

But a new grant is so far a new patent that it will be subject to the provisions of ss. 22 and 27 of the present Act (c). Sect. 25 (5).

Where the petition had been presented by the patentee and the assignees of a moiety of the patent, and the patentee died before the hearing of the petition, leaving his widow sole executrix and residuary legatee, the new patent was, with her consent, granted to the assignees upon trust that they should hold one moiety in trust for the widow (d).

NOTE.

If the invention is used in the interval between the expiry of the old patent and the grant of the new patent, the persons using are not liable (e).

“Restrictions, conditions, and provisions.”—It has been the practice of the judicial committee, in cases of applications by assignees for prolongation, to impose conditions in favour of the original inventor (f) or his representatives (g). Thus the assignee has been required to secure to the inventor an annuity (h) or a share of the profits (i), and exclusive licensees have been required to renounce all right and benefit under their licence (k). Conditions in favour of inventor.

On the other hand, conditions have been imposed on a patentee in favour of persons who have acquired interests in the patent from him (l), or who might be prejudiced by the delay of the patentee in getting the new patent sealed (m). Or persons dealing with him.

But such conditions were only imposed when the patentee had made nothing by his patent, and therefore where an assignee had given valuable consideration for the assignment and had sustained loss, the extension was granted without conditions (n).

Where a mortgagee was not a co-petitioner, a condition was imposed that the petitioner should undertake to give to the mortgagee the same security over the new letters patent as he had over the existing patent (o).

Conditions on behalf of the public have also been imposed, as that the patentee shall grant licences upon terms similar to one already Conditions in favour of the public or the Crown

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| <p>(c) <i>Wastney Smith's Patent</i>, <i>ubi supra</i>; <i>Cooking's Patent</i>, 2 R. P. C. 151.</p> <p>(d) <i>Herbert's Patent</i>, L. R. 1 P. C. 404.</p> <p>(e) <i>Russell v. Ledsam</i>, 14 M. & W. 583; 1 H. L. C. 687.</p> <p>(f) <i>Whitehouse's Patent</i>, 1 Webst. 473 (reported as <i>Russell's Patent</i>, 2 Moo. P. C. 496).</p> <p>(g) <i>Herbert's Patent</i>, L. R. 1 P. C. 399.</p> <p>(h) <i>Whitshouse's Patent</i>, <i>ubi supra</i>; <i>Markwick's Patent</i>, 13 Moo.</p> | <p>P. C. 310; <i>Russell v. Ledsam</i>, 14 M. & W. 574.</p> <p>(i) <i>Hardy's Patent</i>, 6 Moo. P. C. 441; <i>Morton's Patent</i>, Eng. Rep., Apr. to June, 1881, vii.</p> <p>(k) <i>Shone's Patent</i>, 9 R. P. C. 438.</p> <p>(l) <i>Normandy's Patent</i>, 9 Moo. P. C. 452. See also <i>Baxter's Patent</i>, 13 Jur. 593.</p> <p>(m) <i>Schlumberger's Patent</i>, 8 Moo. P. C. 282.</p> <p>(n) <i>Bodmer's Patent</i>, 6 Moo. P. C. 468.</p> <p>(o) <i>Church's Patents</i>, 3 R. P. C. 95.</p> |
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Sect. 25 (5). granted by him (*p*), or shall sell the patented article at a fixed price (*q*), or shall disclaim so much of the specification as relates to parts of the invention not worked out (*r*).

NOTE.

In *Pettit Smith's Patent* (*s*), a condition was inserted requiring the patentee to allow the Crown to use the invention without licence. This condition was refused in *Lancaster's Patent* and *Carpenter's Patent* (*t*); but since the decision in *Dixon v. London Small Arms Co.* (*u*), a condition permitting the use of the invention by the Crown, and all contractors employed by the Crown, had become usual in all cases of inventions likely to be required by Government (*x*). But since ss. 22 and 27 apply to new patents granted by way of prolongation, conditions in favour of the Crown are not now inserted (*y*).

Two cognate patents with different terms were extended so that both should expire on the same day (*z*).

Prolongation may be granted for part only of the invention (*a*).

The judicial committee have no jurisdiction to grant a second extension after one prolongation has been granted (*b*).

Where an order has been made by Her Majesty in Council for the extension of a patent for a further term, or for the grant of a new patent, the person in whose favour such order has been made must leave at the Patent Office an office copy of such order (*c*).

SUB-SECTION (6).

Rules have now been made under this sub-section. See Judicial Committee Rules, *post*.

SUB-SECTION (7).

"Costs"—The judicial committee have always considered that it is not desirable to refuse the costs of a fair opposition to applications for prolongation, and that *bond fide* opposition should rather be encouraged, in order that the court may be put into possession of all that can be

Costs in extension cases.

(*p*) *Mallet's Patent*, L. R. 1 P. C. 308; *Lyon's Patent*, 11 R. P. C. 537.

(*q*) *Hardy's Patent*, 6 Moo. P. C. 441.

(*r*) *Bodmer's Patent*, 8 Moo. P. C. 282.

(*s*) 7 Moo. 133.

(*t*) 2 Moo. P. C. (N.S.) 189, 191.

(*u*) 1 App. Cas. 632.

(*w*) *Hughes' Patent*, 4 App. Cas. 174; *Napier's Patent*, 6 App. Cas. 174.

(*y*) *Wastoney Smith's Patent*, 2 R. P. C. 14; *Cooking's Patent*, 2 R. P. C. 151.

(*z*) *Johnson's and Atkinson's Patents*, L. R. 5 P. C. 87.

(*a*) *Napier's Patent*, 6 App. Cas. 174; *Lee's Patent*, 10 Moo. P. C. 226; *Bodmer's Patent*, *ubi supra*; *Church's Patents*, 3 R. P. C. 95, 102.

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

(*c*) P. R., r. 74, *post*.

alleged against the continuance of the patent (*d*). The costs of a successful opposition are therefore in general allowed. But when the committee have not been satisfied with the manner in which the opposition has been conducted, the costs of opposition have been refused (*e*). And where there was no ground for the opposition, the opponents were made to pay the extra costs occasioned thereby (*f*). And when the petition is abandoned, the petitioner will in general have to pay the costs of opposers (*g*).

Sect. 25 (7)

NOTE.

When there was good ground for the opposition, and the case was doubtful, no costs were given to the petitioner, though he was successful in obtaining a prolongation (*h*).

When there are several opponents the petitioner has been ordered to pay a named sum to be divided among the opponents, sometimes with (*i*) and sometimes without (*k*) the option of having the costs of all the opponents taxed in the usual way; and the petitioner has been allowed time in which to declare his option (*l*).

One set of costs has been given to each set of opponents (*m*); and in another case, one set of costs was given between all the opponents (*n*).

It has been considered a reason for giving between two opponents a lump sum for costs that they both represented the same kind of opposition (*o*).

In the case of an abandoned petition there is no need to serve the petitioners with notice of an intended application by the opponents for costs (*p*).

Revocation.

26.—(1.) The proceeding by scire facias to repeal a patent is hereby abolished. Revocation of patent.

(*d*) *Wield's Patent*, L. R. 4 P. C. 89; *Westrupp and Gibbin's Patent*, 1 Webst. 556; *Honiball's Patent*, 9 Moo. P. C. 394.

(*e*) *Honiball's Patent*, 9 Moo. P. C. 394. See also *Muntz's Patent*, 2 Webst. 122.

(*f*) *Downton's Patent*, 1 Webst. 567.

(*g*) *Macintosh's Patent*, 1 Webst. 739; *Bridson's Patent*, 7 Moo. P. C. 499; *Hornby's Patent*, 7 Moo. P. C. 503; *Re Milner's Patent*, 9 Moo. P. C. 39; *Morgan Brown's Patent*, 5 R. P. C. 212.

(*h*) *Church's Patents*, 3 R. P. C. 95.

(*i*) *Milner's Patent*, 9 Moo. P. C.

39; *Hills' Patent*, 1 Moo. P. C. (N.S.) 258; *Wield's Patent*, L. R. 4 P. C. 89; *Hopkinson's Patent*, [1897] A. C. 249, 253.

(*k*) *Re Schlumberger*, 1 Moo. P. C. (N.S.) 1; *Johnson's Patent*, L. R. 4 P. C. 75; *Jones' Patent*, 9 Moo. P. C. 41.

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

(*m*) *Newton's Patent*, Eng. Rep. Jan. to Mar. 1881, xv.

(*n*) *Newton's Patents*, 9 App. Cas. 592; 1 R. P. C. 177.

(*o*) *Johnson's Patent*, L. R. 4 P. C. 92.

(*p*) *Bridson's Patent*, 7 Moo. P. C. 499.

Sect. 26 (2).

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

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

(4.) A petition for revocation of a patent may be presented by—

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

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

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

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

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

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

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

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

(8.) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true

inventor made in accordance with the provisions of this Act, **Sect. 26 (8).**
 grant to him a patent in lieu of and bearing the same date
 as the date of revocation of the patent so revoked, but the
 patent so granted shall cease on the expiration of the term
 for which the revoked patent was granted.

This section must be read in connection with s. 109, *post*.

Patents for inventions as to which the Secretary of State certifies
 under s. 44, (3), *post*, are not revocable. See s. 44 (9).

SUB-SECTION (2).

"Petition"—A petition to revoke a patent, by whomsoever pre-
 sented, is a petition on behalf of the public and is not personal to the
 petitioner (*q*).

Therefore, a defendant against whom judgment has been given in an
 action for infringement is not estopped from presenting a petition for
 revocation of the patent (*r*).

And the fact that a claim of a specification has been held invalid
 in an action for infringement will not estop the patentee, on a petition
 by the alleged infringer for revocation, from denying the invalidity of
 the claim (*s*). Nor, although the court may at the instance of the
 patentee in an action for infringement have given a wide construction
 to the specification, is the patentee estopped on a subsequent petition
 for revocation from insisting on a narrower construction (*t*).

Where the patent was assigned after presentation of the petition
 for revocation, the name of the assignee was, on payment of a sum into
 court by the patentee and the assignee, substituted for that of the
 patentee as respondent (*u*).

The Act contains no provision for service of the petition out of the
 jurisdiction.

When the petitioner was resident and domiciled in England, and the
 patentee was resident and domiciled in Scotland, and the petitioner had
 delivered to the patentee in Scotland a copy of the petition and
 particulars of objections, and the patentee had written to the petitioner's
 solicitors that he did not intend to appear at the hearing as he was not
 subject to the jurisdiction of the English court, and on the petition
 coming on for hearing the petitioner asked that it might be put into

Patentee out
 of the juris-
 diction:

(*q*) *Deeley's Patent*, [1895] 1 Ch.
 687.

(*r*) *Shoe Machinery v. Cutlan*,
 [1896] 1 Ch. 108, 113.

(*s*) *Deeley's Patent, ubi supra*.

(*t*) *Lewis and Stirckler's Patent*,
 14 R. P. C. 24.

(*u*) *Re Haddan's Patent*, 2 R.P.C.
 218, 219.

Sect. 26 (2). the witness list and tried by *vivâ voce* evidence, an order *nisi* was made for such trial unless the petitioner should appear by a given day and object, and if he appeared it was to be open to him to dispute the jurisdiction (x).

NOTE.

And in *Kay's Patent* (y), where one of the patentees was out of the jurisdiction, it was held (following the analogy of the procedure in *King & Co.'s Trade Mark* (z)) that, if he could not be served, notice of the petition should be given to him. And when notice of the petition and of the time fixed for hearing had, by order of the court, been sent by registered letter to a foreign patentee and he did not appear, the patent was on proof of its invalidity revoked (a).

“**The Court**”—Having regard to sub-s. (4) (a), (b), and to s. 109, “the Court” would seem to be in England the High Court of Justice in England (s. 117), in Scotland the Court of Session, and in Ireland the High Court of Justice in Ireland (s. 111); and since the word “patent” means (ss. 46 and 16) letters patent having effect throughout the United Kingdom and the Isle of Man, it appears that revocation for the whole of the United Kingdom may be obtained in the courts (defined as above) of any of the three kingdoms. The Court of the County Palatine of Lancaster was held not to be a court within the meaning of the Act (b), except with respect to the particular action and proceedings referred to in s. 112A, *post*. But now by s. 3 of the Chancery of Lancaster Act, 1890 (c), that court has, as to all persons and property within its jurisdiction, the same jurisdiction as the Chancery Division of the High Court.

Where an order for revocation has been made, an office copy of the order must be left with the comptroller (d).

SUB-SECTION (3).

General rule as to *scire facias*.

Scire facias to repeal letters patent lay in three cases:—

1. When the king doth grant by several letters patent one and the self-same thing to several persons, the first patentee shall have a *sci. fa.* to repeal the second (e).

2. When the king doth grant a thing upon a false suggestion, he, *prærogativâ regis*, may by *sci. fa.* repeal his own grant.

(x) *Drummond's Patent*, 43 Ch. D. 80 : Seton, 1987.

(y) 11 R. P. C. 279. See also *Görz and Högh's Patent*, 12 R. P. C. 370.

(z) [1892] 2 Ch. D. 462.

(a) *Hirschfeld's Patent*, 11 R.P.C. 514.

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

(c) 53 & 54 Vict. c. 23.

(d) P. R., r. 74, *post*.

(e) See *R. v. Neilson*, 1 Webst. 671, 672.

3. When the king doth grant anything which by law he cannot grant (f). Sect. 26 (3).

As to the second of these rules, the law is thus stated by PARKE, B :— NOTE.

“That a false suggestion of the grantee 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 : *Travell v. Carteret* (g) ; *Alcock v. Cooke* (h). It is on the same principle that a patent for two or more inventions, when one is not new, is void altogether, as was held in *Hill v. Thompson* (i) and *Brunton v. Hawkes* (k) ; for although the statute invalidates a patent for want of novelty, and consequently by force of the statute the patent would be void so far as related to that which was old, yet the principle on which the patent has been held to be void altogether is that the consideration for the grant is the novelty of all, and the consideration failing, or, in other words, the Crown being deceived in its grant, the patent is void, and no action maintainable upon it” (l).

False suggestion avoids patent as against third party as well as against Crown.

Avoids patent altogether when one of two inventions old.

A statement of various grounds on which false suggestion avoids a patent will be found in the Index to Mr. Webster's Reports, p. 751, under the title “False Suggestion.”

The grounds on which proceedings might be instituted are stated by Mr. Webster to be “fraud, false suggestion, non-compliance on the part of the patentee with the conditions of the letters patent, failure of any of the essential requisites of novelty and utility, or abuse of the privileges granted by the letters patent” (m). Grounds of *scire facias*.

Thus *scire facias* would lie to repeal a patent when the invention, being a mere application of a known article to a new use, the mode of application not being new, was not the proper subject of a patent (n).

So, also, where the specification was insufficient, for the patent being granted on condition of filing a proper description of the invention, an insufficient specification was not a compliance with the condition (o).

Some of the above grounds for *scire facias* at the commencement of this Act were more or less dependent on recitals in the patent (p).

(f) *R. v. Mussary*, 1 Webst. P. C. 41 ; citing 4 Inst. 88.

(g) 3 Lev. 134.

(h) 5 Bing. 340.

(i) 8 Taunt. 375.

(k) 4 B. & A. 541.

(l) *Morgan v. Seaward*, 2 M. & W. 544 ; 1 Webst. 196.

(m) Webster on the Law and Practice of Letters Patent for Inventions, p. 32.

(n) *R. v. Cutler*, Macr. P. C. 124.

(o) See *R. v. Arkwright*, 1 Webst. P. C. 66 ; *R. v. Cutler*, Macr. P. C. 137.

(p) See Hindmarch on Patents, p. 106.

Sect. 26 (3). There is also a distinction "between such an error in the specification as will render a suggestion in the letters patent false, and such an error in a matter of direction or otherwise as affects the suggestion in some degree short of the preceding, as, for instance, to diminish the extent of utility. Other defects in a specification, as insufficiency of description, vitiate by reason of non-compliance with the proviso in the letters patent" (*q*). As the documents on which for the future patents will be granted under this Act, and the form of the patent itself, differ in many particulars from what were in use before this Act, there might have been questions how far such grounds of defence to an action for infringement as were founded on false suggestion are now available, but under this sub-section no such question can, it is submitted, arise (*r*).

NOTE

In addition to the above grounds of defence and revocation there is now that contained in clause (c), which appears to be new (*s*).

**Practice in
*scire facias***

Two parties could not have a *scire facias* for the same patent (*t*).

Where a patent was originally granted to two persons it was necessary to join both patentees as defendants, even though one had before the issue of the writ assigned all his share to his co-patentee (*u*).

In *R. v. Arkwright* (*x*) it was held that a suggestion on a writ of *scire facias* that "the grant is prejudicial and inconvenient to our subjects in general," was too vague, and evidence on this issue was refused. This was before particulars of objection were required.

Where the trial had ended in a verdict for the Crown it was no ground for a new trial that the patentee could bring further evidence on certain points, he not alleging surprise or any new discovery of evidence (*y*).

Under the old practice in *scire facias* the Lord Chancellor had power to stay proceedings, and apparently could order security for costs to be given (*z*), and, if the action resulted in favour of the Crown, could order the patent to be restored into Chancery to be cancelled (*a*). There is no provision in the present Act for delivering up the patent in the event of revocation.

The fact of a *scire facias* pending was a ground for refusing a non-suit on an objection to a patent (*b*), and when a plaintiff had obtained a

(*q*) 1 Webst. 42 n.

(*r*) See *Siddell v. Vickers*, 39 Ch. D. 92, 106, 109.

(*s*) See *Vincent's Patent*, L. R. 2 Ch. 341.

(*t*) *R. v. Neilson*, 1 Webst. 673.

(*u*) *R. v. Betts*, 15 Q. B. 540.

(*x*) 1 Webst. P. C. 64 n.

(*y*) *R. v. Arkwright*, 1 Webst. 74.

(*z*) *R. v. Neilson*, 1 Webst. 672 ; but see *R. v. Prosser*, 14 Bea. 306.

(*a*) *R. v. Newton*, Hindmarch on Patents, p. 427. As to the jurisdiction of the Lord Chancellor after judgment, see *R. v. Eastern Archipelago Co.*, 4 D. M. & G. 199.

(*b*) *Haworth v. Hardcastle*, 1 Webst. P. C. 485.

verdict in an action for infringement, and subsequently a *scire facias* was sued out, and a rule obtained to show cause why a non-suit in the action should not be entered, the Court refused to enlarge the time for this rule till after the trial in the *scire facias*; and Sir N.C. TINDAL, C.J., said, that even if the *scire facias* availed, and the patent was repealed, that would not necessarily prevent the Court from giving judgment on the objection taken at the trial of the action for infringement (c).

Sect. 26 (3).

NOTE.

SUB-SECTION (4).

4 (a). There appears to be a limitation on proceedings for revocation in Scotland which does not affect such proceedings in England or Ireland, inasmuch as by s. 109 it is provided that proceedings in Scotland for revocation shall be in the form of an action of reduction, at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only. On the principle stated by JESSEL, M. R., in *Ex parte Stephens* (d), "that when there is a special affirmative power given which would not be required because there is a general power, it is always read to import the negative, and that nothing else can be done," it would seem, on comparing the present section with s. 109, that the latter is to be read as limiting the former, and that in Scotland clauses (c), (d), and (e) are not available unless with the Lord Advocate's concurrence, and that revocation can only be had in the Scotch Courts under the conditions mentioned in s. 109.

Action of reduction in Scotland, Lord Advocate's concurrence always required.

4 (b). By s. 109 the party at whose instance the proceedings are taken in Scotland must have an interest. There are no such words in this sub-section. Under the old practice, however, although in the above case of *R. v. Mussary* (e) it is stated, on the authority of *Butler's case* (f), that when a patent is granted to the prejudice of a subject, the King of right is to permit him upon his petition to use his name for the repeal of it, it was also said that the subject had not a right *mero motu* to have a *scire facias* (g); and the fiat of the Attorney-General was, in fact, necessary in all cases, and was not issued as of course (h).

Attorney-General's fiat required in England, and not issued as of course

(c) *Ibid.*, p. 486; *Muntz v. Foster*, 2 Webst. P. C. 93 n.; but see *Smith v. Upton*, 6 M. & G. 251; *Patteson v. Holland*, Hindmarch on Patents, p. 293. In *Smith v. Upton*, the postponement was at the instance of the plaintiff in the action.

(d) 3 Ch. D. 660.

(e) 1 Webst. 41.

(f) 2 Ventr. 344.

(g) *R. v. Neilson*, 1 Webst. P. C. 672.

(h) 1 Webst. 671, n.; *Ibid.* 672; *R. v. Prosser*, 14 Bea. 306.

Sect. 26 (4).

NOTE.
Attorney-
General's
fiat.

In *Young's Patent (i)* the fiat was refused by Sir R. BETHELL, A.-G. In this case the patent was for the production of paraffin oil by the distillation of bituminous coal. The application for *scire facias* was made by the owner of a coal-field in Scotland, containing a certain mineral called the Torbane Hill mineral, the right to get which was leased to certain persons who sold to the patentee, by whom it was used in his manufacture. Under the terms of the lease, the applicant had a pecuniary interest in the quantity of the mineral raised. His application was based on allegations that the invention was not new, and that his interests were prejudicially affected by the patent, and the use made thereof to interfere with the sale of the Torbane Hill mineral. It appeared also that the applicant had raised in Scotland an action of declaration and reduction (a proceeding analogous to the English *scire facias*) to repeal the patentee's Scotch patent for the same invention. The application was refused on the ground (1) that as a general rule the writ of *scire facias* ought to be used for public purposes only, and not with a view to promote any private end or interest; (2) that the action in Scotland being pending, the proper course was to allow that action to go on, and then to allow, or not allow, proceedings after its determination; and (3) that the patent was eleven years old, and had been the subject of several legal proceedings which had been compromised, and that no evidence of want of novelty was produced, and that such a patent ought not to be lightly challenged. And again, in the same patent, on a fresh application for the writ of *scire facias* made by the same applicants (*k*) after the abandonment of the original Scotch action, but after the institution of a second action for the same purpose which had not been formally, though it was alleged it had been virtually, abandoned, Sir W. ATHERTON, A.-G., refused his fiat (*l*).

Where an action for infringement at the suit of the patentees, who were resident in Scotland, was pending in Scotland against the applicants, the Attorney-General refused his fiat pending the result of the action, but gave leave to renew the application if necessary (*m*).

Where no action is pending the authority of the Attorney-General may be granted without any notice to the patentee (*n*). So, also, where an action against the applicants had been abandoned and the patentee had applied at the Patent Office for leave to amend his specification (*o*).

(i) Practical Mechanic's Journal, 2nd series, vol. 6, p. 98.

(k) *Young's Patent*, Practical Mechanic's Journal, 2nd series, vol. 7, p. 44.

(l) See also *R. v. Neilson*, 1 Webst. P. C. 673, where it is said that after one party has sued out a *scire facias* another could not do it.

(m) *Bell and Coleman's Patent*, Griffin, P. C. 320.

(n) *Gaulard and Gibbs' Patent*, Griffin, P. C. 320; but see *Siddell's Patent*, *ibid.*

(o) *Rothwell's Patent*, Griffin, P. C. 320.

But where in an action for infringement, judgment was given against the defendants, who appealed, and in the interval between the judgment and the hearing of the appeal applied for the authority of the Attorney-General under this sub-section, notice was ordered to be given to the patentee (*p*). So, also, where the applicant was a licensee (*q*).

NOTE.

And where notice had been given to the patentee and he undertook to bring an action for infringement, the application for the Attorney-General's fiat was ordered to stand over (*r*).

The Attorney-General had control over the prosecutor's proceedings, and it seems that he could direct a *nolle prosequi* to be entered as to certain parts of the writ if the prosecutor insisted on retaining them, and he was accustomed to afford similar relief in other cases, though his jurisdiction was exercised principally on the subject of security for costs (*s*).

Where a petition under this sub-section for the authority of the Attorney-General has been abandoned, he has no power under s. 38, *post*, to order payment of costs (*t*).

For the proceedings necessary to obtain the fiat of the Attorney-General, see Appendix, *post*, pp. 611, 612.

4 (c). "In fraud of his rights."—These words mean acts done with the intention of depriving a person of his rights, and do not apply to cases of mere mistake, and therefore, where a person appointed by an agent for a foreign inventor, without any fraudulent intention, took out the patent in his own name without stating that any part of it was a communication from abroad, but always intended to hold the patent for the benefit of the foreign inventor, it was held that, even if the patent was void, a petition could not be sustained under this sub-section, and it was dismissed without prejudice to any petition which the petitioner might present under sub-s. (4) (d), claiming to be the true inventor (*u*).

But where it appeared that the experiments resulting in the invention were made by one of two petitioners under the direction of the other, and not, as alleged by the patentee, by one of the petitioners under the patentee's direction, though they were made at the patentee's factory, and the judge found on the evidence that the invention was not that of the patentee, and that the patent was taken out with the intention of depriving one of the petitioners of his rights, the patent was revoked (*x*).

(*p*) *Walling's Patent*, Griffin, P. C. 320.

(*q*) *Martin's Patent*, Griffin, P. C. 320.

(*r*) *Siddell's Patent*, Griffin, P. C. 320.

(*s*) *R. v. Newall*, 1 Webst. P. C. 671, n.

(*t*) *Martin's Patent*, 29 S. J. 148; Griffin, P. C. 320.

(*u*) *Acery's Patent*, 36 Ch. 307.

(*w*) *Norwood's Patents*, 12 R. P. C. 214. See also *Norwood's Patent* (No. 2), 15 R. P. C. 104.

Sect. 26 (4).

NOTE.

4 (d). Where it did not appear that the second patentee had copied, or fraudulently taken from the first patent, and the second patent was not for an invention identical with that comprised in the first patent, but was for a different method of effecting the objects of the latter invention, and showed a different way of dealing with knowledge common at the date of the first patent, a petition for revocation presented by the first patentee was dismissed with costs (y).

Since the words of the sub-section are "true inventor," and not "true and first inventor," which latter words include an importer (*ante*, p. 6), it would seem that the sub-section distinguishes between a mere importer and the inventor, and that in the case of an invention of foreign origin a patent granted to a person who is only importer and not inventor may be revoked at the instance of the actual inventor.

4 (e). Where it was proved that the petitioner had, before the patent, for many years used a process practically, for all chemical purposes, identical with the patented process, and producing a material chemically the same as the patented material, the patent was revoked under this sub-section (z).

If the petitioner is qualified under sub-ss. (c), (d), or (e), to present the petition, it is open to him to impeach the patent on any lawful ground (a). But the court will not go into the question whether the patent is or is not good, if it appears on the hearing that the petitioner has no *locus standi* under these sub-sections (b). If, therefore, there is any doubt on this latter point, it will be necessary to obtain the authority of the Attorney-General under sub-s. (b).

When the objection is taken that the fiat of the Attorney-General was necessary and has not been obtained, the petitioner's counsel will be heard on the point of *locus standi*, notwithstanding the provisions of sub-s. (7), that the respondent is entitled to begin; and a petition wrongly presented under sub-ss. (c), (d), or (e) will, if the objection is established, be ordered to stand over in order that application may be made for the fiat, and when the fiat is obtained may be amended and brought on again for hearing (c).

The petition must be presented in the name of the person making the allegations referred to in sub-ss. (c), (d), and (e), and not in the name of his attorney, and all persons interested in the patent must be made respondents (d).

(y) *Walker v. Hydro-Carbon Syndicate, Limited*, 2 R. P. C. 3. An appeal from this decision was presented but afterwards withdrawn, 3 R. P. C. 254.

(z) *Haddan's Patent*, 2 R. P. C. 218.

(a) *Morgan's Patent*, 5 R. P. C. 186.

(b) *Avery's Patent*, 36 Ch. D. 307, 323.

(c) *Re Dege's Patent*, 12 R. P. C. 448.

(d) *Avery's Patent*, 36 Ch. D. 307.

SUB-SECTIONS (5), (6).

Sect. 26(5,6).

NOTE

On a petition for revocation, interrogatories may be exhibited by the petitioner to the respondent (e).

For a form of particulars of objections under this sub-section, see *Re Haddan's Patent* (f). See also the notes under s. 29 (2), (3), (4), (5).

It appears that a certificate under s. 29 (6) (*post*, p. 159) cannot be given in respect of the particulars of objections delivered under the present sub-sections on a petition for revocation (g).

SUB-SECTION (7).

A re-enactment of the latter part of s. 41 of the Act of 1852.

In *scire facias* the burden of proof was on the prosecutor, and it was apparently not enough for him to make out merely a *prima facie* case against the patentee (h).

Under the present Act when the patentee did not appear at the hearing, the court, on evidence of want of novelty being given, revoked the patent (i). Where the patentee did not appear when the petition came on for directions, and the petitioner had been informed by the patentee that he did not intend to oppose, the court declined to make an order for revocation until an affidavit verifying the petition had been filed (k). Patentee not appearing.

The patent may be revoked by consent of the patentee (l).

If the respondents desire it a petition for revocation will be tried on *vivâ voce* evidence (m). Evidence.

When the evidence is taken by affidavit, the party who has the right to begin should file his evidence first, and if either party cross-examines, he ought to bring that evidence before the court (n).

If several persons join in the petition they ought not to appear separately. In *Norwood's Patent* (o), where there were two petitioners, and one conducted his own case and the other appeared by counsel and no objection was taken, the judge allowed the separate appearances, but intimated that it was not to be taken as a precedent.

No summons ought to be taken out as to the mode of trial; the judge will decide this when the petition comes on for hearing (p). Mode of trial.

(e) *Haddan's Patent*, 54 L. J. Ch. (N.S.) 126; 51 L. T. (N.S.) 190; W. N. (1884), p. 192.

(f) 2 R. P. C. 219.

(g) *Gaulard and Gibbs' Patent*, 5 R. P. C. 525, 537.

(h) See *R. v. Cutlar*, Macr. P. C. 124, 133, 134.

(i) *Ingram, Jones and Elvan's Patent*, 13 R. P. C. 446.

(k) *Vaisey's Patent*, 11 R. P. C. 591.

(l) *Rendell's Patent*, 11 R. P. C. 277.

(m) *Gaulard and Gibbs' Patent*, 34 Ch. D. 396. See also *per* CHITTY, J., *Gales' Patent*, 8 R. P. C. 438, 440.

(n) *Gales' Patent*, 8 R. P. C. 438.

(o) 12 R. P. C. 214.

(p) See *per* KEKEWICH, J., *Miller's Patent*, 11 R. P. C. 55.

Sect. 26 (7). Under the S. C. R. 1883, Order XXXVI. r. 1, or Order XXX. r. 1, an order was made for a trial of the petition at assizes before a judge without a jury; but such an order was not to prevent the judge at the trial from acting on his own view of his jurisdiction (*q*).

NOTE.

When the petition was for revocation on the ground of fraud, and the petitioner had brought an action complaining of the alleged fraud and claiming damages, an order was made transferring the petition from the Chancery to the Queen's Bench Division, in order that the petition and the action might be tried together (*r*).

Order of
revocation—
Practice in
cases of
appeal.

In *Armstrong's Patent* (*s*) the order for revocation was made, but on the application of the respondents it was directed that it should not be delivered out for a week, and then, if notice of appeal were presented, execution was to be stayed; the court expressing a doubt whether a patent when revoked could be restored.

But in the subsequent case of *Deeley v. Perkes* (*t*), where the court of first instance had held all the claims bad and revoked the patent, and the order had been entered on the register of patents, it was held in the House of Lords that the Court of Appeal, who were of opinion that one claim was valid, could reverse the order below, and order that the patent be revoked unless within three months, or such further time as the court might allow, the patentee should obtain leave to amend his specification by disclaiming the other claims (*u*).

For forms of orders of revocation, see Seton, 1987.

It is not now the practice formally to cancel a patent even after there has been an order revoking it. The order of revocation is carried to the office of the comptroller, and there a note is made, but there is no actual cancellation of the document (*x*).

Security for
costs.

Security for costs will not be ordered against a respondent to a petition for revocation who is resident out of the jurisdiction (*y*).

Costs.

The only costs which can be given on a petition for revocation are the costs of the petition. The court does not deal with any costs incurred before the law officer (*z*).

Where the petition had been sent by the Chancery Division for trial at the assizes, and the judge found that the patent ought to be revoked, but the order having been drawn up as for the trial of an issue the

(*q*) *Edmonds' Patent*, 5 Times Rep. 109. The order was made as in the text. As actually drawn up (Seton, 1987), it appears to be incorrect. See remarks of NORTH, J., at 6 R. P. C. 358.

(*r*) *Edge's Patent*, W. N. (1890), 149.

(*s*) 13 R. P. C. 501.

(*t*) [1896] A. C. 496.

(*u*) And see *Armstrong's Patent*, before the Court of Appeal, 14 R. P. C. 747.

(*x*) See per LINDLEY, L.J., *Armstrong's Patent*, 14 R. P. C. 747, 755.

(*y*) *Miller's Patent*, 11 R. P. C. 55.

(*z*) *Rendell's Patent*, 11 R. P. C. 277.

judge at assizes sent the case back to the Chancery Division without making any order for revocation, it was held in the Chancery Division that under the general jurisdiction of the court the costs could be ordered to be paid by the unsuccessful party, and an order was made revoking the patent with costs, to be paid by the patentee (a).

Sect. 26 (7).

NOTE.

SUB-SECTION (8).

It would seem that it is only when the patent has been revoked under sub-s. (4) (c) that sub-s. (8) applies, and that it would not apply if the patent were revoked under sub-s. (4) (d) (b).

Crown.

27.—(1.) A patent shall have to all intents the like effect as against Her Majesty the Queen, her heirs and successors, as it has against a subject. Patent to bind Crown.

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

This section does not apply to patents existing at the commencement of the Act, or granted on applications then pending. See s. 45 (2). These patents will be subject to the law as laid down in *Feather v. The Queen* (c), where it was held by the Court of Queen's Bench, contrary to the opinion which formerly prevailed (d), that the ordinary form of grant in letters patent did not preclude the Crown from using the invention even without the assent of or compensation made to the patentee. And the patentee, therefore, could not prevent the use of his invention by a Government department. But persons contracting

(a) *Edmonds' Patent*, 6 R. P. C. 355.

(b) See per BOWEN, L.J., *Arery's Patent*, 36 Ch. D. 307, 326.

(c) 6 B. & S. 257.

(d) *Walker v. Congreve*, 1 Carpmael Pat. Cases, 356; mentioned also in Norman on Patents, p. 181. *In re Pettit Smith's Patent*, 7 Moo. P. C. 133; *In re Lancaster's Patent*, 2 Moo. P. C. (N.S.) 189.

Sect. 27.

NOTE.

to supply the Crown with certain articles of manufacture are not servants of the Crown, doing the work of the Crown, and therefore, when contractors for the supply of rifles to the War Office made such rifles according to a patented invention, but without the licence of the patentee, it was held that they were liable to be sued by the patentee for infringement (*e*).

In patents under the present Act, *Feather v. The Queen* will not apply, and the case of contractors acting for a Government Department will be dealt with under sub-s. (2).

The section applies to new patents granted under s. 25 by way of extension of existing patents (*f*).

In cases not within this sub-section, the patentee's remedy is not by petition of right, but by proceeding against the officers of the Crown using the patent (*g*). This also seems to have been the view of Lord ELDON in *Walker v. Congreve* (*h*).

LEGAL PROCEEDINGS.

Plaintiff need not apply to defendant before commencing proceedings.

A plaintiff is not bound, before commencing proceedings, to apply to the defendant and ascertain whether he will, without suit, do what is required (*i*); and as a general rule the court takes no notice of negotiations before suit (save in cases of bad faith), unless they amount to a release or binding agreement with respect to the causes of action (*k*). Nor is a plaintiff compelled to rely on the promise of the offending party not to infringe again, but he is entitled to the protection of an injunction (*l*). If, however, this right is exercised oppressively, the plaintiff may lose the costs of the action (*m*). And the injunction ought not to be granted if the defendant has ceased from the acts complained of and there is no ground to apprehend that they will be repeated (*n*).

Limitation as to proceedings for infringement.

No proceedings are to be taken in respect of an infringement committed before the publication of the complete specification (*o*); and if

(*e*) *Dixon v. London Small Arms Co.*, 1 App. Cas. 632.

(*f*) *Wastney Smith's Patent*, 2 R. P. C. 14; *Cooking's Patent*, 2 R. P. C. 151.

(*g*) *Feather v. The Queen*, 6 B. & S. 257.

(*h*) *Ubi supra*.

(*i*) *Upmann v. Elkan*, L. R. 12 Eq. 146; *Burgess v. Hills*, 26 Bea. 244, 247; *Burgess v. Hately*, 26 Bea. 249; *Upmann v. Forrester*, 24 Ch. D. 231.

(*k*) *Edelsten v. Edelsten*, 1 D. J. S. 203; *Davenport v. Rylands*, L. R. 1 Eq. 305.

(*l*) *Lesh v. Hague*, 1 Webst. P. C. 201; *Geary v. Norton*, 1 De. G. & Sm. 9.

(*m*) See post, p. 238.

(*n*) *Proctor v. Bayley*, 42 Ch. D. 390; *Leahy v. Glover*, 10 R. P. C. 141 (H. L.)

(*o*) Section 13, ante, p. 61.

the time for making any of the prescribed payments has been enlarged, the court may refuse to award damages in respect of any infringement committed after the failure to pay, and before the enlargement of the time for payment (p).

A patentee is often placed in serious difficulty when his patent is infringed by several persons at once. If he proceed by separate actions against the several infringers at the same time, he may have to try the validity of his patent in several distinct proceedings, in each of which different objections may be taken, and he will also be liable to the charge of oppressive litigation. On the other hand, if he does not file bills against the general body of infringers till he has established his patent in an action against one of them, there is not only the difficulty that each separate infringer is not bound by the proceedings in that action, and may require the patent to be established afresh against him (q), but the patentee, by reason of his *laches* (r), may be unable to obtain the interlocutory injunctions to which, having established his patent in one action, he would be otherwise entitled (s).

In such a state of things the course which has been suggested by Lord HATHERLEY, C. (t), is that a patentee in the position referred to should select the case which he thinks best to try the question fairly, and proceed to obtain an interlocutory injunction against that infringer. He should at the same time write to the other persons infringing, 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."

In such a case where the objection of delay was urged against the grant of the interlocutory injunction, the court, while refusing the injunction, has required the defendant to pay a sum of money into court as security, and has required the action to be prosecuted without delay, and pleadings to be delivered in the vacation (u). In the *North British Rubber Co. v. Gormully, etc. Co.* (x), the defendants having offered to pay a sum of money into court the injunction was refused though the patent had been established in a previous action.

All parties claiming an interest in the letters patent, if they do not join as co-plaintiffs, may properly be made defendants to the action, in order that the infringing defendants may not be compelled to account

§s. 23-32.
—
Legal Proceedings.
Several in-
fringements
at one time.

All parties
claiming
interest
should be

(p) Section 17 (4) (b), *ante*, p. 67.

(q) *Bovill v. Goodier* (2), L. R. 2 Eq. 195; *Bovill v. Smith*, W. N. (1867), 340; *Croskill v. Tuxford*, 5 L. T. 342.

(r) See *post*, p. 272.

(s) *Bovill v. Crate*, L. R. 1 Eq.

