

defendants varies from the specification of the plaintiff's patent, but to see whether in reality, in substance, and in effect the defendants have availed themselves of the plaintiff's invention."

Where, to the eye, the two things are so similar that it is necessary to search carefully to discover differences, a strong *prima facie* case of infringement is at once made out. But such *prima facie* case may, on further examination and comparison, be rebutted by the discovery of some essential difference. (*m*)

In *Plimpton v. Malcolmson*, (*n*) the defendant took the plaintiff's invention bodily, excepting one detail, which he varied for the worse by substituting a fixed steel spring for a rubber spring or buffer, which could be tightened or loosened as required, and this was held a clear infringement. So, too, in *Hinde v. Osborne*, (*o*) the substitution of a flexible wire for a pin pivot was held an infringement; in *Osmond v. Hirst*, (*p*) the substitution of a revolving brush for a rotating disc; and in *Macdonald v. Fraser*, the adoption of an air-pump in place of bellows. (*q*)

Infringement by Substitution of Equivalents.—Where the infringer takes the substance of the patented invention, but varies the form by omitting certain parts and introducing elements known to be equivalents for the parts so omitted, he is said to infringe by the substitution of mechanical or chemical equivalents.

Discussing infringement by mechanical equivalents in *Dudgeon v. Thomson*, (*r*) Lord Cairns, C., said: "Now, my lords, what I understand by that is this, 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 shewn that they had infringed the words of a 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

(*m*) See Jessel, M.R., in *Thorn v. Worthing Skating Rink Co.*, 6 C. D. 417, n.

(*n*) 3 C. D. 531; 45 L. J. Ch. 505.

(*o*) 1 R. P. C. 221; 2 R. P. C. 64.

(*p*) 2 R. P. C. 265.

(*q*) 10 R. P. C. 386; 11 R. P. C. 169.

(*r*) 3 App. Ca. 34; see pp. 44, 45.

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 the less be 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."

Instances of Mechanical Equivalents.—The following cases illustrate infringement by mechanical equivalents.

In *Murray v. Clayton*, (s) the plaintiff's machine, which was an improved apparatus for the making of bricks, was so contrived as to cut by the reciprocating action of a vertical wire from clay delivered on the table of the machine a strip long enough to make twelve bricks. This strip of clay was then pushed forward by the action of the machine against a series of fixed wires which divided it into separate bricks of the proper dimensions. The defendants in their machine effected the first operation by a wire acting not vertically but radially, and the second by passing the wires through the clay by the action of a movable frame in which they were set.

In holding this to be an infringement, James, L.J., said: "It appears to me that the defendants have simply made transposition, that is, that instead of moving the clay against the wires they have made the wires move against the clay. It appears to me that what *Mr. Pole* has said on the subject in his evidence is perfectly accurate. He describes the details of what is done by the plaintiff's machine, and what is done by the defendant's machine, and he says this amounts simply to inverting the relative motions of the parts in regard to each other, the essential action and the result produced being identical in the two cases. That is exactly the case of a colourable variation. This machine, which was made by the defendants after they had seen the plaintiff's machine in use, effects the same object; but according to the evidence (which is not contradicted) it effects it by an enormously greater expenditure of power, as to which we may refer to the language of Lord Hatherley in *Daw v. Eley*, (t) to the effect that a clumsy imitation of a patented machine or a patented article may be an infringement although it is not such as would have been an anticipation defeating the plaintiff's right." (u)

(s) L. R. 7 Ch. 570.

(t) L. R. 3 Eq. 496.

(u) L. R. 7 Ch. p. 585.

In *Ehrlich v. Ihlee*, (v) the plaintiff's invention (a form of hand organ) consisted in the combination of a stationary wind chest and a circular rotating music sheet, which, by reason of perforations it contained, operated as it revolved, upon levers attached to the fixed mechanism, and so produced the music. The defendants adopted the plaintiff's idea, but inverted the functions of the parts, by making the music sheet a fixture, and causing the wind chest and mechanism to rotate beneath it. This was held a clear infringement. (w)

In *Moss v. Malings*, (x) the invention was a method of securing a firmer grip on the handles of tennis racquets. The patentee attained this result by longitudinal grooves on the opposite sides of the handle, the defendants by building up protuberances along the handle at intervals. It was contended that this was a new idea, and no infringement. On this North, J., said: "It is clear to my mind that if the plaintiff's is a good patent, this is an infringement of it, and for this reason. The new idea, when carried out in the handle, is an extension of surface for grasping by the hand, coupled with the making of certain parts raised and certain parts depressed, so as at the same time to give a greater surface, and to give greater holding power, or, in other words, to enable you to hold it equally tightly with less pressure from the hand at the time. . . . A suggestion has been made that there is a difference in this way, that what the plaintiff has done has been simply to take what you call a solid handle and groove out certain indentations in it, whereas the defendant's is totally different, because he has taken what I call again a solid handle, and he has built up certain ribs or put certain protuberances upon it. The result in both is the same; there are alternate elevations and depressions, and whether those are produced by cutting out the intervening bits, or building up the ribs so as to leave holes between the two, seems to me entirely immaterial." (y)

In the *United Telephone Company v. Bassano*, (z) the plaintiffs' patent claimed the combination for telephonic purposes of a diaphragm or tympan with tension regulators operating in a closed circuit. The essence of the invention was a vibrating plate or substance to be operated upon by the human voice, and which in

(v) 4 R. P. C. 115; 5 R. P. C. 437.

(w) See, also, *Crampton v. Patent Investments Co.*, 5 R. P. C. 382; 6 R. P. C. 287; *Barrett v. Vernon*, 25 W. R. 343.

(x) 3 R. P. C. 373. In the later case

of *Slazenger v. Feltham* this patent was held invalid by the Court of Appeal for want of subject-matter: 6 R. P. C. 233.

(y) 3 R. P. C. 379.

(z) *Ibid.* 295, p. 313.

its turn operated upon the tension regulator. The defendants suggested that their mechanism was no infringement, because they did not use a diaphragm; but the Court held that a board in the defendants' apparatus in fact performed the function of the diaphragm, and that the infringement was made out. On this the defendants urged that the board in question was not an essential part of their apparatus, which could be worked without it. The Court of Appeal declined, however, to consider this contention, on the ground that in the infringement in fact complained of the board was present, and therefore whether the defendants' mechanism would or would not work without it was immaterial to the issue in dispute.

In the later case of the *United Telephone Company v. St. George*, (a) the defendants' apparatus consisted of a disc of carbonized leather behind a mouthpiece, and a ball of carbonized wood suspended by means of a flexible metallic conductor, so as to rest lightly by gravity against the leathern disc. They claimed that the instrument thus constituted contained neither of the elements of the plaintiff's combination, and did not operate in a closed circuit. Stirling, J., held, however, that the defendants' disc was in effect a diaphragm, that the combination of disc and ball constituted a tension regulator within the meaning of the plaintiff's specification, and that the infringing instrument in fact operated in a closed circuit.

In *Murchland v. Nicholson*, (b) an apparatus for milking cows was fitted with a valve to relieve vacuum pressure. The patentee's valve was formed by a tube connected at one end with the pipes in which the vacuum was set up, and open at the other. The open end rested in a vessel of water, and was so adjusted that when the vacuum drew up into the tube a column of water of a certain height, air found its way up the tube and prevented the vacuum from becoming excessive. The respondents used an apparatus in which they obtained the desired automatic regulation of the vacuum by using an ordinary valve with a lever held down by a weight, the amount of the vacuum being regulated by the position of the weight on the lever. This was held by the Inner House of the Court of Session to be the substitution of a mechanical equivalent, and an infringement of the complainer's patent.

In *Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson & Company*, (c) the patent was for an improved method of

(a) 3 R. P. C. 321.

(b) 10 R. P. C. 417.

(c) 11 R. P. C. 93; 261 (affirmed).

manufacturing a product called lanolin from wool fat. The object of the inventor was to utilize for practical and especially pharmaceutical purposes the fatty matters known to be contained in sheep wool. It was known that by washing sheep wool with alkali, a liquor containing cholesterine fats mixed with soap and other impurities could be obtained. The invention consisted in a special mode of treating this liquor, by which the cholesterine fats were freed from fatty acids and other impurities, and a new product, called lanolin, obtained, which was not liable to become rancid. The ingredients of the liquor obtained by the alkali washing were of different specific gravities, and the inventor, by separating them by means of the mechanical action of a centrifugal machine, was able to extract the pure and unadulterated fat.

The defendants produced a product which they called anaspaline. This, putting aside an immaterial ingredient, was merely lanolin. They produced it by the same means, except that, instead of using the speedy action of a centrifugal machine, they relied on a depositing process. In holding this to be an infringement, Romer, J., said: "They appear to me to have taken the essence, or what is sometimes called the pith and marrow, of the invention. The use of the centrifugal machine was not of the essence of the patented invention. That machine was a well-known method of separating mechanically materials of different specific gravity, and was, to my mind, referred to in the specification as being, and because it was the most speedy and efficient known means for effecting the separation. The mechanical separation, by allowing gravity to act on such materials when deposited in a vessel in the ordinary way, is a well-known equivalent, though not so speedy or efficacious, and the defendants cannot, by adopting this, when they in all essential matters take and use the plaintiff's invention, be heard to say that they are not using that invention or infringing the patent."

In the *British Tanning Company v. Groth*, (d) the plaintiff's patent was for an improved process and apparatus for tanning by aid of electricity. The invention consisted in the application of electricity to a method of tanning by means of a rotatory drum. This was achieved by passing an electric current through the tanning liquor in the drum. The rotatory drum method of tanning was old and well known. Under it the liquor and the hides were all put inside a revolving cask or drum, which had pegs or other means by which, in the interior of the revolving cask or drum, the

(d) 8 R. P. C. 113.

hides were from time to time lifted up and splashed down, or churned about in the liquor. The plaintiff's specification limited his claim to the use of electricity in connection with this mode of tanning. The defendants also used electricity for tanning, but in combination with a different mechanical treatment. In their apparatus the hides were made to revolve on an axis in the tanning fluid electrically treated. This was held to be a distinct method, and no infringement of the plaintiff's patent.

In *Miller v. The Clyde Bridge Steel Company*, (e) the pursuer's patent was for a combination of apparatus for turning over and moving metal masses in machinery for rolling metals. There were four claims each for a combination, and in each combination a "lifter" was included as an essential part. This lifter was the apparatus which the patentee used for turning the masses of heated iron when lying on the rollers. It was a species of fork. One prong lifted and tilted the metal over, which was then received in the hollow of the fork and kept in its place by the other prong. Thus the metal was placed and kept in a suitable position for entering into a new set of rolls. The lifter was attached to the ram of an hydraulic engine placed under the rollers, and upon a movable carriage, so that the lifter might be brought to a convenient place for the exercise of its functions.

The defenders used two hydraulic oscillating engines, each placed on a movable carriage. The ram was jointed to a lever arm, which again was connected with the carriage by a pin, round which it turned. The arm could thus be raised from the horizontal to the vertical or slightly past the vertical, and in its motion it turned the metal. The operation of turning was performed by the defenders' apparatus when the metal rested on the rollers; the metal being received and held in position by a corresponding arm attached to the ram of the other engine. While thus held in position the metal could be pushed along the rollers so as to enter any set of rolls. This combination contained no fork, the arms not being connected in any way. The Inner House of the Court of Session held this to be no infringement. Lord Rutherford Clark said: "The defenders use no fork which turns and receives the metal. With them the turning is effected with separate and unconnected arms. It is said that the two arms when brought together form the pursuer's lifter. I do not think so, for, being unconnected, they cannot form a fork. It seems to me that I have put the case fairly when I say that the defenders dispense with the

fork, which is the essence of the pursuer's invention, and use a separate contrivance of their own to effect the same end."

Where the Doctrine of Mechanical Equivalents does not Apply.—Where the object attained is old and the only novelty consists in the substitution of better equivalents for those already known and used to the same end, the doctrine of mechanical equivalents does not apply; and the patentee cannot bring within his specification any equivalent which he has not described and claimed, so as to make its use an infringement of his patent right. (*f*)

"There are some things," said Lord Halsbury, C., in *Tweedale v. Ashworth*, (*g*) "wherein a principle properly so-called is invented, and the infringer may take the principle and may alter the details, and yet it is very obvious that he has, in truth, taken the idea which has been the subject-matter of the invention, and has simply altered the details so as to avoid the possibility of its being suggested that he has taken the same thing. The Court can in such case very often look through the mere variation of details and see that the substance and pith of the invention has been pirated, and consequently can protect the inventor. But there are some cases in which, although the principle is common to a great variety of manufacturers, there may be a good subject-matter of a patent in the particular mechanical mode by which that principle is carried into operation."

In *Curtis v. Platt*, (*h*) the plaintiff's patent was for improvements in mules, and the object of the invention was to effect certain changes in the action of the mule without the intervention of an eccentric boss and rods and levers, as described in prior patents. "For the efficient agency of this machine," said Lord Westbury, "it has been found necessary that there should be a shaft with cams upon it, and it has also been found necessary that there should be some means of arresting the shaft, staying the shaft once or twice, or even four times, during a single rotation, thereby producing breaks or pauses for spaces of time in the rotatory motion of the shaft. These pauses or breaks have been at various times attempted to be produced in various ways. *Mr. Roberts* had one mode, namely, by the operation of a wheel with spaces. That proving not adequate to the end, another mode was discovered of breaking the rotatory motion, producing pauses in the rotation by the operation of a clutch box. The application of that to the shaft was made, as far as I am informed, in the first instance by the

(*f*) *Tweedale v. Ashworth*, 9 R. P. C. 126; per Lord Watson, p. 128.

(*g*) *Ibid.* p. 126.

(*h*) 11 L. T. (N. S.), 245, at p. 247.

patent of *Lakin and Rhodes*. *Mr. Wain* (the patentee) then applied himself to what he denominates 'an improvement upon the patent of *Lakin and Rhodes*.' Now, it has been vigorously contended before me, that I am not to take *Mr. Wain's* invention as he himself describes it, and that I ought not to allow him to be limited to his own description of its being an improvement; that I ought to take his invention as containing in itself a new and original principle. I cannot so take it. I must take *Mr. Wain's* patent as being specific mechanism, directed to a certain end that was previously well known; directed to facilitate a certain result, the benefit of which had long been discovered; directed to produce in a more simple and easy manner a particular operation of the clutch-box, which was itself only a means to an end. I cannot but think that in patents of this description the doctrine of mechanical equivalents is not by any means applicable. The thing itself is nothing more than a particular agent for attaining a certain end, and if *Mr. Wain* was entitled to a patent for the particular agency by which he effected in a more convenient manner the opening and shutting of the clutch-box, any other person is, on the same principle, entitled also to a patent for the means of effecting the same result, provided those means are not a colourable evasion of *Mr. Wain's* patent, or provided those means do not embody *Mr. Wain's* patent with an improvement."

In *Gosnell v. Bishop*, (i) *Bowen*, L.J., commenting on the above case, said: "What is the law laid down in *Curtis v. Platt*? Precisely what the Lord Justice has said, that where you get a specific mechanism directed to a certain end which was previously well known, directed to facilitate a previous result the benefit of which had been previously discovered, then in a patent of that description the doctrine of mechanical equivalents is not applicable, and that any other person is entitled to the use of old and known principles, provided he does not take substantially the means in which the excellence of the patent alone consists."

In *Garrard v. Edge*, (j) the invention related to improvements in presses for pressing tiles. Machines adapted to this purpose were well known and consisted of three principal parts: the box or lower die, the stamper or upper die, and the lifter. The plaintiff's mechanism contained all these common elements. The essence of his invention, however, was the reversibility of certain parts of the mechanism. The defendant's machine contained the same common elements, but its essence lay in the fact that certain

(i) 5 R. P. C. 159.

(j) 6 R. P. C. 563.

parts were renewable; and the patentee being limited to his special mechanism, this was held to be an independent mode of attaining the desired result, and no infringement. "The defendants," said Fry, L.J., "proceed by an entirely different mode of operation. They reject reversible plates. They say they reject them for a good reason, because they say the worn surface which has been used as the working surface does not make a good basis or support for the other surface when turned against the upper plate—the upper or lower as the case may be. That may be or may not be the case, but they do not proceed upon the use of a reversible plate. They proceed upon the principle of having renewable plates, and of enabling the person using the machine before that renewable plate has been obtained, or without putting it on to use the upper or the lower surface, as the case may be, of the stamper or the lifter as itself a working surface. I think, therefore, that the whole machine—the combination—has not been taken, and that no essential part of it has been taken." (k)

In *Richardson v. Castray*, (l) the invention related to an apparatus for manufacturing wine glasses. Part of the patentee's contrivance consisted of two boards connected by a hinge and spring, so as to be self-acting. The object aimed at being old, the inventor was held to be limited to his special mechanism, and to have no remedy against persons using a mechanism consisting of two boards hinged and fitted with a loop which acted as required on the pressure of a workman's hand.

In *Tweedale v. Ashworth*, (m) the invention related to that part of a carding machine which is known as a "flat." The "flat" consists of a straight bar of solid metal, to the surface of which there is attached a wire brush; what in ordinary language would be described as the back of the brush, is of elastic material, and is technically called its foundation. For the efficiency of the carding machine it is necessary that the surface of the brush shall be perfectly level, and remain so in course of working. The attainment of this result had been found to depend on the manner in which the foundation of the brush was fastened to the bar of metal upon which it rested. At the date of the patent there were two known modes of attachment, rivets, or stitching with wire thread. Both methods were liable to result in a puckering of the foundation, and inequalities in the surface of the brush. The plaintiff's invention consisted in effecting the necessary fastening

(k) 6 R. P. C. p. 569.

(l) 4 R. P. C. 265.

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

by thin strips of metal, one on each side of the bar, used in the following manner. One edge of each strip was moulded so as to grip firmly the outer edge of the foundation, the other edge of the strip being moulded so as to fit and grip a ridge cast upon the back of the bar. After a strip had been so attached to each edge of the foundation, the bar was inserted, producing a degree of tension which made the foundation adhere to it flatly and evenly, and then the other edges of the strips were made to grip the ridges cast on the other side of the bar, the result being that the surface of the brush was made and kept uniformly level, while the edges of the foundation were, by the encasing metal, protected from fraying and from becoming a receptacle for waste.

The defendants effected their attachment first by the use of a metallic clip on one side of the bar. They then by means of a steel comb stretched the elastic material to the other side, where, by applying a similar clip, they held it in position. This, having regard to the narrow ambit of the invention, was held in all the Courts to be no infringement.

“The plain object of the invention as described in the specification,” said Lord Watson, “is to substitute better mechanical equivalents for those already known and used as a means to the same end. It follows that, in construing the appellant’s specification, the doctrine of mechanical equivalents must be left out of view. He cannot bring within the scope of his invention any mechanical equivalent which he has not specifically described and claimed.” (n)

In *Nettlefolds v. Reynolds*, (o) the patentee had described his invention as comprising “a rotating cylindrical die and a stationary curved die employed for progressively forming helical threads upon screw blanks, which are caused to roll round the concave face of the stationary die.” The specification referred throughout to rotary machines and no others. That metal screws could be made by pressure was well known at the date of the patent, and having regard to the existing state of knowledge the only patentable novelty in the plaintiffs’ invention was the particular method of making screws by rotating cylindrical dies working against circular fixed dies cut and used as described in the specification. The defendant’s machine also made screws by pressure, which resembled in all respects those of the plaintiffs, but the dies used in his machine were straight, not cylindrical, and were made to pass backwards and forwards over one another, each die moving

(n) 9 R. P. C. 128.

(o) *Ibid.* 270.

and assisting to form the thread upon the screw. This, in the circumstances, was held to be no infringement, as in such case the doctrine of mechanical equivalents did not apply. "This," said Romer, J., "is not in my judgment a case where the plaintiffs can invoke in their favour the principle with reference to infringements commonly called that of mechanical equivalents. To establish a case of that kind, where an improvement in detail in a well-known class of machines alone is patented, the Courts appear to have thought that as a rule the patentee ought to shew one of two things: first, that a new article has been produced by the patented invention; or secondly, if not, that then some new and valuable principle was involved in, or was first brought into public use by the invention. I find neither of these grounds here." (p)

In the *Ticket Punch Register Company v. Colley*, (q) the invention related to ticket punching machines. The plaintiffs' improvement was a peculiar mode of holding back, and then releasing the punch in the machine by which the punching of the ticket and the registering of the punch were effected at one time. This they achieved by a very ingenious locking device, by which the punch was held back until released by the rising of a pin in it, this rising being caused by the insertion of the ticket. The fundamental idea, the essence, of the invention was first holding the punch back and then releasing it. The defendants attained the same result, but in an essentially different way. They did not lock or hold back their punch at all, but started with an unlocked machine. It was argued by the plaintiffs that the result being the same the defendants' device was a mere equivalent for the plaintiffs', and therefore an infringement. Rejecting this contention, Lindley, L.J., said: "Before any question of mechanical equivalents can arise, the conclusion must be arrived at that the substance of the invention has been taken. Then, if the differences are really immaterial, from that point of view, they ought to be neglected. But if two persons solve the same mechanical problem in two substantially different ways, starting from different conceptions, and both succeed, neither method of solution can be treated as the mechanical equivalent of the other, although each method may involve the use of well-known contrivances, and much may therefore be common to both." (r)

It must always be remembered that where the alleged

(p) 9 R. P. C. p. 285.

(q) 12 R. P. C. 171; see, also, *Jardine*

v. King, Mendham & Co., 13 R. P. C. 411, 615.

(r) 12 R. P. C. 184.

infringement omits the essential feature of the patented invention there is no invasion of the patentee's monopoly; therefore in such case the doctrine of mechanical equivalents has no application. (s)

New Process Aimed at an Old Result.—So likewise where the invention is a new process for attaining an old result, the patentee is entitled only to protection for his process, and it is no infringement to attain the same result by a different process.

In *Hutchinson v. Pattulo*, (t) the invention was an improved treatment of oils and fats for lubricants, the object being to thicken the oil. The patentee's method was to subject the oil or fat to the action of heat while exposed to the air in shallow layers. The defenders attained the same result by heating the oil with steam, and blowing air through it when so heated, and this was held to be no infringement.

New Combination Directed to Achieve a New Result.—Where, however, a new combination of well-known appliances is directed to the attainment of a new result, the patentee, as above mentioned, is not limited to the precise combination which he has patented, but is allowed a wider ambit for his monopoly.

In *Proctor v. Bennis*, (u) the plaintiff's patent was for an improved mechanical stoker, which, by a self-acting mechanism, distributed coal at intervals over the fire surface. Other mechanisms had been invented before, for feeding coal into furnaces automatically, but the means employed under the plaintiff's patent were altogether new; the result being produced by the intermittent radial action of a flap or door. By this device the plaintiff was able to obtain not only better but new results. The mechanism consisted in the employment of tappets, shafts, and springs, in connection with doors. The defendant did not use the identical apparatus of the plaintiff, but in both machines the automatic motion was radial, and in both it was intermittent. In both the radius was moved in one direction by tappets, and in the opposite direction by a spring. There was this difference, however, in the plaintiff's machine, the shaft was impelled by the tappets and by the spring, in the defendant's the radius itself was so impelled. Hence the radius in the plaintiff's machine was attached to the shaft, whereas in the defendant's it

(s) See *Pneumatic Tyre Co. v. Tubeless Tyre*, 15 R. P. C. 236; 16 R. P. C. 77; *Allen v. Abraham Pyatt & Co.*, 15 R. P. C. 723; 16 R. P. C. 135; *Cooper v. Baedeker*, 16 R. P. C. 363; *Griffiths v. Birmingham*

Stopper Co., 16 R. P. C. 383.

(t) 5 R. P. C. 351.

(u) L. R. 36 C. D. 740, 764; 4 R. P. C. 333; 57 L. J. Ch. 11, 24.

worked on a pin. Thus, all the defendant did by way of variation was to substitute the pin for the shaft as the centre on which the radius acted, and by impelling the radius itself instead of impelling the shaft fixed to the radius, he produced in substance precisely the same radial action as was produced in the plaintiff's machine. The Court of Appeal held this to be a clear infringement, the variations being mere mechanical equivalents.

"Now, in *Curtis v. Platt* (v) and other cases," said Bowen, L.J., "it has been said that where the patentee has claimed a particular mechanical device for effecting the object in view, he must be held strictly to that device. But when you are considering an absolutely new invention with a novel result, you cannot apply that rule without recollecting that the result effected is new, as well as the combination, and that when there is really an ingenious novelty in the idea that the combination will produce a new result, that novelty in the idea is part of the merit of the very combination." (w)

A patent for a combination of old and well-known elements may therefore have some novel principle underlying it, which will entitle the patentee, not only to protection against infringement by the use of the identical combination, but also against infringement of the combination (so far as it embodies that novel principle) by mechanical equivalents.

This rule is well illustrated in the series of cases in which the *Automatic Weighing Machine Company* sued for infringements of *Everitt's* patent.

Everitt's invention was a combination of weighing mechanism with a coin mechanism for weighing and recording weights. (x) Weighing mechanism, indicating mechanism, and the use of a coin to actuate machinery, were all well known. But the patentee's combination was so contrived that there was a break in the connection between the weighing mechanism and the indicating part of the machine which recorded the weight. Hence, while the weighing part of the mechanism acted whenever the person to be weighed stepped on to the platform of the machine, the result remained concealed from view until the break in the connection with the indicator was made good. Dropping a penny into a slot in the machine completed this connection by freeing a stop, and

(v) 11 L. T. (N. S.), 245.

(w) 4 R. P. C. p. 359; see, also, Smith, L.J., in *Ticket Punch Co. v. Colley*, 12 R. P. C. 171; *Aktiebolaget Separator v. Dairy Co.*, 15 R. P. C. 334; *Presto Gear*

Case Co. v. Simplex Co., 15 R. P. C. 642.

(x) See *The Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, 6 R. P. C. 120, 371.

so caused the weight to be shewn on the external face of an index dial. The Court held that underlying this combination was the novel principle of utilizing a break in the connection between the weighing and indicating mechanism for the purposes of automatic weighing, and that this was the essence of the invention, and that so far as that feature of the invention was concerned the patentee was entitled to protection against infringement by mechanical equivalents, although all the elements of the machine were old and well known.

In the *Automatic Weighing Machine Company v. The International Hygienic Society*, (y) the defendants' machine included a revolving dial, upon which the weight was marked when the person desiring to be weighed stepped on to the weighing platform. This dial was concealed by two shutters, carried by a spindle, disconnected with the weighing mechanism. The insertion of the coin operated a lever which moved the shutters away and disclosed the marking. This was held an infringement by mechanical equivalents.

In the machine of the *Combined Weighing Machine Company*, (z) a coin and weighing mechanism were also combined. But the mechanism did not ascertain the weight the moment the person to be weighed stepped on to the platform of the machine. A coin had first to be placed in position, and driven in by external pressure on a push-piece: this operation, by liberating a catch, freed the mechanism, and set the machine in motion. This also was held to be an infringement. "The sole question, it seems to me," said Kekewich, J., "that I have to decide is—is that difference, is that necessity of applying the pressure by means of the external button, sufficient to distinguish one machine from the other? To my mind it is a trivial difference, and to say that it made a distinction between the two machines would be to uphold a colourable difference; and whatever ingenuity may attach to the defendants' machine, however honest it may be as an independent discovery, I think that, according to law, it cannot be allowed to be used when the plaintiffs have a patent for what I consider to be substantially, though not precisely, the same thing." (a)

In the *Automatic Weighing Machine Company v. the National Exhibitions Association, Limited*, (b) the weighing and recording

(y) 6 R. P. C. 475.

(z) *The Automatic Weighing Machine Co. v. The Combined Weighing Machine*

Co., 6 R. P. C. 120, 371.

(a) *Ibid.* p. 125.

(b) 8 R. P. C. 345; 9 R. P. C. 41.

parts of the mechanism were also separated in the defendants' machines. Here, too, a coin was used, which, entering the slot, fell down a shoot, and pressed a spring contact against a fixed contact piece, and thus permitted a current of electricity to flow, which energized a magnet. This magnet so energized attracted the armature of a lever, and by releasing an arm brought the indicating mechanism into operation, which, on being set in motion, followed the weighing mechanism, and so recorded the weight. This likewise was held to be an infringement.

In the *Automatic Weighing Company v. Fearby*, (c) the defendant's weighing and indicating mechanisms were likewise disconnected. The insertion of a penny formed a coupling between an exterior handle and a lever. This handle, if then turned by the person being weighed, moved the lever, and drew down an arm; by this operation the indicating mechanism was set free, and falling down by its own weight followed the weighing mechanism, and shewed the result. This, following the last case, Romer, J., also held to be an infringement as containing the three ingredients of the plaintiffs' combination, viz. a break in the weighing and indicating mechanism, the use of a penny to allow the indicating by gravity to follow the weighing part, and an arrest of the indicating mechanism at the same point as that reached by the weighing part.

With these cases may be compared the case of the *Automatic Weighing Machine Company v. Knight*. (d) The defendant's machine in that case had no break between the weighing and indicating mechanisms; but was so contrived that a stop was put on the whole machinery—weighing and indicating alike. Hence the mechanism would not act until a lever was raised which the stop held in position. The dropping of a penny into the machine removed this stop, and so released the lever. The machine, formerly locked, thus became free, and all the mechanism acted at once. This was held an independent contrivance, and no infringement of the company's patent. "It appears to me not to be an infringement or anything near it," said Lindley, L.J. (e) "It is not a mere variety of indicating apparatus. It is not using the penny actuating apparatus which the plaintiff has adapted to the indicating part of the weighing machine at all, but it is seizing the general idea of dispensing with an attendant—seizing the general idea of applying to weighing machines the use of a penny, an idea which, as applied to various forms of mechanism, is extremely old, and applying the thing in a totally different way. There is no colourable imitation of it.

(c) 10 R. P. C. 442.

(d) 6 R. P. C. 113; 297.

(e) 6 R. P. C. 309.

It is a different mechanism applied not to the indicating apparatus at all, but to something totally different."

Equivalents must be Known as such at Date of the Patent.—The doctrine of infringement by equivalents is subject, however, to this limitation, which will be found principally to apply in the case of chemical patents, that the equivalents used must be such as were known to be equivalents at the date of the patent; otherwise they constitute new discoveries, and as such may themselves be made the subject-matter of a patent grant.

In *Heath v. Unwin*, (f) Parke, B., said: "The specification must be read as persons acquainted with the subject would read it at the time it was made; and if it could be construed as containing any chemical equivalents, it must be such as are known to such persons at that time; but those which are not known at the time as equivalents, and afterwards are found to answer the same purpose, are not included in the specification; they are new inventions." In the same case, Williams, J., said: "There is ample evidence that to melt together oxide of manganese and carbonaceous matter with steel and iron, will serve as an equivalent for the melting together of carburet of manganese with steel or iron in producing the desired result. But there is no evidence that at the time of the patent and specification this was known to persons of ordinary skill in chemistry. And I fully agree with the doctrine which has been repeatedly laid down in the course of the discussion of this cause, that though the use of a chemical or mechanical substitute which is a known equivalent to the thing pointed out by the specification, and claimed as the invention, amounts to an infringement of the patent; yet, if the equivalent were not known at the time of the patent and specification, the use of it is no infringement." (g)

In *Nobel's Explosives Company v. Anderson*, (h) the plaintiffs' patent was for improvements in the manufacture of explosives. The invention consisted in combining nitro-glycerine and nitro-cellulose (soluble in ether-alcohol), in a horny substance capable of being reduced to grains suitable for use as a propeller of projectiles. These two highly explosive substances so combined tamed each other, and resulted in a product called "ballistite." The defendant made a powder called "cordite," which was formed

(f) 5 H. of L. Ca. 505, at p. 538; 25 L. J. C. P. 8; 13 M. & W. 583.

(g) 2 W. P. C. 302. See these principles applied by Pearson, J., in *Badische Anilin v. Levinstein*, 24 Q. B. D. 170. See,

also, *Stevens v. Keating*, 2 W. P. C. 189; *Fabriques de Produits Chimiques de Thann v. Caspers*, 15 R. P. C. 94.

(h) 11 R. P. C. 115, 519.

by combining nitro-glycerine with *insoluble* nitro-cellulose. It was contended by the plaintiffs that this was the mere use of a chemical equivalent, and an infringement of their patent. Romer, J., and the Court of Appeal held, however, that insoluble nitro-cellulose was not known to be an equivalent of soluble nitro-cellulose at the date of the plaintiffs' patent, that the fact that it could be safely combined with nitro-glycerine was a new discovery, and that the defendant had not infringed. In the House of Lords this decision was affirmed. Lord Herschel, C., said: "No doubt there may well be cases where a chemical compound patented would protect against the manufacture of the compound in which one of the ingredients differed, where there had been a substitution for one chemical ingredient of that which was known to all chemists to be a mere chemical substitute for the other, producing the same reactions, it might be, or in some other way recognized as the equivalent of the other, so that any chemist would know that merely to change this particular ingredient, and substitute the other for it would make no real difference in the compound. . . . But what is the evidence that in 1888 any chemist would have known that wherever soluble was mentioned in this patent insoluble might be understood as a substitute in its action in all respects equivalent to the other? The evidence seems to me to be the other way." (i)

A patentee is under no obligation to inform persons infringing his patent that they are invading his rights. If he does not do so, he does not thereby preclude himself from subsequently suing such infringers. (j) It is otherwise, however, where by his own conduct he induces the commission of an infringement, as by sending an agent to purchase the article on the sale of which he intends to sue." (k) Whether or not an infringement has been committed is usually a mixed question of law and fact. Though cases may arise in which the absence of any evidence of infringement is so clear that the Court would properly hold that there was no case for the defendant to answer. (l)

"The question of infringement," said Lord Wensleydale, in *Seed v. Higgins*, (m) "is one of mixed law and fact. The construction of the specification is for the Court, with the aid of such facts as

(i) 12 R. P. C. 167, 168.

(j) Per Cotton, L.J., in *Proctor v. Bennis*, 4 R. P. C. 333; 36 O. D. 740, at 760; 57 L. J. Ch. 11.

(k) *Kelly v. Batchelar*, 10 R. P. C. 289; *United Telephone v. Henry*, 2 R. P. C. 11;

but see *Dunlop Pneumatic Tyre Co. v. Neal*, 47 W. R. 632; 80 L. T. 746.

(l) See *De La Rue v. Dickenson*, 7 E. & B. 738.

(m) 8 H. of L. Ca. p. 565; 30 L. J. Q. B. p. 317.

are admissible, to explain written documents. In deciding whether there has been an infringement, there is a question of fact wholly for the jury, viz. what the defendants have done; and if scientific evidence is necessary fully to elucidate the case on either side, it is, no doubt, admissible; and, in determining the question of infringement, the judge must apply what the jurymen find to be true. The opinion of scientific witnesses is only admissible as proof of facts. Their opinion as to whether there has been an infringement or not, though sometimes received in order to save time and trouble, is, strictly speaking, inadmissible; and if objected to, ought to be rejected. The Court alone is to decide questions of law."

"Where infringement," said Lord Campbell, C., in the same case, (n) "depends merely on the construction of the specification, it is a pure question of law for the judge; but where the consideration arises, how far one machine, or a material part of one machine, imitates or resembles another in that which is the alleged invention, it generally becomes a mixed question of law and fact, which must be left to the jury."

In deciding whether or not there has been an infringement, the Court will consider all the circumstances of the case. Thus, the fact that the infringer was at one time a workman in the employment of the plaintiff, and familiar with the plaintiff's invention, is a most material circumstance.

In *Crampton v. Patents Investment Company*, (o) Lord Esher, M.R., said: "When you come to talk of an infringement, you must look at all the circumstances of the case. Here you find that the plaintiff was a workman in a manufactory where this patent of the defendant was being carried out. You find that this workman suddenly leaves that employment, suddenly goes into business to sell electric bells, without informing his employer; you find that he not only goes into business to sell electric bells, but that he takes out a patent himself. When you look at that patent of his, about which he never said anything to anybody, you find that it is as nearly as possible the same as the defendant's, or you find that it is so like it that it requires all the skill of the learned counsel who has argued before us to discover any difference in it."

(n) H. of L. Ca. p. 561.

(o) 6 R. P. C. 294.

CHAPTER XXII.

REMEDY OF THE PATENTEE.

ACTION FOR INFRINGEMENT OF THE PATENT RIGHT.

Introductory.

Former Remedies.—The general principles of the law of infringement have already been discussed. The remedies open to a patentee for the protection of his monopoly when invaded will now be considered.

These remedies, to be effectual, must be twofold: they must ensure alike compensation for the wrong sustained, and protection against the recurrence of the injury.

Prior to the Statute of Monopolies, a jurisdiction in protection of patent rights was exercised by the Court of Star Chamber, which treated persons invading such monopolies as being guilty of a contempt of the royal prerogative. (a)

By the Statute of Monopolies, however, it was enacted that all questions affecting the force and validity of letters patent should be heard, tried, and determined in the Courts of Common Law, according to the common laws of the realm, and not otherwise. (b) Thus the jurisdiction of the Star Chamber, which had often been used oppressively, was taken away, and the patentee was left to vindicate his patent rights only in Courts where their validity could be tested by the rules of the common law.

But just as the Court of Star Chamber had proved an unsatisfactory tribunal to the public as against the patentee, so the Courts of Common Law proved unsatisfactory to the holder of the patent right; for while they gave him damages against an infringer, they had no jurisdiction to order an account of the profits of the wrong-doer (if the plaintiff preferred that relief), or an injunction to restrain the recurrence of the injury. Where the

(a) See Webster's *Letters Patent*, p. 42, n.; also Coryton's *Treatise*, p. 262.

(b) 21 Jac. I. c. 3, s. 2.

law thus failed the patentee, equity came to his aid by granting him discovery, an account, and an injunction. (c)

But equity followed the law; therefore, inasmuch as a patent was a legal privilege granted upon the *ex parte* representation of the grantee, and never guaranteed to be valid by the Crown, it was necessary, where an infringer challenged the validity of the patent, to afford him an opportunity of testing the patentee's title in a Court of law before equity granted him final relief. This meant putting the plaintiff on terms to bring an action in one of the Common Law Courts. But time was required to prosecute an action at law, and during the period of delay involved, the continued infringements of the defendant might be doing the patentee most serious injury. Hence it became the practice of the Court of Chancery to grant the further remedy of interlocutory relief for the purpose of protecting the patentee's property till the legal right could be ascertained. (d) To do this, the Court assumed, for the time being, the validity of the plaintiff's patent, and, on that basis, granted an injunction to protect it. But in order that this assumption might be tested, it put the plaintiff on terms to bring an early action at law, so that the defendant might be able to test the validity of the patent right. The inconvenience of this system of relief, under which the patentee was sent first to one Court and then to another before he could get satisfaction, led to enactments which gave jurisdiction to the Courts of Common Law, on the one hand, to grant injunctions, (e) and to Courts of Equity on the other, to determine every question of law and fact incident to the relief claimed. (f)

The effect of this legislation was to withdraw the trial of patent actions almost entirely from the Common Law Courts. Referring to the first of these enactments, the Patent Law Amendment Act, 1852, (g) Lord Westbury, C., in *Young v. Fernie*, said: "I construe the Statute as laying down the rule for the future, that these things shall be heard and determined in this Court. . . . I do not think that anything more inconvenient can be suggested than that where there are mixed questions of law and fact, the one bound up with the other and scarcely capable of being separated, an attempt should be made to cut the cause

(c) See Cotton, L.J., in *Proctor v. Bailey*, 6 R. P. C. 541, 542; 59 L. J. Ch. 12, 13.

(d) *Harman v. Jones*, 1 Cr. & Ph. 299.

(e) See 15 & 16 Vict. c. 83, s. 42;

Gittins v. Symes, 15 C. B. 362; 24 L. J. C. P. 48.

(f) 15 & 16 Vict. c. 86, ss. 61, 62; 21 & 22 Vict. c. 27; 25 & 26 Vict. c. 42, s. 2.

(g) 15 & 16 Vict. c. 83.

in halves, and to send one-half of it to be tried by a jury in a Court of Common Law, reserving the other half for determination in this Court." (*h*)

Present Remedies—The Tribunal.—By Section 30 of the Patents Act of 1883, (*i*) it is now enacted that, "In an action for infringement of a patent, the Court or a judge may, on the application of either party, make such order for an injunction, inspection, and account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit." (*j*) The words in this Act, "Court or a judge," are sufficiently wide to include all the judges of the High Court, whether sitting in the Queen's Bench or Chancery Division, but owing to the additional facilities afforded by the practice on the Chancery side, for the trial of the questions usually involved in patent disputes, actions concerning the infringement of patent rights are now generally tried in that Division.

By the same Statute actions for infringement of letters patent are now tried without a jury, unless the Court directs otherwise. (*k*) Such actions nearly always involve mixed questions of law and fact, and often depend largely on the construction of written documents, which it is the province of the Court to determine. Moreover, any questions of fact involved are generally of a scientific nature, requiring for their solution the close application of a trained mind to the evidence, and are therefore matters as to which a jury would probably in any case follow the direction of the judge. (*l*) Hence now, unless some issue of fraud arises, there would seem to be little reason for having recourse to a jury in the trial of patent actions.

The Court, if it thinks fit, may have the assistance at the trial of a specially qualified assessor, and either party has the right to require that an assessor shall be called in. The remuneration to be paid to such assessor is determined by the Court. (*m*) Hitherto the assistance of an assessor has been little sought.

Although patent actions are now usually entered in the Chancery

(*h*) 1 De G. J. & S. 354; 1 H. of L. 63.

(*i*) The former equitable and common law jurisdictions are now vested in the judges of the High Court, and where the rules of law and equity conflict those of equity are to prevail (see Judicature Act, 1873, s. 25 (11)).

(*j*) See, also, the Judicature Act, 1873, s. 25 (8).

(*k*) Patents Act, 1883, s. 28 (1).

(*l*) As to the unsuitability of a jury for the trial of these cases see Lord Selborne in *Patent Marine Inventions Co. v. Chadburn*, L. R. 16 Eq. 448. A jury was ordered in the following cases: *Young v. Rosenthal*, 1 R. P. C. 29; *Westinghouse v. Lancashire Railway*, 1 R. P. C. 229; *Edge v. Harrison*, 8 R. P. C. 74.

(*m*) Patents Act, 1883, s. 28 (1) & (3).

Division of the High Court, they may be sent down for trial to the Assizes, if, by reason of the residence of the parties or from some other cause, it is more convenient to have a local venue. (*n*)

In addition to the judges of the High Court, the Vice-Chancellor of the County Palatine of Lancaster has jurisdiction to try patent actions. (*o*) But County Courts have not the machinery suitable for trying such cases, and their jurisdiction would seem by implication to be excluded by Section 9 of the Patents Act, 1883. Moreover, as a patent is in the nature of a franchise, a County Court judge could not try any action in which the validity of a patent was put in issue. (*p*)

The Parties to the Action.

Plaintiffs.—In an infringement action the general rule is that all persons having any interest, whether legal or equitable, in the letters patent ought to be before the Court, and where not willing to be plaintiffs should be joined as defendants. The reason is that where an account may be ordered or damages given, it is expedient that the account should be taken or the damages assessed once for all in the presence of all parties interested. (*q*) Hence, where an injunction and delivery up or destruction of the infringing articles only are claimed, one of several owners may sue alone, without joining his co-owners, for such a course in no way prejudices a defendant, (*r*) against whom neither an account nor an enquiry as to damages is sought.

Again, where a patent has been mortgaged, the mortgagor may sue alone without joining his mortgagee. For in equity the mortgagor is still regarded as the owner, and the fact that his rights are to a certain extent vested in another person does not prevent him from suing to stop an infringement of them. (*s*)

So likewise, if an invention can be severed into distinct portions, the owner of one portion may sue alone for infringements of that

(*n*) *Fairbairn v. Household*, 2 R. P. C. 195; *Edmond's Patent*, 6 R. P. C. 355; *Leadbeater v. Kitchen*, 7 R. P. C. 235; *Varey v. Walker*, 16 R. P. C. 596.

(*o*) 53 & 54 Vict. c. 23. This jurisdiction (claimed before) was expressly conferred upon the Lancaster Court by the above Statute. No similar enactment has been passed giving a like jurisdiction to the Palatine Court of Durham.

(*p*) See *R. v. County Court Judge of Halifax* [1891], 2 Q. B. 263; 60 L. J. Q. B. 550; 8 R. P. C. 338.

(*q*) *Bergmann v. Macmillan*, 17 C. D. 423; *Dent v. Turpin*, 2 J. & H. p. 143; 30 L. J. Ch. 495; *Davenport v. Richards*, 3 L. T. (N. S.), 503; *Westhead v. Kesne*, 1 Beav. 295; 8 L. J. Ch. 89.

