which, put together and used as he puts them together and uses them, produce a result so new that he is entitled to protection for it as a new invention. In a patent of that kind the monopoly would or might be held to be granted, not only to the whole and complete thing described, but to those subordinate integers entering into the whole which I have described. But then, my lords, the invention must be described in that way; it must be made plain to ordinary apprehension, upon the ordinary rules of construction, that the patentee has had in his mind, and has intended to claim, protection for those subordinate integers; and moreover he is, as was said by the Lords Justices, at the peril of justifying those subordinate integers as themselves matters which ought properly to form the subject of a patent of invention."

Substitution  
of equiva-  
lents.

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. A great deal of confusion has been caused by misunderstanding the term "mechanical equivalent." As has been pointed out many times, the question is always, "What is the invention?" And the use of a mechanical equivalent for that which the plaintiff has invented, which at the time of the act complained of is known as an equivalent, is always an infringement (*p*). It is not true to say that "the doctrine of mechanical equivalents does not apply in the *Curtis*

(*p*) *Bunge v. Higginbotham*, 1902, 19 R. P. C. at p. 196.

v. *Platt* type of cases." A patent which did not cover all known mechanical equivalents would be void for want of invention. The narrowest claim for a particular means of attaining an old ultimate result may be infringed by the use of a mechanical or chemical equivalent, *i.e.*, an obvious method of carrying out the same invention, a method which a skilled mechanic or chemist, having once seen the original invention, could at once suggest and apply without the necessity for any inventive power whatever. The confusion has arisen partly because the expression "new result" has been loosely applied, sometimes to mean the ultimate result, and sometimes to mean the new effect immediately produced by the invention. In this latter sense all inventions must produce a new result, or they would fail for want of utility. Things may be mechanical equivalents for many purposes, and yet not for the purpose immediately at hand. A fire-tongs is in many aspects the mechanical equivalent of a dental forceps, but not for the purpose of extracting teeth. Sulphuric acid is a chemical equivalent for nitric acid as far as the reddening of litmus is concerned, but is far from an equivalent in the manufacture of explosives. Equivalents may be substituted for parts as well as for the whole invention, so that it may happen that a patent may be taken out which consists of three parts, and 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.

It is submitted that whether the substituted equivalent was known to be such at the date of the patent or was subsequently discovered is immaterial to the issue of infringement. It might well be that the substitution of a subsequently discovered equivalent might in itself be good subject-matter for a patent, but it would none the less be an infringement. But it is necessary that the claim should be sufficiently wide as to include in its generic terms any specific example subsequently discovered, and the whole question of infringement thus turns upon the construction of the claim.

Take, for instance, the case of *Stevens v. Keating* (1847, 2 W. P. C. 181). Here the patent was for the manufacture of cement. The cement was made from gypsum (sulphate of lime)

Knowledge of equivalent at date of patent effect of, discussed.

by admixing it with pearl-ash (carbonate of potash) and sulphuric acid. Chemically, the effect was this: A salt, 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 specification terminated thus: "And whereas other alkalis and acids, besides those hereinbefore mentioned, will answer the purposes of my said invention, though none that I have tried have answered so well as the alkali and acid hereinbefore set forth, and whereas I claim as my invention the processes of mixing the powdered materials, alkalis, and acids, as hereinbefore described, and subsequently burning, heating or calcining the same, for the purposes hereinbefore set forth." 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 pearl-ash and sulphuric acid a salt which is 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.

In *Unwin v. Heath* (1855, 5 H. L. C. 505) the patentee said in his specification: "I propose to make an improved quality of cast steel, by introducing into a crucible bars of common blistered steel, broken, as usual, into fragments, or mixtures of cast or malleable iron, or malleable iron and carbonaceous matters, *along with from one to three per cent. of their weight of carburet of manganese*, and exposing the crucible to the proper heat for melting the materials, which are, when fluid, to be poured into an ingot mould in the usual manner; but I do not claim the use of any such mixture of cast and malleable iron, or malleable iron and carbonaceous matter, as any part of my invention, *but only the use of carburet of manganese in any process for the conversion of iron into cast steel.*" In another part of the specification he said: "I claim the employment of *carburet of manganese* in preparing an improved cast steel." At the date of the patent carburet of manganese was well

known and very expensive. The defendant heated broken iron with coal tar and oxide of manganese—an inexpensive process. The evidence of the plaintiff was to the effect that carburet of manganese was actually formed in the defendant's melting pot at the moment of fusion. The House of Lords took the opinions of the judges, and Pollock, C.B., and Parke, B., considered that upon the construction of the specification the alleged infringement was not within its ambit and was *not an equivalent*, and expressed the opinion that a subsequently discovered equivalent could not be an infringement. We venture with the greatest respect to the memory of these great judges to suggest that this opinion was erroneous, and it was clearly unnecessary to the decision of the case. The more accurate test was applied by Lord Brougham, who in his judgment referred to *Stevens v. Keating, supra*. "I come at once to the case which is chiefly relied upon, namely, *Stevens v. Keating*, which came before Lord Cottenham (*q*), and in which, the patent being for making cement by uniting gypsum with an acid and an alkali, the defendant made cement (which was the alleged infringement) by uniting gypsum with borax, and it being discovered that borax was composed of an acid and an alkali, Lord Cottenham held that uniting gypsum with borax was uniting gypsum with an acid and an alkali; and that consequently there was an infringement of the patent, which was granted for gypsum united with an acid and an alkali. . . . But I very much question whether the judgment would have been in the affirmative upon the question of infringement or no infringement, if, instead of the patent having been for uniting gypsum with an acid and an alkali, the patent had been for making cement by uniting gypsum with borax; and it being found that borax was compounded of an acid and an alkali, it then had been contended that any compounding of an acid and an alkali was an infringement of the patent, inasmuch as the materials of borax being an acid and

(*q*) The proceedings before Lord Cottenham are not reported, but are referred to in Newton's London Journal C. S. 62; Norman on Patents, 141.



an alkali, and the patent being for continuing an acid and an alkali with gypsum to make cement, therefore there was an infringement. In my opinion, the proposition affirmed by Lord Cottenham in this decision would not at all lead by any necessity whatever to giving a similar decision upon the converse, where the case was such as I have just supposed."

In *Nobel's Explosives Co. v. Anderson* (1894, 11 R. P. C. 115, 519; 12 R. P. C. 164), the object of the invention was the production of an explosive suitable for propelling projectiles, in the use of which explosive perfect combustion might be obtained. The patentee in his specification confined his claim to powder made from soluble nitro-cellulose and nitro-glycerine. It was not known at the date of the patent that insoluble nitro-cellulose could be used in the place of the soluble to effect the same object in a similar manner, and, in fact, anyone reading the specification of the patentee would be led to the conclusion that he was to avoid the use of insoluble nitro-cellulose. It was held by Romer, J., whose decision was confirmed in the Court of Appeal and the House of Lords, that the use of the insoluble nitro-cellulose, although in a similar way and to effect a similar result to that attained by the soluble nitro-cellulose, did not amount to an infringement of the patent. In his judgment he said (11 R. P. C. at p. 127): "The soluble and insoluble are, in my opinion, distinct substances, having, as I pointed out above, distinct properties, and the insoluble cannot, for the purposes of the plaintiff's patent, be regarded as merely the chemical equivalent of the soluble. The plaintiff's patent and claim show that the patentee regarded the two as distinct for the purposes of his invention."

As an instance of an infringement involving the use of a mechanical equivalent we may cite *Russell v. Cowley* (1834, 1 W. P. C. 462), in which the invention claimed was the bringing to a welding heat of a long piece of iron of the proper quality, after having turned up its edges, and drawing it through a hole of the 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 as a fact, that the

two rollers with grooves were a mere mechanical equivalent for the hole through which the iron was passed according to the plaintiff's invention, and that the patent had been infringed.

Taking out a patent for a process or machine that infringes a prior patent does not in itself amount to infringement (r), nor does the granting of a licence to manufacture under a subsequent patent amount to infringement (s); infringement depends upon what the alleged infringer has done. There are three ways in which a patent may be infringed:—

Patenting is not infringing.

1. By making the patented article or working the process.
2. By using.
3. By selling.

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* (1879, L. R. 12 Ch. D. 826) the invention consisted in the application of cards or strips of leather covered with wire to 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 amount for which he contracted. The consequence is that in my judgment all the defences fail" (t).

Infringement by agents and servants.

(r) *Tweedale v. Ashworth*, 1890, 7 R. P. C. at p. 431.

*McCornish v. Gray*, 1861, 7 H. & N. 25; 31 L. J. Ex. 46.

(s) And see *Gibson and Campbell v. Brand*, 1842, 1 W. P. C. at p. 631;

(t) *Montyomerie v. Paterson*, 1894, 11 R. P. C. 221.

But actions against mere workmen who innocently help in an infringement, and are not the really guilty persons, will not be encouraged (*u*).

Express instructions as of patentee.

Express instructions given by the patentee or on his behalf will negative infringement.

In *Kelly v. Batchelar* (1893, 10 R. P. C. 289) the plaintiff's patent was for a telescopic ladder, being two ladders joined together, the inner being raised or lowered by means of an endless cord. The plaintiff, for the purpose of adducing evidence of infringement, instructed an agent to order from the defendant an adjustable ladder with an endless cord. The defendant made a ladder to this order, but without a cord. The agent of the plaintiff said that it would not do, but must have a cord with pulleys, whereupon the defendant added the cord as instructed. In the action for infringement brought against the defendant, North, J., held that the defendant acted upon the express instructions of the plaintiff's agent, who had power and authority to give such instructions, and, consequently, that making this ladder did not amount to an infringement of the plaintiff's patent (*x*).

In *The Dunlop Pneumatic Tyre Co. v. Neal* (1899, 16 R. P. C. 247), the agent of the plaintiffs was sent to the defendant to ask him to repair an old tyre, the subject of the plaintiffs' patent, with a view to ascertaining whether the defendant was infringing the patent by purporting merely to repair tyres. The agent gave no express instructions as to what was to be done to the worn tyres beyond saying that they were to be repaired. It was held that what was done by the defendant amounted to infringement, and that in such a case he could not shelter himself behind the instructions of the plaintiffs' agent.

Making and selling elements of combination.

Where the patent is for a combination there is no infringement in making or selling the separate elements of the combination even though the manufacturer or vendor knows perfectly well that the separate elements are destined eventually to be combined so as to constitute an infringement.

(*u*) See *Savage v. Brindle*, 1896, 13 R. P. C. at p. 267.

(*x*) Also *Henser v. Hardie*, 1894, 11 R. P. C. 421

In *The Dunlop Pneumatic Tyre Co. v. Moseley* (1904, 1 Ch. 177; 21 R. P. C. 274) the patent was for a pneumatic tyre cover, held on to the rim of the wheel by wires passed through circumferential pockets in the edges of the cover. The defendants made and sold covers only, fitted with pockets, but without wires, and advertised them as "ready for wires." There was no other evidence to connect the defendants with the persons who purchased the covers and fitted the wires. It was held, following *Townsend v. Haworth* (1875, L. R. 12 Ch. D. 831, n.), and after an elaborate review of the authorities, that this did not constitute infringement.

But where the circumstances were such as to indicate very clearly that the person selling an element which did not infringe was practically in partnership with another person who completed the infringement, and the real object of his business was to aid in the infringement, an injunction was granted (y). And making and selling all the constituent parts of a machine so that they could easily be put together would probably amount to evidence of infringement (z).

In *Townsend v. Haworth* (1875, L. R. 12 Ch. D. 831, n.) 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

(y) *The Incandescent Gas Light Co. v. New Incandescent Mantle Co.*, 1898, 15 R. P. C. 81.      (z) *United Telephone Co. v. Dale*, 1884, L. R. 25 Ch. D. at p. 782.

that the purchaser intends to make use of it for that purpose."

**Aiding and abetting infringement.**

In *Innes v. Short* (1898, 15 R. P. C. 450) the plaintiff's patent was for the use of powdered zinc in boilers to prevent incrustation. The defendant sold bags of powdered zinc with directions for the use of the powder in boilers. Bigham, J., granted an injunction to restrain the sale *in this manner*, and said: "There is no reason whatever why Mr. Short should not sell powdered zinc, and he will not be in the wrong, though he may know or expect that the people who buy it from him are going to use it in such a way as will amount to an infringement of Mr. Innes' patent rights. But he must not ask the people to use it in that way in order to induce them to buy his powdered zinc from him." It is submitted that this decision was erroneous. There cannot be a claim for "an old substance for a new purpose," for a purpose is not a manufacture—the true claim is for the "new use of an old substance"—and this is not infringed unless the old substance is actually put to that new use. Moreover, there is no such tort as "aiding and abetting" infringement (a).

**Infringement by repairing.**

The points above considered are of material importance when it is alleged that the patent has been infringed by what amounts to the manufacture of a new article under the guise of repairing an old article which has been made under the patent. The tests by which such cases may be decided were enunciated by Kekewich, J., in *The Dunlop Pneumatic Tyre Co. v. The Holborn Tyre Co.* (1901, 18 P. O. R. 226): "There are two tests which might equally well be applied to this question on the evidence. The first test would be this: In the alleged repair, has the workman so employed the patent as that in doing it he has taken an essential part of the patent and infringed it? . . . . But there is another test which, but for the existence of the patent, one would employ, and which I think is the real and most satisfactory test to employ now, and

(a) See Lindley, L.J., in *Badische Anilin und Soda Fabrik v. Johnson & Co.* 1897, 14 R. P. C. at p. 413 ;

and Fry, J., in *Sykes v. Howarth*, 1879, L. R. 12 Ch. D. at p. 833.

that is this : Is it substantially, in common parlance, honestly, a new article, or is it an old article repaired ? ” (b).