388. See also *North British Rubber Co. v. Gormully & Co.*, 12 R. P. C. 17.

(t) *Bovill v. Crate*, *ubi supra*.

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

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

Ss. 28—32.
Legal Proceedings.
 joined in the
 action.

twice, first to the plaintiff, and then to the other defendants who claim an interest (y). And where assignments of shares of the profits under a licence had been made, it was held in an action by one assignee against the licensee for an account, that in order to avoid multiplicity of actions the account must be taken once for all in the presence of all the persons interested (z).

The mortgagor of a patent may, however, sue alone for infringement without joining the mortgagees, either as co-plaintiffs or as defendants, but if at any time the presence of the mortgagees is necessary, as, for instance, if an account has to be taken, the defendants may apply to make them parties to the action (a). In the case cited, the mortgagee was not registered as proprietor, but it seems (though the point was not decided) that such registration of the mortgagee would not have affected the mortgagor's right to sue alone (b).

But no cause is to be defeated by reason of the mis-joinder or non-joinder of parties, and the court may in every cause deal with the matter in controversy so far as regards the rights and interests of the parties actually before it; and the court or a judge may order that the names of any parties improperly joined be struck out, and that the names of any parties, whether plaintiffs or defendants, who ought to have been joined, or whose presence before the court may be necessary in order to enable the court effectually and completely to adjudicate upon and settle all the questions involved in the cause, be added (c). If the judge thinks the action is defective for want of parties, it is his duty under this rule to join the necessary parties himself (d). But the maker of an infringing machine cannot claim under this rule to be added as a defendant in an action against the user (e).

Where, during the progress of a trial, it appeared that the plaintiff's rights had been transferred to a company before action brought, leave to add the company as plaintiffs was allowed, but with a right to the defendant, if he thought fit, to have the trial postponed, although the fact of the transfer was known to the defendant when he put in his defence (f).

But where the defendants had pleaded that they had not been concerned in any infringement since the assignment of the patent to the present plaintiffs, leave at the trial to add as co-plaintiffs the predecessors in title of the plaintiffs was refused (g).

(y) *Westhead v. Keene*, 1 Bex. 287, 295; *Hindmarch on Patents*, p. 308.

(z) *Bergmann v. McMillan*, 17 Ch. D. 423.

(a) *Van Gelder, etc. Co., v. Sowerby Bridge, etc. Society*, 44 Ch. D. 374; 7 R. P. C. 208.

(b) *Ibid.*

(c) S. C. R. 1883, Order XVI. r. 11.

(d) *Van Gelder v. Sowerby*, *ubi supra*.

(e) *Moser v. Marsden*, [1892] 1 Ch. 487.

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

(g) *Nobels Explosives Co. v. Jones*, 42 L. T. (N.S.) 754.

Where defendants, while the action was pending, assigned their business, and then obtained an order in chambers adding their assignees as defendants, such order was, on the application of the plaintiffs, discharged as irregular (*h*). Ss. 28—32.
Legal Proceedings.

If the letters patent are vested in trustees for any persons the trustees may sue alone, but the court or a judge may at any stage of the proceedings order any of such persons to be made parties (*i*). Patent vested in trustees.

A patentee who has granted simple licences to work the invention may of course sue alone to restrain infringement, without bringing his licensees before the court, for since the patentee may grant licences to whom he pleases, no injury is done to a licensee by infringement being permitted (*j*). Where simple licences granted patentee can sue alone.

An exclusive licence may in effect amount to an assignment of the whole interest in a patent, but in general a power of revocation, in the event of breach of covenant, is reserved to the patentee. In virtue of this dominion over the patent it would seem that a patentee who has granted an exclusive licence may sue to restrain infringement without bringing his licensee before the court. The injury done by the infringement to the patentee is distinct from that done to the licensee. The latter suffers by the direct competition with his trade, the former by the injury to the reputation of the patent, through infringement being permitted, and the consequent difficulty of restraining such infringement whenever the dominion is resumed, and also (where the exclusive licence is granted in consideration of royalties reserved) by the diminished returns which, from the interference with the licensee's trade, are made to the patentee. It would seem, therefore, that a patentee who has granted an exclusive licence ought to be allowed to sue to restrain infringement without bringing his licensee before the court. The point has not been actually decided, but it is believed that such a form of action is quite usual. Right of patentee where exclusive licence granted.

Where a patent has been assigned to two persons as tenants in common, there is a joint right of action in the two assignees, and in the event of the death of either it descends to the survivor, who may sue and recover damages for an infringement committed during the joint lives (*k*). Assignees tenants in common.

Where several heads of invention are included in one patent, the assignee of a distinct and severable part of the invention may sue alone Assignee of distinct and

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

(*i*) S. C. R. 1883, Order XVI. r. 8.

(*j*) See *Newby v. Harrison*, before Lord CAMPBELL, cited in *Renard v. Levinstein*, 2 H. & M. 628.

(*k*) *Smith v. London and North-Western Rail. Co.*, 2 E. & B. 69 ; S. C. Macr. P. C. 207.

§s. 28—32. for damages for infringement of that part of the patent without joining the persons interested in the other parts (l).]

Legal Proceedings. In *Walton v. Lavater* (m), the defendant, the original patentee, assigned a moiety of the patent right to the plaintiff, who ultimately became entitled to the other moiety, and then sued the defendant for infringing the patent. One of the grounds of defence was that the thing granted by the letters patent was one and indivisible, and that under the above-mentioned circumstances the patent right remained in the patentee, though he had no beneficial interest, and that the plaintiff, therefore, had no right to sue. But it was held that the assignment of the moiety passed an interest in the patent, and that the plaintiff, having acquired the other moiety, had the whole right in him, and could therefore sustain the action.

This decision, it will be observed, does not decide anything as to the right of the assignee of a share in letters patent for a single invention which is not separable into parts to sue alone, but in *Smith v. London and North Western Rail. Co.* (n), where the right of the survivor of two persons to whom the patent had been assigned as tenants in common to sue at law for the whole damages was established, the ground of the decision was that if one of the assignees had not died the action must have been brought by both (o); and in *Bergmann v. McMillan* (p), it was held by FRY, J., that when an assignment is made of a share of profits arising from the working of a patent by licences, although the assignee is entitled to an account from the licensee, it must be taken, once for all, in the presence of all the parties interested, otherwise the account might have to be repeated at the instance of each of the other assignees of shares. On the other hand, it was held by MALINS, V.-C., in *Sheehan v. Great Eastern Rail. Co.* (q), that one of several co-owners of a patent could sue alone without making the other co-owners parties.

A mere licensee, having a simple licence to work the patented invention, cannot sue alone to restrain infringement, because, since the patentee may grant a licence to other persons besides the plaintiff, and therefore to the defendant, the infringement is not an injury to the plaintiff but to the patentee (r), and this seems to have been admitted

(l) *Dunnioliff v. Mallett*, 7 C. B. (N.S.) 209.

(m) 8 C. B. (N.S.) 184.

(n) *Macr. P. C.* 203.

(o) See remarks of JESSEL, M. R., in *Powell v. Head*, 12 Ch. D. (a copyright case) 686; and *Anderson v. Patent Oxonite Co.*, 3 R. P. C. 279.

(p) 17 Ch. D. 427.

(q) 16 Ch. D. 59, following the analogy of *Dant v. Turpin*, 2 J. & H. 139, a case of two owners of the same trade-mark. See also Lindley on Partnership, 6th ed., p. 36; *Davenport v. Richards*, 3 L. T. (N.S.) 503.

(r) *Newby v. Harrison*, before Lord CAMPBELL, C., cited in the judgment in *Renard v. Levinstein*,

in the case of *Renard v. Levinstein*, cited below. Nor can a person to whom foreign owners of an English patent, not assigned to him, have given the sole agency and control of the working of the patent in England, maintain an action against infringers (s). §s. 28—32.
—
Legal Proceedings.

But in *Renard v. Levinstein* (t), it was held that an exclusive licensee may sue alone, at all events if he bring the owner of the patent before the court as a defendant. In that case a suit to restrain infringement was brought by owners of a patent and persons to whom they had granted an exclusive licence. After the institution of the suit, the owners assigned the patent to third parties, and an unsuccessful attempt having been made to add the latter as co-plaintiffs, they were made defendants. It was objected that the plaintiffs had no right to sue, but the objection was overruled by Lord HATHERLEY, then Vice-Chancellor. Actions by
exclusive
licensee.

However, in the course of the litigation which followed the establishment of the validity of the roller skate patent (u), where the practice of the patentee was to grant exclusive licences for particular districts in consideration of a lump sum, and an agreement by the licensees to purchase skates from the patentee at a particular price, JESSEL, M.R., intimated an opinion that it was the safest course to join the patentee as a co-plaintiff with the licensee in an action to restrain infringement within the licensee's district, and this course was followed in all the actions. See the title to the consolidation order in *Plimpton v. Spiller*, Appendix, post, p. 598 (v). And in *Heap v. Hartley* (x), it was held by the Court of Appeal that a mere exclusive licensee, not being a grantee of the patent for a limited period or a limited space, cannot sue without joining the patentee.

As to the effect of the requirement of registration on the right to sue, see post, s. 87.

The person by whom a patent has been infringed will, of course, be a defendant to the action, but it is not necessary to include as defendants workmen or others by whom the actual infringement is committed. The master is responsible for the acts of his workmen, even though he may have given them general directions not to violate a particular patent (y), and the common form of injunction against the master restrains the repetition of the infringement by him, his servants, agents, or workmen (z). Defendants
to action for
infringement.

2 H. & M. 628. See also *Derosne v. Fairie*, 1 Webst. P. C. 155; Webster's Law and Practice of Letters Patent, pp. 24, 30.

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

(t) 2 H. & M. 633.

(u) *Plimpton v. Malcolmson*, 3 Ch. D. 531.

(v) See also *Barnett v. Barrett's Screw Stopper Bottling Co.*, 1 R. P. C. 9.

(x) 42 Ch. D. 461; 6 R. P. C. 496.

(y) *Betts v. De Vitre*, L. R. 3 Ch. 442.

(z) Seton, p. 548.

Ss. 28—32.

*Legal
Proceedings.*

But anybody who takes part in a wrong of this description is liable to be restrained from committing the wrong, and therefore an agent infringing a patent may be made a defendant to the action, and personally and individually be made to pay the costs of it, and it is no justification for him to say that his master ordered him to do it (c).

The master of a ship is not a mere agent; he has a possession of a particular nature, and he may be sued as a principal (b).

And where there was a patent for the construction of fancy rollers for carding machines by attaching strips of card at intervals to the periphery of the roller, and a cardmaker, under a contract to clothe the rollers of a carding machine, made and supplied to a manufacturer cards of the ordinary construction, which were fastened on the rollers by a nailer whose trade was separate and distinct from that of the cardmaker, and who was selected by the manufacturer but paid by the cardmaker, and the cards were so nailed that the rollers when covered infringed the patent, it was held that the nailer was the agent, not of the manufacturer, but of the cardmaker, and that the latter was properly sued for infringement (c).

But persons who are only custom-house agents for foreign importers, and not themselves the importers of the goods complained of, and have neither possession nor control over the goods, are not liable to be sued as infringers (d).

Account
against manu-
facturer no
licence to
purchasers
from him.

An account directed against the manufacturer of a patented article does not licence the use of the article in the hands of purchasers from him, and therefore, when a patent was infringed by a manufacturer who sold to others who made use of the article without the licence of the patentee, the latter was entitled to file separate bills against the manufacturer and the user, and might have an account of profits against the manufacturer and damages against the user (e).

Distinct
infringements
by different
persons,
separate
actions
necessary, but
not where one
infringes
several
patents.

If there are distinct invasions of a patent by different persons, there must be separate actions against each infringer (f); but where one person at one time infringes several patents, there is no occasion for distinct actions upon each patent; the infringement of the various patents may be comprehended in one action (g); and where this was not done, and two actions were brought against the same person for infringement of two patents, the plaintiffs were only allowed such costs

(a) *Per* Sir W. P. WOOD, V.-C., *Betts v. De Vitre*, 11 Jur. (N.S.) 11; and see judgment of COTTON, L.J., *Adair v. Young*, 12 Ch. D. 19. See also *Betts v. Neilson*, 6 N. R. 221.

(b) *Adair v. Young*, 12 Ch. D. 19.

(c) *Sykes v. Howarth*, 12 Ch. D. 826.

(d) *Nobel's Explosives Co. v. Jones*, 8 App. Cas. 5.

(e) *Penn v. Bibby*, L. R. 3 Eq. 308.

(f) *Dilly v. Doig*, 2 Ves. 487.

(g) See the decree in *Lister v. Wood*, cited in *Seton on Decrees*, 3rd ed. p. 909.

as they would have been entitled to had they joined both patents in one action (*h*). Ss. 28—32

The manufacturer and users who have bought from him may be included together as defendants in one action (*i*). Where such an action is defended by the manufacturer but not by the user, it cannot be set down against the user alone on motion for judgment on default of pleading (*k*). *Legal Proceedings.*
Manufacturer and users may be sued in one action.

If the action is brought against the user alone, the manufacturer cannot insist on being added as a defendant (*l*). But where an action for infringement was brought against the user to whom an indemnity had been given by the manufacturers, and the user gave notice under the third party procedure (*m*) claiming indemnity, and the manufacturers put in an appearance, it was held that the proper order to be made was that on the manufacturers admitting their liability to indemnify the defendants they should be at liberty to appear at the trial and take such part therein as the judge should direct; and that they should be bound by the decision of the court in the action in any question as to the above indemnity, but not further (*n*).

Foreigners are in all cases subject to the laws of the country in which they may happen to be, and if a foreigner while in England infringes a patent, he may be restrained by injunction (*o*). But the Court has no jurisdiction to interfere with the property of a foreign Sovereign, and therefore, when certain shells made in Germany for the Mikado of Japan in infringement of an English patent were brought to this country to be placed on board a ship belonging to the Mikado of Japan, it was held that the court would not interfere to prevent him removing the shells (*p*). Foreigners infringing.

And where a foreign manufacturer in compliance with an order from an English dealer to send to him by post, sent to the latter under circumstances which the court considered equivalent to sending by post, a packet containing the infringing article, it was held by the House of Lords that the foreigner had done nothing in this country to infringe the patent and the action was dismissed (*q*).

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

(*i*) See *Proctor v. Bennis*, 36 Ch. D. 740.

(*k*) *Actien Gesellschaft für Cartonnagen, etc. v. Remus*, 12 R. P. C. 94.

(*l*) *Mocer v. Marsden*, [1892] 1 Ch. 497.

(*m*) S. C. R., 1883, Order XVI. r. 48.

(*n*) *Edison, etc. Co. v. Holland*, 3 R. P. C. 397.

(*o*) *Caldwell v. Van Vlissingen*, 9 Ha. 415, said by TURNER, L.J., (3 D. J. S. 87; 11 Jur. (N.S.) 680) to have been affirmed on appeal.

(*p*) *Vavasseur v. Krupp*, 9 Ch. D. 352.

(*q*) *Badische Anilin und Soda Fabrik v. Basle Chemical Works, Bindschedler*, [1898] A. C., 200.

Ss. 28—32. A company infringing a patent may, of course, be made defendants to an action, and where the directors actively interfere in the infringement they may be joined as co-defendants, and a decree may be made against them as well as against the company, and they may be ordered personally to pay the costs of the action (*r*).

Legal Proceedings.

Company defendant, directors may be made personally liable.

Threat to infringe sufficient to found action.

A threat to infringe under a claim of right so to do is sufficient to found an action for an injunction, provided, of course, that what is threatened to be done is an infringement; and where a defendant had by his original statement of defence asserted a right and intention to continue the manufacture complained of, and afterwards omitted such assertion from his defence, it was held that the original statement of defence might be used against him as evidence (*s*).

The mere possession of infringing machines is of itself sufficient ground for injunction (*t*).

A defendant may be restrained from selling or using machines piratically made during the patent (*u*).

On the question of infringement the patent is assumed to be good (*x*).

Defendants out of the jurisdiction.

Where in a trade mark case the defendants were a company having their registered office in Scotland with branches in England, leave to serve the writ out of the jurisdiction was given, as an injunction could be enforced by sequestration of the property of the company in England (*y*). But leave will not be given where the injunction can only be enforced against the agent living in England of the Scotch principal (*z*). And so, where the defendant was resident in Ireland and had no business premises or agents in England, and only sold to a small extent to customers in England, it was held, having regard to Order XI., r. 2, that the action ought to have been brought in Ireland, and an order for service out of the jurisdiction was set aside as irregular (*a*).

Consignees may be made parties to an action against a steamship company which has brought infringing goods into this country, and if living out of the jurisdiction an order may properly be made for serving them out of the jurisdiction (*b*).

(*r*). *Betts v. De Vitre*, 11 Jur. (N.S.) 9, affirmed L. R. 3 Ch. 442; *Spencer v. The Ancoats Vale Rubber Co.*, 6 R. P. C. 46.

(*s*) *Frearson v. Loc*, 9 Ch. D. 66.

(*t*) *United Telephone Co. v. London and Globe Telephone Co.*, 26 Ch. D. 766.

(*u*) *Crossley v. Beverley*, 1 Webst. 119; *Crossley & Derby Gas Light Co.*, *ibid.*

(*x*) *Muntz v. Foster*, 2 Webst. P. C. 99.

(*y*) *Burland v. Broxburn Oil Co.* 41 Ch. D. 542.

(*z*) *Marshall v. Marshall*, 38 Ch. D. 330.

(*a*) *Kinahan v. Kinahan*, 45 Ch. D. 78.

(*b*) *Washburn and Moen, etc. Co. v. Cunard Co.*, 6 R. P. C. 398.

Service on the managing director, resident in England, of a company whose registered office is in Scotland or Ireland will be set aside as irregular (c). But service on the head officer at the place of business in England of a foreign corporation carrying on business in England is good service (d); and a foreign or colonial firm which carries on business in England may be sued in the firm-name under Order XLVIII A, r. 1, without leave, although its members are resident out of England (e), and it would seem that r. 3 of the same order enables service to be made at the firm's principal place of business in England on the person in control of the business there (f).

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Where plaintiffs proved a *prima facie* case of a sale within this country by a foreign manufacturer residing abroad, leave was given to issue a concurrent writ and to serve notice thereof on the foreigner out of the jurisdiction (g).

Where there are several actions on the same patent against different infringers, they may be consolidated so that the validity of the patent, and any other questions common to all the actions, may be tried once for all in one action (h); and by S. C. R. 1883, Order XLIX. r. 8, re-enacting Order LL. r. 4, of the Judicature Rules, actions are to be consolidated in the manner in use before the Judicature Act in the superior courts of common law.

Consolidation
of actions
against
different
infringers.

At common law actions could only be consolidated at the instance of defendants (i), and this is now the rule under the above order (k). Nor could the plaintiff, according to the practice at common law, be bound without his consent by the result of the one action tried, and he might, after a verdict against him in one action, proceed with any of the others (l).

The order in *Foxwell v. Webster* was binding upon the plaintiff as well as the defendants (m), but it would appear from the report (n) that the order was the subject of arrangement; and now that the practice at common law is to be followed in these cases, it would seem that the

(c) *Wood v. Anderston Foundry Co.*, 36 W. R. 918; *Watkins v. Scottish Imperial Insurance Co.*, 23 Q. B. D. 285.

(d) *Newby v. Van Oppen*, L. R. 7 Q. B. 293; *Haggin v. Comptoir d'Escompte de Paris*, 23 Q. B. D. 519.

(e) *Worcester, etc., Co. v. Firbank*, [1894] 1 Q. B. 784.

(f) *Ibid.*

(g) *Badische Anilin und Soda Fabrik v. Johnson*, [1896] 1 Ch. 25, and see also *Tozier v. Hawkins*, 15

Q. B. D. 650, 680. In the first cited case it was afterwards held that the foreigner had done no wrongful act within the jurisdiction, [1898] A. C. 200.

(h) *Foxwell v. Webster*, 4 D. J. S. 77.

(i) Lush's Practice, 3rd ed., p. 965.

(k) *Amos v. Chadwick*, 4 Ch. D. 869.

(l) Lush's Practice, cited above.

(m) See the order in Seton, p. 556.

(n) 4 D. J. S. 83.

Ss. 28—32 order for consolidation should, if made adversely, be framed so as only to bind the defendants (o).

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At common law, it was held that the consolidation order could be made as soon as the defendants had appeared, and before declaration (p); but in *Foxwell v. Webster*, on an application by defendants for consolidation, it was held that no consolidation order could be made until the defendants had given discovery by answer (q), and on appeal it was, at the suggestion of Lord WESTBURY, C., arranged that the defendants should file affidavits stating their objections to the validity of the patent, and giving full information of every combination of machine made, sold, or used by them, and whence obtained and when used, and undertaking to pay plaintiff royalty in case plaintiff should succeed; the defendants also to furnish verified models of every machine made. On these terms the application was to stand over, no proceedings to be taken in the meantime; but his lordship remarked that in so restraining the plaintiff he was greatly stretching the power of the court (r).

Where, by a consolidation order, the defendants in several actions, who all appeared by the same attorneys, bound themselves to abide by the result of a trial in one, and the plaintiff having succeeded in that action, the particular defendant therein neglected to prosecute an appeal, it was held that a defendant in one of the other actions had no equity to be allowed to carry the case to a superior court (s).

And where in a test action the defendant did not appear, and after formal evidence had been adduced judgment was given for the plaintiffs, an application by the defendant in another action, who had agreed to be bound by the test action, that no steps should be taken on the judgment until he had had an opportunity of moving to set aside this judgment and proceed to trial in the test action was refused (t).

It is therefore desirable in consolidation orders to provide for the case of submission by the defendant in the test action (tt).

But although actions can only be consolidated at the instance of defendants, the court will, where several actions have been brought by different plaintiffs against the same defendants, make an order upon the application of the plaintiffs enlarging the time for taking the

(o) See the orders in *Bovill v. Ainscough*, *Plimpton v. Spiller*, and *Johnasson v. Palgrave* in the Appendix, *post*, p. 596.

(p) Lush's Practice, 3rd ed., 965.

(q) *Foxwell v. Webster*, 2 Dr. & Sm. 250.

(r) *Foxwell v. Webster*, 4 D. J. S.

82. See the order in *Bovill v. Ainscough* in the Appendix, *post*, p. 596.

(s) *Thomas v. Winter*, 17 L. T. (N.S.) 148.

(t) *Edison United Phonograph Co. v. Young*, 11 R. P. C. 489.

(tt) See the orders in *Plimpton v. Spiller* and *Johnasson v. Palgrave*, in the Appendix, *post*, pp. 598, 599.

next step in several of the actions, and staying proceedings therein till after one has been tried as a test action (u). Ss. 28--31.

If, however, the original test action fails to be a real trial of the issue between the plaintiffs and the defendants, the court may substitute another of the actions as the test action (x). Legal Proceedings.

An action for infringement of patent cannot be brought in a county court; the grant of letters patent is a franchise which is excepted from the jurisdiction given by the County Courts Act, 1888 (y).

In addition to the remedies by injunction and account of profits or damages (see s. 30), the court may, on making a final decree in favour of a patentee, direct an inquiry as to what articles made in infringement of the patent are in the possession of the defendant, and may order such articles to be destroyed in the presence of the plaintiff (z). But if the several parts of the machine may be innocently used for other purposes, it would seem that the proper course is not to order the destruction of the machines, but to order them to be marked so as to prevent the various parts from being afterwards used so as to continue the infringement (a). Destruction or delivery up of infringing articles.

And when certain lawn tennis racquets had been stamped with a word which the court held was likely to deceive, an injunction was granted, and it was ordered that the racquets should be delivered up to be destroyed, or, in the alternative, that the word complained of should be erased in the presence of the plaintiff (b).

Instead of ordering the destruction or marking of the articles made in infringement of the patent, they may be ordered to be delivered up to the plaintiff (c), or the court may make an order in the alternative for delivery up or destruction of the articles complained of (d), or the

(u) *Amos v. Chadwick*, 4 Ch. D. 869; *Bennett v. Lord Bury*, 5 C.P.D. 339.

(x) *Amos v. Chadwick*, 9 Ch. D. 459. The order in *Plimpton v. Spiller* (see Appendix, post), provides for this event. See also the order in *Bennett v. Lord Bury*, 5 C. P. D. 310.

(y) *R. v. County Court Judge of Halifax*, 1891, 1 Q. B. 793; 1891, 2 Q. B. 263; 8 R. P. C. 338. See also *Cameron v. Gray*, 6 T. R. 363; *Higgins' Digest*, 353.

(z) *Betts v. De Vitre*, 34 L. J. Ch. 289, 291; S. C., 11 Jur. (N.S.) 9, 217; *Seton*, p. 566; *Emperor of Austria v. Day*, 3 D. F. J., 217.

(a) *Needham v. Orley*, 3 L. T. (N.S.) 604; *Pemberton*, p. 485. See also order in *Westinghouse v. Lancashire and Yorkshire Rail. Co.*, 1 R. P. C. 253; *United Telephone Co. v. London and Globe Telephone Co.*, 26 Ch. D. 766; *Automatic Weighing Co. v. Fearby*, 10 R. P. C. 442, 447.

(b) *Slazenger v. Feltham* (2), 6 R. P. C. 531.

(c) *Tangye v. Stett*, 14 W. R. 386; *Young v. Fernie*, *Pemberton*, p. 484; *Washburn and Moen Manufacturing Co. v. Patterson*, 1 R. P. C. 158, 162. See also *ibid.* 191.

(d) *Plimpton v. Malcolmson*, *Seton*, p. 565; *Badische Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. 176.

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matter may be reserved for further consideration when the account of profits shall have been taken (e). In *Edison Bell, etc. Co. v. Smith* (f) it was ordered by the Court of Appeal that the infringing parts should be removed in the presence of both parties, and delivered up. And where plaintiff sued on two patents for making barbed wire fencing, the defendants were ordered to give up not only the infringing machines, but also the barbed wire in their possession made thereby (g).

The order ought to fix a time within which the machines or articles are to be given up (h). And the defendant may be ordered to specify by affidavit what infringing articles are in his possession (i).

Hearing with
assessor

28.—(1.) In an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance; the action shall be tried without a jury unless the Court shall otherwise direct.

(2.) The Court of Appeal or the Judicial Committee of the Privy Council may, if they see fit, in any proceeding before them respectively, call in the aid of an assessor as aforesaid.

(3.) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal or Judicial Committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act.

This section removes the difficulty raised by the case of *Sugg v. Silber* (k), when a trial with assessors was refused, and it was held that there was no power under the Judicature Rules in a patent action brought in the Common Law Division to deprive the defendant of his right to a jury. In the Chancery Division an adverse order might be made for trial without a jury, since a patent action was before the Judicature Acts an action which, "without any consent of parties,

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

(f) 11 R. P. C. 389, 406, and see p. 395, *Howes v. Webber*, 12 R. P. C. 465.

(g) *Washburn and Moen Manufacturing Co. v. Patterson*, ubi supra.

(h) *Washburn and Moen Manufacturing Co. v. Patterson*, 1 R. P. C. 191; *Otto v. Steel*, 3 R. P. C. 109, 120.

(i) *Tangye v. Stott*, Seton, 565.

(k) 1 Q. B. D. 362.

could be tried without a jury" (l). (See Order XXXVI. r. 26, of the Judicature Rules, re-enacted in Order XXXVI. r. 4, S. C. R. 1883.) The section, it will be observed, relates only to the trial of the action.

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NOTE.

The section has been acted on in Scotland, and patent actions have been tried by judges with the aid of assessors (m).

By Lord Cairns' Act (n), the Court of Chancery was empowered to order questions of fact to be tried by a jury before the court itself, or before the court itself without a jury; and by Sir John Rolt's Act (o) the Court of Chancery was required to determine every question of law or fact arising in the cause on the determination of which the plaintiff's title to relief depended. Issues.

Under these Acts the practice arose in the Court of Chancery of directing in patent cases the trial of certain issues involving the validity of the patent and the question of infringement, and these issues were tried sometimes before a judge without a jury, and sometimes before a judge with a jury. These Acts are now repealed (p), but the jurisdiction thereby established is not affected by the repeal (q). And by the Arbitration Act, 1889 (r), repealing and re-enacting with variations s. 57 of the Judicature Act, 1873, the court may, in any cause or matter requiring scientific or local investigation, which cannot, in the opinion of the court or a judge, be conveniently made before a jury, or conducted by the court through its other ordinary officers (and a patent action was held to be an action requiring scientific investigation within the meaning of the repealed section) (s), order any question or issue of fact to be tried before a special referee or arbitrator or an official referee or officer of the court, and by Order XXXVI. r. 5, S. C. R. 1883, the court or a judge may order a trial without a jury of any cause, matter, or issue, requiring any prolonged examination of documents or accounts, or any scientific or local examination which cannot, in their or his opinion, be conveniently made with a jury. Further, a proviso at the end of rule 7 (a) of the same order empowers the court or a judge at any time to order any cause, matter, or issue, to be tried by a judge with a jury, or by a judge sitting with assessors, or by an official referee or a

(l) *Patent Marine Inventions Co. v. Chadburn*, L. R. 16 Eq. 447. See also *Swindell v. Birmingham Syndicate*, 3 Ch. D. 327; *Back v. Hay*, 5 Ch. D. 235; *Bordier v. Burrell*, 5 Ch. D. 515; cases under the Judicature Rules.

(m) *United Horsenail Co. v. Stewart*, 2 R. P. C. 122; *Mackie v. Berry*, 2 R. P. C. 146; *Gwynne v. Drysdale*, 2 R. P. C. 160.

(n) 21 & 22 Vict. c. 27.

(o) 25 & 26 Vict. c. 42.

(p) 46 & 47 Vict. c. 49.

(q) *Sayers v. Collier*, 28 Ch. D. 103, 108.

(r) 52 & 53 Vict. c. 49, s. 14.

(s) *Sazby v. Gloucester Wagon Co.*, W. N. 1880, p. 28.

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special referee with or without assessors. Issues may therefore still be granted in patent actions, but the usual practice in such actions is not to apply for issues, but to bring the action on for trial in the ordinary way.

By Order XXXIII. r. 1, S. C. R. 1883, when in any cause or matter it appears to the court or a judge that the issues of fact in dispute are not sufficiently defined, the parties may be directed to prepare issues, and such issues shall, if the parties differ, be settled by the court or a judge. The usual questions of fact which, if issues are directed, are ordered to be tried in an action for infringement of patent, are in substance the following :—

1. Was the patentee the true and first inventor of the invention ?
2. Was the invention new ?
3. Is the specification sufficient ?
4. Has the defendant infringed ?

Other issues may, of course, be added, according to the nature of the defence set up (*t*).

The trial of issues may be directed at any stage of the action (*u*).

When questions of fact were referred for trial under the repealed s. 57 of the Judicature Act, 1873, the particular issues did not need to be specified in the order, but the reference might be in general terms (*x*).

By Order XXXIV. r. 9, S. C. R. 1883, when the parties to a cause or matter are agreed as to the questions of fact to be decided between them, they may, after writ issued and before judgment, by consent and order of the court or a judge, proceed to the trial of any such questions of fact without formal pleadings. If this course be adopted in a patent action, it is presumed that the order for trial will direct the delivery of particulars of breaches and notices of objections, as was done under the old practice, when issues were directed by the Court of Chancery under Sir J. Rolt's Act and Lord Cairns' Act (*y*). See *post*, s. 29.

Sufficiency of specification treated as question of fact.

The question of the sufficiency of the specification is properly treated as a question of fact, for although the construction of all written instruments belongs to the court alone, the specification of an invention

(*t*) For the technical form of the above issues, and for other issues in patent actions, see Seton, p. 554.

(*u*) S. C. R. 1883, Order XXXVI. r. 7 (*a*). See under the old practice *Henderson v. Runcorn, etc. Co.*, W. N. 1868, p. 250; 19 L. T. (N.S.) 277; *Arnold v. Bradbury*, L. R. 6 Ch. 706.

(*w*) See the order of Sir H. HAWKINS, *Saxby v. Gloucester Wagon Co.*, Appendix, *post*. See also *Curtis v. Platt*, 11 L. T. (N.S.) 250. See, however, now the forms in S. C. R. 1883, Appendix K., No. 33.

(*y*) See the order in *Davenport v. Jepson*, Seton, p. 554; *Bovill v. Bird*, W. N. 1867, p. 96.

contains generally, if not always, some technical terms, some phrases of art, some description of processes, which require the light to be derived from what are called surrounding circumstances, and these are matters of fact on which evidence may be given (z).

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NOTE.

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

The objection that there is a material variance between the provisional and the complete specification may be taken upon the issue that the specification does not completely describe and ascertain the nature of the invention (b). Variance between provisional and complete specification

The issue that the patentee is not the true and first inventor is not the same as the issue that the invention is not new ; "the one objection is applied to the patentee, and shows that he is not a person capable of sustaining such a grant, and the other objection is applied to the invention, and shows that it could not be made the subject of a patent privilege. . . . An invention may be perfectly new to the public, and yet the patentee may not be the true and first inventor. For he may have purloined it from another, or it may have been communicated to him by one of his fellow subjects, in either of which cases he could not be the true inventor" (c). The issue whether the patentee was the true and first inventor ought not to be raised unless the defendant is prepared to support the case that the patentee is not really the inventor, and if taken without real ground the costs will not be allowed (d). Issue of true and first inventor.

A defendant is entitled to have the question of newness of manufacture tried apart from the question of newness of invention (e).

An issue that "the invention is not the subject of letters patent" is not a proper issue (f). Subject-matter.

An issue as to infringement was not directed by the Court of Chancery unless the infringement was denied by the defendants (g), nor was a defendant allowed to add a totally new question of fact not Infringement.

(z) *Hill v. Erans*, 4 D. F. J. 288, 293; *Betts v. Menzies*, 10 H. L. C. 117.

(a) *Plimpton v. Malcolmson*, 3 Ch. D. 531, 536.

(b) *Penn v. Bibby*, L. R. 2 Ch. 127, 130.

(c) Hindmarch on Patents, pp. 268, 269.

(d) *Morgan v. Windover*, 7 R. P. C. 449; *Thomson v. Macdonald*, 8 R. P. C. 5.

(e) *Spencer v. Jack*, 3 D. J. S. 346. See also *Househill Co. v. Neilson*, 1 Webst. 689.

(f) *Penn v. Jack*, 14 W. R. 760.

(g) *Davenport v. Phillips*, 5 N. R. 485.

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suggested by his answer to the questions of fact already directed to be tried. In such a case it was held that a supplemental answer must be filed (*h*).

Patent actions generally not cases for a jury.

“Tried without a jury unless the court otherwise direct.”—In the opinion of eminent judges, patent cases are not, in general, such as to require the intervention of a jury.

Thus, in *Bovill v. Hitchcock* (*i*), Lord CAIRNS, C., expressed an opinion that many patent cases could be disposed of by a judge much more satisfactorily than by a jury.

And in *Patent Marine Inventions Co. v. Chadburn* (*k*), Lord SELBORNE, C., when refusing an application for a trial by a jury of issues in a patent case, said, “It is to be observed that such cases almost always involve questions of law and fact, not only mixed, but mixed in such a way as to render the extrication of them extremely difficult; secondly, that very often much must depend upon the construction of documents, as to which a jury must take their direction entirely from the judge; thirdly, that much of the evidence, or that which is to be permitted to be given as evidence in such cases, is argumentative and relative to matters of opinion, so as to make it extremely hard, even for the judge himself, to keep it under proper control; and, lastly, that even the questions of fact are often, to a very great extent, questions of science, which, to say the least, are as likely to be as well decided by a judge as by any jury. It very rarely happens, if it ever does, that in such cases the practical work is not done by the judge. It very rarely happens, if ever it does, when the thing is not reduced to a narrow question of fact, that the jury do not simply follow, after a very elaborate discussion of the case by the judge, the direction of the judge” (*l*).

Issues to a jury, when granted and when refused.

Before directing an issue to be tried by a jury, the court must be satisfied by evidence that there is a real question to try (*m*). And in the case of *Henderson v. The Runcorn Soap and Alkali Co.* (*n*), Sir GEO. GIFFARD, V.-C., said that he would never grant a trial of issues at the request of a defendant when the motion was opposed by the plaintiffs; and in *Roskell v. Whitworth* (*o*), it was held by the same learned judge, then Lord Justice, that though there was no inflexible rule as to the

(*h*) *Morgan v. Fuller* (1), L. R. 2 Eq. 296.

(*i*) L. R. 3 Ch. 417. See also *Young v. Fernie*, 1 D. J. S. 353; *Saxby v. Gloucester Wagon Co.*, W. N. 1880, p. 28; *Downes v. Hughes & Co.*, 69 L. T. 150.

(*k*) L. R. 16 Eq. 447.

(*l*) See also observations of COCKBURN, C.J., in *Sugg v. Silber*, 1 Q. B. D. 362.

(*m*) *Davenport v. Phillips*, 5 N. R. 485.

(*n*) W. N. 1868, p. 250; 19 L. T. (N.S.) 377.

(*o*) L. R. 5 Ch. 459.

stage of a cause at which issues would, on the application of a defendant, be directed to be tried by a jury, the court would require strong proof that the case was one which it could not satisfactorily try if the defendant made the application, not on the occasion of a motion for injunction, or a motion to dissolve an injunction, but by an independent motion at any other time, and especially if it was after the disclosure of the plaintiff's evidence.

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NOTE.

Where a patent had been the subject of previous proceedings, and on one occasion a trial had been before a jury, and the plaintiffs were nonsuited on the ground of the insufficiency of the specification, but ultimately the court above held the specification good, and ordered the verdict to be entered for the plaintiffs, who then signed judgment and obtained a decree; and on a second occasion, in an action against another defendant, the jury disagreed; and in a subsequent action against the same defendant he did not appear, and a verdict was taken for the plaintiffs, and afterwards a decree was made in their favour,—Sir W. P. WOOD, V.-C., in a suit against a third defendant who desired to contest over again all the points raised in the preceding actions, refused a reference to a jury (*p*).

But in the same case it was held that if there were a really doubtful question at issue, the court would not decide it for itself if either party desired a jury.

Where in a suit to restrain infringement of a patent the plaintiff opened his case by stating that he should prove certain fraudulent acts on the part of the defendant, and the defendant's counsel stated that these charges were not raised by the pleadings, and asked to have the case tried by a jury, a trial by jury was ordered, and the cause was directed to stand over for that purpose (*q*).

Where a patent had been repeatedly established in previous litigation against other defendants, Lord ROMILLY, M. R., being satisfied at the hearing of the sufficiency of the specification, the utility of the invention, and the fact of infringement, granted an injunction to restrain the defendant from infringing the patent, but directed an issue as to the novelty of the invention to be tried before a jury (*r*).

The circumstance that, as a matter of fact, a patent case arising in the Court of Chancery was, before Lord Cairns' Act (*s*) and Sir John Rolt's Act (*t*), tried by a jury, did not, after the passing of those Acts, enable either party to insist on its then being so tried. The Court of Chancery did not require the legal question to be tried by a jury.

(*p*) *Davenport v. Goldberg*, 2 H. & M. 282. 195; and see S. C. R. 1883, Ord. XXXVI. r. 8.