(*r*) *Dent v. Turpin*, 2 J. & H. p. 143. See, also, *Sheehan v. Great Eastern Railway Co.*, 16 C. D. 59; 50 L. J. Ch. 68. It seems doubtful how far this case is now an authority.

(*s*) *Van Gelder v. Sowerby*, 7 R. P. C. 208; 44 C. D. 374; 59 L. J. Ch. 583; *Fairclough v. Marshall*, L. R. 4 Ex. D. 37.

part, for all damages recoverable in respect of such infringement would in any case belong to him, and not to the owners of the other portions of the patent. (t)

A mere licensee of a patent is not a person having an interest in the patent, he is only a person permitted to use the invention, and thus able to do lawfully that which but for his license would be an unlawful act. He cannot therefore sue an infringer, and the circumstance that his license is exclusive will not entitle him to do so. "The license, pure and simple and by itself," said Fry, L.J., in *Heap v. Hartley*, (u) "never conveys an interest in property; it only enables a person to do lawfully what he could not otherwise do, except unlawfully. I think therefore that an exclusive licensee has no title whatever to sue."

Although a licensee cannot sue third persons for infringements of the patent right, he can, if his licence is irrevocable and exclusive, maintain an action against his licensor where such person acts in breach of the licence so exclusively given. (v)

Nor is a mere agent for the sale of the patented article entitled to bring an action against an infringer. (w)

A legal assignee of the patent may sue for its infringement; (x) but before doing so he should be careful to complete his title by registration, though, once the assignment is registered, he may recover damages as from the actual date of assignment. (y)

The action may also be brought by the assignee or trustee of a bankrupt patentee, (z) and by any person in whom the letters patent are vested as trustee for beneficiaries; (a) also by an equitable assignee. (b)

Where a patent is vested in several persons as tenants in common, and one dies, the right of action in respect of infringements already committed survives to the others, who may recover the whole of the damages. (c)

(t) See Erle, C.J., in *Dunncliffe v. Mallett*, 7 C. B. (N. S.), 209; 29 L. J. C. P. 70; *Van Gelder v. Sowerby*, 7 R. P. C. 208; 44 C. D. 374; 59 L. J. Ch. 583.

(u) 42 C. D. 461; 5 R. P. C. 603; 6 R. P. C. 495; 58 L. J. Ch. 790; see, also, *Derosne v. Fairie*, 1 W. P. C. 155; *Newby v. Harrison*, 1 J. & H. 393; cited 2 H. & M. p. 633; but see contra, *Renard v. Levinstein*, 2 H. & M. 628; *Thorn v. Worthing*, 6 C. D. 415, n.

(v) *Guyot v. Thomson*, 11 R. P. C. 541; [1894] 3 Ch. 388; 64 L. J. Ch. 32; 71, L. T. (N. S.), 416.

(w) *Adams v. North British Railway Co.*, 29 L. T. (N. S.), 367.

(x) *Electric Telegraph Co. v. Brett*, 20 L. J. C. P. 123; 10 C. B. 838.

(y) *Chollet v. Hoffman*, 26 L. J. Q. B. 249.

(z) *Bloxam v. Elsee*, 6 B. & C. 169; 1 C. & P. 558.

(a) R. S. C. Order 16, rule 8.

(b) *Actien Gesellschaft v. Temler*, 16 R. P. C. 447.

(c) *Smith v. London & North Western Railway Co.*, 2 E. & B. 69; Macr. P. C. 203.

Where a patent is granted to two persons jointly and one dies the grant passes by survivorship to the other, in whom the whole interest becomes vested, and who alone thereafter can give effect to any prior agreement entered into by both owners for its assignment. (*d*)

In this respect a patent does not differ from other property. "It was scarcely disputed," said Cozens-Hardy, J., in the *National Company v. Gibbs*, "that a grant, whether by the Crown or by a private individual, of any ordinary species of property to A. B. and C. D., their executors, administrators, and assigns, would create a joint tenancy or joint interest, and not an interest in common. This is not a rule of tenure or of real property law. It applies to an assignment of a policy of assurance as much as to an assignment of a term of years. But it was urged that letters patent are of such a peculiar quality and nature that different principles of interpretation ought to be applied. I am unable to follow this argument. The right or privilege granted by the Crown by the letters patent is an exception from the general prohibition contained in the Statute of Monopolies. It is for all purposes to be regarded as property. It passes in bankruptcy as part of the assets of a bankrupt. On the death of a patentee duty is payable on it as part of the assets of the deceased, and I can see no justification in principle, nor has any authority been produced, for holding that a grant for letters patent to two persons, their executors, administrators, and assigns, creates anything more than a joint interest, which will survive on the death of one of them, unless there has been severance of the joint interest." (*e*)

Defendants.—The actual infringer is the proper defendant. Thus, where the infringement occurs in the course of work done under a contract, the contractor who carries out the work, and not the architect who indicates what is to be done, is the person who ought to be sued. (*f*) Custom House agents, who arrange for the storing and transshipment in an English port of an article which infringes an English patent, do not thereby make themselves liable as infringers, and ought not to be joined as defendants. (*g*) But carriers who bring infringing articles into England are liable, and may be restrained by injunction. (*h*)

(*d*) *National Co. v. Gibbs*, 16 R. P. C. 339:
but see this case in C. A. 16 T. L. R. 348.

(*e*) *Ibid.* p. 343.

(*f*) *Denley v. Blore*, 38 *London Journal*,

(*g*) *Nobel's Explosives Co. v. Jones*, 8
App. Ca. 5; 50 L. J. Ch. 582.

(*h*) *Washburn Manufacturing Co. v.*
Cunard Co., 6 R. P. C. 403.

A person who merely prepares the materials from which the infringing article is made is not liable as an infringer, and should not be joined as a defendant. (i)

Thus, where a machine had been altered so as, in fact, to become an infringement of letters patent, it was held that an action would not lie against a smith who did nothing more than find the materials required for the alteration. (j)

The directors of a public company may be liable for acts of infringement committed by workmen employed in their service, even where such workmen have acted in disobedience to express orders. Although the master in whose employment the infringement is committed is the proper defendant, his servants by whom he has committed the breach of patent right are equally liable, and may themselves be joined as defendants. If so joined, it is no answer for them to shew that in what they did they only conformed to the orders of their employer. (k)

In *Sykes v. Howarth*, (l) where the patent 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 and so made him his agent for putting them on, 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.

Where an infringing manufacturer sells the patented article, both the manufacturer who makes and the purchaser who uses the infringement are liable to the patentee and may be joined as co-defendants in one action, (m) the patentee being entitled to an account against the manufacturers and damages against the person using the article wherever it be found. (n) For a judgment obtained against the manufacturer does not operate to license the use of the illicit articles sold by him in the hands of purchasers. So long as the articles are used there is continuing damage, and the patentee is entitled to follow them into every man's hand. (o)

But where a plaintiff company sued the makers of piratical

(i) *Townsend v. Haworth*, 12 C. D. 831, n.

(j) *Savage v. Brindle*, 13 R. P. C. 266.

(k) *Betts v. Neilson*, 6 N. R. 221; *Betts v. De Vitre*, L. R. 3 Ch. 429; 37 L. J. Ch. 325; *Adair v. Young*, 12 C. D. 18.

(l) L. R. 12 C. D. 826.

(m) *Proctor v. Bennis*, 36 C. D. 740; 4 R. P. C. 333; 57 L. J. Ch. 11.

(n) *Penn v. Bibby*, L. R. 3 Eq. 308; 36 L. J. Ch. 277.

(o) *Ibid.*

articles, and on motion for an interlocutory injunction accepted an order under which the defendants paid certain sums into court to represent royalties, and undertook to keep an account till the trial, it was held that no interlocutory injunction could be obtained by the plaintiff company against customers who had purchased the infringing articles from the first defendants, to restrain them from using such articles. (*p*)

Although foreign subjects committing acts of infringement in the United Kingdom are liable to be sued therefor, (*q*) the Court has refused to allow property of a foreign Sovereign which was an infringement of an English patent to be detained in this country against the will of that Sovereign (*r*).

It frequently happens that a patentee finds that his rights are being infringed by several persons at the same time. In such case he is in the difficult position of having to either commence a number of actions at once, or incur the risk if he only proceeds against one infringer in the first instance, of being refused interlocutory relief in the other cases on the ground of delay. The most prudent course for a patentee to adopt under such circumstances was indicated as follows by Wood, V.C., in *Bovill v. Crate*. (*s*) "After getting information of case after case of infringement, he might 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. That is one way in which the difficulty might be avoided."

In the *North British Rubber Co. v. The Gormully, etc., Company*, (*t*) it was argued that a patentee acting as above suggested might find himself in great difficulties, as the infringers might ignore his communications altogether, or meet them with a flat refusal.

(*p*) *Pneumatic Tyre Co. v. Goodman*, 13 R. P. C. 723.

(*q*) *Caldwell v. Vanolissengen*, 9 Hare, 415; 21 L. J. Ch. 97.

(*r*) *Vavasseur v. Krupp*, L. R. 9 Ch. 351.

(*s*) L. R. 1 Eq. 388, p. 391.

(*t*) 12 R. P. C. 17.

On this Chitty, J., said: "According to my experience of mankind, that kind of offer is not met with the absolute refusal which counsel for the plaintiff assumed it would be encountered with. Then if there is no answer, and the defendants, or proposed defendants, are all desirous of throwing obstacles in the way of the plaintiff, and putting him to expense, the course appears to be that the plaintiff must issue as many writs as he finds necessary." (u)

In *Edison Bell Phonograph v. Hough*, (v) the plaintiffs stated that they had been harassed by numerous infringements by persons of no substance, who, when sued, contested the matter up to trial, and then disappeared. Stirling, J., while refusing an interlocutory injunction, made allowance for the hardship from which the plaintiffs suffered by requiring the defendant to pay a sum into court, and expediting the trial of the action.

Joinder of Parties.—Where parties who ought to have been joined as plaintiffs or defendants are not before the Court, the proper course is for the Court to direct that such parties shall be joined, and not to dismiss the action on the ground of their absence. (w). Whether any additional party ought to be joined will depend on the special circumstances of each particular case; the rule being, that if the presence of any further party is necessary to enable the Court to effectually and completely adjudicate upon and settle all the questions involved, such party should be joined. (x) Where a defendant, after the issue of the writ, sold his business to a company, and sought to join that company as co-defendants, leave was refused. (y)

But where a defendant who had been indemnified after action by the makers of articles, the use of which was complained of, applied to join such makers (under Order 16, rule 48) as co-defendants; this was done and costs were eventually given against such co-defendants on appeal. (z)

The Court will not, however, compel a plaintiff patentee to sue persons other than the original defendant, merely because such other persons are equally guilty of infringement.

In *Moser v. Marsden*, (a) the plaintiff sued the user of certain weaving machines, which he alleged were infringements of his

(u) 12 R. P. C. p. 21.

(v) 11 R. P. C. 594.

(w) *Van Gelder v. Sowerby*, L. R. 44 C. D. 391, p. 394; R. S. C. Order 16, rule 11.

(x) R. S. C. Order 16, rule 11.

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

(z) *Edison v. Holland*, 3 R. P. C. 396; L. R. 33 C. D. 497; L. R. 41 C. D. 28; 6 R. P. C. 243.

(a) [1892] 1 Ch. 487.

patent. Thereupon the maker of the machines (who claimed to manufacture them under a foreign patent of his own) sought permission to be joined as a defendant in the action, fearing that the original defendant would not properly contest the issue, and alleging that a verdict for the plaintiff would prejudice his interests by frightening away customers.

The Vice-Chancellor of Lancaster having made the order under a rule of the Palatine Court, identical with Order 16, rule 11, the Court of Appeal reversed his decision. "Can it be said," asked Lindley, L.J., "that the rule prevents the plaintiff from proceeding against a defendant without having to litigate with everybody who may be in any way affected, however indirectly, by the action? It appears to me that it does not. The counsel for the applicant grounded his argument on the allegation that *Montfort's* interest would be affected by the decision in this action. It is true that his interest may be affected commercially by a judgment against the defendant, but can it be said that it would be legally affected? Can we stretch the rule so far as to say that whenever a person would be incidentally affected by a judgment he may be added as a defendant? No case has been cited that goes so far as that: *Vavasseur v. Krupp* (b) and *Apollinaris Co. v. Wilson* (c) are the nearest to the present case. But in both those cases the proceedings affected the property of persons not before the Court. I can understand the application of the rule where the property of a third party is affected. He may well say, 'I am not to be deprived of my property in my absence.' But this case does not come up to that. In my opinion the Vice-Chancellor has construed the rule too widely." (d)

The Writ.

Commencement of the Action.—No action can be brought until the patent is sealed; nor in respect of any infringements committed prior to the publication of the complete specification. (e) In an infringement action the writ is generally endorsed with a claim for an injunction, an account or damages, and the delivery up or destruction of all infringing articles in the possession of the defendant. (f)

(b) 9 C. D. 351.

(c) 31 C. D. 632.

(d) [1892] 1 Ch. pp. 489, 490.

(e) Patents Act, 1883, ss. 13, 15.

(f) The rules governing the service of

the writ are the same as those applicable to other actions in the High Court. As to endorsements, see forms, Appendix IV., post.

The defendant has eight days in which to enter an appearance after the service of the writ. Prior to the appearance of the defendant no further step can be taken in the action by the plaintiff without the leave of the Court. The plaintiff may, however, apply *ex parte* for an interim injunction. (g) Such an application should not be made except in cases of the greatest urgency. If made at all it should be made at once, otherwise it will not be granted. (h) The application may even be made before the service of the writ and leave obtained to serve notice of motion for an injunction with the writ, so as to save the time which would be lost in waiting for the defendant to appear. (i)

After the defendant has appeared the plaintiff may apply to the Court for an interlocutory injunction. In the Queen's Bench Division the application is made on summons to a judge at Chambers; in the Chancery Division, on motion in open court. (j) The object of an interlocutory injunction is to restrain the defendant until the trial of the action, or further order, from continuing the infringement complained of. An application for an injunction before the hearing of the action is a matter of practice and procedure within Section 1 sub-section 4 of the Judicature Act, 1895, and an appeal against its refusal lies direct to the Court of Appeal. (k)

The principles upon which the Court proceeds in granting or refusing this relief will now be considered in detail.

Interlocutory Relief.

Principles upon which the Court acts.—Where a patentee applies to the Court for relief by way of an interlocutory injunction, the Court, in adjudicating upon the application, seeks as far as possible to maintain the *status quo* and avoid interfering with the respective positions of the parties who are subsequently to decide the questions in issue at the hearing. (l) The Court considers what it can most satisfactorily do provisionally, and especially looks to the degree of convenience and inconvenience to the parties concerned.

In *Thomson v. Hughes*, (m) where the plaintiff's patent was due to expire in six weeks from the date of the motion, North, J., in

(g) *Moser v. Jones*, 10 R. P. C. 368.

(h) *Greer v. The Bristol Tanning Co.*, 7 R. P. C. 1.

(i) R. S. C. Order 52, rule 9.

(j) A Master has no power to grant an injunction: see Order 54, rule 12.

(k) *McHarg v. Universal Stock Exchange*, [1895] 2 Q. B. 81; 64 L. J. Q. B. 498.

(l) Per Lord Langdale, M.R., in *Bridson v. McAlpine*, 8 Beav. 230.

(m) 7 R. P. C. 71, p. 76.

refusing an injunction on the balance of convenience, said: "If the defendant goes on making this card, and the plaintiff succeeds, the plaintiff will get full relief by way of damages, or by an account of profits in respect of all cards of this pattern made by the defendant between the present time and the expiration of the patent, which is some six weeks or so hence. On the other hand, if an injunction is granted, and the defendant should turn out to be successful, upon the ground that what he is doing is not an infringement of the patent, which is not a point that has been actually decided in any suit commenced for that purpose, he would be entitled to damages under the undertaking of the plaintiff as to damages, but I do not see how the Court could arrive at a fair solution of the question what damages really had arisen; how much worse he really was by reason of the injunction having been granted, and his having been thereby prevented from undertaking work which he otherwise might have had. Of course the profit he might have got by such work as could be ascertained could be given, but it would be impossible to say what orders he might have got if he could have executed them, but which he has not got because he could not, and further, what other things might have been done by him, in respect of which the power of executing these orders deprived him of the opportunity of earning money. It seems to me that the plaintiff can lose little, if anything, if I do not grant an injunction, and he is successful. The defendant may lose a great deal if I grant an injunction and he should turn out to be successful."

The Court will not grant an injunction lightly, but will carefully consider the validity of the patent and whether or not the acts complained of are infringements. (n) For the Court proceeds upon the assumed validity of the patent, (o) and if that should subsequently be defeated at the trial great hardship might be imposed on the defendant by an interlocutory injunction.

In *Holophane v. Berend*, (p) it was urged by the plaintiffs that the defendants' trade being still of slender dimensions, no great harm could result from the granting of an injunction against them, whereas the plaintiffs' trade, which was large, would be seriously prejudiced by the refusal of an injunction, owing to the inferiority of the goods with which the defendants were flooding the market. (q) Kekewich, J., however, refused the injunction, being satisfied that

(n) *Bridson v. M'Alpine*, supra.

(o) Per Lord Cottenham in *Bacon v. Jones*, 4 Myl. & Cr. p. 436.

(p) 15 R. P. C. 18.

(q) Cf. Turner, L.J., in *Davenport v. Jepson*, 4 De G. F. & J. p. 448.

there was a serious issue to be tried as to the validity of the patent.

In the *Electric Telegraph Company v. Nott*, (r) the plaintiffs were the owners of three patents of eight, five, and three years' standing respectively. The Court refused to grant them an interlocutory injunction, as there appeared to be great doubt on the question of the alleged infringement. Lord Cottenham, C., said: "Where the application to the Court is to protect and assist a legal right, if there be a doubt as to the validity of the legal right, or as to the acts complained of being a violation of such legal right, it becomes the Court to be extremely cautious in administering its equitable jurisdiction by way of injunction, and such caution is requisite for two reasons; first, because if the legal right ultimately fail, or if the acts complained of turn out to be no violation of the legal right, the Court has then interfered without any authority whatever, the authority being merely derivation from the legal right, and in aid and protection of it. Secondly and principally, because in this Court there is no comparison between the evil of an error in refusing an injunction, and the evil of an error in granting an injunction. That in ordinary cases an injunction, if improperly granted, causes infinitely more mischief to the defendant than the delay of granting the injunction can possibly cause to the plaintiff. The Court ought to be extremely cautious, and not, as a general rule, to give its aid to the legal right by injunction unless satisfied—the legal right being disputed—that in the result such legal right would be established, or—the legal right not being disputed—that the acts complained of were a violation of it."

In *Shillito v. Larmouth & Company*, (s) the plaintiffs moved for an interlocutory injunction upon a patent of ten years' standing. The defendants denied the novelty of the invention and the infringement. Bristowe, V.C., considered the infringement sufficiently made out, and granted the injunction. On the question of infringement, he said that it was not necessary to satisfy the Court beyond all doubt on the point. "The fair rule to go by is this: Is the Court satisfied, for the purposes of the interlocutory application, that the alleged infringement is sufficient to satisfy the Court that there is a *prima facie* case of actual infringement which will be proved at the trial when the case is tried out? . . ."

Even where infringement has not yet taken place, the plaintiff may be entitled to an injunction if he can satisfy the Court that

(r) 2 Coop. 41.

(s) 2 R. P. C. 1.

infringement is threatened. For the Court will interfere to restrain a threatened injury.

“On principle,” said Jessel, M.R., in *Frearson v. Loe*, (t) “there is no reason why a patentee should not succeed in obtaining an injunction without proving actual infringement. I think so 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.”

In *Dowling v. Billington*, (u) the only infringements proved were infringements either between the filing and acceptance of the specification, or after action brought; yet, as this shewed an intention to infringe on the part of the defendant, an injunction was granted, although under the circumstances no damages could be recovered.

No injunction will be granted, however, if the Court is satisfied that the defendant does not intend to continue his infringements. (v) Still, actual infringement is presumptive evidence of an intention to continue that course of conduct, and the Court will not refuse an interlocutory injunction in such case merely because the defendant at the hearing promises to discontinue his infringements. (w)

“Undoubtedly,” said Cotton, L.J., in *Proctor v. Bailey*, (x) “wherever a person has done a wrongful act in infringing a patent, *primâ facie* that is ground for granting an injunction, because when a man has done a wrongful act the probability (unless there is anything which prevents that probability arising) is that he will continue it; and the patentee who is injured by that act is entitled, in a Court of Equity, to prevent a repetition of that wrongful act.”

(t) L. R. 9 C. D. 65; 26 W. R. 138; 27 W. R. 183.

(u) 7 R. P. C. 191.

(v) *Proctor v. Bailey*, 6 R. P. C. 542; L. R. 42 C. D. 390; 59 L. J. Ch. 12; 38

W. R. 100; 61 L. J. (N.S.), 752; *Dunlop Pneumatic Tyre Co. v. Stone*, 14 R. P. C. 263.

(w) *Losh v. Hague*, 1 W. P. C. 200.

(x) 6 R. P. C. p. 542.

In *Lyon v. the Mayor of Newcastle*, (y) however, where the defendants, though in possession of infringing articles, had, when written to, denied actual user, and offered an undertaking not to use the infringing machines pending the trial of the action, Kekewich, J., held a motion for an interlocutory injunction unnecessary, and dismissed it with costs, although the validity of the patent had been established in a prior action.

Where the patent in protection of which an interlocutory injunction is sought is about to expire the relief will usually be refused. (z) But where numbers of infringing articles have been fraudulently manufactured, at the close of a patent term, prior to its expiration, with the object of flooding the market the moment the term has run out, the Court will grant an injunction restraining the sale of such articles; and this even after the patent has expired. (a)

In *Crossley v. Derby Gas Company*, Lord Brougham, C., said: (b) "The point has never yet been decided; but I am of opinion that the Court would interfere, even after the patent has expired, to restrain the sale of articles manufactured previous to its expiration in infringement of a patent right; and that a party would not be allowed to prepare for the expiration of a patent by illegally manufacturing articles, and immediately after its expiration to deluge the market with the produce of his piracy; and thus reaping the reward of his improbus labour in making it. The Court would, I say, in such case restrain him from selling them even after the expiration of the patent."

When the Court will Grant Relief.—It will now be convenient to consider the cases in which the Court, if infringement is made out, will generally grant an interlocutory injunction. These may be grouped under the following heads: (1) When the validity of the patent has already been established in a previous action. (2) When the patent is of old standing and the enjoyment under it has been uninterrupted. (3) When the validity of the patent is not in issue.

1. *When the validity of a patent has been established in a previous action.*

In this case, once the Court is satisfied that infringement has taken place, the plaintiff is entitled to an interlocutory injunction.

(y) 11 R. P. C. 218.

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

(a) *Crossley v. Derby Gas Co.*, 4 L. J. Ch. 26.

(b) *Ibid.* Cf. Turner, L.J., in *Smith v. London & South Western Railway Co.*, Kay, 416; 23 L. J. Ch. 562.

A prior decision of the Scottish Courts, (c) and even the award of an arbitrator, (d) in favour of the patentee have been held sufficient proof of the validity of the patent to justify the application of this rule.

The reason of this rule was thus explained by Lord Romilly, M.R., in *Bovill v. Goodier*: (e) "The law attaches superior rights to a patentee who has established the validity of his patent, to those which belong to a patentee who has not done so. The former stands on a different footing, and though the patent may be contested by fresh persons, he will receive protection until the invalidity of it is shewn. The distinction hitherto made by Courts of Equity has been that where the validity of the patent has not been the subject of any legal proceedings, the patentee must prove its validity at law before the Court of Equity will protect him; but having once established its validity, then the Court of Equity will protect him against another person until that person proves its invalidity."

"In what position would a patentee be placed," said Wood, V.C., in *Davenport v. Goldberg*, (f) "if he is to try his right *ab initio* against every separate infringer *in infinitum*? That certainly is a view of his rights which has never been adopted by this Court." (g)

The patentee's right to relief by way of interlocutory injunction is all the stronger if he can shew that the defendant has in fact been indemnifying a defendant in the former action; (h) or that the defendant is a mere cover for a former infringer, who is thus seeking to deprive the patentee of the benefits which have accrued to him under an earlier action. (i) In such case an interlocutory injunction has been upheld, notwithstanding the circumstance that an appeal in the first action had been taken to the House of Lords, and the second defendants offered to pay royalties pending such appeal. (j)

Where the prior action relied upon has been won by the patentee through the defendant failing to appear at the trial, the same inference of validity will not be drawn in the patentee's favour. But where this happened in two successive actions

(c) *Dudgeon v. Thompson*, 30 L. T. (N. S.), 244.

(d) *Lister v. Eastwood*, 26 L. T. 4.

(e) 35 L. J. Ch. p. 435; L. R. 2 Eq. 200.

(f) 2 H. & M. 286.

(g) See, also, *Edison-Bell v. London*

Phonograph Co., 11 R. P. C. 193; *Moser v. Marsden*, 10 R. P. C. 368.

(h) *Farbenfabriken v. Dawson*, 8 R. P. C. 397.

(i) *Moser v. Sewell*, 10 R. P. C. 365.

(j) *Ibid.*

brought by the same plaintiff, Chitty, J., held that the patent was sufficiently established to justify the granting of an interlocutory injunction against a new infringer. (k)

In the *Pneumatic Tyre Company v. Marwood*, (l) it was suggested that the value of a previous decision in favour of the patentees must be discounted, because the former defendants had not been in a position to call the best expert evidence. But the Court declined to allow any such suggestion to minimize the weight attaching to the judgment already obtained, and granted an injunction.

The circumstance that a patentee has compromised actions previously brought by him in respect of the same patent, is not in his favour, but will not necessarily disentitle him to interlocutory relief. The Court in such case may still grant an injunction if satisfied that the patentee may fail to obtain compensation should he be left to his remedy in damages. (m)

2. *When the patent is of old standing, and the enjoyment under it has been uninterrupted.*

The rule that prolonged possession under colour of title is sufficient *primâ facie* evidence on which to base an interlocutory injunction has long been recognized by Courts of Equity. (n)

In *Hill v. Thompson*, (o) the leading case as to this, Lord Eldon, while dissolving an injunction granted on a patent of three years' standing and one year's user, laid down the rule as follows: "The principle upon which the Court acts in cases of this description is the following; where a patent has been granted, and there has been an exclusive possession of some duration under it, the Court will interpose its jurisdiction, without putting the party previously to establish the validity of his patent by an action at law. But where the patent is but of yesterday, and, upon an application being made for an injunction, it is endeavoured to be shewn in opposition to it that there is no good specification, or otherwise that the patent ought not to have been granted, the Court will not, from its own notions respecting the matter in

(k) *Edison-Bell Phonograph v. Bernstein*, 14 R. P. C. 158.

(l) 13 R. P. C. 347.

(m) *Bracher v. Bracher*, 7 R. P. C. 421. In this case the defendants were a company of small means who might not have

been able to pay damages given against them.

(n) As to this doctrine of equity, see Lord Eldon in the *Universities of Oxford and Cambridge v. Richardson*, 6 Ves. 689.

(o) 3 Mer. 622; 1 W. P. C. p. 231.

dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained in a previous trial.”

So too in *Harmer v. Plane*, (p) where an injunction had been granted on a patent of thirteen years' standing, Lord Eldon, C., upheld the injunction on appeal, although there was strong ground for contending that the patent was bad on the face of the specification. “Where the public have permitted a reasonably long and undisputed possession under colour of the patent,” said the learned Chancellor, “the Court has thought, upon the fact of that possession proved against the public, that there is less inconvenience in granting the injunction, until the legal question can be tried, than in dissolving it at the hazard that the grant of the Crown may in the result prove to have been valid. The question is not really between the parties upon the record; for, unless the injunction is granted, any person might violate the patent; and the consequence would be that the patentee must be ruined by litigation. In the case of *Boulton v. Bull*, (q) therefore, though a case of great doubt, upon which some of the ablest judges in *Westminster Hall* disagreed, yet, upon the ground of the possession by the patentees against all mankind, the injunction was granted until the question could be tried.”

In *Beeston v. Ford*, (r) Lord Lyndhurst, C., said: “There may be considerable doubt as to the validity of a patent, still, if there has been a long exclusive enjoyment, the doctrine of the Court is that an injunction shall go to protect the patent until the question of its validity is duly determined at law.”

In *Bickford v. Skewes*, Shadwell, V.C., acted on this rule and protected by injunction a patent of six years' standing, holding that the Court was bound to look to the fact of such enjoyment under the patent as a sort of practical answer to theoretical objections taken to the specification. (s)

In *Stevens v. Keating*, (t) the plaintiffs were the assignees of two patents of twelve and six years' standing respectively. The defendants denied the infringement and said that the plaintiffs' specification was bad. But Shadwell, V.C., granted the injunction, and on appeal Lord Cottenham, C., confirmed the order. His lordship said: “In the case of patents the rule steps in and says long and uninterrupted possession shall be *primâ facie* evidence of title, which ought to be respected, and it comes,

(p) 14 Ves. 132.

(q) 2 H. Blackstone, 453; 3 Ves. 140.

(r) 2 Coop. Ch. Ca. 68.

(s) 1 W. P. C. 213; see, also, S. C. 8

L. J. Ch. 188.

(t) 2 W. P. C. 176; 2 Phill. 333.

therefore, to the case I have so frequently had occasion to advert to. *Primâ facie* in that state of the case the Court is not at liberty to exercise a discretion as to whether the patent is good or not. . . . Here I have a patent of 1834, very extensively acted on from the year 1834 to 1846, under which the plaintiff has not only claimed, but, as far as it appears, exclusively exercised the right of manufacturing and selling the composition of those three substances; and it comes therefore within the rule of the cases referred to, that under such circumstances, though the Court will give every facility to the defendant that he may not be unnecessarily restrained for a longer period of time than may be absolutely essential to ascertain the right by trial at law, yet that it is a case in which there is that long and undisturbed possession under a patent right which precludes the Court, according to the practice laid down, from refusing to interfere by injunction till the right shall be ascertained by trial at law." (u)

In *Muntz v. Foster*, (v) the patent was disputed, and there was conflicting evidence as to its novelty, but it was a patent of eleven years' standing, and Knight-Bruce, V.C., granted an injunction. On appeal, Lord Lyndhurst, C., in affirming the order, said: "The patentee has been in possession of his exclusive privilege for several years, and the Court will not, on any suggested defect of the specification, allow that privilege to be disturbed, until the title has been decided in a court of law."

In *Caldwell v. Vanvlissengen*, (w) objections were taken to the specification, but the Court granted an injunction, on the ground of possession for eleven years. Turner, V.C., said: "The question, whether the Court will interfere to protect a patentee before he has established his right at law, or will suspend its interference until the right at law has been established, appears to me to depend on very simple principles. It is part of the duty of this Court to protect property pending litigation; but when it is called upon to exercise that duty, the Court requires some proof of title in the party who calls for its interference. In the case of a new patent this proof is wanting: the public, whose interests are affected by the patent, have had no opportunity of contesting the validity of the patentee's title, and the Court therefore refuses to interfere until his right has been established at law. But in a case where there has been long enjoyment under the patent (the

(u) See also the same learned judge in the *Electric Telegraph Co. v. Nott*, 11 Jur. 273; 16 L. J. C. P. 174; 2 Coop. 41.

(v) 2 W. P. C. 95.

(w) 9 Haro. 415; 21 L. J. Ch. 97.

enjoyment, of course, including use), the public have had the opportunity of contesting the patent; and the fact of their not having done so successfully affords at least *primâ facie* evidence that the title of the patentee is good; and the Court therefore interferes before the right is established at law. In the present case, I think the plaintiffs have proved such a case of enjoyment under the patent, and of their title having been maintained at law against the several attempts which have been made to impeach it, that the Court is bound at once to interfere for their protection, unless there are sufficient grounds for withholding its interference."

In *Newall v. Wilson*, (x) the defendants relied on an alleged publication of the invention three years before the date of the patent. The patentee had already on four occasions successfully vindicated his patent rights against infringers; but on none of those occasions had the evidence now relied on been given. The patent, however, was nearly twelve years old, and the Lords Justices (reversing the Master of the Rolls) granted an interlocutory injunction on the ground of long enjoyment, notwithstanding the possibility of the fresh evidence upsetting the patent. (y)

In *Davenport v. Jepson*, (z) Turner, L.J., dealing with a patent of eleven years' standing, said: "The rule is well settled that this Court assumes the validity of a patent and grants an injunction where there has been long and quiet enjoyment under it." (a)

In *Heugh v. Magill*, (b) an injunction was sought to restrain the infringement of a patent which was for improvements in a machine the subject of a prior substratum patent, and which could not be used without the license of the original patentees. The patent in protection of which an injunction was sought had been taken out ten years before this application, but the original patent had only expired the year before. In these circumstances, Jessel, M.R., held that the undisturbed possession of the new patent did not commence until the substratum patent had expired, and that there had not been a sufficiently long enjoyment to entitle the plaintiff to an injunction.

In *Briggs v. Lardeur*, (c) the patent was of ten years' standing,

(x) 2 De G. M. & G. 282; 19 L. T. 161.

(y) See the judgment of Lord Cranworth.

(z) 1 N. R. 173, 307; 4 De G. F. & J. 440, at 447.

(a) See, also, *Betts v. Menzies*, 3 Jur.

(N. S.), 357, and *Davenport v. Richards*, 3 L. T. (N. S.), 503, in both of which cases injunctions were granted by Wood, V.C., on patents of nine years' standing.

(b) W. N. 1877, p. 62.

(c) 1 R. P. C. 126.

and its validity during that period had not been called in question. In granting an injunction, Pearson, J., said: "Whether this patent is a good patent or not, I think I ought not to consider at all on the present motion, unless I can see on the face of this patent that it is so irretrievably and hopelessly bad that it is absolutely impossible that it could be supported. In a case so plain as that, I doubt not that I might consider it on interlocutory motion; but when the patent has been in existence for ten years, and has not been challenged at the end of ten years, I think this Court ought to give credit to the patent and ought to assume, at all events upon the interlocutory motion, that for the purpose of the interlocutory motion the patent is a good patent; of course leaving it entirely open until the case comes on for trial to determine that the patent is as bad a patent as ever was taken out." (d)

Long Possession means Undisturbed Possession.—To entitle the patentee to the protection of an interlocutory injunction, he must shew not only long enjoyment but likewise undisturbed enjoyment. If the defendant can prove to the Court that the invention of which the plaintiff claims the exclusive enjoyment has been openly used by other persons during the term of the letters patent, this will rebut the inference which the Court usually makes in the patentee's favour from the fact of the long enjoyment. Thus, in *Collard v. Allison*, (e) although the patent was one of twelve years' standing, and the infringement admitted, the Court refused an injunction when it was shewn that the patentee's possession under the patent had not been exclusive, Lord Cottenham laying it down that the absence of exclusive enjoyment neutralized the length of time for which a patent had been enjoyed, and created an exception from the rule stated by Lord Eldon in *Hill v. Thompson*.

In *Curtis v. Cutts*, (f) where the patent was more than thirteen years old, and its validity was the only question in issue, Lord Cottenham, after observing that if the enjoyment had been exclusive the patentee would have been entitled to an injunction, said: "But the rule upon which the Court acts in granting an injunction, where the validity of the patent alone is disputed, requires, not merely that there shall have been possession and enjoyment under the patent, but such possession and enjoyment must have been undisturbed and exclusive. Now, the answer negatives an exclusive

(d) See, also, *Rothwell v. King*, 3 R. P. C. 379, where the patent was one of six years' standing.

(e) 4 Myl. & Cr. 487.

(f) 8 L. J. Ch. 184; 2 Coop. Ch. Ca. 60.

possession of the privilege to make the machines. It states that since the patent was granted, persons, not claiming under the patent, have manufactured machines upon the principle sought to be protected by it. There is an end, therefore, of the case of exclusive possession and enjoyment. The injunction granted by the Vice-Chancellor must be dissolved."

Disturbance of the patentee's enjoyment will not, however, defeat his right to an injunction where the patentee has taken proceedings successfully against the prior infringers. For although the establishment of a patent's validity at law is not conclusive against any other subsequent infringer, and will not preclude such infringer from disputing the patent, still, the Court considers the success of a patentee in vindicating his patent right as a strong circumstance in his favour when he seeks relief by interlocutory injunction. (*g*)

It is not necessary that a patentee should actually have gone to trial in vindication of his patent right against infringers. If they have submitted and recognized his title, that will be sufficient.

In *Rothwell v. King*, (*h*) it was proved that the patent had been infringed on four prior occasions, and that on each of those occasions the infringers had desisted, so that the patentee had not in any case proceeded to the trial of an action. On this Bristowe, V.C., said: "It is quite true that in those cases there may not have been actions, but if a party is doing a thing, and it is brought to their knowledge that they are disturbing another man's patent, and they acquiesce in the view that they are doing so, then an action is not necessary. It would be a very hard thing to hold that no compromise, or arrangement, or giving up, or acquiescence, would do unless there was an action."

Enjoyment means User.—Enjoyment of a patent right must include user. If the patent for which protection is sought is of old standing, but has only recently been put in use by the patentee, the rule as to the Court favouring long enjoyment does not apply.

In *Caldwell v. Vanvlissengen*, (*i*) Turner, V.C., said long enjoyment, of course, included use. In *The Electric Telegraph Company v. Nott*, (*j*) Lord Cottenham, C., said: "Where a patent has existed for some time and there has, during this time, been a user under the patent, it is an assertion of a title against all the world."

(*g*) *Davenport v. Jepson*, 4 De G. F. & J. 440; *Hayward v. Pavement Co.*, 1 R. P. C. 207; *United Telephone Co. v. St. George*, 3 R. P. C. 33.

(*h*) 3 R. P. C. 379.

(*i*) 9 Hare, 415; 21 L. J. Ch. 97; cf. *Shadwell*, V.C., in *Stevens v. Keating*, 2 W. P. C. 176; 2 Phill. 333.

(*j*) 2 Coop. Ch. Ca. 47.

In *Plimpton v. Malcolmson*, (k) the plaintiff's patent was one of ten years' standing, but no evidence of user under the patent was given, except user of recent date. Jessel, M.R., in refusing an interlocutory injunction, said: "Where a patentee comes to this Court for interim protection on the ground of previous enjoyment, he must shew that there has been an actual public user of his patent. In this case there is no evidence of actual user for any number of years."

No Injunction where the Patent is Recent and its Validity in Dispute.—The general rule as to long enjoyment implies of necessity the converse proposition, that where the patent is new, is "but of yesterday, and it is endeavoured to be shewn in opposition to it that there is no good specification, or otherwise that the patent ought not to have been granted," (l) the Court will not interfere in its defence.

Coles v. Baylis (m) is the only case in which this rule appears to have been departed from. There the plaintiff's patent was only of eighteen months' standing. The defendant disputed its validity, and objected that the specification incompletely disclosed the knowledge in the possession of the plaintiff at the time when the patent was taken out. Bacon, V.C., however, held that the defendant had by his own conduct proved the novelty of the invention, and granted an injunction, although there was an intricate question of law to be tried at the hearing.

With *Coles v. Baylis* may be compared the cases of *Lister v. Norton* (n) and *Jackson v. Needle*. (o) In the former case, Chitty, J., discussing the meaning of the word "recent" as applied to a patent, said: "As to what is exactly a recent patent, and what is a patent of sufficient account to support an injunction, that is a matter, no doubt, more or less of discretion. But the discretion is limited by the practice; and, according to my recollection of the practice, a patent three years old would not be sufficient where it is disputed."

In *Jackson v. Needle*, (o) Bacon, V.C., made an order for an interlocutory injunction on a patent of eight months' standing of which the validity was disputed, but the Court of Appeal discharged the order. "The Court," said Baggallay, L.J., "abstains from interfering by injunction in the case of a recently dated patent where there is really a substantial question to be tried."

(k) L. R. 20 Eq. 37.

(l) See Lord Eldon in *Hill v. Thompson*, 3 Mer. 624.

(m) 3 R. P. C. 178.

(n) 1 R. P. C. 114.

(o) *Ibid.* 174.

“Where the proprietor of recently granted letters patent,” said Kekewich, J., in *Holophane v. Berend*, (p) “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 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.”

3. *When the Validity of the Patent is not in Issue.*

Where the validity of the patent is not in dispute different considerations arise. Here, as between the parties to the action, it must be assumed that the plaintiff's patent right is good, and consequently, in such case, where the infringement is clearly established, the Court will protect even a recent patent by interlocutory injunction.

The issue of validity may be excluded, either through the defendant not electing to raise it, or through the relations of the parties being such that, as against the defendant, the Court must assume it in the plaintiff's favour.

In *Clarke v. Ferguson*, (q) the plaintiff's patent was not disputed by the defendants, who were the manufacturers employed by the plaintiff to make his patented articles, but the defendants alleged that they had invented an improvement, and were applying for a patent, and asked that the two patents might be vested in trustees for the benefit of both parties. Though the patent was only three months old, Stuart, V.C., granted an injunction.

The defendant, as in the case last mentioned, may, by reason of some special relation towards the plaintiff, be precluded from disputing the validity of the patent. Thus, he may be a licensee working under a license granted by the patentee, and as such estopped during the continuance of his license from denying the title of his licensor. (r) Or he may be the original patentee

(p) 15 R. P. C. p. 19.

(q) 1 Giff. 184.

(r) *Bowman v. Taylor*, 2 Ad. & E. 278; 1 W. P. C. 292; *Smith v. Scott*, 28 L. J. C. P. 325; 5 Jur. (N. S.), 1356; *Hills v.*

Laming, 23 L. J. Ex. 60; *Noton v. Brooks*, 7 H. & N. 499; 8 Jur. (N. S.) 155; *Crossley v. Dixon*, 10 H. of L. Ca. 293; *Lawes v. Purser*, 26 L. J. Q. B. 25; 6 E. & B. 930.

himself, who has assigned his patent, and is acting in breach of that assignment; when, also, he will be precluded from alleging as against his assignee that the patent he has assigned is invalid. (s)

Again, he may have been in partnership with the plaintiff, and working the patent with him during a series of years; (t) or he may have submitted to judgment in a previous action for prior infringements of the same patent. (u) In both of these cases he will be precluded from disputing the validity of the patent.

Practice on Interlocutory Injunctions.

Where the Defendant is Willing to Keep an Account.—Usually the Court will not order an injunction if the defendant is willing to keep an account pending the trial of the action. (v) But if he refuses to do so, or does not appear, and so an undertaking to keep an account cannot be obtained from him, the Court will protect the patentee by granting the injunction. (w)

In one case where the defendants had offered in a letter to keep an account, the Court, while refusing an injunction, still required a formal undertaking as to the account to be given. (x)

Where an undertaking is given, a defendant is as much bound thereby as he would be by an injunction, and must comply strictly therewith. (y)

Delay is Fatal to Relief.—A plaintiff who seeks an interlocutory injunction must apply to the Court without delay. Any delay amounting to laches on his part will disentitle him to this form of relief.

In *Bridson v. Benecke*, (z) the plaintiffs ascertained in January, 1848, that their patent was being infringed. In the April following they warned the defendants, but did not file their bill for relief till the end of December. On the 15th of January, 1849, they

(s) *Chambers v. Crichley*, 33 Beav. 374; *Oldham v. Langmead*, 3 T. R. 439. But in the case of bankruptcy a patentee is not estopped from disputing the validity of his letters patent as against a purchaser from his trustee: *Cropper v. Smith*, 10 App. Ca. 249; 2 R. P. C. 17.

(t) *Muntz v. Grenfell*, 2 W. P. C. 88; 7 Jur. 121; 2 Coop. 61, n.

(u) *Gurcher v. Clayton*, 11 Jur. (N. S.), 107.

(v) *Holophane v. Berend*, 15 R. P. C.

18; *Pneumatic Tyre Co. v. Friswell*, 13 R. P. C. 15; *Actien Gesellschaft v. Temler*, 16 R. P. C. 447.

(w) *Clarke v. Nichols*, 12 R. P. C. 310. But see *British Tanning Co. v. Groth*, 7 R. P. C. 1, where in the special circumstances an injunction was refused even when the defendant refused to keep an account.

(x) *Thomson v. Hughes*, 7 R. P. C. 71.

(y) *Ibid.*

(z) 12 Beav. 1.

gave notice of motion for an injunction. Apart from the circumstance of this delay the plaintiffs had a strong case, for their patent was thirteen years old, and had been established in prior litigation. Lord Lonsdale, M.R., in refusing an injunction, said: "I think that a party coming for the assistance of this Court to protect a legal right, not absolutely established against the party who is alleged to have infringed it, ought to come at an early period. I do not say at the earliest possible period, because that would be putting an application for an injunction on notice, where all parties have an opportunity of being heard, in the same condition as an injunction *ex parte*, which it would not be expedient to do."