In *The United Telephone Co. v. Nelson* (1887, W. N. 192) it was held that the restoration of a broken instrument which had originally been licensed under the patent was an infringement. But the case is not fully reported. It appears to be a question of fact whether an instrument is broken to such an extent as to destroy its identity so as to enable the patentee to say that the repair by its owner amounts in fact to the manufacture of a new article. In *The Sirdar Rubber Co., Ltd. v. Wallington, Weston & Co.* (1907, 24 R. P. C. at p. 543) Lord Halsbury said : “ The principle is quite clear, although its application is sometimes difficult ; you may prolong the life of a licensed article but you must not make a new one under cover of repair.”

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 *Jones v. Pearce* (1832, 1 W. P. C. at p. 125) Patteson, J., said : “ Now, if he did actually make these wheels, his making them would be a sufficient infringement of the patent, unless he merely made them for his own amusement or as a model.” In *Frearson v. Loe* (1878, 9 C. D. at p. 66) 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

Experiments.

(b) See also *Dunlop Pneumatic Tyre Co., Ltd. v. Neal*, 1899, 16 R. P. C. 247 ; *Dunlop Pneumatic Tyre Co., Ltd. v. Excelsior Tyre Co.*, 1901, 18 R. P. C. 209 ; *Dunlop Pneumatic Tyre Co., Ltd. v. Holborn Tyre Co.*, 1901, 18 R. P. C. 222.

been granted, but with a 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" (c).

Use to instruct pupils.

To purchase and use 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 (d).

The grant confers the sole right to "make, use, exercise, and vend" the invention, and by the words of the prohibition the subject is commanded to refrain from "making use of or putting in practice" the said invention. There are a number of cases which have been decided upon the meaning of these words, and they are principally concerned with instances where the defendant has certainly derived advantage from the invention, and yet it would be difficult to say that he had been guilty of making or vending.

Sale of article made by patented process.

In the case of a patent for a process the sale of goods manufactured by that process is an infringement of the process, even though the manufacture took place abroad. In *Wright v. Hitchcock* (1870, L. R. 5 Ex. at p. 47) Kelly, C.B., said: "If the law were otherwise, then when a man has patented an invention, another might, by merely crossing the Channel, and manufacturing abroad and selling in London for far less than the original price, but also at a trifle less than the price charged by the patentee, articles made by the patented process, wholly deprive the patentee of the benefit of his invention. It is therefore impossible to suppose that an exclusive right to vend is not given, and the defendants have therefore infringed the

(c) See also *Muntz v. Foster*, 1844, 2 W. P. C. at p. 101; *Proctor v. Bayley*, 1889, 6 R. P. C. 106.

(d) *United Telephone Co. v. Sharples*, 1885, L. R. 29 Ch. D. 164; 2 R. P. C. 28.

plaintiff's right, and it is immaterial whether it was so was not known to them that Orr's machine was identical with the plaintiffs" (e).

Where the defendant has used and sold articles alleged to have been made by the patented process, the onus of proving that they were in fact made by that process is on the plaintiff; but where such articles were made abroad, and the plaintiffs, in consequence, could not be afforded full opportunity of inspecting the machinery by which they were made, it has been held that it lies with the defendants to rebut a *prima facie* case made out by the plaintiffs (f).

Onus of proof  
in such cases.

In the various *Saccharin Cases* (f), the plaintiffs were the owners of patents which covered all known processes of making saccharin. They were able to produce evidence to the effect that although it was conceivable that saccharin might be made in some other way, no other processes were then known to the scientific world. The defendants, who imported saccharin, could never give any satisfactory account of the way in which the imported substance was actually made. It was held that infringement had been made out.

But in *The Cartsburn Sugar Refining Co. v. Sharp* (1884, 1 R. P. C. 181) the alleged infringement consisted in the sale in England of cube sugar manufactured in America by a machine made in accordance with the specification of the plaintiff's patent. Lord Kinnear, in his judgment, said (at p. 186): "No witness has been examined of sufficient skill as a mechanic to give a detailed description of the machine in question. All that is proved is that it does not correspond in all respects, though in some respects it does correspond, to the description in *Hersey's* patent. It is said that as the manufacture complained of had taken place in America, it was incumbent on the respondents, upon the principle which received effect, in the case of *Neilson v. Betts* (supra), to prove by negative evidence that it was not manufactured according

(e) See also *Elmslie v. Boursier*, L. R. 9 Eq. 217; *Von Heyden v. Neustadt*, 1880, 14 C. D. 230.

(f) *Neilson v. Betts*, 1871, L. R. 5 H. L. at p. 11; *Saccharin Corpora-*

*tion v. Dawson*, 1902, 19 R. P. C. 169; *Saccharin Corporation v. Jackson*, 1903, 20 R. P. C. 611; *Saccharin Corporation v. Mack*, 1906, 23 R. P. C. 611.



to the specified process. I think no such onus lies upon the respondents in the present case, because there can be no question on the evidence that such articles as were sold by the respondents *may have been* produced by machinery which involved no infringement of the complainer's patent. That being so, it lay upon the complainers to prove their case, and as they took a commission to America for the purpose of proving it, there could have been no difficulty in their obtaining a sufficient description of the machine to which it is alleged they have traced the cubes of sugar sold by the respondents to enable them to establish the infringement, if infringement there was."

In *Gibson v. Brand* (1842, 4 M. & G. 196, 2 W. P. C. 631) it was held that an order given by the defendant for the making of silk by a process which infringed the plaintiff's patent, which order was executed in England, was sufficient to satisfy the allegation that the defendant made, used, and put in practice the plaintiff's invention, though the silk was in fact made through the agency of others. Sir N. C. Tindal, C.J., said: "This is quite sufficient to satisfy an allegation that he made those articles, for he that causes or procures to be made, may well be said to have made them himself."

Contracts for  
delivery in  
United King-  
dom and  
abroad.

The delivery, however, must take place in this country to constitute an infringement. In *The Badische Anilin und Soda Fabrik v. The Basle Chemical Works* (1898, A. C. 200; 14 R. P. C. 919), a trader in England ordered goods from the defendant in Switzerland to be sent by post to England. The defendant addressed the goods to the trader in England, and delivered them to the Swiss Post Office, by whom they were forwarded to England. The goods were manufactured according to an invention protected by the plaintiffs' patent. It was held by the House of Lords that, since the contract of sale was completed by the delivery to the Post Office in Switzerland, and since the Post Office was the agent of the buyer and not of the vendor, the vendor had not made, used, exercised, or vended the invention within the ambit of the patent, and that the patentee had no right of action against the vendor for an infringement of the patent.

In *The Saccharin Corporation v. Reitmeyer & Co.* (1900, 2 Ch. 659; 17 R. P. C. 606) the facts were as follows: The defendant, while in England, contracted with persons in England for the delivery to them at a *foreign* port of goods manufactured on the Continent by a process similar to that protected by the plaintiff's English patent. Cozens-Hardy, J., said: "Now it is plain that a patent is of local force . . . . it is admitted that the defendant has not 'made' or 'used,' and I think it is clear that he has not 'vended' within the jurisdiction (see *Badische Anilin Co. v. Basle Chemical Works*, supra). It is said, however, that he has 'exercised' the invention within the jurisdiction. It is remarkable that this word, which has been found in letters patent at least since 1621, so far as I am aware, has never been construed. I think, however, that it can only mean 'put in practice.' I do not think it can be taken to cover a transaction such as I have to deal with. The defendant, as a commission agent, contracted for delivery to the purchasers at a German port. He had no interest whatever in the case when delivered at the foreign port to the purchasers. He had no right to control its destination. I assume that he knew or suspected that the greater part of the stuff would find its way into this country, but I cannot regard that as material."

The House of Lords in *The Badische Anilin und Soda Fabrik v. Hickson* (1906, A. C. 419; 23 R. P. C. 433) approved of this decision, and a *ratio decidendi* was stated by Lord Loreburn, L.C., which raises a point of difficulty: "A contract to sell unascertained goods is not a complete sale, but a promise to sell. There must be added to it some act which completes the sale, such as delivery or the appropriation of specific goods to the contract by the assent, express or implied, of both buyer and seller. Such appropriation will convert the executory agreement into a complete sale." It would seem, therefore—if this be the correct view—that had the vendor notified the purchaser in accordance with the Sale of Goods Act that certain specific lots had been set aside for him abroad, and had the purchaser expressly or impliedly assented to such appropriation, an action for infringement could successfully have been brought against

the vendor. On the other hand, Lord Davey considered that even if the property passed in this country it would not affect the question of infringement." He said (1906, A. C. at p. 423): " . . . Nor is it material to consider whether or when the property in the goods passed to the purchaser. It is lawful to be the owner of the goods if made and situate abroad, and neither the vendor nor the purchaser in my opinion thereby infringes the patent. The goods may or may not be afterwards brought into this country, and a different question will then arise, but that is no concern of the vendor after he has parted with them. I am of opinion that 'vending the invention' in the common form of patent is confined to selling goods made or brought into this country, and that the respondent in this case has not, directly or indirectly, made, used, or put in practice the appellant's invention within the meaning of the prohibition contained in the patent." Lord Atkinson's judgment is to the same effect. To export under a contract of sale, whether such contract was made here or abroad, is an infringement. In *The British Motor Syndicate v. Taylor* (1900, 17 R. P. C. 189, 723) the defendants bought in England twenty-seven infringing articles; they sold seven of them and used another in England; As regards the remaining nineteen, they sent them abroad to their French house in Paris, where they sold them to various foreign firms. The question was whether there had been an infringement in respect of these nineteen. Stirling, J., decided that this was "making use of" the invention, and that the words "make use of" have a wider significance than the words "put in practice." The learned judge said: "In the present case the patented articles, when being transported from place to place in this country, were not serving the purpose for which they were patented, and in my opinion the defendants did not, during that transporting, exercise or put in practice the patented invention. What the defendants did was to carry these articles out of the kingdom with a view to selling them; that is, with the object of turning them to profitable account" (g).

Sending  
abroad.

Purchase,  
transport, and  
possession.

Mere purchase, possession, or transport does not amount to

(g) See also *United Telephone Co. v. Sharples*, 1885, L. R. 29 C. D. 164; 2 R. P. C. 28.

infringement, unless it involves the putting in practice of the invention, although it may justify an injunction on the ground that it is strong evidence of a threat to use (*h*).

In the case of *Neilson v. Betts* (1871, L. R. 5 H. L. 1), 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. Neilson 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' 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 (L. R. 3 Ch. at p. 439): "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

(*h*) *Adair v. Young*, 1877, 12 C. D. 13; *United Telephone Co. v. London and Globe Telephone Co.*, 1884, L. R. 26 C. D. 766; *British Motor Syndicate v. John Taylor and Sons*, 1901, 1 Ch. 122; 17 R. P. C. at p. 723; *British United Shoe Machinery Co. v. Simon Collier, Ltd.*, 1909, 26 R. P. C. at p. 41. Cf. *Proctor v. Bayley*, 538, and see Chap. XV., part ii.

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.* (1881, 17 C. D. 721) 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 matter 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. It was 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. His judgment 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. (i).

Exposure for sale.

Possession accompanied by exposure for sale is an infringement, as it is a user for one of the purposes for which it was intended that the patentee alone should use it during the fourteen years (k).

Use on ships.

In the case of *Caldwell v. Vanlissengen* (1852, 21 L. J. Ch. 97), 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.

(i) See also *The Universities of Oxford and Cambridge v. Richardson*, 6 Ves. 689; *The Dunlop Pneumatic Tyre Co. v. British and Colonial Motor Car Co.*, 1901, 18 R. P. C.

313.

(k) Alverstone, L.C.J., in *British Motor Syndicate, Ltd. v. John Taylor and Sons, Ltd.*, 1900, 17 R. P. C. at p. 729.

In the case of *Adair v. Young* (1877, 12 C. D. 13), 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.

By sect. 48 of the Act of 1907, corresponding to sect. 43 of the Act of 1883,

(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 His 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) "*This section shall not extend to vessels of any foreign state of which the laws do not confer corresponding rights with respect to the use of inventions in British vessels while in the ports of that state, or in the waters within the jurisdiction of its courts.*"

A patent is not infringed by the use of the invention on board an English vessel abroad (l).

In the case of *Nobel's Explosives Co. v. Jones and Scott* (L. R. 8 A. C. 5) the Court of Appeal reversed the decision of Vice-Chancellor Bacon, on the grounds that the defendants had not infringed the plaintiffs' patent, they having merely acted as Custom House agents for the transhipment of the dynamite, and their functions being confined to obtaining papers necessary for such transhipment, and that they never had any ownership in or exercised any control over the dynamite.

Custom House agents.

An action may properly be brought against innocent carriers of infringing articles for an injunction to restrain them from dealing with or disposing of such articles in any way (m).

Carriers.

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

*Co.*, 1889, 6 R. P. C. at p. 403; see also *Upmann v. Elkan*, 1869, L. R. 7 Ch. 130.

(m) *Washburn and Moen Manufacturing Co. v. Cunard Steamship*

*See also ...*

**Lending.**

Lending is not selling and is not an infringement (n).