(*q*) *Tangye v. Stott*, 14 W. R. 128. (*s*) 21 & 22 Vict. c. 27.

(*r*) *Bovill v. Goodier*, L. R. 2 Eq. (*t*) 25 & 26 Vict. c. 42.

Sect. 28. "What it required was the judgment of a Court of Common Law. In most cases it was a necessary incident to proceedings at law that there should be the verdict of a jury before judgment; but these cases were sent to law, not that they might be tried by a jury, but because the court had no jurisdiction to decide upon legal rights" (*p*).

NOTE.

Under s. 2 of Sir John Rolt's Act, which empowered the court to send issues to the assizes whenever it should appear that any question of fact might be more conveniently tried by a jury, it was held that this power was not to be exercised unless the court was satisfied that the administration of justice in the particular suit would be more conveniently promoted by sending issues to be so tried (*q*).

By s. 29 of the Judicature Act, 1873, any party to any cause or matter involving the trial of a question or issue of fact, or partly of fact and partly of law, may, with the leave of the judge or judges to whose division the cause or matter is assigned, require the question or issues to be tried at the assizes or at the sittings in London or Middlesex. See also S. C. R. 1883, Order XXXVI. r. 44.

Where under Order XXXVI. r. 1, S. C. R. 1883, in an action for infringement brought in the Chancery Division, a place of trial out of Middlesex was named in the statement of claim, and at the assizes for that place the parties were ready for the trial, it was held that notwithstanding Order XXXVI. r. 34, the judge at the assizes had no power to send the case back to the judge of the Chancery Division merely because there was no time to try it at the assizes (*r*).

Trial by jury cannot be had before a judge of the Chancery Division (*s*).

By Order XXXIV. r. 2, S. C. R. 1883, if it appear to the court or a judge that there is in any cause or matter a question of law which it would be convenient to have decided before any evidence is given or any question or issue of fact is tried, or before any reference is made to a referee or an arbitrator, the court or judge may make an order accordingly, and may direct such question of law to be raised for the opinion of the court, either by special case or in such other manner as the court or judge may deem expedient, and all such further proceedings as the decision of such question of law may render unnecessary may thereupon be stayed.

By Order XXXVI. r. 8, of the same Rules, the court or a judge may in any cause or matter, at any time or from time to time, order that different questions of fact arising therein be tried by different

(*p*) *Per* Lord CAIRNS, C., L. R. 3 Ch. 419.

(*q*) *Young v. Fernie*, 1 D. J. & S. 353.

(*r*) *Fairburn v. Household*, 2 R. P. C. 195.

(*s*) *Warner v. Murdoch*, 4 Ch. D. 750.

modes of trial, or that one or more questions of fact be tried before the others, and may appoint the places for such trials and in all cases may order that one or more issues of fact be tried before any other or others.

The first of the two rules last above stated was said by JESSEL, M.R., in *The Republic of Bolivia v. The National Bolivian Navigation Co.*, to be intended for cases where the judge saw his way to the final determination of the action; for example, the question of the sufficiency of the specification in a patent case might be tried without any evidence at all, as where it is alleged that the specification is ambiguous or vague(t). But except in such a case as this, or in a case like *Bovill v. Goodier*, cited above, it is in general an inconvenient course to try the issues in a patent case separately, and before different tribunals(u).

An order will not be made for trying the question of infringement by itself unless the validity of the patent is admitted; and a qualified admission of the validity is not sufficient(x).

Where several users were alleged in anticipation of a patent, the court at the trial disposed of all the evidence on one of the alleged users before going into the others(y).

So also where in the cross-examination of the plaintiff, who was the first witness, an article was shown to him, the use of which his counsel admitted would, if proved, be an anticipation sufficient to invalidate the patent, the defendant was allowed to call a witness to prove the prior user of the article, and the action was dismissed(z).

If the court below has decided that the case can be satisfactorily tried in any particular mode, the Court of Appeal is exceedingly disinclined to interfere with that decision(a).

And where a judge had, under s. 57 of the Judicature Act, 1873(b), referred a question of fact in a patent action to the official referee, the Court of Appeal refused to interfere with his discretion(c).

By the Arbitration Act, 1889, ss. 13 and 26, repealing and re-enacting with variations s. 56 of the Judicature Act, 1873, any question arising in a cause may be referred for inquiry and report to an official or

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(t) 24 W. R. 362.

(u) See judgment of Lord WESTBURY, C., in *Young v. Fernie*, 1 D. J. & S. 355.(x) *United Telephone Co. v. Mottishead*, 3 R. P. C. 213.(y) *Richardson v. Castrey*, 4 R. P. C. 265.(z) *Badham v. Bird*, 5 R. P. C. 238.(a) *Bovill v. Hitchcock*, L. R. 3 Ch. 419; *Williams v. Guest*, L. R. 10 Ch. 467; *Brooke v. Wigg*, 8 Ch. D. 510, 517; *Ruston v. Tobin*, 10 Ch. D. 558; *Wharton v. Boffin*, W. N. 1883, p. 97.

(b) Now repealed and re-enacted with variations by the Arbitration Act, 1889. See s. 14.

(c) *Saxby v. Gloucester Wagon Co.*, W. N. 1880, p. 28.

Court of Appeal will not in general interfere with court below as to mode of trial.

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special referee, and the report of any such referee may be adopted wholly or partially by the court (d).

NOTE.

This provision was acted on by PEARSON, J., in *Badische Anilin und Soda Fabrik v. Levinstein* (e), where certain experiments were directed to be performed by a special referee for the purpose of advising the court; and by the Court of Appeal, in *Moore v. Bennett* (f), where the referee was appointed to examine and report on the defendant's machine, and directions were given for the machine to be worked in a particular manner.

Where issues have been tried, the plaintiff may at once set down a motion for judgment as soon as the issues have been determined; and where some only of the issues have been tried or determined, any party who considers that the result renders the trial or determination of the others unnecessary, or renders it desirable that such trial or determination should be postponed, may apply to the court for leave to set down a motion for judgment without waiting for such trial or determination. And the court may give such leave upon such terms as may appear just (g).

Where issues disposing of the whole question in the suit had been directed, and the cause was in the paper for hearing immediately after the trial of the issues, the court made a decree in the suit, but directed it not to be drawn up till the time for moving for a new trial had expired (h); but if a motion for a new trial was refused, the injunction was at once granted (i).

Applications for new trials, whether the action has been tried with a jury (k), or without a jury (l), must be made to the Court of Appeal.

Upon motion for new trial the Court of Appeal would not consider whether the finding was proper, but merely whether there was sufficient evidence to warrant the verdict (m).

And if the motion were grounded on the improper rejection of evidence, the evidence ought to have been formally tendered to the judge of the court below, and rejected by him (n). And see now S. C. R. 1883, Order XXXIX. rr. 6, 7, and 8.

Where the jury found two claims of a specification to be old and a third one new, and on the question of infringement found that the

(d) See now S. C. R. 1883, Order XXXVI. r. 55.

(e) 24 Ch. D. 156.

(f) 1 R. P. C. 129. See the Order, p. 133. See also *Edison Co. v. Holland*, 5 R. P. C. 459, 480; *North British Rubber Co. v. Macintosh*, 11 R. P. C. 477.

(g) S. C. R. 1883, Order XL. rr. 7, 8.

(h) *Macdougall v. General Sewage and Manure Co.*, W. N. 1875, 64; following *Fernie v. Young*, L. R. 1 H. L. 63, 84.

(i) *Tangye v. Stott*, 14 W. R. 387.

(k) 53 & 54 Vict. c. 44, s. 1.

(l) S. C. R. 1883, Order XXXIX. r. 1.

(m) *Penn v. Bibby*, L. R. 2 Ch. 127.

(n) *Penn v. Bibby*, *ubi supra*.

defendant had not infringed this latter claim, a new trial of the question of infringement was refused, on the ground that there must in any case be judgment in the action for the defendant, and that the issue of infringement had become immaterial (*o*).

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Where, after verdict for plaintiff, the court, on an application for a new trial, was of opinion that the plaintiff ought to have been nonsuited, a new trial was only granted upon the terms that the costs of the new trial should be costs in the cause if the defendant obtained a verdict finally, but should not be costs in the cause if the plaintiff obtained a verdict (*p*).

By S. C. R. 1883, Order XXVII. r. 11, if the defendant makes default in pleading, the plaintiff may set down the action on motion for judgment, and such judgment is to be given as upon the statement of claim the court or a judge may consider the plaintiff entitled to. In such a case, particulars of breaches are to be considered part of the statement of claim (*q*).

If the defendant elects to ask for judgment at the close of the plaintiff's case, and the court considers he is entitled to it, the court is bound to give him that judgment, he running the risk of a new trial in the event of the decision being held to be wrong (*r*). See *post*, p. 158.

On a trial of questions of fact under Lord Cairns' Act, the Court of Appeals. Appeal had no power to reverse the findings of the judge on the questions of fact, but could only direct a new trial (*s*). Where, however, the issues raised mixed questions of law and fact, then, if the decision of one of the questions discussed was sufficient to dispose of the case, the Court of Appeal might give a final judgment upon it; and, therefore, when the fact which in the judgment of the Court of Appeal showed the invalidity of the patent was proved and not denied by the patentee, it was held that the Court of Appeal was justified in deciding against the patent, without ordering a new trial (*t*). And now, by S. C. R. 1883, Order LVIII. r. 5, if, upon the hearing of an appeal, it shall appear to the Court of Appeal that a new trial ought to be had, the Court of Appeal may, if it shall think fit, order that the verdict and judgment shall be set aside, and that a new trial shall be had. And

(*o*) *Westinghouse v. Lancashire and Yorkshire Rail. Co.*, 1 R. P. C. 229.

R.P.C. 5; *Fairfax v. Lyons*, 8 R.P.C. 401, 406.

(*p*) *Derosne v. Fairie*, 1 Webst. P. C. 160.

(*s*) *Simpson v. Holliday*, L. R. 1 H. L. 315.

(*q*) *United Telephone Co. v. Smith*, 38 W. R. 70.

(*t*) *Simpson v. Holliday*, cited above. See also *Westinghouse v. Lancashire and Yorkshire Rail. Co.*

(*r*) *Thomson v. Macdonald*, 8

1 R. P. C. 229.

Sect. 28. by r. 4 of the same order very full powers of dealing with the case are given to the Court of Appeal.

NOTE.

Where the issues are settled at the commencement of the trial, then, whether the judge delivers his finding on the facts and his judgment on the whole case on separate days or at one time, his finding of fact is an interlocutory order, which, under the Judicature Rules, Order LVIII. r. 15 (*u*), can only be appealed within a limited time. But if no definite issues of facts are settled at the commencement of the trial, the finding of fact, as well as the judgment on the whole case, can be appealed as a final order (*x*).

Where, under Lord Cairns' Act, questions of fact were tried before the judge without a jury, the verdict of the judge was conclusive, and could only be questioned by application for a new trial, as provided by the Act ; and when this course had not been pursued, but the defendants in a patent suit appealed from a decree made against them, founded on a verdict of the judge on a trial of questions of fact, it was held by the House of Lords that, as the decree merely stated the finding of the judge, and did not refer to the evidence, the House could not look at the evidence to see if it afforded grounds for the findings or the decree (*y*).

But upon appeal from a judge where both law and fact are open to appeal there is no presumption that the judgment in the court below is right, and the appellate tribunal is bound to pronounce such judgment as in their view ought to have been pronounced in the court from which the appeal proceeds, and it is not within their competence to say that they would have given a different judgment if they had been the judge of first instance, but that because he has pronounced a different judgment they will adhere to his decision (*z*).

In the absence, however, of very exceptional circumstances, the House of Lords will not on a question of fact disturb concurrent findings of the court of first instance and the Court of Appeal (*a*).

All appeals to the Court of Appeal are to be by way of re-hearing, and are to be brought by notice of motion, and no petition, case, or other formal proceeding is necessary (*b*). The respondent need not give notice of cross-appeal, but if he intends, on the hearing of the appeal, to contend that the decision of the court below should be

(*u*) Re-enacted with variations, S. C. R. 1883, Order LVIII. r. 15.

(*x*) *Lowe v. Lowe*, 10 Ch. D. 432 ; *Krehl v. Burrell*, 10 Ch. D. 420.

(*y*) *Fernie v. Young*, L. R. 1 H. L. 63.

(*z*) *Rickmann v. Thierry*, 14 R.P.C. 105, 116, 117 (H. L.).

(*a*) *Nobel's Explosives Co. v. Anderson*, 12 R. P. C. 164, 166.

(*b*) S. C. R. Order LVIII. r. 1.

varied, he is to give notice of such intention to any parties affected by such contention (c).

Defendants, against whom an injunction restraining the manufacture or sale of articles in infringement of a patent had been granted, and who subsequently became bankrupt, were held nevertheless to have such an interest in being relieved from the injunction as to entitle them on giving security for costs to proceed with an appeal which had been set down before the bankruptcy (d).

Where, after setting down an appeal, defendants became bankrupt, it was held that the appeal could only proceed on the defendants giving security for costs, or the trustee in bankruptcy making himself a party to the proceedings, and an order was made dismissing the appeal unless this was done within a time named (e).

Where an appellant is ordered to give security for the costs of an appeal (see S. C. R., Order LVIII. r. 15), and such security is not given within a reasonable time, an order will be made for the immediate dismissal of the appeal unless there are extenuating circumstances (f)

By S. C. R., Order LVIII. r. 4, the Court of Appeal may receive further evidence, but on appeal from a judgment after trial, this evidence, except as to matters subsequent to the judgment, is to be admitted on special grounds only, and not without special leave. Further evidence on appeal.

The "special grounds" referred to in the last-mentioned order mean something in the nature of the production of a lost document, not simply that the applicant could not earlier get sufficient evidence to support the issue now desired to be raised (g).

And when a defendant in the court below only raised an issue of infringement, an application to adduce fresh evidence raising an issue of want of novelty was refused in the absence of proof that such evidence could not have been produced at the trial (h).

So, also, where a defendant was shown to have known of a certain patent which was put to him when he was examined *de bene esse* before the trial, and was used against him at the trial, but as to which he had not given evidence, he was not allowed to give further evidence on appeal (i).

And when a witness for the defendant deposed at the trial to the manufacture and sale of a machine not mentioned in the particulars of

(c) S. C. R. Order LVIII. r. 6. *facturing Co. v. Patterson*, 29 See also rr. 3, 7. Ch. D. 48.

(d) *United Telephone Co. v. Bassano*, 31 Ch. D. 630. (g) *Hinde v. Osborne*, 2 R. P. C. 45.

(e) *United Telephone Co. v. Bassano*, *ubi supra*. (h) *Hinde v. Osborne*, *ubi supra*.

(f) *Washburn and Moen Manu- (i) Walker v. Hydro-Carbon Syn- dicate*, 3 R. P. C. 253.

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objections, and the plaintiff did not apply for an adjournment, and on this evidence the judge held the patent invalid, an application by the plaintiff to the Court of Appeal for leave to adduce fresh evidence on the appeal to meet the case thus set up was refused (*k*).

But where the court of first instance had dismissed the action without hearing the defendant's evidence, on the ground of want of subject matter in the alleged invention, the Court of Appeal allowed the defendants to go into their evidence (*l*). See *ante*, p. 155.

Further evidence was also received in the cases cited in the note (*m*).

Where on an appeal from a judgment, given after a trial of several days, during which several objections were gone into, the defendants on the appeal sought to add several new specifications to their objections, alleging that they had only discovered these specifications since the trial, leave to do so was refused, the court considering that it was open to the defendants to raise these objections on a petition for revocation (*n*).

The Court of Appeal has power under this order in a proper case to amend the objections in order to allow fresh evidence of anticipation to be produced (*o*); and it seems that the plaintiff would be allowed under this order to cure a merely formal defect in his title (*p*).

The mere fact that the plaintiff, who was an engineer, was abroad, but desired to attend and instruct his counsel, is not a sufficient ground for postponing the hearing of an appeal (*q*).

Cases before the law officers ought not to be cited before the High Court of Justice or the Court of Appeal (*r*).

Delivery of particulars.

29.—(1.) In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or the judge, at any subsequent time, particulars of the breaches complained of.

(2.) The defendant must deliver with his statement of defence, or, by order of the Court or a judge, at any subse-

(*k*) *Barcroft v. Smith*, 14 R. P. C. 172.

(*l*) *Deutsche Nähmaschinen Fabrik v. Pfaff*, 7 R. P. C. 251.

(*m*) *American Braided Wire Co. v. Thomson*, 5 R. P. C. 118; *Britain v. Hirsch*, 5 R. P. C. 226. See also *Blakey v. Latham*, 6 R. P. C. 184; and on an interlocutory application *Spencer v. Ancoats, etc. Co.*, 6 R. P. C. 46.

(*n*) *Shoe Machinery Co. v. Cutlan*, [1896] 1 Ch. 108; 12 R. P. C. 530.

(*o*) *Ibid.* See also *Pirrie v. York Street Flax Spinning Co.*, 11 R. P. C. 429, 431.

(*p*) *Nordenfelt v. Gardner*, 1 R. P. C. 73. See judgment of LINDLEY, L. J.

(*q*) *Walker v. Hydro-Carbon Syndicate*, 3 R. P. C. 253.

(*r*) *Siddell v. Vickers*, 5 R. P. C. 416, 436.

quent time, particulars of any objections on which he relies in support thereof. Sect. 29.

(3.) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty must state the time and place of the previous publication or user alleged by him.

(4.) At the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered.

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

(6.) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any 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.

SUB-SECTION 1.

“**Statement of claim.**”—The plaintiff must state on the face of his statement of claim a sufficient case to justify the injunction asked (s). Statement of claim.

The grant of the letters patent must be alleged, and if the plaintiff sues by a derivative title, his title must also be stated. It has been usual to allege the novelty of the invention, but this is not necessary, since the allegation of the grant and the production of the letters patent throw upon the defendant the *onus* of disputing the novelty (t). Nor has the court required the plaintiff to allege that the stamp duties necessary for keeping the patent alive have been paid (u). It has been, however, usual to allege in general terms that the letters patent are, and since the grant thereof have remained, valid and subsisting, but this allegation is not contained in the model form given in Appendix C. to the S. C. R. 1883, Form No. 6 of Section VI.

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

(u) *Sarazin v. Hamel* (No. 1), 32 Ben. 145.

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

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There was, at one time, some question whether or not it was necessary to set out the specification in the plaintiff's pleadings, but if the pleadings contained an allegation that the specification duly described and ascertained the nature of the invention, and in what manner the same was to be performed, and that the same had been duly filed (thus showing that the conditions of the letters patent had been complied with), this was sufficient (x). It was, however, usual, at all events in bills in Chancery under the old practice, to set out at least so much of the specification as described in general terms the nature of the invention, but since the Judicature Acts this practice has become obsolete, and the model form above mentioned does not in any manner refer to the specification.

The plaintiff must also allege infringement, but in his statement of claim need only allege this in general terms. He must, however, go into detail in the particulars of breaches.

When an action for infringement of a patent has been discontinued, the plaintiff cannot in a second action on the same patent against the same parties join a claim to be repaid the costs of the first action on the ground that its discontinuance was brought about by false evidence on the part of the defendants (y).

As to delivery of statement of claim, see now S. C. R. Order XVIII A. and Order XXX. of May, 1897.

Particulars of breaches.

"Particulars of breaches."—The courts of common law had always a general power to protect a defendant in an action for infringement of patent from surprise, by requiring the plaintiff to deliver particulars of the breaches of which he complained (z). But where a motion for an injunction had been made in the Court of Chancery, the Court of Common Pleas considered that the defendants had sufficient information as to the alleged infringement, and refused to require the plaintiffs to give particulars of the alleged infringements (a).

Act of 1852.

Particulars of breaches were required by the Act of 1852 (b), but were by that statute only applicable to actions at law. However, under Lord Cairns' Act and Sir John Rolt's Act (c) (which enabled the Court of Chancery to try by itself, or with a jury, questions of fact, and required it to try all questions of law arising in a cause), the

(x) *Kay v. Marshall*, 2 Webst. P. C. 39; *Westhead v. Keene*, 1 Bea. 287.

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

(z) *Electric Telegraph Co. v. Nott*, 4 C. B. 462; *Perry v. Mitchell*, 1 Webst. P. C. 269.

(a) *Electric Telegraph Co. v. Nott*, *ubi supra*.

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

(c) 21 & 22 Vict. c. 27; 25 & 26 Vict. c. 42.

practice of requiring particulars of breaches and notices of objections was adopted by that court, at all events when issues were directed (*d*). In *Finnegan v. James* (*e*), however, it was held that the practice prescribed by the statute ought to be followed in all suits in equity as closely as circumstances would admit, and the practice was, since the Judicature Acts, uniformly followed in the Chancery Division, as well as in the other divisions of the High Court of Justice.

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Notr.
 Particulars of breaches adopted in Chancery.

There was a difference in the requirements of the Act of 1852 (*f*), as to particulars of breaches and notices of objections, and this difference exists also in the present Act. In the former case it is simply enacted that particulars of breaches shall be given, but there is no enactment on the nature of those particulars, while considerable detail was and is required in the objections.

Difference in requirements of particulars of breaches and notices of objections.

Thus, in *Talbot v. La Roche* (*g*), where the particulars pointed to a specific article sold by the defendant, the Court of Common Pleas refused to compel a plaintiff in his particulars of breaches to specify particularly the persons with respect to whom, and the occasions on which, the infringement occurred, or to order him to point out the particular parts of the specification alleged to have been infringed. And the court rested their refusal on the ground that the defendant must know whether and in what respects he had been guilty of infringement (*h*).

Particulars sufficient if specific instance of infringement given.

Again, in *Needham v. Ozley* (*i*), it was held by Lord HATHERLEY, then V.-C., that when the particulars of breaches, taken together with the pleadings, give the defendant fair notice of the case to be made against him, they are sufficient. In that case the plaintiffs stated in their bill that the defendant's machine included and combined certain named substantial ingredients combined in the plaintiffs' invention, and the combination whereof was new and important, and by their particulars of breaches they simply pointed to certain specified machines, and stated in general terms that these infringed the plaintiffs' patent, and it was contended, but unsuccessfully, that the plaintiffs ought to specify precisely in what respect the defendant's machines were an infringement.

And in *Batley v. Kynock* (No. 2) (*k*), where the thing alleged to be an infringement had been made an exhibit in the cause, it was held that it

(*d*) *Curtis v. Platt*, 35 L. J. (N.S.) Ch. 853. See *Borill v. Goodier*, L. R. 1 Eq. 35.
 (*e*) L. R. 19 Eq. 72.
 (*f*) 15 & 16 Vict. c. 83, s. 41.
 (*g*) 15 C. B. 310.
 (*h*) See also *Ledgard v. Bull*, 11

App. Cas. 649; *S. C.*, reported as *Petman v. Bull*, 3 R. P. C. 90; *Walter C. Church Engineering Co. v. Wilson*, 3 R. P. C. 123, 127; *Haslam Co. v. Hall*, 4 R. P. C. 203.
 (*i*) 1 H. & M. 248.
 (*k*) L. R. 19 Eq. 229.

Sect. 29 (1). was not necessary that the particulars of breaches should point out the precise portion of the specification alleged to have been infringed. And in an Indian case (the Indian Act being substantially the same as the Act of 1852, as far as it relates to particulars of breaches), it was held, by the Judicial Committee of the Privy Council, that where the plaintiff in his plaint pointed to a particular kiln constructed and used by the defendants and not only referred to his patents but indicated in each case the distinctive features of his invention which he alleged to have been appropriated by the defendants, the Act had been sufficiently complied with notwithstanding formal particulars had not been delivered with the plaint (*l*).

NOTE.

Where reference to particular part of specification required.

But where a specification contained a description of a number of articles, the subject of the invention, a plaintiff has been ordered to point out what part of the specification he alleges to have been infringed.

Thus, in *Perry v. Mitchell* (*m*), a case before the Act of 1852, in a suit to restrain infringement of a patent for making pens, thirteen different sorts being mentioned in the specification, the plaintiff was ordered to specify the particular pens shown in the drawing annexed to the specification in respect of which infringement was alleged.

And in *Talbot v. La Roche* (*n*), it was said by JERVIS, C.J., that if two processes described in a specification were wholly distinct from each other, and the defendant's process might be an infringement of the one, and not of the other, particulars in general terms would not be sufficient.

So, also, in *Patent Type Founding Co. v. Richard* (*o*), a merely general allegation of infringement of a patent for making type was struck out of the particulars, apparently on the ground that the case was distinguishable from *Talbot v. La Roche* (where the general allegation was held sufficient) in the circumstance that type might be made in various different ways, whereas *Talbot v. La Roche* was a case of sun pictures, and one instance would represent the process in every instance.

And in *Lamb v. The Nottingham Manufacturers Co.* (*p*), a case since the Act of 1852, a plaintiff was ordered to specify, by reference to pages and lines, the parts of his specification in respect of which the alleged breaches had been committed.

(*l*) *Ledgard v. Bull*, 11 App. Cas. 648.

(*m*) 1 Webst. P. C. 269.

(*n*) 15 C. B. 320.

(*o*) 2 L. T. (N.S.) 359.

(*p*) Seton, 557, cited in *Batley v. Kynock* (No. 2), L. R. 19 Eq. 229, where it is stated by counsel that there was an admission of infringement, and that there had been an inspection. See also *Jones v. Lee*, 25 L. J. (N.S.) Ex. 241.

Under the present Act it has been held that the plaintiff should state whether he alleges breaches of all or only some and which of the claims in the specification (*q*). But where the particulars referred to pages and lines of the specification, this was held sufficient, though the claiming clauses were not mentioned (*r*). In a simple case a reference to the claims alleged to be infringed was held sufficient without reference to pages and lines (*s*). And in an action on two patents relating to dog muzzles, the specification of the first having a single claim for an improved dog muzzle, and the specification of the second having two claims, one for providing the muzzle with guides and the other for the improved muzzle described, particulars of breaches, alleging that the defendant had made and sold muzzles substantially in accordance with the improved muzzle described and claimed in the first specification, and also substantially in accordance with the improved muzzle described and claimed in the second specification and illustrated in the drawings thereof, and that the defendant's muzzles were guided substantially in accordance with the first claim of the second specification, were held sufficient (*t*).

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Present practice.

In *Walter C. Church Engineering Co. v. Wilson* (*u*), particulars of breaches alleging infringement by reference to certain named claiming clauses of the plaintiffs' specification, and identifying certain machines of the defendant as infringements, were held sufficient, and a summons requiring the plaintiffs to give further particulars by stating what portions of the plaintiffs' specification were alleged to be infringed with reference to pages and lines of such specification, was dismissed.

In an action for infringement of a patent for a new dye which the plaintiff sold as "Naphtol black," the specification claiming the process and the new colouring matter, it was held by the Court of Appeal that the proper form of particulars of breaches was as follows: "(i.) The defendants have, since the date of the patent, manufactured or caused to be manufactured and sold, dye stuffs the same, or substantially the same, as the plaintiff's Naphtol black. (ii.) The dye stuffs complained of are those sold by the defendants under the name of Naphtol black O.D. (iii.) The dye stuffs complained of are made according to the process described and claimed in the plaintiff's specification in all respects" (*v*).

An allegation that defendants had infringed by importing and selling glass globes treated with the patented process was held too wide, and

Specific instances required.

(*q*) *Haslam Co. v. Hall*, 4 R. P. C. 203.

(*r*) *Elsey v. Butler*, 1 R. P. C. 189.

(*s*) *Cheetham v. Oldham* (No. 3), 5 R. P. C. 624.

(*t*) *Eggleton v. Nichols*, 7 R. P. C. 423.

(*u*) 3 R. P. C. 123. *Wenham Co. v. Champion Gas Lamp Co.*, 8 R. P. C. 22.

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

Sect. 29 (1). the plaintiffs were ordered to give specific instances (x). And where in an action on several patents for water-proofing garments the particulars of breaches alleged sales by the defendant of certain named articles and of other waterproof garments made by the manufacturers of the named articles but not bearing their distinguishing names, but which unnamed garments were manufactured by similar processes to the named garments, and that every one of the patented processes had been used in the manufacture of the named and the other garments, the particulars were held insufficient (y).

NOTE.

But in a simple case particulars alleging infringement by reference to certain claims of the specification, but not identifying the plaintiff's process with defendant's process, were held sufficient (z).

In an action for infringement a patentee will not be compelled to produce to the defendant a specimen of the patented article (a).

Nor can a plaintiff be compelled in particulars of breaches to put a construction on his specification (b).

References
by way of
example not
now allowed.

A plaintiff has been allowed, after specifying particular instances of infringement, to add words stating that the instances were given by way of example only and not so as to preclude him at the trial from insisting on other infringements (c); but in *Walter C. Church Engineering Co. v. Wilson* (d), the words "in particular and by way of illustration" were held to be too wide. In *Haslam Co. v. Hall* (e), however, where the particulars complained "by way of example and not of limitation" of certain machines fitted by the defendants on board a named ship, and of all machines made by the defendants similar to them, the words in italics were allowed to remain, the plaintiff, however, being confined (so far as concerned machines fitted to ships) to the named ship unless further names were given.

Where there is a question of amending particulars of the types of engines alleged to be infringements, it lies on the party who alleges that for the honest purpose of his litigation he wants further information or limitation to satisfy the court that he is really placed in a difficulty by the particulars as they stand (f).

And where a plaintiff had given particulars of breaches alleging generally the manufacture of articles according to the invention, and

(x) *Tilghman's Patent Sandblast Co. v. Wright*, 1 R. P. C. 103.

(y) *Mandleberg v. Morley*, 10 R. P. C. 256.

(z) *Cheetham v. Oldham* (No. 3), 5 R. P. C. 624.

(a) *Crofts v. Peach*, 1 Webst. 268.

(b) *Wenham Co. v. Champion Gas Lamp Co.* 8 R. P. C. 22.

(c) *Talbot v. La Roche*, 15 C. B. 310; *Tilghman's Patent Sandblast Co. v. Wright*, 1 R. P. C. 103.

(d) 3 R. P. C. 125.

(e) 4 R. P. C. 204.

(f) *Haslam Co. v. Hall*, 4 R. P. C. 203, 207, per WILLS, J.

specifying sales to one particular company, but stating that he could not give further particulars till he had obtained discovery from the defendant, a motion for better particulars was ordered to stand over till after the defendant had given discovery (*g*). Sect. 29 (1)

NOTE.

Where the particulars of breaches are in form sufficient, and the plaintiff has in answer to interrogatories pledged his oath to their correctness, he cannot be required to answer interrogatories asking for particulars of the alleged infringement (*h*).

Where the defendant is a vendor only, the court may require greater detail in the particulars than where the defendant manufactures the infringing article (*i*).

SUB-SECTIONS (2) (3).

“Statement of defence.”—See notes on s. 26 (3). A defendant in an action for infringement desiring to dispute the validity of the patent must state in his pleadings the various grounds of defence relied on, or he will not be allowed to bring them forward at the trial. Thus, in a case in Chancery, where notices of objections had not been ordered, and a defendant, by his answer, denied the validity of the patent on various specified grounds, but did not mention an objection that the patent was for an invention included in an expired French patent, and was therefore void under 15 & 16 Vict. c. 83, s. 25 (*k*), the court refused at the hearing to allow this objection to be raised (*l*). And a defendant who had, by his answer, disputed the validity of the patent upon certain specified grounds on which issues of fact were directed, was not allowed to add totally new issues of fact not suggested by the answer (*m*). Defence to state all the grounds of defence.

A defendant, who by his defence had simply denied infringement, has, however, been allowed, after the case had been set down for trial, to amend his defence by inserting therein a denial of the validity of the plaintiff's patent, but only on the terms that the defendant should pay the costs of the application and all costs occasioned by the amendment (*n*).

Where the defence was (1) a denial of infringement, (2) an allegation that if any such construction were put upon the claims of the

(*g*) *Russell v. Hatfield*, 2 R. P. C. 144. See also *Millar v. Harper*, 38 Ch. D. 110.

(*h*) *Hoffmann v. Postill*, L. R. 4 Ch. 673, 674; *Moseley v. Victoria Rubber Co.*, 3 R. P. C. 351; *Ehrlich v. Ihlee*, 5 R. P. C. 37.

(*i*) *Mandleberg v. Morley*, 10 R. P. C. 256.

(*k*) Repealed and not re-enacted in the present Act.

(*l*) *Bovill v. Goodier* (No. 2), L. R. 2 Eq. 195.

(*m*) *Morgan v. Fuller* (1), L. R. 2 Eq. 296.

(*n*) *United Telephone Co. v. Basano*, 2 R. P. C. 70.

Sect. 29 (2,3) specification as would include the articles made by the defendant the patent was invalid, it was held that this allegation, though unnecessary, was not embarrassing within the meaning of S. C. R. Order XIX. r. 27, and the Court refused to strike it out of the defence (o).

NOTE.

As to delivery of statement of defence, see now S. C. R. Order XVIII A., and Order XXX. of May, 1897.

But where there was a contract between plaintiff and defendant relating to certain patents and involving a right for defendant to work the invention at a royalty, it was held in an action on the contract, and for an account and injunction, that the defendant could not combine with his defence to the contract a defence to an action for infringement. And all the paragraphs of the defence relating to invalidity of the patent were struck out (p).

Form of pleas to raise particular issues.

The following cases have been decided upon the subject of the proper pleas to raise the issues in an action for infringement of patent.

The issue as to novelty of invention is distinct from the issue whether the patentee was the first inventor (q).

Invention not new manufacture.

In *Walton v. Potter* (r), it was held that a plea that the invention was not a new manufacture admitted the invention to be a manufacture, and put in issue the novelty (s). But in *Bush v. Fox* (t) it was held by the House of Lords that this plea put in issue both the novelty of the invention and its being a manufacture; and in *Spencer v. Jack* (u), the defendant was allowed to have the question of newness of manufacture tried apart from the question of newness of invention.

Under plea of not new manufacture want of utility cannot be alleged.

Under a plea that the patentee was not the inventor, or that the invention was not a new manufacture, no objection can be taken to the specification (x). Nor will a plea that the invention is not a new manufacture allow the defendant to raise the defence of want of utility (y).

Plea of no subject-matter.

An objection that the invention is not the proper subject for a patent cannot be taken under a plea denying the novelty of the invention (z), or upon a plea denying infringement (a).

(o) *Hocking v. Hocking*, 3 R. P. C. 291.

(p) *McDougal v. Partington*, 7 R. P. C. 216.

(q) *Househill Co. v. Neilson*, 1 Webst. 689.

(r) 1 Webst. 601, 611. See also 1 Webst. 598, n. (b).

(s) See also *Spilsbury v. Clough*, 1 Webst. 255.

(t) *Macr. P. C.* 179.

(u) 3 D. J. S. 346.

(x) *Bateman v. Gray*, *Macr. P. C.* 110.

(y) *Walton v. Bateman*, 1 Webst. 623.

(z) *Walton v. Potter*, 1 Webst. 598; *Househill Co. v. Neilson*, 1 Webst. 677.

(a) *Househill Co. v. Neilson*, 1 Webst. 677.

Questions have been raised as to the proper form of pleading the defence of want of utility of the invention. The requirement of utility does not arise from express words to that effect in the Statute of Monopolies (*b*), but is rather an inference from the enactment in that statute that the monopoly granted must "not be mischievous to the State, or to the hurt of trade, or generally inconvenient" (*c*). And it seems to have been thought that the proper form of plea was to plead the statute, and not merely the want of utility.

Sect. 29 (2,3)

NOTE.

Proper plea to raise issue of utility.

The practice at common law, however, appears to have been to put in a plea denying utility in general terms (*d*), and the practice was followed in the Court of Chancery (*e*).

Under the old law insufficiency of the specification was one of the most usual grounds of objection to a patent. This was founded on the condition which was contained in the patent obliging the patentee to file a specification ascertaining the nature of his invention, and in what manner it was to be performed, and unless that condition was complied with the patentee forfeited all the benefit he derived from the Great Seal (*f*).

Insufficiency of specification.

The form of patent given in the first schedule to the present Act (which, however, is not compulsory (*g*)) contains no condition avoiding the patent if the specification be insufficient. But the objection may still be taken in actions upon patents granted under the present Act. Insufficiency of the specification was a ground on which a patent might be repealed by *scire facias* (*h*), and by s. 26, sub-s. 3, of this Act, every such ground is made available by way of defence to an action for infringement (*i*).

Objections to specification, still available in case of new patents.

So also the fact that the complete specification differed materially from the provisional, was a ground for *scire facias* at the commencement of this Act, and by s. 26, sub-s. 3, may therefore be taken as a defence to an infringement action (*k*).

Disconformity between provisional and final specification still a defence.

Under a plea of the insufficiency of the specification, it has been held that it is not open to contend that the specification is not as large

What objections may be

(*b*) 21 Jac. 1, c. 3, s. 6.

(*g*) Section 33, *post*.

(*c*) *Morgan v. Seaward*, 1 Webst. 197.

(*h*) *Ante*, p. 125.

(*d*) Hindmarch on Patents, 275, and cases there cited.

(*i*) See *Siddell v. Vickers*, 39 Ch. D. 92, judgment of COTTON and FRY, L. J.J.

(*e*) *Simpson v. Holliday*, *Renard v. Lerinstein*, and *Morgan v. Fuller*, all cited Seton, 555; *Plimpton v. Malcolmson*, 3 Ch. D. 531, 536.

(*k*) *Nuttall v. Hargreaves*, [1892] 1 Ch. 23, following *dictum* of Lord HALSBURY, L.C. in *Vickers v. Siddell*, 15 App. Cas. 496, 499.

(*f*) *Arkwright v. Nightingale*, 1 Webst. P. C. 61.

Sect. 29 (2,3) as the title (*l*), nor, apparently, that the patent is for a principle only, and therefore void (*m*), nor that the invention is not the subject-matter of letters patent (*n*).

NOTE.

taken under plea of insufficiency of specification.

Upon an issue as to the sufficiency of the specification, it seems to have been doubted (*o*) whether a defendant could prove that the complete specification differed materially from the provisional specification, a fact which, if established, would invalidate the patent (*p*). But in *Penn v. Bibby* (*q*), Lord CHELMSFORD, C., allowed this to be done, and said that the specification did not particularly describe and ascertain the nature of the invention if the complete specification departed from the terms of the title or of the provisional specification, in which the nature of the invention must be described.

Ignorance no defence.

It is no defence to an action for infringement to say that the party charged was not aware of the existence of the patent (*r*), or was not aware that the article complained of was an infringement (*s*), or that the acts complained of were done by workmen employed by the defendant, but contrary to orders (*t*).

Nor the fact of no intention to infringe.

Nor is the intention of the defendant material if he has in fact invaded the rights of the patentee (*u*); and the fact that the defendant did not intend to infringe is no answer to a motion to commit for breach of an injunction which restrained infringement (*x*).

And where the defendant, who was a dealer only, had bought the article complained of in open market, without knowledge of the process of its manufacture, and, on the plaintiffs bringing to his knowledge the fact of an infringement, had offered, if the plaintiffs would refrain from taking proceedings, to cease to purchase the article, except from the plaintiffs, and the defendant had complied with his promise and

(*l*) *Derosne v. Fairie*, 1 Webst. 161; *Neilson v. Harford*, 1 Webst. 312. See, however, *Penn v. Bibby*, L. R. 2 Ch. 127.