In *Borill v. Crate*, (a) the plaintiff knew of the infringement in August, 1864. In the November following he communicated with the defendant, and was told in reply exactly what the defendant was doing. In January, 1865, the plaintiff wrote again to the defendant, and, receiving no reply, threatened legal proceedings in April, but did not file his bill in Chancery till July. This delay was held by Wood, V.C., to disentitle him to relief by injunction.

In *Greer v. Bristol Tanning Company*, (b) a delay of three weeks was held sufficient to defeat the plaintiff's right to interlocutory relief.

In the *North British Rubber Company v. the Gormully, &c., Company*, (c) the plaintiffs, who had already established their patent in an action against prior infringers, came for an interlocutory injunction after a delay of twenty-two months. During this period the defendants had been establishing and pushing a growing trade. The Court held this delay fatal to the application.

"I am not aware," said Chitty, J., "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." (d)

In *Edison-Bell v. Hough*, (e) a delay of six months was held to militate against granting an injunction. In *Leonhardt v. Kallé*, (f)

(a) L. R. 1 Eq. 388; see, also, *The Patent Type Founding Co. v. Walter*, 29 L. J. Ex. 207; Johns. 727; *Johnson v. Wyatt*, 2 De G. J. & S 25; see, also, Wood, V.C., in *Smith v. London & South Western Railway Co.*, Kay, 408; 23 L. J. Ch. 562.

(b) 2 R. P. C 268; see, also, *Thomson v. Batty*, 4 T. L. R. 36; *Lister v. Norton*,

1 R. P. C. 116.

(c) 12 R. P. C. 17.

(d) *Ibid.* p. 20. In this case the defendants undertook to keep an account and paid £500 into court.

(e) 11 R. P. C. 594.

(f) *Ibid.* 534.

and in *Aluminium Company v. Domeiere*, (g) a delay of a year was held to bar the plaintiffs' right; while Stirling, J., in *Dunlop Pneumatic Tyre Company v. Stone*, (h) held a delay of three months sufficient to disentitle the plaintiffs to interlocutory relief.

Persons who assert legal rights are bound to come promptly; and, *à fortiori*, persons who assert only equitable rights. (i)

In *Actien Gesellschaft, &c. v. Temler*, (j) the plaintiffs had an agreement for the assignment of the patent, but the assignment had not been carried out. After acquiring their equitable title, they delayed for nine months before moving for an injunction. On account of this delay the injunction was refused, but the defendant was put on an undertaking to keep an account.

The delay which is fatal, is delay after knowledge of the infringement. If the plaintiff is in ignorance, or lulled into security by circumstances entitling him to believe that no infringement is going on, he will be excused from the consequences of his delay. (k)

Delay, when Excused.—In the following cases the delay was held not to have disentitled the plaintiff to relief. (l)

In *Losh v. Hague*, (m) Shadwell, V.C., granted relief although there had been a delay of three months, during a portion of which the plaintiffs had been making enquiries as to what the infringers were doing.

In the *United Telephone Company v. the Equitable Telephone Company*, (n) the facts were peculiar. The defendants, in February, 1887, wrote to the plaintiffs stating that they intended to manufacture and sell the *Swinton* telephone, and inviting the plaintiffs to inspect it, and take proceedings if they thought fit. The plaintiffs, who took no notice of this letter, eleven months later commenced their action for infringement, and moved for an interlocutory injunction. To explain their delay the plaintiffs filed evidence shewing that, on the advice of their solicitor, they had purposely abstained from embarking in expensive litigation with what they believed to be a bubble company, until the infringing instruments had actually been manufactured and sold by the defendants.

The Court accepted this explanation, and granted the injunction. Chitty, J., said: "It is often stated that, on applications

(g) 15 R. P. C. 32.

(h) 14 R. P. C. 263.

(i) *Actien Gesellschaft, &c. v. Temler*, 16 R. P. C. (p. 449).

(j) *Ibid.*

(k) *Crossley v. Derby Gas Co.*, 1 W. P.

C. 120; 4 L. J. Ch. 26.

(l) See, also, *Caldwell v. Vanvliessengen*, 21 L. J. Ch. 97; 9 Hare, 415; 16 Jur. 115; *Osmond v. Hirst*, 2 R. P. C. 265.

(m) 1 W. P. C. 201.

(n) 5 R. P. C. 233.

for interlocutory injunctions, delay is fatal; and that may be taken to be a very fair ordinary working proposition; but in each case the circumstances must be examined. I can put a case at once where there might, in one sense, be an apparent delay, but in which the delay would afford no defence to the motion. I take the case of a man writing a letter to an owner of land in possession, saying, 'I intend to cut your trees, and I give you notice that I shall come in and cut down your trees.' The plaintiff considers this to be an idle threat, and a year or two may elapse, and nothing is done. Then, when afterwards the plaintiff finds that the defendant is going to act upon that threat, the plaintiff institutes his action and asks for an injunction. In such a case as that, the mere threat, which would have been sufficient to found an injunction, would not be sufficient to afford a defence to the motion for an injunction; because the plaintiff would be entitled to say, 'I treat it as an idle threat, and until something is really being done upon it, I shall not proceed.' A wrong-doer cannot force his adversary prematurely into litigation; and, although, on the facts I have stated, in such a case the plaintiff would be entitled to his injunction, I do not consider he would lose his right by delaying to move till some act was done in the way of execution of the threat. Is a plaintiff bound, on a mere threat of this kind, to begin an action against a company of this class—a company whose means are extremely feeble, and who will not, in all probability be able to answer the expense of such a litigation as that of which this is an example? I think not. I think he is entitled to wait, after the threat is made, for a reasonable time, to see what has been done in execution of the threat, and that, it appears to me, is what the plaintiffs did."

The circumstance that a plaintiff who seeks an interlocutory injunction has so held his hand in regard to some other infringer as to have barred his right to interlocutory relief against that person, is no ground for refusing him such relief against a defendant in regard to whom he has shewn no such laches. (o)

Where the Defendant has Extensive Works which the Injunction will Stop.—The object of the Court in granting an interlocutory injunction is to prevent mischief, (p) therefore, where a direction to the defendant to keep an account will do the plaintiff ample justice, an injunction will rarely be granted. (q) Still, the plaintiff's

(o) *Pneumatic Tyre Co. v. Warrilow*, *Thompson*, 1 W. P. C. 278.
13 R. P. C. 284.

(q) *Jones v. Pearce*, 1 W. P. C. 122.

(p) Per Lord Eldon, in *Neilson v.*

strict right is to have the injunction—an account being discretionary. (r)

Where the injunction will have the effect of stopping extensive works, and will therefore be likely to do the defendant irreparable mischief should the plaintiff eventually fail, Lord Cottenham, C., said that the Court would not be justified in granting the injunction unless the plaintiff's title was established beyond all possibility of doubt. (s)

In *Muntz v. Foster*, (t) however, Lord Lyndhurst affirmed an injunction granted in defence of a patent of eleven years' standing, but of which the novelty was disputed, although the defendants alleged that the injunction would stop their works, and throw from forty to fifty people out of employment. (u)

But where the plaintiff stood by and allowed the defendants to erect blast furnaces and practise the invention, in the expectation that the defendants on making proof of its utility would pay a royalty as others had done, and the defendants refused to pay such royalty and disputed the validity of the patent, Lord Cottenham, C., dissolved the injunction, despite the fact that the patent was of more than twelve years' standing, saying that although the plaintiff might be fully entitled to his royalty, in expectation of which he had allowed the defendants to go on using his invention, it would, on the other hand, be extremely hard to tell the defendants that they shall not use the works which, with the plaintiffs' knowledge, they have prepared at a very considerable expense. To stop the works by injunction under such circumstances, said the Lord Chancellor, would be to invert the purpose for which an injunction is used, and to create mischief rather than prevent it. (v)

In *Plimpton v. Spiller*, Brett, J.A., dealing with the stoppage of trade arising from an injunction, said: "There will be a hardship on the one side or on the other, and the question is, On which side does the balance appear to lie? Now, if the trade of a defendant be an old and an established trade, I should say that the hardship upon him would be too great if an injunction were granted. But when, 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

(r) *Renard v. Levinstein*, 2 H. & M. 631 (per Wood, V.C.).

(s) *Neilson v. Forman*, 2 Coop. Ch. Ca. 61, n.

(t) 2 W. P. C. 92.

(u) See, also, *Davenport v. Jepson*, 4 De G. F. & J. 445.

(v) *Neilson v. Thompson*, 1 W. P. C. 285; 2 Coop. Ch. Ca. 61 n.

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. Therefore, as a rule of conduct, I think that in such a case as this it is better, where the trade of the defendant is a new one—and not an old established trade—and where there are likely to be many customers of the new trade, to say that you will act against the new trade by injunction, whereas if he were carrying on an old trade you would act in the other way.” (w)

In the *United Telephone Company v. Tasker*, (x) the Court, to prevent the injunction ruining the defendant's business, required the plaintiffs to undertake to supply the defendants, who had been using pirated machines, with lawful instruments until the hearing of the action.

In the *North British Rubber Company v. the Gormully Company*, (y) Chitty, J., gave weight to the circumstance that the defendants had established a growing trade, and, on the defendants' suggestion, directed them to pay a sum into court to represent royalties, and keep an account pending the trial, as a more convenient course than granting an interlocutory injunction. In this case the plaintiffs, however, had been guilty of delay.

Where the Court refuses an interlocutory injunction it may dismiss the motion with costs; or order the motion to stand over till the trial, (z) leaving the question of costs to be decided at the hearing; or it may, while refusing the injunction, put the defendant on terms to keep an account pending the trial of the action. (a)

Undertaking as to Damages.—When an interlocutory injunction is granted it is the practice of the Court to require the plaintiff on whose behalf the injunction is ordered to give an undertaking to abide by any order the Court may make in the defendant's favour for damages, should it subsequently appear that the plaintiff's patent is invalid or that from some other reason the plaintiff was not entitled to an injunction. Even where the case for an interlocutory

(w) L. R. 4 C. D. 292, 293.

(x) 5 R. P. C. 633.

(y) 12 R. P. C. 17.

(z) *Crosskill v. Ivory*, 10 L. T. 459; *British Tanning Co. v. Groth*, 7 R. P. C. 1.

(a) *Cochrane v. Smethurst*, D. P. C. 356 n.; *Jones v. Pearce*, 1 W. P. C. 544; 5

M. & G. 208; 12 L. J. C. P. 179; *Edison-Bell v. Hough*, 11 R. P. C. 594; *Dunlop Pneumatic Tyre Co. v. Pneumatic Tyre Co.*, 14 R. P. C. 263; *Holophane v. Berend*, 15 R. P. C. 18; *Leonhardt v. Kalle*, 11 R. P. C. 534; *Pneumatic Tyre Co. v. Friswell*, 13 R. P. C. 15; *Crosskill v. Tuxford*, 5 L. T. 342; *Neilson v. Fothergill*, 1 W. P. C. 287.

injunction is clearly made out this rule will be applied. (b) This rule aids the Court in that which is its great object on these applications, viz.—to abstain from expressing any opinion upon the merits of the case until the hearing. (c) The rule applies as well to injunctions obtained on notice of motion as on *ex parte* applications.

“If any damage has been occasioned by an interlocutory injunction,” said James, L.J., in *Graham v. Campbell*, (d) “which, on the hearing, is found to have been wrongly asked for, justice requires that such damage should fall on the voluntary litigant who fails, not on the litigant who has been without just cause made so.” (e)

Evidence on Applications for Interlocutory Injunctions.—Where relief is sought by means of an interlocutory injunction, the Court will act on the evidence in the affidavits before it. (f)

The legal title of the plaintiff, as well as the particulars of the infringement of which he complains, should be clearly set out. He ought to state that he is the first and true inventor, or if he is an assignee, that the patentee is the first and true inventor, and shew how his title is derived from the patentee. Also that at the time of the application he believes the patent to be valid.

“When a party comes for an injunction against the infringement of a patent,” said Lord Lyndhurst in *Sturtz v. De La Rue*, (g) “he ought to state that he believes, at the time when he makes the application, that the invention was new, or had never been practised in this kingdom at the date of the patent. It is not enough that it was believed to be new at the time when the patent was taken out.”

So, likewise, it will not be sufficient to allege the infringement complained of generally with a mere, “I am informed and believe.” For it is a rule which the Courts will strictly enforce, that where a suitor states his belief of a fact on an interlocutory motion he must also state the grounds of such belief. The Court will not grant an injunction on mere suspicion, and if the particulars of infringement are not set out, the plaintiff’s evidence will have little weight. (h)

(b) *Newby v. Harrison*, 3 De G. F. & J. 287; *Renard v. Levinstein*, 2 H. & M. 628; 11 L. T. (N. S.), 766; 13 W. R. 382.

(c) Per Kindersley, V.C., in *Wakefield v. Buccleuch*, 11 Jur. (N. S.), 524.

(d) L. R. 7 C. D. 494.

(e) See, also, *Moser v. Jones*, 10 R. P. C. 368; *Fenner v. Wilson*, 10 R. P. C. 287;

Edison-Bell v. Bernstein, 14 R. P. C. p. 159; *Plimpton v. Spiller*, 4 O. D. 286.

(f) Per Lord Eldon in *Hill v. Thompson*, 1 W. P. C. 230; *Mayer v. Spence*, 1 J. & H. 87.

(g) 5 Russ. 329.

(h) *Germ Milling Co. v. Robinson*, 1 R. P. C. 217.

“The rule of the Court is,” said Rigby, L.J., in the *Saccharin Corporation v. the Chemical and Drugs Company*, (i) “that on interlocutory applications only is information and belief to be received at all, and that in that case, which is the only case where information and belief is admitted as evidence, you must shew the nature of that information. I will only refer to what the late Master of the Rolls, Sir George Jessel, said in the case of the *Quartz Hill Gold Company v. Beal*. (j) In a case of an interlocutory application, ‘and where an affidavit is made upon information and belief, the rules of the Court require that the deponent should state what are the grounds of his information and belief’—of course he is talking of the case before him, of an interlocutory application—‘and that he does not do, he only says they’—those are the assertions—‘are untrue to the best of his knowledge, information, and belief, not saying what the best of his knowledge is, and it may be nothing at all. There is, therefore, no evidence as to the truth of the allegations in the circular.’ I think that is true and sound law, and to say simply, ‘I am informed and believe,’ is not evidence, and does not constitute an affidavit evidence at all.”

Although the Court has power to require the attendance of persons who have sworn affidavits for the purpose of cross-examination at the hearing of the motion, this power is but rarely exercised; and where witnesses are summoned to attend for this purpose, their cross-examination will not be allowed to develop into a general trial of the matters in issue, as if it were the hearing of the action. (k)

So, likewise, where a defendant files affidavits in opposition to an interlocutory injunction, it is not sufficient for him to allege generally his information and belief that the plaintiff's patent is invalid; he must point out in what respect the patent is bad and set out the grounds of his belief. (l)

In *Whitton v. Jennings*, (m) a bill was filed for an injunction to restrain the infringement of a patent or for leave to bring an action at law. The defendant stated by his answer that the invention was not novel and that the patent was therefore invalid. The plaintiff, without filing an affidavit as to the novelty of the

(i) 15 R. P. C. p. 55.

(j) L. R. 20 C. D. p. 508.

(k) *Bracher v. Bracher*, 7 R. P. C. 421; *Saccharin Corporation v. the Chemical & Drugs Co.*, 15 R. P. C. 56. Here the cross-

examination allowed was before the Court of Appeal.

(l) *Read v. Andrew*, 2 R. P. C. 119.

(m) 1 Dr. & S. 110.

invention and the validity of the patent, moved for an interlocutory injunction. Kindersley, V.C., refused the injunction and the leave to bring an action unless the plaintiff produced a clear and distinct affidavit that the invention was new and the patent valid; but allowed the motion to stand over.

In *Read v. Andrew*, the patent was fourteen years old, and the evidence filed in support of the motion was clear, distinct, and explicit. The defendants having insufficient evidence to resist the motion, applied for an adjournment and offered to keep an account. But Bacon, V.C., refused to grant an adjournment, saying that he did not credit the defendants' statement that they had not had time to meet the case. "It is not a complicated case; it relates to plain, patent facts which, as far as they imply knowledge of the practice to the defendants, are within their plain knowledge; they can read the patent; they know the practice; they can say, and could have said within eight and forty hours as well as within any other period, what they have to say about the validity of the patent." (n)

Uberrima Fides Necessary.—Where the application is made *ex parte*, the plaintiff must shew *uberrima fides*, and disclose for the information of the Court all the facts in his knowledge, so that the Court may be able to judge fairly on the whole case. Otherwise any injunction obtained will be liable to be dissolved by the Court when the concealed facts are discovered. (o)

In *Gardner v. Broadbent*, (p) where the plaintiff, who was the assignee of the inventor, simply stated his belief that as purchaser he had a valid patent, the Court held the statement insufficient. Stuart, V.C., said: "When the plaintiff applied for an *ex parte* injunction, his affidavit ought to have stated clearly and distinctly that he believed the patentee from whom he purchased the patent was the original and true inventor, and that he believed that the invention had not been practised at the time when the patent was granted."

Disobeying the Injunction.—Defendants who disobey an injunction granted against them are guilty of contempt, and liable to imprisonment, and it is no answer for them to shew that the order had not been served, if in fact they were aware that an injunction had been granted against them. (q)

(n) 2 R. P. C. p. 122.

(o) *Dalglisch v. Jarvie*, 2 McN. & G. 231.

(p) 4 W. R. 767; 2 Jur. (N. S.), 1041.

(q) *United Telephone v. Dale*, L. R. 25

C. D. 778; *Avory v. Andrews*, 51 L. J. Ch. 414; 46 L. T. 279; 30 W. R. 564. See the Scottish case of *Harvie v. Ross*, 4 R. P. C. 234, where a fine and costs were imposed instead.

Where the disobedient defendants are a company, the directors are liable to be committed. (*r*)

A defendant who has submitted to an injunction will not be allowed on a motion for attachment for breach of that injunction to allege the invalidity of the plaintiff's patent, or that his own prior acts were not infringements. (*s*)

An undertaking to keep an account is as binding on the defendants as an injunction would be, and must be faithfully observed. (*t*)

On a motion to commit for contempt, costs may be given as between solicitor and client to the party moving, (*u*) but not to the respondent if the motion is dismissed; for such costs are in the nature of an indemnity to the plaintiff where the respondent is not in fact committed. (*v*)

A motion to commit should not be made unless there is a clear case of contempt. Its use will not be encouraged as a machinery merely for getting an apology and costs. (*w*)

Expediting the Trial of the Action.—Sometimes when a motion for an interlocutory injunction is unsuccessful the plaintiff seeks to obtain an order expediting the trial of the action. This necessarily involves, however, postponing other litigants, and usually such an application will not be granted; the rule upon which the Court acts being that where an injunction is not given, the damages awarded at the trial are a full and adequate compensation for any loss meanwhile sustained by the plaintiff.

In *Farbenfabriken v. Bowker*, (*x*) the plaintiffs not being in a position to press their motion for an interlocutory injunction, asked that the trial of the action might be expedited, on the ground that the trade to which their patent related (dyeing) was subject to constant innovations, and the commercial value of their patent might at any time be destroyed by the introduction of some new dye; they also relied on the circumstance that the defendant, by underselling them with infringing articles, was destroying their trade.

In refusing the application, Stirling, J., said: "The patent is for the usual term, and I confess I do not think that the mere fact that the patentee is apprehensive that his monopoly may practically not be found to extend over the whole term, ought to give

(*r*) *Spencer v. Ancoats Vale Co.*, 6 R. P. C. 68.

(*s*) *Moore v. Thomson*, 6 R. P. C. 626; 7 R. P. C. 325.

(*t*) *Thomson v. Hughes*, 7 R. P. C. 71.

(*u*) *Spencer v. Ancoats Co.*, 6 R. P. C. 68.

(*v*) *Plating Co. v. Farquharson*, L. R.

17 C. D. p. 57; Griff. P. C. 187.

(*w*) *Ibid.* p. 56.

(*x*) 8 R. P. C. 136.

him a right to have his cause tried before those of other suitors, who have used the ordinary diligence in coming to the Court. It is said that the defendant is offering infringing articles at greatly reduced prices to the public, and that the plaintiff's sales are falling off, and that such falling off is attributable to the offers made by the defendant of his spurious articles. As regards that, I think that it simply comes to this. The plaintiff is, unfortunately, by the practice of the Court, unable to obtain an interlocutory injunction. He consequently is suffering injury in the meantime, if his case be well founded. In the view of the Court, that loss which he suffers will be made good by the damages which he will obtain at the trial, or by the account of profits which may be given him. Under these circumstances, I see no special ground which should have sufficient weight given to it to induce me to advance the case so as to give it priority over other actions."

Where the plaintiffs had been harassed by numerous infringements by persons of small means, who contested the patent right up to trial, and then failed to appear, Stirling, J., being of opinion that they were not entitled to an interlocutory injunction, expedited the trial of the action, on grounds of the special hardship of their position. (*y*)

The Pleadings.

Statement of Claim.—The pleadings in a patent action are governed by the ordinary rules which apply to actions in the High Court, (*z*) and are only peculiar in this respect, that there must be delivered with the statement of claim particulars of breaches, setting out the instances of infringement in respect of which the plaintiff claims relief; (*a*) and with the defence particulars of objection, stating the objections, if any, upon which the defendant relies to establish the invalidity of the plaintiff's patent. (*b*)

It is not necessary for the plaintiff to allege the novelty of the invention in the statement of claim, as the allegation of the grant throws upon the defendant the onus of disputing it; (*c*) nor that the fees requisite to keep the patent in life have been paid. (*d*)

The plaintiff must shew his right to sue by pleading the grant of the letters patent under which he claims his monopoly, and his

(*y*) *Edison-Bell Phonograph v. Hough*,
11 R. P. C. 594.

(*z*) R. S. C. Orders 19, 21.

(*a*) Patents Act, 1883, s. 29 (1).

(*b*) *Ibid.* s. 29 (2).

(*c*) *Amory v. Brown*, L. R. 8 Eq. 664;
38 L. J. Ch. 593.

(*d*) *Sarazin v. Hamel*, 32 Beav. 145.

title thereto, either as original grantee or by assignment. But it has long been decided that he need not set out the contents or effect of the specification. (e)

In the statement of claim the infringement complained of need only be alleged generally, as the details are set out in the necessary particulars of breaches.

The statement of claim will conclude with a claim for an injunction, an enquiry as to damages, or an account and delivery up to the plaintiff or destruction of all infringing articles in the possession or control of the defendant. Costs need not be claimed, unless the plaintiff has obtained in a prior action a certificate that the validity of his patent has been in issue; in which case the certificate and a claim for costs as between solicitor and client should be added. (f)

If the defendant makes default, and does not deliver a defence within the time prescribed by the rules, the plaintiff may set down a motion for judgment. (g) But where there were several defendants, and some put in a defence and some did not, Chitty, J., refused leave to set down the action on motion for judgment against the defendants in default, on the ground that the other defendants might at the trial upset the patent. (h)

Defence.—In his defence a defendant may deny the infringement and impeach the patent, or he may rely upon either of those defences.

In *Hocking v. Hocking*, (i) the defendant denied the infringement, and pleaded further that if the plaintiff's patent was construed so widely as to include his apparatus, it was bad for want of novelty, and named certain prior specifications. The Court of Appeal held this alternative plea redundant, as disclosing no defence which was not covered by the first plea, but refused to strike it out as calculated rather to assist than embarrass the plaintiffs, by giving them and the Court information which might be useful at the trial.

If the defendant decides to dispute the plaintiff's right to his monopoly, under the letters patent, various other defences are open to him.

He may plead that the grantee of the letters patent sued upon

(e) *Kay v. Marshall*, 2 W. P. C. 39; *Westhead v. Keene*, 8 L. J. Ch. 89; 1 Beav. 289.

(f) *Pneumatic Tyre Co. v. Chi-holm*, 13 R. P. C. 488. For forms of statements of claim and defences, see Appendix IV.

(g) R. S. C. Order 27, rule 11; *United Telephone v. Smith*, 61 L. T. 617.

(h) *Actien Gesellschaft v. Remus*, 12 R. P. C. 94. This notwithstanding Order 27, rule 3.

(i) 3 R. P. C. 292.

was not the true and first inventor of the invention patented. (*j*) This plea goes further than a plea of want of novelty, and it would seem that particulars of objection delivered under it must state who the first inventor was. (*k*) It is the proper plea where the patentee is a first importer and it is intended to contest that claim. It should not be pleaded if all that the defence intend to suggest by it is that the invention is not new. (*l*)

By the plea that the alleged invention is not new, the defendant alleges that the letters patent are void because the plaintiff's invention was in use by or otherwise known to the public prior to the date of the grant. That is all; he does not thereby contest the sufficiency of the subject-matter of the grant or of the specification. (*m*)

The particulars under this plea must state the time and place of the previous publication or user alleged. (*n*)

It is also open to the defendant to plead that the alleged invention is not useful. This plea, which is a compendious mode of alleging that the letters patent are void because the monopoly they purport to legalize is prohibited by the Statute of Monopolies as being contrary to the law, mischievous to the State, to the hurt of trade, and generally inconvenient, (*o*) has, after some doubt as to the correctness of its form, (*p*) now been authorized by the form of defence to a patent action contained in the Appendix to the Rules of the Supreme Court. (*q*)

A plea that the alleged invention is not subject-matter for a patent grant is a proper defence where the defendant proposes to contend at the trial that the plaintiff's invention is not a "manufacture" within the meaning of the Statute of Monopolies, *e.g.* that it is a mere abstract principle, and not capable of being made the subject of a patent grant. (*r*)

A defendant may also rely by way of defence upon any ground which at the commencement of the Patents Act, 1883, would have been available as a ground of repealing letters patent by *scire*

(*j*) 21 Jac. I. c. 3, s. 6.

(*k*) *Siddell v. Vickers*, 5 R. P. C. 85; but see *Russell v. Ledsam*, 11 M. & W. 647; 12 L. J. Ex. 439.

(*l*) *Thomson v. Macdonald*, 8 R. P. C. 9; *Morgan v. Windover*, 7 R. P. C. 443; see also *Kurtz v. Spence*, 5 R. P. C. 161; 4 R. P. C. 427.

(*m*) See *Walton v. Potter*, 1 W. P. C. 598, n.; 11 L. J. C. P. 138; *Walton v. Bateman*, 1 W. P. C. p. 623, *Bateman v.*

Gray, 22 L. J. Ex. 290; Macr. P. C. 115.

(*n*) Patents Act, 1883, s. 29 (3).

(*o*) 21 Jac. I. c. 3, s. 6. Per Parke, B., in *Morgan v. Seaward*, 1 W. P. C. p. 197; 2 M. & W. p. 5.

(*p*) See *Jupe v. Pratt*, 1 W. P. C. 151, and *Morgan v. Seaward*, *supra*.

(*q*) See *Annual Practice*, 1900, vol. ii. App. D, s. vi. p. 72.

(*r*) See *Walton v. Potter*, 1 W. P. C. 598, n.

facias. (s) Thus, he may plead that there is disconformity between the specifications, that the complete specification is ambiguous and calculated to mislead, that it does not distinguish the old from the new, that it does not sufficiently describe the manner of performing the invention, and that it does not disclose the best mode of performing the invention known to the patentee at the time it was filed; or that the letters patent are void as being in derogation of a prior grant by the Crown, or as made upon a false suggestion by the grantee.

The defendant may further plead that the letters patent have lapsed through non-payment of the patent fees; (t) or that the infringement complained of was committed prior to the publication of the complete specification, (u) or prior to an amendment of the specification. (v)

A defence is embarrassing if the Court cannot find out without a minute criticism of each paragraph what the defendant means. (w)

In an action on a contract between two parties for the working and development of a patented invention, the defendant may raise any issue open to him on the contract, such as fraud or want of consideration, but he cannot set up defences as if the action were one of infringement, and in that form dispute the validity of the patent. (x)

The Particulars.

Particulars of Breaches.—By Section 29 of the Patents Act, 1883, (y) it is provided that the plaintiff in an action for infringement of a patent must deliver with his statement of claim, or by order of the Court or judge, at any subsequent time, particulars of the breaches complained of; and that at the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement of which particulars are not so delivered. (z)

(s) Patents Act, 1883, s. 26 (3).

(t) *Ibid.* s. 17.

(u) *Ibid.* s. 13.

(v) *Ibid.* s. 20.

(w) *McDougall v. Partington*, 7 R. P. O. 216.

(x) *Ibid.*

(y) 46 & 47 Vict. c. 57.

(z) Apart from Statute, the Court has jurisdiction to order particulars of breaches to be delivered to the defendant, in order

that the defendant may not be taken by surprise at the trial (*Bulnois v. McKenzie*, 1 W. P. O. 260; 4 N. O. 127; 5 Scott, 419; 6 Dowl. P. O. 21; *Perry v. Mitchell*, 1 W. P. O. 269; *Electric Telegraph Co. v. Nott*, 4 C. B. 468; 16 L. J. C. P. 174). The Patent Law Amendment Act, 1852 (15 & 16 Vict. c. 83, s. 41), required the plaintiff in any action for the infringement of letters patent in any of her Majesty's Superior Courts of Record at

The statute does not prescribe any special form in which these particulars must be stated, but in preparing them it is important to remember that the object of requiring them to be given is to prevent the defendant being taken by surprise at the trial. (a) They ought, therefore, to be so drawn as to give the defendant full and fair notice of the case he will have to meet. (b) If they do this they are sufficient. The plaintiff must also remember that his evidence will at the trial be restricted to such breaches as are alleged in his particulars. (c)

“The object of having these particulars,” said Wood, V.C., in *Needham v. Oxley*, (d) “is to give the defendant fair notice of what the complaint against him is, not to tie the plaintiffs down to the precise terms of any verbal definition, or to make the trial of the issue turn upon a point of form. Full and fair notice the defendant is entitled to.”

In that case the particulars specified certain machines made by the defendants for certain named persons, and this was held sufficient, an attempt to get particulars of the respects in which each machine infringed being defeated.

The Court will distinguish between the particulars required of a plaintiff alleging infringement and of a defendant alleging that the plaintiff's patent is bad, inasmuch as the facts of his own infringement must be well known to the defendant, whereas in particulars of objections the plaintiff may be wholly without knowledge of the matters relied on to establish the invalidity of his patent. (e)

In *Batley v. Kynoch*, where the case was plain and simple, it was held sufficient to produce the article complained of (a cartridge) and make it an exhibit; and the Court declined to order the plaintiff to specify what particular parts of his specification he alleged were infringed. (f)

The plaintiff must give the defendant notice of all the

Westminster, or in Dublin, to deliver with his declaration particulars of the breaches complained of, and confined the evidence at the trial to those cases of infringements of which particulars had been given. The practice thus introduced as to Courts of Common Law was adopted by the Courts of Equity (see *Curtis v. Platt*, 35 L. J. (N. S.), Ch. 853; *Finnegan v. James*, L. R. 19 Eq. 72; 44 L. J. Ch. 185.

(a) *Batley v. Kynoch*, L. R. 19 Eq. 229;

see, also, *Petman v. Bull*, 3 R. P. C. 390; reported as *Ledgard v. Bull*, 11 App. Ca. 648. Forms of Particulars are given in Appendix IV. post.

(b) *Ibid.*

(c) Patents Act, 1883, s. 29.

(d) 1 H. & M. 248.

(e) *Talbot v. La Roche*, 15 C. B. 310; *Ledgard v. Bull*, L. R. 11 App. Ca. 648.

(f) L. R. 19 Eq. 229; cf. *Eggleton v. Nichols*, 7 R. P. C. 423.

infringements upon which he intends to rely at the trial. It will not do for him to set out instances by way of illustration only, and so reserve to himself the right to give evidence at the trial of other infringements of a like nature.

Thus, in the *Patent Type Founding Company v. Richards*, (g) where the plaintiffs, in reply to an order for further particulars of breaches, enumerated certain instances, and added, "The plaintiffs state these particular instances by way of example only, and not so as to preclude them from proving any of the infringements mentioned in the former particulars of breaches;" these words were ordered to be struck out. Again, in *Church v. Wilson*, (h) where the plaintiffs' particulars of breaches alleged that they complained "in particular, by way of illustration, of the following instances." The words "in particular, by way of illustration," were ordered to be struck out.

In *Haslam v. Hall*, (i) the plaintiffs stated in their particulars that, "by way of example and not of limitation," they complained of machines fitted by the defendants on board the ship *Selembria*. The defendants objecting to such particulars, the Court made an order confining the plaintiffs to the infringements on the *Selembria* unless they gave further names. (j)

Where, however, the plaintiffs complained generally of the defendant making and selling pictures made by a special process, and added, "One of such pictures was made and sold by the defendant to one C. on the 27th April, 1854; but plaintiff states this by way of example only, and not so as to preclude him at the trial from insisting on other infringements," the Court of Common Pleas refused to order further particulars, apparently on the ground that the instance given being representative of all the others, there was no likelihood of surprise. (k)

In *Elsley v. Butler*, (l) the patent was for "improvements in the manufacture of lace, in twist-lace machinery, and in apparatus employed therein." The plaintiff delivered particulars of breaches, alleging that the defendant had infringed "by the production in a twist-lace machine, or in twist-lace machines, of lace fabrics in the manner described in the specification of the said patent, p. 3, l. 22 to p. 9, l. 39, or in a manner only colourably differing therefrom; and by the use of the improved combinations of apparatus therein

(g) 2 L. T. (N. S.), 359.

(h) 3 R. P. C. 123.

(i) 4 R. P. C. 203.

(j) See, also, *Ehrlich v. Ihlee*, 5 R. P.

C. 39.

(k) *Talbot v. La Roche*, 15 C. B. 310.

(l) *Griff.* 96; 1 R. P. C. 189.

described, and also in particular by the production in a twist-lace machine, or in twist-lace machines, of fabric known as 'double-tie Swiss net' in the manner described in the specification of the said patent, p. 6, l. 57 to p. 7, l. 38, or in a manner only colourably differing therefrom, and by the use of the improved combinations of apparatus therein described." These particulars were held sufficient by Pearson, J.

Again, where the defendant was not the manufacturer of the articles complained of, the Court has been less exacting in limiting the plaintiff to the cases actually specified in his particulars.

Thus in *Tilghman v. Wright*, (m) the particulars of breaches were as follows: "The defendants have infringed the plaintiff's patents in the statement of claim mentioned, by importing into this country, selling, exposing for sale, using, and otherwise dealing with glass globes, shades, or moons, having their surfaces wholly or in part ground, roughened, or obscured by the projection against such surfaces of a stream of sand, or other suitable similar material." The defendants having applied for better particulars, Pearson, J., while requiring the plaintiffs to specify particular instances, allowed, as in *Talbot v. La Roche*, (n) general words to be added, so as not to confine the plaintiffs solely to those instances.

Where the plaintiff has not sufficient information to deliver full particulars of all the infringements he believes to have been committed, his proper course is to interrogate the defendant, and, if necessary, amend his particulars thereafter.

In *Russell v. Hatfield*, (o) where the defendant also was a manufacturer, the plaintiff alleged in his particulars of breaches sales to a specified railway company and other persons. On this the defendant applied for better particulars, but the plaintiff alleging that he did not at the time know the names of the other persons with whom the sales had been effected, but was going to interrogate, his particulars were held sufficient, pending the defendant's answers to interrogatories.

The object of the particulars of breaches being to tell the defendant what the plaintiff says he has done in infringement of the patent, it is not their office to answer an interrogatory as to the construction of the specification. Therefore, the defendant cannot compel the plaintiff to construe his patent in his particulars of breaches. (p)

It is not generally necessary that the particulars of breaches

(m) 1 R. P. C. 103; Griff. 216.

(n) See supra.

(o) 2 R. P. C. 144; Griff. 204.

(p) *Wenham v. Champion*, 8 R. P. C. 22.

should specify the parts of the plaintiff's patent alleged to be infringed by referring to the lines and pages of the specification. (q) But where the specification includes several claims, and the plaintiff only complains of infringement of some of these, the particulars of breaches ought to indicate which. (r)

Where the infringer is a seller only, and not a manufacturer of the articles complained of, the plaintiff, although less strictly tied down to the actual instances specified by him in his particulars, will usually be required to give more detailed information as to the manner in which he alleges his patent to be in fact infringed by the defendant's sales; for the mere seller of an article has not the knowledge possessed by a manufacturer as to the processes by which it is made. (s)

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

Infringements of which no notice has been given in the particulars of breaches cannot (except by leave) be given in evidence at the trial. (u)

Particulars of Objections.—In an action of infringement the defendant must deliver with his statement of defence, or by order of a Court or a judge, at any subsequent time, particulars of any objections on which he relies in support thereof. 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, the time and place of the alleged previous publication or user must be given. At the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered. (v)

Notice of the objections upon which the defendant intended to rely were formerly required to be given to the plaintiff under 5 & 6 Vict. c. 83, s. 5, and under Section 41 of the Patent Law Amendment Act, 1852. Discussing the notice of objections required by the first of these Statutes, Tindal, C.J., in *Fisher v. Dewick*, (w) said the object of requiring notice to be given to the

(q) *Cheetham v. Oldham*, 5 R. P. C. 624.

(r) *Ibid.*; see, also, *Haslam v. Hall*, 4 R. P. C. 203; *Lamb v. Nottingham*, *Seton on Decrees*, vol. i. p. 557; *Wrenn v. Wield*, L. R. 4 Q. B. 213.

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

(t) Patents Act, 1883, s. 29 (5).

(u) *Henser v. Hardie*, 11 R. P. C. 421.

As to particulars in an action for infringement of a chemical patent, see *Cassella v. Levinstein*, 8 R. P. C. 475.

(v) Patents Act, 1883, s. 29 (2) (3) (4); *Perry v. Société des Lunetiers*, 13 R. P. C. 670; see Forms, Appendix IV. post.

(w) 1 W. P. C. 267; 4 Bing. (N. C.), 706; 7 L. J. C. P. 279; see, also, *Jones v. Berger*, 1 W. P. C. 544; 12 L. J. C. P. 179.

plaintiff "was not to limit the defence, but to limit the expense to the parties, and more particularly to prevent the patentee from being upset by some unexpected turn of the evidence." In another case under the same Act, Lord Abinger, C.B., said that the legislature never intended that the defendant should argue his case in particulars of objection. (x) The object, therefore, of the earlier Acts in requiring the defendant to give notice of his objections was to provide the plaintiff with fair notice of the case to be made against him, and to prevent his being taken by surprise at the trial.

Dealing with the provisions of the present Act, Bristowe, V.C., in *Boyd v. Horrocks*, (y) said: "I take it that the real meaning of this Act, as it was of the former Act, is not to bear oppressively upon either party, but to require each party to give so much information as shall enable an action to be tried with the least expense, and as few materials as are consistent with a due trial, so that the case shall not be encumbered with a mass of proof which, when the action comes on for trial, may be absolutely nugatory and useless." "The object of particulars," said Lindley, L.J., in *Holliday v. Heppenstall*, "is simply to prevent surprise." (z)

The defendant should state his particulars as concisely as possible, and avoid alleging instances of objection upon which he does not intend to rely at the trial. (a) In *Allen v. Oates*, (b) Kekewich, J., in commenting on the frequency with which long lists of objections were given, when only one or two were really relied on by the defendant, suggested that it might be desirable to have the particulars reviewed by some officer of the Court, so as to settle the real issues before trial.

Where the defendant intends to allege that the plaintiff's patent is bad, because some person other than the patentee is the actual inventor of the invention, the objection that the patentee is not the true and first inventor is a proper one to take. Formerly when this objection was taken it was held that the defendant in making it need not state who the true and first inventor was; (c) but now it would seem that such information ought to be given. (d)

(x) *Heath v. Unwin*, 10 M. & W. 687.

(y) 3 R. P. C. p. 287.

(z) 6 R. P. C. p. 328.

(a) *Thomson v. Batty*, 6 R. P. C. 84,
p. 97.

(b) 15 R. P. C. 303.

(c) *Russell v. Lelsam*, 11 M. & W.
647; *Heath v. Unwin*, 10 M. & W. 684;
Bulnois v. McKenzie, 4 Bing. N. C. 127;
6 Dowl. 215.

(d) See Kekewich, J., in *Morgan v. Windover*, 7 R. P. C. 449.

If, however, the defendant only intends to allege that the plaintiff's patent is not new, or that it contains no invention, he ought not to raise as a particular of objection that the patentee was not the true and first inventor. For in such case this objection is devoid of meaning. (e)

Where a defendant alleges that the plaintiff's patent is bad for want of novelty, he may mean either (1) that its novelty is defeated by the state of general public knowledge at the date of the grant; or (2) by actual prior user; or (3) by a prior publication of the invention.

It will be convenient to consider these grounds of objection separately.

1. *Anticipation by Public Knowledge.*

Where a defendant relies upon this objection it is not necessary to specify the particular works by which he proposes to prove the state of general knowledge.

"I do not know," said Cotton, L.J., in *Holliday v. Heppenstall*, (f) "how far you are to go back as regards general public knowledge, if you are to refer to the books which give that, or upon which the general public knowledge was acquired. Are you to go back to spelling books or anything of that sort? You must prove by witnesses in a general way, and, if necessary, by reference to well-known works, that that was the state of general public knowledge at the time when the specification was filed."

In the same case, Lindley, L.J., in answering the question, What has the defendant to do if his defence is common knowledge? said: "All he has to do is to say so, and that the state of knowledge was such that there is no novelty in the patent. Having said that he need not go on in support of that to give all the evidence he intends to adduce to prove it. He need not put down every chemical book in which dyeing by aniline has been discussed and explained to shew what is common knowledge." (g)

Thus, as will be shortly indicated more at length, anticipation by public knowledge differs from anticipation by prior publication, for in the latter case the particulars of the publications relied on must be given. Where, however, the defendant relies to prove his objection of common knowledge upon a single

(e) See Kekewich, J., in *Thomson v. Macdonald*, 8 R. P. C. p. 9; *Pneumatic Tyre Co. v. Casswell*, 13 R. P. C. 187.

(f) 6 R. P. C. p. 326; L. R. 41 C. D. 114; 58 L. J. Ch. 330.

(g) Ibid. p. 328; see, also, *The English and American Machinery Co. v. Union Boot and Shoe Co.* 11 R. P. C. p. 374; *Siemens v. Karo*, 8 R. P. C. p. 377.

specification, he must give the plaintiff notice of that specification; (*h*) the reason being apparently that such an objection is not really one of common knowledge, but of anticipation by prior publication. (*i*)

2. *Anticipation by Prior User.*

Where the objection to the patent is founded on prior user, (*j*) the defendant must specify particularly the instances of alleged user on which he relies, giving the plaintiff express notice of the time and place of use, and of the address of the user. (*k*) The object of this is to enable the plaintiff to investigate the circumstances of the cases alleged against him, and prepare his evidence for the trial. In such particulars the defendant, where he relies on prior machines, ought to indicate what particular machines he relies on, and not allege generally—machines at the works of such and such a firm. (*l*) But he need not state what particular part of the plaintiff's invention the machine anticipates, for that the plaintiff can ascertain for himself on inspection. (*m*)

In *Smith v. Lang*, (*n*) the defendant alleged by way of objection the prior use, sale, or public exhibition of wire ropes made according to the alleged invention by one *W.* from the year 1832 to 1862. This was held insufficient, and further particulars were required.

Where the defendant, as in the case last mentioned, alleges prior user generally over a number of years, the plaintiff, instead of applying for better particulars, may interrogate him as to the names and addresses of the alleged prior users, and, if so interrogated, the defendant will be compelled to answer. (*o*) The object of particulars being to prevent surprise, the defendant must give such particulars as will enable the plaintiff to identify the anticipations relied upon; and not such as will leave it open to the defendant to say at the trial, "I meant something different from what you have inferred." (*p*)

In *Scott v. Hull Steam Fishing Company*, (*q*) the particulars

(*h*) *English and American Machinery Co. v. Union Boot and Shoe Co.*, supra.

(*i*) *Solvo Laundry Co. v. Mackie*, 10 R. P. C. p. 70. As to prior publication, see ante, p. 71, Chap. VI.

(*j*) As to prior user, see ante, p. 93, Chap. VII.

(*k*) *Birch v. Mather*, L. R. 22 C. D. 629; 25 L. J. Ch. 292; Patents Act, 1883, s. 29 (3); *Flower v. Lloyd*, 20 Sol. J. 860;

45 L. J. Ch. 746.

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

(*m*) Ibid.

(*n*) 7 R. P. C. 148.

(*o*) *Alliance Syndicate v. MacIvor*, 8 R. P. C. 321; 39 W. R. 487; see, also, *Birch v. Mather*, L. R. 22 C. D. 629.