**Effect of sale  
by patentee.**

A patentee by himself or by his agent selling the patented article without limitation sells with it the right of free disposition as to that article, and if he sells the article abroad, the purchaser may import and sell it in England. Lord Hatherley, in *Betts v. Willmott* (1871, L. R. 6 Ch. at p. 245), said: "Unless it can be shown, not that there is some clear injunction to his agents, but that there is some clear communication to the party to whom the article is sold, I apprehend that 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 licence 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, being owners of patents in Belgium and England for an invention for making glass lamp globes, by a deed executed in Belgium, granted a licence to the plaintiffs to manufacture under their invention in Belgium but not elsewhere, and the plaintiffs under this licence 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 licence to use the patent in Belgium did not imply permission to sell the manufactured article in England in violation of the defendants' English patent (o).

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

(n) *United Telephone Co. v. Henry*, 1885, 2 R. P. C. 11; Griff. P. C. 228.

(o) *Société Anonyme des Manufac-*

*tures de Glaces v. Tilghman's Patent Sand Blast Co.*, 1883, L. R. 25 Ch. D. at p. 9; and see p. 204, ante.

Act 1907. See 29. Acton v. Crowe  
in re Hale.

XXXV R.P.C. 172. & XLII R.P.C. 18  
Hale v. Columbe  
Common on Buns Inventor

Selling article below fixed price

Columbe Graphophone v. Murray

XXXIX R.P.C. 249.



monopoly rights in France, but only in England, the patentee could not make and sell in France and 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 (p).

The question of infringement by the breach of a limited licence has been dealt with in Chap. X. at p. 209 et seq.

Limited licence.

In *Monforts v. Marsden* (1895, 12 R. P. C. 266) it was decided that the sale of an article does not imply any warranty within sect. 12 of the Sale of Goods Act, 1893, that the article sold is not an infringement of an existing patent, and in that case it was not contended that there was any implied warranty apart from the section.

No warranty under Sale of Goods Act.

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.

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 (q).

Sect. 27 of the Act of 1883 (re-enacted by sect. 29 of the Act of 1907) provided that a patent should bind the Crown, but that the Crown might use the invention "by agents or contractors" on terms to be before or after the use agreed upon (see p. 12, ante).

(p) *Betts v. Willmott*, 1871, L. R. 6 Ch. 239. and L. R. 1 App. Cas. 632, reversing decision of the Court of Appeal,

(q) *Dixon v. The London Small Arms Co.*, 1875, L. R. 10 Q. B. 130, L. R. 1 Q. B. D. 384; also *Feather v. R.*, 1865, 6 B. & S. 257.

*Arrangements claimed in the specification*  
*vide ante 29 R.P.C. 266*  
*As to infringement of Gov contractors see*  
*Pyrene v. Hobbs, 1878 11 Q.B. 513*  
*1878*

## CHAPTER XV.

## ACTION FOR INFRINGEMENT.

## I. PARTIES.

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.

The Act 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.

**Plaintiff.** *The Plaintiff.*—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, even though he have acquired the right by assignment of two separate moieties, and the party sued be the original grantee (a).

**Joint owners.** 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 (b), and he may sue alone for an account of profits, and for payment to the plaintiff of such part of such profits as the plaintiff should be entitled to.

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* (7 C. B. N. S. at p. 209), said: “The question is 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

(a) *Walton v. Lavater*, 1842, 8 C. B. N. S. 162; 29 L. J. C. P. 275; see p. 196, supra.

(b) *Sheehan v. Great Eastern Railway Co.*, 1880, 16 Ch. D. 59, and see p. 198, supra.

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. 14, sub-sect. 2, however, of the Act of 1907 (corresponding to sect. 33 of the Act of 1883) provides, "*Every patent . . . shall be granted for one invention only, but the specification may contain more than one claim; and 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 has been granted for more than one invention.*"

By sect. 14, sub-sect. 1, "*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.

Assignee for a district.

Whether the assignment must be registered before the assignee can sue is a question which has not been settled (c). But as there is no difficulty in effecting registration at any time this point need not give trouble.

Registration of assignment.

An equitable assignee cannot sue without joining the legal owner. In *Bowden's Patent Syndicate, Ltd. v. H. Smith & Co.* (1904, 2 Ch. 86; 21 R. P. C. 438), the facts were as follows. In 1897 B. applied for a patent. By a deed in the same year B. assigned to the plaintiffs the benefit of this application. The patent was subsequently granted to B. and of course was dated as of the day of application. In June, 1903, the plaintiffs issued the writ in this action, and in October, 1903,

Legal owner must be party.

(c) See p. 218, *supra*.

B., in pursuance of the deed of 1897, assigned the letters patent to the plaintiffs. B. had since died. It was held that as the patent was not granted at the time of the assignment of 1897 that assignment was equitable only, and consequently the plaintiffs at the date of the issue of the writ were not the legal owners of the patent and could not sue. They were allowed to amend the writ and statement of claim by adding the executors of B.

Licensees  
cannot sue.

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 licence might grant a dozen other such licences without prejudicing the rights of the licence; and although 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, yet he cannot sue infringers (*d*).

Trustees in  
bankruptcy  
and execu-  
tors.

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

Mortgagee  
cannot sue.

A mortgagee of a patent is not a necessary party in an action for infringement of that patent (*f*), and he cannot sue infringers (*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*).

Defendants.

As defendants, any person infringing is liable (*i*).

A company, to whom the business of the defendants was assigned while an action for infringement of a patent was pending against them, cannot be joined as co-defendants in that action (*k*).

Effect of  
contract of  
indemnity.

But where an indemnity was given to the defendants, after the commencement of the action, by a third party who had manufactured the infringing articles, it was held that the person giving such an indemnity should be joined as a party

(*d*) See p. 202, supra.

(*e*) See p. 193, supra.

(*f*) *Van Gelder v. Sowerby Bridge Flour Co.*, 1890, 7 R. P. C. 208; and see p. 196, supra.

(*g*) *Ibid.*

(*h*) *Adams v. North British Railway Co.*, 1873, 29 L. T. N. S. 367.

(*i*) See Chap. XIV.

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

under R.S.C. Order XVI. r. 48 (l), but such third party will only be bound by the decision of the Court so far as such decision falls within the terms of the order by which he was directed to appear, and if the plaintiffs neglect to amend by joining him as a defendant they will not be able to obtain an injunction against him as well as against the actual defendant (m).

The manufacturer and patentee of a machine, the use of which is claimed to be an infringement of another patent, cannot compel the plaintiff to join him as a co-defendant with the person by whom the machine was used and against whom the action for infringement was brought (n).

Manufacturers need not be joined.

An action is properly brought by the patentee against a company who are innocent carriers of infringing articles, to restrain them from dealing with or handing over such articles to other persons, and on the discovery of the name of the consignee, such consignee should be joined as a co-defendant in the action (o).

Carriers.

II. PLEADINGS.

Writ.—An action for infringement is commenced by writ issued out of the High Court of Justice.

The writ.

The writ may be issued either in the King's Bench or in the Chancery Division, but the machinery of the latter tribunal is the more suitable, and is the more generally used.

See Sec 8. Defico.  
+ See p 207 18th 19

In nearly all actions for infringement, the writ is indorsed with a claim for (1) an injunction; (2) damages, or, in the alternative and at the option of the plaintiffs, an account of sales and profits; and (3) delivery up to the plaintiffs or destruction of all infringing articles in the possession of the defendants. If the patent has expired there cannot, of course, be a claim for an injunction.

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

(l) *Edison v. Holland*, 1886, 3 R. P. C. 395. *facturing Co. v. Cunard Steamship Co.*, 1889, 6 R. P. C. 398, 403; and

(m) *Edison v. Holland*, 1889, 6 R. P. C. 243, 286. see p. 370, post.

(n) *Moser v. Mursden*, 1892, 9 R. P. C. 214. (a) *Speckhart v. Campbell, Achnach & Co.*, Solr. Journ. Feb. 2nd, 1884; Vol. 28, p. 254; W. N. (84)

(o) *Washburn and Moen Manu-* 24.

The practice is regulated by Order LIIIA. of the Supreme Court Rules, dated June 3, 1908, and made pursuant to sect. 98, sub-sect. 1, of the Act of 1907. In addition to the special rules of this order, the ordinary rules apply where applicable (b).

By sect. 98, sub-sect. 1, corresponding to sect. 107 of the Act of 1883, nothing is to affect the forms of process in Scotland, and, apart from rules which may be made by the Scotch Courts, the practice seems to remain what it was under the Act of 1883, so far as particulars and costs are concerned, for the English Supreme Court Rules do not apply to Scotland (c).

Statement of claim.

**Statement of claim.**—Order 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 where 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 form 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.

The statement of claim should allege that the plaintiff is the grantee or registered legal owner of the letters patent, and if his title is derived by assignment he should set forth the devolution; this, however, is not strictly necessary.

It is unnecessary to allege either that the plaintiff or the original patentee was the first and true inventor (d), or that the invention is new (e). If the specification has been amended, it is better to plead the fact, and that the original specification was framed in good faith and with reasonable skill and

(b) See *Haddan's Patent*, 1884, 54 L. J. Ch. 126; *Griff. P. C.* 108 (decided before O. LIIIA.).

(c) And see *Mica Insulators Co., Ltd. v. Bruce, Peebles & Co., Ltd.*,

1905, 22 R. P. C. 527.

(d) See *Ward v. Hill*, 1901, 18 R. P. C. 491.

(e) *Amory v. Brown*, 1869, L. R. 8 Eq. 663.

knowledge (*f*), since, by sect. 23 of the Act of 1907 (sect. 20 of the Act of 1883) (see p. 189, ante), no damages are recoverable in respect of infringements committed prior to the amendment unless the patentee can satisfy the Court that it was so framed.

If a certificate of validity has been granted in a previous action so as to entitle the plaintiff to solicitor and client costs under sect. 35 of the Act of 1907 (sect. 31 of the Act of 1883), the certificate and the claim to such costs should be pleaded (*g*).

Two or more patents may be sued on at one and the same time if the different issues can be conveniently tried together. In some of the actions brought by the Saccharin Corporation, the position was peculiar. The Corporation owned more than twenty patents for processes for making saccharin, which included every known process of manufacture. The saccharin manufactured by the defendants showed no trace of the method by which it had been brought into existence, and the plaintiffs were unable to say precisely which of their patents had been infringed. The Court of Appeal allowed the plaintiffs to select a certain limited number of these patents and to allege that the defendants had infringed one or other of them (*h*). The limitation of the number of the patents sued on was to enable the defendants to attack their validity without embarrassment on the question of costs (see particulars of objections, below).

**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 by sect. 29, sub-sect. 1, of the Act of 1883. Rules 13, 16, 19, 20 and 21 of Order LIIIA., have replaced these statutory requirements and are as follows: “(13) *In action for infringement of a patent, the plaintiff must deliver with his statement of claim particulars of the breaches relied upon.*”

Particulars of Breaches.

The new rules.

“ (16) *Particulars of breaches shall specify which of the claims in the specification of the patent sued upon are alleged to be*

(*f*) *Kane and Pattison v. Boyle, White & Sons, Ltd., 1903, 20 R. P. C. 1901, 18 R. P. C. 337. 454 ; Saccharin Corporation v Alliance Chemical Co., Ltd., 1905, 22*

(*g*) *The Pneumatic Tyre Co. v. Chisholm, 1896, 13 R. P. C. 488. R. P. C. 175.*

(*h*) *Saccharin Corporation v. R.*

*infringed, and shall give at least one instance of each type of infringement of which complaint is made."*

*"(19) Particulars of breaches and particulars of objections (i) may from time to time be amended by leave of the Court, upon such terms as may be just."*

*"(20) Further and better particulars of breaches or particulars of objections may at any time be ordered by the Court."*

*"(21) At the hearing of any action, petition, or counterclaim relating to a patent, no evidence shall, except by leave of the Court (to be given upon such terms as to the Court may deem just), be admitted in proof of any alleged infringement or objection not raised in the particulars of breaches or objections respectively."*

The practice as formulated by these rules is substantially the same as that under sect. 29, sub-sect. 1, of the Act of 1883.

**Purpose of  
particulars of  
breaches.**

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 (*k*). In *Batley v. Kynoch* (1874, L. R. 19 Eq. at p. 231), 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."

It had, 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 plaintiff cannot be required to place a construction upon his patent in his particulars of breaches (*l*).

(i) See p. 335, *infra*.

1893, 10 R. P. C. 256.

(k) *Needham v. Oxley*, 1863, 1 H. & M. 248; *Mandleberg v. Morley*,

(l) *Wenham Co. v. Champion Gas Co.*, 1891, 8 R. P. C. 22.



The requirements of particulars of objections differ materially from those of particulars of breaches. In the case of objections taken by the defendant to the plaintiff's patent, it is essential that each objection should be set out in detail and that the defendant should be tied down to the particular instances of anticipation which he discloses in those particulars, since the objections to be taken by the defendant at the trial cannot otherwise lie within the plaintiff's knowledge, whereas in the case of particulars of breaches, to use the words of Bristowe, V.-C. (*m*): "You must always bear this in mind, that the plaintiff, asserting his patent, knows what he claims, and he says, 'I tell the public according to that which I am bound to do by the specification that which I do claim'; and the defendant well knows, or the defendants, as in this case, perfectly well know what they are doing." Consequently to fulfil the object for which such particulars are required, it is only necessary for the plaintiff to indicate what patent or portions of what patent he relies upon and in what way he considers the defendant to have infringed, and if these two points be made clear without adducing specific instances, that will be sufficient.

Differ from particulars of objections.

Rule 16, in so far as it refers to the necessity of specifying, in all cases, the claiming clauses which are alleged to be infringed, follows what was substantially the practice before the rule in cases where the specification included a number of claims.

There is no objection, however, to a plaintiff stating that he relies on *all* the claims of his specification, and it is a matter of costs at the trial if this course has been taken unreasonably (*n*).