(*m*) *Jupe v. Pratt*, 1 Webst. 151.

(*n*) *Walton v. Potter*, 1 Webst. 598; *Househill Co. v. Neilson*, 1 Webst. 677.

(*o*) *Morgan v. Fuller* (1), L. R. 2 Eq. 297; *Derosne v. Fairie*, 1 Webst. 161; *Neilson v. Harford*, 1 Webst. 312.

(*p*) *Foxwell v. Bostock*, 4 D. J. S. 298; *Bailey v. Robertson*, 3 App. Cas. 1055.

(*q*) L. R. 2 Ch. 127, 130.

(*r*) *Wright v. Hitchcock*, L. R. 5 Ex. 37; *Davenport v. Rylands*, L. R. 1 Eq. 303; *Wittman v. Oppenheim*,

27 Ch. D. 260; *Young v. Morris*, 11 R. P. C. 617.

(*s*) *Walton v. Lavater*, 8 C. B. (N.S.) 162; *Wright v. Hitchcock*, L. R. 5 Ex. 37; *Geary v. Norton*, 1 De G. & Sm. 9.

(*t*) *Betts v. De Vitre*, L. R. 3 Ch. 430.

(*u*) *Heath v. Unwin*, 15 Sim. 552, disapproving what had been said in the same case by the Court of Exchequer, 13 M. & W. 583; *Stead v. Anderson*, 2 Webst. 156. See also *Seed v. Higgins*, 5 Jur. (N.S.) 540, 543; 8 E. & B. 771; *Young v. Rosenthal*, 1 R. P. C. 29, 39.

(*x*) *Plimpton v. Spiller*, 4 Ch. D. 286, 288.

had sold none of the patent articles since that time, except the trifling residue he had in stock, and had since purchased a considerable quantity from the plaintiffs, who had, nevertheless, without further communication, filed their bill, it was held that there was nothing in these circumstances which could operate as accord and satisfaction for the wrong committed by the infringement, and the plaintiffs were held to be entitled to damages (y). In this case the patent had expired pending the litigation, and therefore no injunction could be granted.

Sect. 29 (2,3)

NOTE.

But although a plaintiff may have his action against a defendant infringing in ignorance of the patent, it is not a matter of course that he should be entitled in such a case to an injunction; and therefore, where a retailer had unwittingly sold a few articles in infringement of the patent, but gave the plaintiff full information as to where he had obtained the articles complained of, and promised not to sell any more, a bill for an injunction was dismissed, and he was left to his remedy in damages (z).

When defendant infringed in ignorance, injunction not always granted.

And where defendant had not intended to sell, but had lent on an undertaking to return, certain instruments admitted to be made in infringement of a patent, and these had come into plaintiff's possession, and this was the only evidence of infringement, the action was dismissed with costs; but the instruments being piracies an order for their return to the defendant was refused (a).

And in a Scotch case where the defendant admitted infringement before the action, but had discontinued such infringement, and offered to pay what was reasonable in respect of it, and the action was brought in respect of a different article which the court held not to infringe, it was held that there was no case for an interdict, and, notwithstanding the previous admitted infringement, the plaintiff must pay the costs of the action (b).

“Particulars of objections.”—By the 4 & 5 Will. 4, c. 83, s. 5, it was enacted that in an action brought against any person for infringing letters patent, the defendant on pleading thereto should give to the plaintiff a notice of any objections on which he meant to rely at the trial of such action, and that no objection should be allowed to be made in behalf of such defendant at such trial unless he proved the objections stated in such notice. This Act (c) did not require any more detail in the objections than in the particulars of breaches.

Particulars of objections under Act of 1835.

(y) *Darenport v. Rylands*, L. R. 1 Eq. 305.

(z) *Betts v. Willmott*, 18 W. R. 946; *Upmann v. Elkkan*, L.R. 12 Eq. 145. See also *Thornton v. Baker*, 3 Times R. 715.

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

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

(c) Section 5.

Sect. 29 (2,3) Upon this statute it was soon decided that the particulars of objections delivered by a defendant were not conclusive at his peril; and that if they were insufficient the court could compel delivery of fuller and better particulars (*d*).

NOTE.

And further, that the objections were intended to give more specific information than the pleas (*e*), and that in general a notice of objections in the terms of the pleas would be insufficient (*f*).

Some difference of opinion seems to have prevailed as to the details which the court, under the Act of Will. 4, could require to be given of alleged prior user of the patented invention. In *Bulnois v. Mackenzie* (*g*) the Court of Common Pleas considered that they had no power to require the defendant to set out the names and addresses of those who were alleged to have used the invention previously to the patent. A similar view was taken in the cases of *Carpenter v. Walker* (*h*), *Heath v. Unwin* (*i*), and *B. v. Walton* (*k*). In *Jones v. Berger* (*l*), however, when the defendant's objections stated that the invention had been previously published by certain named persons in certain specifications, and "also by other persons in other books or writings," it was held that the defendant must specify the books relied on; and in *Galloway v. Bleaden* (*m*), the names, addresses, and descriptions of alleged prior users were ordered to be furnished. The question was again considered in *Russell v. Ledsam* (*n*), where the Court of Exchequer, upon a review of all the above-mentioned cases, decided that a defendant could not be compelled, in an objection for want of novelty, to state who was the first inventor, or when and in what place and under what circumstances the invention was used before.

Upon an objection that the specification is insufficient, it was held that if the plaintiff was contented to take that as notice, any objection showing insufficiency might be made at the trial (*o*).

And objections that the invention was not properly set forth in the specification (*p*), or that the specification is calculated to deceive (*q*), or that the specification does not sufficiently distinguish between what is

(*d*) *Bulnois v. Mackenzie*, 1 Webst. P. C. 260.

(*e*) *Bulnois v. Mackenzie*, *ubi supra*; *Jones v. Berger*, 1 Webst. P. C. 544; and see judgment of CRESSWELL, J., in *Walton v. Bateman*, 1 Webst. P. C. 616.

(*f*) *Neilson v. Harford*, 1 Webst. P. C. 370; *Betts v. Walker*, 14 Q. B. 363, 368. See also *Walton v. Bateman*, 1 Webst. P. C. 268, n.

(*g*) 1 Webst. P. C. 260.

(*h*) 1 Webst. P. C. 268 n.

(*i*) 10 M. & W. 684.

(*k*) 2 Q. B. 969.

(*l*) 1 Webst. P. C. 544.

(*m*) 1 Webst. P. C. 268, n.

(*n*) 11 M. & W. 647.

(*o*) *Neilson v. Harford*, 1 Webst. P. C. 332.

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

(*q*) *Neilson v. Harford*, 1 Webst. P. C. 324, n.

new and what is old (*r*), or did not describe the most beneficial method with which the patentee was acquainted of practising his invention (*s*), or did not sufficiently describe the nature of the invention, or the manner in which it was to be performed (*t*), or that the invention does not produce the effect stated (*u*), were all held sufficient without going into particulars. It will be seen, however (*post*, p. 174), that under the most recent practice detailed particulars are now required in the case of several of these objections. **Sect. 29 (2,3)**

NOTE.

But upon an objection that the invention for which the patent was granted was more extensive than that described in the specification, and another objection founded on discrepancy between the drawings and specification, the defendant was required to call the plaintiff's attention to the particular parts (*x*). And where an objection alleged, as to certain letters patent the term of which had been extended by the Judicial Committee of the Privy Council, that such extension had been obtained by fraud, covin, and misrepresentation, the defendant was required to state the species of fraud, covin, and misrepresentation on which he relied (*y*).

Where a defendant in one objection alleged that the patentee had not, by his specification, sufficiently described the invention, and in a second objection that the patentee had not enrolled *any specification* sufficiently describing, etc., this was held not precise enough, and the word "*other*" was ordered to be inserted before the word "specification" in the second objection (*z*).

The Act of 1852 (*a*), defined the detail as to prior user necessary in particulars of objections, and required such particulars to state "the place or places at or in which, and in what manner, the invention is alleged to have been used or published prior to the date of the letters patent." **Particulars of objections under Acts of 1852 and 1883.**

Several cases have been decided on this section, and these will probably form a guide to the construction to be placed on the words in the present sub-section, words which, though differing from and perhaps somewhat wider than the corresponding words of the Act of 1852, do not, it is submitted, carry the rules as to particulars of objection further than had been the practice under the latter Act.

(*r*) *Jones v. Berger*, 5 M. & G. 208.

(*s*) *Ibid*; S. C., 1 Webst. P. C. 546.

(*t*) *Heath v. Unwin*, 1 Webst. P. C. 551, n.

(*u*) *Ibid*.

(*x*) *Fisher v. Dewick*, 1 Webst. P. C. 551, n.

(*y*) *Russell v. Ledsam*, 11 M. & W. 647.

(*z*) *Leaf v. Topham*, 14 M. & W. 146.

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

Sect. 29 (2,3)

NOTE.

Prior specifications and prior user.

Thus, in *Curtis v. Platt* (b), the defendants, under an order requiring them to state "the place where, and the earliest date at which," the machines they relied on as showing a prior user had been made, gave a list of thirteen persons and firms, with a general statement that the user had, in all the cases, been at the earliest from 1825 downwards. It was contended that they ought to state in each instance the place at which the first machine had been made, and the date of making. Lord HATHERLEY, then Sir W. P. WOOD, V.-C., ordered the particulars to be amended, observing that, as far as concerned the date of user and the place of use of the machines, the defendants were bound to give the plaintiff all the information they themselves had. And in the same case the defendants, having alleged in their objections prior publications in books, and done this by a mere general reference, were ordered to state the particular work or document, and the volume of that work, in which the alleged prior publication was found. So also, where a defendant relied on prior specifications as anticipating the plaintiff's patent, it was held that he must point out the particular pages and lines of the prior specifications on which he relied, and in a case where infringement of several patents was complained of in one action, a defendant relying on prior user was ordered to state which parts of plaintiff's machines he alleged to have been so used (c).

Pages and lines.

Reference to claiming clauses of plaintiff's specification.

In the *London and Leicester Hosiery Co. v. Higham* (d), the defendant was ordered not only to state what portions of the specifications alleged as prior publications were alleged to anticipate the plaintiff's patents, with a reference to pages and lines of such specifications, but also what portions of plaintiff's inventions were alleged to have been published or used prior to the date of the letters patent, with reference to the claiming clauses of the specifications of such letters patent.

Present practice.

These rules have been in effect adopted in particulars of objections under the present Act, and defendants relying on prior specifications or anticipations have been ordered to state, by reference to pages and lines, what parts of the specifications are relied on (e). And when the plaintiff's specification has several claims, the court, following the order in the *London and Leicester Hosiery Co. v. Higham*, cited above, has compelled a defendant to show further to which of the plaintiff's

(b) 8 L. T. (N.S.) 657.

(c) *Grover & Baker Sewing Machine Co. v. Wilson*, W. N. 1870, 78. See also *Fisher v. Dewick*, 1 Webst. P. C. 264; *Plimpton v. Spiller*, Higgins, p. 312.

(d) Appendix, *post*.

(e) *Fowler v. Gaul*, 3 R. P. C. 247; *Heathfield v. Greenway*, 11 R. P. C. 17, 19. See also *Harris v. Rothwell*, 3 R. P. C. 243; *Boyd v. Farrar*, 5 R. P. C. 33, 36.

claims the specifications relied on are addressed (*f*). In *Heathfield v. Greenway* (*g*), however, it was said by NORTH, J., that there must be special grounds for an order of this sort.

Sect. 29 (2,3)

NOTE.

And in a case where anticipation by prior user of a particular machine was alleged, KAY, J., refused to compel the defendant (although the plaintiff's specification contained seventeen claims) to state the parts of the plaintiff's invention which were said to be anticipated, as the plaintiff must be taken to understand his own patent well enough to be able, on seeing the machine, to judge how far it is or is not an anticipation of his invention (*h*).

Where a defendant had stated in objections alleging prior specification that "the parts relied upon are the whole specification, but more particularly," with a reference to certain portions of the specification, he was ordered to strike out the words denoting reliance on the whole, but was at liberty to refer to other pages and lines beyond those already referred to (*i*).

But it would appear that an actual reference to pages and lines of the specification relied on is not always necessary. The whole question of the detail required in particulars of objections alleging prior publication was considered by the Court of Appeal in *Holliday v. Heppenstall* (*k*). In that case the defendants relied on seventeen specifications, all of them short, and in each case on the whole specification; and they also relied on a large number of other publications, referring in most instances to one page only, but in others to several pages. It was held that the particulars were insufficient, and that the defendants must give further and better particulars, and specify what the alleged anticipations were, and where they were to be found, but the defendants were not bound to state what were the particular pages of the documents relied on. And it was said by COTTON, L.J., that if the defendants would state the nature of the anticipation on which they relied, state where they found it, and, in the case of a specification, show on what part of the claim they relied, that would be enough, unless there was something else in the specification or publication of such a nature that it remained doubtful on what they meant to rely.

Detail in objections alleging prior publication.

A defendant is, however, at liberty to say that he relies on the whole of a specification as anticipating the plaintiff's invention, and if the court comes to the conclusion that he is honestly relying on the whole,

(*f*) *Harris v. Rothwell*, 3 R. P. C. 243; *Boyd v. Farrar*, 5 R. P. C. 33, 36; *Boyd v. Horrocks*, 3 R. P. C. 285.

(*g*) 11 R. P. C. 17, 19.

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

(*i*) *Harris v. Rothwell*, 3 R. P. C. 243.

(*k*) 41 Ch. D. 109.

Sect. 29 (2,3) it will not compel him to give further particulars, although the specification may be of great length (*l*).

NOTE.

But it is always in the discretion of the court to examine the matter, and see whether it is in fact the whole of the specification which is relied on (*m*).

Public
general
knowledge.

If the defendant intends to depend for resistance to the plaintiff's claim upon common knowledge, as distinguished from anticipation, it is convenient, if not necessary, to plead that distinctly (*n*).

In *Holliday v. Heppenstall*, cited above, it was held that it is not required by the Act of Parliament that, if a defendant relies on general public knowledge as an objection to the patent, he should state all the books or publications which contain that knowledge. That is to be proved by witnesses in a general way, and, if necessary, by reference to well-known works, and the defendants were ordered to strike out from their particulars all the publications on which they relied simply as enabling them to prove general knowledge. And in *Siemens v. Karo* (*o*), this case was treated by CHITTY, J., as deciding that it is a wrong method of framing particulars when, by way of illustration of the case intended to be made, under the head of general public knowledge particular instances are given, which, according to the mode in which the objections are framed, can be made use of as special and particular anticipations of the patent.

But the case of *Holliday v. Heppenstall* is not an authority for allowing a defendant to use, as the only evidence of common knowledge, a specification not mentioned in the objections (*p*). And in the *Solvay Laundry Co. v. Mackie* (*q*), it was held that specifications do not show common knowledge, and a defendant, who in an action for infringement pleaded that if the plaintiffs alleged that material parts of their alleged invention had been used by her, such parts were old and in common use before the patent, but did not deliver any particulars of objections, was not allowed to adduce in evidence any prior specifications, although such specifications had been referred to on a motion for injunction in a threats action brought by the defendant against the plaintiffs, which came on for trial with the infringement action.

Detail in
objections on
specification.

A defendant objecting that the invention described in the complete specification differed from that described in the provisional specification,

(*l*) *Nettlefold v. Reynolds*, 8 R. P. C. 410; *Siemens v. Karo*, 8 R. P. C. 376; *Sidebottom v. Fielden*, 8 R. P. C. 267.

(*m*) Per CHITTY, J., *Siemens v. Karo*, 8 R. P. C. 378.

(*n*) Per KEKEWICH, J., *Phillips v. Irel Cycle Co.*, 7 R. P. C. 77, 82.

(*o*) 8 R. P. C. 376, 377.

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

(*q*) 10 R. P. C. 68.

was ordered to give further and better particulars, pointing out the alleged difference (r). Sect. 29 (2,3)

And the words "in particular" were struck out of such an objection so as to confine it to the particular instance of variance stated (s).

And if a defendant alleges that the specification does not sufficiently describe the nature of the invention, and in what manner it is to be performed, or that it is ambiguous and misleading, he must state in what respects the description fails, or the specification is ambiguous or misleads (t).

And where, in an action for infringing a patent for dynamo-electric machines, on an objection that the specification did not sufficiently describe the nature of the invention, and in what manner the same was to be performed, a defendant had been ordered to give further particulars, it was held by the Court of Appeal that an allegation that the specification did not contain a sufficient direction to enable a workman skilled in the manufacture of electrical machinery to make a dynamo-electric machine in which the electro-motive force is kept approximately constant at constant speed when the resistance of the external circuit varies (words taken from the claim in the specification), was not sufficiently explicit, it being admitted that the defendants were in a position to give better particulars (u).

Under the Act of 1852, it was held by the Court of Appeal that an order requiring further particulars of objection must in form be confined to the particulars mentioned in the Act, and therefore, where an order had been made requiring the defendants to state *the names and addresses of the persons by whom, and the places where, and the dates at, and the manner in which, the alleged prior user had taken place*, it was held by the Court of Appeal that the order must be varied by omitting the particulars printed above in italics (x). The court, however, intimated that under the order so varied the defendants would still be required to furnish full and sufficient particulars; and accordingly, where the defendants, having, in alleged obedience to the last-mentioned order, given to the plaintiff particulars of prior user by three persons, the names and addresses of whom were furnished, added a statement that the invention had been used by "other persons in London and Birmingham," these words were held to be too indefinite, and the defendants were ordered to give more specific information, or to submit

NOTE.

(r) *Anglo-American Brush Electric Light Corporation v. Crompton*, 34 Ch. D. 152.

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

(t) *Heathfield v. Greenway*, *ubi supra*.

(u) *Crompton v. Anglo-American Brush Corporation*, 35 Ch. D. 283.

(x) *Flower v. Lloyd*, 45 L. J. (N.S.) 746.

Limits of
Flower v. Lloyd.

Sect. 29 (2,3) to the words objected to being struck out (*y*). It has since been expressly held that to satisfy an order in the form settled in *Flower v. Lloyd* the defendant must give the names and addresses of prior users (*z*). And a plaintiff may, on making out a proper case, administer interrogatories to a defendant who has delivered particulars of objections complying literally with the form of order as settled by *Flower v. Lloyd*, asking for the names and addresses of the alleged prior users, and whether the machines were in existence (*a*).

NOTE.

And again, where a defendant relied on an objection that a prior American patent had been surrendered, and that the invention had been published in certain journals of specified dates, and in sketches and drawings deposited at a specified time in the Patent Office library, it was held the defendant must state the date of the American patent, the name of the patentee, and the date of the alleged surrender, and specify also the pages but not the lines of the journals referred to, and that the drawings must be identified in writing, whether contained in books or not, the rest of the order to be in the terms of the above-cited case of *Flower v. Lloyd* (*b*).

Where names and addresses of prior users are given, the address must be the present residence of the alleged prior users (*c*).

Objections to be precise.

It has always been held that the objections must be precise and definite, and not in too general terms. Thus, it was not sufficient to say that "if any part of the invention were new, the same was useless," or that "the improvements or some of them had been used long before" (*d*). And where the prior user was alleged to be by persons named and "divers other persons" (*e*), or at Nottingham "and elsewhere" (*f*), or "by other persons in London and Birmingham" (*g*), the general words were in each case ordered to be struck out. So, also, a defendant has been compelled to state whether he objected to the whole of the alleged invention as being old, or whether the objection applied only to a particular part (*h*).

And an allegation of prior user by the exhibition in use of articles made according to the supposed invention, was held too vague in an action

(*y*) 20 Sol. J. 860; Higgins. 311.
 (*z*) *Birch v. Mather*, 22 Ch. D. 629.
 (*a*) *Ibid.*
 (*b*) *Plimpton v. Spiller*, 20 Sol. J. 860.
 (*c*) *Palmer v. Cooper*, 9 Ex. 236.
 (*d*) *Fisher v. Dewick*, 1 Webst. P. C. 264; *Heath v. Unwin*, 1 Webst. P. C. 552, n.; *Russell v. Ledsam*, 11 M. & W. 647.

(*e*) *Galloway v. Bleaden*, 2 Chit. Arch. Prac. 1031, cited 1 Webst. 268, n.; *Fisher v. Dewick*, 1 Webst. P. C. 551, n.
 (*f*) *Jones v. Berger*, 1 Webst. P. C. 544; *Holland v. Fox*, 1 C. L. Rep. 440.
 (*g*) *Flower v. Lloyd*, 20 Sol. J. 860.
 (*h*) *Fisher v. Dewick*, 1 Webst. P. C. 264; *Russell v. Ledsam*, 11 M. & W. 647.

for infringement of a complicated patent for improvements in machinery for winding, doubling, and twisting thread, and the defendants were ordered to give such a statement as would show which particular machines were alleged as anticipations (*i*). So, also, an allegation of prior user of the said invention or material parts thereof, without saying what material parts, and an allegation which gave only the name and place and date of the user, but did not give the machine said to be used, were held insufficient (*k*).

Sect. 29 (2,3)

NOTE.

And where the defendants delivered long and elaborate objections alleging several persons as having anticipated the plaintiff's patent by the mode in which they used certain contrivances, but not saying that these persons in every case did it in the same way, nor showing the particular mode adopted by each person, further particulars were ordered (*m*).

But when the patent was for improvements in machinery for spinning and doubling cotton, and the objections stated that the defendants relied on the use by certain named firms of spindles and bobbins made according to the alleged invention, this was held sufficient (*n*).

It would seem, however, from the case of *Penn v. Bibby* (*o*), that general words may sometimes be allowed in order to give the defendant the benefit of a general saving, and liberty to apply for leave to give particulars of prior user, if and when he may find them. In this case Lord HATHERLEY, then Sir W. P. WOOD, V.-C., refused to strike out from an objection alleging certain cases of prior user the words "*among other instances*;" and in the previous case of *Curtis v. Platt* (*p*), the same learned judge allowed the words "*amongst others*" to remain in an objection that the invention had been previously used by certain named persons. In this latter case, however, on the plaintiff objecting that if the words above mentioned were allowed to remain the defendant could go into any number of cases of which the plaintiff could have no notice, his Lordship observed that if anything of that sort were attempted at the trial the court would know how to protect the plaintiff from surprise. This view appears to be at variance with the practice at common law (*q*). *Curtis v. Platt*, however, was not a case before a jury, and this fact appears to have influenced the decision.

When the user relied on is a general user it may be stated in general terms. Thus, it was held a sufficient allegation of such user to say that

General user.

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

(*o*) L. R. 1 Eq. 549.

(*k*) *Law v. Ashworth*, 7 R. P. C. 86.

(*p*) 8 L. T. (N.S.) 657.

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

(*q*) *Hull v. Bollard*, 1 H. & N. 134. See, however, *Carpenter v. Walker*, 1 Webst. 268 n.

(*n*) *Sidbottom v. Fielden*, 8 R. P. C. 266.

Sect. 29 (2,3) the invention was used "by candle-makers generally in London and the vicinity thereof" (r). In such a case the plaintiff is not harmed, because to prove a general user proof by one person would not be enough, and "the plaintiff has no reason to complain of generality of statement, for the more general it is the more the defendant must prove under it" (s).

NOTE.

So, also, where the objection points to the general use of a particular preparation by a limited class. Thus, where the patent was for making starch, an objection that the invention had been used by persons engaged in the manufacture of lace "at Nottingham" was held sufficient (t).

But even an allegation of general user must not be too wide. Thus, where the patent was for improvements in the construction of carriages, objections alleging user by "carriage builders generally throughout Great Britain," and user by "various carriage-builders in or near London, Liverpool, Manchester, and Southampton, and various other of the principal towns of Great Britain" were held insufficient (u).

And allegations of anticipation by the general use of regenerative gas lamps, and by the general use of the *W.* regenerative gas lamp, the particular kind of *W* lamp not being specified, were held insufficient (x).

When the defendants relied on an objection of general user, and had in answer to interrogatories described a particular arrangement as supporting that objection, and at the trial offered evidence of another method in support of the same objection, the case was ordered to stand over at the plaintiff's risk as to costs, but with liberty to the defendants to give particulars of further instances (y).

When the defendant desired to amend his objections by adding an objection that the alleged invention did not substantially differ from the contrivances in common use prior to the patent, he was allowed to amend, but was required to particularize the contrivances, and the place and time when and where they were used or known (z).

The best test of the sufficiency or insufficiency of objections will probably be found in the words of PARKE, B., in *Palmer v. Cooper* (a): "The defendant's particulars ought to give the plaintiff such information

(r) *Palmer v. Wagstaff*, 8 Ex. 841.

(s) Per ALDERSON, B., *Palmer v. Wagstaff*, 8 Ex. 841. See also observations of ERSKINE, J., *Jones v. Berger*, 1 Webst. P. C. 547; *Bentley v. Keighley*, 7 M. & G. 502; 8 Scott (N.R.) 372.

(t) *Jones v. Berger*, 1 Webst. P. C. 549. See also *Palmer v. Cooper*, 9 Ex. 231.

(u) *Morgan v. Fuller* (2), 1. R. 2 Eq. 297. And see *post*, p. 505.

(x) *Siemens v. Karo*, 8 R. P. C. 376.

(y) *Pascall v. Toope* (2), 8 R. P. C. 1.

(z) *Darrah v. Purser*, 6 R. P. C. 365.

(a) 9 Ex. 236.

as will enable him to make the necessary inquiries at the places named." Sect. 29 (2, 3)

NOTE.

An objection that the invention is not new is sufficient to enable a defendant to contend at the trial that one of two inventions described in the specification is not new (*b*).

Where two defendants were sued as being jointly liable, it was held, under the Act of 1852, that it was not necessary that particulars of objections should be delivered by both defendants, even though they defend separately, and that both might set up at the trial all the objections in the particulars (*c*); and the present Act seems to make no alteration in this respect.

An action against manufacturers and users in which no defence is delivered by the users cannot be set down against the latter alone for judgment in default of pleading (*d*).

It has been held that notices of objection cannot go beyond the pleas, and that such objections do not stand in the place of pleas (*e*); and where a defendant had only pleaded the general issue and want of novelty of the invention, and that the plaintiffs were not first and true inventors, he was not allowed to contend that the patent was illegal, although he had given notice of an objection to that effect (*f*). Objections not in place of pleas.

And this is the form of pleading adopted in the schedule to the Rules of 1883, Appendix D., Sect. VI. But it has of late been usual to find in the defence no other plea as to the validity of the patent than a simple denial of validity of the patent "on the grounds stated in the particulars of objections delivered herewith," and this mode of pleading appears to be sufficient (*g*).

It has been usual in the common form of particulars of objections which has been in use for many years to preface the objections with the words "*the defendant besides denying that he has infringed the letters patent relies on the following objections,*" etc. The use of the words in italics has been disapproved of (*h*).

"**Time and place.**"—It will be noticed that these words differ from the words of the corresponding section of the Act of 1852, which required the *place* and *manner* of prior publication or user to be stated.

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

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

(*d*) *Actien Gesellschaft für Car-
tonnagen Industrie v. Remus*, 12
R. P. C. 94.

(*e*) *Maomamara v. Hulse*, 2 Webst.
P. C. 128, n.; *Jones v. Berger*, 1

Webst. P. C. 544. See also *Chollet
v. Hoffman*, 7 E. & B. 686.

(*f*) *Gillett v. Wilby*, 1 Webst.
P. C. 270.

(*g*) See order of C. A. in *Kurtz v.
Spence*, 36 Ch. D. 776.

(*h*) *Phillips v. Ivel Cycle Co.*
7 R. P. C. 77, 85.

Sect. 29 (2. 3) But under the present Act it has been held that a defendant desiring to raise the objection of want of novelty must state reasonably on what grounds in respect of want of novelty he disputes the patent, and must also state the time and place of the previous publication or user alleged by him (*i*).

NOTE

And pages and lines must be given, as under the old practice, when prior specifications (*k*), or printed books (*l*), are relied on. It appears, therefore, that the information necessary to satisfy the present Act is, in substance, the same as what was required under the Act of 1852.

Under the Act of 1852, it was held that, so far as regards date of user and place of user, defendants were bound to give the plaintiffs all the information they themselves had (*m*).

Where the defendants referred to certain machines as having been made or used at named places by named persons in particular years, and alleged these machines as anticipations of particular claims in the specification, the objections were held sufficient, notwithstanding allegations by the plaintiff that the present owner of some of the machines refused to allow inspection thereof, and that of others the defendants could not say whether they were still in existence (*n*).

When the objection was that the invention was published by the user by a named person "from 1832 to 1862," it was held that further particulars must be given, but that the defendants were not under the particulars to be tied to continuous user during that period (*o*).

Further and better particulars.

If the particulars delivered are insufficient, further and better particulars can be required (*p*). Where they are too general, it is the business of the parties who mean to object to them to procure an order for better particulars (*q*); and this is important, otherwise evidence within the literal meaning of the particulars may be admitted, although the particulars are, in fact, too general (*r*). There is a very large difference between a case where a judge has been applied to and has ordered further particulars, in order to state an objection more specifically, and a case where at the trial the plaintiff asserts that the defendant ought to be prevented from "availing himself of an objection. If, wherever the court could order further particulars because the

(*i*) *Fowler v. Gaul*, 3 R. P. C. 247, 250; *Boyd v. Horrocks*, 3 R. P. C. 287.

(*k*) *Fowler v. Gaul*, *ubi supra*; *Heathfield v. Greenway*, 11 R. P. C. 17.

(*l*) *Harris v. Rothwell*, 3 R. P. C. 243.

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

(*n*) *Boyd v. Horrocks*, 6 R. P. C. 561.

(*o*) *Smith v. Lang*, 7 R. P. C. 148.

(*p*) S. C. R. 1883, Order XIX., r. 7.

(*q*) *Per* POLLOCK, C. B., *Hull v. Ballard*, 1 H. & N. 134.

(*r*) See notes under sub-s. 4, *post*.

objection had not been particularly specified, it would also hold that the party was precluded from raising it at the trial, nobody would be foolish enough to apply to a judge for further particulars" (s). Sect. 29 (2, 3)

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NOTE.

Where in an action by a vendor for specific performance of a contract for the sale of patents the defendant alleged that by the contract he was only to pay if he satisfied himself that the patents were valid, and that he had satisfied himself of their invalidity, he was ordered to give particulars of objections to the validity of the patents (t).

In a threats action, where the plaintiff had delivered insufficient particulars of objections alleging a prior user thirty years ago, and the person alleged to have used the invention had in an affidavit in another action by the defendants exhibited certain specimens of articles made by him, the court ordered that the plaintiff should before putting in further particulars have a month to see the specimens, and required the defendants to undertake to give such consent as would be necessary for the plaintiff to have such access (u).

The application for further and better particulars should be made by summons at chambers (x). If the particulars delivered are insufficient, the party delivering them may be ordered to pay the costs of the application for better particulars (y).

If a defendant does not comply with an order for better particulars of objections, it would seem that the proper course is to apply that the insufficiently-stated objection may be struck out (z).

By r. 8 of the S. C. R. 1883, Order XIX., an order for particulars does not, except as mentioned in the rule, operate as a stay of proceedings or give any extension of time. Nor is the fact that the plaintiff has obtained an order for further and better particulars of objections any ground for giving him further time to reply (a).

Under an order to give further and better particulars of objections new instances of anticipation cannot be added without leave (b).

“Previous publication or user.” — The law as to previous publication has been thus stated by Lord BLACKBURN (c) :— Previous publication.

“The consideration for a patent is the communication to the public of a process that is new. In Hindmarch on Patents (d), it is laid down

(s) *Per* MELLISH, L.J., *Sugg v. Silber*, 2 Q. B. D. 495.

(t) *Hazlehurst v. Rylands*, 9 R. P. C. 1.

(u) *Smith v. Lang*, 7 R. P. C. 148.

(x) See S. C. R. May, 1897, Order XXX. r. 1 (a) (c).

(y) *Grover and Baker Sewing Machine Co. v. Wilson*, W. N. 1870, p. 78; *Penn v. Bibby*, L. R. 1 Eq. 548.

(z) *Flower v. Lloyd*, 20 S. J. 860; *Higgins*, 311.

(a) *Boyd v. Farrar*, 5 R. P. C. 33, 36.

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

(c) *Patterson v. Gas Light and Coke Co.*, 3 App. Cas. 244.

(d) P. 33.

Sect. 9 (2, 3) that 'If the public once becomes possessed of an invention by any means whatever, no subsequent patent for it can be granted, either to the true or first inventor himself, or any other person ; for the public cannot be deprived of the right to use the invention, and a patentee of the invention could not give any consideration to the public for the grant, the public already possessing everything that he could give.' This is, in my opinion, a correct statement of the law. It is not necessary that the invention should be used by the public as well as known to the public. If the invention and the mode in which it can be used has been made known to the public by a description in a work which has been publicly circulated (*Stead v. Williams (e)*), or in a specification duly enrolled (*Bush v. Fox (f)*; *Betts v. Menzies (g)*), it avoids the patent, though it is not shown that it ever was actually put into use." So, also, if the invention has been published in a provisional specification (*h*).

NOTE.

The question to be asked in cases of alleged prior publication is, "Is it the fair conclusion from the evidence that some English people, under no obligation of secrecy (*i*) arising from confidence or good faith towards the patentee, knew of the invention at the date when the plaintiff took out his patent?" (*k*).

Previous publication in books.

In order to show that a patentee is not the true and first inventor of his patented invention, it is not necessary to show that he learnt it from a prior publication existing in this country. It is sufficient to show that the invention was so described, in some book or document in this country, as that some English people may be fairly supposed to have known of it (*l*). Thus, where the invention has been made public in England by a description contained in a work, whether written or printed, which has been published in England (*m*), or where a few copies of a foreign book containing an account of the same invention have been actually sold in England (*n*), this will invalidate a subsequent patent.

Publication in England in foreign books.

In the case of a book published in England, no evidence is necessary to show that the book was in fact read or referred to (*o*). But if the

(*e*) 7 M. & G. 818, 842 ; 2 Webst. 141.

(*f*) 5 H. L. C. 707.

(*g*) 10 H. L. C. 117.

(*h*) *Stoner v. Todd*, 4 Ch. D. 58 ; *Lawrence v. Perry*, 2 R. P. C. 179, 187.

(*i*) See *post*, p. 190.

(*k*) Per FRY, L.J., *Humpherson v. Syer*, 4 R. P. C. 407, 414 ; *Gadd v. Mayor of Manchester*, 9 R. P. C. 516.

(*l*) Per COTTON and LINDLEY, L.J.J., *Harris v. Rothwell*, 35 Ch. D. 429.

(*m*) *Househill Co. v. Neilson*, 1 Webst. 673, 718, n. ; *Heurteloup's Patent*, 1 Webst. 553 ; *Harris v. Rothwell*, 35 Ch. D. 416, 428.

(*n*) *Lang v. Gisborne*, 31 Beav. 133.

(*o*) *Harris v. Rothwell*, 35 Ch. D. 416, 428.

book relied on be a foreign work, it must be shown that it has been published in this country in such a way as to become part of the public stock of knowledge in this country (*p*). And, therefore, where the only publication proved is that a foreign book containing the alleged antecedent description has been deposited in a public library in this country, but is not there in such a position as to be accessible to the public; as, for instance, where an American book which was sent to the Patent Office Library was not entered in the donation book or in a catalogue, but was put into a private room (*q*), or on a shelf in a public corridor, or in a room where other American books were kept, not the principal room in the library (*r*), there is no sufficient publication (*s*). But in *Harris v. Rothwell* (*t*), where two foreign specifications alleged to anticipate the plaintiff's invention were in the Patent Office Library in their proper places there, and translations of their titles had been published among a list of German patents in the Commissioners of Patents Journal, this was held sufficient *prima facie* evidence of publication, although it was not shown whether in fact anyone other than the librarian had seen them. And in this case it was held by LOPES, L.J., that the mere fact of the existence of the specifications in the library of the Patent Office, where they were unreservedly accessible to every one, was in itself conclusive evidence of a prior publication (*u*).

Sect. 29 (2, 3)

NOTE.

And in *Pickard v. Prescott* (*x*), where the patent being dated July 24th, it was proved that an article describing a construction identical with that in the alleged invention was published in a French periodical for June in the same year, and that copies of the periodical were sold by a firm of booksellers having houses in London and Edinburgh to persons residing in England and Scotland shortly before July 24th, and one of these copies was stated in the seller's periodical-book to have been delivered on July 10th, though the recipient could not say when he first read the article in question, it was held that prior publication was established, and the patent was invalidated.

From the case of *Heurteloup's Patent* (*y*), and some observations of JESSEL, M.R., in *Plimpton v. Malcolmson* (*z*), it would appear that if a foreign book has been in the British Museum a sufficient time to have been entered in the catalogue, the presumption is that it was read.

(*p*) See PEARSON, J., *Otto v. Steel*, 31 Ch. D. 243.

(*q*) *Plimpton v. Malcolmson*, 3 Ch. D. 531.

(*r*) *Plimpton v. Spiller*, 6 Ch. D. 412.

(*s*) See also *Harris v. Rothwell*, 35 Ch. D. 416, 431, *per* COTTON and LINDLEY, L.JJ.

(*t*) 35 Ch. D. 416.

(*u*) 35 Ch. D. 431.

(*x*) 7 R. P. C. 361; affirmed in H. L., [1892] A. C. 263; 9 R. P. C. 195.

(*y*) 1 Webst. 553.

(*z*) 3 Ch. D. 560.

Sect. 29 (2, 3) But in *Otto v. Steel* (a), PEARSON, J., refused to make that presumption, and declined to receive in evidence a book which, though in the British Museum, was not in the reading room, and could only be obtained by some person knowing of the book and asking for it, or by some person who, wishing to see works on a particular subject, had been taken to the section of the library where those works were to be found, and allowed to make his own selection, and which, though in the catalogue, was only catalogued under the name of the author (b).

NOTE.

And although, as a general rule, when it is said that a book is published in England it is assumed that it is publicly circulated, it may be that in fact it never was sold or circulated, or became part of the public knowledge, and if this were shown, the mere circumstance that it was published in the technical sense would not make its contents a publication which would vitiate a patent (c).

In *Lang v. Gisborne* (d), it was said by Lord ROMILLY, M.R., that as soon as an inventor informs the public of what his invention consists, and prints it in a book, which he sends to a publisher to sell, from the moment the book is exposed for sale in the bookseller's shop there becomes, in point of law, a complete publication of the invention. These observations are not, however, to be taken in a strict literal sense, but only in the sense that if a man publishes a book, that is, a large number of copies, and sends them to a bookseller for sale, and they are for a reasonable time exposed in the window, then if the other side cannot prove that one has not been sold, it may be reasonably inferred that some have been sold (e).

The mere fact that a French book was catalogued under the name of the author in a French catalogue, and under a general heading in another French catalogue, and that large numbers of those catalogues were disposed of to libraries and various persons in this country, was held to be no proof of publication in the absence of evidence that there was any copy of the book in this country except one in the British Museum catalogued only under the author's name (f).

But where it was shown that the book in question was actually consulted by one person in this country, that was held sufficient, even though only two copies were shown to be in the country, and of these one was irregularly catalogued in the library to which it belonged (g).

(a) 31 Ch. D. 241, 245.