(*p*) *Scott v. Hull Steam Fishing Co.*, 13 R. P. C. 206.

(*q*) Ibid.

delivered alleged anticipation by a number of prior makers, but did not indicate which particular make of each respective maker the defendants relied on. This, inasmuch as each maker might have several ways of making the same thing, was held to be insufficient.

3. *Anticipation by Prior Publication.*

Where the novelty of the patent is contested on the ground of prior publication of the invention, the particulars must specify in detail the specifications or books relied upon by the defendant to prove his case, the object being to enable the plaintiff to identify the alleged anticipations.

Sometimes the Court will order a defendant to specify by pages and lines the precise parts of the prior specifications upon which he relies. (r) Though this is not the general rule, (s) it will be done where the prior specifications relied on are intricate and complicated. But not where the specifications are simple, or where the defendant *bonâ fide* relies upon the whole. (t)

In *Boyd v. Farrar*, (u) the defendant relied on anticipation by a number of prior specifications, to which he gave references by pages and lines. The plaintiff, whose patent was of a complicated character, asked for particulars as to what portions of his patent the prior specifications were alleged to anticipate. Kay, J., required these further particulars to be given. "The objection of the defendant, as I gather, is that his hands will be tied if he gives these particulars; but that is the very object of giving and requiring particulars—that his hands may be tied, (v) and that the plaintiff may, before the matter comes into Court to be determined on evidence, have stated exactly that upon which the defendant intends to rely, and certainly to say that the particulars would tie the hands of the man who gives them, and that that is an objection to them, is practically to say, 'No, I will not give you any particulars, I will give you general statements,' which is not the law."

In *Harris v. Rothwell*, where the matters involved were also intricate and the plaintiff's specification had six claims, Chitty, J., required the defendant to amend his particulars of objection in

(r) *Heathfield v. Greenway*, 11 R. P. C. 266; *Nettlefolds v. Reynolds*, 8 R. P. C. 19; *Nettlefolds v. Reynolds*, 8 R. P. C. 410. 410.

(s) *Holliday v. Heppenstall*, 6 R. P. C. 320; *Siemens v. Karo*, 8 R. P. C. p. 378.

(t) *Sidebottom v. Fielden*, 8 R. P. C.

(u) 5 R. P. C. 36.

(v) But see *Nettlefolds v. Reynolds*, 8 R. P. C. p. 417: per Lindley and Fry, L.JJ.

such a way as to shew to which of the plaintiff's claims each objection was directed. (w)

In *Fowler v. Gaul*, (x) the defendants delivered particulars of objection referring to certain patents and specifications as anticipations of the plaintiff's patent, and alleging that the plaintiff's specification claimed some of the matters specified and patented in such prior patents. The plaintiff objecting to such particulars, it was held by a divisional Court that the defendants must deliver further particulars shewing what parts of the specifications and patents relied on were anticipations of the plaintiff's patent, and what parts were alleged to be claimed by the plaintiff's specification.

Where the defendant alleges anticipation by books, he must in his particulars give the plaintiff such information as will enable the plaintiff to find the part of the particular book relied upon.

In *Harris v. Rothwell*, (v) the defendants referred to a whole book and also to certain parts of it. But the Court ordered the reference to the whole book to be struck out.

Insufficiency and Variance of Specifications.—Where the defendant objects that the specification of the patentee is insufficient, he must particularise his objection by stating in what respects the specification is so insufficient. (z) Thus, it is not enough for the defendant to allege merely that the specification is not such as a competent workman could construct a machine from. He must point out wherein the defect lies; but he cannot be required to tell the plaintiff how to cure the defect. (a) So, likewise, it will not suffice to allege generally disconformity between the specifications; particulars must be given of how the invention claimed by the complete specification differs from that outlined in the provisional. (b)

Particulars of objection delivered and proved by one defendant may be relied upon by another in the same interest, even when that other defendant has not attacked the validity of the patent. (c)

Where a defendant suspects that a ground of opposition exists as to which he is without proper information, his proper course is not to insert in his particulars what he only imperfectly knows,

(w) 3 R. P. C. 245; 1 Griff. 109.

(x) 3 R. P. C. 247.

(z) *Heathfield v. Greenway*, 11 R. P. C. 20.

(a) *Crompton v. Anglo-American Corporation, Limited*, 4 R. P. C. 197; 35 C. D.

283; 56 L. J. Ch. 802.

(b) *Arglo-American Brush Corporation v. Crompton*, 34 C. D. 152; 4 R. P. C. 27; 56 L. J. Ch. 167.

(c) *Smith v. Cropper*, 10 App. Ca. 249.

but to wait till he has obtained full information and then apply for leave to amend. (d)

Amending Particulars.—Particulars of breaches and particulars of objection may be from time to time amended by leave of the Court or a judge. (e) The application should be made by summons at chambers; but it may be made at the trial of the action. (f)

Leave to amend may be given after the trial on appeal by the Court of Appeal. (g) But the Court of Appeal does not encourage such amendments, and will exercise this jurisdiction with great care; as the necessary effect of allowing substantial amendment at that stage is to re-try the case on appeal, as if the Court of Appeal were a Court of first instance. Thus, in the *Shoe Machinery Company v. Cutlan*, (h) the Court of Appeal refused to allow a defendant who had fought his case before Romer, J., on twelve alleged instances of anticipation to amend by adding seven new anticipations; the remedy of presenting a petition for revocation still being open to him if his new anticipations were objections which ought to prevail.

Under the Patent Law Amendment Act of 1852, it was decided that where particulars of a vague nature were delivered, it was for the party objecting to them to apply for further particulars, as otherwise any matters falling within the general statement would be admissible at the trial. (i) Thus, in *Hull v. Bollard*, (j) Pollock, C.B., held that an objection of public user "in corn-mills for many years previously," was sufficient to admit evidence of user at certain mills in Cheshire, notwithstanding that the Statute required the particulars to specify the place or places of prior user.

The words of the Patents Act, 1883, are, however, more stringent than those in the earlier enactment; for, after providing that where a defendant disputes the validity of a patent for want of novelty, he must state the time and place of the previous publication or user alleged by him, (k) it expressly enacts that no

(d) *Aktiebolaget Separator v. Pirry Co.*, 13 R. P. C. 725.

(e) Patents Act, 1883, s. 29 (5).

(f) *Otto v. Sterne*, 2 R. P. C. 139; *Blakey v. Latham*, 6 R. P. C. 29; *Allen v. Horton*, 10 R. P. C. 412; *Westley v. Perkes*, 10 R. P. C. 186; *Badische Anilin Fabrik v. Societe Chimique*, 14 R. P. C. 881.

(g) R. S. C. Order 58, rule 4; *Cropper v. Smith*, 1 R. P. C. 81; 2 R. P. C. 17; 26

C. D. 700; *Shoe Machinery Co. v. Cutlan*, 12 R. P. C. 530; 44 W. R. 92; 65 L. J. Ch. 44; see, also, the Irish case of *Pirrie v. York Co.*, 11 R. P. C. 429.

(h) [1896] 1 Ch. 108; 12 R. P. C. 530; 65 L. J. Ch. 44.

(i) *Sugg v. Silber*, 2 Q. B. D. 493.

(j) 1 H. & N. 134; 25 L. J. Ex. 304.

(k) Sect. 29 (3).

evidence shall be admitted (except by leave) in proof of any objection of which particulars are not so delivered. (l)

The Court has a full discretion to grant or refuse the amendment. Where an applicant seeks by amendment to introduce new matter, the *onus* is upon him to satisfy the Court that the omission from the original particulars of the breach or objection sought to be added was not due to any want of diligence or proper care on his part.

Thus, in *Moss v. Malings*, (m) where the defendant applied for leave to add new objections at the trial, but did not produce an affidavit shewing that the new matter could not have been discovered earlier, leave was refused. Leave will usually be given where the Court is satisfied that the information upon which the amendment is sought only came to the applicant's knowledge recently. (n)

Generally, leave to amend particulars will only be granted on terms. The party seeking leave to amend will be required to pay the extra costs thereby occasioned to the other side; (o) and in the case of particulars of objection, the amendment will sometimes only be allowed upon the condition that the plaintiff shall have the option to discontinue the action within a specified time, all costs incurred subsequent to the delivery of the original particulars of objection being paid to him by the defendant. (p)

Following the above rule in *Ehrlich v. Ihlee*, Chitty, J., said: "It seems to me that that order is a fair order, adapted to ordinary circumstances, and one which, speaking for myself, I should adopt by way of general rule, and for these reasons: the plaintiff is told, in the first instance, as he must be told, what are the objections to the validity of his patent, and, seeing these objections, he determines to proceed with his action. Afterwards some further objection is put in, and that changes the aspect of the case so far as he is concerned; and the order provides that, although on discontinuing subsequently to the delivery of the new particulars of objections, he shall pay the general costs of the action, yet he is to get the costs intermediate between the delivery of the two sets

(l) Sect. 29 (4).

(m) 3 R. P. C. 373; 33 C. D. 603; see, also, *Shrewsbury Tyre Co. v. Morgan*, 13 R. P. C. 75.

(n) *Parker v. Maignen*, 5 R. P. C. 207; *Pirrie v. York*, 11 R. P. C. 431.

(o) *Otto v. Steel*, 2 R. P. C. 139; *Parker v. Maignen*, 5 R. P. C. 208; see,

also, *Penn v. Bibby*, L. R. 1 Eq. 548.

(p) See *Baird v. Moule*, 17 C. D. p. 139, n.; *Edison Telephone v. India Rubber Co.*, 17 C. D. 137; *Ehrlich v. Ihlee*, 4 R. P. C. 115; *Solvo Laundry v. Mackie*, 10 R. P. C. 69; *Badische Anilin Fabrik v. Societe Chimique*, 14 R. P. C. 881.

of particulars, because there has never been any issue with regard to the new particulars of objection. The plaintiff says, 'There are certain objections to my patent. Well, I meet these.' Then there comes a new objection, which he may not have been aware of at the time, and he says, 'In these circumstances I now find, knowing what the intricacies of the patent law are, that there is a valid objection to my patent which I was not aware of before, and I will discontinue my action.' That is the common case, and, I think, therefore, that this form of order is the proper order in an ordinary case." (q)

The above practice does not, however, amount to a binding rule in all cases. For the Patents Act, 1883, gives a discretion to the judge, which no practice, however inveterate, can take away. (r)

Inspection.

Jurisdiction and Object of Order.—In an action for infringement of a patent, the Court or a judge may, on the application of either party, make such order for inspection, and impose such terms and give such directions respecting the same and the proceedings thereon, as the Court or a judge may see fit. (s)

Order 50, rule 3, of the Rules of the Supreme Court also provides that it shall be lawful for the Court or a judge, upon the application of any party to a cause or matter, and upon such terms as may be just, to make any order for the detention, preservation, or inspection of any property or thing, being the subject of such cause or matter, as to which any question may arise therein, and for all or any of the purposes aforesaid, to authorize any persons to enter upon or into any land or building in the possession of any party to such cause or matter, and for all or any of the purposes aforesaid, to authorize any samples to be taken, or any observation to be made, or experiment to be tried, which may be necessary or expedient for the purpose of obtaining full information or evidence.

The jurisdiction to order inspection in patent suits was originally an equitable jurisdiction exercised only by the Court of Chancery. By the Patent Law Amendment Act, 1852, jurisdiction to order inspection in patent actions was conferred on the Courts

(q) 4 R. P. C. 117.

(r) Per Esher, M.R., in *Woolley v. Broad*, [1892] 2 Q. B. 318; 61 L. J. Q. B. 808. The above form of order was refused by Kay, J., in *Pascall v. Toope*, 7

R. P. C. 129. In *Wilson v. Wilson*, 16 R. P. C. 315, an order was made following *Woolley v. Broad*.

(s) Patents Act, 1883, s. 30; see Forms, Appendix IV. post.

of Common Law. (t) But this jurisdiction was held to extend only to the inspection of machines or instruments in use, and not to apply to books. (u)

The principles upon which the Court will act in ordering or refusing inspection are the principles upon which the Court of Chancery has always acted. (v)

The object of the Court in ordering inspection is to enable the issues before it to be properly tried, and not determined on evidence which may be mere conjecture. (w) But the Court has a wide discretion in the matter, and must be satisfied (1) that the party seeking inspection has a case to be tried, and (2) that inspection is required to place that case properly before the Court. (x)

Where the plaintiff can shew that inspection is material and really wanted for the purposes of the cause, he may obtain an order on notice to the defendant at any time after the issue of the writ of summons, even before the statement of claim is delivered. (y) A defendant may apply, on notice to the plaintiff, at any time after entry of appearance in the action. (z)

The affidavits in support of an application for inspection must shew the grounds upon which the order is alleged to be necessary to the party applying. Where the applicant did not allege in his affidavits that inspection was necessary to his case, and the other side deposed that it was not, inspection was refused. (a) The applicant should set out in his affidavit not only that he believes inspection to be necessary, but also the grounds of that belief; for if the Court thinks that belief to be founded on nothing more than suspicion, inspection will not be ordered.

In the *Germ Milling Company v. Robinson*, (b) where the patent was for an elaborate process of manufacturing meal and flour so as to separate the germ part of the grain from the meal and flour product, the plaintiff in the fifth paragraph of his affidavit in support of an order for inspection said: "The defendants are extensive corn millers at Deptford Bridge Mill, Greenwich, and

(t) 15 & 16 Vict. c. 83, s. 42.

(u) *Vidi v. Smith*, 3 E. & B. 969; 23 L. J. Q. B. 342.

(v) *Holland v. Fox*, 23 L. J. Q. B. 360; *Meadows v. Kirkman*, 29 L. J. (N. S.), Ex. 205; per Pollock, C.B., *Patent Type Founding Co. v. Lloyd*, 5 H. & N. 192; *Shaw v. Bank of England*, 29 L. J. Ex. 26.

(w) Per Lord Eldon, in *Bovill v. Moore* (1815), 2 Coop. 56.

(x) *Piggott v. Anglo-American Telegraph Co.*, 19 L. T. (N. S.), 46; see, also, *Amies v. Kelsey*, 22 L. J. Q. B. 84.

(y) *Amies v. Kelsey*, 22 L. J. Q. B. 84; *Drake v. Muntz Metal Co.*, 3 R. P. C. 43; Griff. 78; R. S. C. Order 50, rule 6.

(z) Order 50, rule 6.

(a) *Batley v. Kynoch*, L. R. 19 Eq. 90.

(b) 1 R. P. C. 217.

they have recently introduced therein machinery for reducing wheat into meal and flour by means of rolling and sifting, and I verily believe that the defendants are now manufacturing wheat into flour by means of my said invention, and by the process or means described in my said specification, or only colourably differing therefrom." Kay, J., in refusing to order inspection, said: "The first thing I have to consider is, What sort of evidence is that? There is a rule in this Court that where a person states, as he may in an affidavit upon an interlocutory motion, his belief of a fact, he must state the grounds of that belief. What are the grounds of that belief? There are absolutely none; I mean there are none stated. That means this, then: I suspect; 'I suspect' (because 'I believe' without any grounds is only 'I suspect') 'that the defendants are manufacturing according to my process.' Thereupon, without any particular, without any evidence which the Court ought to look at as being evidence of infringement, the plaintiff comes to the Court and says, 'Grant me inspection.' The defendants' answer in effect, because I am not giving the words, is 'I have a great many processes in my mill which are trade secrets, which I do not want people to inspect.' That is a very good answer until the plaintiff makes out a strong ground for inspection; but in point of fact, the whole of this pleading and evidence before me now only amounts to this: for this reason, which is not expressed, I, the plaintiff, say, 'I suspect the defendants are infringing this elaborate process of mine.' If he had said, 'The nature of the flour they produce is such that it could not have been done by any other process,' and satisfied the Court of that, that would be one thing, and it would come very nearly to the well-known case before Lord Eldon in which inspection was granted. (c) But he says nothing of the kind; and this is really no more than this, taking the pleadings and affidavits and everything which is before me, 'I suspect, and I will not tell you the grounds for suspecting, that the defendant is infringing this elaborate process of mine, and I ask for leave to go and look into his works to see whether I can make a case against him or not.' This is not the way in which the Court can grant inspection; and, therefore, at present I decline to make any order on the motion."

So, likewise, the Court will not order a roving inspection; (d) or one merely to satisfy the applicant's curiosity. (e) It must be

(c) *Bovill v. Moore*, 2 Coop. 56.

(e) *Piggott v. Anglo-American Tele-*

(d) *Cheetham v. Oldham*, 5 R. P. C. 621, 622.

graph Co., 19 L. T. (N. S.), 46.

satisfied that inspection is essential to the case of the party applying; and even then it will carefully exercise its discretion in the matter, having due regard to the interests of the parties; for inspection is never a matter of absolute right. (f) "The Court is always reluctant," said Lord Halsbury, C., in *McDougall v. Partington*, (g) "to grant inspection where it may be injurious to one side, and where the right depends on a question which has yet to be determined in the cause."

Trade Secrets.—Sometimes the party resisting an order for inspection objects that the order ought not to be made, as it will place his opponent in possession of valuable trade secrets. (h) This objection will not, however, prevent the Court making the order in a proper case. (i) But the Court will sometimes give weight to this objection, so far as to appoint some independent person to make the inspection, and to report to the Court. Thus, in the *Plating Company v. Farquharson*, (j) where the infringement complained of was the use of a process of nickel plating, Jessel, M.R., made an order that Professor Dewar, as analyst, should be allowed access to the defendant's works at all reasonable times (on giving two days' previous notice) to see the defendant's method of making his solutions and the materials used, and the method of the defendant in using those solutions in the process of nickel plating, and to take samples of the solutions and report to the Court the facts, and his opinions founded thereon; no disclosure of the report, or of facts, or opinions obtained or arrived at, to be made by Professor Dewar without the leave of the Court. At the trial this report was perused by the judge, and the leading counsel on both sides, but not otherwise disclosed, and no cross-examination of Professor Dewar was allowed.

In *Badische v. Levinstein*, (k) the defendants, who relied upon a secret process, were given the option of disclosing it or not, at the trial. They elected to do so, and the evidence was taken *in camera*, reporters and public being excluded.

In an action for infringement of a chemical patent the Court will not order the production of books containing such trade secrets of the defendants as the analysis of the products which they employ in the process they are carrying on, until the plaintiff

(f) *Piggott v. Anglo-American Telegraph Co.*, 19 L. T. (N. S.), 46; *McDougall v. Partington*, 7 R. P. C. 472.

(g) 7 R. P. C. p. 473.

(h) *Piggott v. Anglo-American Tele-*

graph Co., 19 L. T. (N. S.), 46.

(i) *Bovill v. Moore*, 2 Coop. 56.

(j) Griff. P. C. 187; see, also, *Flower v. Lloyd*, W. N. 1876, 169 & 230.

(k) 24 C. D. 156.

has established the validity of his patent. When, however, the plaintiff has done this an application for production of such books may properly be made to the judge at the trial. (l)

“It appears to me to be evident,” said Bowen, L.J., in *Rawes v. Chance*, (m) “that one litigant is not entitled to see the books containing the processes of the other litigant unless he wants it for the purposes of justice; and it seems to me to be a corollary only from that broad proposition to say that he is not entitled to see the books and papers of his antagonist until the time comes in the litigation when he wants it for such purposes. . . . What would be the opposite result? Why, that any patentee who is not working himself, might, by bringing an action for infringement against a working competitor, see laboratory processes in the books under the plea that he wanted it to prove infringement, and that he ought to succeed in getting it for that purpose, unless it could be shewn that he could not possibly want it for the purpose of infringement. The answer is, the hands of justice are not so tied; you can wait until the necessary moment comes before you give that which may turn out at that particular moment to be wanted.”

Taking Samples.—The Court, in addition to ordering inspection, will also, if necessary, order samples to be taken. (n) Apart from the provisions of Order 50, rule 3, the Court has inherent jurisdiction to do this.

Thus, in the *Patent Type Founding Company v. Walter*, (o) Wood, V.C., said: “The jurisdiction of this Court to order inspection, and, if necessary, the taking of samples for the purpose of a suit here has scarcely been contested. If a precedent is wanted, the case of *Russell v. Cowley* is in point. There specimens were allowed to be taken away, though the necessity for so doing was scarcely so great as in the present case; and that the Court when it orders inspection will not stop short of what is necessary to make the jurisdiction of the Court effectual was laid down in the case of the *East India Company v. Kynaston*.” (p)

In the *Patent Type Founding Company v. Walter*, the following order was made: “Liberty to the secretary of the company and *Dr. Frankland* (an analytical chemist) to inspect the type used for

(l) *Rawes v. Chance*, 7 R. P. C. 280; R. S. C. Order 31, rule 20. It would be otherwise, however, if it could be shewn that such books were relevant to the issue of the validity of the plaintiff's patent.

(m) 7 R. P. C. p. 281.

(n) *Russell v. Cowley*, 1 W. P. C. 457; R. S. C. Order 50, rule 3.

(o) *Johnson*, 727, p. 729.

(p) 3 Bligh, 153.

printing the *Times*. The defendant to deliver to the plaintiffs a competent part, not exceeding four ounces of type so used: liberty to apply. Costs to be costs in the cause." (q)

Foreign Manufacturers and Licensees.—Inspection of a process in a foreign manufactory cannot be granted by English Courts. But in such case the onus (where there is doubt) is upon the defendants to clearly shew that their process differs from that of the plaintiffs. (r)

Nor will the Court order inspection of the process used by the licensees of one of the parties to an infringement action, the Court having no control over licensees. (s)

The Court, in fact, will not make an order for inspection unless the articles it is desired to inspect are the property, or under the control, of the person against whom the order is made. (t)

In *Rylands v. Ashley's Patent Bottle Company*, (u) the defendants having applied for inspection, the plaintiff deposed that the machines of which inspection was sought belonged to a limited company, of which the plaintiff was director, the company not being parties to the action, and also that he was engaged in making improvements of the machines referred to, for which he was applying for letters patent, and it would be injurious to give inspection to a rival. The defendant's solicitor deposed that he believed the machines were in the power of the plaintiff. The Court held that it was not necessary that the machines should be the property of the plaintiff; and that, although under the circumstances the plaintiff ought not to be obliged to give inspection of any modifications, it would aid the Court to have inspection of the machines; that the plaintiff must make a further affidavit saying whether any of the machines were still in existence without modifications: that there was a *primâ facie* case for saying he could procure inspection, and that he must make a *bonâ fide* application to the limited company to give inspection to the defendants, and make a further affidavit as to the result of such application.

Where an order is made for inspection of machinery, the Court will not generally require the party against whom such order is

(q) Johnson, p. 732; see also *Germ Milling Co. v. Robinson*, 3 R. P. C. 11, where 93 samples were taken by the plaintiffs.

(r) *Betts v. Nilson*, L. R. 5 H. of L. 11: per Lord Westbury.

(s) *Germ Milling Co. v. Robinson*, 3

R. P. C. 13.

(t) *Garrard v. Edge*, 6 R. P. C. 372; 58 L. J. Ch. 397; *Sidebottom v. Fielden*, 8 R. P. C. 266, 270.

(u) 7 R. P. C. 175.

made to work the machinery in the presence of the other side. (v) But in a special case it may be desirable that the machinery should be so worked. (w)

In the *Singer Sewing Machine Company v. Wilson*, (x) where it was alleged that the defendant had a stock of infringing machines, no order to inspect the stock as a whole was made, but the defendant was required to verify on affidavit the various kinds of machines sold by him, and to produce one of each class for inspection. (y)

Where the Court is of opinion that inspection on one side only will be inconvenient, and tend to make the proper determination of the matters in issue more difficult on the trial of the action, it will require inspection to be given by both sides. (z)

In the *Germ Milling Company v. Robinson*, the plaintiffs having obtained an order to inspect the defendant's process and taken samples of the products, the defendants applied for a similar order against the plaintiffs. Kay, J., made the order, saying that in doing so he looked rather to the convenience of the Court than the parties, as he thought that the Court at the trial might be in difficulties if the inspection had only been on one side. (a)

An application for an order for inspection should only be made after notice to the other side. But in exceptional circumstances it has been heard and the order made *ex parte*. (b)

The right to inspection does not depend on the promptness with which the application is made, therefore laches which would be fatal to an interlocutory injunction is no ground for refusing inspection. (c)

In the Chancery Division the application for an order for inspection is made by motion in Court or on summons at chambers; in the Queen's Bench Division, by summons at chambers. (d)

(v) *Drake v. Muntz Metal Co.*, Griff. 78; 3 R. P. C. 43; *Sidebottom v. Fielden*, 8 R. P. C. 269.

(w) See North, J., in *Rylands v. Ashley's Patent Bottle Co.*, 7 R. P. C. 175; also *Russell v. Cowley*, 1 W. P. C. 457; *Davenport v. Jepson*, 1 N. R. 307.

(x) 5 N. R. 505; 13 W. R. 560.

(y) But see *Drake v. Muntz Metal Co.*, where Bacon, V.-C., said he had no power to require an affidavit to be made by the defendant: Griff. 78; 3 R. P. C. 43.

(z) *Russell v. Cowley*, 1 W. P. C. 457; *Davenport v. Jepson*, 1 N. R. 307. (See this case for form of order.)

(a) 3 R. P. C. 11. See also *Cheetham v. Oldham*, 5 R. P. C. 622.

(b) *Hennessy v. Bohmann*, W. N. 1877, p. 14.

(c) *Patent Type Founding Co. v. Walter; Johnson*, 727.

(d) See R. S. C. Order 54, rule 12; Order 55, rule 15.

Interrogatories and Discovery.

Interrogatories.—In an action of infringement, interrogatories may be delivered by either side for the examination of the opposite party, but only on leave obtained from the Court or a judge. (e) The interrogatories must be strictly limited to matters in issue in the action, and questions in the nature of cross-examination are not allowed. (f)

The statutory provision as to the delivery of particulars of breaches and of objections in patent actions do not affect the right of parties to also interrogate as in other actions. (g)

When leave to interrogate is applied for the party seeking leave must produce to the Court or judge the interrogatories which he proposes to administer to his opponent. (h) And where such opponent is willing to concede the object to which an interrogatory is directed, either by delivering particulars or making admissions, or disclosing documents, leave to interrogate in regard to that matter will be refused. (i) While thus the approval of the Court must be obtained to all proposed interrogatories, they are not to be regarded as settled by the Court, (j) and the mere fact that any given interrogatory has been allowed does not preclude the party interrogated from objecting to answer it on any good ground. (k) Although an appeal lies against the decision of a judge allowing interrogatories, the Court of Appeal is unwilling to interfere with the judge's discretion, and no such appeal will succeed unless gross injustice has been done. (l)

The party seeking to interrogate must pay into court a sum of at least five pounds (m) as security for costs, before delivering his interrogatories. If this payment is not made, the party interrogated is under no obligation to answer. (n)

The object of interrogatories and discovery is to enable parties who believe they have a case to prove that case, and not to fish out a case, where they are in doubt whether one exists. (o) In the Chancery Division leave to interrogate will not usually be given

(e) R. S. C. Order 31, rule 1.

(f) *Ibid.*

(g) *Birch v. Mather*, 22 C. D. 629; *Crossley v. Tomey*, 2 C. D. 533.

(h) Order 31, rule 2.

(i) *Ibid.*

(j) *Tye v. Willoughby*, 38 Sol. J. 338.

(k) *Peck v. Ray*, [1894], 3 Ch. 282.

(l) *Ibid.*: per Lindley, L.J.

(m) A further sum of ten shillings for any additional folio above five: Order 31, rule 26.

(n) *Eder v. Attenborough*, 23 Q. B. D. 135.

(o) *Daw v. Eley*, 2 H. & M. 725.

to a plaintiff before he has delivered his statement of claim, or to a defendant before the delivery of his defence. In the Queen's Bench Division discovery on either side is not generally allowed until after the delivery of the defence, as only then are the issues defined. (*p*)

Where the party to be interrogated is a body corporate, or a joint stock company, or any other body of persons, empowered by law to sue or be sued, whether in its own name or in the name of any officer or other person, the opposite party may apply for an order allowing him to deliver interrogatories to any member or officer of such corporation, company, or body. (*q*)

Interrogatories must be answered by affidavit filed within ten days or such other time as a judge may allow. (*r*) If the answer is insufficient, an application should be made to the Court or a judge for an order for a further answer. The judge may order such answer to be given either by affidavit or *viva voce*. (*s*)

Interrogatories are intended to assist the party administering them to prove his own case, not to search out the evidence of his opponent and ascertain the names of the opposite witnesses. (*t*)

A defendant in an infringement action may interrogate the plaintiff as to what portions of the plaintiff's patent he is charged with having infringed. But he cannot interrogate the plaintiff as to the construction of the specification, for that is a matter to be subsequently determined by the Court. (*u*) Therefore interrogatories, the relevancy of which depends on the construction of the patent, are inadmissible, for at that stage it is too early to construe the patent. (*v*)

Although a party cannot require his opponent to put a construction upon his patent in an answer to an interrogatory, he is not precluded from asking questions which involve references to specifications. Thus, a defendant may ask whether some part of

(*p*) *Mercier v. Cotton*, 1 Q. B. D. 424; 64 L. J. Q. B. 184; *Mellor v. Thompson*, 49 L. T. 422; *Harbord v. Monk*, 9 C. D. 616.

(*q*) Order 31, rule 5; see *Benno Jaffe v. Richardson*, 10 R. P. C. 137.

(*r*) *Ibid.* Order 31, rule 8.

(*s*) *Ibid.* Order 30, rule 11.

(*t*) *Daw v. Eley*, 2 H. & M. 729; *Bovill v. Smith*, L. R. 2 Eq. 459; *Delta Metal Co. v. Maxim*, 8 R. P. C. 169. But where defendants alleged by their particulars of objection prior manufacture

and sale generally for fifty years prior to the patent in London, North, J., allowed the plaintiffs to interrogate the defendants as to the names, places and dates of such prior users and use. See *Alliance White Lead Syndicate v. McIvor*, 8 R. P. C. 321; *Birch v. Mather*, 22 C. D. 629.

(*u*) *Moseley v. Victoria Rubber Co.*, 3 R. P. C. 352; *Delta Metal Co. v. Maxim*, 8 R. P. C. 172.

(*v*) *Delta Metal Co. v. Maxim*, 8 R. P. C. 171.

the plaintiff's invention is not a mere mechanical equivalent for a contrivance described in some other named specification, or whether that other specification does not contain some device claimed by the plaintiff; for these are questions of fact. (*w*)

"The defendant," said Giffard, L.J., in *Hoffman v. Postill*, (*x*) "has a right to ask all questions which are fairly calculated to shew that the patent is not a good patent, or that what the plaintiffs allege to be an infringement is not an infringement. It is almost impossible, where you have antecedent publications in a book or antecedent patents which are alleged to destroy the novelty of the succeeding patent, whether it be in examining the parties by interrogatories, or in examining witnesses, to avoid the necessity of referring to those documents, and asking a variety of questions respecting them, some of which are more proper for the Court, but many of which are absolutely essential in order to enable the Court to come to a proper conclusion as to the legal effect of the different specifications."

Where interrogatories are answered, they should be answered fully. (*y*) Everything shewing, or tending to shew, the fact of infringement must be set out in the answer to the full extent of the interrogatory. (*z*)

A defendant is entitled to discovery as to all matters of fact which are or may be material to his case; and where he relies on the invalidity of the plaintiff's patent, everything that is material to shew that, is part of his case. (*a*)

Discovery of the names and addresses of the defendant's customers, which is inadmissible before infringement is proved, may be had after the trial of that issue; (*b*) and the circumstance that such discovery may expose other persons to actions is no ground for refusing to give the fullest information. (*c*) On an enquiry as to damages the plaintiff is entitled to know not only the names of the defendant's customers, but also the prices of his sales. (*d*)

In an action against a licensee for an account, the defendant must answer interrogatories as to the names and addresses of customers with whom he has effected sales. (*e*)

(*w*) *Hoffmann v. Postill*, L. R. 4 Ch. 673.

(*x*) *Ibid.* p. 681.

(*y*) *Swinborne v. Nelson*, 16 Beav. 416; 22 L. J. Ch. p. 335; *Elmer v. Creasy*, L. R. 9 Ch. 69; 43 L. J. Ch. 166.

(*z*) *De La Rue v. Dickenson*, 3 K. & J. 391.

(*a*) *Hoffman v. Postill*, L. R. 4 Ch. 678.

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

(*c*) *Tetley v. Easton*, 18 C. B. 643.

(*d*) *American Braided Wire Co. v. Thomson*, 5 R. P. C. 375.

(*e*) *Ashworth v. Roberts*, 7 R. P. C. 451; L. R. 45 C. D. 623; 60 L. J. Ch. 27.

Interrogatories tending to incriminate the person answering them or to expose him to penal consequences, need not be answered. (*f*)

Discovery.—Any party to an action of infringement may, without filing an affidavit, apply to the Court or a judge for an order directing any other party to the action to make discovery on oath of any documents which are, or have been in his possession or power, relating to any matter in question in the action. The judge has a discretion to make or refuse the order, or to adjourn the application. Discovery will not be ordered unless it is necessary for disposing of the action, or for saving costs. (*g*)

Where a party has made an affidavit of the documents in his possession, the Court will not generally allow the other side to interrogate him as to documents, for that amounts to a cross-examination upon his affidavit, which is inadmissible. But if the Court is satisfied that some particular relevant document, undisclosed by the affidavit, may be in his possession, it may, on special application, allow an interrogatory as to that; but only on a *prima facie* case being shewn. (*h*)

Where the documents disclosed by an affidavit of documents shewed that the party making the affidavit probably had other relevant documents in his possession, the Court of Appeal held that the proper remedy was for the other side to apply for an order that a further affidavit should be made, such order to be in general terms, but specially referring to the particular documents known not to have been disclosed. (*i*) In this case it was laid down that the order ought to be made in a general form, because the Court assumes that where particular documents have been withheld there may be others which the deponent, under an equally erroneous opinion as to relevancy, has also failed to disclose. (*j*)

At what Time Discovery will be Ordered.—It is often material to consider the time at which the discovery is asked; if premature, it may be refused on that ground. (*k*) Thus, interrogatories directed to matters not necessary for the trial of the action are inadmissible, even if these matters may subsequently need to be enquired into. (*l*) Where, for instance, infringement is admitted,

(*f*) As to this and the other grounds generally on which answers may be refused, see the *Annual Practice*; R. S. C. Order 31, rule 1, and notes.

(*g*) R. S. C. Order 31, rule 12.

(*h*) *Hall v. Truman*, 29 O. D. 307; *Edison v. Holland*, W. N. [1888], p. 31; 5

R. P. C. 217.

(*i*) *Bown v. Sansom*, 5 R. P. C. 510.

(*j*) *Ibid.* per Bowen, L.J.

(*k*) R. S. C. Order 31, rule 20.

(*l*) *De La Rue v. Dickenson*, 3 K. & J. 388; 29 L. T. 194.

and the only issue the validity of the patent, questions regarding the names of the defendant's customers will not be allowed till after the trial, as they are not relevant until the plaintiff has established the validity of his patent. (m)

In *Benno Jaffé v. Richardson*, (n) interrogatories were delivered by the plaintiffs asking the defendant, *seriatim* (following the plaintiffs' specification), whether he had used the processes claimed by the plaintiffs. The defendants, who impeached the validity of the patent, declined to answer some of the interrogatories, on the ground that at that stage of the proceedings, before the validity of the patent had been established, they were not relevant; it being possible that the issue of infringement might never have to be tried. North, J., in ordering further answers, said: "A very salutary alteration has been made by giving the Court a discretion now which it used not to have, both as to saying whether discovery shall be given at a particular stage or postponed to a later stage, as well as that of refusing it altogether. But if that means what it is contended it does mean, that in every patent action in which invalidity is set up—that is to say, in every patent action ever launched—there is first to be a deliberate trial before the judge and jury, if necessary, of the validity of the patent, and that it is only after that has been settled there are issues to be raised, and discovery obtained by interrogatories and otherwise, with regard to the question of infringement, the benefit gained by getting rid of the waste of time and money in answering interrogatories will be far more than made up for by the increased waste of time and money involved in having two trials of every patent action in which the plaintiff succeeds in establishing his patent instead of one. In my opinion, that is not the meaning of the rules, and it would have a very bad effect if that was so. It is intended to give the Court the opportunity of saying that discovery should not be given before the trial of the action, unless it is wanted for the purposes of the trial, that is to say, if a mortgagor wants to redeem an estate, and it is denied that he has a right to redeem at all, it is quite useless going into any questions of accounts until it is known whether there is such a right or not, and then if that right is established at the trial, the taking the accounts afterwards is a matter of course. . . . But in the case of a patent it is different. No doubt validity is one thing, and infringement another; but they both have to come on to be tried at the same time, and

(m) *Lister v. Norton*, 2 R. P. C. 68;
Crossley v. Tomey, 2 C. D. 533.

(n) 10 R. P. C. p. 139; 62 L. J. Ch.
p. 712.

the parties must come before the Court ready to deal with both cases at the one trial. If the present contention was right, that discovery was to be postponed until the validity of the patent was tried, discovery by interrogatories would be refused altogether, because it could not practically be given then."

Privilege.—Certain matters are privileged from discovery either by interrogatories or disclosure of documents.

Thus, no party is bound to answer interrogatories as to what advice has been given him by his solicitor; and documents which have come into existence merely to be communicated to a party's solicitor for the purpose of litigation, actual or intended, either as materials for briefs or for his advice or consideration are privileged from production. (o)

"The true principle," said Lord Cottenham, in *Nias v. North Eastern Railway Company*, (p) "is, that parties are to be at liberty to communicate with their professional advisers with respect to matters which become the subject of litigation, without restriction, and without the liability of being afterwards called upon to produce or discover what they shall so have communicated; whether a bill is or is not actually filed at the time is, to my mind, a matter of perfect indifference." (q)

This privilege is, however, limited to communications with legal advisers, and does not extend to patent agents. Thus, where the solicitor was also a patent agent, the Court held that the privilege only attached to the communications made to him in his capacity as solicitor. (r)

In *Westinghouse v. Midland Railway Company*, (s) reports and letters sent to the company by its officers after the company had been warned that it was infringing a patent, were held not to be privileged.

Affidavits and notes of evidence in a former infringement action have been required to be produced. (t)

Sometimes when a defendant is interrogated as to the process by which he arrives at the product alleged to be an infringement, he seeks to shelter himself from answering on the ground that his process is a trade secret, which he ought not to be called upon to divulge. In such case the Court, if satisfied that the

(o) *Haslam v. Hall*, 5 R. P. C. 9.

(p) 3 My. & Cr. 357.

(q) See, also, Lord Selborne, C., in *Minet v. Morgan*, L. R. 8 Ch. 367.

(r) *Moseley v. Victoria Rubber Co.*, 3

R. P. C. 351; 55 L. T. (N. S.), 482.

(s) 48 L. T. (N. S.), 98, 462.

(t) *Bown v. Sansum*, 5 R. P. C. 510; *Thomson v. Hughes*, 7 R. P. C. 187.

objection is taken *bonâ fide*, will as far as possible protect the defendant. (u)

But the mere plea of a secret process is no ground for refusing discovery where the nature of that process is material to the issues in the action. (v)

“I quite agree,” said Kekewich, J., in *Ashworth v. Roberts*, (w) “that a 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, and I think the Court is, and will be, strong enough to prevent his being obliged to disclose that which need not be disclosed for the purposes of the trial of the action.”

In *Renard v. Levinstein*, (x) Wood, V.C., while requiring the defendant to answer whether he used the materials mentioned in the plaintiff's specification, and whether other additional materials, excused the defendant from stating what preparations he employed and from naming the other materials he used, when the defendant alleged that full answers would disclose secrets on which his trade depended.

In another case where this objection was taken to answering questions in Court on the trial, Pearson, J., appointed a neutral expert to inspect the defendant's process and report. (y)

Trial of the Action.

Procedure on Trial.—The Court or a judge may at any time order different questions of fact arising in the same action to be tried by different modes of trial, or that one or more questions of fact be tried before others. (z) The Court has refused, in an infringement action, to try the question of infringement separately from that of the validity of the patent where both were in issue. (a)

Where it has seemed probable that the trial of one issue would decide the whole action, that issue has been taken first. (b)

Under the Arbitration Act, 1889, the Court has power to compulsorily refer actions involving any prolonged examination of documents, or any scientific investigation which cannot be

(u) *Benno Jaffé v. Richardson*, 10 R. P. C. 156; 2 R. P. C. 73
C. 139; 62 L. J. Ch. 712.

(v) *Ashworth v. Roberts*, 7 R. P. C. 451.

(w) *Ibid.* p. 455.

(x) 3 N. R. 665.

(y) *Badische v. Levinstein*, 24 C. D.

(z) R. S. C. Order 36, rule 8.

(a) *United Telephone Co. v. Mottishead*,
3 R. P. C. 213.

(b) *Richardson v. Castray*, 4 R. P. C.

265; *Badham v. Bird*, 5 R. P. C. 238.

conveniently conducted by the Court through its ordinary officers, to a referee or arbitrator for trial. (c) This jurisdiction has not been exercised hitherto in patent cases. (d)

Evidence.—On the trial of the action the plaintiff begins, and where (as will usually be the case) the validity of the patent as well as the infringement is disputed, he must first prove his title to the monopoly. This should be done by producing the letters patent sealed with the seal of the Patent Office. (e) Where the plaintiff is not the original patentee, but an assignee, the devolution of the patent and the registration of the assignment in the Register of Patents must be duly proved.

The registration may be proved by the production of a certified copy of the entry in the register. (f) Specifications, disclaimers, and other documents in the Patent Office, or extracts from them, may be proved by printed or written copies purporting to be certified by the comptroller and sealed with the seal of the Patent Office. (g)

Where the patent is attacked on the ground of want of subject-matter, evidence may be called in chief to shew that the invention was only found out after experiments and labour. (h)

The specification must be left to speak for itself, as its construction, like that of any other written document, is for the Court alone to decide. The patentee, therefore, may not be called to state what he meant by it; though, like any other expert, he may be called to assist the Court by explaining the state of knowledge at the date when it was filed. (i)

Apart from the rule excluding oral evidence in explanation of written documents, a specification which required to be supplemented by statements of the patentee to enable the public to perform the invention would be bad. Technical expressions and terms of art may, however, be explained by witnesses conversant with the subjects to which they relate.

Where the sufficiency of the specification is challenged, evidence must also be given to prove that a person following the instructions contained therein can successfully perform the invention. For this purpose a workman of average skill and knowledge in the

(c) Sect. 14.

(d) As to a similar jurisdiction under the Judicature Act, 1873, s. 57, see *Saxby v. Gloucester Waggon Co.*, W. N. 1880, p. 28. But this case was prior to the Patents Act, 1883.

(e) Patents Act, 1883, ss. 12 (2) & 81.

(f) *Ibid.* ss. 23 & 89.

(g) *Ibid.* s. 89.

(h) *Thierry v. Riekmann*, 12 R. P. C. 417.

(i) Per Lord Herschell, in *Balische v. Levinstein*, 12 App. Ca. pp. 717, 718.

subject-matter of the patent is preferable to a highly trained person or scientific expert, whose skill might lead him to perform the invention even when the specification was defective, by correcting rather than following its directions. (*j*)

It may happen, however (as in the case of a chemical patent), that the invention is some extremely subtle process, which can only be described in novel terms of abstruse science which have not yet passed into the vocabulary of the practical chemist; in such case it is not only permissible, but necessary, to call a theoretical witness of the most advanced knowledge to prove the sufficiency of the specification, for he alone is the class of person to whom such a specification is addressed. (*k*)

Evidence of Experts.—Experts in giving their evidence have a tendency to become advocates rather than witnesses; when this happens their evidence is not viewed with much favour by the Courts. (*l*) The subject-matter of patent actions is, however, so technical and complicated as to make it generally impossible to dispense with this class of evidence.

Experts are usually called to explain the working of the invention and indicate its characteristic features. Such witnesses are also required to prove the existing state of knowledge at the time of the patent grant, and to shew what step in advance the patentee has made. But when expert witnesses pass from statements of fact to expressions of opinion, it is necessary to elicit the grounds of their opinions, for such opinions are, in themselves, no evidence, and, apart from the grounds on which they are based, ought to have no weight with the Court. (*m*)

Thus, in proving the infringement complained of, it is not permissible to ask an expert witness whether, in his opinion, what the defendant has done amounts to infringement of the plaintiff's patent; for that is the question the Court, and not the witness, has to determine. (*n*) But such a witness may be asked to indicate in what respects, if any, the defendant's method or process differs from that of the plaintiff, and whether any such differences or variations are or are not mechanical or chemical equivalents. (*o*)

In this way the grounds upon which a witness arrives at his

(*j*) See Jessel, M.R., in *Plimpton v. Malcolmson*, 3 C. D. 569.