In future, by rule 16, it will be obligatory to specify some instance of infringement. This is new, as a rule of practice, but in most particulars of breaches it has been customary to state that the patent has been infringed and "in particular by the sale, on the 3rd day of May, 1909, to one A. B., of an article constructed according to the invention described and claimed in claim No. —." This has been for the purpose of

Type of infringement must be specified.

? *Interim ~*  
*Money ch. work*  
*v Levenstein*  
*v v R.P.C. 677.*

(*m*) *Cheetham v. Oldham*, 1888, 5 L. R. 11 App. Cas. 648; *Haslam v. R. P. C.* at p. 626; see also *Talbot Hall*, 1887, 4 R. P. C. 206.  
*v. La Roche*, 1854, 15 C. B. at (n) *Haslam & Co. v. Hall*, 1887, 4 p. 321; *Ledgard v. Bull*, 1886, R. P. C. at p. 206.

identifying the type of act complained of, and technically proving it if denied. The giving of the instance is merely for identification purposes, and a defendant was not supposed to limit his rights to damages to the example only (o). "It lies on the party who alleges that for the honest purpose of his litigation he wants further information or limitation, to satisfy the Court that he is really placed in a difficulty by the particulars as they stand" (p).

When an action is brought in respect of a particular type of infringement, and to restrain the threatened infringement by continued manufacture of that type (the usual way in which an action is framed), the plaintiffs will not be allowed to give evidence of infringements of a different type committed after action brought to justify the allegation of intention to infringe; the proper course is to apply to amend the particulars of breaches (q).

Further particulars of breaches have sometimes been postponed to discovery on the ground that the defendant knew the breaches which he had committed better than the plaintiff (t).

Degrees of  
particularity  
required  
against  
vendor.

Where an action is brought against the vendor of articles alleged to have been made by a process which infringed the plaintiff's patent, a greater degree of precision is required in the particulars of breaches than if the defendant had been the manufacturer himself.

In *Mandleberg v. Morley* (1893, 10 R. P. C. 260), Stirling, J., said: "Now if a manufacturer is attacked for infringing a patent by a particular process he does not want to be told in the shape of particulars, or otherwise, what the process is he is using. He knows what the process he is using is. But it is a very different thing with respect to a vendor. The vendor does not know with certainty what process is being used

(o) See *Haslam & Co. v. Hall*, 1887, 4 R. P. C. 203. *Tilghman's Patent Sand Blast Co., Ltd. v. Wright and Butler Ltd.*, 1884, 1 R. P. C. 103.

(p) Per Wills, J., in *Haslam & Co. v. Hall*, 1887, 4 R. P. C. at p. 207.

(q) *The Shoe Machinery Co., Ltd., v. Cutlan*, 1895, 12 R. P. C. 342; *The Welsbach Incandescent Light Co., Ltd. v. Dowle*, 1899, 16 R. P. C. 391.

(t) *Russell v. Hatfield*, 1885, Griff. P. C. 204; 2 B. P. C. 144.

by the person from whom he himself buys, and who manufactures the article.”

In that case the particulars of breaches alleged that : “ The plaintiffs complain that each of the said letters patent of the plaintiffs have been infringed by the sale and exposure for sale by the defendants of each of the said garments known as ‘ The Champion,’ and ‘ The Distingué,’ and by the sale and exposure for sale of other waterproof garments made by the manufacturers of ‘ The Champion,’ ‘ The Distingué,’ and ‘ The Tropical Odourless,’ but not bearing their distinguishing names, but which unnamed garments are manufactured by similar processes to the three named garments.” It was held that the reference to unnamed garments was not sufficiently specific, as it was not clear that the unnamed garments referred to were substantially the same as those which were specifically mentioned.

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 have waited until the trial to take his objection (u).

Evidence  
admitted if  
within  
particulars.

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. Bollard*. It appears to me I have to inquire what is the meaning of the particulars. I find the case of Hirst is within the literal meaning of the particulars.

(u) *Hull v. Bollard*, 1856, 25 L. J. Ex. at p. 306.

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 Shaw'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 that there is no such witness" (*v*).

Conversely, where the particulars of breaches complained of infringement by user only, the Court refused to enter into the question as to whether there had been infringement by manufacturing the articles complained of (*w*).

Particulars of breaches may also be ordered in actions which are not strictly actions for infringement or petitions for revocation; this is done under the ordinary jurisdiction of the Court (*x*). In an action charging that the defendant falsely and maliciously wrote and told persons who had bought certain machines of the plaintiff's 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 part 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 (*y*).

Where infringement alleged to be contemplated in future.

Where the plaintiff claiming an injunction relies on certain acts of the defendant as evidence of an intention to infringe in the future, the defendant is entitled to full notice of the nature of the infringements he is alleged to be contemplating, especially where such acts have been committed since action brought (*z*), and the plaintiff will not be permitted to adduce evidence thereof unless such notice has been given.

(*v*) *Sykes v. Howarth*, 1879, L. R. 12 Ch. D. 826.

(*w*) *Henser v. Hardie*, 1894, 11 R. P. C. 421, 427.

(*x*) *Perry v. Mitchell*, 1840, 1 Web. P. C. 269.

(*y*) *Wren v. Weild*, 1869, L. R. 4 Q. B. 213.

(*z*) See *The Shoe Machinery Co. v. Cutlan*, 1895, 12 R. P. C. 357; *Welsbach Incandescent Light Co. v. Dowle*, 1899, 16 R. P. C. 391.

## STATEMENT OF DEFENCE.

Defence.—The following defences are available to a defendant to an action for infringement. Defences available.

1. He may deny the plaintiff's title to the letters patent sued on.
2. He may plead the leave and license of the patentee, specifying the circumstances.
3. He may deny that he has committed the acts complained of in the particulars of breaches.
4. He may deny that the acts complained of are infringements of the letters patent.

[Nos. 3 and 4 are included under a mere denial of infringement.]

5. He may allege that the letters patent are invalid, in which case he must deliver particulars of objections to the validity.
6. He may allege that the patented article or process is carried on exclusively or mainly outside the United Kingdom (constituted a defence by sect. 25, sub-sect. 2, of the Act of 1907).
7. He may allege circumstances which would have justified revocation of the patent on an application for a compulsory licence or revocation under sect. 24 of the Act of 1907 (constituted a defence by sect. 25, sub-sect. 2).
8. He may allege that in a contract made after the passing of the Act of 1907, if such contract is in force at the time, relating to the sale or lease of, or licence to use or work any article or process protected by the patent, there exist certain conditions which are made void by sect. 38 (constituted a defence by sect. 38, sub-sect. 4).
9. As a defence to a claim for damage (but not to a claim for an injunction) on a patent granted after the commencement of the Act of 1907, he may allege that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent (constituted a defence to a claim for damages by sect. 33 of the Act of 1907).

**Estoppel.**

An assignor who has covenanted for the validity of the patent is estopped from alleging invalidity in an action for infringement brought against him by the assignee (see p. 200 *et seq.*).

A licensee is always estopped from denying the validity of the patent or the title of his licensor (see p. 205 *et seq.*).

Where there are several defendants, an estoppel may operate against one and not against the others, and in an action against partners, one of the partners by putting in a separate defence may be able to free himself from the effect of the estoppel which prevents his partner from raising the issue of validity (*a*).

Judgment having been recovered against the defendant in an action for infringement, such defendant cannot plead the invalidity of the patent as a defence to a subsequent action brought against him for an infringement of the same patent; he is estopped by the first judgment, and this is so, even though the first judgment was entered by consent (*b*), and the defendant will not even be allowed to raise the question of validity on new grounds (*c*).

But where the defendants in the second action are not the same as those in the first, there will be no estoppel (*d*), though in such a case, if the patent had been previously upheld by a court of co-ordinate or superior jurisdiction, strong additional evidence will be required in order to reverse the previous finding, and the Court will usually hold itself bound by previous decisions in the question of the construction of the patent (*e*).

Similarly if the patent has been held invalid in a previous

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

(*b*) *Thomson v. Moore*, 1889, 6 R. P. C. 426; 7 R. P. C. 325; *Brown v. Hastie & Co., Ltd.*, 1906, 23 R. P. C. at p. 374.

(*c*) *The Shoe Machinery Co. v. Cutlan* (No. 2), 1896, 13 R. P. C. at p. 145.

(*d*) *Goucher v. Clayton*, 1865, 11 Jur. N. S. 107; 34 L. J. Ch. 239; *Otto v. Steel*, 1886, 3 R. P. C. 109,

114.

(*e*) *Otto v. Steel*, 1886, 3 R. P. C. at p. 114; *Slazenger v. Feltham*, 1889, 6 R. P. C. at p. 130; *Automatic Weighing Machine Co. v. Combined Co.*, 1889, 6 R. P. C. 120, 367; *Edison v. Holland*, 1889, 6 R. P. C. 243; *The Shoe Machinery Co. v. Cutlan*, 1896, 13 R. P. C. 143; *The Flour Oxidising Co., Ltd. v. Carr & Co., Ltd.*, 1908, 25 R. P. C. at p. 448.

action it will be a bar to a subsequent action for infringement between the same parties (*f*). But if the ground of invalidity has been removed by amendment of the specification there will be no estoppel (*g*).

“An estoppel must be certain to every intent and not be taken by argument or inference” (*h*), so where a question of infringement was submitted to an arbitrator who in his award found that the letters patent were not illegal or void, in a subsequent action for infringement against the same defendant, it was held that the arbitrator’s award was not such a decision as to make an estoppel within the above-cited rule (*i*).

And in an action against manufacturers who have at an earlier date, under a contract of indemnity, financed the defence of users in actions by the same plaintiffs, the manufacturers will not be precluded from raising the issue of validity (*k*).

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 the paragraph under Order XIX., rule 27 ; the Court of Appeal dismissed the appeal with costs (*l*).

Conditional  
defence.

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 inquiry 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 (*m*).

The defences which are made available by the Act of 1907

Special  
defence

(*f*) *Horrocks v. Stubbs*, 1895, 12 R. P. C. at p. 540.      *facturing Co.*, 1905, 22 R. P. C. at p. 459.

(*g*) *Decley’s Patent*, 1894, 11 R. P. C. at p. 76.      (*l*) *Hocking v. Hocking*, 1886, Griff. P. C. 129 ; 3 R. P. C. 291.

(*h*) Com. Dig. tit. Estoppel (E 4).      (*m*) *United Telephone Co. v.*

(*i*) *Newall v. Elliott*, 1863, 32 L. J. Ex. 120.      *Donohoe*, 1886, L. R. 31 C. D. 399 ; 3 R. P. C. 45.

(*k*) *Gammons v. Singer Manu-*

created by  
Act of 1907.

and numbered 6, 7, 8, and 9 on p. 329, supra, must be specially pleaded in the defence and are not matters to be dealt with in the particulars of objections to validity.

By sect. 25, sub-sect. 2, "*Every ground on which—*

(a) *a patent might, immediately before the first day of January, one thousand eight hundred and eighty four, have been repealed by scire facias ; or*

(b) *a patent may be revoked under this Act either by the Comptroller or as an alternative to the grant of a compulsory licence ;*

*shall be available by way of defence to an action of infringement and shall also be a ground of revocation under this section."*

The defences numbered 6 and 7 are made available by this sub-section and will now be considered.

In Chap. XII. supra, we have seen that the Comptroller may revoke a patent under sect. 26 on any ground on which the grant might have been opposed, *i.e.*, on certain specified grounds of invalidity. As one or more of these grounds may be alleged in support of the defence of invalidity they need not be further considered here.

Patent mainly  
worked  
abroad.

We have also seen (Chap. XII.) that by sect. 27 the Comptroller is empowered to revoke a patent on the ground that the patented article or process is carried on exclusively or mainly outside the United Kingdom. It is therefore possible to allege that the patented article or process is carried on exclusively or mainly outside the United Kingdom as a defence to an action for infringement, and by sect. 32 (see p. 253) the defendant *may* be in a position to counterclaim for revocation on this ground. This is not necessarily so, however.

This defence is only available after the lapse of four years from the date of the patent.

There are no rules in Order LIII<sup>A</sup>. which deal with this defence, but it would appear from the observations of Mr. Justice Parker in *Hatschek's Patent*, 1909, 26 R. P. C. at p. 246, that the onus of proof lies on the person seeking to revoke the patent (and by analogy the same may be said of a defendant) to prove the truth of his allegations. Consequently it would appear just that the defendant should be called upon to deliver



some particulars justifying the plea in order that the plaintiff may know what case he has to meet.

The defence is of course available on appeal to the Court of Appeal and the House of Lords, and raises an issue of fact as between the plaintiff and the defendant only. Consequently a judgment upon this issue will not create an estoppel against or in favour of a person seeking to revoke the patent on this ground, since a petitioner to revoke is in the position of a member of the public (*n*). Moreover, the defence raises an issue of fact as regards a particular date only, consequently a defendant may raise the defence in successive actions on the same patent, just as a petitioner may present petitions under sect. 27 to revoke the same patent from time to time as the circumstances change (*o*).

In Chap. XII., we have seen that, under sect. 24, if the reasonable requirements of the public with respect to the patented invention have not been satisfied, any person interested may present a petition for the grant of a compulsory licence or in the alternative for the revocation of the patent. The petition is referred to the Court.

Wants of  
public  
unsatisfied.

The defence (to an action for infringement) based on this section must be the allegation of some ground which, if true, would have justified the Court in coming to the conclusion that the reasonable requirements of the public would not be satisfied by the granting of licences.