(b) See also observations of JAMES, L.J., *Plimpton v. Spiller*, 6 Ch. D. 429.

(c) See per JESSEL, M.R., *Plimpton v. Malcolmson*, 3 Ch. D. 531, 559; and per BRETT, L.J., *Plimpton v. Spiller*, 6 Ch. D. 435; *Harris v. Rothwell*, 35 Ch. D. 416, 428.

(d) 31 Beav. 135.

(e) Per JESSEL, M. R., *Plimpton v. Malcolmson*, 3 Ch. D. 562.

(f) *Otto v. Steel*, 31 Ch. D. 241, 244.

(g) *United Telephone Co. v. Harrison*, 21 Ch. D. 721, 731.

A foreign book not known in England will not invalidate a patent (*h*). **Sect. 29 (2. 3)**
 But if the book be known in England it makes no difference whether it is English or in a foreign language (*i*), if the latter is not one of those remote languages with which very few people in England would be acquainted (*k*).

NOTE.

This proposition is assumed in the cases of *United Telephone Co. v. Harrison*, and *Otto v. Steel*, cited above, and was expressly laid down by CHITTY, J., and afterwards by the Court of Appeal, in *Harris v. Rothwell* (*l*), where it was held that two German specifications in the Patent Office Library were sufficient publication of the invention to avoid the patent.

If the anticipation relied on is a prior English specification filed in the Patent Office, no proof is required of other publication of it, or of its even having been actually seen by the public (*m*). This arises from the fact that the second of two patents must be bad in law (*n*). Publication in an English specification.

The leading case on anticipation by prior specifications or printed books is *Hill v. Evans*, where the rule is thus stated by Lord WESTBURY, C. (*o*): "The antecedent statement must be such that a person of ordinary knowledge of the subject would at once perceive, understand, and be able practically to apply the discovery without the necessity of making further experiments and gaining further information before the invention can be made useful. If something remains to be ascertained which is necessary for the useful application of the discovery, that affords sufficient room for another valid patent." And again, "the information as to the alleged invention given by the prior publication must, for the purposes of practical utility, be equal to that given by the subsequent patent. The invention must be shown to have been before made known. Whatever, therefore, is essential to the invention must be read out of the prior publication. If specific details are necessary for the practical working and real utility of the alleged invention, they must be found substantially in the prior publication." Anticipation by specification or books.

And in *Ehrlich v. Ihlee* (*p*) it was held that the prior description must be of such a character as to enable anyone, competent to make the machine

(*h*) Per Lord BROUGHAM in *Househill Co. v. Neilson*, 1 Webst. 718, n.; per Lord CAMPBELL, *Soames' Patent*, 1 Webst. 733.

(*i*) *Lang v. Gisborne*, 31 Beav. 133.

(*k*) Per CHITTY, J., *Harris v. Rothwell*, 35 Ch. D. 426.

(*l*) 35 Ch. D. 416.

(*m*) *Plimpton v. Malcolmson*, 3 Ch. D. 531, 557; *Harris v. Rothwell*, 35 Ch. D. 416, 428.

(*n*) See per COTTON and LINDLEY, L.J.J., in *Harris v. Rothwell*, *ubi supra*.

(*o*) 4 D. F. & J. 300, 301. See also *Neilson v. Betts*, L. R. 5 H. L. 1, 15, 24; *Von Heyden v. Neustadt*, 50 L. J. Ch. 126; *Plimpton v. Malcolmson*, 3 Ch. D. 531, 567, 568.

(*p*) 5 R. P. C. 437, 450, judgment of COTTON, L. J.

Sect. 29 (2, 3) for which protection is claimed by the patentee, to make it from the description given.

NOTE. The rule as to anticipation in writing has also been stated as follows:—

“It is not sufficient to say that if a machine were made by a person who had read that writing, something in that machine would, if it had been really a machine used, have been by reason of that user an anticipation of the plaintiff's patent. You must go further where you allege that the anticipation is in writing, and in writing only, and you must show that a person conversant with such matters, reading that writing, would find in the writing alone a reasonably clear description of the plaintiff's invention. If it requires that a machine should be made in order that the anticipation may be seen, the subsequent inventor is not obliged, when his attention is called to a mere writing, to make a machine from it, in order to see what will be the effect of that machine. He has to find a description of his own invention on the face of that writing, construing that writing reasonably as describing an invention” (q).

Distinction between sufficiency of specification and prior publication.

Upon this question it has been said, by GROVE, J., “there is not the same necessity for accurate description of how an invention shall be carried into effect, for the purpose of anticipating an invention, as there is for the purpose of sustaining a patent in the hands of a patentee, because in the latter case a description ought to be given which ought not to merely inform the minds of every skilled person or scientific person in the trade, but should inform the minds of ordinary people who are accustomed to work at the trade. Therefore I think that there is a distinction, but I am willing to rest my definition or description of what anticipates a patent on this, that there must be a publication which, when read by persons versed in the trade, skilful and well acquainted with the trade (I might even limit it perhaps to those in the trade who are most skilled—the higher class of skilled workmen) would enable them to understand it” (r).

Insufficient specification may be a prior publication.

And in *Anglo-American Brush Co. v. King, Brown & Co.* (s), it was said by Lord WATSON that the sufficiency or insufficiency of the previous specification for the guidance of a skilled workman “does not afford a crucial test of prior publication. Every patentee as a condition of his exclusive privilege is bound to describe his invention in such detail as to enable a workman of ordinary skill to practise it, and the penalty

(q) *Otto v. Linford*, 46 L. T. (N.S.) 39, 44, judgment of BRETT, L.J. See also *Gadd v. Mayor of Manchester*, 9 R. P. C. 532; *Shrewsbury and Talbot Cab Co. v. Sterckx*,

13 R. P. C. 44, 52; *Thomson v. Batty*, 6 R. P. C. 84, 99.

(r) *Philpott v. Hanbury*, 2 R. P. C. 43.

(s) [1892] A. C. 367, 378.

of non-compliance with that condition is forfeiture of his privilege. **Sect. 29 (2, 3)**
 His patent-right may be invalid by reason of non-compliance, but it certainly does not follow that his invention has not been published. His specification may, notwithstanding that defect, be sufficient to convey to men of science and employers of labour information which will enable them without any exercise of inventive ingenuity to understand his invention and to give a workman the specific directions which he failed to communicate. In that case I cannot doubt that his invention is published as completely as if his description had been intelligible to a workman of ordinary skill" (t).

NOTE.

But it must not be assumed necessarily that information which is given in an unworkable patent, because in terms it is sufficiently described, is that kind of information which gives the world new knowledge (u).

In estimating the significance of a prior specification brought forward as an anticipation, it is necessary to consider what amount of information with respect to the subject of the specification is to be attributed to persons who had an opportunity of reading it when it was first published, and a previous specification on the same subject may be assumed to be within the knowledge of such persons. Thus, when in an action for infringement of a patent of 1878 for a series-shunt-wound dynamo electric machine a specification of Varley of 1876 was alleged as a prior publication, and there was no doubt that a reader acquainted only with series-winding would not attach the same meaning to the words as would naturally occur to one who was also familiar with the shunt, or with the shunt and series-shunt systems of winding, it was held that the reader of Varley's specification in 1876 must be assumed to be acquainted with a previous specification of Clark of 1875 which was for a shunt-wound machine, and this, notwithstanding eminent electricians deposed that they did not know of Clark's machine until after the date of plaintiff's patent (x).

A picture of a machine published in a book without description might be sufficient to avoid a subsequent patent (y). And it would seem that a worthless and abandoned patent may be an anticipation (z).

But "you must not give people mechanical problems and call them specifications" (a). Thus in the well-known roller skate case, where the

(t) See also *Betts v. Neilson*, L. R. 3 Ch. 429, 432.

(u) Per BOWEN, L.J., *American Braided Wire Co. v. Thomson*, 5 R. P. C. 113, 125.

(x) *Anglo-American Brush Electric Light Co. v. King, Brown & Co.*, [1892] A. C. 367, 376, 377.

(y) *Herrburger v. Squire*, 6 R. P. C. 194.

(z) *Kaye v. Chubb*, 5 R. P. C. 641.

(a) Per JESSEL, M.R., *Plimpton v. Malcolmson*, 3 Ch. D. 576.

Sect. 29 (2, 3) only knowledge in England at the date of the patent was derived from a copy of an American journal containing a drawing of the skate with a copy of the claims of the American patent and a note by the editor very briefly describing the invention, and the expert witnesses differed as to the meaning of the letterpress and drawing, it was held that this was not sufficient publication to avoid the patent (*b*).

NOTE.

And where a specification for obtaining dyes from rhodamines described as the initial step the production of a potassium salt of rhodamine which was subsequently treated in a particular way, and it appeared that the potassium salt was non-existent, and chemically impossible, it was held that this was no anticipation of a subsequent patent which started from the unconverted rhodamine base, and was founded on a new discovery that rhodamine was itself capable of behaving as an acid, although the actual steps of the treatment of the rhodamine base were very similar to the treatment of the so-called potassium salt in the earlier specification (*c*).

The existence of a chemical patent wherein the combined effect of two or more chemicals is claimed in order to bring about a desired result does not constitute an anticipation of a subsequent discovery that by the use of any one of the named chemicals the desired result can be attained (*d*).

Distinction between technical and scientific literature as to anticipation.

With reference to prior publication alleged to anticipate a patent for a chemical invention, it is to be remembered that there are two distinct forms of literature on the subject: the systematic scientific literature and the technical literature; and the distinction is one very important to be borne in mind in dealing with such patents, since publications having reference to chemical science will be studied by scientific chemists, but, speaking generally, such publications are not sought after and studied by the practical working chemist (*e*).

And when it requires a "mosaic of extracts" from annals and treatises, spread over a series of years, to prove the want of novelty, the contention stands thereby self-condemned (*f*).

Prior user

But the public may have become possessed of the invention through its having been in use before the patent.

(*b*) *Plimpton v. Malcolmson, ubi supra*. See also *Lewis & Stirkler's Patent*, 14 R. P. C. 24.

(*c*) *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône*, 14 R. P. C. 875.

(*d*) *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate*, 12 R. P. C. 232, 256.

(*e*) See *per* BAGGALLAY, L.J., *Badische Anilin und Soda Fabrik v. Lerinstein*, 29 Ch. D. 384.

(*f*) *Per* JAMES, L. J., *Von Heyden v. Neustadt*, 50 L. J. Ch. 126. See also *Young v. Fernie*, 4 Giff. 577.

There is a considerable difference between publication by prior user and publication in a book or specification. In the latter case, as we have seen, the invention must be so published as to become part of the public knowledge. But when it is said that a process has been disclosed or an invention has been disclosed by means of user, it is not necessary that such user should be a user by the public proper, provided only there is a user in public (g).

Sect. 29 (2, 3)

NOTE.
Difference between anticipation by prior user and by specification.

It is doubtful whether the production of a machine made for a particular purpose, and which would accomplish when used results not thought of when it was made, would without any user be an anticipation; but "it is clear that the machine if used so that the public could ascertain what it would effect, would be an anticipation. But that is quite different from producing as an anticipation a specification, for you cannot tell, except from the language of the specification, what results the contemplated machine may accomplish" (h).

The rule as to public use is thus stated by GROVE, J. :—"If the invention was in public use before, even by one person, the patent is bad. Mere private use in the closet, mere experimental working in a laboratory without publishing the invention, but keeping it a secret, with a view possibly of a patent being taken out, would not invalidate it. But if it is once publicly used or sold in a shop, or publicly used in a carriage, or on the person, or in any such way, then the public have a right to it, and the patent is bad" (i). By the publication of an invention is meant an addition to the stock of knowledge which the public either has or can acquire by consulting some source of information open to it. The word "publication" has not the same meaning when used with reference to patents as it has when used with reference to libels or slanders (k).

Public use.

Meaning of "publication."

Therefore, a mere private use, as the use in an observatory of certain object glasses for telescopes, there being no publication of the mode of construction or use (l); or mere experiments never communicated to the world, and laid by as forgotten things (m), will not avoid a subsequent patent.

Private use or experiments.

(g) Per POLLOCK, B., *Croysdale v. Fisher*, 1 R. P. C. 14, 21; per ALDERSON, B., and Lord ABINGER, *C. B. Carpenter v. Smith*, 1 Webst. 543.

(h) See per HOLKER, L.J., *Otto v. Linford*, 46 L. T. (N.S.) 39, 46.

(i) *Young v. Rosenthal*, 1 R. P. C. 29, 32.

(k) Per LINDLEY, L.J., *Gadd v. Mayor, etc. of Manchester*, 9 R. P. C.

517, 527. See also *Sunlight Incandescent Co. v. Incandescent Gas Light Co.*, 14 R. P. C. 757, 774.

(l) *Dollond v. —*, 1 Carpmael, P. C. 28; 1 Webst. 43.

(m) *Cornish v. Keene*, 1 Webst. 508; *Galloway v. Bleaden*, 1 Webst. 529; *Moseley v. Victoria Rubber Co.*, 4 R. P. C. 241; *Humpherson v. Syer*, 4 R. P. C. 184, 188; *Mathews v. Parmenter*, 13 R. P. C. 514.

Sect. 29 (2, 3) And when a person communicated an invention (which another subsequently invented independently and patented) confidentially to third parties, who knew that he did not intend to publish it, and who did not themselves publish it; it was held that there was no publication which would avoid the subsequent patent (*n*).

NOTE.

And the use for a year in a cart on a public road of a peculiar construction of wheel, which was afterwards abandoned on account of defects (*o*), and the use in a workyard of a new form of pulley, which was afterwards thrown aside (*p*), and the use of a certain form of wood pavement as a carriageway (*q*), and the construction of a model of tramway crossings which was left for some time in the sheds of a tramway company, and was afterwards seen by persons to whom the designer of the model showed it in his private room, but of which no practical use had ever been made, and which was ultimately laid aside (*r*), were all held to be no bar to the validity of patents obtained by other inventors for the same or very similar articles, in which the old defects were for the first time remedied.

So, also, where a previous inventor had, before taking out a patent for purifying coal gas, used in large quantities oxides of iron, and had used oxides which were actually hydrated, but had not known that hydrated oxides produced the best results, and had, in fact, desired to render his oxides anhydrous, and the jury found that this user was by way of experiment; it was held that a subsequent patent granted to another person for the use of hydrated oxides for the like purpose was good (*s*).

The abandonment of an invention is a very strong presumption that it was only an experiment, not an invention completed (*t*).

Secret use
of invention

Where there has been no more than a secret use of the invention by the inventor with a view to taking out a patent (*u*), or the manufacture for the inventor, and under injunctions as to secrecy, by a manufacturer (*x*), or by the inventor's own workmen (*y*), the patent will be good. But this will not be the case where the invention was

(*n*) *Gadd v. Mayor, etc., of Manchester*, 9 R. P. C. 249, 517.

(*o*) *Jones v. Pearce*, 1 Webst. 124.

(*p*) *Tungye v. Stott*, W. N. 1866, p. 68.

(*q*) *Stead v. Williams*, 2 Webst. 135.

(*r*) *Winby v. Manchester, etc., Tramways Co.*, 6 R. P. C. 359.

(*s*) *Hills v. London Gaslight Co.*, 5 H. & N. 312. See also *Otto v. Linford*, 46 L. T. (N.S.) 39.

(*t*) See *per* Lord BROUGHAM,

Househill Co. v. Neilson, 1 Webst. 713; *Morgan v. Windover*, 5 R. P. C. 295, 303.

(*u*) *Smith v. Davidson*, 19 C. B. 690. See also *Bentley v. Fleming*, 1 Car. & K. 587.

(*x*) *Morgan v. Seaward*, 1 Webst. 187; *Useful Patents Co. v. Rylands*, 2 R. P. C. 255; *Humpherson v. Syer*, 4 R. P. C. 407; *Kurtz v. Spence*, 5 R. P. C. 161.

(*y*) *Betts v. Menzies*, 1 E. & E. 1008.

communicated to a third person in a manner which, both in law and equity, allowed him to do what he liked with the information (z). And the public exhibition of a lifeboat with a collapsible gunwale, where no precautions as to secrecy were taken, and accounts of the exhibition appeared in a newspaper, was held to invalidate a subsequent patent (a). Sect. 29 (2, 3)

NOTE.

Where the invention was disclosed to public officers who could not keep it secret without a breach of duty, the disclosure was considered as made to the public, and a subsequent patent was held invalid (b). Disclosure to public officers.

The question may arise whether the public sale of an article which in no way discloses the process employed in its manufacture will of itself invalidate a subsequent patent for the process. Previous sale of article made by secret process.

Where the sale has been by the person who afterwards becomes the patentee the patent is void, because if the inventor could sell the invention, keeping the secret to himself, and when it was likely to be discovered by another take out a patent, he might have practically a monopoly for a much longer period than fourteen years (c). Previous sale by patentee.

Thus, in *Wood v. Zimmer* (d), where the patent was for a method of making verdigris, it appeared that the patentee had sold the article in the public market four months before the date of the patent, and the patent was held invalid.

So also in *Germ Milling Co. v. Robinson* (e), where the action was for infringement of a patent for improvements in the manufacture of meal and flour from wheat and other grain, the patentee, in his examination-in-chief, stated that he had made flour according to his process before the date of the patent, and had sold such flour in the ordinary course of his business, and on this evidence the action was dismissed.

If the sale prior to the patent has been by some person other than the subsequent patentee different considerations apply, and there appears to be a difference of judicial opinion as to the effect of such a sale on the validity of the patent. Previous sale by persons other than patentee.

Thus, in *Hancock v. Somervell* (f), an action for infringement of a patent for improvements in the preparation of caoutchouc, it was shown by way of anticipation that shoes made of the prepared material had been sold in England previously to the patent, and Sir E. VAUGHAN

(z) See per BOWEN, L.J., *Humpherson v. Syer*, 4 R. P. C. 407, 413.

(a) *Lifeboat Co. v. Chambers*, 8 R. P. C. 418.

(b) *Patterson v. Gas Light & Coke Co.*, 3 App. Cas. 239, 245.

(c) See per PARKE, B., *Morgan v. Seaward*, 1 Webst. 187, 194. See

also per BOWEN, L.J., *Germ Milling Co. v. Robinson* (No. 2), 3 R. P. C. 400, 408.

(d) 1 Webst. 44.

(e) 3 R. P. C. 254, 259, 408.

(f) 39 Newton's London Journal, 158, 165, Higgins 236, cited in Johnson's Pat. Man. 40.

Sect. 29 (2, 3) WILLIAMS, J., directed the jury as follows: "If you should come to the conclusion upon the facts that the material was in use before the date of the patent, then the question resolves itself into this,— what is your opinion as to whether the publication of the material was substantially a publication of the invention? If you should find that the material was in public use, but that, notwithstanding it were so, the invention remained still a matter to be discovered, why then, in my opinion, the plaintiff's case would not be affected by the circumstance of the material being in public use. But if, on the other hand, you should think not only that the material was in public use (and I should here say that I do not think it is necessary the use should be actually for sale,—if it were in public use it need not be sold—it would be sufficient, for instance, if it were in use, handed about the country for the purpose of attracting customers),—if you should think also that, the material being so in use it was so palpable how you could make it when you got the material, that substantially, the disclosure of the material was a disclosure of the means of making it,—if you do not think that, then I think the plaintiff's case is unaffected by the circumstance of the material being before the public in the way I have just been describing to you."

NOTE.

In the recent case of *The Sunlight Incandescent Gas Lamp Co. v. The Incandescent Gaslight Co. (g)*, the patent was for a method of treating certain mantles for producing light by incandescence known as the "Welsbach mantles" in a particular manner for the purpose of avoiding danger of breakage in handling and packing, and so that the protecting material could be burnt off without injuring the mantle. It appeared that one C., a foreigner, had brought into this country certain mantles performing the same functions as the *Welsbach* mantle, but made of a different material, and strengthened by means substantially the same as the patented process, and with the same object, and had exhibited and burnt his mantles in public before the date of the patent. It was shown, however, that the burning off of the protecting material was done by the exhibitor only when he wanted to change his mantle, not showing people what he was doing, and that all that the public saw was the good result of the incandescence. On these facts it was held that there had been no publication of the plaintiff's process which would invalidate the patent.

On the other hand, in *Heath v. Smith (h)*, which was an invention of a process for making steel, it was shown that previously to the patent the process had been used by five firms, of whom three had used the process openly, and the other two in secret. The patent was held bad on the ground of the previous publication by the three firms, but

(g) 14 R. P. C. 757.

(h) 2 Webst. 258, 278; 3 E. & B. 256, 273.

ERLE, J., said he was disposed to go further, and that if one party only had used the process and had brought out the article for profit and kept the method entirely secret he was not prepared to say that then the patent would have been valid. And in the same case Lord CAMPBELL, C.J., added: "If we had held this patent valid, the five firms would all have been liable to an action for exercising the invention after the patent had been taken out. Nothing in the statute gives an exception in such a case. So that if we had held a person entitled to a patent for the discovery of a process openly practised by others for their own profit, but without a public announcement of the method, the action would lie against them; there is no ground for contending that there is anything exempting such parties from liability. Now, see what that comes to. If any man makes a discovery and uses it without taking out a patent, and does not announce it by sound of trumpet, or calling in the public as spectators, he must suspend the use of his discovery if another person subsequently makes the same discovery and takes out a patent for it. That would be the consequence of the principle for which the plaintiff is driven to contend."

Sect. 29 (2, 3)

NOTE.

In the case of *Cornish v. Keene (i)*, it was said by TINDAL, C.J., that if the defendants had shown that they practised the invention and produced the same result in their factory before the patent was obtained, they could not be prevented by the subsequent patent from going on with that which they had done. The question whether it would be a good test of the validity of a patent to say that a person who had been doing certain things in England could be stopped by the patent, was raised in *The Sunlight Incandescent Gas Lamp Co. v. The Incandescent Gaslight Co.* cited above, but was expressly left undecided, as in that case the patent applied only to *Welsbach* mantles, and could not therefore prevent the person who had previously used the process from continuing to apply it to his own mantle.

Patent cannot stop persons from continuing what they had done before.

The experimental use of a machine by the inventor, though more or less a user in public, is not necessarily such a dedication to the public as to defeat subsequent patents for it. Thus the patent was sustained where an inventor lent his machine to a friend, to be used in his mill, in order that he might discover, by testing its utility, whether it was worth while to patent it (*k*). And in *Honiball v. Bloomer (l)*, a case of an anchor, afterwards patented, which was previously used on board ship, it was said by MARTIN, B., that if it had been put on the ship for

Experimental use by inventor.

(i) 1 Webst. 501, 511. And see *K. 587; Mathews v. Parmenter*, 13 R. P. C. 514.

(k) *Bentley v. Fleming*, 1 Car. & (l) 2 Webst. 200.

Sect. 29(2, 3) the purpose of trying whether it would answer, and did not answer, and was returned on that ground, that would not interfere with the patent (*m*).

NOTE.

And the fact that the inventor derives profit from an experiment, which, if made at all, must be made on a large scale, and in the presence of others, does not of itself make the experiment a dedication to the public (*n*).

But if the user in public is not for the simple purpose of testing, but for the purpose of carrying out a contract, the invention cannot afterwards be patented (*o*).

Exhibition of
useless
machine.

The mere exhibition of a useless machine, which turns out a failure, will not affect the right of a patentee who has made a successful machine, though there may be a degree of similarity between some of the details of the two machines (*p*).

So, also, the mere exhibition to a few persons of a model brought from abroad, no machine having been made from it, and the very persons who had seen the model having afterwards bought and used the patented machines, was not held sufficient public use to invalidate the patent (*q*).

The publication by an inventor that a particular result is desirable is no anticipation of a subsequent patent for obtaining that result (*r*).

It has been doubted whether the mere preparation of a plan submitted to directors of a company, not intended to go beyond the board-room and the office of the engineer and architect consulted by the board, would be an anticipation sufficient to invalidate a subsequent patent (*s*).

What public
use avoids
patent

If the invention has been publicly used before the patent, the patent is void, even though the user be by one person only (*t*), or be of only one specimen of the patented article, as the use of a lock on a gate (*u*), or the use of one anchor on a particular ship (*x*), or a fire-grate

(*m*) See also *per* Lord LYNDHURST, L.C., *Househill Co. v. Neilson*, 1 Webst. 708.

(*n*) *Re Newall and Elliott*, 4 C. B. (N.S.) 269, 293; *Morgan v. Seaward*, 1 Webst. 194.

(*o*) *Adamson's Patent*, 6 D.M.&G. 420; 25 L. J. Ch. 456.

(*p*) *Per* JAMES, L.J., *Murray v. Clayton*, L. R. 7 Ch. 581; and see *Barlow v. Baylis*, Griffin, P. C. 44; *Daw v. Eley*, L. R. 3 Eq. 496; *Pneumatic Tyre Co. v. East London Rubber Co.*, 14 R. P. C. 77, 103.

(*q*) *Lewis v. Marling*, 1 Webst. 493, 495.

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

(*s*) *Tickelpenny v. Army & Navy Co-operative Society*, 5 R. P. C. 405, 410.

(*t*) *Per* CRESSWELL, J., *Stead v. Williams*, 2 Webst. 136; *Heath v. Smith*, 2 Webst. 278.

(*u*) *Carpenter v. Smith*, 1 Webst. 530, 534. See, however, observations of STUART, V.-C., on this case. *Young v. Fernie*, 4 Giff. 577.

(*x*) *Honiball v. Bloomer*, 10 Ex. 538; *Honiball's Patent*, 2 Webst. 201, 209.

in the hall of a house (*y*), or the use by one man on public roads, and for business or pleasure, of a tricycle invented by himself (*z*). In all these cases the prior user was held sufficient to invalidate the patent. Sect. 29 (2, 3)

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NOTE.

There has been no decision on the question whether if an invention had been formerly used and abandoned many years ago, and the whole thing lost sight of and not known to the public, a new inventor could have a patent. The question was stated, but expressly left undecided in the case of *The Househill Co. v. Neilson*; it was, however, suggested by Lord BROUGHAM, in that case, that it was like a new discovery (*a*).

Public use, sufficient to defeat a patent, may be shown without its being necessary to prove use in an actually public place, as in a market place. It is sufficient if it be without concealment, as where the article was openly manufactured (*b*), or exhibited (*c*) in a shop, all the workmen knowing of the method, or when the article (a lifeboat with collapsible gunwale) was publicly exhibited in a shipbuilding yard with no precautions for secrecy, and accounts of the exhibition had appeared in the newspapers (*d*). And this will be the case if the article has been manufactured openly, even though not a single piece has been actually sold (*e*). Use in a public place need not be proved.

A person who has himself practised any process cannot be deprived, by any subsequent patent, from going on with what he has done before (*f*).

And, therefore, where, in an action for infringement of a patent for imitation sealskins, defendants showed that they had themselves made the article openly in their workshop, though only in a small quantity, and by way of a pattern, and though they had, in fact, never made any in pieces till after the plaintiff's patent, it was held that the plaintiff's patent was invalid (*g*).

Prior user in a colony does not invalidate an English patent (*h*).

(*y*) *Re Taylor's Patent*, 13 R. P. C. 482.

(*z*) *Brereton v. Richardson*, 1 R. P. C. 177.

(*a*) 1 Webst. 717. See, however, observations of COLERIDGE, C.J., in *Morgan v. Windover*, 5 R. P. C. 306.

(*b*) *Heath v. Smith*, 2 Webst. 268; *Croysdale v. Fisher*, 1 R. P. C. 17; *Lister v. Norton*, 3 R. P. C. 199; *Podmore v. Wright*, 5 R. P. C. 380; *Westley Richards v. Perkes*, 10 R. P. C. 181.

(*c*) *Humpherson v. Syer*, 4 R. P. C. 407.

(*d*) *Lifeboat Co. v. Chambers*, 8 R. P. C. 418.

(*e*) *Per* Lord CHELMSFORD, C., *Betts v. Neilson*, L. R. 3 Ch. 436.

(*f*) *Per* TINDAL, C.J., *Cornish v. Keene*, 1 Webst. 511. See also *Heath v. Smith*, 2 Webst. 268, 279; 3 E. & B. 273; *Kay v. Marshall*, 2 Webst. 82; *Ralston v. Smith*, 11 H. L. C. 223.

(*g*) *Lister v. Norton*, 3 R. P. C. 199, 210.

(*h*) *Rolls v. Isaacs*, 19 Ch. D. 268.

Sect. 29 (2, 3) If the invention has been once publicly used, it is not necessary in order to defeat a subsequent patent that the user should be continuous down to the time of the patent (*i*).

NOTE.

Public sale. The public sale of an article before the date of the patent is evidence of the invention having been used and exercised for the purposes of commerce, and not simply for purpose of experiment (*k*). Therefore, where before the patent even a single specimen of the article is sold (*l*), the patent is void, and it is immaterial whether the articles sold were made abroad or in England (*m*).

And the result will be the same even though the articles are made and sold in this country for export, and at once sent abroad (*n*); or the sale is a mere experiment to ascertain if the goods would stand wear, or that buyers would take to the goods (*o*).

Offering for sale. The exhibition, with a view to obtain orders, of the articles subsequently patented (*p*), or the deposit of the articles in a warehouse for sale (*q*), is sufficient to defeat the patent, even though no actual sale is proved.

Subject-matter—A common objection to the validity of a patent is want of subject-matter. The form which this objection generally takes is that in the patentee's contrivance there is not sufficient "invention" to sustain the patent. "If a patentee would succeed it is necessary for him to show not merely newness, in the sense of doing a thing which has not been done before, but he must show newness in the shape of novelty, by producing a thing which requires some exertion of mind that would properly be called invention" (*r*).

Difference between invention and discovery. An invention is not the same thing as a discovery. A man who discovers that a known machine can produce effects that no one before him knew could be produced by it may make a great and useful discovery, but if he does no more his discovery is not a patentable

(*i*) *Househill Co. v. Neilson*, 1 Webst. 709; 9 Cl. & F. 788, correcting an inference which had been drawn from certain expressions in the judgment of PATTESON, J., in *Jones v. Pearce*, 1 Webst. 123. See also *Tangye v. Stott*, W. N. 1866, p. 68.

(*k*) *Wood v. Zimmer*, 1 Webst. 44; *Germ Milling Co. v. Robinson* (No. 2), 3 R. P. C. 405.

(*l*) *Honiball v. Bloomer*, 2 Webst. 199. See also *Germ Milling Co. v. Robinson* (No. 2), 3 R. P. C. 399; *Hollins v. Capper*, 5 R. P. C. 289.

(*m*) *Jensen v. Smith*, 2 R. P. C. 249.

(*n*) *Carpenter v. Smith*, 1 Webst. 541.

(*o*) *Lister v. Norton*, 3 R. P. C. 199, 207.

(*p*) *Ibid.*

(*q*) *Mullins v. Hart*, 3 Car. & K. 297.

(*r*) *Per WILLES, J., Tatham v. Dania*, Griffin, P. C. 213. See also *Blakey v. Latham*, 6 R. P. C. 184, 187, and observations of COTTON, L.J., *Williams v. Nye*, 7 R. P. C. 62, 67. See also *Pascall v. Toope* (2), 8 R. P. C. 1.

invention. He has added nothing but knowledge to what previously existed. A patentee must do something more; he must make some addition not only to knowledge but to previously known inventions, and must so use his knowledge and ingenuity as to produce either a new and useful thing or result, or a new and useful method of producing an old thing or result (s).

Sect. 29 (2, 3)

NOTE.

And in *Lancashire Explosives Co. v. The Roburite Explosives Co.* (t), RIGBY, L. J. said, "Invention consists in many cases in putting together items of common knowledge which no one else has ever thought of combining."

The question of invention is in each case a question of fact depending on a true view of all the circumstances of the particular case, and cannot be governed by a finding of fact on a totally different invention by another tribunal (u).

A leading case on this subject is *Harwood v. The Great Northern Rail. Co.* (x). In that case, the patent was for what were called fish-joints for connecting the rails of railways. The invention consisted in forming a groove in the sides of each fish, adapted for receiving the heads of the bolts employed for securing such fishes. It was proved that the same contrivance had been used for the purpose of connecting timbers placed vertically upon one another; and it was held that there could not be a patent "for a well-known mechanical contrivance, merely when it was applied in the manner or to a purpose which was not quite the same but is analogous to the manner or purpose in or for which it had been hitherto notoriously used," and that there being no novelty in the application, the patent was held invalid (y).

Patents for new application of old machines to analogous purposes bad.

On these grounds, a patent for an improvement in finishing yarns of wool or hair by the action of rotary beaters or burnishers, it being shown that the same method had been previously known for finishing cotton and linen yarns (z), was held invalid. So, also, the construction of a caisson for working under water, the same apparatus having been used for working on land, to diminish the influx of water (a); or the

(s) *Per* LINDLEY, L.J., *Lane Fox v. Kensington, etc. Co.*, [1892] 3 Ch. 424, 428.

(t) 12 R. P. C. 471, 482. See also *per* STUART, V.-C., *Young v. Furnie*, 4 Giff. at p. 611.

(u) *Lyon v. Goddard*, 10 R. P. C. 121, 335, 346; 11 R. P. C. 354.

(x) 11 H. L. C. 654.

(y) See *per* LINDLEY, L.J. *Gadd v. Mayor of Manchester*, 9 R. P. C. 524; *Moser v. Marsden*, 10 R. P. C. 358; *Lane Fox v. Kensington, etc.*, [1892] 3 Ch. 424; *Wood v. Raphael*,

13 R. P. C. 733; *Leadbetter v. Kitchen*, 7 R. P. C. 235. For a careful discussion of all the cases, see judgment of FITZGIBBON, L.J., *Pirrie v. York Street, etc. Co.* 11 R. P. C. 447.

(z) *Brook v. Aston*, 8 E. & B. 478. See also *Losh v. Hague*, 1 Webst. 200; *Tatham v. Dania*, Griffin, P. C. 213.

(a) *Bush v. Fox*, 5 H. L. C. 709. See also *Longbottom v. Shaw*, 6 R. P. C. 147; *Pow v. Taunton*, 9 Jur. (O.S.) 1056.

Sect. 29 (2, 3) construction of iron frames for ships adapted to an external covering of timber planking, the construction of ships with frames partly of iron and partly of wood and with an iron coating on iron frames being previously known (*b*); or the use of a mandril for forming bottle cases of straw, the like use for producing given forms of pliable materials being old (*c*),—were held insufficient subject-matter for patents.

NOTE.

And, where in a carriage certain springs known as C springs, and admitted to be old, had been used fixed to the back of the carriage and to the axle of the back wheel, and these springs were taken by the patentee and used by him in a particular way in the front part of his carriage, it was held, that there was not sufficient invention to sustain the patent (*d*).

And the mode of making embossed metal by pressing it between a suitable punch and a yielding support instead of the ordinary matrix, the use of a yielding substance for the matrix being known for flexible materials (*e*); and the use in oil spray lamps of the steam on the surface of water to neutralize certain back pressure, the use in oil vapour lamps of the vapour of oil on the surface of oil to neutralize a like back pressure being known (*f*), were held not good subject-matter.

Use of known application in same article for new purposes.

The use for a new purpose of a known appliance, applied in a known way to the same article to which it was formerly applied, is not patentable (*g*).

Thus the mere placing on the front of a lock a known mechanism for moving the catch, which mechanism was formerly at the side (*h*), and the use of split ferrules soldered along the split for securing elastic tyres on bicycles, such use being known in various kinds of wire work for joints (*i*), and the application to boiler tubes of a water joint, well known as applied to hot water coils (*k*), and the shaping of the heels of socks by adding widenings to the heels, widening being an old process as applied to other parts of the sock (*l*), were all held to be no subject-matter.

(*b*) *Jordan v. Moore*, L. R. 1 C. P. 624. See also *Rowcliffe v. Longford Wire, etc. Co.* 4 R. P. C. 281. See also *Ormson v. Clarke*, 13 C. B. (N.S.) 337; 14 C. B. (N.S.) 475; *Newsum v. Mann*, 7 R. P. C. 307.

(*c*) *Patent Bottle Envelope Co. v. Seymer*, 5 C. B. (N.S.) 164. See also *Longbottom v. Shaw*, 6 R. P. C. 143; 8 R. P. C. 333; *re Edmonds' Patent*, 6 R. P. C. 355, 357.

(*d*) *Morgan v. Windover*, 7 R. P. C. 131 (H. L.).

(*e*) *Embossed Metal Plate Co. v. Saupé and Busch*, 8 R. P. C. 355.

(*f*) *Rose's Patents Co. v. Braby*, 11 R. P. C. 198.

(*g*) *Elias v. Grovesend Tin Plate Co.* 7 R. P. C. 455; *Deutsche Nähmaschinen Fabrik v. Pfaff*, 7 R. P. C. 16, 251.

(*h*) *Tucker v. Kaye*, 8 R. P. C. 58.

(*i*) *Shaw v. Barton*, 12 R. P. C. 282.

(*k*) *Baker v. Kinnell*, 9 R. P. C. 441.

(*l*) *Sudbury v. Lee*, 11 R. P. C. 58.

And where in oil boxes a piston actuated by a screw was used for forcing the grease into a joint, the omission of the piston and the making the screw fill the whole of the cavity was held not to show sufficient invention to sustain the patent (*m*). Sect. 29 (2 3)
NOTE.

And where the alleged invention was the substitution of double-angle iron for two pieces of single-angle iron in the formation of joints to gas holders (*n*), or the substitution of steel hoops for whalebone hoops in a petticoat (*o*), or the replacing of a slide by a hinge in a glass lamp (*p*), or the substitution of a pivot for a hinge in a nail-making machine (*q*), or the use in bottles of a spherical barrel cock previously used in tea urns (*r*), or the substitution of clinker for granite in artificial stone (*s*), the patent was held void. Mere substitution of one material for another in known article.

And when a mincing machine consisting of a cutting part and a filling part was known, and an improved form of the cutting part was also known, it was held that the mere substitution in the machine of the improved for the old cutting part was not good subject-matter for a patent (*t*).

So, also, the use of a new material to produce a known article, as the use of Russian tops, or similar wool, in the manufacture of chignons, which were formerly made from mohair, is not a good subject-matter for a patent (*u*). New material to produce known article.

In all these cases the test appears to be "whether the new application lies so much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought and study" (*x*). "It must not be the obvious or natural suggestion of what was previously known" (*y*). The question in each case is whether the new application has invention in it, whether it is something novel, something which entitles the man who so applies the old appliance to a new purpose to describe himself as an inventor (*z*). Test as to patents for application of old machines.

(*m*) *Jensen v. Smith*, 2 R. P. C. 249.

(*n*) *Horton v. Mabon*, 16 C. B. (N.S.) 141.

(*o*) *Thompson v. James*, 32 Beav. 570.

(*p*) *Parke v. Stevens*, L. R. 8 Eq. 358, 367.

(*q*) *United Horse Shoe Nail Co. v. Swedish Horse Nail Co.* 6 R. P. C. 1, 8.

(*r*) *Hazlehurst v. Rylands*, 9 R. P. C. 1.

(*s*) *Adamant Stone and Paving Co. v. Corporation of Liverpool*, 14 R. P. C. 18.

(*t*) *Williams v. Nye*, 7 R. P. C. 37, 62.