(*k*) Per Fry, L.J., in *Badische v. Levinstein*, 29 C. D. 406; Griff. P. C. 37.

(*l*) *Thorn v. Worthing*, 6 C. D. 416, n.

(*m*) *Seed v. Higgins*, 8 H. of L. Ca. 550;

Leadbeater v. Kitchen, 7 R. P. C. p. 247; *Brooks v. Steele*, 14 R. P. C. p. 73.

(*n*) *Parkinson v. Simon*, 11 R. P. C. p. 506 (per Esher, M.R.).

(*o*) *Ticket Punching Co. v. Colley*, 12 R. P. C. 186 (per Smith, L.J.).

conclusion are evidence, though the conclusion itself is inadmissible.

“It is necessary,” said Lindley, L.J., in *Brooks v. Steele*, (p) “to examine each patent separately, and to ascertain first what the patented invention really is; and, secondly, whether the defendants have used that invention. In this, as in all cases, the nature of the invention must be ascertained from the specification, the interpretation of which is for the judge, and not for any expert. The judge may, and indeed generally must, be assisted by expert evidence to explain technical terms, to shew the practical working of machinery described or drawn, and to point out what is old and what is new in the specification. Expert evidence is also admissible, and is often required to shew the particulars in which an alleged invention has been used by an alleged infringer, and the real importance of whatever differences there may be between the plaintiff’s invention and whatever is done by the defendant. But, after all, the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the judge, and not by a jury, nor by any expert nor other witness. This is familiar law, although apparently often disregarded when witnesses are being examined.”

Proof of Infringement.—The plaintiff must prove that the defendant has put the invention in practice without his authority. Making, using, or selling, are all equally infringement. (q) If the defendant is charged merely with selling or using, the plaintiff will also have to prove that the articles sold or used were not made by himself or his agents; (r) for an article made and sold by the patentee, unless sold with a restricted licence, is licensed for re-sale or subsequent use in the hands of any other person.

The owner of an English patent manufactured the patented article in France as well as in England. In a suit to restrain the sale of the article in England, the plaintiff proved that it was not made at his manufactory in England, but could not prove that it was not made at his manufactory in France. The bill was dismissed with costs by James, V.C.; and, on appeal, the decision below was affirmed. Lord Hatherley, C., said: “I apprehend that, the onus being upon the plaintiff to shew, not merely that the thing made is his own patented article, but that it has been unlawfully sold, he must be prepared to swear distinctly that it is not manufactured

(p) 14 R. P. C. p. 73.

(q) See ante, p. 403, Chap. XXI.

(r) *Betta v. Willmott*, L. R. 6 Ch. 239.

by him or his agent. Suppose that he had three houses of manufacture—one in the north of England, one in the west of England, and one in London—I cannot doubt that it would be his duty, in making out his case before a jury, to prove not only that the article was of the same description as the patented articles, but that it was not made by himself; and, for that purpose, he would have to call as witnesses persons who had control of his houses in the north and west, as well as in London, to shew that the article was not made by them.” (s)

Where the patentee shews that from the construction of the article complained of it is almost certain that it must have been made according to his method, this is *primâ facie* evidence of infringement, and if not rebutted by the defendant proving that in fact the article was not so made—is sufficient to support a verdict for the plaintiff. (t) Thus in *Huddart v. Grimshaw*, (u) Lord Ellenborough, C.J., reviewing the evidence, said: “*Mr. Rennie* says, I know of no other mode than *Mr. Huddart’s* for producing this effect, and in proportion as that is deviated from the strands will be worse; this piece of rope (v) exhibits to the eye that gradation of length in the different shells which he should expect to find in *Mr. Huddart’s* invention. I should state that this is certainly what is called *primâ facie* evidence of its having been made by that method; when one sees it agree in all its qualities when it is produced with a rope actually made upon *Mr. Huddart’s* plan, it is *primâ facie* evidence, till the contrary is shewn, that it was made upon his method, and therefore, as against him it should seem, supposing this patent in full force and a valid one, it is reasonable, fair evidence, in the absence of contrary evidence, to presume that it was made that way.”

In *Hall v. Jarvis*, (w) the plaintiff’s invention consisted in a method of burning off the superfluous fibres from lace or net without injuring the fibre. This he accomplished by applying a gas flame to the surface of the fabric. It was proved that lace delivered by the defendants had the exact appearance it would have presented if dressed according to the patented process. It was also proved that one of the defendants had a gassing machine on his premises; that his gas fittings had been tampered with,

(s) *Betts v. Willmott*, L. R. 6 Ch. M.R.
p. 243.

(t) See *Neilson v. Betts*, 5 H. of L.
p. 11 (per Lord Westbury); *Thorn v.*
Worthing, 6 C. D. 416 n. (per Jessel,

(u) 1 W. P. C. 91.

(v) The infringement complained of.

(w) 1 W. P. C. 100.

and that the gas consumed by him had been largely in excess of the amount required for mere lighting purposes. On this evidence, Abbott, C.J., directed the jury to find a verdict for the plaintiff.

The principle that where the article complained of closely resembles the patented invention, the Court will assume that it has been made by an infringing process until the contrary is shewn, is specially applicable in the case of a foreign made article, as the patentee in that case cannot have inspection of the defendant's process or manufactory, and has therefore no means of more direct proof. (x)

If, however, the Court is satisfied that the article might have been made by another process, this principle has no application.

In the *Cartsburn Sugar Company v. Sharp*, (y) the complainers sought protection against the acts of the respondents, who, they alleged, were selling in Scotland cubes of sugar made in America by an apparatus for which the complainers held a patent by assignment.

“It is said that as the manufacture complained of had taken place in America,” said Lord Kinnear, “it was incumbent on the respondents, upon the principle which received effect in the case of *Neilson v. Betts*, to prove by negative evidence that it was not manufactured according to the 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 complainers' 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.” (z)

In the *Welsbach Incandescent Gas Light Company v. New Incandescent Company*, (a) the plaintiffs relied for proof of the infringement complained of, upon admissions in defendants' answers to interrogatories, and Buckley, J., held these to afford sufficient proof.

Amending the Particulars.—As already noticed, both sides at the trial are tied down by their particulars, (b) and unless

(x) *Neilson v. Betts*, 5 H. of L. 11.

(y) 1 R. P. C. 179.

(z) *Ibid.* p. 186.

(a) 17 R. P. C. 237; 16 T. L. R. 205.

(b) *Supra*, pp. 484, 488, 494.

leave is given to amend, are not entitled to call evidence outside the particulars delivered. The Court has, however, a discretion under Section 29 (4) of the Patents Act, 1883, independently of the provisions dealing with amendment, to admit fresh evidence at the trial, the object of giving such discretion being to enable the Court to get at the real facts and do justice between the parties. (c)

The Court does not encourage applications at the trial for leave to amend the particulars, as such applications where granted must generally involve an adjournment to give the other side the opportunity of meeting the fresh evidence thus admitted. In *Moss v. Malings*, (d) North, J., said he would only grant leave to amend at the trial if satisfied that the matter of the amendment was recently discovered and could not with reasonable diligence have been discovered before. In *Shrewsbury v. Morgan*, (e) an infringer applied at the trial for leave to amend by raising the new objection that the patent was bad by reason of variance between the title and the claims; but Romer, J., refused the application as being made too late.

Amending the Specification.—In an action for infringement of a patent, the Court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or a judge may impose, be at liberty to apply to the Patent Office for leave to amend his specification by way of disclaimer, and the Court may further direct that in the meantime the trial or hearing of the action shall be postponed. (f)

It will be noticed that the amendment here provided for is only by way of disclaimer (g). It sometimes happens that during the trial of an action the patentee discovers that the drag-net of his claim has been thrown too wide, and that a patent otherwise good is avoided by the inclusion in the claim of something which is not new. Such a patent can be saved by disclaimer.

If the judge is satisfied at the trial that the proposed disclaimer will not make the patent good, he ought to refuse leave. (h) If he does so the Court of Appeal will not interfere with the exercise of his discretion unless clearly satisfied that injustice has been done. (i)

(c) *Britain v. Hirsch*, 5 R. P. C. 231.

(d) 3 R. P. C. 373; 38 C. D. 604; Griffin, 167.

(e) 13 R. P. C. 75

(f) Patents Act, 1883, s. 19. See Amendment of the Specification, pp. 274-279, supra.

(g) *Owen's Patent*, [1899] 1 Ch. 157; 68

L. J. Ch. 63; 70 L. T. 458; 47 W. R. 180.

(h) *Armstrong's Patent*, 14 R. P. C. 747;

see, also, *Dellwick's Patent*, [1896] 2 Ch. 705; 13 R. P. C. 591.

(i) *Ibid.* As to amendment pending action but prior to trial, see ante, p. 278.

Leave in any case will only be given on terms. The words "costs and otherwise" are of the widest description, and give the judge an ample discretion to impose any terms he may think the justice of the case requires. (*j*)

The conditions that no damages shall be asked or injunction claimed in respect of anything done prior to the amendment have been held to be proper terms. (*k*) And generally the plaintiff will be required to pay all the costs of the action up to the time of the amendment. But each case depends on its own circumstances.

In *Meyer v. Sherwood*, (*l*) Smith, L.J., gave leave to apply to amend the specification at the close of the trial; the comptroller allowed the amendment, and the defect in the specification was apparently cured; notwithstanding which, Smith, L.J., gave judgment for the defendants with costs, and the Court of Appeal held that this was right (the application to amend having been made so late), but suggested that liberty might properly have been reserved to the plaintiffs to bring another action for an injunction if so advised.

In *Chatwood's Patent Company v. Mercantile Bank of Lancashire*, (*m*) liberty to apply for leave to amend the specification was given twice in the same action by North, J.

Models, if produced at the trial, ought to be properly proved and put in evidence. But the Court has looked at a model, not in evidence, to aid it in understanding the descriptions of counsel. (*n*)

Once a model has been produced and put in evidence at the trial, the party producing it must, if the case is appealed, produce it in the Court of Appeal in the same state in which it was when used below. He must not tamper with it even for purposes of cleaning and renovation. (*o*)

Matters Res Judicata.—Where a Court has construed the specification of a patent, an inferior Court or a Court of co-ordinate jurisdiction will follow that construction in a subsequent action on the same patent, for the construction is a question of law. (*p*)

(*j*) *Lang v. Whitecross*, 7 R. P. C. p. 392.

(*k*) *Ibid.*; *Ludington Cigarette Machine Co. v. Baron Cigarette Machine Co.*, 17 R. P. C. 25.

(*l*) 7 R. P. C. 287.

(*m*) 17 R. P. C. 23.

(*n*) *Boyd v. Horrocks*, 6 R. P. C. 125.

(*o*) *Winby v. Manchester Steam Tramways Co.*, 8 R. P. C. 63.

(*p*) *Edison v. Holland*, 6 R. P. C. 243; see, also, *Slazenger v. Feltham*, 6 R. P. C. p. 234 (per Cotton, L.J.). In this case the Court of Appeal held that Kekewich, J., was right in following a prior decision of North, J., on the same patent, that it had

But the findings of one Court on questions of fact will not debar another Court from trying the same questions of fact over again upon other evidence in an action against another infringer. (*q*) Where, however, the second action is against the same defendant he will not be allowed to dispute the validity of the patent (even on new evidence) if that issue has been found against him in the first action, as it is then *res judicata* between the parties. (*r*)

On this principle a defendant who has submitted to an injunction cannot in a subsequent action for infringement dispute the validity of the patent which he has already admitted by his submission. (*s*)

Surprise.—If a party to an action is taken by surprise at the trial, his proper course is to apply for an adjournment. If he does not do so, but elects to take his chance of a verdict, the Court of Appeal will not afterwards, when that verdict has gone against him, allow him to adduce fresh evidence on appeal. (*t*)

Secret Process.—Where defendants alleged that the process they followed was a trade secret, the Court allowed their evidence at the trial to be heard *in camera*. (*u*)

Irrelevant Issues.—In action of infringement when the plaintiff does not allege that the defendant threatens or intends to continue infringing, evidence of acts of infringement subsequent to the issuing of the writ is inadmissible, and if no infringement prior to the writ is proved, the defendant is entitled to judgment. (*v*)

The Court will not generally go into issues, the trial of which is not necessary to its decision. Thus, where the patent is found invalid the question of infringement will generally become immaterial. (*w*)

Costs where Defendant Submits.—Sometimes a defendant on being sued by the patentee submits, and a question arises as to whether the plaintiff is entitled to proceed only to recover his costs.

In *Upmann v. Elkan*, (*x*) (a trade mark case), Lord Romilly

sufficient utility and invention to be good subject-matter. See also *Dunlop Pneumatic Tyre Co. v. New Ixion Co.*, 16 R. P. C. 16; *Tweedale v. Ashworth*, 16 R. P. C. 142.

(*q*) *Shaw v. Day*, 11 R. P. C. 189; see, also, *Slazenger v. Feltham*, 6 R. P. C. 130. Anticipation is a question of fact.

(*r*) *Shoe Machinery Co. v. Cutlan*, 13 R. P. C. 395.

(*s*) *Moore v. Thomson*, 7 R. P. C. 325.

(*t*) *Barcroft v. Smith*, 14 R. P. C. 172

(*u*) *Badische v. Levinstein*, 2 R. P. C. 73; 24 C. D. 156; 52 L. J. Ch. 704.

(*v*) *Shoe Machinery Co. v. Cutlan*, 12 R. P. C. 357; [1896] 1 Ch. 667; *Welsbach Incandescent Gas Light Co. v. Dowle*, 16 R. P. C. 395.

(*w*) *Tubeless Pneumatic Tyre v. Trench Tyre Co.*, 16 R. P. C. 291.

(*x*) L. R. 12 Eq. 140; L. R. 7 Ch. 130; 41 L. J. Ch. 246.

(affirmed on appeal by Lord Hatfield, C.) held that defendants guilty of a mere technical infringement, who on having it brought to their notice, offered before bill filed to give the plaintiffs all reasonable assistance for the enforcement of their rights against the real infringers, ought not to be made to pay costs.

So, too, in *Betts v. Willmott*, (y) James, V.C., held that an innocent vendor of an infringing article, who was willing to stop selling, and who before suit gave full information to the patentee, ought not to have costs given against him, or, in fact, to be sued at all.

In the *American Tobacco Company v. Guest*, (z) (also a trade mark case), where the infringement was trifling, the plaintiff, though held to be entitled to his injunction, was refused costs. (a)

Where, however, the infringement, though innocently committed, is substantial, the fact that the infringer on receiving the writ and notice of motion acquiesces in all that the plaintiff wants, has been held to be no reason for not giving the plaintiff the costs of the writ and motion for an injunction. (b)

A patentee is not bound to give notice to an infringer before commencing an action against him; but if he does so, and is offered complete satisfaction, his wiser course is generally to accept satisfaction and not commence legal proceedings.

Thus, in *Lyon v. the Mayor of Newcastle-on-Tyne*, (c) where the plaintiff before action was informed that the defendants did not dispute his patent right, and had not used, and were prepared to undertake not to use the machine complained of, Kekewich, J., held that a motion for an injunction was unnecessary, and on the defendants giving the undertaking originally offered, allowed them their costs of the motion.

Each case must, however, depend on its own particular circumstances, and if from the conduct of the defendant the patentee is justified in suspecting a want of good faith, and fearing a recurrence of the injury, he is entitled to protect himself by obtaining an injunction.

A party to an action who advertises an unfair report of the proceedings on an interlocutory motion therein, for the purpose of putting before the trade and his own customers a version of facts

(y) 18 W. R. 947; see, also, *Nunn v. D'Albuquerque*, 34 Beav. 595.

(z) 9 R. P. C. 218; L. R. [1892] 1 Ch. 630; 61 L. J. Ch. 242.

(a) See, also, *Jenkins v. Hope*, 13 R. P. C. 57.

(b) *Upmann v. Forester*, 24 C. D. 231 (per Chitty, J.); *Wittmann v. Oppenheim*, 27 C. D. 260; 54 L. J. Ch. 56 (per Pearson, J.).

(c) 11 R. P. C. 218.

which will lead to his own profit, is liable to be committed for contempt, and even where he gives an undertaking not to continue the advertisement, may be made to pay the costs of the motion. (d)

Injunction.

Three remedies are open to the patentee who has successfully prosecuted an action against an infringer—an injunction, delivering up or destruction of the infringing articles, and damages, or an account of profits. These will now be considered.

Where an Injunction is the Proper Remedy.—Where the Court is satisfied that infringement has been committed, and that there is a probability that it will be repeated, an injunction will usually be granted. In such a case the plaintiff has *prima facie* established his right to an injunction, and the Court will require exceptional circumstances to be shewn to induce it to refuse this relief. (e)

There must, however, be a probability that the infringement is going to be repeated. An injunction is a remedy against future injury, and the Court will not make the order if satisfied that no such injury is likely to occur.

“It is not because a man has done a wrong,” said Cotton, L.J., in *Proctor v. Bailey*, (f) “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.”

“An injunction, be it borne in mind,” said Fry, L.J., in the same case, “is granted under a preventative jurisdiction of this Court, is addressed to the prevention of an injury which is about to be done, or which the Court sees the probability of being done, and is not rightly described as a protective jurisdiction. . . . What has been pressed upon us, and what is really the only ground,

(d) *Edlin v. Pneumatic Tyre Agency*, 10 R. P. C. 317; cf. *Fenner v. Wilson*, in which the advertisement issued was held by the Court of Appeal not to amount to a contempt. But an undertaking not to repeat it was required: 10 R. P. C. 113.

(e) *Shelfer v. City of London Electric Lighting Co.*, [1895] 1 Ch. 317 (per Lindley, L.J.).

(f) G R. P. C. pp. 541, 542; 59 L. J. Ch. 13; 38 W. R. 101; 61 L. T. 754; 42 C. D. 393.

on the part of the plaintiff, is that the defendants have, whilst admitting that they did what they did, said, 'We had a right to do it'—as I think a very foolish and idle statement on the part of the defendants, but regarded in the light of the existing circumstances, a statement which seems to me not to raise the probability of a repetition of the wrongful acts of the defendants." (g)

Where an Injunction will be Refused.—The exceptional circumstances which will justify the Court in refusing an injunction when an infringement is proved, and future infringements probable, were discussed by the Court of Appeal in *Shelfer v. City of London Electric Lighting Company*. (h) After laying down the rule that in such cases an injunction will usually be granted, Smith, L.J., said: "There are, however, cases in which this rule may be relaxed, and in which damages may be awarded in substitution for an injunction. In any instance in which a case for an injunction has been made out, if the plaintiff by his acts or laches has disentitled himself to an injunction, the Court may award damages in its place. . . . In my opinion, it may be stated as a good working rule that—(1) If the injury to the plaintiff's rights is small, (2) and is one which is capable of being estimated in money, (3) and is one which can be adequately compensated by a small money payment, (4) and the case is one in which it would be oppressive to the defendant to grant an injunction: then damages in substitution for an injunction may be given. There may also be cases in which, though the four above-mentioned requirements exist, the defendant by his conduct . . . has disentitled himself from asking that damages may be assessed in substitution for an injunction. It is impossible to lay down any general rule as to what, under the differing circumstances of each case, constitutes either a small injury, or one that can be estimated in money, or what is a small money payment, or an adequate compensation, or what would be oppressive to the defendant. This must be left to the good sense of the tribunal, which deals with each case as it comes up for adjudication."

In *Jenkins v. Hope*, (i) where the value of the infringing goods sold by certain defendants amounted to about nine guineas only, and those defendants were willing to give a perpetual undertaking not to infringe, North, J., being satisfied that they had acted in ignorance of the plaintiff's patent right, refused an injunction against them, as he did not consider that under the circumstances

(g) 6 R. P. C. pp. 545, 546.

(h) L. R. [1895] 1 Ch. p. 321.

(i) 13 R. P. C. 57.

he ought to give the plaintiff the opportunity of advertising these defendants' names as persons who had infringed his patent.

In *Marshall v. Marshall*, (j) where the defendant was outside the jurisdiction, an injunction was sought against him and his agents. The Court refused the order, because, as it was only enforceable by attachment, it could not be made effective against the principal offender, but only against the minor wrong-doers—his agents within the jurisdiction.

Here, however, the principal infringer was resident in Scotland, and the patentee had therefore his remedy by an action in the Scottish Courts; a circumstance which influenced the Court in refusing the relief.

Where the principal defendants were a company with their registered office in Scotland, but holding property in England, the Court granted an injunction; as an injunction can be enforced against a company by sequestration of its property. (k)

In *Elmslie v. Boursier*, (l) an injunction was granted against a French manufacturer who was importing into England goods made in infringement of an English patent.

To induce the Court to grant an injunction a probability of future injury must, as above stated, be shewn. Thus, where the only infringement proved had been discontinued five years before action, an injunction was refused. (m)

But past infringement of recent date is *prima facie* evidence of an intention to continue the wrong done; (n) and if just before action a defendant has committed infringement for profit, he will not escape an injunction by saying he will not do it again; for the proper inference from a very recent act of misfeasance is a probability that it will be repeated. (o)

Where, however, the infringer has acted in ignorance of the patent right, the same inference does not arise from past infringement; and the Court in such case has refused an injunction (p) or accepted an undertaking instead. (q)

Proof of Past Infringement not Required.—Nor is it necessary to entitle a patentee to an injunction that actual past infringement should be proved. The Court looks to the future rather than the

(j) 38 C. D. 330.

(k) *In re Burland's Trade Mark*, 41 C. D. pp. 544, 545.

(l) L. R. 9 Eq. 217.

(m) *Proctor v. Bailey*, 6 R. P. C. 538; 42 C. D. 390; 59 L. J. Ch. 12.

(n) *Ibid.*

(o) *Ibid.*: per Cotton, L.J.; 6 R. P. C. pp. 544, 545; see, also, *Geary v. Norton*, 1 De G. & S. 9.

(p) *Hudson v. Chatteris Engineering Co.*, 15 R. P. C. 438.

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

past, and although an inference as to the future may be drawn from past conduct, yet mere threats or other evidence of an intention to infringe in future are sufficient to induce the Court to grant an injunction without any proof of effect having yet been given to such threats. (r)

In *Frearson v. Loe*, (s) 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 so 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."

In *Adair v. Young*, (t) the Court granted an injunction against a defendant, the master of a ship into which pumps made in infringement of the plaintiff's patent had been fitted, although no user of the pumps in British waters was proved against the defendant—the Court being satisfied that if not restrained by injunction he would, in fact, use the pumps in breach of the patent right.

In *Dowling v. Billington*, (u) no actionable infringement was proved, but the defendants had infringed between the filing and acceptance of the complete specification, and after the

(r) See *Proctor v. Bailey*, 6 R. P. C. p. 542 (per Cotton, L.J.); *Frearson v. Loe*, 9 C. D. 65 (per Jessel, M.R.).

(s) *Supra*.

(t) 12 C. D. 13.

(u) 7 R. P. C. 191; cf. *Shoe Machinery Co. v. Cutlan*, 12 R. P. C. 357.

commencement of the action, and the Court of Appeal in Ireland held this evidence of an intention to infringe and granted an injunction accordingly.

Term and Scope of Injunction.—Usually an injunction will only be granted for the period covered by the life of the patent; when the patent term has run out the injunction falls with the monopoly. (v) Thus, also, where the patent is upset on some ground of invalidity in a subsequent action, any injunction granted in respect of it ceases to operate. (w)

An injunction granted on proof of one form of infringement binds the defendant as to that and all other possible forms of infringing the same letters patent. If, therefore, the same defendant repeats his infringement in some new form after an injunction has been granted, the proper remedy of the patentee is not to commence a new action, but to move to attach the defendant for contempt in acting in breach of the injunction already granted. (x)

As an injunction will generally be granted for the duration of the patent term only, the Court will usually refuse this relief where the letters patent in aid of which it is sought have expired before the hearing, or are then about to expire; (y) for, in the first case, there will be nothing upon which the injunction can operate, while in the second, damages will as a rule be a sufficient remedy.

Where, however, it appeared that a quantity of infringing goods had been manufactured just before the expiration of the patent, with the object of having such goods ready to throw upon the market as soon as the monopoly was at an end, Lord Lyndhurst, C., granted a perpetual injunction to restrain the sale of such goods both before and after the term limited by the patent grant. (z)

Third parties are not defendants, and an injunction will not be granted against them; although they may be ordered to pay costs (a). If a plaintiff in an infringement action finds, while the action is pending, that he has a direct claim against a third party

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

(w) *Ibid.*

(x) *Thomson v. Moore*, 6 R. P. C. 445.

(y) *Davenport v. Rylands*, L. R. 1 Eq. p. 306; *Betts v. Gallais*, L. R. 10 Eq. 392; *British Motor Syndicate v. Universal Motor Co.*, 16 R. P. C. 113; *Welsbach Incandescent Gas Light Co. v. New Incandescent Co.*

16 T. L. R. 205; 17 R. P. C. 237.

(z) *Crossley v. Beverley*, 1 R. & M. 166, n.; 1 W. P. C. 119; see, also, *Crossley v. Derby*, 4 L. J. Ch. 26 (per Lord Brougham, C.).

(a) *Edison & Swann v. Holland*, 6 R. P. C. p. 286.

he ought to apply to amend, and add him as a co-defendant. (b) Where such an application had not been made to the Court below, the Court of Appeal refused to join third parties as co-defendants in the appeal. (c)

A defendant who has in error consented to a perpetual injunction going against him, has been allowed to withdraw such consent. (d)

In the *Welsbach Incandescent Gas Company v. Daylight Mantle Company*, (e) the secretary of the defendant company had been made a co-defendant. He had taken no part in the acts of infringement, but appeared and put the fact of infringement in issue. An injunction was granted against him, but no damages.

Enforcing Obedience to the Injunction.—When a defendant disobeys an injunction which has been granted against him, the patentee's remedy is a motion to commit. (f) It is not necessary that the order for the injunction should have been served, but knowledge that the injunction has been granted must be brought home to the offender.

“If there is a breach of an injunction immediately after it has been ordered, and before there has been time to pass and enter the order and to serve it on the defendant, the Court will enquire whether the defendant knew of the making of the order, and the defendant will not be allowed to escape by any subterfuge. If he was in court when the order was made, he will not be allowed to say he did not hear it; if he was just outside the court, having left it in order that he might not hear the order actually pronounced, he will not be allowed to say he did not know of it.” (g)

If, however, the plaintiff, by his long delay in having the order drawn up, or otherwise by his conduct gives the defendant reason to think that he does not intend to enforce the injunction, that is an answer to a motion to commit. (h) Committal will not be ordered lightly. The case must be strictly made out on the affidavits. (i) The Court will not encourage motions to commit where no real case for committal can be made out, and all the mover wants is an apology and costs. (j)

(b) *Edison v. Holland*, 6 R. P. C. p. 285.

(c) *Ibid.* p. 286.

(d) *Elsas v. Williams*, 1 T. L. R. 145.

(e) 16 R. P. C. 344, p. 356.

(f) *Plimpton v. Spiller*, 4 C. D. 287;
Thomson v. Moore, 6 R. P. C. 445.

(g) Per Pearson, J., in *United Telephone Co. v. Dale*, 25 C. D. pp. 784, 785.

(h) *Ibid.* p. 786.

(i) *Dick v. Haslam*, 8 R. P. C. 196.

(j) *Plating Co. v. Farquharson*, 17 C. D. 49.

Defendants who disobey an injunction render themselves liable to a motion to commit, even where they act in the *bonâ fide* belief that they are not guilty of any infringement. (k) But where the intention of the offenders has been clearly innocent, the Court has refused to construe their conduct as a contempt, or order their committal, though it has made them pay the costs of the motion. Such costs may properly be given on the higher scale, but not (where the respondent is innocent) as between solicitor and client. (l)

In *Lyon v. Goddard*, where the defendants swore that they had acted in ignorance and with no intention of breaking the injunction, the Court directed that attachment should issue, but not be enforced, if within a fortnight the defendants delivered up their machines and paid the costs of the motion as between solicitor and client. (m)

On a motion to commit, the Court, it would seem, cannot order the offender to account for the profits made by his breach of the injunction; but, indirectly, it can compel him to do so, by making non-committal conditional on his submitting to an account. (n) If satisfied that the respondent has wilfully disobeyed the injunction, the Court, where it does not commit, will order him to pay the costs of the motion as between solicitor and client, as the price of non-committal and an indemnity to the mover. (o)

In *Steele v. Hutchings*, where the plaintiff did not press for committal, this course was followed by Jessel, M.R. (p)

In *Lyon v. Goddard*, where an order was made for committal, these costs were given. (q) But such costs are never given to the respondent where the motion fails, not even where the motion has been a mere waste of the time of the Court. (r)

In the case of a company, an injunction can be enforced by moving to sequester its property, and commit the directors under whose orders the acts complained of have been committed.

In *Spencer v. Ancoats Rubber Company*, (s) where no order was made on the motion, the respondents were put to their election, the alternatives being an account of profits and delivery up of infringing articles, or sequestration against the company and

(k) *Spencer v. Ancoats Rubber Co.*, 6 R. P. C. 46; see, also, *Incandescent Gas Light Co. v. Sluce*, 17 R. P. C. 173.

(l) *Ibid.* p. 68.

(m) 11 R. P. C. 115.

(n) *Ibid.*

(o) *Ibid.*; *Plating Co. v. Farquharson*,

17 C. D. 49; *Spencer v. Ancoats Rubber Co.*, 6 R. P. C. pp. 66, 67.

(p) W. N. 1879, p. 18.

(q) 11 R. P. C. 115.

(r) *Plating Co. v. Farquharson*, *supra*.

(s) 6 R. P. C. 68.

committal against the directors; costs also were given, both against the company and the directors, the directors only to be liable personally in the event of the company failing to pay.

In the *Lancashire Explosives Company v. the Roburite Company*, (t) the plaintiffs moved to commit the manager and chairman of the respondent company, and, besides costs, asked the Court to direct an enquiry as to damages. Kekewich, J., commented on the unusual form of the motion, but both parties being willing that the substantial question as to whether the respondent company had infringed should be decided by the Court, and it being admitted by the plaintiffs that they did not seek for committal, the motion was heard, both before the learned judge and in the Court of Appeal, very much as if it were an action for infringement. As it was dismissed with costs, the question of ordering an enquiry as to damages did not arise. But Kekewich, J., intimated that, in his opinion, a motion for sequestration, and not for committal, would, in this case, have been the better form of bringing the matter before the Court.

An appeal lies to the Court of Appeal and to the House of Lords, from a refusal to commit. (u)

Delivery Up, or Destruction of Infringing Articles.

An Old Remedy in a New Form.—Where infringement is proved against a defendant, the Court will now order the infringing articles in his possession to be delivered up to the plaintiff, or destroyed, or marked so as to prevent their being sold or again put in use. The order will only be made in respect of articles in the possession and control of the defendant. (v)

This jurisdiction is not based upon any provision in the letters patent themselves, and is comparatively new.

At one time letters patent usually contained provisions forfeiting articles made in contravention of the patentee's monopoly, and authorizing him to search for such articles. Thus, in the letters patent granted by James I. to *John Gilbert*, in 1618, for a water-plough, or dredger, there are clauses forfeiting all engines, instruments, or devices, made, erected, framed, used, or employed, in resemblance to, or in imitation of, the patentee's invention; and, providing that goods forfeited under the patent may be sold, a

(t) 13 R. P. C. 435, 436.

terton, 20 Q. B. D. 493.

(u) Ibid. In the House of Lords, 14 R. P. C. 303; see, also, *Jarmain v. Chat-*

(v) *Chadburn v. Mehan*, 12 R. P. C. 135.

moiety of the proceeds going to the Crown, and a moiety to the patentee. (w)

Although these conditions are found in ancient grants, the common law denied their validity, and laid down the principle that no forfeiture can arise by royal patent. (x) No forfeiture clause, therefore, is now found in letters patent for inventions. Nevertheless, the Court has recently assumed a jurisdiction in infringement actions over infringing articles under the control, or in the possession, of the defendant.

Betts v. De Vitre (y) appears to have been the first reported case in which this jurisdiction was exercised. There Wood, V.C., made an order for an enquiry as to what infringing articles the defendants had in their possession, all articles so certified, to be destroyed in the presence of the managers and solicitors of the plaintiffs.

Next, in *Tangye v. Stott*, (z) the plaintiffs prayed a decree that all pulleys in the custody of the defendants and made in infringement of the plaintiffs' patent might be delivered up; and the same learned Vice-Chancellor made an order requiring the defendants to make an affidavit specifying such articles, and to deliver them up to the plaintiffs within seven days of the filing of the affidavit.

In *Plimpton v. Malcolmson*, Jessel, M.R., made a similar order in the following terms: "And let the defendant forthwith upon oath deliver up to the plaintiff, or break up, or otherwise render unfit for use, all roller skates, or parts of roller skates, so manufactured or let for hire by, or by the order, or for the use, of the defendant in infringement of the said letters patent as aforesaid, which are in the possession, custody, or power of the defendant or his servants or agents." (a)

Again, in *Frearson v. Loe*, (b) the same learned judge ordered the defendant either to deliver up to the plaintiff or destroy in his presence any infringing machinery in the defendant's possession or power.

So, likewise, in *Badische Anilin v. Levinstein*, (c) Pearson, J., ordered all infringing dye stuffs in the possession of the defendants

(w) Rymer's *Fœdera*, vol. xvii. fo. 12 (Pat. 16 Jac. I. p. 5); see, also, *Baker's Small Patent*, 1 W. P. C. 12, n.; *Lord Dudley's Patent*, 1 W. P. C. 15.

(x) See Coke, 2 *Inst.* 47; *Hasting's Patent*, Noy, 183; *City of London's Case*, 8 Coke, *Rep.* 125 (a), 127 (b); *Horne v. Ivy*, 1 *Siderfin*, 441.

(y) 2 Giff. 628; 3 De G. F. & J. 217, 309; 34 L. J. Ch. 289 (1865).

(z) 14 W. R. 386; *Seton on Decrees*, 5th edit. (1891), vol. i. p. 565.

(a) *Seton on Decrees*, 5th edit. vol. i. pp. 565, 566.

(b) L. R. 9 C. D. 67.

(c) 24 C. D. 176.

to be verified by affidavit, and at their option either delivered up to the plaintiffs or destroyed. A similar order for verification was made in *Westinghouse v. Lancashire Railway Company*. (d) But in that case the plaintiff was to be at liberty to inspect and mark the articles (a brake apparatus) so verified, and no order for delivery up was made.

In *Siddell v. Vickers*, (e) where the patent related to mechanical appliances for operating on large forgings in iron and steel, Kekewich, J., in view of the nature of the invention, declined to order delivery up or destruction of the infringing apparatus. The Court of Appeal took a like course in *Lancashire Explosives Company v. Roburite Company*. (f)

Where the infringement is limited to parts of a machine, the order will also be limited to those parts. (g)

In *Moser v. Marsden*, (h) where the infringement consisted in parts of a machine, the Court of Appeal made an order that the infringing articles should be delivered up to the plaintiff, or destroyed, or rendered unfit for use.

In the *Welsbach Incandescent Gas Company v. Daylight Mantle Company*, (i) an order for delivery up of infringing articles was made; the plaintiffs undertaking that if notice of appeal was given by the defendants within a month, the articles so delivered up would be retained in the plaintiffs' possession pending the appeal.

The object of the Court in making an order for delivery up or destruction of infringing articles is not to punish the defendant, but to protect the plaintiff; therefore, where such an order is not required in the plaintiff's interest, it will not be made, for its effect would be merely mischievous. (j)

For the protection of the plaintiff the Court will require the defendant by its order to file an affidavit verifying on oath the articles in his possession which infringe the plaintiff's patent. (k)

Property still in Defendant.—Although the Courts will thus order the infringing articles in the possession of the defendant to be delivered up or destroyed, they have never claimed to effect a

(d) 1 R. P. C. 253.

(e) 5 R. P. C. 101.

(f) 12 R. P. C. 483.

(g) *Automatic Weighing Machine Co. v. Fearby*, 10 R. P. C. 442; *Edison-Bell v. Smith*, 11 R. P. C. 389; *Howes v. Webber*, 12 R. P. C. 470; *Shoe Machinery Co. v. Cutlan*, 12 R. P. C. 357.

(h) 10 R. P. C. 364; see, also, *Otto v. Steel*, 3 R. P. C. 120.

(i) 16 R. P. C. 355.

(j) *United Telephone Co. v. London & Globe Telephone Co.*, 26 C. D. 776.

(k) *Washburn Co. v. Patterson*, 1 R. P. C. 191; *Edison-Bell v. Smith*, 11 R. P. C. 406.

forfeiture and divest the defendant of his property in such articles.

“The property,” said Cotton, L.J., in *Vavasseur v. Krupp*, (l) “in articles which are made in violation of a patent is, notwithstanding the privilege of the patentee, in the infringer, if he would otherwise have the property in them. The Court in a suit to restrain the infringement of a patent does not proceed on the footing that the defendant proved to have infringed has no property in the articles, but, assuming the property to be in him, it prevents the use of those articles, either by removing that which constitutes the infringement, or by ordering, if necessary, a destruction of the articles, so as to prevent them from being used in derogation of the plaintiff’s rights, and does this as the most effectual mode of protecting the plaintiff’s rights, not on the footing that there is no property in the defendant.”

A plaintiff, therefore, where articles are delivered up, cannot sell such for his own profit; he is only entitled to their custody, so that the defendant shall not use them.

In the *United Telephone Company v. Walker*, (m) the defendants sought to set off against the damages payable by them the value of the instruments delivered up under the judgment. Commenting on this Chitty, J., said: “It was said by the defendants there ought to be a set-off as against these damages of the value of the instruments which had been given up under the judgment. That appears to me to be absolutely untenable. The judgment is that those instruments should be delivered up, and the plaintiffs have not to pay for them in any form. That is one of the penalties which the patent law imposes on the infringer.”

Marking Infringements.—When the Court does not order delivery up of infringing articles it will sometimes order them to be marked to prevent their being put into circulation to the patentee’s injury. (n)

Damages or an Account.

These Remedies Alternative only.—In addition to an injunction and delivery up or destruction of infringing articles, the patentee may claim damages or an account of profits.

Formerly in Courts of Equity an account was a remedy

(l) L. R. 9 C. D. pp. 358, 359.

(m) 4 R. P. C. 67.

(n) *Needham v. Oxley*, 8 L. T. (N. S.), 604; *Plimpton v. Malcolmson*, Seton, 565;

Westinghouse v. London & Yorkshire Railway Co., 1 R. P. C. 229; *Badische Anilin v. Levinstein*, L. R. 24 C. D. 156.

ancillary only to an injunction. Therefore where an injunction was refused, no account could be obtained, and the patentee was left to obtain redress for the wrong he had suffered by way of damages in an action at law. (o) But now every judge of the High Court has jurisdiction in an infringement action to order an account or an enquiry as to damages whether an injunction is granted or not. (p) A successful plaintiff cannot, however, have both damages and an account against the same infringer. He must elect which remedy he will take; for in asking for damages he treats the defendant as a wrong-doer, an infringer of the patent right; whereas in taking an account he condones the infringement and treats the defendant as an agent or trustee called upon to account for the profits made by him in the unauthorized use of the invention. These two forms of relief are therefore inconsistent, and the patentee cannot at one and the same time reprobate and approbate. (q)

“The account and the enquiry as to damages,” said Lord Chelmsford in *Betts v. Neilson*, (r) “have each of them a different object: one is to ascertain what loss the plaintiff has sustained, the other, what profit the defendant has acquired by the infringement of the patent. It might be that the party infringing had sold the patented article at an under-price, so that the amount of his profit would be no measure of the plaintiff’s loss. And even in cases where there has been no such underselling, the plaintiff may have sustained damage far beyond what the gains of the defendant would compensate.”

Damages.

Measure of Damage where the Patentee does not himself Manufacture.—Where the patentee did not himself manufacture, but granted licenses for that purpose to others at a fixed royalty, Wood, V.C., held that he could not recover as a part of his damages a manufacturer’s profit, much less the profit he would have made if every unlicensed machine had been sent to him to be fitted with his

(o) Hindmarch, p. 361; *Smith v. London & South Western Railway Co.*, Kay, 408; *Price v. Bauwen*, 4 K. & J. 727; *Hocking v. Fraser*, 3 R. P. C. 7; *Proctor v. Bailey*, 6 R. P. C. 538; *Betts v. Gallais*, L. R. 10 Eq. 392.

(p) Patents Act, 1883, s. 30; *Sayers v. Collyer*, L. R. 28 C. D. p. 108.

(q) *Betts v. Neilson*, L. R. 5 H. of L. Ca.

1; 40 L. J. Ch. 317; *Betts v. De Vitre*, L. R. 6 H. of L. 319; *United Horse Shoe Nail Co. v. Stewart*, 3 R. P. C. 143; 13 App. Ca. p. 412; 5 R. P. C. 260; *American Braided Wire Co. v. Thompson*, 7 R. P. C. 158; 44 C. D. 274.

(r) L. R. 3 Ch. p. 440. Reversed in so far as it gave both damages and an account against same defendant. See supra.

invention; but that he was limited to the sum represented by the royalties which would have been paid him had the defendants manufactured under his license. (s)

“Here is a case,” said the learned Vice-Chancellor, “where the patentee is not in the habit of manufacturing the articles to which the patent applies, or, at all events, very seldom does so; but he has been in the habit of granting, not general shipbuilders’ licenses, but a particular license of 2s. 6d. per horse-power for each ship which is about to be built with his invention. The defendants accordingly, if they had applied, as they ought to have applied, to the plaintiff, would have had to pay 2s. 6d. per horse-power for every ship which they built with his invention. That is the amount which the plaintiff got from everybody else; and it does not appear to me that he is entitled to anything more from the defendants.” (t)

In this case it appeared that some of the persons who had purchased the invention from the defendants had already paid the royalty direct to the patentee; in respect of such infringements, Wood, V.C., held that nothing further could be recovered by the patentee, as his loss had already been made good.

In the *English and American Machinery Company v. Union Boot and Shoe Company*, (u) the plaintiffs only granted licenses to use their machines, and did not offer them for sale in England. The defendants had sold nine for exportation. Stirling, J., varying the Chief Clerk’s certificate, held that the sum to which the plaintiffs were entitled by way of damages was the amount represented by the profits from licenses of which they had been deprived.

Where the Patentee Manufactures. — Where, however, the patentees are themselves the manufacturers of the patented article which they sell, they can recover a manufacturer’s profit; and in such case the true measure of their damage is the amount of profit which they would have made if they had themselves effected the defendants’ sales, deducting a fair percentage in respect of any sales which may be found to have been due to the particular exertions of the defendants. (v)

Different considerations arise, however, where the infringement is committed in connection with an article in which the patentee does not himself deal.

Thus, in the *Pneumatic Tyre Company v. the Puncture Proof*

(s) *Penn v. Jack*, L. R. 5 Eq. 81; 37 L. J. Ch. 136.

(t) *Ibid.* p. 85.

(u) 13 R. P. C. 67.

(v) *United Horse Shoe Nail Co. v. Stewart*, 5 R. P. C. 260; 13 App. Ca. 401.

Tyre Company, (w) the defendants had infringed by applying bicycle tyres which were an infringement of the plaintiffs' patent to machines of a lower grade than the bicycles in connection with which the plaintiffs used their invention. An enquiry as to damages having been directed, the plaintiffs contended that their damage was to be measured on the footing that but for the infringement, they would have themselves made the number of sales effected by the defendants. The Master having acceded to this proposition, the defendants moved to vary the certificate and reduce the damages, on the ground that it was wrong to assume that the plaintiffs would have effected with their high grade machines the sales made by the defendants, seeing that the plaintiffs did not cater for the lower class of buyer by making the cheaper article. The defendants further contended that the proper measure of damage was what the plaintiffs would have earned in royalties on the machines sold had the defendants been licensees. Wills, J., having reduced the damages, the plaintiffs appealed against the reduction. The Court of Appeal held, however, that the sum assessed by Wills, J., was, in fact, the correct amount. But that, as the action was one to compensate the plaintiffs, they were only entitled to such a sum as represented the actual loss occasioned to their trade by the sales of the defendants; and, therefore, that the mode suggested of arriving at that loss by treating the defendants as licensees was inadmissible, and (seeing that the plaintiffs did not grant licenses) impossible of application, for there was no means of ascertaining what royalty they would have accepted for the use of their invention.

Where the Infringer takes Part only of the Invention.—The circumstance that an infringer only uses a small part of the patented invention may be very material, where the claim against him is for an account of profits, but it is quite irrelevant where the claim is for damages.