Only a person interested,—not any member of the public, may present a petition under sect. 24, and it would seem that this defence will be available only to such persons as could have been considered interested on a petition, and consequently a judgment obtained on this defence or on a petition under sect. 24 would be conclusive as between the parties with respect to the particular circumstances at any particular date.

It is submitted that the pleading should not be confined to the bare statement that the requirements of the public with respect to the patented invention have not been satisfied, but should set forth the facts, *i.e.*, “the ground” upon which the

(*n*) See pp. 253—254, *supra*.

*Patent*, 1909, 26 R. P. C. at p. 246.

(*o*) See Parker, J., in *Hatschek's*

patent might have been revoked as an alternative to a compulsory licence. The question of the nature of the facts necessary to justify revocation has been discussed in Chap. XII, supra.

Since by sect. 24, sub-sect. 3, it is provided that the patent may not be revoked until after three years from the date of the patent, it follows that the defence is not available until after this period has elapsed.

By sect. 38, sub-sect. 4, of the Act of 1907 it is provided :—

Defence of  
existence of  
contract with  
void condi-  
tions.

*“The insertion by the patentee in a contract made after the passing of this Act of any condition which by virtue of this section is null and void shall be available as a defence to an action for infringement of the patent to which the contract relates brought while that contract is in force.”*

The nature of the conditions made void by sect. 38 has been discussed at p. 211.

It is clear that the words “*by the patentee*” refer to anyone who has owned the patent since it was in force, and it will be no reply to this defence for the owner of the patent to say that the objectionable contract was made by a previous owner of the patent.

By rule 10 of Order LIIIA. it is provided that a defendant relying on this defence must deliver with his defence full particulars of the contract and condition on which he relies.

It is not anticipated that many cases will arise on this defence, as the public are by now fully aware of the restrictions placed upon the insertion of conditions, and moreover before bringing an action, if such a contract existed, the patentee could take steps to relieve the other party from the objectionable conditions.

Defence as to  
damages;  
ignorance of  
patent.

By sect. 33 it is provided that a patentee shall not be entitled to recover damages from a defendant who proves that he was not aware of the patent, and had no reasonable means of making himself aware of it.

This section is discussed further on in this chapter. From the point of view of the pleader it is submitted that he should merely state that “at the date of the infringement alleged, he was not aware, nor had reasonable means of making himself

aware, of the patent." The onus of proof is expressly laid upon the shoulders of the defendant.

**Particulars of Objections.**—If the defendant in an action for infringement, or the petitioner in a petition for revocation pleads the invalidity of the patent he must deliver with his defence particulars of the objections upon which he intends to rely. The requirements as to the specific nature of such particulars have grown more and more stringent since the Act 5 & 6 Will. IV. c. 83, s. 3, which required that "in any action brought against any person for infringing any letters patent, the defendant, on pleading thereto, shall give to the plaintiff a notice of any objections on which he means to rely at the trial of such action." The Act of 1883 required particulars of the objections, which implies considerably more than a mere notice.

Sect. 29, sub-sect. (2), of that Act provided:—"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."

The statutory requirement is now replaced by rules 14, 15, 17, 18, 19, 20 and 21 of Order LIIIA. Rule 17 is as follows:—"Particulars of objections (whether delivered with the defence in an action for infringement of patent or with a petition for revocation under sect. 25 of the Act or with a counterclaim for revocation under sect. 32 of the Act) must state every ground upon which the validity of the patent is disputed and must give such particulars as will clearly define every issue which it is intended to raise."

By rule 21, "At the hearing of any action, petition, or counter-

*claim relating to a patent, no evidence shall, except by leave of the Court (to be given upon such terms as to the Court may seem just) be admitted in proof of any alleged infringement or objection not raised in the particulars of breaches or objections respectively."*

Every objection must be pleaded.

Apart from granting leave to amend the particulars, the Court will not allow an objection to be taken to the validity of the patent unless that objection has been pleaded, even though the objection should become clear in the evidence at the trial. In the case of the *Alsop Flour Process, Ltd. v. Flour Oxidising Co. Ltd.* the particulars of objections alleged that the patent was invalid on the grounds of want of novelty, want of utility, and insufficiency of the specification. Paragraph 3 of the particulars was as follows: "The alleged invention was not the subject-matter for valid letters patent, inasmuch as the action of gaseous oxidising agents, prepared in any of the matters described in the specification, on flour and the like was well known at the date of the patent." At the trial want of subject-matter was urged by counsel for the defendants upon a particular construction of the claim, apart from anticipation. Lord Loreburn, L.C., dealing with this argument, said (1908, 25 R. P. C. at p. 490), "He (defendant's counsel) also urged that if the claim were for all oxidising agents in the gaseous or vapourised state, except ozone, there was no proper subject-matter. I will not enter upon these points, because they were not raised either in the particulars, or in the Court of Appeal, or in the printed case of the appellants in this House. Patentees are entitled to protection against objections made without notice or opportunity of refuting them by evidence, and it is possible the respondents here would have desired to give evidence, had they been so challenged (*p*).

In other than infringement actions or petitions.

Particulars of objections have always been ordered, when the validity of a patent has been put in issue. When it was a condition precedent to an agreement to assign letters patent, that the assignee should first satisfy himself as to the validity of the patent, in an action brought for specific performance of this

(*p*) See also judgment of Fletcher Moulton, L.J., in *British United Shoe Machinery Co., Ltd. v. A. Fussell & Sons*, 1908, 25 R. P. C. at p. 659.

agreement, and resisted by the assignee on the ground of his right under the condition precedent, it was held that the validity of the patent was at issue and that the plaintiff was entitled to particulars of objections (*q*).

It is not necessary for every one of two or more defendants defending in the same interest to deliver particulars of objections (*r*).

Any of the objections which we have discussed in previous chapters may be taken in order to upset a patent, but the particulars must set out those objections in such terms that the plaintiff may be informed what case he will have to meet at the trial of the action.

If it be pleaded that the patentee was not the true and first inventor it is submitted that particulars must be delivered stating the name of the person whom the defendant alleges to have been the true and first inventor. The case of *Russell v. Ledlam* (1843, 11 M. & W. 647), which has been referred to in various text-books as an authority to the contrary, was decided upon the construction of the Act 5 & 6 Will. IV. c. 83, s. 3, and is now obsolete. Moreover, it is to be remembered, as was pointed at p. 20, ante, the issue raised by this plea is not one of novelty, but a specific ground of attack in itself.

True and first inventor.

The most common ground of objection to the validity of a patent is want of novelty either on account of prior publication in some document or prior public user of the invention. By rule 18 of Order LIIIA., "*If one of the objections taken in the particulars of objections be want of novelty, the particulars must state the time and place of the previous publication or user alleged, and if it be alleged that the invention has been used prior to the date of the patent, must also specify the names of the persons or person who are alleged to have made such prior user and whether such prior user is alleged to have continued down to the date of the patent, and if not, the earliest and latest dates on which such prior user is alleged to have taken place, and shall also contain a description (accompanied by drawings if necessary) sufficient to identify such alleged prior user, and if such user*

Want of novelty.  
Rule 18.

(*q*) *Hazlehurst v. Rylands*, 1892, 9 R. P. C. 1.

(*r*) *Smith v. Cropper*, 1885, 10 A. C. 249.

*relates to any machinery or apparatus shall specify whether the same is in existence and where the same can be inspected."*

*"No evidence at variance with any statement contained in the particulars shall be given in support of any objection, and no evidence as to any machinery or apparatus which is alleged to have been used prior to the date of the patent and which is in existence at the date of the delivery of the particulars shall be receivable unless it be proved that the party relying on such prior user has, if such machinery or apparatus be in his own possession, offered inspection of the same, or if not in his own possession, has used his best endeavours to obtain inspection of the same for the other parties to the proceedings."*

If this rule be compared with paragraph 2 of sect. 29, sub-sect. 2, of the Act of 1883, it will be seen that the requirement for particulars has become far more strict than was formerly the case. It has been decided by Parker, J. (s), that in the case of a prior user alleged to be in existence at the date of the particulars the defendants were not bound to deliver a description and drawings provided they obtained inspection of the articles for the plaintiffs, for in that case the plaintiffs might themselves make the required drawings.

Some difficulty is occasioned by the words "sufficient to identify." Do they mean that the particulars must be such as to enable the plaintiff to know precisely the nature of the prior user alleged, or would it be sufficient to say that an article kept in some specific safe in a safe deposit and no other was relied on? In the case of an article the requirement for drawings to be delivered might supply the solution of the difficulty, but in the case of a process the answer is not so easy (t).

We submit that the defendant should be forced to disclose in his particulars all the information in his possession concerning the prior user which he proposes to prove in Court, and that no useful purpose is served by allowing him to conceal the true nature thereof until the trial. Unfortu-

(s) *The Crossthwaite Fire Bar Syndicate v. Senior*, 1909, 26 R. P. C. 260.

(t) See judgment of C. A. in *Minerals Separation Ltd. v. Ore Concentration Co. Ltd.*, April 2nd, 1909.

nately the words "sufficient to identify" are precisely the words used in the judgment of Fletcher Moulton, L.J., in *Brown's Patent* (1906, 23 R. P. C. 792) before Order LIIIA. came into force. The learned Lord Justice held that the purpose of particulars under the old practice was not to describe the prior user to the plaintiff or to inform him of its nature, but merely to identify the article in question. We are not concerned with the question of whether this judgment was taken into account in framing the rules, but if the words of the rules bear the same meaning as those in the judgment there is some danger that a manifest and ridiculous injustice will be perpetuated.

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 be given such details of the books or newspapers as will enable them to be found and identified by the plaintiff.

Whether or not a defendant will be required to give particulars of lines and pages of the specifications upon which he relies in his objections or to point out specifically what part or parts of the plaintiff's specification he alleges to be affected thereby will depend upon the circumstances of the case and the nature of those specifications (*u*); where it appeared that the defendant had, figuratively speaking, "thrown at the head" of the plaintiff a large number of complicated specifications without any attempt at discrimination, further particulars were required (*x*), but if the defendant bonâ fide relies upon the whole of a specification, or any number of specifications in reason, and the subject-matter is simple, his particulars of objections will not be interfered with (*y*).

In *Nettlefolds v. Reynolds* (1891, 8 R. P. C. at p. 417),

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

(*x*) *Holliday v. Heppenstall*, 1889, 6 R. P. C. 320; *Sidebottom v. Fielden*, 1891, 8 R. P. C. at p. 270; *Heathfield v. Greenway*, 1894, 11

R. P. C. 17.

(*y*) *Siemens v. Karo*, 1891, 8 R. P. C. 376; *Nettlefolds v. Reynolds*, 1891, 8 R. P. C. 410; *Edison-Bell Phonograph Co. v. Columbia Phonograph Co.*, 1901, 18 R. P. C. 4.

Lindley, L.J., said: "It appears to me, therefore, that the moment the learned judge came to the conclusion, as he did in fact, that the defendant here had honestly done his best to give to the plaintiff that information that he is entitled to, unless the Court came to the conclusion that there was some grievous or some obvious mistake, he ought to be satisfied with that, and not to say, 'I shall order further particulars, because I know from experience that if you say you rely on the whole of the specification, when you come into Court nine-tenths will not be referred to.' If the defendant is to be bound hand and foot to a particular page, and to a particular line, it will be perfectly impossible for him to defend his case, or to impeach the patent to the extent and in the manner in which he is entitled to do it."

In *Plimpton v. Spiller* (1876, 20 Solrs. Journal, 863), 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.

Want of Subject-matter.

The objection that the invention is not proper subject-matter in view of the common knowledge of the time when it was patented is a distinct allegation, and should be specifically pleaded (z).

Common knowledge.

Objections on the ground of common knowledge must be carefully distinguished from objections on the ground of prior publication; in the latter case every book or document must be particularised, as no instance of anticipation can be adduced

(z) *Holliday v. Heppenstall*, 1889, 6 R. P. C. at p. 328; *Phillips v. The Ivel Cycle Co.*, 1890, 7 R. P. C. at p. 82.



at the trial of which particulars have not been delivered; but when the objection to a patent is based upon common knowledge, no particular instances need be referred to, as this objection can only be proved by the examination of witnesses and references to well-known standard works upon the subject (*a*). But specifications may not be used as evidence of common knowledge unless they have been referred to in the particulars of objections, either under the plea of anticipation or specifically under the objection at present under consideration (*b*).

It is important to remember that the contents of specifications are not necessarily common knowledge, but may be shown to be part of the common knowledge (*c*). It is for this reason that attempts to show that a newly patented combination is not good subject-matter, because the elements have been described in prior specifications in different combinations, usually fails (*d*).

The usual practice is to state in the particulars whether the specifications cited are referred to as anticipations or as part of the common knowledge.

Particulars are not required of the allegation that "the patented invention is not useful."

Want of utility.

The allegation that the specification is insufficient must be supported by particulars which indicate the alleged defect, and where a workman would meet with difficulty in carrying out the directions given (*e*). In *Heathfield v. Greenway* (1894, 11 R. P. C. 17), the following objections, viz.: "That the specification does not sufficiently describe and ascertain the

Insufficiency of specification.

(*a*) *Holliday v. Heppenstall*, supra; *English and American Machinery Co. v. Union Boot Co.*, 1894, 11 R. P. C. at p. 374.

(*b*) *The Salvo Laundry Co. v. Mackie*, 1893, 10 R. P. C. 68; *English and American Machinery Co. v. Union Boot Co.*, 1894, 11 R. P. C. 367; *Castner-Kellner Alkali Co. v. Commercial Development Co.*, 1899, 16 R. P. C. at p. 276; *Sutcliffe v. Abbott*, 1903, 20 R. P. C. at p. 55.