(*u*) *Rushton v. Crawley*, L. R. 10 Eq. 522, and see observations of Lord WATSON, *Thomson v. American Braided Wire Co.* 6 R. P. C. 525.

(*r*) *Per* Lord CHELMSFORD, *Penn v. Bibby*, L. R. 2 Ch. 136. See also *per* LINDLEY, L.J. *Blakey v. Latham*, 6 R. P. C. 187.

(*y*) *Per* LINDLEY, L.J., *Blakey v. Latham*, 6 R. P. C. 189.

(*z*) *Per* CHARLES, J., *Young v. Morris*, 11 R. P. C. 617, 623. See also *per* Lord DAVEY, *Rickmann v. Thierry*, 14 R. P. C. 105, 121.

Sect. 29 (2, 3) And the objection of "analogous purpose" will not prevail if that analogous purpose cannot be fulfilled without a substantial variation in the instrument itself, or a distinct method of application requiring the exercise of the inventive faculties (a).

NOTE.

There may be cases in which a thing is used which would be identically the old one to produce a new product altogether, but applied to something so totally different that there is an obvious invention in it. Thus, it being known that macaroni pipe could be made by spinning flour into a pipe, an invention of spinning red hot iron, in the same way as the flour was spun into pipes for macaroni, would have been a patentable invention (b).

The use in wet spinning of flax of a flexible tube of paper on which the yarn was supported when spun, and to which it would adhere when dried, the tube being placed on a bobbin which revolved on the spindle was held good subject-matter for a patent, although these paper tubes had long been used in the dry spinning of cotton and other yarns, but for a different purpose (c).

And the adaptation of a filter-press to the manufacture of artificial stone from cement, or for making slabs of clay, filter-presses being well known for the purpose of removing water from cement and clay amongst other substances, but not for moulding such substances, and this mode of manufacture of artificial stone being shown to possess many advantages over the known methods, was held to involve sufficient invention and utility to support the patent (d).

And where the patent was for an invention to apply fillets of wood in the bearings of propellers in steamships, and the only examples of an old use proved were the use of wood in grindstones and water wheels for supporting the bearings, the patent was upheld (e).

So also when the invention was for a means of protecting from injury mantles for incandescent lighting which were of an extraordinary fragility of structure, and of a peculiar earthy constitution, it was held that a previous process of protecting the cotton wick of a moderator lamp by treating it in a manner similar to that in which the mantles were treated by the patentee, was too far from the plaintiff's invention to invalidate the patent (f).

(a) *Per* KEKEWICH, J., *Morgan v. Windover*, 4 R. P. C. 426, 427.

(b) See *per* BLACKBURN, J., *Bamlett v. Picksley*, Griffin, P. C. 40, 42.

(c) *Pirrie v. York Street Flax Spinning Co.* 10 R. P. C. 34; affirmed 11 R. P. C. 429.

(d) *Adamant Stone and Paving Co. Ltd. v. Corporation of Liverpool*, 14 R. P. C. 19.

(e) *Penn v. Bibby*, *ubi supra*.

(f) *Sunlight Incandescent, etc., Co. v. Incandescent Gas Light Co.* 14 R. P. C. 757, 773.

The rule, however, as to the application of old contrivances to analogous purposes does not necessarily apply to inventions in chemistry (g). Sect. 29 (2, 3)

NOTE.

And in an action for infringement of a chemical patent it was held in the House of Lords that it was no objection to the patent to say that, even though the particular substance patented was unknown, similar bodies, arrived at by similar processes, were well known, and that chemical analogy would at once indicate the supposed invention. "Analogy does not go a long way in chemistry" (h). Rule does not necessarily apply to chemical cases.

But where the use of naphthaline in solution had been used for enriching gas, but in that form had certain disadvantages, and naphthaline in a solid form was also known, it was held that a patent for enriching gas by means of solid naphthaline could not be sustained (i). And when in a patent for treating cotton oil mucilage so as to obtain soap stock, the plaintiff claimed the employment of chlorinated alkaline leys, or free chlorine gas, on an emulsion of or saponified fats or oils, and transforming them by destroying the colouring matter contained therein, and it was shewn that these agents had been used for the same purpose on identical, or if not identical, on exactly analogous substances, the patent was held void (k).

If the new invention is an entirely new article, the above considerations will not apply. Thus, in the well-known case of *Crane v. Price* (l), where the invention was the use of anthracite with hot-air blast for the smelting of iron, the use of the hot-air blast being known, and the use of anthracite with the cold blast being also known, but the use of the two together for the manufacture of iron being new, the patent was sustained, and Sir N. C. TINDAL, C. J., said :— Rule does not apply if article entirely new

"If the result produced by such a combination is either a new article or a better article or a cheaper article to the public than that produced before by the old method, such combination is an invention or manufacture intended by the statute, and may well become the subject of a patent. . . . There are numerous instances of patents which have been granted, where the invention consisted in no more than in the use of things already known, and acting with them in a manner already known, and producing effects already known, but producing those Combination patents.

(g) *Young v. Fernie*, 4 Giff. 577.

(h) *Badische Anilin und Soda Fabrik v. Levinstein*, 12 App. Cas. 710, 723, judgment of Lord HERSCHELL. See also *Farbenfabriken v. Bowker*, 8 R. P. C. 389.

(i) *Albo-Carbon Co. v. Kidd*, 4 R. P. C. 535.

(k) *Wilson v. Union Oil Mills Co.* 9 R. P. C. 57.

(l) 1 Webst. 409.

Sect. 29 (2, 3) effects so as to be more economically or beneficially enjoyed by the public" (m).

NOTE.

Thus, in *Cornish v. Keene* (n), where the use of elastic threads of india-rubber previously covered by filaments wound round them was old, and the use of yarn, of cotton, or other non-elastic material was old, but the placing them alternately side by side in a wrap, and combining them by a web when in extreme tension and deprived of their elasticity, was new, and the result, viz., a cloth, in which the non-elastic threads formed a limit up to which the elastic threads might be stretched, but beyond which they could not, was a new article, the invention was held good subject-matter for a patent. See also *Dowling v. Billington* (o), where a patent for making mattresses in a particular way by the use of old machinery, the mattresses thus made being new and useful, was upheld.

The adaptation to raising and lowering gas-tanks of means described in previous patents for an analogous purpose in floating docks and pontoons was held good subject-matter within the principle of *Penn v. Bibby*, there being ingenuity required to overcome practical difficulties in the application of the method to gas tanks (p).

And in *Hayward v. Hamilton* (q), where the invention was for a pavement light, consisting of an arrangement of prisms in frames, so as to deflect the light in a particular direction, the patent was sustained, although the manner of using the prism was old, and the particular mode in which the pavement light was made was also old; and the ground of the decision was that the plaintiff had made a claim for a new pavement light, made by combining together the old frame, the old flange, and perhaps the old prism, which old portions had never been combined together before, so as to produce the article claimed by the patentee. In this case, BRAMWELL, L.J., said:—"It seems to me that the plaintiff really is an inventor; he has found out something. He makes an article that was not made before. This particular case may be no doubt upon the verge, but one cannot help making this remark, that it is very strange, if it is no invention, that it has never been done before. Why has it never been done before? Why, because nobody else found it out, which I take to be equivalent to invention" (r).

(m) See also *Murray v. Clayton*, L. R. 7 Ch. 584; *Lyon v. Goddard*, 10 R. P. C. 121, 335; 11 R. P. C. 354; *Young v. Fernie*, 4 Giff. 577.

(n) 1 Webst. 501, 517. See also *Vorwerk v. Evans*, 7 R.P.C. 265, 271.

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

(p) *Gadd v. Mayor of Manchester*, 9 R.P.C. 517; 10 R.P.C. 334.

(q) *Griffin*, P. C. 115. See also *Duoketts v. Whitehead*, 12 R. P. C. 187, 376; *Fawcett v. Homan*, 13 R. P. C. 398.

(r) See, however, on this point observations in *American Braided Wire Co. v. Thomson*, 5 R. P. C. 125.; *Gosnell v. Bishop*, 5 R. P. C. 168; *Blakey v. Latham*, 6 R.P.C. 187.

And in *Siddell v. Vickers (s)*, it was said by COTTON, L.J., that none of the cases which have held that a patent cannot be claimed for applying an old machine for an analogous purpose, will apply where there is a new machine, although that new machine does contain, as new machines must do, old and well-known mechanical appliances. Sect. 29 (2, 3)

—
NOTE.

On this ground a patent for a particular method (to be used in the manufacture of ensilage) of compressing fodder in a pit by means of chains, was sustained (*t*); as was also a patent for a bustle, in which the only novelty was the application of rolls of tubular braided wire, new and useful effects being thereby produced (*u*).

And where in an invention for turning forgings the use of a chain and wheel was old, and the use of a ratchet wheel for turning forgings was also old, it was held that the combination of these elements into a portable appliance, which enabled work to be done which could not be done before, was good subject-matter for a patent (*x*).

And where the invention consisted in producing ornamental designs on waterproof fabrics, by printing them in colours on a farina-coated fabric "by suitable means, such, for example, as those employed in calico printing," and then vulcanizing, it was held that since the plaintiff by his new combination of old processes produced a new and useful article of commerce, which had never been produced before, the objection of want of subject-matter failed (*y*).

In *Muntz v. Foster (z)*, the well-known case of the patent for metal sheathing for ships, where the invention was an alloy of zinc and copper in certain proportions, the patent was held good; and Sir N. C. TINDAL, C.J., said:—"If it was shown, as possibly it might be, that sheets had been made of metal before in the same proportions which he (the patentee) has pointed out, but if this hidden virtue or quality had not been discovered or ascertained, and consequently the application never made, I cannot think the patent will fail on that ground. I look upon it that there is as much merit in discovering the hidden and concealed virtue of a compound alloy of metal as there would be in discovering an unknown quality which a natural earth or stone possessed." New alloy
of metals.

The discovery that the mixture of two or more simple substances in certain definite proportions will form a compound valuable for medical New recipes.

(*s*) 5 R. P. C. 430.

(*t*) *Reynolds v. Amos*, 3 R. P. C. 215.

(*u*) *American Braided Wire Co. v. Thomson*, 5 R. P. C. 113; affirmed by the House of Lords, 6 R. P. C. p. 518.

(*x*) *Siddell v. Vickers*, 39 Ch. D. 92; affirmed 15 App. Cas. 496.

(*y*) *Moseley v. Victoria Rubber Co.* 4 R. P. C. 241.

(*z*) 2 Webst. 103.

Sect. 29 (2, 3) or other purposes affords good ground for a patent (a). Thus, for instance, the use for preserving animal substances of bi-sulphate of lime in a medium of gelatine would be good subject-matter (b).

NOTE.

The term "Patent medicines," in the Pharmacy Act, 1868 (c), means only medicines which are the subject of letters patent, and does not extend to proprietary medicines (d).

New combination of materials.

And where the invention consisted in the manufacture of pile fabrics in imitation of sealskins, by a combination of silk and mohair in the raw state (that is, the materials were blended previous to spinning), and the patentee had by observation of the structure of the natural sealskin and by careful experiments ascertained that the above mixture would produce certain beneficial results existing in the natural article, but not found in any then-known imitation, it was held, that there was good subject-matter for the patent; although it was proved that the same combination had been well known for some years in what were known as Bradford dress goods, but which were a smooth material wholly different from pile fabrics (e).

New discovery invoking a particular law of nature.

And the introduction into an old combination of a new shape of one of the old elements of that combination which invokes a law of nature otherwise left on one side, may be the good subject of a patent; and, therefore, where it appeared that in the patentee's electric lamp a carbon filament was used, whereas in a previous lamp a rod and not a filament of carbon had been adopted, and the patentee had used the filament for a definite purpose, and by the diminution of the sectional area made a physical law subserve the end he had in view, the patent was sustained (f).

New test in chemical process.

When in an action on a patent for the production of colouring matter it was shown that the process of sulphonation was known, and it was also known that this sulphonation admitted of degrees, the higher degrees being obtained by increase of the elements of time, strength of acid or temperature, it was held that a claim for the preparation of certain sulpho-acids which had certain peculiar properties and were new, the preparation process consisting essentially in the application of a certain

(a) *Bewley v. Hancock*, 6 D. M. G. 391.

(b) See *per* Lord CAIRNS, L.C. *Bailey v. Robertson*, 3 App. Cas. 1062, 1063.

(c) 31 & 32 Vict. c. 121.

(d) *Pharmaceutical Society v. Piper*, [1893] 1 Q. B. 686.

(e) *Lister v. Norton*, 3 R. P. C. 199, 206.

(f) *Edison, eto. Co. v. Woodhouse* (first action), 4 R. P. C. 79, 92, 93; *Gadd v. Mayor of Manchester*, 9 R. P. C. 517.

new test, whereby it was at once shown when the proper degrees of sulphonation had been reached, was good subject-matter for a patent (j). **Sect. 29 (2, 3)**

Where there has been a long unsatisfied demand, and then suddenly an article springs into existence and satisfies it, the length of time during which the demand has remained unsupplied is matter from which it may be inferred that it is ingenuity alone which has enabled the inventor to surmount the obstacle, which otherwise seems, from the long unsatisfied demand, to have existed somewhere or in some shape (h). **NOTE.**
How far long unsatisfied demand taken into consideration on question of invention.

It is an important element, in the consideration whether there has been an invention or not, if the thing never was done in the memory of man, down to a particular point, and at the moment it is done it is a great success as regards utility and as regards value in the market (i). **Immediate success of the new article, how far test of invention.**
And where the use in musical instruments of circular perforated discs for the purpose of actuating valves and so producing notes was known, and the use of endless perforated bands for actuating the levers of such valves was known, a patent for a portable organ, in which the levers were actuated by means of a perforated disc, was upheld, it being shown that, immediately upon its introduction, there was an enormous sale which drove the endless band instrument out of the market (k).

If there is any invention a very little is sufficient to sustain a patent. Where a slight alteration in the combination "turns that which was practically useless before into that which is very useful and important," judges have considered that, though the invention was small, yet the result was so great as to be fairly the subject of a patent (l). Thus, the substitution in a duplex lamp of a round wick for a flat wick (m); and the manufacturing gelatine by reducing the skin into shavings by an instrument resembling a carpenter's plane (n),—were held to be good subject-matter for patents. **Very little invention will sustain a patent.**

And where the patented invention differed from a previously known hand camera with folding sides in having the folding sides hinge bound,

(g) *Badische Anilin und Soda Fabrik v. Dawson*, 6 R. P. C. 387.

(h) *Per BOWEN, L.J., Gosnell v. Bishop*, 5 R. P. C. 158.

(i) *Per BOWEN, L.J., American Braided Wire Co. v. Thomson & Co.* 5 R. P. C. 125, and see *Ehrlich v. Ihlee*, 5 R. P. C. 205, judgment of KEKEWICH, J.; and remarks of Lord ESHER, M.R. in *Edison Bell Phonograph, etc. Co. v. Smith*, 11 R. P. C. 398. See also *Dowling v. Billington*, 7 R. P. C. 191, 204; *Ducketts v.*

Whitehead, 12 R. P. C. 376, 379, 381.

(k) *Ehrlich v. Ihlee*, 5 R. P. C. 437.

(l) *Per JESSEL, M.R., Hinks v. Safety Lighting Co.*, 4 Ch. D. 615, 616. See also *Re Betts' Patent*, 1 Moo. P. C. (N.S.) 49, and observations of COTTON, L.J., *Williams v. Nye*, 7 R. P. C. 62, 67.

(m) *Hinks v. Safety Lighting Co.*, *ubi supra*.

(n) *Warrington v. Dale*, 7 Ex. 888.

Sect. 29 (2, 3) giving extra rigidity to the front, this was held to be sufficient invention to support the patent (o).

NOTE.

And in *Edison, etc. Co. v. Holland* (p), where the main difference between the Edison electric lamp and that previously made by Swan was that the rod or filament in the Swan lamp was carbonized after being put into shape, and it was proved that the difference introduced by Edison had changed failure into success, the patent was upheld.

But while no smallness or simplicity will prevent a patent being good, mere novelty of manufacture or usefulness in the application of known materials to analogous uses will not necessarily establish invention within the meaning of the patent law (q). And if the alleged invention is simply the application of a well-known thing to an analogous use the mere fact that it is accompanied by advantages not thought of or practised before is no answer to the objection that there is no invention (r).

An alleged invention may, on the face of it, be insufficient subject-matter for a patent; as where the patent was for an improved box for the parcels post, the invention consisting in two boxes or cases, placed one within the other, the space between the one and the other being provided with a packing such as that described in the specification, which packing was shown to be old (s); or for the placing of grooves in a particular manner along the length of a handle of a bat (t), or the use of a siphon bend for the purpose of keeping a supply of steam in a coil of pipe (u).

And where the specification claimed a flexible comb for securing ladies' hats in position and a short comb of the same form was known which, if made longer, would have been flexible, it was held that there was not sufficient invention to form subject-matter for a patent (v).

Utility.—Want of utility in the invention is another common objection to a patent. The statute of James says nothing about utility, but utility has been engrafted into it because of the words in that statute that the letters patent “be not contrary to law or mischievous to the State by raising of prices of commodities at home or generally inconvenient,” that is to say it has been found by experience that it is

(o) *Perry v. Société des Lunetiers*, 13 R. P. C. 671. See also *Scott v. Hamling*, 14 R. P. C. 123.

(p) 6 R. P. C. 243, 277.

(q) *Riehmann v. Thierry*, 14 R. P. C. 105, 115 (H. L.).

(r) *Morgan v. Windover*, 7 R. P. C. 131, 134, 138.

(s) *Jackson v. Needle*, 2 R. P. C. 194.

(t) *Slazenger v. Feltham*, 6 R. P. C. 233. See also *Herrburger v. Squire* 6 R. P. C. 194.3

(u) *Rose's Patents Co. v. Braby*, 11 R. P. C. 198.

(v) *Sarago v. Harris*, 13 R. P. C. 364.

mischievous to the State to grant patents which are not useful as well as new (x). Sect. 29 (2) (3)

Upon this question, it is settled that the slightest amount of utility is sufficient to sustain a patent (y); and in law, utility means "an invention better than the preceding knowledge of the trade as to a particular fabric. It does not mean abstract utility" (z).

NOTE.

"Utility is a question of degree, and always has reference to some object. Useful for what? is a question which must be always asked, and the answer must be, Useful for the purposes indicated by the patentee" (a).

The element of commercial pecuniary success has no relation to the question of utility in patent law (b), and it is not a correct test of utility to inquire whether the invented product was at the time of the patent likely to be in commercial demand, or capable of being produced at a cost which would make it a profitable commercial speculation to manufacture it (c). But an interrogatory asking whether the patentee had not found it necessary to introduce modifications into the patented process in order to enable it to be worked successfully for commercial purposes is relevant to the issue of utility since the answer may be a step towards the defendant's proof of that issue (d).

And the patent may be good even though none of the patented machines have ever been sold if there is evidence that they will work (e).

If one part of an invention is impracticable and useless the patent is void (f). But where there is general utility, that is, utility of the invention as a whole, the patentee is not bound to prove that each part of the invention is equally useful (g).

(x) *Per* LINDLEY, L.J. *Elias v. Grovesend Tinplate Co.*, 7 R. P. C. 467.

(y) *Per* GROVE, J., *Philpott v. Hanbury*, 2 R. P. C. 37.

(z) *Young v. Rosenthal*, 1 R. P. C. 34. GROVE, J. See also p. 41.

(a) *Per* LINDLEY, L.J., *Lane-Fox v. Kensington, etc., Co.*, [1892] 3 Ch. 481.

(b) *Badische Anilin und Soda Fabrik v. Levinstein*, 12 App. Cas. 710, 712, judgment of Lord HALSBURY, C., *Ehrlich v. Ihlee*, 5 R. P. C. 437, 450. *Sunlight Incandescent Co. v. Incandescent Gas Light Co.* 14 R. P. C. 757, 775.

(c) *Badische, etc. Fabrik v. Levinstein*, 12 App. Cas. 710.

(d) *Rylands v. Ashley's, etc. Co.* 7 R. P. C. 175.

(e) *Otto v. Linford*, 46 L. T. (N.S.) 39; *Goodeve*, P.C. 349; *Renard v. Levinstein*, quoted by JESSEL, M.R., in *Otto v. Linford*, *ubi supra*; *United Telephone Co. v. Bassano*, 3 R. P. C. 295, 313; *Ehrlich v. Ihlee*, 5 R. P. C. 437, 450; *Edison, etc. Co. v. Holland*, 6 R. P. C. 243, 277.

(f) *Morgan v. Seaward*, 1 Webst. 196; *United Horse Shoe and Nail Co. v. Stewart*, 2 R. P. C. 122, 132; *United Horse Shoe and Nail Co. v. Swedish Horse Nail Co.* 6 R. P. C. 1.

(g) *Per* KEKEWICH, J., *Ehrlich v. Ihlee*, 5 R. P. C. 203.

Sect. 29 (2, 3) The fact that the defendant has attempted to infringe is of itself evidence of the utility of the invention (*h*).

NOTE.

And in the case of a mechanical musical instrument, the fact that since the introduction of the new machine thousands had been sold, and the old machines had become a drug in the market, was held to be sufficient proof of utility (*i*).

But in an invention for locking the catch rods in railway signals, the mechanical impossibility of going wrong by anything short of violence or malice was held to be an absolute condition of usefulness, and since this did not exist the patent was held bad (*k*). And where in an invention for points and crossings for tramways the drawing of the specification showed a point which the court held on the evidence to be a right-hand and not a left-hand point, and it was shown that a right-hand point was practically valueless, it was held that the invention was not useful and that the patent was invalid (*l*). And where the invention differed only from an earlier one by an ingredient which did neither harm nor good, it was held that there was not sufficient utility to support a patent (*m*). And when a method of punching blanks for nails was shown to be useless for its avowed purpose and to cause waste of material, the patent was held void (*n*).

The burden of proving utility is not always on the patentee. If a *prima facie* case is made that the invention is not useful, it is for the patentee to prove that it is useful (*o*).

An invention may be useful as indicating the direction in which further progress is to be expected, and yet that same invention may be useless for any other purposes, useless, that is, as an invention without further developments and improvements which have not occurred to the patentee. And when this appeared to be the case a patent for the invention was held invalid (*p*).

The circumstance that the patentee takes out a subsequent patent for an improvement on the first invention is no ground for inferring that the first invention was useless (*q*).

(*h*) *Lucas v. Miller*, 2 R. P. C. 158, 160. See also *Badische Anilin und Soda Fabrik v. Levinstein*, 12 App. Cas. 710, 712; *United Horse Shoe and Nail Co. v. Stewart*, 13 App. Cas. 401, 407; *Reynolds v. Amos*, 3 R. P. C. 215.

(*i*) *Ehrlich v. Ihlee*, 5 R. P. C. 437, 449.

(*k*) *Easterbrook v. Great Western Rail. Co.* 2 R. P. C. 207.

(*l*) *Winby v. Manchester, etc. Co.* 8 R. P. C. 61.

(*m*) *Lawrence v. Perry*, 2 R. P. C. 180, 184.

(*n*) *United Horse Shoe and Nail Co. v. Swedish Horse Nail Co.* 6 R. P. C. 1.

(*o*) *Ehrlich v. Ihlee*, *ubi supra*, Judgment of COTTON, L.J.

(*p*) *Lane-Fox v. Kensington, etc. Co.*, [1892] 3 Ch. 424, 431.

(*q*) *Per* BRETT, L.J., *Otto v. Linford*, 46 L. T. (N.S.) 39; *Thomson v. Batty*, 6 R. P. C. 84, 100; *Edison, etc. Co. v. Holland*, 6 R. P. C. 243, 277.

SUB-SECTION (4).

Sect. 29 (4).

NOTE.

"Except by leave of the court or a judge."—These words are an addition to the Act of 1852 (s. 41), which was peremptory that no evidence should be given which was not contained in the particulars.

And under that Act a defendant was not allowed at the trial to adduce evidence of prior user not disclosed by his particulars of objection, even though such evidence had only come to his knowledge since the particulars were delivered. In such a case the right course was to apply at once, on learning the new evidence, for leave to amend the particulars (r).

But under this sub-section it is in the discretion of the judge to allow evidence to go beyond the particulars actually delivered, and this is different from the power of allowing particulars to be amended, which is given by the next sub-section (s).

Notwithstanding, however, the discretion given to the judge, it will always be prudent to apply before the trial for leave to amend by adding new objections, since the court will always protect the plaintiff from surprise, and may refuse at the trial to give leave under this section, or to allow the particulars to be amended (t). Objections to an amended specification that the amendment made was not the amendment advertised, or that the amendment was made pending proceedings and in contravention of s. 18 (10) of the Act ought to appear in the particulars of objections (u).

A plaintiff's witness may, in cross-examination, be asked questions in a general form as to his knowledge of user of the invention prior to the patent, although this may not be mentioned in the objections, but the counsel for the defendant is not entitled to inquire of the plaintiff's witnesses as to any specific instance of prior user of which he has not given notice (x). And where at the trial evidence was given of a method which appeared completely to anticipate the plaintiff's invention, but no particulars of this had been given, the court at the plaintiff's request allowed the case to stand over but at the plaintiff's risk as to costs, the defendants being also at liberty to give particulars of further instances of user of this method (y).

But if the evidence is within the literal meaning of the words of the particulars, however general the statement the evidence will be received Evidence within literal meaning of

(r) *Daw v. Eley*, L. R. 1 Eq. 38.
 (s) *Britain v. Hirsch*, 5 R. P. C. 226, 231.
 (t) See *Moss v. Malings*, 33 Ch. D. 603.

(u) *Farbenfabriken v. Bowker*, 8 R. P. C. 389.
 (x) *Penn v. Bibby*, L. R. 2 Ch. 127, 137.
 (y) *Pascall v. Toope*, 7 R. P. C. 125.

Sect. 29 (4). at the trial (z). The only question then is, whether the words of the notice are sufficiently large to include the objection (a). Thus, where particulars of breaches alleged that the defendant had at divers times between specified dates infringed by the manufacture or sale or use of the patented article, and in particular alleged sales to two specified persons, and the defendant, in answer to interrogatories, admitted a sale to a third person, the plaintiff was allowed to give evidence at the trial of the transactions with that third person (b).

NOTE.
particulars
admitted.

And where the particulars of objections alleged that the invention had *been publicly used in corn-mills*, evidence of user in Cheshire was admitted (c).

Where, however, a defendant had been ordered to amend his particulars of objections by stating the names and dates of the specifications relied upon, or *that they should be excluded*, and the defendant amended by giving a notice for all the plaintiff's specifications "*between 1 Jan. 1840 and 20 Mar. 1850*," it was held at the trial that the order had not been complied with, and a specification granted in 1849 was not admitted in evidence (d).

Where specific acts of infringement were stated in the particulars, and the defence denied infringement at all, and the plaintiffs having proved their case, the defendants went into evidence on the wider issue raised by them, it was held that the Act of 1852, s. 41, did not apply to such a case, and that as the defendants had not confined themselves to meeting the case set up against them, the plaintiffs were at liberty to adduce evidence in reply by giving instances of infringement other than those alleged in their particulars (e).

Plaintiff's
evidence in
support of
patent.

If the novelty or effect of the invention be disputed, the plaintiff must show in what his invention consists, and that he produced the effect proposed by his patent in the manner proposed. Slight evidence of this on his part is sufficient, and it is then incumbent on the defendant to falsify the specification (f). It will be sufficient for the plaintiff to call persons of science or workmen who say that the specification is intelligible to them, and that they can make the invention without further instruction than the specification (g).

(z) *Per* POLLOCK, C.E., *Hull v. Bollard*, 1 H. & N. 134; *Curtis v. Platt*, 35 L. J. (N.S.) Ch. 852, 868; and see remarks of MELLISH, L.J., *Sugg v. Silber*, 2 Q. B. D. 495.

(a) *Per* ALDERSON, B., *Neilson v. Harford*, 1 Webst. 332. See also p. 370.

(b) *Sykes v. Howarth*, 12 Ch. D 826; 48 L. J. Ch. 769.

(c) *Hull v. Bollard*, *ubi supra*.

(d) *Lister v. Leather*, 3 Jur. (N.S.) 811.

(e) *Adair v. Young*, W. N. 1879, p. 8.

(f) *Turner v. Winter*, 1 Webst. 81; *Westley Richards v. Perkes*, 10 R. P. C. 181, 186.

(g) *Cornish v. Keene*, 1 Webst. 503.

In *Crossley v. Potter* (h), the parol evidence of the patentee was held admissible to prove that the patent was not obtained for some of the things claimed in the specification. And the ground of the decision was that there must be some means of getting at the fact of what the invention was, and that the specification could not be conclusive evidence, as it might have been fraudulently prepared. And on the patentee being examined it turned out that the patentee was the inventor of a loom for weaving coach lace, and knew nothing about carpet weaving, and that before specifying he had sold the patent to other parties, who drew the specification and described the machinery as being applicable to the weaving of carpets as well as of coach lace. But in the *Badische Anilin und Soda Fabrik v. Levinstein* (i), it was held, in the House of Lords, that neither the actual inventor nor any other witness could be called to prove what the real invention was, and that this was a question which could only be answered from a critical examination of the specification. And in *Kaye v. Chubb* (k), the Court of Appeal, upon an objection that the plaintiff's invention had been anticipated by an earlier patentee, refused to consider as conclusive the evidence of the latter tending to show that, when he framed his specification, he did not intend it to have the effect now attributed to it, and that he never saw that it had that effect, and the court drew its own conclusion from the prior specification.

Sect. 29 (4).

NOTE.

Evidence of patentee as to invention.

Where the defendant denies the novelty of the invention, the affirmative of the issue thus raised rests with him (l). And if a specification is alleged as an anticipation, evidence should be called to explain it (m). And even if there is identity of language between two specifications, it cannot be predicated that both describe the same external object, unless it is ascertained that the terms of art used in the one have the same signification and denote the same external objects at the date of the one specification as they do at the date of the other (n).

The plaintiff can only make a *prima facie* case as to novelty by calling persons conversant with the subject to show that they had not heard of the invention before the date of the patent. That is enough

Evidence in reply.

(a) Macr. P. C. 253, 255. See also *Bateman v. Gray*, Macr. P. C. 111. See, however, *Hinks v. Safety Lighting Co.*, L. J. No. Ca. 1876, p. 213.

(i) 12 App. Cas. 717, judgment of Lord HERSCHELL.

(h) 4 R. P. C. 289, 297, 298.

(l) *Penn v. Jack*, L. R. 2 Eq. 314; *Minter v. Wells*, 1 Webst. P. C. 129;

Peroni v. Hudson, 1 R. P. C. 261; *Westley Richards v. Perkes*, 10 R. P. C. 181, 186.

(m) See observations of BACON, V.-C., *Hooking v. Fraser*, 3 R. P. C. 6, 7. See also *Borill v. Smith*, Griffin, L. O. C. 52.

(n) *Betts v. Menzies*, 10 H. L. C. 177.

Sect. 29 (4). to call on the other side (*o*), and, therefore, the plaintiff will be allowed to call evidence in reply, for the purpose of rebutting the case set up by the defendants (*p*). And where the defendants' evidence had gone further than was justified by the particulars of objection, the trial was, after the defendants' evidence was closed, ordered to stand over, in order to give the plaintiff the opportunity of rebutting this evidence, the defendants being at the same time allowed to amend their objections, so as to include the evidence they had given (*q*).

NOTE.

And where it appeared that there was a point relevant to the issue, which had not been thoroughly "threshed out" at the trial, and which did not affect the credit of any of the witnesses, the plaintiff was allowed to adduce fresh evidence after the evidence had been given and counsel's speeches on both sides delivered, and judgment had been reserved (*r*).

Where, however, a plaintiff has given a part of his evidence on the issue of novelty, and at the commencement of his case has had his attention called to a prior specification, he cannot, for the purpose of giving evidence as to the contents of it, recall, in reply, any witness who, when he gave his evidence, was acquainted with the specification in question (*s*).

When no affidavit of documents had been required by plaintiff, and at a late stage of a trial it appeared that defendant had received a report from a patent agent, which report was not produced, the plaintiff was not allowed to recall a witness to be cross-examined as to the contents of the report (*t*).

And when the plaintiff's witness, the patentee, gave evidence which showed the patent invalid, a motion for a new trial, on the ground that the witness had made a slip, was refused (*u*).

A defendant, after cross-examination of plaintiff was concluded, was not allowed to recall him to put to him a prior user, it not being shown that the matter had only been recently discovered, and could not with reasonable diligence have been discovered before (*x*).

And after the evidence of the defendant has been summed up, he will not be allowed to adduce further evidence in answer to that given by the plaintiff in reply (*y*).

(*o*) *Galloway v. Bleaden*, 1 Webst. P. C. 526; *Cornish v. Keene*, 1 Webst. P. C. 509; *Amory v. Brown*, L. R. 8 Eq. 663; *Harris v. Rothwell*, 35 Ch. D. 416, 427; *Westley Richards v. Perkes*, 10 R. P. C. 181, 186.

(*p*) *Penn v. Jack*, L. R. 2 Eq. 314.

(*q*) *Blakey v. Latham*, 6 R. P. C. 29, 36.

(*r*) *Boyd v. Horrocks*, 5 R. P. C. 558.

(*s*) *Tetley v. Easton*, Macr. P. C. 61.

(*t*) *Sugg v. Bray*, 54 L. J. Ch. (N.S.) 132.

(*u*) *Germ Milling Co. v. Robinson*, 3 R. P. C. 399.

(*x*) *Moss v. Malings*, 3 R. P. C. 373.

(*y*) *Penn v. Jack*, L. R. 2 Eq. 314.

If the defendant has put in a defence, but does not appear at the trial, the plaintiff must prove his case. And for this purpose it is sufficient for the plaintiff to prove the specification and infringement (z). Sect. 29 (4).
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NOTE.

Infringement.—The question of infringement is one of mixed law and fact, and, when the facts are ascertained, the question is one of law for the court (a).

In ordinary cases the burden of proving infringement lies upon the plaintiff (b), and the patentee is bound to prove, not merely the user of the invention by the defendant, but also that such user was unauthorized; and, therefore, where in an action to restrain the sale of a patented article the plaintiff proved the sale, but did not prove that the article complained of had not been made by himself or his agent, the bill was dismissed (c). Evidence of infringement.

But when the thing complained of is manufactured abroad, and the plaintiff has been unable to obtain inspection of the defendant's process, and can, therefore, only produce *prima facie* evidence of infringement, it seems that it is the duty of the defendant to give evidence of a negative character, to show that the process used was of a different character from that which had been patented (d). Where onus on defendant.

And when the defendant pleaded that he had not infringed, and in the alternative that the subject-matter of the sale complained of was purchased from a person with whom the plaintiff had agreed not to take proceedings in respect of the said goods, it was held that the burden of proof of the alternative fact was on the defendant. And with regard to the defence of non-infringement, the plaintiffs having proved that the defendant had sold the patented article, it was also held that when that fact was proved it lay on the defendant to show how and why it was that he was selling it (e).

When the plaintiffs merely proved a sale of the infringing article, but did not prove that they had not made it themselves, and the defendant did not call evidence, and objected that the plaintiffs had not proved infringement, but declined to call evidence, the plaintiffs were allowed to call further evidence to show that they had not made the article (f).

(z) *Peroni v. Hudson*, 1 R. P. C. 261; S. C. R. 1883, Ord. XXXVI. r. 31.

(a) *Seed v. Higgins*, 8 H. L. C. 565; *Westinghouse v. Lancashire and Yorkshire Rail. Co.*, 1 R. P. C. 229, 237, 244.

(b) *Neilson v. Betts*, L. R. 5 H. L. 1, 11.

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

(d) *Neilson v. Betts*, L. R. 5 H. L. 1.

(e) *Badische Anilin und Soda Fabrik v. Dawson*, 6 R. P. C. 387.

(f) *Farbenfabriken v. Bowker*, 8 R. P. C. 389.

Sect. 29 (4).

NOTE

Evidence that an order was given in England, which order was executed in England, for making articles by the same mode for which the plaintiffs had obtained their patent, which articles were afterwards received by the defendant, is sufficient to satisfy an allegation that he made those articles (*g*).

So also where, in an action for infringement of a method of improving lace and net by passing it over a flame of gas in a gassing machine, it was proved that the lace left with the defendant to be dressed had been returned in the state to which it would have been brought by the use of the plaintiff's process, and that similar lace had been offered for sale by the defendant, and that the defendant had one of the patented machines in his possession, it was held there was sufficient evidence of infringement (*h*).

But when the article, which was admitted to be the same as the plaintiff's, had been made by the defendant in its present form at the express request of the plaintiff's agent who had given the order for it, it was held that the defendant had not infringed (*i*).

Where a trade secret is alleged by the defendant, and there has been no inspection by the plaintiff, similarity of structure in the patented article and the things produced by the defendant is *prima facie* evidence of infringement (*k*).

The above cases, however, will not apply when it is clear on the evidence that the articles complained of may have been produced by machinery which involved no infringement of the plaintiff's patent (*l*).

And an admission by the defendants that they had worked according to the specification of a certain patent, the specification being susceptible of two constructions, one of which would not infringe the plaintiff's patent, was held insufficient evidence of infringement (*m*).

Sale or importation.

The sale (*n*) in this country of the patented article, even if made abroad (*o*), and sold to a foreign customer (*p*), is an infringement. So, also, is the importation from abroad and sale in this country of products made according to the patented process (*q*).

(*g*) *Gibson v. Brand*, 1 Webst. P. C. 631.

(*h*) *Hall v. Boot*, 1 Webst. P. C. 103.

(*i*) *Kelly v. Batchelar*, 10 R. P. C. 289. See also *Hennessy v. Kennett*, Seb. Dig. p. 331.

(*k*) *Huddart v. Grimshaw*, 1 Webst. P. C. 91. See also *Davenport v. Richards*, 3 L. T. (N.S.) 503.

(*l*) *Cartsburn Sugar Refining Co. v. Sharp*, 1 R. P. C. 181.

(*m*) *Winby v. Manchester, etc. Steam Tramways Co.* 7 R. P. C. 30.

(*n*) *Walton v. Lavater*, 8 C. B. (N.S.) 190.

(*o*) *Walton v. Lavater*, 8 C. B. (N.S.) 185.

(*p*) See *per* KAY, J., *United Telephone Co. v. Sharples*, 29 Ch. D. 164.

(*q*) *Elmslie v. Boursier*, L. R. 9 Eq. 217; *Wright v. Hitchcock*, L. R. 5 Ex. 37; *Von Heyden v. Neustadt*, 14 Ch. D. 230 (C. A.); *Cartsburn Sugar Refining Co. v. Sharp*, 1 R. P. C. 181.

Where an English dealer wrote to a foreign manufacturer asking the latter to send him by post a certain quantity of an infringing article, and the foreigner sent it to a forwarding agent abroad to be held at the English dealer's disposal, this was held by the Court of Appeal to be *prima facie* a sale in England, and leave was given to serve a concurrent writ in an action against the English dealer and the foreigner, and to serve notice of it on the foreigner out of the jurisdiction (r). Upon the case coming on for trial, it appeared that the foreign forwarding agents had forwarded the article by post, and in the Court of Appeal the transaction was treated as if the foreign manufacturer had himself posted the article. It was held by the majority of the court that the foreign manufacturer had done nothing in this country to infringe the patent, and judgment was entered for him in the action (s). And this decision was affirmed by the House of Lords (t).