In the *United Horse Shoe Nail Company v. Stewart*, (x) the Court of Session having on such ground given nominal damages only, the House of Lords reversed their decision.

“When a patentee,” said Lord Watson, “elects to claim the *profits* made by the unauthorized use of his machinery it becomes material to ascertain how much of his invention was actually appropriated, in order to determine what proportion of the net

(w) 15 R. P. C. 405; 16 R. P. C. 209.
See *Gavioli v. Shepherd*, 17 R. P. C. 157,
where the defendant's evidence that he
could not have afforded to buy the

patentee's machine was held to negative
damage altogether.

(x) 13 App. Ca. 412; 5 R. P. C. 266.

profits realized by the infringer was attributable to its use. It would be unreasonable to give the patentee profits which were not earned by the use of his invention. But the case is altogether different when the patentee of machinery, who does not grant licenses, claims *damages* from an infringing manufacturer, who competes with him by selling the same class of goods in the same market. In that case the profit made by the infringer is a matter of no consequence. However large his gains, he is only liable in nominal damages, so long as his illegal sales do not injure the trade of the patentee; and however great his loss, he cannot escape from liability to make full compensation for the injury which his competition may have occasioned. Every sale of goods manufactured, without license, by patent machinery is, and must be, treated as an illegal transaction in a question with the patentee; and its inherent illegality is not affected by the circumstance that the infringement consisted in using a small, and, it may be, the least useful part of the invention."

If the defendants have, in fact, infringed they will not be heard to say that they could have done the same amount of business without using the plaintiff's invention, and that therefore the plaintiffs have suffered no damage. In view of their actual infringement such a contention is entirely beside the mark. (y)

Such Loss only as is the Natural Consequence of the Infringement is Recoverable.—The loss which a patentee can recover in damages is such loss as is the natural consequence of the acts of infringement complained of; other damage is too remote. (z) This is the universal rule of law in actions founded on tort and equally applicable in patent cases.

What is the amount of loss in any particular case can rarely be determined by exact arithmetical calculations. It is hardly ever possible to arrive precisely at what the amount of the patentee's sales and profits would have been but for the infringement. As a rule a general estimate must be made, assessing the damage as a jury would assess it; (a) not by mere guessing. "As if," said Lord Esher, M.R., in *Ungar v. Sugg*, "you were tossing up for the thing, but it must come to a mere question of what, in the mind of the person who has to estimate them, was a fair sum." (b)

(y) 5 R. P. C. p. 268; see, also, *Boyd v. Tootal*, 11 R. P. C. 175.

(z) *United Horse Shoe & Nail Co. v. Stewart*, 5 R. P. C. 268; 13 App. Ca. 401; *British Insulated Wire Co. v. Dublin Tramway Co.*, 17 R. P. C. 14.

(a) See Lord Halsbury, C., *ibid.* p. 264; Lord Watson, p. 267. See, also, *American Braided Wire Co. v. Thomson*, 5 R. P. C. 541.

(b) 9 R. P. C. 117.

Loss by Reduction of Prices.—Sometimes the competition of infringers who undersell the market so affects the patentee's trade that to save his business he reduces his prices to meet this unlawful competition. A question then arises whether he is entitled to recover from the offender as damages the diminution of profit so occasioned.

This question was much discussed in the *United Horse Shoe & Nail Company v. Stewart* (c) and the *American Braided Wire Company v. Thomson*. (d) In the first of those cases the patent was for a waste saving machine which resulted in the more economical production of nails. Here the pursuers had in self-defence reduced their prices on various occasions. Such reductions had, however, always been made in anticipation of those of the defenders, and to a figure a little below their price. (e) The pursuers alleged they were compelled to this course by the defenders' unlawful competition, and claimed damages in respect of such reductions. The Court, however, was of opinion that the action of the pursuers in reducing their prices was not occasioned solely by the trade of the defenders, but to a large extent by the lawful competition of other makers, and gave no damages in respect of these reductions.

“I think,” said Lord Macnaghten, “the claim for loss of profit by reason of the reduction of price must be rejected. I do not think that was the natural or direct result of the respondents' acts. The appellants seem to have had no difficulty in ascertaining where the competing nails were made, and in coming to the conclusion that they were produced by machinery which infringed their patent rights. The appellants must be taken to have believed in their case. If they believed that the respondents were infringing their rights, and relied on obtaining redress in due course of law, it appears to me that it was not a reasonable course on their part to reduce the price so as to injure their own trade. On establishing their rights they would be entitled either to the profits which the respondents might have made, or to the damages which they could prove they had sustained. In lowering their prices they seem to me to have been prompted by a desire to provide for the contingency of their failing in their action, and by an anxiety to drive their rivals from the field, whether they were right or wrong.” (f)

(c) 5 R. P. C. 260; 13 App. Ca. 401.

(d) 7 R. P. C. 152.

(e) See Cotton, L.J., distinguishing

this case in *American Braided Wire Co. v. Thomson*, 7 R. P. C. p. 160.

(f) 5 R. P. C. 269; 13 App. Ca. 416.

In the *American Braided Wire Company v. Thomson*, (g) the same point was discussed, and the plaintiffs were allowed to recover the loss, but not as damages for reduction of price. Here the facts were somewhat different. The plaintiffs had not reduced prices until after the defendants had first done so, and on each occasion of a reduction they had only come down to the price at which the defendants were then selling. Moreover, the article sold was not one in which there was already a general trade, but one which no person but the plaintiffs could lawfully make. The Official Referee, to whom the enquiry to assess the damages had been referred, found as a fact that but for the unlawful competition of the defendants the plaintiffs would have effected, at the original price, not only their own sales but also those made by the defendants; and the Court being unable to disturb this finding on the evidence, held that the plaintiffs were entitled to recover damages on this footing, *i.e.* not as arising from a reduction of price, but as directly occasioned by the wrongful conduct of the defendants.

“It appears to me,” said Lindley, L.J., “to be an entire fallacy to say in this case that the plaintiffs are seeking damages for selling at reduced prices. They are not doing anything of the sort. In the Scotch case they were, and it was precisely that controversy and that contention of theirs which was negatived by Lord Macnaghten. In the Scotch case there was competition of the most formidable kind of other nails besides those made by the patentees’ process, and entirely exclusive of the competition by the infringers of the patent. . . . The patentees there were claiming, or seeking to claim, and endeavouring to substantiate, not the damages properly referable to, and occasioned by, the wrongful act of the defendants, but they were claiming that which the plaintiffs here do not claim at all—they were claiming damages in respect of the reduction of price.” (h)

Commenting on the above cases in *Alexander v. Henry*, (i) Kekewich, J., stated the law as laid down by them as follows: “Because a trader has reduced the prices of the article which he is offering to the public, you must not therefore assume, notwithstanding that there is an infringer in the market, that he is really injured by the reduction of prices. He may have done it merely as a matter of policy; he may have been influenced by many reasons; and to jump to the conclusion that because a manufacturer has thought fit to reduce his prices, therefore the reduction

(g) 7 R. P. C. 152.

(h) *Ibid.* 161.

(i) 12 R. P. C. p. 367 (a trade mark case).

—that is to say, the difference between the original price and the reduced price is an injury caused to him by the infringer, to be measured by that difference in money, is really coming to a conclusion without premises, ignoring possible and even probable facts which might influence the result. Again, if you find facts from which a reasonable man might conclude that the reduction in price was the result of the infringement, then you at once get on entirely different lines, and you then come to the conclusion that the loss is the natural consequence of the infringement, and is caused to the manufacturer directly by what the infringer does. Then you have no difficulty in measuring the damage by the loss in money, and visiting that on the head of the infringer.”

In *Boyd v. Tootal*, a claim for damages, on the ground that the conduct of the infringers had increased the cost at which the plaintiffs produced their machines, and had prevented their keeping up the price, was held too remote. (*j*)

In the *Pneumatic Tyre Company v. the Puncture Proof Tyre Company*, (*k*) Lord Russell, C.J., said that in assessing the damages the injury done to the patentee by his articles being shouldered out of the market, and the injury to his trade reputation by inferior articles being put before the public were both to be considered.

Damages obtained against the Seller will not License an Infringing Article in the Hands of Buyers.—The circumstance that a patentee has recovered damages or an account against a manufacturer of infringing articles does not preclude him from thereafter suing the persons who are using pirated articles bought from such manufacturer.

“It has never been held in this Court,” said Wood, V.C., in *Penn v. Bibby*, (*l*) “that an account directed against a manufacturer of a patented article, licenses the use of that article in the hands of all the purchasers. The patent is a continuing patent, and I do not see why the article should not be followed in every man’s hand, until the infringement is got rid of. So long as the article is used there is continuing damage.” (*m*)

Nor are the damages which may be recovered from such users merely nominal; substantial damages may be given. “The Courts would never,” said Robinson, V.C., in *Boyd v. Tootal*, “have directed accounts and enquiries the way that they have done, if they considered that the damages that the plaintiff had

(*j*) 11 R. P. C. p. 184.

(*k*) 16 R. P. C. 209.

(*l*) L. R. 3 Eq. 308; *Penn v. Jack*,

L. R. 5 Eq. 81; 37 L. J. Ch. 136; *Boyd v. Tootal*, 11 R. P. C. 184.

(*m*) L. R. 3 Eq. 311.

sustained by a person who had used an infringing machine were merely nominal." (n)

In the *United Telephone Company v. Walker*, (o) the defendants were sued for using articles in respect of which the plaintiffs had already obtained judgment for £50 (agreed damages) against *Orme*, the manufacturer. They contended that no second action would lie in regard to these articles, which had been freed from objection by the damages paid by *Orme*. Rejecting this contention, Chitty, J., said: "That contention, it appears to me, cannot be for one moment maintained. *Orme* was a manufacturer, and he had parted with a certain number of instruments, in respect of which the present defendants are sued. A large number, I understand, out of the 140 were supplied by *Orme* to the defendants. The damages that were taken by the plaintiffs in their action against *Orme* were only in respect of his infringement, and nothing more, and the patentees (the plaintiffs) are entitled to pursue the instruments into other hands, and to recover from them damages in respect of that other infringement. If a royalty had been paid by *Orme*, equal to the total royalty payable in respect of each instrument, any such instrument, though disposed of by *Orme*, would, as I am at present advised, have been what I have termed a free instrument in the market, and the plaintiffs would have suffered no loss in respect of that; in other words, they would have taken from *Orme* that which would have amounted to a complete license to deal with those instruments, and so the purchasers of those instruments would have been freed from any liability in respect of them. But that is not what was done. The £50 was only the agreed amount of damage against *Orme*, and it was part of the order that *Orme* should give the names of his purchasers, and the instruments which he had supplied to them, in order that the plaintiffs might pursue those instruments into the hands of the purchasers or their assigns."

Settlement with one Defendant does not Bar Right to Damages from Others.—The circumstance that the plaintiff has accepted damages on a reduced scale from infringers who have settled with him before action, is no bar to his right to recover his full damages from others who have not availed themselves of that offer.

In *Boyd v. Tootal*, the plaintiffs had issued a circular offering to take damages at 4s. per spindle on all infringing machines from such infringers as paid without litigation. This offer they said they made at a rate considerably less than their actual damage to induce a friendly settlement. It was argued that this offer

(n) 11 R. P. C. 179.

(o) 4 R. P. C. 63; 56 L. T. 508.

precluded them from afterwards recovering their full damage, which was 7s. per spindle, from users who had declined to settle. Robinson, V.C., following *Penn v. Bibby*, (p) rejected this contention. "That seems to me to be entirely covered by the case before Wood, V.C., in which he says that litigants may be sued for a larger sum, that is, for the true amount of damages, and the fact that the plaintiffs have settled with certain people on a lower basis is not to be taken finally as the complete measure of damage that the plaintiffs have sustained. In fact, it would be most unreasonable, for it is always worth a litigant's while to take off something from his claim for the sake of peace, especially in a case like the present, where he is endeavouring to keep the good-will of the persons who have been using his patent." (q)

Innocence of Infringer no Answer to Claim for Damages.—As innocence of an intention to infringe is no answer to an action of infringement, a defendant is not relieved from his liability to pay full damages by shewing that he acted in ignorance of the patent right.

In *Boyd v. Tootal*, (r) one set of defendants had taken over the machines complained of with the purchase of a mill, knowing little or nothing about them. The House of Lords having ultimately determined, in the action of *Boyd v. Horrocks*, (s) that those machines were an infringement of the plaintiff's patent, the patentee instituted proceedings against these defendants, and recovered damages for the full amount of his loss, through their unauthorized use of his invention.

Where the plaintiffs inadvertently omitted to ask for damages at the trial, Kay, J., varied the minutes of decree on a subsequent motion by adding an enquiry as to damages. (t)

Damages will not be given against third parties, though they may be made liable in costs. (u)

Where a patent belongs to tenants in common and one dies, damages recoverable for infringement of the patent right accrue to the survivor. (v)

(p) L. R. 3 Eq. p. 312 (per Wood, V.C.).

(q) 11 R. P. C. p. 184.

(r) Ibid. 175, see p. 185; cf. *Davenport v. Rylands*, L. R. 1 Eq. 308.

(s) 9 R. P. C. 77.

(t) *Edison v. Holland*, 5 R. P. C. 483; cf. *Fritz v. Hobson*, 14 C. D. 561.

(u) *Edison & Swan v. Holland*, 6

R. P. C. p. 286. It would be otherwise if they were made defendants by amendment: *ibid.* See Lindley, L.J.

(v) *Smith v. London & North Western Railway Co.*, 2 E. & B. 69; see, also, *National Society for the Distribution of Electricity v. Gibbs*, 68 L. J. Ch. 503; 80 L. T. 524; 15 T. L. R. 336; [1899] 2 Ch. 289.

Assignees of a patent may recover damages in respect of infringements committed before the date of their assignment, for they succeed to all the rights and property of their predecessors in title. (*w*)

Mode of Assessment.—Where damages are awarded to a successful plaintiff the Court will not usually itself try the question of the amount. That will be referred to be the subject of a separate enquiry. But if the damage is manifestly of a trivial character the Court will assess it. (*x*)

In *Cole v. Saqui*, (*y*) where the damages were nominal, Kekewich, J., refused an enquiry, and himself assessed the amount at 40s. In *Ungar v. Sugg*, (*z*) the damages were problematical, and the Court of Appeal said the judge should not have referred them to the chief clerk, but assessed them himself.

In the *Incandescent Gas Light Company v. Brogden*, (*a*) the plaintiffs were given an enquiry as to damages at their own risk as to costs, which were reserved, the judge doubting whether the quantum of damage was more than nominal.

Where the infringement has been substantial an enquiry as to damages will generally be more advantageous to the plaintiff than an account of profits. (*b*)

When damages are claimed the profits made by the infringer are wholly immaterial, the sole object of the enquiry being to ascertain what direct loss the plaintiff has suffered by reason of the defendant's wrongful acts. (*c*)

Enquiry when Directed.—Whenever the assessment of the damage involves an examination into matters which cannot be conveniently dealt with by the judge at the trial, such as accounts and details of business transactions, an enquiry will be directed. But there appears to be no power, once the case has been tried by a judge alone, to direct the assessment of the damages by a jury.

Discussing this in the *American Braided Wire Company v. Thomson*, Kekewich, J., said: "The old practice of the Court of Chancery was to refer everything in the way of damages or

(*w*) *United Horse Shoe & Nail Co. v. Stewart*, 13 R. P. C. 417.

(*x*) *Dicks v. Brooks*, 15 C. D. p. 40; 49 L. J. Ch. 819; *United Telephone v. Sharples*, 2 R. P. C. 32.

(*y*) 5 R. P. C. 496, 497.

(*z*) 9 R. P. C. 117.

(*a*) 16 R. P. C. 179.

(*b*) See, however, *English & American Machinery Co. v. Union Boot & Shoe Co.*, where the reverse was the case: 13 R. P. C. 67.

(*c*) *United Horse Shoe & Nail Co. v. Stewart*, 5 R. P. C. 260; 13 App. Ca. 401, p. 413.

compensation or anything of that kind to the chief clerk, or, before the days of the chief clerks, to the master; or, in modern times, there was a power to call in an expert to guide the Court. That power remains under the Judicature Acts, and we have besides that a large power of referring questions of difficulty to gentlemen who are appointed for the purpose, and who are called official referees. (d) Beyond that, with the consent of the parties, the Court is enabled to refer questions to a special referee; (e) but I know of no means by which the Court can get over a difficulty of this kind other than those indicated in the way I have mentioned. The Court must try itself, with the assistance of an expert, referring matters of detail to the chief clerk, or it must send it to a referee. What I am asked to do is to go beyond that and to adopt entirely a different course, and direct a trial by jury. Now, it has not been suggested that the words of any order directly enable me to do that. The second part of Order XXXVI., which deals with the mode of trial, is all pointed to the trial of the action being one trial, which takes place either with or without a jury, with or without assessors, and so forth, but to one trial of the action; or there may be, no doubt, independently of the trial, but for the purposes of the trial, an issue of fact, or an issue of law, directed in order that the result of that may come before the Court at the trial. That part of that order has nothing whatsoever to do with an assessment of damages directed by the judgment to be assessed, and one would not expect to find anything of the kind there. As a matter of fact, there is nothing there. Cases have arisen, no doubt, in which questions of fact and questions of damages have been ordered to be tried by the Chancery Division, at the Assizes, or in the Queen's Bench Division in London; and in the case of *Fennessy v. Rabbits*, (f) which has been mentioned, the Court did that very thing where, by the submission of the defendants to the rest of the relief asked, the plaintiffs' claim was reduced merely to one of damages, which was the only issue at the trial. That was very properly and naturally sent to the Queen's Bench Division, in order that it might be tried by a jury. It seems to me that I have no power to divest myself of this difficult task of ascertaining these damages. They must be ascertained by the officer of the Court in the ordinary way, with the power of coming back to the Court to vary the certificate, and so forth." (g)

(d) See R. S. C. Order 36, rules 57 & 57A.

(e) See Arbitration Act, 1889, ss. 13, 14.

(f) 56 L. J. (N. S.), 138.

(g) 5 R. P. C. pp. 541, 542.

Discovery in Aid of the Enquiry.—The plaintiff is entitled to discovery in aid of his enquiry as to damages. And the defendant may be ordered to file an affidavit stating what infringing articles he has made or sold, and giving the names and addresses of the persons to whom he has sold them.

In *Murray v. Clayton*, the defendants sought to withhold these names unless the plaintiff would give an undertaking not to proceed against such purchasers. The Court, however, insisted on full information being given.

“As a matter of course,” said Bacon, V.C., “in prosecuting that enquiry, (h) the plaintiff is entitled to have from the defendants the fullest possible discovery. That is so well settled that no case can be referred to in which the practice is called in question. Among other things, the plaintiff is entitled to that which the order gives him, the names and addresses of the persons to whom machines were sold. . . . The defendants apprehend ‘that if they were to furnish the plaintiff with the names and addresses of the persons to whom they have sold machines, the plaintiff might feel inclined to attack them, and issue process against them; and that, as a consequence, the business of the defendants would be injured.’ That is a consideration to which I can in no degree attend. If the inconvenience which they apprehend should ever happen, it will be in consequence of that which, as the law now stands, has been decided to be a wrong done by the defendants. They cannot excuse themselves or avoid the discovery which is asked, because of any consequences which may ensue from their wrong-doing. . . . I cannot interfere so as to prevent the plaintiff taking any proceedings he may be advised to take.” (i)

In the *American Braided Wire Company v. Thomson*, Kekewich, J., made an order that the defendants should disclose the names of their customers and the prices at which they had sold, notwithstanding an appeal was pending to the House of Lords. (j)

Form of Enquiry.—In directing an enquiry as to damages the proper form is to enquire “what damage the plaintiff has sustained,” not “what damage, if any,” as it would be in a trade mark case.

The reason of this is explained by Wood, V.C., in *Davenport v.*

(h) As to damages.

(i) L. R. 15 Eq. pp. 118, 119, 120; 42 L. J. Ch. 192. See, also, *Powell v. Bir-*

mingham Vinegar Brewery Co., 14 R. P. C. 1 (a trade mark case).

(j) 5 R. P. C. 378.

Rylands as follows: "There is this difference between the case of a trade mark and that of a patent: in the former case the article sold is open to the whole world to manufacture, and the only right the plaintiff seeks is that of being able to say, 'Don't sell any goods under my mark.' He may find his customers fall off in consequence of the defendant's manufacture; but it does not necessarily follow that the plaintiff can claim damages for every article manufactured by the defendant, even though it be under that mark. On the other hand, every sale without license of a patented article must be a damage to the patentee." (k)

The order for an enquiry as to damages will generally contain a direction that the defendant pay to the plaintiff the amount found against him.

In *Cunningham v. Colling*, (l) the order was to pay within twenty-one days after the filing of the chief clerk's (now the master's) certificate of the result of the enquiry.

Where a defendant admits infringement by his defence, and the plaintiff elects to move for judgment on the admissions, under Order XXXII., rule 6, he accepts the negative as well as the affirmative allegations of the defence, and is only entitled to an enquiry as to damages in respect of the admitted instances of infringement. All evidence of other infringements will therefore be excluded at the enquiry. (m)

The plaintiff is entitled to have the damages assessed down to the date of the enquiry; or, if the patent has expired during action, down to the date of its expiration. (n)

No damages are recoverable in respect of infringements prior to the publication of the complete specification; (o) nor (where the specification has been amended) prior to that amendment, 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; (p) nor where the infringement occurred after a failure by the patentee to pay his patent fees within the prescribed time and before the enlargement thereof, under Section 17 of the

(k) L. R. 1 Eq. p. 308; 35 L. J. Ch. p. 206.

(l) *Seton on Decrees*, 5th edit. vol. i. p. 567. See, also, *Plimpton v. Malcolmson*, *ibid.* 565; and *Wenham v. Carpenter*, 5 R. P. C. 70. Both of these last were cases of an enquiry as to profits.

(m) *United Telephone v. Donohoe*, 31 C. D. 401.

(n) See *Davenport v. Rylands*, L. R. 1

Eq. 302; *Fox v. Dellestable*, 15 W. R. 194; *Fritz v. Hobson*, 14 C. D. 557; *British Insulated Wire Co. v. Dublin Tramway Co.*, 17 R. P. C. 14; also R. S. C. Order 36, rule 58.

(o) Patents Act, 1883, s. 13.

(p) *Ibid.* s. 20; *Wenham v. Carpenter*, 5 R. P. C. 68; *Hopkinson v. St. James's Co.*, 10 R. P. C. 62.

Patents Act, 1883, if the Court which tries the action refuses to give any damages in respect of such infringement. (q)

Where an enquiry as to damages is directed, the costs are generally reserved for consideration after the enquiry has been held. (r)

Reviewing the Finding at the Enquiry.—Where an enquiry as to damages is ordered, either party, if dissatisfied with the result, may move to have the certificate varied. On the hearing of the motion, the judge, if the evidence below appears to him to have been unsatisfactory, will hear further evidence. (s) But this is not usual, and will only be done in exceptional circumstances.

In any case, however, the judge is not bound by the certificate as he would be by the finding of a jury, and may vary it if he thinks proper, (t) whether it be the certificate of the Master or the finding of an official referee. (u)

At the same time, the Court will remember that the official referee, or the master (as the case may be), has had the witnesses before him and seen how they gave their evidence, and will not therefore differ from his decision willingly.

“Where the evidence,” said Kekewich, J., in *Alexander v. Henry*, “is all in writing, then, of course, the Court is in a very different position; but when the evidence is oral, it would be presumptuous, dangerous, mischievous, in my opinion, for the judge, with only the transcript of the shorthand notes, or the referee’s own notes before him, to say that this, that, or the other conclusion must follow, because it is the necessary consequence of the grammatical meaning of certain language used by persons who may have been lying, or stating facts in language which they did not themselves understand, or did not mean to be understood in the sense which it grammatically bears.” (v)

In the *Pneumatic Tyre Company v. the Puncture-Proof Tyre Company*, (w) the Court of Appeal, on an appeal from Wills, J., who had varied the master’s certificate as to damages, expressed the opinion that such an appeal ought to be heard as the Court would hear a motion for a new trial after a verdict given by a jury,

(q) Patents Act, 1883, s. 17 (4) (b).

(r) *United Telephone Co. v. Fleming*, 3 R. P. C. 282; *United Telephone Co. v. Patterson*, 6 R. P. C. 142; *Jenkins v. Hope*, 13 R. P. C. 60; *Aktiebolaget Separator v. Dairy Co.*, 15 R. P. C. 338; *Incandescent Gas Co. v. Brogden*, 16 R. P. C. 179.

(s) *English & American Machinery Co.*

v. *Union Boot & Shoe Co.*, 13 R. P. C. 66.

(t) *Ibid.*

(u) *Alexander v. Henry*, 12 R. P. C. 366.

(v) *Ibid.*

(w) 16 R. P. C. 209; per Lord Russell, C.J., p. 216.

and that the test was not whether the finding was one the Court would have given, but one at which a jury could reasonably have arrived, on the evidence.

Where, however, the enquiry is referred, by consent, to a special referee, his finding is as binding on the parties and the Court, as that of an arbitrator would be.

Account of Profits.

Disadvantages of an Account.—Instead of an enquiry as to damages, a patentee may claim an account of profits; where he does so, he elects to take, by way of compensation, what the defendant has made out of the infringement of the patent. If the wrong-doer has been underselling the patentee in the market, this will probably be less than he might have recovered in damages. In any case, an account of profits is a doubtful remedy, because of the difficulty of working it out.

“I do not know any form of account which is more difficult to work out, or may be more difficult to work out than an account of profits,” said Lindley, L.J., in *Siddell v. Vickers*. “One sees it, and I, personally, have seen a good deal of it, in partnership cases, where the capital of a deceased or outgoing partner has been left in the trade; an account has been directed of the profits made in respect of his capital, which is something like the profits made in respect of an invention, and the difficulty of finding out how much profit is attributable to any one source is extremely great—so great that accounts in that form very rarely result in anything satisfactory to anybody. The litigation is enormous, the expense is great, and the time consumed is out of all proportion to the advantage ultimately attained; so much so, that in partnership cases, I confess I never knew an account in that form worked out with satisfaction to anybody. I believe, in almost every case people get tired of it, and get disgusted. Therefore, although the law is that a patentee has a right to elect which course he will take, as a matter of business he would generally be inclined to take an enquiry as to damages rather than launch upon an enquiry as to profits.” (y)

In the *Automatic Retort Company v. Mayor, &c., of Salford*, Romer, J., stated that an account of profits would mean great expense, delay, and difficulty in Chambers, and the parties agreed instead to an account of what, in lieu of damages, would be a

proper sum to pay by way of royalties for the use of the infringing apparatus. (z)

Sum to be arrived at on taking an Account.—The sum to be ascertained in taking an account of profits is the sum which represents the money value of the advantage which the infringer has derived from the use of the patent over and above what he would have got from the use of means or processes open to the public. (a) It is therefore material, on the taking of the account, to enquire what profits the defendants were making before they used the patentee's invention, as these, contrasted with the profits made subsequently, afford a clue to the proportion of their profits attributable to the infringement. It is not conclusive, as other factors, such as economy in production, and so forth, may enter in; but it is a most important factor in the problem, and will throw upon the defendants the onus of shewing whether such other factors exist, and to what extent they vitiate the inference which would otherwise be drawn. (b)

In *Siddell v. Vickers*, where the defendants contested the right of the plaintiff to enquire into their transactions prior to the infringements complained of, Kekewich, J., ordered them to file a further and better affidavit, disclosing the cost to them of manufacture, before and after they used the plaintiff's invention, adding, "I do not mean from time immemorial, but from such time as will enable a comparison to be made." (c)

The patentee is entitled to discovery in aid of the account, and the defendant will be compelled to produce his books and disclose his business transactions, so far as they relate to the infringements in question: (d) and this, too, even when the decision is under appeal, unless the account has been stayed. (e)

Where no profits have been made by the infringer an account will be refused. (f) Where the admitted profits were very small the plaintiff was given an account, but warned that if he did not prove more profit than the defendants admitted, he should have to bear the costs of the enquiry. (g)

The order for an account will generally contain a direction that the defendant pay to the patentee within a specified time the sums

(z) 14 R. P. C. 471, 472.

(a) See Lord Kinnear, in *United Horseshoes and Nail Co. v. Stewart*, 3 R. P. C. 143.

(b) *Siddell v. Vickers*, 6 R. P. C. 467.

(c) *Ibid.*

(d) *Saaby v. Easterbrook*, L. R. 7 Ex.

(e) *Ibid.*

(f) *Bergmann v. Macmillan*, 17 C. D. 427.

(g) *Jenkins v. Hope*, 13 R. P. C. 60 (per North, J.). See, also, *United Telephone Co. v. Patterson*, 6 R. P. C. 142.

found to have been made by the defendant through his unlawful use of the invention. (*h*)

As in the case of an enquiry into damages, the taking of an account will in the Chancery Division be referred to the master or to a referee, whose certificate or report is subject to review by the Court.

Where the judge has directed an account to be taken before the master, and that officer has held his enquiry, the judge ought not, if he finds it necessary to discharge the certificate, to remit the account to be taken afresh before an official referee. In such case the proper course is to send the account back to the master with directions; and this is so even where it becomes clear that the account ought in the first instance to have been sent to an official referee. (*i*)

As in the case of an injunction, a plaintiff may forfeit his right to an account by laches. (*j*)

Costs.

General Costs of the Action.—The general rule is, that the costs are given to the successful party. The judge, however, has a discretion, subject to this, that if the case is tried with a jury the costs must, except where good cause exists for a contrary order, follow the event. (*k*)

Generally speaking, the successful litigant is entitled to costs. "As I understand the law as to costs," said Jessel, M.R., (*l*) "it is this, that where a plaintiff comes to enforce a legal right, and there has been no misconduct on his part—no omission or neglect which would induce the Court to deprive him of his costs—the Court has no discretion, and cannot take away the plaintiff's right to costs. There may be misconduct of many sorts: for instance, there may be misconduct in commencing the proceedings, or some miscarriage in the procedure, or an oppressive or vexatious mode of conducting the proceedings, or other misconduct which will induce the Court to refuse costs; but where there is nothing of the kind, the rule is plain and well settled, and is as I have stated it. It is, for instance, no answer, where a plaintiff asserts a legal

(*h*) *Holland v. Fox*, 3 E. & B. p. 986;
Plimpton v. Malcolmson, *Seton on Decrees*,
vol. i. 567; *Wenham v. Carpenter*, 5
R. P. C. 70.

(*i*) *Siddell v. Vickers*, 11 R. P. C. 163.

(*j*) *Crossley v. Derby*, 1 Myl. & Cr. 428.

(*k*) R. S. C. Order 65, rule 1.

(*l*) *Cooper v. Whittingham*, 15 C. D. 502;
49 L. J. Ch. 754 (copyright case).

right, for a defendant to allege his ignorance of such right and to say, 'If I had known of your right I should not have infringed it.'"

Counsel and Expert Witnesses.—The costs of more than two counsel will not usually be allowed; but in exceptional circumstances three have sometimes been allowed on taxation. (m) Luxuries must be paid for by the party indulging in them. Thus, the costs of drawings on the borders of counsel's brief, to assist him in understanding his case, will not be allowed, nor the cost of the attendance at the trial of a solicitor's clerk as well as the solicitor. (n) Special costs, to a moderate extent, are allowed for scientific witnesses, (o) and sometimes a fee for the time devoted by them out of court to preparing for the evidence they are to give. (p) But no sums approaching the fees actually paid by litigants to experts of eminence are ever allowed on taxation. For the costs chargeable under a taxation between party and party are merely such costs as are necessary to enable the adverse party to conduct the litigation, and no more. (q)

Shorthand Notes.—The costs of shorthand notes of the evidence are not generally allowed, though it is usual in the case of an appeal to allow the costs of a shorthand note of the judgment. (r)

It is therefore desirable where shorthand notes are taken that the respective parties should arrange before the trial how the expense of these shall be met. The proper arrangement would seem to be to agree to make such costs, costs in the action. (s)

In *Ungar v. Sugg*, (t) where shorthand notes had been taken of the proceedings before the chief clerk in the enquiry as to damages, the Court of Appeal expressed the strongest opinion that this was a horrible waste of money.

(m) *Betts v. Clifford*, 1 J. & H. 74; *Cousens v. Cousens*, L. R. 7 Ch. 48; *Betts v. Cleaver*, L. R. 7 Ch. 516; *Smith v. Buller*, L. R. 19 Eq. 473; 45 L. J. Ch. 880; *Automatic Weighing Machine Co. v. Hygienic Society*, 6 R. P. C. 475; *Leonhardt & Co. v. Kallé & Co.*, 12 R. P. C. 306; *Palmer Tyre, Limited, v. Pneumatic Tyre Co.*, 16 R. P. C. 496.

(n) *Smith v. Buller*, supra.

(o) *Batley v. Kynoch*, L. R. 20 Eq. 632; 33 L. T. (N. S.) 45.

(p) *Smith v. Buller*, supra. Fifteen guineas for two days' work were allowed in this case.

(q) *Ibid.*

(r) *American Braided Wire Co. v.*

Thomson, 7 R. P. C. 163. Where, however, the judge and both parties had used the notes day by day in the trial below, the Court of Appeal allowed the costs; see *Castner Kellner Alkali Co. v. Commercial Corporation, Limited*, 16 R. P. C. 251; [1899] 1 Ch. 803. The shorthand notes were also allowed by Wills, J., in *Palmer Tyre, Limited, v. Pneumatic Tyre Co.*, 16 R. P. C. 496.

(s) *Mosley v. Victoria Rubber Co.*, 57 L. T. 148; 4 R. P. C. 255. As to right of solicitor to recover costs of shorthand notes from his client, see *Osmond v. Mutual Cycle Co.* 48 W. R. 125; [1899] 2 Q. B. 488.

(t) 9 R. P. C. 113.

Costs of necessary models will be allowed to a moderate extent. (*u*)

Costs on Certificate of Validity.—In an action for infringement of a patent the Court or a judge may certify that the validity of the patent came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses, as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same. (*v*)

To get the benefit of such a certificate in a subsequent action, the plaintiff must plead it. (*w*)

Sometimes a defendant, who by his defence has contested the validity of the patent, does not appear at the trial, when judgment is obtained in his absence; or appears, and allows judgment to go by consent. Whether a certificate of validity ought in such cases to be given by the judge seems doubtful, conflicting decisions as to this being found in the reports.

In *Stocker v. Rodgers*, (*x*) a case tried before Erskine, J., at the Gloucester Assizes in 1843, where a verdict by consent was taken for the plaintiff for 40s., that learned judge refused to certify that the validity of the patent had come in issue, saying, "My certificate would affect third parties; and it would be possible in a case like the present for two parties by collusion to consent to a verdict in favour of a patent, and if they could obtain a certificate under the third section of the Statute, to use it afterwards to the injury of another party who was really contesting the validity of the patent." (*y*)

Inasmuch as the judge has a discretion to give or refuse the certificate, it would seem that the above is the sound principle for him to act upon, and in *Peroni v. Hudson*, (*z*) where the defendant did not appear, Kay, J., refused to certify. But in recent cases certificates have been given, both where defendants did not appear (*a*) and where actions were compromised at the trial.

In *Tweedale v. Ashworth*, where the question of the validity of the patent though put in issue was not seriously contested, as the plaintiff failed to prove infringement, a certificate was given. (*b*)

(*u*) *Balley v. Kynoch*, L. R. 20 Eq. 632.

(*v*) Patents Act, 1883, s. 31.

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

(*x*) 1 C. & K. 99.

(*y*) This was under 5 & 6 Wm. IV.

c. 83, s. 3.

(*z*) 1 R. P. C. 261.

(*a*) *Haydock v. Bradbury*, 4 R. P. C.
74; *Edison v. Edison*, 11 R. P. C. 33;
Delta Metal Co. v. Maxim, 8 R. P. C. 248.

(*b*) 7 R. P. C. 436. See, also, *Auto-*

In *Birch v. Harrap*, (c) where the Court of Appeal (reversing the judge below) held the patent good subject-matter, but found no infringement, they granted the plaintiff a certificate of validity.

In *Haslam v. Hall*, (d) Stephen, J., granted a certificate to the plaintiff, although the patent was found invalid. It is difficult to see how such a certificate could be of the slightest use, for even if the patentee cured the patent by amendment, no judge would be likely to allow an action in which the patentee had been proved to have no good patent to entitle him to costs as between solicitor and client in a subsequent action.

A certificate of validity can only be granted to a patentee, and therefore cannot be obtained by a defendant who defeats a patent. (e)

Whether a certificate that the validity of a patent has been in issue can be given in an action against a patentee for threats is doubtful (f)

In *Badische v. La Société Chimique*, (g) where one claim in the patent was held bad, Wills, J., granted a certificate as to the rest.

The application for a certificate that the validity of the patent has been in issue should be made to the judge who tried the case, and in court at the close of the trial, but it may be made in chambers. (h) Where the Court of Appeal reverses the decision of the judge below the Court of Appeal may grant a certificate. (i)

It was at one time held that the Vice-Chancellor of Lancaster had no jurisdiction to give such a certificate, (j) but this is no longer the case. (k)

A certificate is not a "judgment" or "order" within Section 19 of the Judicature Act, 1873, and no appeal lies in respect of the granting or refusal of it. (l)

Where a certificate that the validity of a patent has been in

matic Machine Co. v. Knight, 6 R. P. C. 120. In *Morris v. Young* (12 R. P. C. 464, 465), the House of Lords seem to have doubted the propriety of doing this. Cf. *Garrard v. Edge*, 6 R. P. C. 375, where, infringement being proved, the judge declined to go into the issue of validity merely to enable a certificate to be given, and refused the certificate.

(c) 13 R. P. C. 615.

(d) 5 R. P. C. 27.

(e) *Badische v. Levinstein*, 29 C. D. 419.

(f) *Crompton v. Pat-nts Investment Co.*,

5 R. P. C. 404. In *Kurtz v. Spence* (5 R. P. C. 184), Kekewich, J., held it could not.

(g) 14 R. P. C. 892. See, also, *Haslam v. Hall*, 5 R. P. C. 1.

(h) Judicature Act, 1873, s. 39.

(i) *Cole v. Saqui*, 6 R. P. C. 45 (a certificate as to particulars); R. S. C. Order 58, rule 4.

(j) *Proctor v. Sutton*, 5 R. P. C. 185.

(k) 53 & 54 Vict. c. 23.

(l) *Haslam v. Hall*, 20 Q. B. D. 491; 5 R. P. C. 144.

issue has once been granted, the Court will not grant another certificate in respect of the same patent in a second action. (*m*)

Where a certificate has been given, the circumstance that the second defendant does not dispute the validity of the patent has been held to be no reason for refusing to give the plaintiff the benefit of his certificate and costs as between solicitor and client in the second action. (*n*)

The second action must have been begun subsequent to the giving of the certificate, otherwise the section does not apply. (*o*)

The judge, however, may certify in the second action that the plaintiff ought not to have solicitor and client costs.

In *Otto v. Steel*, where the patent was impeached in the second action on grounds different from those taken in the first, Pearson, J., refused the plaintiff solicitor and client costs, although he held a certificate of validity. (*p*)

In the *Automatic Weighing Machines Company v. the National Exhibitions Association*, (*q*) Vaughan-Williams, J., considered that the lax manner in which the plaintiffs' specification was drawn had given rise to the litigation, and on that ground refused solicitor and client costs, despite the plaintiffs' success in a previous action.

The circumstance that the defendant in the subsequent action has acted innocently, and with no knowledge of the patent right, is also a good ground for certifying that he shall not pay solicitor and client costs. (*r*)

Where the Court thinks that the action is vexatious, and that the plaintiff, though technically in the right, ought not to have persisted in his action, the plaintiff may properly be deprived of the costs to which the certificate would otherwise entitle him. (*s*)

But here, as in all other cases where a discretion is given, no hard and fast rule can be laid down to fetter its exercise. Usually in the absence of special circumstances the Court will not certify against solicitor and client costs being given to the holder of a

(*m*) *Edison v. Holland*, 6 R. P. C. 175. p. 287; but see *Otto v. Steel*, 3 R. P. C. p. 120.

(*n*) *United Telephone v. Townshend*, 3 R. P. C. 10; *United Telephone v. St. George*, 3 R. P. C. 339; *United Telephone v. Patterson*, 6 R. P. C. 140 (in this case the defendant had paid £75 into court) but see Charles, J., in *Automatic Weighing Machine Co. v. Hygienic Society*, 6 R. P. C. 480, and *Boyd v. Tootal*, 11 R. P. C.

(*o*) *Automatic Weighing Machine Co. v. Hygienic Society*, 6 R. P. C. p. 480; L. R. 3 Eq. 308; *Automatic Weighing Machine v. Com' ned Weighing Machine*, 6 R. P. C. 126.

(*p*) *Otto v. Steel*, 3 R. P. C. 120.

(*q*) 8 R. P. C. 352.

(*r*) *Boyd v. Tootal*, 11 R. P. C. 185.

(*s*) *Proctor v. Sutton*, 5 R. P. C. 184.

certificate of validity; (t) for, in the absence of good reason to the contrary, he is entitled to such costs. (u)

Costs of Particulars.—The costs of particulars of breaches and particulars of objection are specially provided for, apart from the general costs of the infringement action, by the Patents Act, 1888. (v) Section 29 sub-sect. 6 enacts that on taxation of costs, regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particular delivered by them, unless the same is certified by the Court or a judge to have been proven, or to have been reasonable and proper, without regard to the general costs of the case. A certificate may be obtained either in respect of particulars of objection or particulars of breaches. (w)

The application should be made at the trial, to the judge who tried the case. It may, however, be made within a reasonable time after; (x) but if so made the costs of the application will not be allowed. Although the Court is not restricted to giving the certificate at the trial only, it must, before deciding, have materials upon which to do so. Therefore, where a plaintiff discontinued his action after the defence had been delivered, Romer, J., declined to certify that the defendant's particulars of objection were reasonable and proper, as, without a trial, he had no means of judging of them. (y)

“I cannot certify,” said the learned judge, “unless I have the materials before me which enable me to make a certificate; that is to say, unless I know sufficient of the case, and what is to be said on one side or the other, to enable me to certify that these particulars of objection are reasonable. Now, as a fact, I have no materials before me, and I cannot have, unless I were to enter into a sort of half-trial of the action, and that I cannot do.”

At the same time, it is not always necessary that there should have been a trial of the action to enable particulars to be certified. They may be certified without being proved, if the judge is satisfied

(t) *Fabriques de Produits Chimiques v. Lafitte*, 16 R. P. C. p. 68.

(u) *Welsbach Incandescent Gas Co. v. Daylight Mantle Co.*, 16 R. P. C. 354.

(v) As to the former practice, see 15 & 16 Vict. c. 83, s. 43; *Honiball v. Blumer*, 10 Ex. 538; 24 L. J. Ex. 11; *Batley v. Kynoch*, L. R. 20 Eq. 635.

(w) *Kane v. Guest*, 16 R. P. C. 443; *Haslam v. Hall*, 5 R. P. C. 23.

(x) *Rowcliffe v. Morris*, 3 R. P. C. 145. In this case judgment was given on Nov. 12, and a certificate granted on March 29 following. *Duckett v. Sankey*, 16 R. P. C. 357.

(y) *Wilcox & Gibbs v. James*, 14 R. P. C. 523; [1897] 2 Ch. 71; 66 L. J. Ch. 525; 45 W. R. 474; see, also, *Rothwell v. King*, 4 R. P. C. 399.

that they are reasonable and proper. (z) Some interlocutory proceeding may have been taken in the action, and evidence adduced, from which the Court can form an opinion as to the propriety or reasonableness of the particulars. (a)

Where the Court has felt that it had not sufficient materials in which to judge of the particulars, it has sometimes, as a term of giving leave to discontinue the action, required the plaintiff to pay to the defendant the costs of his particulars of objections, as if they had been certified to be reasonable and proper. (b)

Where the decision of the judge below is reversed on appeal, a difficulty may arise as to certifying the particulars.

In *Morgan v. Windover*, the Court of Appeal affirmed the decision of Kekewich, J., in the plaintiff's favour, but was reversed by the House of Lords. The Lords having only determined the question that the patent was invalid for want of subject-matter, the defendants applied to the judge below for a certificate that they had proved their particulars of objection. Commenting upon the difficulty in which he was placed in having to decide the point three years after the hearing, Kekewich, J., said he could not re-hear the case for this purpose, but must do the best he could in the circumstances. (c)

In the later case of *Morris v. Young*, the House of Lords themselves granted the certificate (d) as to certain particulars of objection considered before them.