(*c*) *Salvo Laundry Supply Co. v. Mackie*, 1893, 10 R. P. C. at p. 70; *Holliday v. Heppenstall*, 1889, 6 R. P. C. 326.

(*d*) See, e.g., *British United Shoe Machinery Co. v. A. Fussell & Sons, Ltd.*, 1908, 25 R. P. C. 631.

(*e*) *Crompton v. Anglo-American Brush Corpn.*, 1887, 4 R. P. C. 197; *Heathfield v. Greenway*, 1894, 11 R. P. C. 17; *Dege's Patent*, 1895, 12 R. P. C. 448.

*V. de ...*  
29/11/12

nature of the invention, and the manner in which the same is to be performed;" and, "That the said specification is ambiguous and framed in a manner calculated to mislead;" were held to be too vague. A very typical and instructive instance of such an objection, where better particulars were ordered of the insufficiency, is to be found in *Dege's Patent* (1895, 12 R. P. C. 447).

Specification does not define invention.

The objection that the specification does not define the limits of the invention claimed is sufficient and does not require to be further particularised (*f*). But as to the substantiality of this defence see the judgment of Fletcher Moulton, L.J., in *British United Shoe Machinery Co., Ltd. v. A. Fussell & Sons, Ltd.* (1908, 25 R. P. C. 631).

Disconformity.

When the objection is on the ground of disconformity between the provisional and complete specification, the defendant ought to give such particulars as would inform the plaintiffs of the nature and scope of the alleged differences. 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 (*g*). On account of sect. 42 of the Act of 1907 (see p. 100, ante), it is not sufficient to show that there is disconformity between the provisional and the complete specifications,—the objector must show that the excess in the complete specification was not novel at the date of the complete specification, and consequently it would seem that he should be obliged to specify the manner in which that matter had been published, as in the case of an objection to the patent on the ground of want of novelty at the date of the patent.

Fraud.

Order XIX. rule 6, of the Rules of the Supreme Court, 1883, 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

(*f*) *British Ore Concentration, Ltd. v. Minerals Separation, Ltd.*, 1907, 24 R. P. C. 790.

(*g*) *Anglo-American Brush Corp'n. v. Crompton*, 1886, L. R. 34 C. D. 152.

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.”

Such an allegation of fraud might be involved where the plaintiff is alleged to have stolen the invention from someone else, or that he had obtained the patent by bribery.

By rule 21 of Order LIIIA. “*At the hearing of any action, petition or counterclaim relating to a patent, no evidence shall, except by leave of the Court (to be given upon such terms as to the Court may seem just) be admitted in proof of any alleged infringement or objection not raised in the particulars of breaches or objections respectively.*”

Particulars  
limit  
evidence.

Apart from rule 19, which will be considered presently, the Court has always possessed the power to allow the evidence to go beyond the matters set forth in the particulars of objections. In *Britain v. Hirsch* (1887, 5 R. P. C. at p. 231) Cotton, L.J., said: “In my opinion, under the present Act of Parliament (1883) it is within the discretion of a judge who hears evidence in a patent case to allow evidence to go beyond the particulars actually delivered. Sub-sect. 4 of sect. 29 provides ‘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.’ But that is different from amending the particulars, because the very next sub-section is ‘Particulars delivered may be from time to time amended, by leave of the Court or a judge,’ as something different from the discretion which is left to the judge, under the previous sub-section, and I think it is very right that that discretion should be given, so that the judge at the trial of a patent action should not be fettered or hampered in any way, which would prevent the real facts of the case being laid before the Court and justice being done between the parties.”

But Court  
may allow  
further  
evidence.

Evidence will be admitted at the trial, provided the language

of the particulars of objections is large enough to admit it; since 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.

In *Sugg v. Silber* (1876, L. R. 2 Q. B. D. at p. 495), Mellish, L.J., said: "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."

Amendment  
of particulars.

By rule 19, "*Particulars of breaches, and particulars of objections may from time to time be amended by leave of the Court upon such terms as may be just.*"

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 terms.

Whether the application to amend be made before or at the trial the terms should be such that the plaintiff is 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; and the defendant should be put under such terms as to costs as to the judge or Court may seem just. The particulars of objections give notice to the plaintiff of the case which is to be made against him; and he should be able to discontinue or not, as he pleases,

paying the 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.

The form of order for leave to amend before trial which has been consistently followed is that which was made in *Baird v. Moule's Patent Earth Closet Co.* set out in the report of *Edison Telephone Co. v. India Rubber Co.* (1881, 17 C. D. 137) (h).

Where the application to amend is made at the trial such leave will only be granted if the new evidence has only been recently discovered, and could not with reasonable diligence have been discovered before (i).

In *The Shrewsbury and Talbot Co. v. Morgan* (1896, 13 R. P. C. 75), Romer, J., refused leave to amend by adding an allegation of disconformity between the title and the claims after the question of infringement had been decided against the defendants.

In *Badische Anilin und Soda Fabrik v. La Société Chimique* (1897, 14 R. P. C. at p. 881) it became clear during the course of the trial that the specification of the patent sued upon was insufficient, and the defendants applied to Romer, J., who was trying the case, for leave to amend the particulars by inserting an objection on this ground. Leave was granted to amend, the plaintiffs having a fortnight to elect whether they would continue the action, the terms upon which such leave should be granted being left for argument until the plaintiffs had elected. On the hearing the plaintiffs elected to continue, and the patent was declared invalid as a result of the new objection, but all costs of and occasioned by the application to amend, and all costs thrown away by reason of the amendment being made so late, were given to the plaintiff (k).

In *Westley, Richards & Co. v. Parkes* (1893, 10 R. P. C. at p. 186), the Court allowed the defendants to amend at the

(h) See also *Ehrlich v. Ihlee*, 375. 1887, 4 R. P. C. 115; *Wilson v. Wilson*, 1899, 16 R. P. C. 315.

(i) Per North, J., in *Moss v. Malings*, 1886, 3 R. P. C. at p. 207; *Allen v. Horton*, 1893, 10 R. P. C. 412.

(k) See also *Parker v. Maignen's Filtre Rapide Co.*, 1888, 5 R. P. C.

trial by adding an allegation that the patented invention lacked subject-matter.

In *Pirrie v. York Street Spinning Co.* (1894, 11 R. P. C. at p. 431), leave to amend the particulars of objections was granted by the Court of Appeal in Ireland pending appeal.

The terms on which amendment will be allowed are a matter for the discretion of the Court, and it is of little use to appeal (*l*).

In *The Shoe Machinery Co. v. Cutlan* (1896, 1 Ch. 108), the Court of Appeal decided that they had jurisdiction to amend the particulars of objections although in that particular case they declined to do so.

### III. INTERLOCUTORY INJUNCTION.

Interlocutory  
injunction,  
when  
granted.

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, where there is a presumption that the patent is valid, when he can clearly establish his title and the commission of the act which he declares to be an infringement, and where there is a strong *prima facie* case that that act is an infringement of the patent (*a*); and the Court will usually require the plaintiff to give a satisfactory undertaking that he will pay any damage that the defendant may suffer in the event of the latter being successful at the trial (*b*).

Notice of  
motion.

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

By sect. 25 of the Judicature Act, 1871, 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

(*l*) *Wilson v. Wilson*, 1899, 16 R. P. C. 315. 1856, 2 Jur. N. S. 1041.

(*b*) See p. 351, *infra*.

(*a*) See *Gardner v. Broadbent*,

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.

Order 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 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 *primâ facie* reasons for acting on the supposition that the patent is valid.

Must be  
“*primâ facie*”  
evidence of  
validity.

Lord Eldon, in the case of the *Universities of Oxford and Cambridge v. Richardson* (1802, 6 Ves. 706), 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* (1856, 2 Jur. N. S. 1041), 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*."

Established  
in former  
trial.

Long posses-  
sion.

There having been a trial as to the validity of the patent, which has terminated in favour of the patentee, will be considered by the Court sufficient reason for granting an interlocutory injunction; and where the patentee has worked and enjoyed the patent for many years without dispute, an interlocutory injunction will be granted (c); so also 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 *Dudgeon v. Thompson* (1874, 30 L. T. N. S. 244), 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* (1857, 3 Jur. N. S. 358), 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

(c) *Dudgeon v. Thompson*, 1874, 30 L. T. N. S. 244; *Muntz v. Foster*, 1843, 2 W. P. C. at p. 95; *Rothwell v. King*, 1886, 3 R. P. C. 379; *Hayward v. Pavement Light Co.*, 1884, Griff. P. C. 124.

(d) *Dircks v. Mellor*, 1845, 26 Lon. Journ. 268.

(e) *Dudgeon v. Thompson*, 1874, 30 L. T. N. S. 244; *Clarke v. Fergusson*, 1859, 1 Giff. 184.



protect his rights until trial, even although his rights under his patent be doubtful.”

What amount's to long enjoyment is difficult to define, but decided cases would appear to suggest that undisturbed enjoyment for six years would be sufficient (*f*); but the user of the invention during that time must be active. The mere possession of a patent for a long period does not of itself give rise to a presumption of its validity (*g*).

Mere possession insufficient.

An interlocutory injunction is seldom granted in the case of a new patent (*h*), unless very strong evidence in support of the motion be adduced.

Seldom granted for new patent.

In *Clarke v. Nichols* (1895, 12 R. P. C. 310) the patent was less than a year old. Notice of motion was served with the writ, but the defendant did not appear. The affidavit by the plaintiff stated that prior to the purchase of the patent he had caused a full investigation to be made into its validity by his patent agents, and that he was advised that it was valid, and to the best of his knowledge, information and belief, it was valid now. The injunction was granted.

In *Holophane, Ltd. v. Berend & Co.* (1898, 15 R. P. C. at p. 19), Kekewich, J., said: “During the forty years over which my experience extends, and I think for a considerably longer period, the Court has acted on one uniform rule, subject, of course, to exceptions, in dealing with applications of this character. The rule, as I understand, is this: that where the proprietor of recently granted letters patent, the validity of which has not been established by legal process, seeks an injunction against an alleged infringer, the Court declines to interfere by interlocutory injunction and leaves the patentee to establish the validity by formal proceedings. Of course, forty years ago, the motion for injunction had to stand over while the validity of the patent was established at law. Fortunately we have got rid of that, and the injunction and the validity

(*f*) *Bickford v. Skewes*, 1837, 1 Web. P. C. 211; *Rothwell v. King*, 1886, 3 R. P. C. 379.

(*g*) *Plimpton v. Malcolmson*, 1875, 44 L. J. Ch. 257; L. R. 20 Eq. 37.

(*h*) *Cladwell v. Vanvlissengen*,

1851, 9 Hare, 415, 424; *Renard v. Levinstein*, 1864, 10 L. T. N. S. 177; *Lister v. Norton*, 1884, 1 R. P. C. 114; *Jackson v. Needle*, 1884, 1 R. P. C. 174; *British Tanning Co. v. Groth*, 1890, 7 R. P. C. 1.

can all be determined and disposed of in one and the same action in one and the same Court; but the rule holds still. Of course, there are exceptions; it will not do for a defendant coming here as against the proprietors of letters patent simply to say, 'I challenge the validity.' There must be something more than that. The Court must be satisfied that there is an honest intention of trying the question; and not only an honest intention of trying the question, but that there is something to be tried."

If a certificate of validity has been granted in a previous action, it will not avail the defendant on an application for an interlocutory injunction to allege fresh grounds for invalidity (i).

Delay will  
bar right.

An interlocutory injunction will not be granted in cases where the plaintiff is guilty of delay.

In *The North British Rubber Co. v. The Gormully and Jeffery Co.* (1895, 12 R. P. C. at p. 20), Chitty, J., said: "Now I am not aware, having regard to patents, that there is any substantial ground of distinction between an interlocutory injunction upon a patent right and upon any other. The principles appear to me to be substantially the same; and the general rule of the Court is that a person who comes to ask for that remedy, which is granted with despatch and for the purpose of protecting rights until the trial, should come promptly" (k).

The amount of delay which will prevent the granting of an interlocutory injunction will, of course, vary with the nature of the patent and the circumstances of the trade.

Unless  
explained.

The delay may, in some cases, be satisfactorily explained, and will not therefore be fatal, as in a case where the plaintiffs' solicitors advised them not to commence an action until the defendants appeared to be in a condition of sufficient financial soundness to undertake manufacture of the infringing articles (l).

Delay in proceeding against persons who are not parties to

(i) *Heine, Solly & Co. v. Norden*, 1898, 15 R. P. C. 32; *Gillette Safety Razor Co. v. A. W. Gamage, Ltd.*, 1904, 21 R. P. C. 513.

(k) See also *Bovill v. Crate*, 1866, L. R. 1 Eq. 388; *Greer v. Bristol Tanning Co.*, 1885, 2 R. P. C. 268; *The Aluminium Co. v. Domeiere*, 1907, 24 R. P. C. at p. 3.

(l) *United Telephone Co. v. Equitable Telephone Co.*, 1888, 5 R. P. C. 233.

the application in question is no ground for refusing an injunction, if there has been no delay in proceeding against the defendant (*m*).

A common course is for the Court to order the motion to stand until the trial of the action on the condition that the defendant undertakes to keep an account of all articles made and sold by him, but in some cases the plaintiff may be justified in persisting in his application, and the Court may make the injunction notwithstanding that the defendant offers to keep such an account (*n*). 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, and the plaintiff will usually be required to give an undertaking to pay any damages occasioned by the injunction if it should appear subsequently that the defendant was in the right (*o*). And the discontinuance of the action will not prevent the undertaking being enforced (*p*).