Sect. 29 (4).

NOTE.

In *Minter v. Williams* (u), mere exposure for sale of infringing articles was held not to be an infringement. But in *Oxley v. Holden* (x), where the defendant had made articles according to the invention, and his traveller had offered them for sale, but had not sold any, it was held there had been a user of the patent.

Exposure or offering for sale.

A loan, without any intention to sell or invade the patent (y), is not an infringement. And the mere offer to supply "swivelling" pumps, the patent not claiming every kind of swivelling pump, unaccompanied by any evidence of positive infringement, was held not to be sufficient to support an application for an injunction (z).

The sale by a patentee of an article made under the patent, and sold without any restriction on the buyer, and whether the article be made under an English or a foreign patent, gives the purchaser an absolute right to deal with that which he so buys in any way he thinks fit, which includes selling in any country where there is a patent in the possession of and owned by the vendor (a). And a purchaser from a patentee without notice of an exclusive licence granted for a limited district, cannot be restrained by the licensee from selling within the district (b).

Sale by patentee makes article free in hands of purchaser.

So, also, the re-sale of an article purchased from a licensee is no infringement (c), even though the licence be for a limited area, and the purchaser from the licensee sells outside that area (d).

(r) *Badische Anilin und Soda Fabrik v. Johnson*, [1896] 1 Ch. 25.

(s) [1897] 2 Ch. 322.

(t) [1898] A. C. 200.

(u) 4 A. & E. 251.

(x) 8 C. B. (N.S.) 666.

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

(z) *Gwynne v. Drysdale*, 2 R. P. C. 160. S.C., on appeal, 3 R. P. C. 65.

(a) See per COTTON, L. J., *Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Company*, 25 Ch. D. 9; *Betts v. Willmott*, L. R. 6 Ch. 239.

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

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

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

Sect. 29 (4).**NOTE.**

But licensor
may impose
conditions.

It is, however, open to the licensor to impose his own conditions on the user of the patented article, and if these are brought to the knowledge of the purchaser at the time of sale, he is bound by the conditions (e).

But it is otherwise if the purchaser buys without knowledge of the conditions, and therefore when certain mantles for incandescent gas lighting were sold to an agent of the purchaser and consigned directly to the purchaser, and nothing was said about conditions on the occasion of the sale to the agent, and the purchaser on opening the parcel learnt for the first time that each mantle was enclosed in a box with a label stating certain conditions under which alone it might be used; it was held he was not bound by the conditions, and was justified in pasting his own labels on the boxes and re-selling them without restriction (f).

A licence to exercise the invention in a foreign country does not imply permission to sell the article in England in violation of an English patent of the same patentee (g).

The sale of the patented article implies no warranty that the patent is valid, or that the purchaser may use the machine as against another patentee (h).

Making for
amusement or
experiment.

The making of patented articles merely for amusement or as a model (i), or by way of *bonâ fide* experiment, and not with the intention of selling and making use of the thing so made for the purpose for which a patent has been granted, but with a view of improving upon the invention, or with the view of seeing whether an improvement can be made or not (k), is not an invasion of the exclusive rights granted by the patent (l).

But where defendants had purchased certain infringing machines which had been erected at their works upon the understanding that they were only to be paid for if successful, and the machines were in use for several months, it was held that the user was not experimental, and was an infringement (m).

Manufacture
for sale.

The manufacture for the purpose of sale is an infringement, even though the article is never actually sold (n).

Manufacture
and sale of
component
parts.

The mere manufacture and sale of component parts of an infringing machine (o), or the supply of articles with the intention that they shall

(e) *Incandescent Light Co. v. Cantelo*, 12 R. P. C. 262.

(f) *Incandescent Light Co. v. Cantelo*, *ubi supra*.

(g) *Société Anonyme, etc. v. Tilghman's, etc.*, 25 Ch. D. 1.

(h) *Monforts v. Marsden*, 12 R. P. C. 266.

(i) *Jones v. Pearce*, 1 Webst. 124.

(k) *Frearson v. Loc*, 9 Ch. D. 66; *Muntz v. Foster*, 2 Webst. 101.

(l) See also *Higgs v. Goodwin*, E. B. & E. 529.

(m) *Proctor v. Bayley*, 6 R. P. C. 106, 42 Ch. D. 390.

(n) *Muntz v. Foster*, 2 Webst. 101.

(o) *M' Cormick v. Gray*, 7 H. & N. 25; *Savage v. Brindle*, 13 R. P. C. 266.

be used in infringing the patent, is not an infringement (*p*). But an injunction granted to restrain the sale of a complete machine would, it seems, be violated by the sale of the component parts of the machine in such a way that they might be put together by any one (*q*). Sect. 29 (4).
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NOTE.

And repairing patented instruments by restoring essential parts of the combination (*r*), or the possession of infringing machines for instruction of and use by pupils (*s*) is an infringement. Repairing patented instruments.

If a combination of machinery originally directed to one purpose is made to minister to another and additional purpose, the user of it for that additional purpose is an infringement of the patent for the combination (*t*). User for new purpose.

User of the patented article in this country, whether active, as on board a foreign ship in British waters (*u*), or passive, as when bottles capsuled with a capsule made of the patented material were sent from Scotland to England for the purpose of being exported from England (*x*), is an infringement. User, active or passive.

In the case of machinery the prohibition extends to the product of the machinery (*y*).

In *Lister v. Leather* (*z*), it was said that a patent for a whole combination may be infringed by taking part, provided it is a new and material part of the combination. Upon this case it has been observed by JAMES, V.-C., that it had been thought to establish that a patent for a combination would be a distinct patent for everything that is new and material and went to make up the invention, but that the judgment gave no warrant for such a contention, and that all that was meant was that "you not only have no right to steal the whole, but you have no right to steal any part of a man's invention; and the question in every case is a question of fact—is it really and substantially a part of the invention Supposing that a clock was now for the first time invented, and patented as a machine for measuring and indicating time, a man could not evade the patentee's right by substituting a spring for a weight, or by leaving out the whole of the striking apparatus" (*a*). Infringement of combination patents.

(*p*) *Townsend v. Haworth*, 12 Ch. D. 831, n.; more fully reported 48 L. J. Ch. (N.S.) 770; Higgins, 165, 168.

(*q*) *United Telephone Co. v. Dale*, 25 Ch. D. 778.

(*r*) *United Telephone Co. v. Nelson*, W. N. 1887, 193.

(*s*) *United Telephone Company v. Sharples*, 29 Ch. D. 164.

(*t*) Per Lord WESTBURY, *Cannington v. Nuttall*, L. R. 5 H. L. 205,

230. See also *Pneumatic Tyre Co. v. East London Rubber Co.* 14 R.P.C. 77, 103, 573.

(*u*) *Caldwell v. Van Vlissingen*, 9 Hare, 415.

(*x*) *Neilson v. Betts*, 5 H. L. 1.

(*y*) *Townsend v. Haworth*, *ubi supra*.

(*z*) 8 E. & B. 1004, 1023.

(*a*) *Parkes v. Stevens*, L. R. 8 Eq. 367; *Winby v. Manchester, etc. Co.* 6 R. P. C. 359, 365.

Sect. 29 (4) There is, or may be, in a patent for a combination, an essence or substance of the invention underlying the mere accident of form, and that invention may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination (b).

NOTE.

No infringement of the equity of a patent.

Upon this subject, it was observed by Lord CAIRNS, C., in *Dudgeon v. Thomson* (c): "There is, by some confusion of ideas, a notion sometimes entertained that there may be something like an infringement of the equity of a patent. I cannot think that there is any sound principle of that kind in our law; that which is protected is that which is specified, and that which is held to be an infringement must be an infringement of that which is specified. But I agree it will not be the less an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist and yet the thing protected by the specification be taken notwithstanding" (d).

"Pith and marrow" taken.

And it might well be that if the instrument patented consisted of twelve different steps producing in the result the improved article, an infringer who took eight or nine of those steps might be held by the tribunal judging of the patent to have taken in substance the pith and marrow of the invention, although there were one, two, three, four, or five steps that he might not actually have taken and represented in his machine (e). The question in such a case is, "Has the combination in substance been taken? Has the defendant, though not exactly taking the whole combination which has been patented, taken by slight variation or by mechanical equivalent the substance of it, so as to produce the same result by practically the same means?" (f)

Mechanical or manufacturing equivalents.

Therefore, where the defendant takes two out of the three parts of a combination, with a colourable variation of the third (g), or takes mechanical equivalents for the plaintiff's invention and adds an improvement (h), or, while omitting some parts of the plaintiff's

(b) *Per* JAMES, L.J., *Clark v. Adie*, L. R. 10 Ch. 675.

(c) 3 App. Cas. 34, 44.

(d) See also the remarks of the same learned judge on the words "colourable imitation," 3 App. Cas. p. 43.

(e) *Per* Lord CAIRNS, C., *Clark v. Adie*, 2 App. Cas. 320; *Ehrlich v. Ihlee*, 5 R. P. C. 437, 456; *Moore v. Thomson*, 7 R. P. C. 325, 335; *Jardine v. King, Mendham, etc.* 13 R. P. C. 411.

(f) *Per* COTTON, L.J., *Proctor v. Bennis*, 36 Ch. D. 754. See also *Dudgeon v. Thomson*, 3 App. Cas. 34, 43.

(g) *Murray v. Clayton*, L. R. 7 Ch. 570, 585; *Kaye v. Chubb*, 5 R. P. C. 641; *Ticket Punch, etc. Co. v. Colley's Patents*, 12 R. P. C. 181.

(h) *Ehrlich v. Ihlee*, 5 R. P. C. 437, 454.

machine and adding certain things to it, takes the substance and essence of the plaintiff's combination (*i*), or uses a manufacturing equivalent for a step of the process not of the essence of the invention, and takes every other step claimed (*k*), in all these cases there is infringement. But where there is a combination of three things, all of which are essential, it is not an infringement to take two of the elements of the combination and combine them with a new and different element (*l*). Thus, in *Murray v. Clayton* (*m*), where the invention was for a brick-making machine, and the claim was in effect for a combination of plate, wires, and movable board, an arrangement consisting of the same elements, but in which the wires were made to move against the clay instead of the clay being pushed against the wires, was held an infringement, and restrained by injunction, while an arrangement in other respects like the patentee's but in which the bricks were transferred by the hand of a workman instead of by the action of the machine, was held to be no breach of the injunction (*n*).

Sect. 29 (4).

NOTE.

And again, where, in a patent for fastening boiler tubes into the boiler, the patentee claimed the combination in an expanding tool of a roller, roller stock, and expanding instrument, "operating in combination substantially as set forth," and the rollers were three parallel perfect cylinders, and the expanding instrument a tapering plug placed in the centre of the rollers, it was held by the House of Lords that a tool for the same purpose in which the rollers were tapering cylinders, and the centre part was not a tapering plug, but a cylinder, and the whole was worked not as in the patentee's instrument by pressing out the cylinders against the inner surface of the tube, but by the whole working into the tube as a rotating wedge, was a different combination, and no infringement of the patent (*o*).

In order to constitute an infringement, if the defendant has taken a new and material part of the combination he must also have applied it to a purpose similar or analogous to that which the plaintiff's combination was intended to effect (*p*).

In *Curtis v. Platt* (*q*), it was held that if the invention "be nothing more than a particular means to attain to a given result, which is

Curtis v. Platt.
Particular means to

(*i*) *Proctor v. Bennis*, 36 Ch. D. 740, 755; *Incandescent Gas Light Co. v. The De Mare Incandescent, etc. Co.* 13 R. P. C. 559.

(*k*) *Benno Jaffé, etc. Fabrik v. Richardson*, 11 R. P. C. 93, 261, 273.

(*l*) *Dudgeon v. Thomson*, 3 App. Cas. 34, 51, 55.

(*m*) L. R. 7 Ch. 570; 10 Ch. 675 n.

(*n*) See also *Garrard v. Edge*, 6 R. P. C. 372, 375, 567.

(*o*) *Dudgeon v. Thomson*, *ubi supra*. See also *Nordenfelt v. Gardner*, 1 R. P. C. 61.

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

(*q*) 3 Ch. D. 135, n.; *per Lord Westbury*, C.; 35 L. J. Ch. 852.

Sect. 29 (4). perfectly well known, then you can no more say that the invention of one distinct set of means interferes with the invention of another than you could say, originally, that there ought not to be patents for the invention of distinct means to an end"; and where the patent was for a particular arrangement of old parts whereby one-half of a certain clutch-box was connected with, and acted upon, certain parts of mechanism for effecting changes in the action of a spinning mule, and there had been other patents for that object, it was held that a contrivance for the same object, being an arrangement of the same elements in a different combination, with a different effect on the clutch-box, and with a different result, was not an infringement (*r*).

NOTE.
produce a known result.

Narrow construction given to such a patent.

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

Real meaning of *Curtis v. Platt*.

The case of *Curtis v. Platt* has been said to have laid down the principle that where an invention is claimed for improvements in machinery consisting only in a combination, there the patentee must be held to the description which he gives of the particular means by which his invention is to be carried into effect, and that the doctrine of mechanical equivalents cannot apply. The real meaning, however, of that case is, "that where there is no novelty in the result, and where the machine is not a new one, but the claim is only for improvements in a known machine for producing a known result, the patentee must be tied down strictly to the invention which he claims, and the mode which he points out of effecting the improvement" (*s*).

And the case of *Curtis v. Platt* does not apply to a case where there is not only novelty in the machine, but novelty in the result to be

(*r*) *Curtis v. Platt*, 3 Ch. D. 135, n.; *Automatic Weighing Machine Co. v. Knight*, 6 R. P. C. 297; *Ticket Punch Register Co. v. Colley's Patents*, 12 R. P. C. 1, 171.

(*s*) Per COTTON, L.J., *Proctor v. Bennis*, 36 Ch. D. 756, 757, 758. See also 764. *Ehrlich v. Ihlee*, 5

R. P. C. 437, 453. See also *Boyd v. Horrocks*, 6 R. P. C. 152; *Jahncke v. Bell*, 9 R. P. C. 94; *Tweedale v. Ashworth*, 9 R. P. C. 121; *Nettlefold v. Reynolds*, 9 R. P. C. 270; *Ticket Punch Register Co. v. Colley's Patents*, 12 R. P. C. 1; *Brown v. Jackson* [1895] A. C. 446.

produced by that machine (*t*). And the rule was not applied in a case where, though the difference between the old mechanical arrangements and those of the plaintiffs was not great, yet the plaintiffs' machine was characterised by greater simplicity and directness of action (*u*). Sect. 29 (4).

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NOTE.

A claim for a weighing machine, in which an old weighing machine was combined with old coin-receiving mechanism in such a way as to produce a certain specified effect, was held not to be infringed by an apparatus in which the same old machines were combined but in which the coin-receiving mechanism was made to perform a different operation with a different result (*v*).

If the defendants have taken the plaintiff's invention they infringe, even although they may have added to that invention something which is an improvement (*x*). "The superadding of ingenuity to a robbery does not make the operation justifiable" (*y*).

Where the patent was for the use of carbonate of manganese in the process of making steel, and it was not known at the date of the patent that coal tar and black oxide of manganese would be chemical equivalents for the carbonate of manganese, it was held by the House of Lords that the use of coal tar and black oxide of manganese was not an infringement (*z*). Chemical equivalents.

And where a patentee claims the combination of two chemical substances named and specified, he cannot extend the protection of his patent to a combination of other substances than those which he has specified because such other combination may be found to produce a substance having substantially the same qualities and capable of employment in the same way. But there may be cases where a chemical compound patented would protect against the manufacture of the compound in which some 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, so that any chemist would know that merely to change this particular ingredient and substitute the other would make no real difference in the compound (*a*).

(*t*) *Proctor v. Bennis*, 36 Ch. D. 758.

(*u*) *Boyd v. Horrocks*, 9 R. P. C. 77.

(*v*) *Automatic Weighing Machine Co. v. Knight*, 6 R. P. C. 113, 297; 5 Times R. 359.

(*x*) *Ehrlich v. Ihlec*, 5 R. P. C. 454; *Hayward v. Hamilton*, Griffin, P. C. 115, 124; *Automatic Weighing Machine Co. v. National Exhibitions Co.* 8 R. P. C. 345; 9 R. P. C. 41; *Wenham Gas Co. v. Champion, etc.*

Co. 9 R. P. C. 49, 56; *Proctor v. Bennis*, 36 Ch. D. 764 (BOWEN, L.J.).

(*y*) *Wenham Gas Co. v. Champion, etc. Co.* 9 R. P. C. 49, 56, judgment of BOWEN, L.J.

(*z*) *Unwin v. Heath*, 5 H. L. 545.

(*a*) Per Lord HALSBURY, L.C., *Nobel's Explosives Co. v. Anderson*, 12 R. P. C. at p. 167. See also *Incandescent Gas Light Co. v. Sunlight, etc. Co.* 13 R. P. C. 333.

Sect. 29 (4). Where a defendant stated that the alleged infringement was his own secret process, PEARSON, J., allowed him to refuse answering questions on cross-examination which might disclose his process, but at the close of the evidence continued the trial *in camera* for the purpose of hearing the defendant state his process, which he elected to do. And in giving judgment for the plaintiff his Lordship avoided stating the alleged secret, and ordered the shorthand notes of the proceedings in court where the case was being heard in private to be impounded in court until there should be an appeal or until further order (b).

NOTE.

Trade secret.

Expert evidence.

The evidence of scientific witnesses is admissible only as proof of facts. It is for them to indicate and elucidate the machinery, and to point out what resemblances there may be in the machinery, and what differences there are, but it is not for them to say one infringes the other, and one is substantially the same as the other, when all the materials are before the court (c).

Nor is it for expert witnesses to say what is the nature of the invention; this must be ascertained from the specification the interpretation of which is for the judge and not for any expert (d).

But the evidence of experts is legitimate and important in order to inform the court what are and what are not equivalent mechanical devices (e), and to explain technical terms, to show the practical working of machinery, and to point out what is old and what is new in the specification (f).

And the court may form an opinion from admitted models, which are evidence similar to documentary evidence (g); and models being examples of the class of machines in question may, in order to explain counsel's argument, be handed up and looked at, although not in evidence (h).

Where expert evidence is explanatory only, and the first witness is not substantially broken down in cross-examination, there is no need to call further expert witnesses (i).

For a form of letter of request to a German court to examine witnesses in the trial of an action for infringement of patent, see *Lister v. Norton* (k).

(b) *Badische Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. 156, 170.

(c) GROVE, J., *Westinghouse v. Lancashire and Yorkshire Rail. Co.*, 1 R. P. C. 245; *Seed v. Higgins*, 8 H. L. C. 565; *Boxill v. Smith*, Griffin, L. O. C. 52; *Brooks v. Steele*, 14 R. P. C. 73.

(d) *Brooks v. Steele*, 14 R. P. C. 46, 73.

(e) *Ticket Punch Register Co. v. Colley's Patents*, 12 R. P. C. 171, 186.

(f) *Brooks v. Steele*, 14 R. P. C. 46, 73.

(g) See cases in previous note (c).

(h) *Boyd v. Horrocks*, 6 R. P. C. 152, 154.

(i) *Automatic Weighing Machine Co. v. Knight*, 6 R. P. C. 113.

(k) 2 R. P. C. 135.

The court looks with suspicion upon evidence which is only brought into existence for the purpose of a cause (*l*), as, for instance, experiments conducted with a view of making evidence for the trial (*m*), or experiments (*n*), or drawings (*o*), made in the course of the trial. Sect. 29 (4).

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NOTE.

In a chemical case, it is not in the least conclusive against the sufficiency of the directions in the specification that a few experiments, made truly by great chemists, but not by practical manufacturers or workmen, have produced unsatisfactory results. The evidence of those who do succeed is always of more force than the evidence of those who do not succeed. Test tube experiments are not nearly so satisfactory as those on a commercial scale, and a chemical patent dealing with very subtle and delicate reactions is entitled to the benefit of being tested by the results of its working in the hands of persons not merely practised in chemistry generally, but having acquired the necessary familiarity with the processes (*p*).

Shorthand notes of the evidence taken by the solicitor's clerk cannot be referred to in the Court of Appeal (*q*).

A *bonâ fide* agreement by a manufacturer of infringing articles to indemnify a purchaser from him against an action by the patentee is not necessarily void as against public policy (*r*).

SUB-SECTION (5).

The court will, at any time during the progress of a patent action, allow the defendant to raise a fresh issue on the discovery of facts which could not, with due diligence, have been discovered before (*s*); and has even permitted a defendant, during the progress of the trial, to give short notice of motion for leave to amend his particulars of objections so as to admit the fresh evidence (*t*). Amendment of particulars allowed at any stage.

But if the application is made during the trial, there must be evidence to justify the application to be allowed to give such notice, and it is a sufficient ground for refusing it that it is not shown that the alleged new facts could not, with reasonable diligence, have been discovered earlier (*u*).

(*l*) *Betts v. Neilson*, L. R. 3 Ch. 433.

(*m*) *Young v. Fernie*, 4 Giff. 609.

(*n*) *Plimpton v. Malcolmson*, 3 Ch. D. 576.

(*o*) *Crompton v. Patents Investment Co.*, 5 R. P. C. 382, 404, FIELD, J.

(*p*) See per WILLS, J., *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône*, 14 R. P. C. 875, 890, 891.

(*q*) *Ellington v. Clark*, 38 Ch. D. 332.

(*r*) *Townsend v. Haworth, Higgins*, pp. 166, 167.

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

(*t*) *Renard v. Levinstein*, 13 W. R. 229; S. C. 11 L. T. (N.S.) 505. See also *Daw v. Eley*, L. R. 1 Eq. 38; *Allen v. Horton*, 10 R. P. C. 412; *Badische Anilin und Soda Fabrik v. Société Chimique, etc.*, *ubi supra*.

(*u*) *Moss v. Malings*, 33 Ch. D. 603. See also *Edison Electric Light Co. v. Shippey*, 4 R. P. C. 471.

Sect. 29 (5). The Court of Appeal under Order LVIII., r. 4, may amend particulars of objections after a trial with a view to the introduction of fresh evidence on the appeal (z).

NOTE.

Terms on which amendment allowed.

The defendant will, however, have to pay the costs of and occasioned by any such application (y). And where a defendant, after amending his objections in compliance with an order to that effect, applied for leave to re-amend by adding certain instances of prior user, leave was granted, but on the terms that the defendant paid the costs of the application, and the additional costs occasioned by the re-amendment were reserved (z).

So, also, where a cause was in the paper for hearing, a defendant was allowed, on application after notice to the plaintiff, to adduce evidence by affidavit of prior user discovered after the cause was in the paper, but upon terms ensuring to the plaintiff an opportunity of filing affidavits in answer, the costs of and consequent on the application being reserved (a).

In *Edison Telephone Co. v. India Rubber Co.* (b), where the application was not made till after the day of trial had been fixed, the court gave the plaintiffs a time within which to elect whether they would discontinue the action, and ordered the defendants in the event of discontinuance to pay all costs incurred by the plaintiffs since delivery of the original particulars of objections; and only allowed the objections to be amended in the event of the plaintiffs not electing to discontinue, the defendants being also ordered to pay the costs of the application. And this form of order is the proper order in an ordinary case (c).

And the mere fact that the plaintiff was aware that there was such an objection as that now sought to be introduced, though he did not know what the effect of the objection was, is not sufficient to justify a departure from this form of order (d).

The order should also provide that the plaintiff should, in any event, have the costs of and consequent upon the amendment being made at this stage of the proceedings (e).

(x) *Shoe Machinery Co. v. Cutlan*, [1896] 1 Ch. 108; *Pirrie v. York Street Flax Spinning Co.* 11 R. P. C. 429, 431.

(y) *Renard v. Levinstein*, *ubi supra*.

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

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

(b) 17 Ch. D. 137, Seton 559, following *Baird v. Moule's Earth*

Closet Co. (M.R. Feb. 3, 1876), and *Aveling v. Maclaren* (C. P. D. Dec. 23, 1880); the two latter orders are printed 17 Ch. D. 139.

(c) *Per* CHITTY, J., *Ehrlich v. Ihlee*, 4 R. P. C. 115. See also *Parker v. Maignen's Filtre Rapide Co.* 5 R. P. C. 207; *Solvo Laundry Supply Co. v. Mackie*, 10 R. P. C. 68.

(d) *Ehrlich v. Ihlee*, *ubi supra*.

(e) *Ibid.* The order in this case is printed 4 R. P. C. 119.

If the plaintiff states at once that he does not intend to discontinue the action the order will simply provide that the costs of the application and all costs occasioned by the amendment and costs unnecessarily caused to the plaintiff by reason of the amendment being made at the last stage of the proceedings, should be the plaintiff's in any event (*f*). Sect. 29 (5).

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NOTE.

But there is nothing in the practice above mentioned to take away from the judge the absolute discretion which he has under the present sub-section of the Act (*g*).

And where in the course of the trial evidence was given of an anticipation not in the particulars of objections, which appeared to destroy the plaintiff's case, and at his request the action was ordered to stand over, an order in the form of *Edison Telephone Co. v. India Rubber Co.* was refused (*h*).

Where the court is of opinion that the new objection is on the face of it unsustainable, leave to amend will be refused (*i*).

It is the usual practice, when applying for leave to amend objections, to state the particular amendments which it is desired to make. (See the various cases on amendments cited above).

Under an order for further and better particulars new instances cannot be added without leave (*k*).

Where a new trial has been directed the defendant will be allowed to bring forward further particulars on which to found, at the new trial, evidence of prior user not given at the first trial (*l*). On new trial further particulars allowed.

A plaintiff has been allowed to amend his statement of claim at the trial, so as to charge as custom-house agents defendants who had been originally sued as importers, but who, as it appeared for the first time on their own evidence, were, in fact, custom-house agents only. The plaintiff, however, was not allowed to adduce fresh evidence, but the defendant had liberty to amend his defence and adduce fresh evidence (*m*).

SUB-SECTION (6).

“Shall not be allowed any costs, etc., unless,” etc.—The corresponding section (*n*) of the Act of 1852 provided that in taxing the costs of any action for infringing letters patent regard should be had to the particulars delivered in such action, and that the plaintiff and defendant

(*f*) *Parker v. Maignen's Filtre Rapide Co.*, 5 R. P. C. 207.

(*g*) *Woolley v. Broad*, [1892] 2 Q. B. 317; 9 R. P. C. 429.

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

(*i*) *Holste v. Robertson*, 4 Ch. D. 9.

(*k*) *Aktiebolaget Separator v. Dairy Outfit Co.* 13 R. P. C. 725.

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

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

(*n*) Section 43.

Sect. 29 (6). respectively should not be allowed any costs in respect of any particular unless certified by the judge before whom the trial was had to have been proved by such plaintiff or defendant respectively without regard to the general costs of the cause.

NOTE.

The present sub-section adds the words "to have been reasonable and proper," and alters the requirement of a certificate by "the judge before whom the trial was had" to the requirement of a certificate by "the court or a judge." These alterations, it will be seen, have produced an important change in the practice as to costs of particulars.

Practice under Act of 1852.

The provisions of the Act of 1852 were held to apply only where there had been a trial, and where there was no trial matters were left as if there had been no such enactment; and, therefore, when a plaintiff abandoned his action, after having given notice of trial, the defendant was held entitled to the costs of preparing his particulars of objections and evidence in support of them (o). But if there were a trial and the plaintiff was non-suited, it was held at common law that the defendant was not entitled to any costs in respect of his particulars of objections unless the judge certified that they had been proved (p). And in a case where the patent was held void the court refused to certify that the plaintiff had proved his particulars of breaches, even though it was of opinion, on the evidence, that the defendant had infringed (q).

New practice.

The present sub-section has altered the old practice, and its operation is not limited to cases where the action is brought on for trial and tried (r).

If no certificate no costs of particulars

In some cases the court, while refusing a certificate, has given liberty to apply as to the costs of the particulars of objections (s), or has reserved the question of costs and certificate till the matter has been before the taxing-master (t). But the taxing-masters decline to go into the question of the costs of particulars without a certificate (u). And it is now settled that the provisions of this sub-section are express and that

(o) *Greaves v. The Eastern Counties Rail. Co.*, 1 Ell. & Ell. 961; S. C. 28 L. J. (N.S.) Q. B. 290; *Batley v. Kynock*, L. R. 20 Eq. 632.

(p) *Honiball v. Bloomer*, 10 Ex. 538; S. C. 24 L. J. (N.S.) Ex. 11. As to this case, see observations of BRISTOWE, V.-C., in *Parnell v. Mort, Liddell & Co.*, 1 R. P. C. 4, and BOWEN, L.J., S. C. on appeal, 29 Ch. D. 329; 2 R. P. C. 60; 33 W. R. 481.

(q) *United Telephone Co. v. Harrison*, 21 Ch. D. 720.

(r) *Middleton v. Bradley*, [1895] 2 Ch. 716; *Wilcox and Gibbs v. Janes*, [1897] 2 Ch. 71. A contrary view had been expressed in *Rothwell v. King*, 4 R. P. C. 397.

(s) *Rowcliffe v. Longford, etc. Co.* 4 R. P. C. 288.

(t) *Mandleberg v. Morley*, 11 R. P. C. 1.

(u) See *Mandleberg v. Morley*, 12 R. P. C. 35; *Middleton v. Bradley*, *ubi supra*.

when no certificate has been given the costs of particulars cannot be allowed (x). Sect. 29 (6).

And this rule was held to apply even when in an action to restrain infringement of a patent and the issue of certain circulars, the plaintiff after the defendant had delivered defence and particulars of objections amended his statement of claim, and abandoned the case as to infringement and subsequently discontinued the whole action (y).

But when the plaintiff after the close of the pleadings applied for leave to discontinue, he was only allowed to do so on paying the costs of objections as if the same had been certified to be reasonable and proper (z).

If the case of the plaintiff fails on any one point, the general rule is that the court will not go into the other objections merely for the purpose of seeing whether a certificate under this sub-section shall be given (a). When plaintiff's case fails.

Thus, where the action failed by reason of the invalidity of the patent being proved by one of the plaintiff's witnesses, and judgment was given for the defendants without their being called on for their defence, it was held, under this present sub-section, by STIRLING, J., that the judge must be satisfied, having regard to the knowledge he had acquired in the conduct of the case, that the particulars were reasonable and proper, and that it was not his duty either to put himself back into the position in which the advisers of the defendants were when they framed the particulars of objections, or, on the other hand, to carry himself forward by having additional evidence brought before him. And a certificate was accordingly granted to the defendants in respect of certain particulars of objections specified by the judge; but, inasmuch as the plaintiffs were held not entitled to costs at all, a certificate that they had proved their particulars of breaches was refused (b).

In the *Albo-Carbon Light Co. v. Kidd* (c), where the defendants succeeded on an objection as to subject-matter without being called upon, a certificate that they had proved their objections was granted, not extending, however, to those objections which it was for them to prove and which they had not proved. And, in a similar case, the court refused to certify that the defendant's objections, which he had

(x) *Longbottom v. Shaw*, 43 Ch. D. 46; *Middleton v. Bradley*, [1895] 2 Ch. 716.

(y) *Middleton v. Bradley*, *ubi supra*.

(z) *Boake, Roberts & Co. v. Stevenson*, 12 R. P. C. 228; *Bethell v. Gage*, 14 R. P. C. 699.

(a) *Boyd v. Herrocks*, 6 R. P. C. 152; *Longbottom v. Shaw*, 6 R. P. C. 143, 147; *Newsum v. Mann*, 7 R. P. C. 310; *Dairy v. Bailey*, 8 R. P. C. 166.

(b) *Germ Milling Co. v. Robinson*, 3 R. P. C. 254.

(c) 4 R. P. C. 535.

Sect. 29 (6). no opportunity of proving, were reasonable and proper, upon the ground that, for the present, the judgment of the court must be assumed to be right ; and in that case the objections were unnecessary (*d*).

NOTE.

And when the plaintiff, on the action coming on for trial, submitted to have it dismissed with costs, without the case being heard, it was held that no certificate that the defendant's objections were reasonable and proper could be given (*e*).

There may, however, be cases where the matter is decided against the plaintiff without calling on the defendant's counsel, and yet the court, relying upon the evidence obtained by the defendant in cross-examining the plaintiff's witnesses, may think it right to look at the particulars of objections and allow the costs of such particulars of objections as were in fact made out by the cross-examination (*f*).

Thus, where a patent was held bad on evidence of prior user of an article put to the plaintiff in cross-examination, which evidence the defendant was allowed to give at once without waiting for the close of the plaintiff's case, a certificate was given to the defendant that his particulars of objections were reasonable and proper, limited, however to the anticipation put to the plaintiff in cross-examination (*g*).

And the costs of particulars of prior user, useful as showing the state of knowledge at the date of the patent, were allowed, although the patentee's case broke down on the point of subject-matter (*h*).

Action discontinued.

And even when there has been no trial and the action has been discontinued, it may be that there has been a motion on which evidence may have been given which would give the court materials for determining whether the particulars of objection were reasonable, or it may be that there has been some other interlocutory application, perhaps with reference to the particulars themselves, upon which the court may have had an opportunity of forming an opinion on the subject (*i*).

But if the action is discontinued before the close of the pleadings, and there is no evidence before the court as to the nature of the patent, the court cannot go into the case merely to see whether a certificate can be given that the particulars of objections are reasonable and proper (*k*).

(*d*) *Longbottom v. Shaw*, 5 R. P. C. 497 ; 6 R. P. C. 147. See also *Oddy v. Smith*, 5 R. P. C. 503 ; *Boyd v. Horrocks*, 6 R. P. C. 152, 162 ; *Fairfax v. Lyons*, 8 R. P. C. 401, 410.

(*e*) *Mandleberg v. Morley*, 12 R. P. C. 35.

(*f*) *Per* KAY, J., *Longbottom v. Shaw*, 43 Ch. D. 46, 51.

(*g*) *Badham v. Bird*, 5 R. P. C. 238 ; and see *Griffin v. Weaver*, 6 R. P. C. 396 ; *Phillips v. Ivel*

Cycle Co., 7 R. P. C. 77 ; *Dairy v. Bailey*, 8 R. P. C. 166 ; *Nuttall v. Hargreaves*, 8 R. P. C. 273, 276 ; *Heyes v. Hallmark*, 9 R. P. C. 25.

(*h*) *Dege's Patent*, 12 R. P. C. 448. See also *Nobel's Explosives Co. v. Anderson*, 11 R. P. C. 115, 128.

(*i*) *Per* STIRLING, J., *Middleton v. Bradley*, [1895] 2 Ch. 716, 718. And see *Brooks v. Steele*, 14 R. P. C. 46 (stated *post*, p. 230).

(*k*) *Wilcox and Gibbs v. Janes*, [1897] 2 Ch. 71.

Where an action for infringement was dismissed on the ground of non-infringement, the court not deciding the question of validity of the patent, and no certificate under this sub-section was given to the defendant, it was held that the plaintiff could not, under Order lxxv. r. 27, sub-r. 20, have his costs of meeting the defendant's objections on the ground that they were "improper, vexatious, or unnecessary." In such a case the plaintiff ought to ask the court to direct the taxing-master to see whether the proceedings have been "improper, etc.," and to order that the plaintiff shall have the costs of such improper proceedings (l).

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NOTE.

Costs of vexatious proceedings.

Where certain specifications and prior users were mentioned in the objections, but not insisted on, or not considered material at the trial, a certificate as to these was refused (m). And in *Singer v. Rudge Cycle Co.* (n), the certificate that the defendant had proved his objections as to want of novelty was accompanied by an expression of the opinion of the court that he was not, in the costs of the particulars of objections, to have the costs of specifications other than those actually used at the trial.

Unnecessary matters in particulars.

And where the particulars alleged four breaches, and only three were proved at the trial, the certificate was confined to the breaches actually proved (o).

The costs of all specifications put in evidence may be allowed, not merely those which were proved to be anticipations (p).

Costs of specifications put in evidence.

So, also, where prior specifications were put in evidence, and were of assistance to the court, the costs were allowed to the defendant, although in the result the court only found non-infringement, and gave no opinion as to the validity of the patent (q).

But where the patent is upheld, the mere fact that some of the objections have compelled the court to put a narrow construction on the specification, and to hold that there is no infringement, will not enable the court to give the defendant the costs of these objections (r).

The Court of Appeal is not the judge pointed at by this section, but where the judgment of the court below is reversed the Court of Appeal will make such an order as the judge who heard the case ought

Certificate by Court of Appeal.

(l) *Garrard v. Edge*, 44 Ch. D. 224, 235.

(m) *Lawrence v. Perry*, 2 R. P. C. 179. See also *Pooley v. Pointon*, 2 R. P. C. 167; *Binnington v. Hill*, 8 R. P. C. 326; *Fairfax v. Lyons*, 8 R. P. C. 401, 410.

(n) 11 R. P. C. 585.

(o) *Cole v. Sagni*, 5 R. P. C. 489.

(p) *Crosthwaite v. Moorwood*, 11 R. P. C. 555, 562.

(q) *Nettlefolds v. Reynolds*, 9 R. P. C. 270, 290. See also *Jardine v. King Mendham & Co.*, 13 R. P. C. 411.

(r) *Shoe Machinery Co. v. Cutlan*, 12 R. P. C. 342, 360.

Sect. 29 (6). to have made, and therefore will, when proper, certify under this section (s). So, also, the certificate may be granted by the House of Lords (t).

NOTE.

Thus, where the action was dismissed in the court below, without hearing the defendant's evidence, on the ground that the alleged invention was not subject-matter for a patent, and the Court of Appeal, after hearing the defendant's evidence, affirmed the decision; the Court of Appeal gave a certificate that all the objections were reasonable and proper (u).

And when the court below had upheld the patent, and granted an injunction, and the decision was reversed in the Court of Appeal, on the ground that the patent was invalid, the Court of Appeal granted a certificate that the particulars of objections were proven, or were reasonable and proper (x).

Where the decisions of the judge of first instance and of the Court of Appeal, both of which upheld the patent, were reversed by the House of Lords, a certificate that certain of the objections were reasonable and proper was, on the application of the defendant, given by the judge who tried the case (y).

"Reasonable and proper."—It is not necessary that the particulars should be proved, or could have been proved. The judge need only certify that they are reasonable and proper (z).

When the court of first instance dismissed the action, and gave a certificate that the objections were reasonable and proper, and the Court of Appeal held the second claim of the specification good but that the patent was invalid because the first claim was too wide, it was held, that as it could not have been said that the particulars would have been unreasonable if the specification had contained only the first claim, the certificate of the judge below was right, and the appeal was dismissed with costs (a).

When a plaintiff by his statement of claim alleged infringement of six patents, and defendants put in particulars of objections to them all, and the plaintiff subsequently abandoned his case as to three patents, and the defendants succeeded in the action, a certificate that the

(s) *Cole v. Saqui*, 40 Ch. D. 132; *Humpherson v. Syer*, 4 R. P. C. 407, 416. See also *Shoe Machinery Co. v. Cutlan*, [1896] 1 Ch. 108.

(t) *Morris v. Young*, 12 R. P. C. 455, 465.

(u) *Deutsche Nähmaschinen Fabrik v. Pfaff*, 7 R. P. C. 251, 257.