Where the Court of Appeal reverses the decision of the judge below, it can certify as to the particulars in the action, just as the judge who tried the case could have done. (e)

But, if it dismisses the appeal, it would seem that the Court of Appeal cannot vary the certificate given by the judge below as to particulars; for, the certificate being neither a judgment nor an order, apparently no appeal will lie as to it alone. (f) This point has not, however, been expressly decided in regard to particulars. (g)

In every case the question must arise as to whether the Court to which the application is made has sufficient materials upon

(z) *Phillips v. Ivel Cycle Co.*, 7 R. P. C. 77.

(a) See the case last cited; and *Stirling, J.*, in *Middleton v. Bradley*, 12 R. P. C. 390.

(b) *Boake v. Stevenson*, 12 R. P. C. 228; *Bethel v. Gage*, 14 R. P. C. 700.

(c) 7 R. P. C. 446; see also the observations of the Court of Appeal in *Cole v. Saqui*, 40 C. D. p. 134; and of *Stirling, J.*,

in *Germ Milling Co. v. Robinson*, 3 R. P. C. 260.

(d) 12 R. P. C. p. 465.

(e) *Cole v. Saqui*, 6 R. P. C. 41; 40 C. D. 132; R. S. C. Order 58, rule 4.

(f) Cf. *Haslam v. Hall*, 5 R. P. C. 144; 20 Q. B. D. 491 (certificate of validity).

(g) See *Lindley, L.J.*, in *Cassel Co. v. Cyanide Co.*, 12 R. P. C. p. 305.

which to certify. Where the Court of Appeal has decided a case on one issue, it has refused to go into other evidence outside that issue, merely in order to inform itself as to whether a certificate for particulars ought to be given. (*h*)

“You are inviting us,” said Lindley, L.J., in *Longbottom v. Shaw*, (*i*) “to hear a great number of objections in order to give you costs. If we had heard them, we should know all about the costs, but I do not feel disposed to investigate those points for the purpose of giving costs.”

In the same way, the judge at the trial has frequently refused a certificate in regard to particulars not gone into before him, through the action being disposed of on some other issue. (*j*)

In *Mandelberg v. Morley*, (*k*) the plaintiffs submitted, when the case was called on, to have their action dismissed with costs. Stirling, J., refused to give the defendants a certificate for their particulars of objection.

In *Badham v. Bird*, (*l*) the defendants were allowed a certificate for such particulars as had been used by them on cross-examination.

Where the Court has been satisfied, however, that it was just and reasonable, under the circumstances of the litigation, that the particulars should have been given, it has allowed such particulars, notwithstanding their not having been gone into at the trial.

Where a certificate is not given as to particulars, the parties, in the absence of any special direction to the contrary, bear their own costs; for, being outside the general costs of the action, the taxing master has no power to enquire into the particulars. Where, therefore, one party thinks that he has been put to costs by improper and vexatious particulars delivered by the other, he ought to apply to the Court to direct the taxing master to see whether any proceedings have been taken improperly by the other side, and to direct that he shall get the costs occasioned by such improper proceedings. (*m*)

It is not necessary that the party applying for a certificate should be entitled to the general costs of the action. A certificate may be, and often is, given to the losing party where the

(*h*) *Longbottom v. Shaw*, 6 R. P. C. 143;
Boyd v. Horrocks, 6 R. P. C. 162.

(*i*) Page 147.

(*j*) *Newsum v. Mann*, 7 R. P. C. 307.

(*k*) 12 R. P. C. 35; 64 L. J. Ch. 245.

(*l*) 5 R. P. C. 238.

(*m*) *Garrard v. Edge*, 7 R. P. C. 139.

successful litigant has contested matters in respect of which he has proved to be in the wrong. (*n*)

In granting certificates under Section 29 of the Patents Act, 1883, the Court aims at securing to the party delivering the particulars the costs of everything reasonably and properly inserted in them, although such party may fail to prove the specific objection under which the detailed particulars may be ranged. (*o*)

Costs of Separate Issues.—Where, as will usually be the case in patent actions, separate issues in law or fact are involved, the costs, unless otherwise ordered, follow the event on each particular issue. (*p*)

In *Badische Anilin v. Levinstein*, (*q*) the infringement, though denied by the defendants, was proved at the trial, but the patent was found invalid on appeal. The Court of Appeal, whilst giving the defendants the general costs of the action, upheld the certificate of Pearson, J., that the plaintiffs had proved their particulars of breaches.

“It seems to me,” said Bowen, L.J., “that without laying down any hard and fast line, or trying to fetter our discretion at a future period in any other case, we are acting on a sensible and sound principle, namely, the principle that parties ought not, even if right in the action, to add to the expenses of an action by fighting issues in which they are in the wrong. It may be very reasonable as regards their own interests, and may help them in the conduct of the action, that they should raise issues in which in the end they are defeated; but the defendant who does so does it in his own interest, and I think he ought to do it at his own expense.” (*r*)

Costs on Higher Scale.—Under Order LXV., rule 9 of the Rules of the Supreme Court, costs on the higher scale may be allowed either generally or as to any particular application made or business done in any cause or matter, if on special grounds arising out of the nature and importance or difficulty or urgency of the

(*n*) L. R. 29 C. D. 419; 2 R. P. C. 118. See, also, as to apportioning costs, *Wegmann v. Corcoran*, 27 W. R. 357; cf. *Nordensfelt v. Gardner*, 1 R. P. C. 75; *Pooley v. Pointon*, 2 R. P. C. 173; *Kane v. Guest & Co.*, 16 R. P. C. 443.

(*o*) This was stated to be the correct working rule by Lindley, M.R., after consultation with the other members of the

Court of Appeal and with the Taxing Masters; see *Castner-Kellner Alkali Co. v. Commercial Corporation, Limited*, 16 R. P. C. p. 276; [1899] 1 Ch. 803; 68 L. J. Ch. 402; 80 L. T. 476; 47 W. R. 534.

(*p*) R. S. C. Order 65, rule 2.

(*q*) L. R. 29 C. D. 366; 2 R. P. C. 118.

(*r*) 29 C. D. p. 419.

case, the Court or a judge shall so order or direct the taxing master.

No appeal usually lies on a mere question of costs; but where costs depend on conditions an appeal lies as to whether such conditions exist. Hence, an appeal lies under this order as to whether special grounds exist enabling the judge to order costs on the higher scale. Where, however, the Court of Appeal finds that such grounds exist they will not interfere with the exercise of the judge's discretion. (s)

Special reason, then, must be shewn before costs on the higher scale can be given. (t)

The circumstance that an action involves a quantity of scientific evidence, or necessitates special knowledge on the part of those concerned in it, is such special reason. (v) But where the enquiry is one of fact only, and not scientific, costs should not be given on the higher scale. (w)

It may happen, however, that although the case could have been tried without scientific witnesses, the conduct of one side in bringing such witnesses has compelled their opponents to do likewise; in such case the opponents if successful may properly be awarded costs on the higher scale. (x)

On the other hand, where the necessity for the scientific evidence arose from the unfortunate wording of the specification, Vaughan-Williams, J., refused to give the plaintiff costs on the higher scale. (y)

In *Fraser v. Brescia Steam Tramways Company*, (z) Kekewich, J., said that the difficulty of a case meant difficulty from a professional point of view, that is, whether the case was one requiring greater industry, greater learning, and more time and expense than the majority of cases. Thus, a case involving a long examination, preparation of models, and expert evidence, is a proper case for costs on the higher scale. (a)

Similarly, in *Farbenfabriken v. Bowker*, Romer, J., gave costs on the higher scale, on the ground that the case was one of great

(s) *Paine v. Chisholm*, [1891] 1 Q. B. 531. R. P. C. 64.

(t) *Grafton v. Watson*, 51 L. T. (N. S.), 145 (per Lindley, L.J.).

(v) *Moseley v. Victoria Rubber Co.*, 4 R. P. C. p. 255; 57 L. T. (N. S.), 148; *Edison v. Holland*, 5 R. P. C. 483; *Hopkinson v. St. James Lighting Co.*, 10 R. P. C. 62; *Muirhead v. Commercial Cable Co.*, 12

(w) *American Braided Wire Co. v. Thomson*, 44 C. D. 296; 7 R. P. C. 163.

(x) *Ellington v. Clark*, 5 R. P. C. 328; 58 L. T. (N. S.), 522.

(y) *Wenham v. Champion*, 8 R. P. C. 320.

(z) 56 L. T. (N. S.), p. 772.

(a) *Wenham v. May*, 4 R. P. C. 310.

difficulty, involving much trouble to the solicitors and other persons engaged in it. (b)

The simplicity of a case when it comes into court may be due to the expenditure of unusual time and trouble out of court in overcoming difficulties and clearing the issues. In such case costs on the higher scale may properly be given. (c)

Where successful appellants did not at the hearing of the appeal ask for costs on the higher scale, but moved for such costs subsequently, the Court of Appeal, although allowing higher costs, gave no costs of the motion, as the application should have been made when the appeal was heard. (d)

Stay of Execution pending Appeal.

Stay of Injunction.—Sometimes the defendant applies for a stay of execution pending appeal. An appeal does not in itself operate as a stay, (e) and the general rule is that in the case of an injunction a stay will not be granted. (f) But each case depends largely upon its own special circumstances. If a stay is granted as to the injunction, the defendant will generally be put on terms to keep an account. (g) Sometimes the injunction is suspended by consent, the defendants undertaking to keep an account.

If the defendant is engaged in executing orders for the article complained of, and the question of infringement is one of difficulty and doubt, the Court is more disposed to stay the injunction pending appeal. (h)

In *Proctor v. Bennis*, Cotton, L.J., said: "This is an application to stay the execution of a judgment pending an appeal to the House of Lords. I say stay the execution, because restraining the plaintiffs from putting in force the injunction, or saying that it is not to be put in force pending that appeal to the House of Lords, is staying execution. In my opinion, on the facts before us, there is no case for that at all. If it appeared that the defendant *Bennis* was now making machines which we have decided to be an infringement of the plaintiff's patent, then, in order not to stop his

(b) 8 R. P. C. 397.

(c) *Fraser v. Brescia Steam Tramways Co.*, 56 L. T. (N. S.) 771. See, also, *Davies v. Davies*, 56 L. J. Ch. 486.

(d) *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, 6 R. P. C. 372.

(e) R. S. C. Order 58, rule 16.

(f) *Otto v. Steele*, 3 R. P. C. 121.

(g) *Hocking v. Fraser*, 3 R. P. C. 7; *Kaye v. Chubb*, 4 R. P. C. 27; *Lyon v. Goddard*, 10 R. P. C. 136; *North British Rubber Co. v. Mackintosh*, 11 R. P. C. 489; *Ducketts v. Whitehead*, 12 R. P. C. 191; *National Opalite Syndicate v. Ceralite Syndicate*, 18 R. P. C. 658.

(h) *Ducketts v. Whitehead*, 12 R. P. C. 191; *Boyd v. Horrocks*, 5 R. P. C. 580.

manufacture of those machines while the question is still before the House of Lords, I think it might be right, subject to terms, to stop the injunction being enforced; but it appears to me that the object is to prevent the effect of our judgment deterring those who would otherwise buy machines, he saying he is not now making any of the machines. In my opinion, therefore, there is no reason for granting this stay." (i)

But where defendants, after warning that they were infringing a patent, accepted orders, and proceeded to execute them deliberately, with their eyes open, the Court refused a stay (the plaintiffs standing on their strict rights), although the orders under execution were for public authorities, and it would have been a convenience to the public to grant it. (j)

In *Nordenfelt v. Gardner*, (k) the injunction was stayed so far as related to the defendants supplying arms to the Government.

In *Hopkinson v. St. James's Company*, (l) the injunction, in consequence of the inconvenience the public would suffer if it were immediately enforced, was suspended for six months, an account of profits being kept meanwhile.

Enquiry as to Damages.—Sometimes the Court, while refusing to stay the injunction, will grant a stay as to the enquiry into damages or the account, (m) on condition that notice of appeal is given within a fortnight, or some other specified time. (n)

In the *Automatic Retort Company v. Mayor, etc., of Salford*, the enquiry as to damages was allowed to proceed, but the judge directed the amount found to be paid into Court if the appeal was still pending. (o)

Costs.—A stay is not generally granted as to costs, the usual practice being for the defeated party to pay over the costs awarded against him if taxation is completed before the appeal is heard—the solicitor of the other party undertaking to return them if the appeal is allowed. (p)

Stay by the Court of Appeal.—An application for a stay pending

(i) 4 R. P. C. 363.

(j) *Lyon v. Goddard*, 10 R. P. C. 348.

(k) 1 R. P. C. 63.

(l) 10 R. P. C. 62.

(m) *Humpherson v. Syer*, 4 R. P. C. 189; *Siddell v. Vickers*, 5 R. P. C. 101; *Brooks v. Lamplugh*, 14 R. P. C. 620.

(n) *Hocking v. Fraser*, 8 R. P. C. 7; *Pneumatic Tyre Co. v. Leicester Tyre Co.*, 15 R. P. C. p. 168; *Presto Gear Case Co. v. Simplex Co.*, 15 R. P. C. 644; *Pneumatic*

Tyre Co. v. Leicester Co., 16 R. P. C. 50.

(o) 14 R. P. C. 472.

(p) *Ticket Punch Co. v. Colley*, 12 R. P. C. p. 10; *Deeley's Patent*, 12 R. P. C. 75; *Muirhead v. Commercial Cable Co.*, 12 R. P. C. 64; *Chadburn v. Mechan*, 12 R. P. C. 135; *Automatic Retort Co. v. Salford*, 14 R. P. C. 472; *Castner-Kellner Co. v. The Commercial Corporation, Limited*, 15 R. P. C. 662; *Dick v. Ellam*, 16 R. P. C. 424.

an appeal to the Court of Appeal will not be entertained by that Court, unless it has first been made to the Court below. (q)

The Court of Appeal will not grant a stay of execution pending an appeal to the House of Lords, unless the circumstances of the case are exceptional. (r)

In the *North British Rubber Company v. Gormully*, (s) a stay was granted for three weeks, £500 being paid into Court by the appellants; but the Court intimated that whatever the result of an application to the House of Lords might be the Court of Appeal would not itself extend the stay lightly.

Where a stay is desired pending an appeal to the House of Lords, the intending appellant should not apply at the conclusion of the hearing, but move for a stay on some subsequent day. (t)

Appeal.

When an Appeal Lies.—An appeal lies to the Court of Appeal under Section 19 of the Judicature Act, 1873, from any judgment or order—and by the interpretation clause, “judgment” includes “decree,” and “order” includes “rule;” but no appeal lies in respect of a certificate. “At the time the Act of 1873 was passed,” said Fry, L.J., in *Haslam v. Hall*, “there was another well-known method of expressing judicial determinations, namely, by certificate. For instance, certificates under the Patent Act had been enforced by the various Statutes for many years—certainly since the Statutes of William IV.; there were certificates as to special juries, there were certificates if an action was brought to try a right under 3 & 4 Vict., and there were certificates on summonses—properly attended by counsel. In all these, and I dare say many other instances, certificates were known, and if the legislature had been minded to give a right of appeal in respect of those certificates it clearly would have been expressed in the Statute. The Statute is silent as to them, and, in my judgment, there is no right of appeal.” (u)

So likewise there is no right of appeal as to a question of costs

(q) R. S. C. 58, rule 17; *Young v. Kershaw*, *Times*, Aug. 9, 1899.

(r) *Castner-Kellner Alkali Co. v. Commercial Corporation, Limited*, 16 R. P. C. 251; *Lyon v. Goddard*, 10 R. P. C. 350 (per Esher, M.R.); *Proctor v. Bennis*, 4 R. P. C. 363; *Edge v. Johnson*, 9 R. P. C. 142; *Johnson v. Edge*, 9 R. P. C. 150; *North British Rubber Co. v. Gormully*, 14 R. P. C. 302, 303; *Lancashire Explosives*

v. Roburite Co., 12 R. P. C. 483. See, also, *Penn v. Bibby*, L. R. 3 Eq. 308.

(s) *Supra*; cf. *Lucas v. Miller*, 17 R. P. C. 165.

(t) *Proctor v. Bennis*, 4 R. P. C. 363; *Lyon v. Goddard*, 10 R. P. C. 348; *Lancashire Explosives Co. v. Roburite*, 12 R. P. C. 483.

(u) 5 R. P. C. 145.

merely. (*v*) But where costs depend on some special grounds, as, *e.g.* where costs on the higher scale are awarded, the Court of Appeal will review the judge's decision, so far as to determine whether or not such special grounds in fact exist, but not so as to question the discretion of the judge in acting upon them, if found. (*w*)

To give an unrestricted right of appeal the judgment or order must be final—if it is merely interlocutory no appeal lies without leave; (*x*) for which application must first be made to the Court below; if refused there, the application may be renewed in the Court of Appeal. (*y*) But the Court of Appeal will not grant leave if it has not first been sought from the judge below. (*z*)

Although, as above stated, the general rule is that no appeal lies from an interlocutory order without leave, yet, if the application is for an injunction or a receiver, leave is not necessary. (*a*)

Practice on Appeals.—All appeals to the Court of Appeal are by way of re-hearing. But this does not mean that the Court will re-hear the case, and judge of the witnesses and evidence as a Court of first instance would do. (*b*) Appeals are brought by notice of motion in a summary way. (*c*)

Notice of appeal, in the case of a final order, must be given before the expiration of three months from the decision appealed from; (*d*) if the order is interlocutory, before the expiration of fourteen days. (*e*) But the Court of Appeal may by special leave extend the time. The time for appealing is calculated in the case of an order in chambers from the time when it was pronounced, or when the appellant first had notice of it; in other cases, from the time when the judgment or order is signed, entered, or otherwise perfected; in the case of applications, from the date of refusal. (*f*)

The notice is in the case of any judgment, or of a final order, a fourteen days' notice. In the case of appeal from an interlocutory order it is a four days' notice. (*g*)

(*v*) Judicature Act, 1873, s. 49.

(*w*) *Paine v. Chisholm*, [1891] 1 Q. B. 531.

(*x*) Judicature Act, 1894, s. 1 (b).

(*y*) *Ibid.*

(*z*) R. S. C. Order 58, rule 17; *Young v. Kershaw*, *Times*, Aug. 9, 1899.

(*a*) Judicature Act, 1894, s. 1 (b, ii.).

(*b*) *Huggenmacher v. Watson*, 14 R. P. C. p. 634.

(*c*) R. S. C. Order 58, rule 1.

(*d*) R. S. C. Order 58, rule 15.

(*e*) *Ibid.*

(*f*) *Ibid.* Where part of the relief sought is granted and part refused the appellant is entitled to see the exact form of order before deciding whether he will appeal or not, unless the simplicity of the order renders this unnecessary; see *Shelfer v. City of London Co.*, [1895] 1 Ch. 287.

(*g*) R. S. C. Order 58, rule 3.

If a respondent gives notice of a cross appeal the periods of notice are respectively eight and two days. (*h*)

The appellant may appeal from all or part only of the judgment or order. If from part he must specify what the part is of which he complains. (*i*)

The grounds of appeal need not be specified in the notice, unless a new trial is asked for, in which case it will apparently be safer to set out the grounds. (*j*)

Evidence and Amendment.—If on appeal it is desired to refer to the oral evidence given below, the appellant should apply to one of the judges of the Court of Appeal through his clerk, to ask the judge who tried the case to send to the Court of Appeal a copy of his notes. If this has not been done the appeal will be ordered to stand over at the appellant's cost. (*k*)

The Court of Appeal will not look at a shorthand note of the evidence taken by a clerk of one of the solicitors in the action. A shorthand note to be referred to must have been taken by a professional shorthand writer. (*l*)

The Court of Appeal has all the powers of amendment that a judge of the High Court would have had, and has a full discretion to admit on the hearing of the appeal further evidence as to questions of fact. It may make any order that the judge below might have made, and any further order that the nature of the case may require. (*m*)

Its jurisdiction in the case of a patent action is just the same as in the case of any other appeal. (*n*)

The Court of Appeal will, however, only admit fresh evidence on appeal reluctantly; (*o*) and special grounds for doing so

(*h*) R. S. C. Order 58, rule 7. He need not do so, however, if he does not propose to contend that the order below should be varied.

(*i*) R. S. C. Order 58, rule 1.

(*j*) R. S. C. Order 39, rule 3. This rule was made when these appeals were heard by a Divisional Court; now they go direct to the Court of Appeal: Judicature Act, 1890, s. 1.

(*k*) *Ellington v. Clark*, 38 C. D. 332.

(*l*) As the Court of Appeal will not allow the costs of a shorthand note of more than the judgment, the parties should agree before trial as to how the costs of the note of the evidence shall be met. The best mode would seem to be an

agreement that they shall be costs in the action: *Moseley v. Victoria Rubber Co.*, 4 R. P. C. 255.

(*m*) Order 58, rule 4; *Shoe Machinery Co. v. Cutlan*, [1896] 1 Ch. 111. It may grant a certificate as to particulars; see *Cole v. Saqui*, 6 R. P. C. 45; L. R. 40 C. D. 132.

(*n*) *Shoe Machinery Co. v. Cutlan*, supra. Per Smith, L.J., pp. 111, 112. As to an appeal against an injunction by defendants who have become bankrupt, see *United Telephone Co. v. Bassano*, 31 C. D. 630.

(*o*) *Walker v. Hydro-Carbon Syndicate*, 3 R. P. C. 254.

must always be shewn. (p) Discussing what circumstances would amount to special grounds, Lindley, L.J., in *Hinde v. Osborne*, said: "I cannot understand that as meaning that the Court of Appeal ought to grant leave to adduce fresh evidence simply because a man has failed at the trial and he thinks he can get more evidence, which, if he had got it before, would have enabled him to succeed on the trial. That cannot be. There must be some ground shewn to satisfy the Court that there is some evidence now forthcoming which, with due diligence, he could not have got, and it must, moreover, in accordance with the usual practice, be evidence—not merely the swearing by affidavits or anything of that kind—but something in the nature of the production of a lost document, or something of that sort, which will not expose the parties to a mere flood of affidavits made up to meet the blots and the defects which have been disclosed upon the first trial." (q)

When the evidence proposed to be admitted on appeal had been used in the Court below for cross-examination purposes, leave was refused. (r) Where the defendant had deliberately elected below to raise only the question of infringement, the Court of Appeal refused to admit evidence to prove the invalidity of the patent. (s)

Allegations of counsel that witnesses below were acting in conspiracy, unsupported by anything appearing on the evidence, afford no ground for admitting further evidence on the appeal. (t)

In *Spencer v. Ancoats Company*, (u) on a motion for sequestration and committal, leave was given to file further evidence, the other side to have an opportunity of replying to it; and both sides to be entitled to cross-examine on the new affidavits before an examiner, if they so desired.

Security for Costs.—Where a respondent desires to get security for the costs of the appeal, he ought to apply to the appellant before moving for security. (v) An uncontradicted affidavit that the appellant has given a bill of sale on all his visible property is sufficient evidence to induce the Court to order security to be given. (w) In *Garrard v. Edge*, on this evidence £20 was ordered to be paid into court as security for the costs. But no costs of the motion were given. (x)

(p) R. S. C. Order 58, rule 4.

(q) 2 R. P. C. p. 47.

(r) *Walker v. Hydro-Carbon Syndicate*,
3 R. P. C. 253

(s) *Hinde v. Osborne*, 2 R. P. C. 47.

(t) *Huggenmacher v. Watron*, 14 R. P.

C. p. 634 (per Lord Esher).

(u) 6 R. P. C. 54, 55.

(v) *Garrard v. Edge*, 7 R. P. C. 144.

(w) *Ibid.*

(x) *Ibid.*

An intending appellant may advertise for trade subscriptions in support of his appeal, and also for evidence to prove anticipation, and offer a reward therefor without committing a contempt of court. (*y*)

Appeal to the House of Lords.—From any order or judgment of the Court of Appeal an appeal lies to the House of Lords. (*z*) Such appeal must be brought within a year. (*a*)

In the *American Braided Wire Company v. Thomson*, the Court of Appeal declined to allow the appellants to pay the damages, pending an appeal to the House of Lords, into court instead of to the plaintiffs. Such an order will not be made unless the Court of Appeal is satisfied that the appellant will probably not be able to get the money repaid in the event of the appeal being successful." (*b*)

Where an application for this purpose is made, it ought to be by separate motion (*c*)

The Court of Appeal will not, unless the circumstances are exceptional, grant a stay of execution pending an appeal to the House of Lords. (*d*) The fact that the plaintiff's patent is about to expire is not by itself a ground for granting such stay of execution. (*e*)

(*y*) *Plating Co. v. Farquharson*, 17 C. D. 49.

(*z*) Appellate Jurisdiction Act, 1876, s. 1. See Forms of Notice and Petition of Appeal to the House of Lords, Appendix IV. post.

(*a*) Standing Orders, Nov., 1867, Order 1.

(*b*) 7 R. P. C. 163.

(*c*) Ibid.

(*d*) See cases cited ante, p. 558, note (*r*).

(*e*) *Taylor v. Annand*, 16 T. L. R. 84, p. 86. In *Lucas v. Miller*, 17 R. P. C. 165, a stay was granted.

CHAPTER XXIII.

REMEDIES OF THE PUBLIC.

1. *Action against the Patentee for Threats.*

Remedy under the Statute of Monopolies.—Inasmuch as grants to inventors are not guaranteed by the Crown, but always liable to be defeated if shewn to be contrary to law, it is manifest that threats issued by a patentee against persons whom he believes to be infringing his monopoly are issued at the peril of the patentee, and may be totally unjustifiable. Hence, a legal remedy is obviously required for the protection of the public, in cases where the person issuing such threats proves, when challenged, to have no valid patent right to support his pretensions.

Section 4 of the Statute of Monopolies (*a*) might have been supposed to provide such a remedy. For by that section it is enacted that any person hindered, grieved, disturbed, or disquieted by pretext of any monopoly or letters patent, may have his remedy by action at the common law upon that Statute for treble damages and double costs. No advantage, however, seems to have been taken of this remedy by the public, as the early reports do not contain any reference to a decision under this section, (*b*) and although it is still unrepealed, the legislature has recently provided another remedy by Section 32 of the Patents Act, 1883. Prior to that Act the Courts had held that an action for damages and an injunction would lie (independently of any express enactment) against a patentee who *mala fide* issued threatening circulars containing untrue statements. (*c*) In such action, however, it was

(*a*) 21 Jac. I. c. 3.

(*b*) A recent attempt to enforce the provisions of s. 4 of 21 Jac. I. c. 3 was not viewed with favour by the Court; Mathew, J., holding that no proceedings could be taken under this section against a person suing on a patent which was invalid, but capable of being cured by disclaimer.

See *Peck v. Hindes*, 14 T. L. R. 164; 15 R. P. C. 113.

(*c*) *Wren v. Wiold*, L. R. 4 Q. B. 730; 38 L. J. Q. B. 327; *Burnett v. Tak*, 45 L. T. (N. S.), 743; *Anderson v. Liebig's Co.*, 45 L. T. (N. S.), 757; *Sugg v. Bray*, Griff. P. C. 210; 1 R. P. C. 45; 2 R. P. C. 223.

held that the circumstance that a patentee did not follow up his threats by legal proceedings was not by itself evidence of *mala fides*. (d)

Action under the Patents Act, 1883.—The remedy provided by Section 32 of the Patents Act, 1883, is not so ample as that originally given under the Statute of Monopolies. Any person aggrieved through circulars, advertisements, or otherwise, with threats of legal proceedings or liability, by a person claiming to be the patentee of an invention, may under this section bring an action for an injunction and damages, if the alleged manufacture, use, sale, or purchase to which the threats relate was not or would not have been in fact an infringement of any legal rights of the person making such threats.

But no action lies under this section, however unfounded the threats may be, where the person making them, with due diligence commences and prosecutes an action for infringement. (e) “The meaning of this,” said Bowen, L.J., “is that the sword of Damocles should either not be suspended at all, or should fall at once.” (f) The *bona fides* of the person threatening is therefore now immaterial; his only defences are: (1) That the matters in respect of which he issued his threat are infringements of his patent right; or (2) that he has commenced and prosecuted an action for infringement with due diligence.

Discussing the section in *Skinner v. Perry*, (g) Smith, L.J., said: “This is an absolute prohibition against a person threatening, unless the threatener brought himself within either of the two saving clauses at the end of the section. My reading of the section is that you shall not threaten legal proceedings, unless the manufacture to which the threat applies infringes the legal right of the threatener, or unless the threatener is about to forthwith bring an action to shew the validity of his threats. If he cannot bring himself within these two what I call saving clauses at the end of the section, then the section absolutely forbids a man threatening legal proceedings with regard to a patent at all, and in my opinion it is *nihil ad rem* to say that what he

(d) *Halsey v. Brotherhood*, 15 C. D. 514; 19 C. D. 386; 49 L. J. Ch. 786; 51 L. J. Ch. 233. Overruling *Rollins v. Hinks*, L. R. 13 Eq. 355, and *Azmann v. Lund*, 18 Eq. 330. In *Clark v. Adie*, threatening circulars were sent by the patentee to the customers of a licensee under the patent; an injunction was

granted, this being in contravention of the license: 21 W. R. 456, 764.

(e) *Colley v. Hart*, L. R. 44 C. D. 179; 6 R. P. C. 17; 7 R. P. C. 101; 62 L. T. (N. S.), 424; 38 W. R. 501.

(f) See *Skinner v. Perry*, 10 R. P. C. 8.

(g) *Supra*. See, also, *Douglass v. Pintsch*, 13 R. P. C. 681.

did was on a privileged occasion, because the section says you shall not threaten, unless you come within those two provisions at the end."

This action may be tried at Assizes, (*h*) and either party may claim a jury. Usually, recourse has not been had to a jury; but in *Appleby's Twin Roller Chain Company v. Eadie*, (*i*) where a trade libel was also pleaded, the plaintiffs obtained an order for trial before a special jury.

What is a Threat within the Meaning of the Act.—It will be convenient now to consider what constitutes an actionable threat within the meaning of the section. A threat may be a statement having reference to future as well as past acts.

It was at one time supposed that the language of the section only contemplated threats having reference to completed acts. This view received countenance from the language used by Bowen, L.J., in *Challender v. Royle*. (*j*) The learned Lord Justice in that case said: "I think the threat which is the subject-matter of the action must not be merely a warning about something that is going to be done, but must be a threat about an act done, a threat of legal proceedings or liability in respect of an alleged manufacture, use, sale, or purchase of an invention, not in respect of a proposed manufacture, use, sale, or purchase. It seems to me that that interpretation is confirmed by the subsequent language in the section, where the words employed are that an injunction and damages may be obtained if the alleged manufacture, use, sale, or purchase, was not in fact an infringement, the condition imposed under the word 'if' pointing, it seems to me, to an act done which is alleged by the patentee to be an infringement, but which may not really be an infringement. Again, when you come to the proviso, you find that an action for infringement of the patent is to be the means by which the section may be avoided, implying, I think, that there has been something done which is asserted to be an infringement of the patent. I think, then, that threats would not fall within the section if they were mere threats or warnings as to something which might be done in the future."

In the later case of *Johnson v. Edge*, (*k*) the Court of Appeal, however, dissented from the above dicta of Bowen, L.J. "The Lord Justice went on to say, as I understand him," said Lindley, L.J., "that he doubted whether this section would apply unless

(*h*) *Appleby's Twin Roller Chain v. Eadie*, 16 R. P. C. 330. p. 441.

(*i*) *Supra*.

(*j*) 56 L. J. Ch. p. 1005; 36 C. D.

(*k*) [1892] 2 Ch. 1; 9 R. P. C. 142; 61 L. J. Ch. 262.

there had been an actual infringement. I should like to qualify that by saying that I think, upon the true construction of this section, the section might apply to an intended infringement, provided that you could shew that the intended infringement, if carried out, would be an actual infringement. I can understand a man issuing a prospectus, and issuing circulars and notices, to the effect that he was going to make something which would be an infringement of the patentee's right. I am not prepared to say that the patentee could not threaten to stop him, and bring himself within the section. I should not like to say that the section would not apply to such a case simply because the threat preceded the actual damage. I doubt whether it would not. I also doubt whether Bowen, L.J., in *Challender v. Royle* meant to address his mind to such a case as that. He had not got it before him."

"I can conceive one case of future infringement," said Kay, L.J., in the same case, "which would come entirely within the mischief which this section was intended to provide against. Suppose a man issued a circular, saying, 'I have a patent for such and such an article. I understand that Messrs. A. and Co. have recently erected a large manufactory for the purpose of manufacturing articles which, if 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? Could not Messrs. A. and Co. bring an action against the person who issued that circular for an injunction? I should wish at least to suspend my opinion on that subject until that point comes before the Court of Appeal to be tried." (1)

That the view of Lindley and Kay, L.JJ., as above expressed is the sounder construction of the section would seem to admit of little doubt; especially considering that the whole object of issuing threatening circulars must be the prevention of future intended acts of infringement either by frightening the makers of pirated articles from making and selling them or their customers from purchasing and using them. Nor does the proviso that due diligence in bringing and prosecuting an infringement action shall be a good defence, appear to raise any serious difficulty to this interpretation, seeing that an action will

(1) [1892] 2 Ch. p. 12. See, also, Kekewich, J., in *Kurtz v. Spence*, 5 R. P. C. 171; 57 L. J. Ch. 240. In this last case the plaintiffs had not yet erected their

plant and machinery for making the articles in respect of which they were threatened; but an injunction was granted.

lie for an injunction to restrain an intended infringement even where no acts of infringement have already been committed.

The words "or otherwise" in the section, after "by circulars, advertisements," are not *ejusdem generis* with circulars and advertisements; they extend the meaning of those words, and are not limited by them, for the section is an absolute prohibition. (m)

"I agree," said Bowen, L.J., in *Skinner v. Perry*, (n) "that you should not find out the mischief in order to extend the remedy; yet if the mischief is obvious, and apt words are to be found in the section, nothing is plainer than that you ought to expound an Act of Parliament so as to deal with the whole mischief that is disclosed. What is the explanation of the addition of the words 'circulars or advertisements'? I think it is rather to enlarge the words 'or otherwise' than to cut them down. It might well be doubted whether a threat which was not addressed to a particular person, or was not addressed to a particular customer, could be said to be a threat if it was couched in the general form of an advertisement issued to the world or a circular issued to the trade. It might be said it is not a threat at all; 'I am only informing you of the way in which I intend to do my business.' The Statute says circulars and advertisements nevertheless may contain threats, and using those words so as to sweep into its net every kind of threat, the result will be that a man is not paralysed in his trade by having an action on a patent suspended before his eyes without the opportunity given to him to determine the suspense at once, and to bring the question which is raised by his antagonists to a speedy and immediate issue."

Threats by Letters.—The section includes threats by letters. (o) The letter need not be written direct to the person aggrieved; it is sufficient if it is written to one of his customers, or to a person using his invention. (p) Nor need it necessarily contain any statement as to the threatener being himself a patentee. If the Court is satisfied at the trial that the defendant had his own patents in his mind when he wrote, and that the letter was intended to

(m) *Driffield v. Waterloo Co.*, 31 C. D. 638; 3 R. P. C. 46; 55 L. J. Ch. 391; *Combined Weighing Machine Co. v. Automatic Co.*, 42 C. D. 665; 6 R. P. C. 502; 58 L. J. Ch. 709; 38 W. R. 233; *Barrett v. Day*, 43 C. D. 435; 7 R. P. C. 54; *Skinner v. Perry*, 10 R. P. C. 1; [1893] 1 Ch. 413.

(n) 10 R. P. C. 8.

(o) *Driffield v. Waterloo Co.*, 3 R. P. C.

46; *Griff. P. C.* 80; *Barrett v. Day*, 7 R. P. C. 54; *Willoughby v. Taylor*, 11 R. P. C. 45; *Hoffnung & Co. v. Salsbury*, 16 R. P. C. 375.

(p) *Johnson v. Edge*, [1892] 2 Ch. 1; *Burt v. Morgan*, 4 R. P. C. 278; *Colley v. Hart*, 44 C. D. 186; 7 R. P. C. 101; *Kensington Lighting Co. v. Lane Fox*, [1891] 2 Ch. 577; *Skinner v. Perry*, 9 R. P. C. 142.

hamper or interfere with the plaintiff's sales, that is an actionable threat. (q) Thus, in *Douglass v. Pintsch*, (r) Romer, J., held the following letter to a railway company, one of the plaintiff's customers, to be within the section: "I am in receipt of your letter of yesterday's date, and understand that you have given *Mr. Douglass* the order for the gas buoy lanterns, no price having been asked from my company. As we have supplied hundreds of lanterns, and *Mr. Douglass* has, so far as I know, not made one, I am much surprised at this. I am afraid this matter will lead to a great deal of difficulty and unpleasantness, and you must not be surprised if my company applies for an injunction against *Mr. Douglass* to restrain him from selling his gas buoy lanterns."

In *Kurtz v. Spence*, (s) Kekewich, J., held threats to be within the section which were contained in a correspondence expressed to be "without prejudice," and entered into with a view to a settlement without litigation.

A threat contained in a letter which is not withdrawn is a continuing threat, and the defendants will not escape an injunction by striking out of their defence the plea of infringement. (t)

A threat is none the less a threat from being conveyed in a private letter. (u)

There is nothing in the Act to limit the cause of action to threats in writing only, therefore a verbal threat made at an interview will be within the section, (v) but in such case the plaintiff would have more difficulty in proving his case, as an action brought upon threats conveyed in conversation only would probably produce a considerable conflict of testimony.

A complaint that the plaintiff's machine, though not in itself an infringement, is being used by third parties in an infringing manner would seem not to be within the section. But the Court will grant an injunction if the form of the complaint is such as to cause people to believe that the invention itself is complained of. (w)

When a General Warning may be a Threat.—Nor is a mere general warning that a patentee intends to stand upon his rights

(q) *Douglass v. Pintsch*, 13 R. P. C. 673; [1897] 1 Ch. 176; 65 L. J. Ch. 919; 75 L. T. 332; 45 W. R. 108.

(r) *Supra*.

(s) 5 R. P. C. 161; 57 L. J. Ch. 238.

(t) *Driffeld v. Waterloo Co.*, 31 C. D. 638; Griff. P. C. 80; 3 R. P. C. 46.

(u) *Dowson v. Drosophore*, 12 R. P. C. 100.

(v) See *Kurtz v. Spence*, 57 L. J. Ch. 241; 5 R. P. C. 161; *Dowson v. Drosophore*, 11 R. P. C. 536.

(w) *Burt v. Morgan*, 4 R. P. C. 280.

an actionable threat; it must be directed against some person. (x) "I cannot suppose," said Lindley, L.J., "that the section prevents a patentee from saying that which the patent itself implies, namely, that anybody infringing must expect legal proceedings to be taken against him. I do not think it can mean that. It is merely saying what everybody knows already. That is not a threat against anybody in particular."

But a circular, though framed in general terms, may, when sent to dealers in the articles concerned, amount to a direct threat to such persons. In one case a circular had been issued by the patentee in the following terms: "Notice to grocers and others. Information of extensive violations of *Mr. William Edge's* patent rights has been received. All parties are warned not to infringe these rights." This was issued by the patentee as a wrapper round goods of his own manufacture, and several such circulars were received by the customers of the plaintiffs. This was held to be a threat within the meaning of the section. "That circular," said Mathew, J., "was sent out with the goods of the defendant, and warned everybody who took those goods that the person taking them might find himself involved in liability for an infringement of the patent right alleged here, if he bought other goods of a similar nature. It seems to me that that is what this section aims at." (y)

Pleadings and Particulars.—In an action for threats, the plaintiff may plead that the defendant's patent upon which the threats have been issued is invalid. (z) If he has not done so in the statement of claim, he may raise this issue in his reply. (a) By proving this he negatives the defence that the threats were justifiable because he was an infringer, for there can be no infringement where there is no valid patent right. (b) But where the plaintiff raises this issue, he must deliver to the defendant particulars of the objections on which he relies, and, on the question of validity, the defendant will be entitled to begin and to have a reply. (c)

Where the defendants in an action for threats owned several patents, and did not specify in the advertisement containing the threats complained of, which of their patents those threats referred

(x) *Challender v. Royle*, 36 C. D. 425;
Johnson v. Edge, [1892] 2 Ch. 1.

(y) *Johnson v. Edge*, supra.

(z) *Kurtz v. Spence*, 36 C. D. 770; 4
R. P. C. 427; *Challender v. Royle*, 36 C. D.
443; *Herrburger v. Squire*, 5 R. P. C. 581;

6 R. P. C. 194; *Dowson v. Drosophore Co.*,
12 R. P. C. 100.

(a) *Dowson v. Drosophore Co.*, supra.

(b) *Challender v. Royle*, supra.

(c) *Kurtz v. Spence*, 36 C. D. 770, per
Cotton, L.J., p. 774.

to, North, J., on an application by them for particulars of objection, made an order that the plaintiffs should deliver particulars of objection within three weeks after the defendants gave to them a list of the letters patent upon which they intended to rely to justify their threats.

The Court of Appeal, while approving this order, added that the defendants ought not only to state what the patents were on which they relied, but also that they relied on no others. (*d*)

The defendant is also entitled to particulars of the threats complained of, but not to the names of the customers of the plaintiff whom the plaintiff has promised to indemnify against such threats. (*e*)

Where the threats complained of were verbal statements alleged to have been made by agents of the defendants, the defendants were held entitled to particulars as to the names of such agents.

Although *mala fides* is not necessary to support an action on threats under Section 32, it will generally be well to plead it; (*f*) to support the alternative right of action at common law to which the defence that an action of infringement has been begun with due diligence is no answer.

Defences to the Action.—It is not the object of the section to prevent a patentee from warning persons who, in fact, are infringing his rights, that he intends to take proceedings. Persons who are infringers deserve to be threatened, and, therefore, whether the patentee follows up his threats by legal proceedings or not, the Court will not come to their assistance. Hence it is provided that infringement proved against the plaintiff is a good answer to an action for threats.

It is likewise a good defence to prove that the person making the threats has with due diligence commenced and prosecuted an action for infringement of his patent rights. (*g*) This in substance is a defence of *bona fides* in making the threats and affords proof that the person threatening in fact believes in the validity of his letters patent. (*h*)

The words “due diligence” have been the subject of judicial

(*d*) *Union Electrical Power & Light Co. v. Electrical Storage Co.*, 38 C. D. 325; 5 R. P. C. 329, see p. 333.

(*e*) *Law v. Ashworth*, 7 R. P. C. 86; *Dowson v. Drosophore Co.*, 11 R. P. C. 536; 12 R. P. C. 95.

(*f*) *Colley v. Hart*, 44 C. D. p. 192.

(*g*) Patents Act, 1883, s. 32; *Dunlop Pneumatic Tyre Co. v. New Seddon Pneumatic Tyre Co.*, 76 L. T. 405.

(*h*) Cf. *Azmann v. Lund*, L. R. 18 Eq. 330; 43 L. J. Ch. 655; and see Cotton, L.J., in *Challender v. Royle*, 36 C. D. pp. 439, 440.

interpretation in various cases. An action begun before the threats sued upon were made, has been commenced with due diligence. (i)

In deciding the question of due diligence the time to be considered is not the time when the defendant first knew of the alleged infringement, but the time of issuing the threats; (j) and from that time, three months is a reasonable period within which to commence an action. (k)

In *Herrburger v. Squire*, a delay of fourteen months after issuing the threats was held to negative due diligence. (l)

In *Johnson v. Edge*, (m) a manufacturer issuing threats brought an action against certain rivals for fraudulently passing off as his, goods manufactured by themselves. Subsequently, when sued by these rivals in respect of threats to their customers, he amended by adding a claim for infringement. This claim was held not to be an action brought with due diligence, and to afford no defence to the proceedings in respect of the threats.

In *Colley v. Hart*, (n) the threats were made in a circular issued on the 15th of September; on the 22nd of the same month the plaintiff commenced an action on that circular. On the 6th of December following the defendant followed up his threats by an action against the plaintiff for infringement. North, J., held that there was no want of due diligence in commencing the action; but pointed out that every case must depend on its own circumstances, and that it was not possible to lay down a general rule.

Where a threats action has been promptly commenced against a patentee he is not guilty of undue delay if he waits before commencing proceedings for infringement against the plaintiff, to see whether he cannot raise his action by way of counter-claim; and for this purpose he is entitled to wait for, and have reasonable time to consider, the statement of claim. (o)

No patentee is bound to raise his action by a counter-claim; but it is inexpedient to fight the same issue in two actions and incur double costs. To avoid this, the proper course is for the parties to arrange a stay in the threats action, so that unnecessary costs may not be incurred. (p)

(i) *Berliner v. Edison-Bell Co.*, 16 R. P. C. 338; *Day v. Foster*, 7 R. P. C. 54.

(j) *Challender v. Royle*, 36 C. D. 425.

(k) *Ibid.* p. 437.

(l) 5 R. P. C. 594.