Usual course on application.

Undertaking to keep account.

In *Plimpton v. Spiller* (1876, L. R. 4 C. D. 289), 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 is 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 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

(*m*) *The Pneumatic Tyre Co. v. Warrilow*, 1896, 13 R. P. C. 284. L. R. 7 C. D. 490 (undertaking enforced).

(*n*) *Plimpton v. Spiller*, 1876, L. R. 4 C. D. 286.

(*p*) *New Comen v. Coulson*, 1878, L. R. 7 C. D. 764.

(*o*) See *Graham v. Campbell*, 1878,

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 Master of the Rolls, Sir W. B. Brett, said (*q*): "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."

Although the Court is naturally disposed to avoid granting an injunction and to induce the defendant to keep an account, yet if he should refuse to keep an account the Court will not be the more disposed to grant the injunction, the application for which must be heard on its merits (*r*).

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 (*s*). 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 (*t*). If the plaintiff is an assignee, he must swear

(*q*) At p. 292.

(*r*) See e.g., *The British Tanning Co., Ltd. v. Groth*, 1889, 7 R. P. C. 1.

(*s*) *Hill v. Thompson*, 1817, 1 W. P. C. at p. 231; 3 Mer. 624.

(*t*) *Hill v. Thompson*, 1817, 1 W.

P. C. at p. 321; 3 Mer. 624; *Sturtz v. De la Rue*, 1828 (per Lord Lyndhurst), 5 Russ. 329; *Whitton v. Jennings*, 1860, 1 Dr. & S. 110; *Clarke v. Nichols*, 1895, 12 R. P. C. 310.

to the best of his belief (*u*). 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 (*x*). Affidavits on "information and belief" must state the sources of the information (*y*). 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 (*z*).

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

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

#### IV. DISCOVERY.

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

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

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.

The plaintiff may interrogate the defendant as to the act of infringement complained of; but where the defendant is asked concerning the customers whom he has supplied, it becomes material to ascertain from the pleadings whether the acts

Interrogatories.

Directed to infringement issue.

(*u*) *Gardner v. Broadbent*, 1856, 2 Jur. N. S. 1041.

(*x*) *Hill v. Thompson*, 1817, 3 Mer. 624.

(*y*) *The Saccharin Corporation v. Chemicals Co.*, 1898, 15 R. P. C. 55;

*Budische Anilin und Soda Fabrik v. W. G. Thompson*, 1902, 19 R. P. C.

502.

(*z*) *Stocking v. Llewellyn*, 1842, 3

L. T. 33.

complained of are admitted. If the act complained of be not admitted, the defendant may be asked whether he has not supplied a certain definite article to anybody, and to whom—since by this means an admission, not necessarily of infringement but of the act complained of, may be obtained. But if the act complained of be admitted, an inquiry as to the persons supplied only becomes relevant on the issue of damages and should be postponed until the inquiry. This principle was clearly stated by Chitty, J., in *Lister v. Norton* (1885, 2 R. P. C. 69 (a)).

*Crossley v. Tomey* (1876, L. R. 2 Ch. D. 533) 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. 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.

As to persons  
who supplied  
defendant.

An inquiry as to the names of persons who supplied a defendant who is merely a vendor will usually be inadmissible, since it is not relevant to any issue between the parties. But where the vendors sold a chemical product, which the plaintiffs had good reason to believe was manufactured in infringement of one of their patents for processes, the Court of Appeal allowed the interrogatory on the ground that the answers would probably enable the plaintiffs to ascertain whether the article were an infringement or not (b).

Framed on  
plaintiff's  
specification.

In *Benno Jaffé v. Richardson* (1893, 10 R. P. C. 136), the plaintiff administered interrogatories to the defendant, framing them upon the statements in his specification, which he

(a) And see *Tetley v. Easton* C. D. 184; *Raves v. Chance*, 1890, 7 R. P. C. 275.  
1856, 18 C. B. 643; *De la Rue v. Dickinson*, 1857, 3 K. & J. 388; (b) *Saccharin Corp'n. v. Haines*,  
*Leu v. Sarby*, 1875, 32 L. T. N. S. 1898, 15 R. P. C. 344.  
731; *Fennessy v. Clark*, 1887, 37

alleged that the defendant had infringed, and asked the defendant if he had used the processes described in the specification, taking them step by step. Some of these interrogatories the defendant refused to answer, on the ground that they were not relevant until the patent was established. It was held by North, J., that the plaintiff was entitled to further answers.

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 (c).

Where defendant's process is secret.

“The mere plea of secret process is not sufficient to defeat discovery, but, on the other hand, interrogatories must not be made the means of unfair treatment of a man who is fighting fairly” (d).

The use of interrogatories after judgment on an enquiry as to damages (e), or on the taking of an account of profits (f), will be dealt with later.

The fact that the defendant's particulars of objections are sufficient will not necessarily preclude the plaintiff from obtaining more detailed information by administering interrogatories. In *Birch v. Mather* (1883, L. R. 22 Ch. D. at p. 631), Chitty, J., said: “The right to interrogate is conferred by the general orders, and I cannot say as a matter of principle that it can be laid down that the plaintiff is not entitled to interrogate the defendant, and vice versâ, with reference to these matters which may be covered by the particulars. I hold, therefore, on the general question, that there is a right to deliver interrogatories, and provided the interrogatories are properly worded, interrogatories with reference to these very matters which ought to be covered by the particulars” (g).

Particulars will not excuse interrogatories.

In *Delta Metal Co., Ltd. v. Maxim Nordenfelt, Ltd.* (1891, 8 R. P. C. 169), the defendants had pleaded prior user; the

As to prior user.

(c) *Renard v. Levinstein*, 1864, 3 N. R. 665; 10 L. T., N. S. 94.

(d) Per Kekewich, J., in *Ashworth v. Roberts*, 1890, 7 R. P. C. at p. 455.

(e) See p. 377.

(f) See p. 379.

(g) *Alliance Pure Whitelead Syndicate v. MacIvor's Patents*, 1891, 8 R. P. C. at p. 322; *General Electric Co. v. Safety Light and Elevator Co.*, 1904, 21 R. P. C. 109.

plaintiffs proposed to interrogate by asking whether the alleged prior user was in respect of a particular process, specifying it. The defendants answered that the prior user was substantially the process as described in the plaintiffs' specification. It was held that this was a sufficient answer.

The delivery of particulars does not prevent the plaintiff being entitled to interrogate as to the names and addresses of the persons by whom the defendant alleges the invention was used prior to the date of the plaintiff's patent, also as to the places where such prior user occurred (*h*).

Documents  
relating to  
prior user.

In *Carnegie Steel Co. v. Bell Bros., Ltd.* (1907, 24 R. P. C. 82), the defendants objected to allow inspection of certain documents referred to in their affidavit of documents, which documents, they said, referred solely to certain prior users alleged in their particulars of objections. It was held that the documents were privileged, and Buckley, L.J., said (at p. 92), "Particulars of prior user must be given; evidence of prior user need not be given; and it does not follow that every document relating to prior user is a particular of prior user; it may be something which may assist the defendant to prove the prior user, but that he is not bound to produce. I am not aware of any principle which in a patent action any more than any other action compels the defendant to produce documents of that description." Needless to say, however, all documents that are relevant must be included in the affidavit of documents whether privileged or not (*i*). The same rules apply to a petition for revocation under sect. 25 (*k*).

Interrogatories for the examination of a plaintiff are on a different footing from those for the examination of a defendant in this respect, that a plaintiff is not entitled to discovery of the defendant's case, but a defendant may ask any questions tending to destroy the plaintiff's case (*l*).

(*h*) *Crossley v. Tomey*, 1876, L. R. 2 Ch. D. 533; *Birch v. Mather*, 1883, L. R. 22 Ch. D. 629; *Alliance Pure Whitelead Syndicate v. MacIvor's Patents*, 1891, 8 R. P. C. 321; *General Electric Co. v. Safety Light and Elevator Co.*, 1904, 21 R. P. C. 108.

(*i*) *Carnegie Steel Co. Ltd. v. Bell Bros. Ltd.*, 1907, 24 R. P. C. at p. 93.

(*k*) *Haddan's Patent*, 1884, 54 L. J. Ch. 126.

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



Communications between a man and his patent agent are not privileged, consequently, where the plaintiff's patent agent also acted as his solicitor, he was ordered to answer interrogatories with reference to documents which passed between them at the time the specification was prepared, such communications having taken place in the relationship of patent agent, and not of solicitor, and client (*m*).

Communica-  
tions with  
patent agent  
not  
privileged.

In the same case interrogatories which sought to compel the plaintiff to particularise the alleged breaches by stating what parts of the plaintiff's speculation were infringed by the defendants (the defendants having in answers to interrogatories disclosed what they had done) were disallowed on the ground that the defendants could for themselves compare the plaintiff's specification with what they admitted they had done.

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 (*n*).

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 (*o*).

The plaintiff was also required 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

(*m*) *Moseley v. Victoria Rubber Co.*, 1886, 3 R. P. C. 351.  
 (*n*) *Hoffman v. Posthill*, L. R. 4

Ch. 673.

(*o*) Ibid.

(*p*) Ibid.

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* (1865, 2 H. & M. 725), 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 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 with 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 his power" (q).

In *Rylands v. Ashley's Patent Bottle Co.* (1890, 7 R. P. C. 175) the defendant pleaded that the invention patented was not useful, and administered an interrogatory asking whether it had not been found necessary to use some and what modifications in the process described in the specification. The Court of Appeal allowed this interrogatory.

As in other cases discovery of documents will not be ordered until after the delivery of the defence (r).

The rules generally applicable with reference to discovery of documents apply to patent cases.

(q) *C.f.* the judgment of Kay, J., in *Bidder v. Bridges*, 1885, L. R. 29 C. D. 34.

(r) See *Woolfe v. Automatic Picture Gallery Co.*, 1902, 19 R. P. C. 161.

## V. INSPECTION.

Sect. 34 of the Act of 1907 (sect. 30 of the Act of 1883), **Inspection.** provides: "In an action for infringement of a patent, the Court 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 may see fit."

The power to order an inspection was always assumed by the Courts; in *Borill v. Moore* (1815, 2 Coop. Ch. Ca. Temp. Cottenham 56, n.) 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 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 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 right to inspection is a right to be given at the discretion of the Court—to be exercised with a judicial discretion and with due regard to the interests of the partes concerned in the litigation" (a).

The object which the Court had in view in all cases where

(a) Per Bristowe, V.-C. in *McDougall v. Partington*, 1890, 7 R. P. C. at p. 357.

See Osram v. ...  
...  
... 30

B.F. v. ...  
xxxvii R.P.C. 121

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.

**Primâ facie case of infringement necessary. May be limited to scientific witnesses.**

The Court requires, before granting an order for inspection, that a *primâ facie* case of infringement (b) shall be made out.

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 do not affect the question of infringement. In *Flower v. Lloyd* (1876, W. N. 169, 230) and *Swan v. Edlin-Sinclair Tyre Co.* (1903, 20 R. P. C. 435) the Court strictly limited the inspection to scientific men, and excluded the plaintiff from being present.

In *Pigott v. The Anglo-American Telegraph Co.* (1868, 19 L. T. N. S. 46) 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 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. Kynoch* (1874, L. R. 19 at p. Eq. 92) 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

(b) *Bovill v. Moore*, supra; *The Singer Sewing Machine Co. v. Wilson*, 1865, 12 L. T. N. S. 140; *Shaw v. The Bank of England*, 1852, 22 L. J. Ex. 26; *Batley v. Kynoch*, 1874, L. R. 19 Eq. 90; *Germ Milling Co. v. Robinson*, 1884, 55 L. J. Ch. 287; 1 R. P. C. 217; *Cheetham v. Oldham*, 1888, 5 R. P. C. 617.

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."

In *Drake v. Muntz Metal Co.* (1886, 3 R. P. C. 43), 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 the date of the 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* (1860, 8 W. R. 353) (c), 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.

Taking of  
samples for  
analysis.

In that case it was also held that laches sufficient to defeat the plaintiff's right to an interlocutory injunction was no bar to an order on the same motion for inspection.

In *Webb v. Kynoch & Co. Ltd.* (1898, 15 R. P. C. at

(c) See also *Germ Milling Co. v. Robinson*, 1886, 3 R. P. C. 11.

p. 273) inspection was ordered of the defendants' works as one of the conditions for the refusal to grant an interlocutory injunction.

**Mutual  
inspection.**

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 (*d*).

**Patent Office  
samples.**

It is submitted that the Court could order the production of the samples which a patentee of a chemical invention is obliged to deposit at the Patent Office under sect. 2, sub-sect. 5, of the Act of 1907 (see p. 147, ante).

Whether the plaintiff will be entitled to see the alleged infringing machine at work or not will depend upon the circumstances of the case (*e*).

In a case where the defendant delivered to the plaintiff specimens of the alleged infringing articles, the latter was not allowed to see those articles in actual use on the defendant's premises (*f*).

In *McDougall v. Partington* (1890, 7 R. P. C. 351, 472) the plaintiff's right to inspection depended upon a contract which was the matter in dispute, and since he was unable to show that inspection was necessary to prepare his case, it was held that no inspection should be granted on the ground that the right depended upon the question to be determined at the trial.

**Application.  
how made.**

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 it must be shown that the inspection is material to the plaintiff's case.

(*d*) *Davenport v. Jepson*, 1862, 1 N. R. 307; see also *The Germ Milling Co. v. Robinson*, 1886, 55 L. J. Ch. 288; 3 R. P. C. 11.

*Robinson*, 1886, 3 R. P. C. 11; *Drake v. Muntz Metal Co.*, 1886, 3 R. P. C. 43.

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

(*e*) *The Germ Milling Co. v.*

The cost of an inspection depend on the circumstances, and are in the discretion of the Court (g). In *Ashworth v. English Card Clothing Co.* (1904, 21 R. P. C. 353) Joyce, J., allowed the costs of an inspection to the successful party, although it had taken place voluntarily and without an order of the Court, on the ground that circumstances showed that it had been necessary and proper.

Costs of inspection.

Rule 18 of Order LIIIA., dealing with particulars of objections concludes thus: “. . . No evidence as to any machinery or apparatus which is alleged to have been used prior to the date of the patent and which is in existence at the date of the delivery of the particulars shall be receivable unless it be proved that the party relying on such prior user has, if such machinery or apparatus be in his own possession, offered inspection of the same, or if not in his own possession, has used his best endeavours to obtain inspection of the same for the other parties to the proceedings.”

New rule as to inspection of prior users.

The Court has always exercised power to order inspection of articles in the possession of the parties, but it generally happened that when an application was made to inspect an important “prior user” the defendant was in a position to say that the article was in the possession of a third party who, though willing to produce it at the trial, positively refused to allow inspection beforehand. This device is now, it is to be hoped, effectually rendered useless, for it is to be remembered (h) that if the third party refuses inspection the defendant is nevertheless bound to deliver a description and drawings.

## VI. THE REMEDY.

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 were made for the governing of the practice of the Courts introduced great

(g) *Mitchell v. The Darley Colliery Co.*, 1883, L. R. 10 Q. B. D. 457. (h) See p. 338, ante.

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 establish 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 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.

Injunction  
based on  
threat to  
continue.

**Injunction.**—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 right; 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* (1878, L. R. 9 C. D. at p. 65) 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 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."

So in *Dowling v. Billington* (1890, 7 R. P. C. 191) two acts of infringement of the plaintiff's patent were proved, the first of which took place prior to the acceptance of the complete specification by the Comptroller, while the second was committed a few days after the commencement of the action, it was held by Chatterton, V.-C., whose decision was affirmed by the Court of Appeal, that neither of these acts constituted an actionable infringement; but inasmuch as the conduct of the defendant showed a deliberate intention to infringe, the plaintiffs were entitled to an injunction upon the principle laid down by Jessel, M.R., in *Frearson v. Loc* (*supra*).

Unless to support a claim for an injunction and for the purpose of showing that the defendant has an intention of infringing in the future, evidence of acts after action brought is inadmissible. In *The Welsbach Incandescent Gas Light Co. v. Dowle* (1899, 16 R. P. C. 391) the plaintiffs attempted to supplement their evidence of an actual infringement having taken place by means of evidence of such acts since the issue of the writ. Bruce, J., refused to admit the supplementary evidence.

Evidence of  
acts after  
action  
brought.

Where what has been done since action brought is different in any way from what was done before, and is relied on as evidence of the intention to infringe, the defendant must have clear notice of the nature of the infringement which he is

Two kinds of action.

alleged to be contemplating. In *Shoe Machinery Co. v. Cutlan*, 1895, 12 R. P. C. at p. 367, Romer, J., said: "Two kinds of action may be brought by a plaintiff patentee. The one is based on this—that the defendant has infringed before action brought, and in respect of this the plaintiff is entitled to claim damages, or an account, and an injunction to prevent similar infringements in the future. The other action is based on the fact, not that the defendant has infringed, but that he threatens and intends to infringe; and in this case the plaintiff may claim an injunction to restrain the threatened infringement. Of course you may find both kinds of action combined in one, but they are distinct in themselves in several respects. In the first, the plaintiff has to give particulars of breaches, that is to say, of the infringement relied on; and by statute, except by leave of the Court or a judge, no evidence can be given at the hearing, of any breaches other than those stated in the particulars. In the other, of necessity, there can be no particulars of breaches; but to avoid unfairness to the defendant, care is always taken that he shall have fair notice as to the nature and particulars of the special infringement he is alleged to be contemplating; and then no doubt, if after action he commits that special infringement, or substantially that infringement, evidence of it can be given, as it is evidence to show that the plaintiff was right in his allegation that, at the date of action brought, the defendant was threatening and intending to infringe. I may add that if an action, as originally brought by a plaintiff patentee, is of the first class only, but he finds that the defendant has, since action brought, infringed in a way substantially different from his former infringements, leave would be given by the Court to the plaintiff in a proper case, and on proper terms, to amend his action, and to bring these subsequent infringements before the Court to be dealt with once and for all with the prior infringements."

Actual infringement evidence of intention.

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, unless it be proved beyond doubt that there can be no intention to continue infringing (see p. 368 *et seq.*, post), and an injunction will be granted. Vice-

Chancellor Shadwell, in *Losh v. Hague* (1837, 1 W. P. C. at p. 200), 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" (a).

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 *British United Shoe Machinery Co. v. Simon Collier, Ltd.*, 1909, 26 R. P. C., the defendants had purchased a machine provided with an extra appliance which was an infringement of the plaintiff's patent; they had no use for the appliance and never connected it to the machine. After action brought they returned the appliance to the manufacturers. It was clear that there was no intention to infringe at the date of the action, and counsel for the plaintiffs relied on the purchase of the machine and appliance for the purposes of trade as an infringement. The Court of Appeal (Cozens-Hardy, M.R., and Moulton, L.J., Buckley, L.J., dissenting), reversed the decision of Parker, J. (on this point) holding that there had been no actual infringement and that no injunction could be granted.

Mere possession is not threat.

In the case of *Adair v. Young* (1879, L. R. 12 C. D. 13), 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.

(a) See also *Geary v. Norton*, 1846, 1 De. G. & S. 9.

Now, a master who comes on board ought not to be answerable on the ground that, when he takes 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.

**Sale.**

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 (b).

The principle upon which the Court grants an injunction was clearly demonstrated in *Proctor v. Bayley* (1889, 6 R. P. C. 538). In that case the infringement complained of took place six years before the trial of the action. It was proved that the user continued only for a few months, after which the machines were abandoned as unsatisfactory. It was held by the Court of Appeal, reversing the decision of Bristowe, V.-C., that it was clear that the defendants had no intention whatever of continuing the wrongful act, and consequently that it was not a proper case in which an injunction should be granted. Cotton, L.J., in his judgment, said (at p. 541): "There is no doubt that it was a good patent, and we must also take it that the defendants have infringed; but the point is this: Is there any ground here which would justify the Court in exercising the extraordinary jurisdiction of the Court of Chancery in granting

(b) *Betts v. Willmott*, 1871, L. R. 6 Ch. 239.

an injunction? That, I think, has been a good deal lost sight of in the argument. It is not because a man has done a wrong that an injunction will be granted against him. If a man has done a wrong which will not be continued, at common law damages may be obtained for the wrong done, which the common law says is sufficient indemnity for that wrong; but then the Court of Chancery says this, in the exercise of its extraordinary jurisdiction: 'We will not be satisfied with that: we will grant an injunction, because a wrongful act has been done, in order to prevent that wrongful act;' and they grant an injunction where a wrongful act has been done, and the Court is satisfied of the probability of the continuance of the wrongful act. . . . But here, although the defendants did infringe the plaintiff's patent, we must consider all the circumstances of the case in order to guide us in the consideration of this: Ought the Court to draw the inference that there will be a continuance of the wrongful act so as to justify the Court in granting the extraordinary interference and the protection which is exercised by the Court of Equity?" (c).

An action for an injunction may be brought against innocent carriers of infringing articles. In *Upmann v. Elkan* (1871, L. R. 7 Ch. 130) (d), which was a trade mark case, Lord Hatherley, L.C., in his judgment, said: "It has been argued that the plaintiffs were not entitled to an injunction against the defendants, who had been guilty of no offence, being merely carriers receiving goods, which, though fraudulently marked, were not for their own use, nor to be sold by them for their own benefit, but were received merely for the purpose of transmitting them to the persons to whom they were consigned. I cannot conceive a doctrine more dangerous or mischievous, or more fatal to the authority of the Court with respect to trade marks. If that argument prevailed, any persons being abroad, as was the case in this instance, and minded to commit frauds upon an English trade mark, could easily do so by sending

Innocent  
carriers.

(c) Note also *Hudson v. Chatteris Manufacturing Co. v. Cunard Engineering Co.*, 1898, 15 R. P. C. 438. *Steamship Co.*, 1889, 6 R. P. C. 398.

(d) And see *Washburn and Moen*

their different consignments together to persons in the position of the defendants, who appear to be respectable agents and warehousemen, thereby committing an injury in a manner most convenient to themselves, and very mischievous to the person entitled to the benefit of the trade marks."

Consignees  
should be  
joined.

The above reasoning would apply equally well to infringements of letters patent. The consignees of the goods should also be added, even if out of the jurisdiction. In *The Washburn and Moen Manufacturing Co. v. The Cunard Steamship Co. and J. C. Parkes & Sons* (1889, 6 R. P. C. at p. 403) Stirling, J., said: "I conceive the action was properly brought in the first instance against the Cunard Steamship Company, who are within the jurisdiction, and the question which remains is, were Messrs. Parkes, who are out of the jurisdiction, the consignees, and, as it now turns out, the owners of the goods, proper parties to the action? If they were resident within the jurisdiction, I conceive there would be no question that they were. Where goods were alleged to constitute an infringement of a patent or were marked in such a way that a trade mark was infringed, it was the settled practice in the Court of Chancery to bring actions against carriers and others who had control of the goods, to restrain them from being dealt with, and upon the consignees of those goods being found out, to add them as parties, in order that the questions which arose might be decided once for all in the presence of the persons who were the real owners of the goods alleged to infringe." The carriers, however, will be absolved from all liability if they make full disclosure of the names of the consignors and consignees of the goods complained of.

Proper course  
where  
several  
infringers.

In cases where there are several infringers the plaintiff is not justified in commencing a vast multitude of actions and applying for injunctions in each.

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. 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" (e).

A question has arisen as to what should be done if on an action against two defendants for the same infringement one of them fails to appear. The defendant who appeared might succeed in establishing the invalidity of the patent, and the difficulty arises as to the position of the other defendant, since judgment for the defendant on the ground of invalidity is *inter partes* only, and does not affect the status of the patent.

Where one defendant only appears.

On the whole, however, it may be said that injunction is an equitable remedy, and that it would be contrary to principle for the same tribunal which had pronounced a patent to be invalid to restrain a member of the public from doing what could not be an infringement.

In *Actien Gesellschaft für Cartonagen Industrie v. Remus & Burgon* (1895, 12 R. P. C. 94), Chitty, J., refused to set down on motion for judgment against the defendant who had not delivered a defence, asking what would happen if the other defendant succeeded in upsetting the patent.

In *Savage v. Brindle and Another* (1900, 17 R. P. C. at p. 233) a motion for judgment against one defendant stood over until the trial; after the hearing he consented to an injunction, but the other defendant succeeded in upsetting the patent. Farwell, J., granted the injunction asked for.

The general balance of convenience will be looked to in granting an injunction.

General convenience looked to.

In *Hopkinson v. St. James and Pall Mall Electric Light Co.* (1893, 10 R. P. C. at p. 62) an injunction was granted but was suspended for six months, the defendants agreeing to keep an account on the ground that great inconvenience would

(e) Per Sir W. Page-Wood, 1 Eq. at p. 391. See also *Foxwell v. Webster*, 3 N. R. 103.  
*V.-C., Bovill v. Crate*, 1865, L. R.

be caused to the public by suddenly stopping the use of the three wire system.

In *The Leeds Forge Co. v. Deighton's Patent Flue Co.* (1901, 18 R. P. C. at p. 240) the injunction was suspended pending an appeal on the ground that to put it into force at once would throw a large number of workmen out of employment.

The injunction falls with the expiration of the patent (*f*), but 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 (*g*).

Injunction  
and subse-  
quent amend-  
ment of  
specification.

In *Dudgeon v. Thomson* (1877, 3 A. C. 34) the plaintiff had obtained an injunction. Subsequently he amended his specification, and after this had been done took proceedings to enforce the injunction. The House of Lords held that he should have brought a new action, since the new specification might be open to objection, and was not the same as the old specification. It is submitted that this is no longer good law, on account of sect. 18, sub-sect. 9 of the Act of 1883, re-enacted as sect. 21, sub-sect. 7 of the Act of 1907 (see p. 184, *ante*).

In *Saccharin Corporation v. Dawson* (1902, 19 R. P. C. 169) and *The Same v. Jackson* (1903, 20 R. P. C. 611) the actions were brought upon several patents (see p. 323). It was impossible to say which patent had been infringed, but it was clear that one of them must have been. The injunction was granted for the life of the patent which would earliest expire.

A person against whom an injunction has been granted or who has given an undertaking in Court is liable to be committed should he be guilty of a breach of such injunction or undertaking, and a person aiding and abetting such a person and with knowledge of the injunction is also guilty of contempt (*h*), but an application for committal, involving as it does the liberty of the subject, will require the strictest proof in its support (*i*).

(*f*) *Daw v. Eley*, 1867, L. R. 3 25.  
Eq. 496.

(*g*) *Crossley v. Beverley*, 1829, 1  
W. P. C. 119; *Crossley v. The Derby*  
*Gas Light Co.*, 1834, 4 L. J. Ch.

(*h*) *Incandescent Gas Light Co. v.*  
*Sluce*, 1900, 17 R. P. C. at p. 175.

(*i*) *Dick v. Haslam*, 1891, 8 R. P.  
C. 196.