(m) 9 R. P. C. 142; [1892] 2 Ch. 1.

(n) 44 C. D. 179.

(o) *Ibid.* p. 188.

(p) *Combined Weighing Machine Co. v. Automatic Co.*, 6 R. P. C. 509. See, also, Lord Halsbury in *Automatic Co. v. Combined*, 6 R. P. C. 370, 371; *Edlin v. the Pneumatic Tyre Agency*, 10 R. P. C. 316.

In *Edlin v. the Pneumatic Tyre Agency*, (q) the threats had gone on over a period of three years, but during that time the parties had been in negotiation, and no application had been made to the Court to restrain the threats. An action in respect of these threats having at last been brought, the defendants applied for inspection of the plaintiff's machines to satisfy themselves that they were in fact infringements; after inspection they issued a writ for infringement, and Chitty, J., refused, in the particular circumstances, to hold that this action had not been commenced with due diligence.

If, however, it is apparent that the action for infringement would never have been brought had not the action been commenced for the threats, the proper inference will be that there has not been due diligence. (r)

The circumstance that an action in respect of threats may be defeated by the defendant subsequently starting an action for infringement, although at the time the writ was issued there was no defence, has been judicially noticed as somewhat of an anomaly. (s) Nevertheless it is clear, upon the authorities, that an infringement action commenced after service of proceedings in an action for threats may still be an action brought with due diligence within the meaning of the proviso to Section 32. (t)

It must, however, be a *bonâ fide* action, and not commenced collusively, merely with a view to setting up a defence under the proviso. "It is my opinion, and I ought to express it," said Cotton, L.J., in *Challender v. Royle*, "that, in order to bring the case within this proviso, the action must be an honest action, an action honestly brought in order to test the validity of the patent or the fact of infringement, whichever may be in question." (u) Moreover, the action must be brought in respect of the same class of infringement as that to which the threats relate. An action in respect of infringements of a different character does not meet the exigency of the proviso, and is no defence. (v)

The infringement action must not only have been begun, it must also have been prosecuted with due diligence. (w) But the Act

(q) *Supra*. See, also, *English & American Machine Co. v. Gare Machinery Co.*, 11 R. P. C. 627.

(r) *Appleby's Twin Roller Chain v. Eadie*, 16 R. P. C. 330.

(s) *Combined Weighing Machine Co v. Automatic Co.*, 6 R. P. C. p. 508; 42 C. D. 665; 58 L. J. Ch. 709.

(t) *Ibid.*; *Colley v. Hart*, 7 R. P. C.

101; 44 C. D. 179; *Mackie v. Solvo Co.*, 9 R. P. C. 466; *English & American Machine Co. v. Gare*, 11 R. P. C. 627.

(u) 36 C. D. p. 438.

(v) *Combined Weighing Machine Co. v. Automatic Co.*, 6 R. P. C. 507.

(w) See *Household v. Fairburn*, 2 R. P. C. 140; *Griff. P. C.* 131.

does not say, and the section does not mean, that it must have been carried to a successful issue, (x) nor necessarily that it must have been prosecuted to trial. If the patentee, having duly commenced his action, carries it on until he is satisfied by the objections delivered that his patent is invalid, he not only may but ought to discontinue, and will not lose the protection of the section by so doing. (y)

The action contemplated by the proviso is not necessarily an action against the plaintiff in the threats action; where a patentee has threatened various persons it is sufficient if he has brought an action for infringement with due diligence against any one of them. Thus, an action brought against a customer of the aggrieved person was held a sufficient defence in *Challender v. Royle*. "In my opinion," said Cotton, L.J., in that case, "the proviso is satisfied if an action to test the validity of the patent or the fact of infringement is honestly brought with reasonable diligence against the person, or any of the persons, to whom the threats have been made. . . . It is not required that the action should be brought against the aggrieved person." (z)

But the action must be an action brought by the person issuing the threats, and such person must be the owner of the patent in support of which the threats are issued. Thus, in *Kensington Electric Lighting Company v. Lane Fox*, (a) the defendants had issued threats in support of a patent in respect of which they had an agreement with the owner for its assignment to themselves; the assignment, however, had not in fact taken place. It was held that the defendants could not rely by way of defence upon an action for infringement then pending by the owner of the patent against the plaintiffs in the threats action.

It has been held, however, that exclusive licensees with an option to purchase, may, if sued for threats, rely by way of defence upon an action brought by their licensor against an infringer; and that such action, though not brought by themselves, is a good defence. (b)

A patentee who has applied for leave to disclaim will be restrained by injunction if, pending disclaimer, he issues circulars threatening persons he alleges to be infringing his patent. (c)

Injunction and Damages.—The plaintiff in a threats action will,

(x) *Colley v. Hart*, 44 C. D. 191 (per North, J.) 372.

(y) *Ibid.* See, also, *English & American Machinery Co. v. Gare Co.*, 11 R. P. C. 630 (per Chitty, J.).

(z) 36 C. D. pp. 439, 440; 4 R. P. C.

(a) [1891] 2 Ch. p. 577.

(b) *Incandescent Gas Light Co. v. New Incandescent Co.*, 76 L. T. . . .

(c) *Fusee Vestu Co. v. Injant & May*, 4 R. P. C. 191; 56 L. T. 136.

if successful, be entitled to an injunction, and if he has suffered damages, to damages also.

In addition to the remedy of a perpetual injunction at the trial he may move for an interim injunction till the hearing. (d) Such motion should not be made *ex parte*, but on notice. (e) The Court will not, however, grant an interim injunction, unless the plaintiff shews a strong *prima facie* case: such a case as in the absence of a change of evidence will entitle him to a verdict at the trial. For this injunction will not be conceded on a mere balance of convenience, (f) nor on the ground that a foreign tribunal may take a different view of the parties' rights. (g)

In *Barney v. United Telephone Company*, (h) Chitty, J., held that the plaintiff in a threats action is not entitled to an interlocutory injunction, unless he satisfies the Court that he has not infringed the defendant's patent. But Kay, J., took a different view in *Walker v. Clarke*. (i) The Court refused an injunction where the defendant gave an undertaking; (j) so, likewise, where an infringement action was pending. (k)

The plaintiff may also be entitled to damages. But the Court will not direct an enquiry to be held, unless the damage is substantial. (l) If the injury inflicted on the plaintiff's trade has been considerable, heavy damages may be awarded.

In *Ungar v. Sugg*, (m) the Court of Appeal themselves assessed the damage at £500.

In *Willoughby v. Taylor*, (n) the damages, being little more than nominal, were assessed by the judge at ten guineas.

The circumstance that the plaintiffs, since the threats were made, have incurred expense in looking into their patents and taking advice, or even that they have in consequence of the threats stopped the progress of new works intended for an extension of their business, is not sufficient to support a claim to damages. Damages so accruing are too remote.

“When the plaintiffs,” said Bacon, V.C., in *Driffield v.*

(d) *Challender v. Royle*, 36 C. D. p. 436.

(e) *Wilson v. Church Engineering Co.*, 2 R. P. C. 175.

(f) *Challender v. Royle*, supra; *Société Anonyme v. Tilghmann*, 25 C. D. 1; *Howard v. Sykes*, L. T. 1897, p. 418. But see *Walker v. Clarke*, 4 R. P. C. 115.

(g) *Société Anonyme v. Tilghmann*, 25 C. D., p. 7.

(h) 2 R. P. C. 173; 38 C. D. p. 397; Griff. P. C. 48; 52 L. T. 573.

(i) 4 R. P. C. 111; 56 L. J. Ch. 379.

(j) *Mackie v. Solvo Co.*, 9 R. P. C. 467.

(k) *Berliner v. Edison*, 16 R. P. C. 338.

(l) *Driffield v. Waterloo*, 31 C. D. 638; 3 R. P. C. 46; Griff. P. C. 81; *Douglass v. L'intsch*, 13 R. P. C. 681.

(m) 9 R. P. C. 113. The like sum was recovered for damages in *Appleby's Twin Roller Chain v. Eadie*, 16 R. P. C. 330.

(n) 11 R. P. C. 45.

Waterloo, (o) “received that notice they set themselves to look into their patent—their title-deed—and to look over their machinery all of which they ought to know very well. They ought to know their patent and the terms of it, and they ought to know their machinery, and what it is capable of doing, without requiring the assistance of engineers or solicitors or anybody else to enable them to know whether what they are doing is within their rights or not. I think there is no case whatever for an enquiry as to damages. It has not been alleged in any way that I can notice that any damage has been sustained. The business has not been suspended. Certain works contemplated have not been carried out with the vigour which it was conceived at first would be necessary, but the business has not been stopped; and that is the whole case for damages.”

Damages are recoverable in respect of a contract lost by the threats of the defendant. (p)

In *Hoffnung & Company v. Salisbury*, (q) one of the plaintiffs' customers, who had entered into a large contract with the plaintiffs, refused, in consequence of the defendant's threats, to carry it out. The defendant contended that no damage could be recovered by the plaintiffs in respect of loss so accruing, because the plaintiffs ought to have enforced their legal rights under the contract against their customer. Byrne, J., however, held that an enquiry as to damages should go, for the conduct of the defendant having placed the plaintiffs in the position of having to cancel their contract or start litigation against an old customer, was necessarily injurious to the plaintiffs, and there was sufficient evidence of damage to support an enquiry.

Where an enquiry as to damages is directed the costs will generally be reserved. (r)

Enforcing the Injunction.—If, after injunction granted, the defendant repeats the threats, the proper remedy is to move to commit the offender. But while the Court will not for a moment tolerate a breach of the injunction, nor allow itself to be trifled with or tricked, it is a serious matter to imprison the defendant, and therefore the Court will not strain the language of the injunction to meet a case which would have been prohibited if foreseen.

In *Ellam v. Martyn & Company*, (s) the injunction had been

(o) *Supra*.

(p) *Skinner v. Perry*, 11 R. P. C. 406; [1894] 2 Ch. 581; 64 L. J. Ch. 826.

(q) 16 R. P. C. 375.

(r) *Johnson v. Edge*, 9 R. P. C. 142.

(s) 16 R. P. C. 30; 68 L. J. Ch. 123; 79 L. T. 510; 47 W. R. 212.

granted in the following terms: "The Court doth order and adjudge that the defendants, *Martyn & Company*, their servants, and agents, be perpetually restrained from publishing, either verbally or by circular letter, notice, or otherwise howsoever, any statements to the effect that an injunction has been granted against the plaintiffs, restraining them from infringing certain letters patent or any other letters patent, and also from threatening the plaintiffs, or any of the plaintiffs' customers, with any legal proceedings or liability in respect of the manufacture, sale, or purchase of the duplicating machine known or described by the defendants as the "Genuine Edison Mimeograph."

The defendant firm subsequently circulated among customers of the plaintiffs and other persons, a pamphlet headed, "The Genuine Edison Mimeograph," issued by *D. & Co.*, the exclusive makers under Edison's authority. On the front of this pamphlet appeared the name, as special agents for *D. & Co.*, of the defendant firm; on the back a public notice, dated from the office of *D. & Co.*, Chicago, stating *D. & Co.*'s intention to proceed against any other makers of Edison mimeographs, and alleging that the goods of such makers were fraudulent.

On a motion to commit for breach of the above injunction, the Court of Appeal, reversing Romer, J., held that no breach had been committed, the threats being the threats of *D. & Co.*, and not of the defendant, who traded as *Martyn & Company*. "I cannot bring myself," said Lindley, M.R., "to say that the injunction is so clearly worded as to extend to circulating the threats contained in the pamphlet. The *D. Company* are no myths; they are real traders; the defendant is their agent; the threats circulated are their threats, not his. He does not threaten them. They threaten, and make their threats known by him. That he may be restrained from circulating their threats is very likely, and I will assume that he could. I have, moreover, no doubt that those threats which are sent to the plaintiffs' customers are a serious injury to the plaintiffs. But for all that, in my opinion, the injunction as worded does not so plainly prohibit what the defendant has done as to justify me in holding judicially that the defendant has been guilty of a breach of the injunction." (t)

(t) 16 R. P. C. p. 31.

CHAPTER XXIV.

REMEDIES OF THE PUBLIC.

2. *Revocation of the Patent.*

Prerogative of the Crown to avoid Grants by Letters Patent.—A grant of letters patent from the Crown has always been liable to be avoided on proof that the assumed consideration for the grant did not in fact exist. In such case the grant has been made upon a false suggestion, and the Crown has been misled by the patentee. This high prerogative of the Crown to avoid its own grants has been said to have obtained recognition from the common law as a means of protecting the public interest. Thus, in the report of *Legat's Case*, Sir Ed. Coke says: "It was likewise resolved that there was a difference between the king's case and the case of a subject, for a subject who may mind his own private affairs shall not avoid his grant in these or the like cases being made upon a false insinuation or suggestion; but the king, who takes care of the commonwealth, shall avoid his grant in these cases, *jure regio*, as it is said in 21 Ed. III. 47 A.b. in the Earl of Kent's case, and it is a high and great prerogative which the king has, that when he makes any grant upon such false suggestions as aforesaid, they are void in law; so, when upon false insinuations or pretences he makes any grant, as of any monopoly, etc., which in truth is to the prejudice of the king and commonwealth, the king, *jure regio*, shall avoid such grants, and such letters patent by judgment of law shall be cancelled." (a)

Repeal formerly by Writ of Scire Facias.—Formerly such royal grants were repealed by *scire facias*, (b) and every ground upon which such grants could formerly have been repealed is now available as a ground of revocation, under the Patents Act, 1883. (c)

In his fourth *Institute*, Sir Ed. Coke says that *scire facias*

(a) 10 Coke, Rep. 113b.

(b) *R. v. Butler*, 3 Lev. 220.

(c) See s. 26 (3).

lies to repeal letters patent in three cases. First, 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. Thirdly, when the king doth grant anything which by law he cannot grant, he, *jure regio* (for advancement of justice and right) may have a *scire facias* to repeal his own letters patent." (d)

Every applicant for letters patent represents to the Crown that he is the true and first inventor of the invention which he seeks to patent. He also represents that that for which he claims protection is new and useful, and if any of these representations are false his patent cannot stand.

"That a false suggestion of the grantee," said Parke, B., in *Morgan v. Seaward*, (e) "avoids an ordinary grant of lands or tenements from the Crown, is a maxim of the common law, and such a grant is void; not against the Crown merely, but in a suit against a third person."

Revocation now to be by Petition.—The remedy by an action of *scire facias* which existed down to the passing of the Patents Act, 1883, is now abolished, and petition to the High Court substituted therefor, in England and Ireland. (f) In Scotland the remedy remains as formerly, an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest, (g) with the concurrence of the Lord Advocate.

In England a petition for revocation will be dealt with according to the usual practice prevailing on petitions in the High Court of Justice, (h) except in so far as the Statute may otherwise provide. (i)

Under the former procedure by *scire facias* it was not open to any and every member of the public to take proceedings for the repeal of letters patent. That remedy was an action instituted in the name of the Crown, and therefore the fiat of the Attorney-General had always to be obtained before a writ could be issued. (j) The fiat was never granted as a matter of course, but only at the

(d) 4 *Inst.* 88. See, also, *R. v. Muscry*, 1 W. P. C. 41; Bull, N. P. 76a.

(e) 1 W. P. C. 196; 2 M. & W. 544.

(f) Patents Act, 1883, s. 26 (1) (2).

(g) Patents Act, 1883, s. 109 (i). See *Worthington Pumping Engine Co. v. Weir*, 11 R. P. C. 657.

(h) *Haddan's Patent*, Griff. P. C. 109.

(i) See Patents Act, 1883, s. 26 (5) (6) (7).

(j) 1 W. P. C. 671, n. As to former practice on *Scire Facias*, see Hindmarch, p. 376; Agnew, p. 340.

discretion of the Attorney-General. (*k*) And after the proceedings were instituted the Attorney-General still retained a certain control over them, exercised chiefly as to security for costs. (*l*)

Under the Patents Act, 1883, the right of taking proceedings to revoke a patent is still a limited right, confined to certain specified classes of persons, (*m*) but the fiat of the Attorney-General is not now always necessary; though in Scotland the concurrence of the Lord Advocate is in every case required. (*n*)

Who may Petition.—A petition for revocation may be presented by any one of the following persons:—

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

(2) *Any person authorized by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland.* (*p*)

Any person intending to apply to the Attorney-General for his authority must first transmit the following papers to the Patent Clerk at the Royal Courts of Justice, London: (*q*) (1) A memorial to the Attorney-General stating all the circumstances, and asking for his authority; (2) a statutory declaration verifying the statements in the memorial; (3) two copies of the proposed petition, and of the particulars intended to be delivered with it; (4) the certificate of a barrister that the petition is a petition proper to be authorized by the Attorney-General; (5) a certificate by a solicitor that the intending petitioner is a proper person to petition, and that he is competent to answer the costs of all proceedings in connection with the petition if unsuccessful. (*r*)

The Attorney-General will sometimes hear the application for his authority *ex parte*. But if he thinks it undesirable to do so, he will direct notice to be given to the patentee, in order that both parties may appear before him.

The Attorney-General has no power to give costs on these applications. (*s*) But where notice had been sent to the patentee, lengthy declarations filed on both sides, and the application was eventually directed to stand over, on the patentee undertaking to bring an action for infringement against the intending petitioners

(*k*) *Young's Patent, Practical Mechanics' Journal*, 2nd series, vol. vi. 98; Lawson p. 105, n.

(*l*) *Reg. v. Newall*, 1 W. P. C. 671, n.

(*m*) *Avery's Patent*, 4 R. P. C. 161 (per Stirling, J.).

(*n*) Patents Act, 1883, s. 109 (1).

(*o*) Patents Act, 1883, s. 26, sub-s. 4

(*a*) (*b*).

(*p*) *Ibid.*

(*q*) As to this procedure, see Griff. P. C. pp. 319, 320, n.

(*r*) Griff. *supra*. Forms of Memorial, Declaration, and Certificate will be found in Appendix IV. post.

(*s*) *Welch's Application*, *ibid.*

within one month, the costs of the application were by consent made costs in the action. (*t*)

In *Ferranti's Application*, (*u*) where no other proceedings were pending between the applicant and the patentees, the authority was given *ex parte*. So likewise in the application of *King's* trustees, where the patentee had commenced an action against *King*, but had abandoned it after the delivery of the defence, and applied at the Patent Office for leave to amend, Webster, A.G., gave his authority *ex parte* for presenting a petition. (*v*)

In the *Haslam Foundry Company's Application*, notice was directed to be given to the owners of the patent (*Messrs. Bell & Coleman*), who had commenced an action of infringement against the applicants in Scotland. On the hearing, *Bell & Coleman* objected that, as they were resident in Scotland, the application should have been made to the Lord Advocate, and James, A.G., refused to give authority pending the result of the Scottish action, but gave leave to renew the application if necessary. (*w*)

In *Bayley's Application*, the circumstances were peculiar. The applicant was one of the defendants in an action for infringement, in which judgment had been given for the patentee; but an appeal was pending. Notice was directed to be sent to the patentee; but the patentee did not appear at the hearing, and Russell, A.G., granted his authority. (*x*)

The fiat of the Attorney-General may even be applied for after the petition has been presented. In *Dege's Patent*, the Court ordered the petition to stand over until the fiat had been obtained. (*y*)

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

Fraud here means more than innocent mistake: conduct morally culpable must be proved.

In *Avery's Patent*, (*z*) a petition was presented for the revocation of a patent granted to *Thomas Steven Lindsay*, and alleged to have been obtained by him in fraud of the rights of the petitioner. The facts were shortly as follows: In 1885 *Avery*, a citizen of the United States, authorized one *Weeks*, under a power of attorney, to

(*t*) *Vicker's Application*, Griff. P. C. p. 320.

(*u*) Griff. P. C. 320.

(*v*) *Ibid.*

(*w*) *Ibid.*

(*x*) *Vicker's Application*, *supra*.

(*y*) 12 R. P. C. 448. Forms for Proceedings for Revocation of Letters Patent will be found in Appendix IV. *post*.

(*z*) 4 R. P. C. 152.

apply for letters patent in England and elsewhere for all his inventions in processes or appliances or apparatus for heating, lighting, and metallurgical purposes. *Lindsay* undertook to test in England the invention it was intended to patent. While so engaged, *Lindsay* met with difficulties which necessitated experiments. Owing to the imminence of the publication of *Avery's* invention in the United States, it became necessary to obtain protection in England before the experiments were completed. To do this, *Lindsay*, who was advised by a patent agent that he was an inventor within the meaning of English patent law, applied (through *Weeks*) for a patent in his own name, and filed a provisional specification. Before it was necessary to file a complete specification the experiments had resulted in the discovery of an improvement upon *Avery's* invention, and this improvement was incorporated in the complete specification. *Weeks* appointed *Lindsay* his substitute as the attorney of *Avery*, under a power for the purpose contained in the original power of attorney, and *Lindsay* made a statutory declaration, stating that he was the true and first inventor, but not disclosing the fact that part of the invention had been communicated from abroad.

On these facts it was contended that the patent had been granted in fraud of the petitioner's rights, and that the statement that *Lindsay* was the inventor was not only untrue, but, having regard to the rules and well-established practice upon applications for a patent, so recklessly untrue as to be evidence of fraud. Further, that it was sufficient under the Act to shew that the petitioner had been defrauded of his rights, and the Crown deceived, without proving actual fraud by the patentee. But Stirling, J., held that fraud, such as would entitle the petitioner to succeed, was not made out.

Discussing the meaning of the word "fraud" in the Act, his lordship said: "Here we have not to deal with a Statute nearly three hundred years old, like the Statute of Monopolies, nor is there any current of decision to fix the sense in which the word therein is used; and in my judgment, it would be wrong to construe the word, occurring as it does in an Act passed little more than three years ago, and in the absence of any context imperatively demanding such a construction otherwise than in accordance with the usual construction of the English language, and, consequently, as involving a grave moral culpability in the person obtaining the patent." (a)

(a) 4 R. P. C. p. 165.

On appeal, the judgment below was affirmed. Cotton, L.J., said: "If *Lindsay*, having obtained the patent in his own name, had sought, by means of that, to deprive *Avery* of any rights which he would have had if the patent had been in his own name, then the case would have stood very differently; but, in my opinion, if he made a mistake—I do not say that he did—if he made a mistake honestly, that, in my opinion, although it might make the patent bad, would not enable the petitioner to establish this, that the patent was obtained in fraud of his rights. In my opinion, that means obtained in violation of the rights of *Avery*, who was entitled, I will assume, to have a patent for this as the true inventor, and obtained so as, directly or indirectly, to deprive him of his rights, and to gain some advantage to himself. The mere fact that an agent makes an honest mistake, even though that may cause loss to the principal, is not, in my opinion, an act done in fraud of the rights of the principal. It is an act done which injures the rights of the principal, but an act done in fraud of his rights is, to my mind, an entirely different thing. To be in fraud of his rights, it must be either done with the intention of depriving the principal of his rights, or must be insisted upon so as to deprive the principal of his rights. There was an argument addressed to us with great zeal, that anything which deprives a person of his rights, if done by one in a confidential position, such as an agent is, is done in fraud of the rights of the principal. That, in my opinion, is a misuse of the term 'fraud.' It may be a mistake for which the agent must be answerable for not having performed his duty. It may be a mistake for which he may not be answerable, but which still may cause great loss to his principal; but 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; and, in my opinion, on the evidence here—I will not go through it in detail—there is nothing which can justify us in coming to any other conclusion than this: that if, in fact, *Lindsay* did act under a mistake, or was wrongly advised, he did so by an innocent mistake, and not as acting in fraud of the rights of his principal. In my opinion, therefore, the case which is raised by the petition fails, and Mr. Justice Stirling was right in dismissing the appeal with costs." (b)

In *Gale's Patent*, (c) the Court held that the petitioner was entitled to succeed on the ground of fraud. There, however, the respondent,

(b) 4 R. P. C. pp. 326, 327.

(c) 8 R. P. C. 438.

having agreed to assist the petitioner in patenting his invention in their joint names, and to supply the money to work it, in breach of that agreement took out a patent for the invention in his own name. (d)

Where revocation is sought on the ground of fraud, the evidence on the hearing of the petition should be oral evidence, as in such case there is usually a direct conflict of testimony, which it is almost impossible to test satisfactorily on affidavits. (e)

Where a patent has been revoked on the ground of fraud the comptroller may, on the application of the true inventor, made in accordance with the provisions of the Patents Act, 1883, grant to him a patent in lieu of, and bearing the same date as the date of revocation of, the patent so revoked. The comptroller has a discretion in the matter, and a patent so granted ceases on the expiration of the term for which the revoked patent was granted. (f)

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

In *Walker v. The Hydro-carbon Syndicate, Limited*, (g) the petitioner, *Walker*, presented a petition alleging that he was the true and first inventor of the inventions comprised in two patents granted to *Haddan* and *Boult* respectively, of which patents the *Hydro-Carbon Syndicate* were the assignees.

In 1875 a patent had been granted to the petitioner for an improved method of applying petroleum and other hydro-carbons in furnaces for generating steam, or in ovens for heating purposes, including the smelting of metals. In 1880 *Haddan* obtained a patent for improvements in apparatus for generating heat, light, and power from hydro-carbon oil, as a communication from abroad. In 1881 a patent was granted to *Boult* for an improved method of burning hydro-carbon oils, together with steam or water, for the purpose of generating heat for calorific and dynamic effect. This patent was also a communication from abroad.

At the hearing of the petition the respondents relied generally upon the state of public knowledge prior to the petitioner's patent, and in particular on the description in the specification of an

(d) See, also, *Norwood's Patents*, 12 R. P. C. 214; 15 R. P. C. 98.

(e) *Gale's Patent*, supra, per Chitty, J., p. 440.

(f) Patents Act, 1883, s. 26 (8). See also, *Norwood's Patent*, 12 R. P. C. 214.

(g) 2 R. P. C. 3; Griff. P. C. 238.

earlier patent granted to one *Wise*. Having heard witnesses on either side, Bacon, V.C., held that the petitioner's patent must be construed as a patent for the particular method therein described only, and that the patents of the respondents were for different methods. He accordingly dismissed the petition with costs.

His Honour said: "There was a common universal knowledge that petroleum, dangerous in itself, inapplicable in itself, could, by means which had been resorted to long ago in *Wise's Patent*, and long before that, namely, by being reduced into the form of spray, be usefully applied for the purposes for which alone petroleum is valuable, and avoiding all the danger which would attend the application of it in any other way. The three patents, the patent of *Walker*, the patent of *Haddan*, and the patent of *Boult*, are not for totally different purposes, but are totally different in their mode of application, and now I am to be told, after a mechanical invention has been produced for a common object, that any person who makes a better combination of machinery (not by the mere introduction of mechanical equivalents, but by the exercise of mechanical genius or talent, or whatever it may be called) could not obtain a patent for it; that he has no right to say to *Walker*: 'Admitting yours was a good patent, and your contrivances are very ingenious and clever, I see a much better way of dealing with the basis of common knowledge, and by retorts and by other means which I describe fully in my specification and drawings, I do it better and differently from the way in which you do it.' That is the whole case."

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

In *Haddan's Patent*, (h) the petitioner alleged that the patent had been obtained in fraud of his rights, inasmuch as he was the true inventor and had publicly manufactured and sold within the realm prior to the date of the patent the invention claimed by the patentee. The petition was tried before Kay, J., with *vivâ voce* evidence. His Lordship found that the patentee had been anticipated, and directed that the patent should be revoked.

Referring to the ground of the petition, the learned judge said: "Now, the justice and common-sense of that is too apparent to need

much comment. A man has been carrying on a particular manufacture for some time, and that another person should come and take out a patent for that manufacture as for a new invention by that other person, and stop the manufacture that has been going on for years, would be an intolerable wrong, carried out under the apparent sanction of the Patent Law; and therefore, when anything of the kind happens, the legislature provides this simple remedy, that the person who has been carrying on this manufacture may come to the Court and have the patent revoked." (i)

In *Edmond's Patent*, (j) letters patent had been granted for improvement in tools and tool holders used in machines for making umbrella and parasol ribs and stretchers. The petitioners were the defendants in an action for infringement which had been commenced against them by the patentee and the *English Umbrella Manufacturing Syndicate, Limited*, who claimed to be his assignees. The patentee had formerly been in the service of the petitioners, and they prayed revocation of the grant on the ground that it had been obtained in fraud of their rights, that one of them was the true inventor or joint inventor with *Edwards*, and that they had publicly used the invention prior to the date of the patent. The specification contained seven claims. At the hearing before Pollock, B., the petitioners confined their evidence to the second claim, which was for the application of the machine described for making double-ended solid ribs.

Evidence of prior user by one of the petitioners having been given, it was contended that this was no anticipation, because the user proved extended only to solid and not to "Paragon" ribs.

On this Pollock, B., said: "You take tools which have been used for making solid-ended ribs, and you apply that to the 'Paragon.' That will not do. You might as well say that these things have been made in brass, and you will make them in another metal, and take out a patent for that. It is merely an adaptation and not an invention." (k)

Grounds of Revocation.—The petitioner must deliver with his petition particulars of the objections on which he means to rely, and no evidence, except on special leave, will be admitted in proof of any objection of which particulars are not so delivered. (l)

Particulars delivered may be from time to time amended by

(i) See, also, *Morgan's Patent*, 5 R. P. C. 187.

R. P. C. 576; L. R. 43 O. D. 80.

(j) 6 R. P. C. 355.

(l) *Goulard & Gibbs' Patent*, 5 R. P. C. 532; Patents Act, 1883, s. 26 (5).

(k) See, also, *Drummond's Patent*, 6

leave of the Court or a judge. (*m*) A petitioner who has the required *locus standi*, may impeach the patent for the revocation of which he petitions on any legal grounds which would be open to a defendant resisting an action for infringement or which would formerly have supported proceedings for *scire facias*.

In *Morgan's Patent*, (*n*) the petitioner alleged that he had publicly made and sold carriages according to the alleged invention before the date of the patent.

The particulars of objection raised the following grounds of revocation: That the patentee was not the inventor of the alleged invention, that the alleged invention was not new, that there was a variance betwixt the original and the complete specifications, that the alleged invention was not fit subject-matter for a patent, and that there had been three prior publications of it, as well as instances of prior user besides the user by the petitioner. These objections were held to be open to any petitioner qualified to petition under the Patents Act, 1883.

In *Goulard & Gibbs' Patent*, (*o*) where the petition was presented with the authority of the Attorney-General, the particulars of objections included the following: (1 and 2) that the alleged invention was not novel; (3) that it was a suggestion to use on a large scale a well-known mode of deriving electrical action by induction; (4) that claims 1 and 2 of the specification were for principle only; (5) want of utility; (6) absence of a proper specification; (7) that the specification did not describe or ascertain the nature of the alleged invention, or the manner in which the same was to be performed, and did not distinguish the old from the new, and was vague and calculated to mislead the public; (7*a*) that the complete specification described and claimed an invention different from the provisional; (8) prior publication in a number of earlier specifications; (9) prior user.

Service of the Petition.—There are no special provisions as to service. Where the respondent is resident abroad, personal service will not be required. In such case the Court has directed notice to be given to the respondent by a registered letter containing a copy of the petition and of the particulars of objection. (*p*)

In *Drummond's Patent*, (*q*) a petition was presented by two petitioners, who alleged that they had publicly manufactured and

(*m*) Patents Act, 1883, s. 26 (5).

(*n*) 5 R. P. C. 186.

(*o*) *Ibid.* 529.

(*p*) *Drummond's Patent*, 6 R. P. C. 576;
Hirschfeld's Patent, 11 R. P. C. 514;

Kay's Patent, 11 R. P. C. 279; *Cerchel's Patent*, 15 R. P. C. 500; *Goerz & Hoegh's Patent*, 12 R. P. C. 370.

(*q*) *Supra*.

sold within the realm, and prior to the date of the respondent's patent, articles embodying the respondent's invention. The respondent resided in Scotland, at Dundee, and in reply to a letter from the petitioner's solicitor, stated that he did not intend to appear on the petition, as he was not under the jurisdiction of the English Courts. The respondent had commenced an action for infringement against the petitioners in the Scottish Courts. The petitioners applied to have the petition treated as an action, and placed in the witness list. The respondent did not appear on the hearing of this application, but there was evidence that the particulars of objection and a copy of the petition had been delivered to him personally at Dundee. North, J., made the order, postponing its operation to a specified date, in order that the respondent might have the opportunity of shewing cause against it, if so advised.

Practice on the Hearing.—It would seem that the judge who tries the petition has no power to certify that the objections are proper, for there is no provision in Section 26 of the Patents Act, 1883, similar to that in sub-section 6 of Section 29, dealing with infringement actions. (r) But as the judge, where the contrary is not provided, has a complete discretion as to costs, the silence of the section will not affect the right of the petitioner to all such costs as he may be justly entitled to.

Where, on a petition for revocation the petitioner and respondent have been defendant and plaintiff respectively in a prior infringement action in respect of the same patent, no estoppel arises from the judgment in that action to preclude the validity of the patent being fully enquired into on the hearing of the petition. (s)

In *Deeley's Patent*, (t) the Court, in an infringement action, had found the first claims anticipated, and the patent invalid. Whereupon the defendant presented a petition for revocation, and contended that the respondent was estopped from shewing that the first claim was, in fact, good. On this the Court of Appeal said: "A petition to revoke a patent, by whomsoever presented, is a petition on behalf of the public, and it is not personal to the petitioner, and, in a legal point of view, it is a mere accident that in this case the petitioner was a party to a former litigation. Under the old procedure by *scire facias*, it is plain that there would be no estoppel, and although the procedure is altered, the principle underlying it and the effect of it are the same; and, as

(r) See *Goulard & Gibbs' Patent*, 5 R. 12 R. P. C. 192; 64 L. J. Ch. 480. P. C. 537.

(t) *Ibid.*

(s) *Deeley's Patent*, [1895] 1 Ch. 689;

in the case of a *scire facias*, so in this petition, there is no estoppel." (u)

Again, in the *Shoe Machinery Co. v. Cutlan*, Smith, L. J., said: "We held in the case of *Deeley's Patent*, that in a petition for revocation of a patent, there was no estoppel, because the person petitioning and having obtained the fiat of the Attorney-General for revocation of the patent, stands as one of the public and not as an individual." (v)

The petition must be presented in the name of the person actually qualified under the Act to present it. An attorney, acting under a power received from a person qualified, cannot petition on behalf of such person. (w)

All persons having an interest under the patent of which revocation is sought must be before the Court, and should therefore be made respondents. (x)

In *Avery's Patent*, a petition was presented by an attorney named *Kimber*, in his own name, under a power from *Avery*, who was a citizen of the United States of America. Several persons were interested under an agreement in the invention which was the subject of the disputed grant. Objection being taken that these persons had not been made respondents, *Stirling, J.*, held the objection good. The revocation of a patent, his Lordship said, would destroy the rights of all persons beneficially interested, and that he could not do in their absence. The petitioners must amend by making *Avery* sole petitioner, and making all persons interested in the patent parties. And for this purpose the petition was ordered to stand over generally, with liberty to any party to apply. (y)

In *Haddan's Patent*, the respondent *Haddan*, after the presentation of the petition for revocation, had assigned his interest in the petition to one *Horlick*. An order was made that *Horlick's* name should be substituted as respondent for that of *Haddan* upon each paying £25 into court as security for costs. (z)

Amendment of the Specification pending the Petition.—Section 19 of the Patents Act, 1883, provides that in a proceeding for revocation of a patent the Court or a judge may, at any time, order

(u) Per Smith, L.J., 12 R. P. C. p. 199.
See, also, *Lewis & Stirokler's Patent*, 14 R. P. C. 35.

(v) 12 R. P. C. p. 533; [1896] 1 Ch. 113; 35 L. J. Ch. 44.

(w) *Avery's Patent*, 4 R. P. C. 152; 36 C. D. 310, 311; 56 L. J. Ch. 1007; *Haddan's Patent*, 2 R. P. C. 218.

(x) *Avery's Patent*, supra.

(y) 4 R. P. C. p. 159.

(z) 2 R. P. C. 218; cf. *Reg. v. Betts* (15 Q. B. 540; 19 L. T. Q. B. 531), where it was held that a patentee who had assigned all his interest in the patent ought still to remain as a defendant in an action of *scire facias* for revocation of the patent.

that the patentee shall, subject to such terms as to costs and otherwise as the Court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that, in the meantime, the trial or hearing shall be postponed.

Whether on such application being made liberty shall be given is a matter of discretion, and once the judge has exercised his discretion the Court of Appeal will not interfere with his order unless satisfied that it is clearly erroneous. (a)

In *Goulard & Gibbs Patent*, (b) the respondents applied under this section for liberty to apply at the Patent Office for leave to amend their specification by striking out their third claim, and for a postponement of the hearing of the petition. For the petition it was contended that as the patentee had delayed his motion till a few days before the day on which, in the ordinary course, the petitioner would have been heard, the motion was a mere pretext for delay, and ought to be refused. Kekewich, J., made the order on terms that the patentees should pay all the costs occasioned up to and including the day of petition, and proceed forthwith to apply to the Patent Office, and prosecute the application with diligence: the petitioner, on his part, to have fourteen days after the date of amendment to amend the petition and particulars of objection, or to give notice that the petition was discontinued.

In *Chatwood's Patent*, (c) the respondents also moved for liberty to apply for leave to amend after the petition had been presented. The motion was opposed on the ground that the proposed amendments were not disclaimers. Bryne, J., not being satisfied that the amendments amounted to more than disclaimers, gave leave on the following terms: the applicants to pay in any event the costs of the application and of the petition up to and occasioned by the disclaimer, except only so far as the proceedings in the matter might thereafter be utilized for the purpose of the hearing of the petition, should the same be heard; if petitioners elected not to proceed, then the respondents to pay all the costs of the proceedings.

The power to amend given by Section 19 is by way of disclaimer only, and does not include corrections or explanations, except such as may be required to define the disclaimer. (d)

In *Deeley v. Perkes*, (e) the question arose as to whether a

(a) *Armstrong's Patent*, 13 R. P. C. 508;
14 R. P. C. 747; 77 L. T. (N. S.), 267.

(b) 5 R. P. C. 190.

(c) 16 R. P. C. 371.

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

(e) 13 R. P. C. 581; [1896] A. C. 496.

respondent who appealed against an order revoking his patent could disclaim, pending the hearing in the House of Lords. An adjournment having been granted for that purpose, the comptroller refused to register the disclaimer, on the ground that the patent no longer existed, it being the practice at the Patent Office to remove a patent from the register whenever the result of the petition was recorded.

This having been brought to the notice of the House of Lords, Lord Herschell in delivering the judgment of the House said: "All your Lordships are, I believe, of opinion that it would be very unfortunate if, on a petition for revocation of a patent, the patentee was in this position, that if the judge of first instance on any ground declared the patent invalid, the result should necessarily be an order of revocation, precluding the patentee from disclaiming, however meritorious the invention, and however unimportant the error which rendered it inevitable to hold the patent in its then form to be invalid. The 19th section of the Patents Act, 1883, enables the Court or a judge to order, in a proceeding for revocation, that the patentee may be at liberty to apply for leave to amend, and to direct that, in the meantime, the trial or hearing shall be postponed. This provision is, however, inapplicable when the judge holds, as in the present instance, that the claims made by the patentee are bad; and even when one claim only is held bad, it would be unjust that the patentee should be bound, either to forego his right of appeal, or to lose all opportunity of amending, in case the Court of Appeal should adopt the same view as the Court below. The 26th section of the Act, which relates to the revocation of a patent, contains no provision touching the form of the judgment. It only abolishes the proceeding by *scire facias*, and enables revocation to be obtained 'on petition to the Court,' prescribing certain procedure in relation to such a petition. I do not see any difficulty, therefore, in so framing the order on a petition for revocation as to avoid the possible injustice and hardship to which I have referred. . . . I think that . . . it ought to be ordered that the patent be revoked, unless within three months, or such further time as the Court may allow, the patentee obtain leave to amend his specification by disclaiming the first claim." (*ee*)

A petition for the revocation of a patent is "a cause or matter" within the meaning of Order XXXI. of the Rules of the Supreme Court, and interrogatories may therefore be delivered where the

(*ee*) So ordered in *Haggenmacher's Patent*, 15 R. P. O. 437.

leave of the Court has been obtained. In *Haddan's Patent*, Kay, J., gave leave to the petitioner to interrogate the respondent. (*f*)

Trial.—The Patents Act, 1883, provides that at the hearing the mode of trial shall be the same as that of an infringement action. (*g*) Under the old practice actions of *scire facias* were tried before a judge sitting with a jury. Petitions for revocation are now heard by a judge sitting alone. They are consequently generally heard by a judge of the Chancery Division. But it is not necessary that they should be tried in London, and where the residence of the parties interested made it more convenient that a petition should be heard elsewhere. North, J., on a motion by the petitioners, made an order for the trial of the issues of fact by a judge without a jury at the next Birmingham Assizes. (*h*)

On the hearing the respondent is entitled to begin, and lead evidence in support of the patent, (*i*) and the respondent also has the right of reply if the petitioner gives evidence impeaching the validity of the grant. This is because the *onus* of proof is upon the petitioner, and therefore it is right that the patentee should have the last word. (*j*)

Evidence on the Hearing.—Evidence at the hearing may be given either on affidavit or *viva voce*. (*k*) But where the respondent contests the petition, the hearing will usually be treated as a witness action. "The petition," said North, J., in *Gaulard & Gibbs' Patent*, "involves precisely the same issues as an action to try the validity of the patent, and it is clear that it ought to be tried on evidence taken in court. . . . It is in every sense of the word an action; and I think it ought to be tried in the way in which actions usually are tried, and set down accordingly." (*l*)

Revocation Order.—When an order is made for the revocation of a patent, the person in whose favour it is made shall forthwith leave at the Patent Office an office copy of such order. The Register shall thereupon be rectified, or the purport of such order shall otherwise be duly entered in the Register, as the case may be. (*m*)

Where a patent has been revoked on the ground of fraud, (*n*) the comptroller may, on the application of the true inventor made in accordance with the provisions of the Patents Act, 1883, grant

(*f*) Griff. P. O. 109.

(*g*) Sect. 28 (1).

(*h*) *Edmond's Patent*, 6 R. P. C. 355.

(*i*) Patents Act, 1883, s. 26 (7).

(*j*) Cf. Patent Act, 1852, s. 41.

(*k*) See *Edmond's Patent*, 6 R. P. C.

357; *Walker v. Hydro-Carbon Syndicate*, 2 R. P. C. 7; *Vaisey's Patent*, 11 R. P. C. 591 (where the respondent did not appear).

(*l*) L. R. 34 C. D. 396; 5 R. P. C. 525.

(*m*) P. R. rule 74.

(*n*) See ante, p. 580.

to such person a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted. (q)

Staying Revocation Pending Appeal.—Where a patent has been revoked and an appeal is intended, the Court will stay execution as to revocation, for once the patent is revoked difficulties may arise as to its being restored in the event of the appeal succeeding.

In *Armstrong's Patent*, (r) Kekewich, J., said that the proper course was to have the order drawn up but not delivered out if notice of appeal was given within a week. In the same case the Court of Appeal also granted a stay pending appeal to the House of Lords. (s)

Costs of the Petition.—A successful petitioner is entitled to costs; and this is so even where the respondent has intimated that he will not oppose the petition, for except by petition no means of revoking a patent exists. (t) In awarding costs the Court will exercise its discretion, according to the circumstances of the case, as to the particulars of objection in respect of which costs should be allowed. (u)

A foreign respondent who contests the petition will not be ordered to give security for costs. In *Miller's Patent*, (v) the respondent, a foreigner resident abroad, on being served with notice of the petition, intervened and issued a summons for further particulars of the objections to the patent, whereupon the petitioner applied that he should be required to give security for costs. Kekewich, J., in refusing the application, said: "The principle upon which the Court has acted in ordering security for costs is perfectly clear and perfectly simple. It is this: that no person out of the jurisdiction is allowed under ordinary circumstances to institute proceedings in the High Court here without reasonably satisfying the respondent to his application—be he defendant or be he in any other way respondent—that, supposing the application fails, there will be tangible opportunity of recovering the costs of failure. That is what is laid down by Cotton, L.J., in the case of the *Apollinaris Company v. Wilson*, (w) and also by the interlocutory observation of Bowen, L.J., in the same case, and it is clearly to

(q) Patents Act, 1883, s. 26, sub-s. 8.

(r) 13 R. P. C. 508.

(s) 14 R. P. C. 756; 11 L. T. (N. S.), 267.

(t) *Wallace's Patent*, 12 R. P. C. 444.

(u) *Stimmon's Patent*, 12 R. P. C. 446

(v) 11 R. P. C. 55; 63 L. J. Ch. 321.

(w) L. R. 31 O. D. 632.