(x) *Cole v. Saqui*, 40 Ch. D. 132; *Humpherson v. Syer*, 4 R. P. C. 407, 416.

(y) *Morgan v. Windover*, 7 R. P. C. 446.

(z) *Phillips v. Ivel Cycle Co.* 7 R. P. C. 77, 84; *Heyes v. Hallmark*, 9 R. P. C. 25.

(a) *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate*, 12 R. P. C. 303.

objections to all the patents were reasonable and proper was given, **Sect. 29 (6).**
 except as to certain particulars relating to the contested patents which
 had not been urged at the trial. And it was held that the abandonment
 by the plaintiff of part of his case ought not to operate to deprive the
 defendants of any costs properly incurred by them in resisting the claim
 as originally made (b).

NOTE.

When an important objection, on which the defendant succeeded, was only added during the trial, the action was dismissed without costs, and a certificate under this section was refused (c).

Section 43 of the Act of 1852 applied only to the courts of common law, which had no discretion as to costs, but the Court of Chancery had always such a discretion, and was, therefore, not bound to follow that section, and the Acts which gave common law jurisdiction to the Court of Chancery were not intended to fetter this discretion (d). Costs irrespective of certificate.

And, accordingly, in the Court of Chancery costs were given irrespective of any certificate under the above section (e); and in a case in the Court of the County Palatine of Lancaster, where the Vice-Chancellor had virtually non-suited the plaintiff, the costs of the defendants' particulars of objections were allowed, though no certificate was asked or given (f).

But since the Judicature Acts, the judges of the Common Law Division, as well as the judges of the Chancery Division, have an absolute discretion as to costs, and there is nothing to exclude any particular actions from that discretion (g), and it will be seen that in both divisions costs have been given in patent actions without reference to any certificate of proof of the particulars.

And now, subject to the Judicature Acts, and rules of court thereunder, and to the express provisions of any statute, the costs of and incident to all proceedings in the Supreme Court are in the discretion of the court or judge, and a judge has full power to determine by whom and to what extent such costs shall be paid (h).

By S. C. R. 1883, Order lxx. r. 2, it is provided that where issues of fact and law are raised upon a claim or counter-claim, the costs of the

(b) *Brooks v. Steele*, 14 R. P. C. 46, 72.

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

(d) *Parnell v. Mort Liddell and Co.* 29 Ch. D. 325, 329. See also *Garnett v. Bradley*, 3 App. Cas. 944.

(e) See Seton, p. 565; Pemberton, 484.

(f) *Parnell v. Mort Liddell and Co.*, *ubi supra*.

(g) S. C. R. 1883, Order LXV. r. 1, extending Order LV. r. 1 of 1875. BOWEN, L.J. *Parnell v. Mort Liddell and Co.*, *ubi supra*.

(h) 53 & 54 Vict. c. 44, s. 5.

Sect. 29 (6). several issues both in law and fact shall, unless otherwise ordered, follow the event.

NOTE.

Apportionment of costs of separate issues.

There are several cases, some before the enactment of the last-mentioned rule, in which the court has dealt with the costs of patent actions according to the result of the issues. Thus, where a plaintiff succeeded on the issue as to validity of the patent, but failed as to infringement, the costs were apportioned (*i*). In a similar case, the Court of Appeal gave the defendants the general costs of the trial and appeal, but, as to the suggested want of novelty in the plaintiff's invention, gave no costs on either side (*k*). In another like case the action was dismissed with costs, but the Court of Appeal directed that the plaintiff should be allowed any costs which he had incurred by reason of the pleas of want of novelty beyond what he would have incurred if those pleas had not been put on the record (*l*).

The court has also given one party the costs of the issue of validity, and the other those of the issue of infringement, giving no general costs of the action to either party (*m*).

And where, the plaintiff having succeeded on the validity of the patent but having failed on the question of infringement, the court gave the defendant the general costs of the action, the defendant has nevertheless been ordered to pay the costs of his particulars of objections (*n*).

Where the plaintiff sued on two patents, and there were various findings on the different claims in the respective patents, the ultimate result being in favour of the plaintiff on the validity of the patents, but in favour of the defendants on the question of infringement, it was ordered that the costs should abide the event of the several findings, and that, save as aforesaid, the defendants should have their costs of suit from the plaintiff (*o*).

But in *Boyd v. Horrocks* (*p*), when the court of first instance had held in favour of the plaintiff, both on the question of validity of the patent and infringement, and the Court of Appeal, without going into the question of validity, reversed the judgment as to infringement, with costs, and gave liberty to the defendants to apply for repayment of a

(*i*) *Simmonds v. Hitchman*, 29 Ch. D. 417, n.; Eng. Rep. Jan. to Mar. 1881, p. xvi. See the order in the Appendix, *post*.

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

(*l*) *Nordenfelt v. Gardner*, 1 R. P. C. 61.

(*m*) *Scott v. Hamling*, 14 R. P. C. 123.

(*n*) *Sunlight Incandescent Co. v. Incandescent Gas Light Co.* 14 R. P. C. 757, 776.

(*o*) *Westinghouse v. Lancashire and Yorkshire Rail. Co.*, 1 R. P. C. 229, 254. See also *Automatic Weighing Machine Co. v. Knight*, 6 R. P. C. 113, 120, 297; *Tweedale v. Ashworth*, 7 R. P. C. 426.

(*p*) 6 R. P. C. 528.

sum of costs which they had paid into court pending the appeal, it was held by the Vice-Chancellor of the County Palatine of Lancaster that, as the defendants had done no wrong at all, there ought not to be any apportionment of costs. **Sect. 29 (6).**

NOTE.

In the foregoing cases the plaintiff succeeded in establishing the validity of his patent, but the principle of apportionment of costs has been applied also where the defendant succeeds on this issue, and fails on that of infringement. **Apportionment of costs where patent invalid.**

Thus, in *Wegmann v. Corcoran* (q), where, in an action for alleged infringement of two patents, the defendants denied the validity of both patents upon the usual grounds, and also denied infringement, and at the trial the plaintiffs abandoned the action entirely as to one patent, and the defendants only argued on the other patent the question of insufficiency of specification, on which they succeeded, and the action was dismissed with general costs of action, it was held, under the Act of 1852, that the defendants were to have from the plaintiffs their costs of the particulars of objections and particulars of breaches in the case of the patent on which the action was abandoned, and that the plaintiffs should have from the defendants the costs of the particulars of breaches of the other patent (q).

Where the plaintiffs sued on two patents and succeeded as to one only, the action was dismissed with costs as to one patent, and an injunction was granted with costs as to the other (r).

Where the jury found that the defendants had infringed, but that the invention was neither new nor useful, judgment was given for the defendants, with the general costs of the action, and it was held that the plaintiffs were entitled to a certificate that they had proved their particulars of breaches, but (apparently on account of certain special circumstances in the case) so as to entitle them only to the costs of delivering such particulars and subpoenaing the witnesses in support thereof; and the defendants were held entitled to a certificate that they had proved their objections except in regard to certain matters specified (s).

The general question was considered, since the present Act, by the Court of Appeal in the *Badische Anilin und Soda Fabrik v. Levinstein* (t), where the action was tried in 1883, and was therefore under the Act of 1852. In that case it was said that the rule adopted **General rule as to apportionment of costs.**

(q) 27 W. R. 357, 362.

(r) *United Telephone Co. v. Harrison*, 21 Ch. D. 747. See also *Hocking v. Fraser*, 3 R. P. C. 7; *Edison, etc. Co. v. Woodhouse* (first action), 3 R. P. C. 167. *Shrewsbury,*

etc. Co. v. Sterckx, 12 R. P. C. 336, 342.

(s) *Young v. Rosenthal*, 1 R. P. C. 29, 41.

(t) 29 Ch. D. 366, 418.

Sect. 29 (6)

NOTE.

in *Wegmann v. Corcoran* (cited above), was in accordance with the provisions of the present Act, and it was held that without laying down any hard and fast line, or fettering the discretion of the Court of Appeal or other the judges in other cases, 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, was a sound principle to act upon, and the result of the action being that the patent was invalid, but that the defendant was held to have infringed, it was ordered that the defendant should pay to the plaintiffs the costs occasioned by the issues raised by the particulars of breaches, but that the plaintiffs should pay to the defendant all the other costs of the action, and there should be a set-off in respect of costs (u).

And when at the trial the defendant admitted infringement, though he had pleaded non-infringement, and the court found against the patent, the costs were not apportioned (v).

And in *Pooley v. Pointon* (x), where the patent was held void, but the plaintiff succeeded on the issue as to infringement, the plaintiff was held entitled not only to the costs of the latter issue, but also to the costs of an objection that the plaintiff was not the inventor, which was not the objection on which the patent was invalidated.

When in a threats action under s. 32 the plaintiff pleaded non-infringement and invalidity of the defendants' patent and at the trial gave up the latter issue and the jury found that he had not infringed and an injunction was granted, the costs of the issue of validity were allowed to the defendants, the general costs of the action being given to the plaintiff (y).

And in *Lister v. Norton* (z), where the patent was held invalid on the ground of prior user, but the defendants had alleged want of subject-matter, insufficiency of the specification, and that plaintiff was not first and true inventor, and had also impeached the validity of the patent on a legal point, on all of which grounds they failed, the costs of all these issues were given to the plaintiff. And in the same case when infringement was admitted but not till a late stage of the action, it was held that the plaintiff was to have the costs of the issue of infringement up to the date of the admission.

(u) The order made is set out in 29 Ch. D. p. 420. As to proper form of order when costs are apportioned, see *Shoe Machinery Co. v. Cutlan* (No. 2), 13 R. P. C. 395.

(v) *Westley Richards v. Perkes*, 10 R. P. C. 181, 194.

(x) 2 R. P. C. 167. See also *Laurie v. Baker*, 2 R. P. C. 213; *Automatic Weighing Machine Co. v.*

Knight, 6 R. P. C. 113, 120; *Phillips v. Irel Cycle Co.* 7 R. P. C. 77; *Binnington v. Hill*, 8 R. P. C. 326; *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Sydicate*, 11 R. P. C. 638.

(y) *Ungar v. Sugg*, 6 R. P. C. 337.

(z) 3 R. P. C. 199, 211.

But this course is not always followed ; and where the patent is held invalid, the court has refused to apportion the costs (a). Sect. 29 (6).

NOTE.

Sometimes, where it appears that if the costs are apportioned one party would have to pay as much as he would be entitled to receive, the court, in order to avoid a troublesome and difficult apportionment of costs on taxation, will cut the knot by giving no costs to either party (b). Costs not always apportioned.

And in *Monnet v. Beck* (c), where the defendants, though succeeding in the action, had raised certain issues on which they had failed, the court directed the taxation of costs to proceed as if the defendants had succeeded on everything, and gave the defendants two-thirds of the sum so arrived at.

Where the Court of Appeal had held the patent bad, and also that there was no infringement, and on appeal to the House of Lords the patent was held to be valid, but the judgment as to infringement was affirmed, the appeal was dismissed ; but as the plaintiff had obtained an important result in his favour, no costs of the appeal were given (d).

The costs of particular issues allowed to any party include the costs of appeal as well as the costs in the court below (e).

“Certified by the court or a judge.”—See notes under s. 31, *post*.

The certificate under this sub-section, if not applied for at the trial, may be given on an application made within a reasonable time afterwards (f).

It seems that the certificate cannot be given on the trial of a petition for revocation of a patent (g).

“General costs of the case.”—The rule as to costs has thus been stated by JESSEL, M.R. :—“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 General rule as to costs.

(a) *Edison, etc. Co. v. Holland*, 5 R. P. C. 459, 483 ; *Blakey v. Latham*, 6 R. P. C. 38, 186, 190 ; *Kaye v. Chubb*, 4 R. P. C. 289, 303.

(b) *Sugg v. Bray*, 2 R. P. C. 223, 248.

(c) 14 R. P. C. 777, 852.

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

(e) *Badische Anilin und Soda Fabrik v. Levinstein*, 29 Ch. D. 366, 420.

(f) *Rowcliffe v. Morris*, 3 R. P. C. 147.

(g) *Re Gaulard and Gibbs’ Patent*, 5 R. P. C. 525, 537.

Sect. 29 (6). 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" (*h*).

NOTE.

No ground for refusing costs that defendant acted in ignorance, or had no notice of intended proceedings. Thus, it is no ground for refusing the plaintiff his costs that the defendant acted in ignorance of the plaintiff's rights (*i*), or never intended to do wrong (*k*). Nor will the plaintiff be refused costs because, before suing, he made no application to the defendant (*l*). It has never been laid down that a plaintiff entitled to relief must, before commencing proceedings, apply to the defendant, and ascertain previously whether he will without suit do all that is required (*m*).

When defendant offers to submit. Sometimes a person infringing a patent will, on complaint being made, offer to discontinue the infringement, and account for the profits he has made. A question then arises as to whether the patentee is bound to accept this promise, or is entitled to take proceedings for an injunction.

In *Losh v. Hague* (*n*), SHADWELL, V.-C., said :—"I do not think it enough on a question of injunction for the defendant to say why he has done the thing complained of, but will not do it again. That is not the point, because if a threat had been used, and the defendant revokes the threat, that I can understand as making the plaintiff satisfied ; but if once the thing complained of has been done, I apprehend this court interferes, notwithstanding any promise the defendant may make not to offend again."

And in *Geary v. Norton* (*o*), Sir J. L. KNIGHT-BRUCE, V.-C., asked "whether it had ever been decided where a right of this kind had been invaded, and the invading party says he is doing wrong and will do so no more, that the party complaining is barred as to his costs on filing a bill to have the protection of an injunction rather than the promise of the person." And in that case, where the defendant had before bill filed merely promised not to repeat the infringement, the plaintiff was held entitled to his costs of suit.

(*h*) *Cooper v. Whittingham*, 15 Ch. D. 504. See also *Edelsten v. Edelsten*, 1 D. J. & S. 185, 204.

(*i*) *Burgess v. Hills*, 26 Bea. 244 ; *Collins' Co. v. Walker*, 7 W. R. 222 ; *Cooper v. Whittingham*, 15 Ch. D. 505 ; *Upmann v. Forrester*, 24 Ch. D. 231.

(*k*) *Cooper v. Whittingham*, 15 Ch. D. 507. See also *Datenport v. Rylands*, L. R. 1 Eq. 303.

(*l*) *Burgess v. Hatcley*, 26 Bea. 249 ; *Upmann v. Forrester*, 24

Ch. D. 231 ; *Wittman v. Oppenheim*, 27 Ch. D. 260.

(*m*) Per LORD ROMILLY, M.R., *Upmann v. Elkan*, L. R. 12 Eq. 146 ; *Cooper v. Whittingham*, 15 Ch. D. 505 ; *Upmann v. Forrester*, 24 Ch. D. 236 ; *Fennessy v. Day*, 55 L. T. (N.S.) 161.

(*n*) 1 Webst. P. C. 200.

(*o*) 1 De G. & Sm. 9. And see remarks of COTTON, L.J. on this case, *Proctor v. Bayley*, 42 Ch. D. 390, 400.

And when defendants, before suit, offered to remove certain parts of the machine which were alleged to be infringements, but did not offer to undertake never to use them again, it was held that the offer was insufficient, and that plaintiffs were entitled to the protection of an injunction, and that defendants must pay the costs of the action (p). Sect. 29 (6).
—
NOTE.

But an injunction ought not to be granted when the defendant has discontinued the wrongful acts and there is no ground to apprehend that they will be repeated. And, therefore, where infringing machines had been used by the defendants, but had been taken down and disused five years, and removed from defendants' premises three years before the action, and there was no ground for inferring an intention to continue the use, it was held in an action for infringement, and notwithstanding that the defendants denied that they had infringed, that the plaintiffs were not entitled to an injunction (q).

And in *Scott v. Hull Steam Fishing, etc. Co.* (r), where the court held that there was no further intention to use the invention, nominal damages were given with liberty to apply for an injunction if necessary. And where the infringement was small and the defendants offered to give an undertaking not to infringe, the injunction was refused (s).

In *Upmann v. Elkan* (t), a trade mark case, Lord ROMILLY, M.R., said that "a party using a forged trade mark, though innocently, is liable for [the costs of setting that right up to the time when he first knew of the forgery; but if, after that time, he stops, and is willing to undertake not to go any further with the use of the mark, he is not liable for further costs." And again, "It is his duty at once to give the plaintiff all the information required, and to undertake that the goods shall not be removed or dealt with till the spurious brand has been removed, and to offer facilities for that purpose. If, after that, the person injured file a bill, though he will be entitled to all that he asks in the shape of relief, as he might have got it all without suit he will not get from such defendants the costs of the suit, and he may have to pay them." What costs innocent infringer must pay.

A plaintiff was not, under the old Chancery practice, bound to accept the defendant's affidavit as to the profits made by him, and had a right to an answer from the defendant, and might have his costs up to and including the answer (u).

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

(q) *Proctor v. Bayley*, 42 Ch. D. 390; *Leahy v. Glover*, 10 R. P. C. 141 (H. L.).

(r) 14 R. P. C. 143.

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

(t) L. R. 12 Eq. 144, 145; affirmed L. R. 7 Ch. 131. See also *Wittman v. Oppenheim*, 27 Ch. D. 260.

(u) *Colburn v. Simms*, 2 Ha. 543.

Sect. 29 (6).**NOTE.**

And a plaintiff is also entitled in strictness to an account of profits at the hearing of the cause, though if the court thinks the conduct of the plaintiff has been oppressive, it will only give such an account at the plaintiff's peril (*x*).

And the plaintiff may have his costs, even though the injunction is submitted to, and the plaintiff waives the account at the hearing (*y*).

But if plaintiff's conduct oppressive or improper, he may be refused costs.

But where a defendant who had in ignorance infringed the plaintiff's patent offered before suit to discontinue the infringement, and to pay the amount of profits made, and to sell the stock to the plaintiff or to take it to pieces, and the plaintiff insisted on taking the account and on the destruction of the stock in hand, and a signed apology, and, on this being refused, instituted a suit for injunction and account, the court, although the defendant submitted at the hearing to a perpetual injunction, gave the plaintiff no costs (*z*).

In a trade libel case where the plaintiff obtained only nominal damages he was ordered to pay the costs of the action (*a*).

If, after the commencement of the action, the defendant offers to submit to all the relief to which the plaintiff is entitled, the plaintiff will not have the costs of the subsequent prosecution of the suit (*b*).

And in a trade mark case where the defendant, who had innocently infringed, offered immediately after service of the writ in an action brought without previous notice an undertaking in terms of the indorsement on the writ, and to withdraw the goods marked with the spurious mark from sale, and the plaintiff nevertheless moved for an injunction, it was held that the motion was unnecessary, the undertaking being as good as an injunction, but that the plaintiff was entitled to a small sum for costs, *e.g.*, for the costs of the writ, and 5*l.* only was allowed him for costs (*c*).

Where defendant was a retailer who had innocently bought a small quantity of cigarettes made by a third person, and marked with a close imitation of the plaintiffs' trade mark, and the plaintiffs without previous notice brought an action for infringement, and the defendant thereupon returned the spurious goods to the makers, and submitted to any order the court might make, but contended that he ought not to pay costs, it was held that the defendant was not bound to pay costs (*d*).

(*x*) *Nunn v. D'Albuquerque*, 34 Bea. 595.

(*y*) *Burgess v. Hateley*, 26 Bea. 249; *Burgess v. Hills*, 26 Bea. 244; *Upmann v. Forrester*, 24 Ch. D. 236.

(*z*) *Nunn v. D'Albuquerque*, 34 Bea. 595. See also *Hudson v.*

Bennett, 14 W. R. 911; *Smith v. Roberts*, 5 R. P. C. 611.

(*a*) *Dicks v. Brooks*, 15 Ch. D. 41.

(*b*) *Colburn v. Simms*, 2 Ha. 543.

(*c*) *Caruncho v. Highmore*, L. J. No. Cas. 1883, p. 15.

(*d*) *American Tobacco Co. v. Guest*, [1892] 1 Ch. 630.

And where the allegation of infringement failed, the circumstance that the defendant had before action infringed the patent, but had discontinued that infringement, was held (the defendant offering to pay what was reasonable in respect of the former infringement) to be no reason for not making the plaintiffs pay the costs of the action (e). Sect. 29 (6).
—
NOTE.

Where, on an appeal to the House of Lords, the respondent continued the appeal after the appellant had offered to give him all to which he was entitled, the respondent, though successful, was ordered to pay the costs of the appeal subsequent to the date of the offer (f). And may be made to pay costs.

And in a designs case the court, considering that some very unscrupulous evidence had been given on the part of the plaintiffs, who succeeded in the action, only gave the plaintiffs two-thirds of their taxed costs (g).

And when before action on a patent which had been upheld in a previous action the defendant offered to give any proper undertaking not to infringe the patent, and the plaintiff nevertheless moved for an injunction, it was held that the motion was unnecessary, and, on the defendant's undertaking not to use the machine until trial or further order, the costs of the motion were ordered to be paid by the plaintiff (h).

And if the defendant offers to submit to an injunction to be obtained by summons in chambers, and the plaintiff moves for an injunction and succeeds, the costs payable by the defendant may be limited to what they would have been if the application had been made for an order by consent in chambers (i).

But the defendant, in order to avoid costs, must offer to pay the plaintiff's costs of suit already incurred or the plaintiff may bring the cause to a hearing, and the defendant will then have to pay the costs (k), —*a fortiori* if the defendant has actually refused to pay costs (l). What defendant should do to avoid costs.

Where a defendant who has before suit promised not to infringe again raises after suit objections to the patent, which he afterwards abandons, he may be refused his costs, although the court dismisses the bill (m).

(e) *Fletcher v. Glasgow Gas Commissioners*, 4 R. P. C. 386, a Scotch case.

(f) *De Vitre v. Betts*, L. R. 6 H. L. 319, 326.

(g) *Sherwood v. Decorative Tile Co.*, 4 R. P. C. 207.

(h) *Lyon v. The Mayor, etc. of Newcastle-on-Tyne*, 11 R. P. C. 218; *Snuggs v. Seyd, etc. Co.*, [1894] W. N. 95.

(i) *Slazenger v. Pigott*, 12 R.P.C. 439.

(k) *Burgess v. Hateley*, 26 Bea. 249; *Fradella v. Weller*, 2 R. & M. 247; *Geary v. Norton*, 1 De G. & Sm. 9, 12.

(l) *Burgess v. Hills*, 26 Bea. 248.

(m) *Betts v. Willmott*, 18 W. R. 946.

Sect. 29 (6). A person charged with infringement who desires to submit before suit ought to offer to pay the plaintiff's costs of consulting his solicitor (*n*).

NOTE.

Defendant bankrupt, trustees defending, and failing.

Where a defendant became bankrupt after the commencement of proceedings, and then delivered a defence, but did not appear at the trial, and his trustees in bankruptcy were made defendants, and an account of profits was asked against them, though there was no allegation that they had manufactured, and the trustees put in no defence, but appeared at the trial and objected that the amount to be found under the account was not proveable in the bankruptcy, and cross-examined witnesses in order to show no infringement, it was held that the plaintiff succeeding in the action, the trustees must pay the costs (*o*).

Directors of company.

The directors of a limited company may be made personally liable to the costs of an action against the company to restrain infringement of a patent, even though they may show that the acts complained of were done by workmen contrary to orders (*p*).

Married woman.

In the case of a married woman ordered to pay costs, the costs were ordered to be paid out of her separate property and not otherwise, with liberty to apply for payment out of any property subject to a restraint on anticipation (*q*).

It seems that the court will not make an order for costs when it is probable that proceedings in the cause may afterwards take place which will affect the decision of the court upon the question of costs, and therefore when a bill to restrain infringement of a patent was, under the old chancery practice, retained at the hearing, to give the plaintiff an opportunity of trying the right at law, the court refused to make an order as to the costs of the evidence which had been adduced, and which costs were claimed by the plaintiff on the ground that the defendant had not required him to establish his title at law before the hearing (*r*).

When defendant succeeded on an objection to the patent introduced only by amendment at the trial the action was dismissed without costs (*s*).

(*n*) *Nunn v. D'Albuquerque*, 34 Bea. 596.

(*o*) *Watson v. Holliday*, 20 Ch. D. 780; affirmed, 31 W. R. 536.

(*p*) *Betts v. De Vitre*, 11 Jur. (N.S.) 9; affirmed, L. R. 3 Ch. 429, 442; 6 H. L. 319. See as to this *Att.-Gen. v. Vestry of Bermondsey*,

23 Ch. D. 60; *Mathias v. Yetts*, 46 L. T. 497.

(*q*) *Savage v. Harris*, 13 R. P. C. 364, 375.

(*r*) *Ward v. Key*, 10 Jur. 792.

(*s*) *Allen v. Horton*, 10 R. P. C. 412, 416.

In a trade mark case the plaintiff has been held entitled to a lien for his costs on the goods complained of (*t*). But this decision has since been questioned (*u*). Sect. 29 (6).

NOTE.

Lien for costs.

Where the prosecution of an action which fails is due to the mistake of the judge, or where the action is founded on the authority of decisions which are afterwards reversed, the action will be dismissed without costs (*x*). Action due to mistake of judge.

Where the plaintiff obtained an injunction on motion, and the bill was ultimately dismissed with costs for want of prosecution, the defendant was held to be entitled to the costs of the motion (*y*). Costs on dismissal for want of prosecution

So also where the motion for injunction was ordered to stand over till after the trial, and the plaintiff succeeded on the issue as to infringement, but failed as to the validity of the patent, the bill was ultimately dismissed with costs (*z*). Motion for injunction ordered to stand to trial.

Where the motion for injunction was ordered to stand to the hearing, and at the hearing a decree was made for a perpetual injunction, and the defendant was ordered to pay the costs of the suit, it was held that the costs of the motion were costs in the cause (*a*). So also when the motion had been refused on the ground of delay, and the costs had been reserved (*b*).

And when the action was dismissed with costs at the trial, it was held that the judgment carried with it the costs of a motion for injunction which stood over until the trial, and was not then brought on (*c*).

And the judges of the Chancery Division have now directed that where interlocutory applications have been ordered to stand to the trial and are not then mentioned to the judge, the costs of such applications are to be treated as costs in the action and taxed accordingly, and need not be mentioned in the judgment. And where interlocutory applications have been disposed of, but the costs have been reserved, such costs are not to be mentioned in the judgment or order, or allowed on taxation without the special direction of the judge (*d*).

(*t*) *Upmann v. Elkan*, L. R. 12 Eq. 140; affirmed, 7 Ch. 131; *Moet v. Pickering*, 6 Ch. D. 770.

(*u*) *Moet v. Pickering*, 8 Ch. D. 372.

(*x*) *Lister v. Leather*, 1 De G. & J. 361; 3 Jur. (N.S.) 849.

(*y*) *Stevens v. Keating*, 1 Mac. & G. 659.

(*z*) *Betts v. Clifford*, 1 J. & H. 74.

(*a*) *Mounsey v. Earl of Lonsdale*, L. R. 6 Ch. 141.

(*b*) *Thomson v. Batty*, 6 R. P. C. 84, 101.

(*c*) *Gosnell v. Bishop*, 38 Ch. D. 385.

(*d*) *British Natural Premium Provident Association v. Bywater*, [1897] 2 Ch. 531.

Sect. 29 (6). In the absence of a direction to the contrary the costs of an appeal include the costs of the shorthand writer's notes of the judgment (*e*).

NOTE.

Staying proceedings for costs pending appeal.

Application to stay proceedings for costs pending an appeal must be made in the first instance to the court below (*f*), and if not made at the moment of giving judgment should be supported by an affidavit showing special circumstances (*g*).

The general rule is that the applicant must pay the costs of an application to stay proceedings pending an appeal (*h*); but where on an application by defendant to stay pending an appeal the proceedings under an account ordered on the trial of an action for infringement of patent, the proceedings were stayed, but the appeal was advanced, the court, considering that the plaintiff had obtained a benefit by the order, directed the costs of the application to be costs in the appeal (*i*).

And see *post* under s. 30, p. 278.

Taxation of costs.

Costs for "luxuries" not allowed.

On taxation of costs as between party and party, the only costs chargeable are such as are necessary to enable the adverse party to conduct the litigation and no more. Any charges merely for conducting litigation more conveniently may be called luxuries, and must be paid by the party incurring them (*k*).

Therefore, in a suit to restrain infringement of a patent in which the plaintiff failed, the costs of drawings and sections explanatory of the exhibits to the defendant's affidavits, which were only required for the purpose of being affixed to the margin of copies of the evidence supplied to counsel, were disallowed, and this notwithstanding the plaintiff himself took advantage of, and asked for copies of, the drawings (*l*).

Scientific witnesses.

But proper remuneration to scientific witnesses will be allowed (*m*), and also the expense of preparing a model for the trial (*n*). The models, however, will not be ordered to be given to the party who fails in the action, though he is ordered to pay the costs of them (*o*). Such remuneration will include, in proper cases, fees to the scientific witnesses for qualifying themselves to give evidence (*p*), and fees,

(*e*) *Eland v. Medland*, 41 Ch. D. 493.

(*f*) *Otto v. Linford*, 18 Ch. D. 394; *Cropper v. Smith*, 24 Ch. D. 305.

(*g*) *Tuck v. Southern Counties Deposit Bank*, 42 Ch. D. 471.

(*h*) *Merry v. Nickalls*, L. R. 8 Ch. 205; *Cooper v. Cooper*, 2 Ch. D. 493.

(*i*) *Adair v. Young*, 11 Ch. D. 136.

(*k*) *Per* Sir R. MALINS, V.-C., *Smith v. Buller*, L. R. 19 Eq. 473.

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

(*m*) *Batley v. Kynock*, L. R. 20 Eq. 632.

(*n*) *Batley v. Kynock*, *ubi supra*; *Musgrave v. Hicks*, 3 R. P. C. 49, 54.

(*o*) *Horrocks v. Stubbs*, 3 R. P. C. 221, 246.

(*p*) *Thomson v. Moore*, 25 L. R. Ir. 98.

although very large, have been allowed for experiments made for the purpose of supporting the plaintiff's case at the trial and meeting the case made against the plaintiff at the trial (q). Sect. 29 (6).
NOTE.

But special fees to scientific witnesses of peculiar eminence have been disallowed, and the costs of their assistants have also been disallowed as part of such witnesses' fees (r).

The costs of reference by the court to an expert will be costs in the cause (s).

The costs of an inquiry as to damages or account of profits should be reserved, so that the judge may have control over them (t), and the rule is the same when the action is undefended (u). In *Shaw v. Jones* (x) when it was referred to the referee to take the account of profits, the court gave him jurisdiction over the costs of the reference. Costs of inquiries reserved

The rule at common law was not to give to a defendant costs of preparing for trial until after notice of trial had been given (y); and in *Curtis v. Platt* (z), where a defendant had obtained further time to plead upon terms that the action should be put down for trial, and that short notice of trial should be given, and the pleas were delivered, and the plaintiff then discontinued the action before issue joined or notice of trial given, it was held by the Court of Common Pleas that the defendant's costs incurred before notice of trial could not be allowed; and with reference to the defendant's contention that as notice of objections were delivered with the pleas, the expenses ought to be allowed as accessory to those objections, WILLES, J., after observing that he was not satisfied that these expenses were so connected, said:—"One instance has been given, the looking into specifications of patents of a similar character, but the validity of such a claim would depend on whether the defendant knew, when he delivered the objections, the particulars of the invention, or whether he was merely making speculative inquiries. I have strong doubts whether such expenses should be allowed at all." Costs of preparing for trial.

However, in *Batley v. Kynock* (a), where the plaintiff shortly before the hearing dismissed his bill with costs, and the taxing-master had

(q) *Leonhardt v. Kallé*, 12 R. P. C. 306.

(r) *Thomson v. Moore*, *ubi supra*.

(s) *Badische Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. 156, 176.

(t) *Slack v. Midland Rail. Co.*, 16 Ch. D. 81. See also *Cole v. Saqui*, 5 R. P. C. 489, 497; *Needham v. Oxley*, Seton, 4th ed. 353; *Hill v. Evans*, 4 D. F. J. 288, 309.

(u) *United Telephone Co. v. Fleming* (2), 3 R. P. C. 282; *Same v. Faulkner*, *ibid*.

(x) 6 R. P. C. 328.

(y) *Freeman v. Springham*, 14 C. B. (N.S.) 197.

(z) 10 Jur. (N.S.) 823; S. C. 33 L. J. (N.S.) C. P. 255.

(a) L. R. 20 Eq. 632.

Sect. 29 (6). allowed to the defendant the expenses of drawing particulars of objections (*b*) and settling same by counsel, on the ground that the defendant, by the course taken by the plaintiff dismissing his own bill, had no opportunity of applying for the certificate, Sir JAMES BACON, V.-C., refused to review the taxing-master's decision, and said that up to the moment when the plaintiff chose to dismiss his own bill the defendant was bound to be on the *qui vive*, and to be prepared with every sort of defence he could lawfully use. But his Lordship intimated that if complaint is made that the charge is unreasonable, or that the defences are too long, too numerous, or too manifestly untenable on the face of them, the taxing-master ought to take such a complaint into consideration.

NOTE.

Costs in consolidated actions.

It is said that at common law, where several actions are consolidated, all the defendants are liable to the plaintiff for the costs of the action that is tried, and that they stand together in the relation of joint defendants so as to be liable to contribution for these costs (*c*). But where a number of actions had been brought by different plaintiffs against the same defendant, and one action was selected as a test action to try all the questions, it was held that in the absence of agreement the plaintiff in the test action had no right to be indemnified against costs by the other plaintiffs (*d*).

Costs on the higher scale.

The fact that defendant submits to an injunction is not a "special ground" within S. C. R. Order LXV. r. 9, for allowing costs on the higher scale (*e*); and costs on the higher scale were refused where defendant did not appear at the trial, though plaintiff succeeded in the action (*f*). "Costs on the higher scale ought only to be given in cases of very unusual difficulty requiring skill, antiquarian research, and things of that kind" (*g*).

Where the case has involved long examination, preparation of models, and the calling of expert evidence, costs on the higher scale have been allowed to the plaintiff (*h*) or the defendant (*i*) succeeding in the action (*k*).

(*b*) The report speaks of particulars of breaches, but this is clearly a clerical error.

(*c*) Lush's Practice, 3rd. ed. 965.

(*d*) *Amos v. Chadwick*, 9 Ch. D. 459.

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

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

(*g*) See *per* LINDLEY, L.J., *Gadd v. Mayor, etc. of Manchester*, 9 R. P. C. 535.

(*h*) *Wenham v. May*, 4 R. P. C. 310; *Hopkinson v. St. James's, etc. Co.*, 10 R. P. C. 46, 62.

(*i*) *Ellington v. Clark*, 5 R. P. C. 319, 328.

(*k*) See also *Westinghouse v. L. & F. Rail. Co.*, 1 R. P. C. 98, 103; *Easterbrook v. G. W. Rail. Co.*, 2 R. P. C. 212; *Watling v. Stevens*, 3 R. P. C. 33, 43; *Otto v. Steel*, 3 R. P. C. 120; *Moseley v. Victoria Rubber Co.*, 4 R. P. C. 241, 251; *Kaye v. Chubb*, 4 R. P. C. 289.

And the Court of Appeal has given costs on the higher scale, [Sect. 29 (6). although the judge in the court below refused them, and the Court of Appeal gave no decision upon one of the points on which the plaintiff had succeeded in the court below (*l*).

NOTE.

Where, in an action under s. 32 of this Act, the validity of the patent was tried, costs on the higher scale were allowed (*m*).

In *Crampton v. The Patents Investment Co.* (*n*), costs on the higher scale were refused at the trial, but the question was reserved till after taxation with liberty to apply after taxation, if the party to whom the costs were given could show that he had suffered any injustice by the costs being taxed on the lower scale.

Costs on appeal against an interlocutory injunction were allowed on the lower scale only, though an important question was raised (*o*).

30. In an action for infringement of a patent, the Court or a Judge may on the application of either party make such order for an injunction inspection or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a Judge may see fit.

Order for inspection, etc., in action.

This is substantially a re-enactment of the corresponding section of the Act of 1852 (*p*); but that section, although said by Lord CAMPBELL to have been intended to vest in the Courts of Common Law the power as to these matters theretofore exclusively exercised by Courts of Equity (*q*), does not seem to have had the effect of enabling the plaintiff at common law to obtain such full relief, either by way of injunction (*r*) or inspection as he could have in equity (*s*). But now, by the Judicature Act, 1873, all the jurisdiction which could be exercised by all or any of the old Courts of Common Law and Chancery is transferred to the High Court of Justice, and by s. 25 (11) it is provided that in case of conflict between the rules of equity and the rules of common law the rules of equity shall prevail.

(*l*) *Ellington v. Clark*, 5 R. P. C. 319, 328.

(*m*) *Kurtz v. Spence*, 5 R. P. C. 161; *Ungar v. Sugg*, 6 R. P. C. 337.

(*n*) 5 R. P. C. 404.

(*o*) *Grafton v. Watson*, 51 L. T. (N.S.) 143.

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

(*q*) *Holland v. Fox*, 3 E. & B. 977; *S. C.* 1 Jur. (N.S.) 13.

(*r*) *Gittins v. Symes*, 15 C. B. 362.

(*s*) Compare *Patent Type Founding Co. v. Lloyd*, 5 H. & N. 192 (where the Court of Law refused to permit a portion of certain type alleged to have been made in infringement of a patent to be carried away for analysis) with *Patent Type Founding Co. v. Walter, Johnson*, 727, where Sir W. P. WOOD, V.-C. allowed this to be done. See also *Vidi v. Smith*, 3 E. & B. 969; *S. C.* 1 Jur. (N.S.) 15.

Sect 30.**NOTE.**

By s. 25 (8) of the same Act an injunction may be granted by an interlocutory order of the court in all cases in which it shall appear to the court to be just and convenient that such order should be made, and any such order may be made either unconditionally or on such terms and conditions as the court shall think just. And by S. C. R. 1883, Order L. r. 12, it is provided that in any cause or matter in which an injunction has been or might have been claimed, the plaintiff may, before or after judgment, apply for an injunction to restrain the defendant or respondent from the repetition or continuance of the wrongful act or breach of contract complained of, or from the commission of any injury or breach of contract of a like kind relating to the same property or right, or arising out of the same contract, and the court or a judge may grant the injunction either upon or without terms as may be just.

By Rule 3 of the same order the court or a judge is empowered, on the application of any party to a cause or matter, and upon such terms as may seem just, to make any order for the detention, preservation, or inspection of any property or thing being the subject of such cause or matter, or 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 seem necessary or expedient for the purpose of obtaining full information or evidence.

And by Rule 4 of the same order any judge by whom any cause or matter may be heard or tried with or without a jury, or before whom any cause or matter may be brought by way of appeal, may inspect any property or thing concerning which any question may arise therein. And by Rule 5 of the same order the provisions of Rule 3 mentioned above shall apply to inspection by a jury (*t*).

The result, therefore, is that each division of the High Court of Justice has now the fullest powers of making orders for injunction, inspection or account whenever it shall think proper so to do, and this jurisdiction can be exercised by any judge of the court (*u*). The powers conferred by this section and the rules cited above being given to "the court or a judge" may be exercised either on application in court or on summons at chambers (*x*), subject, however, to the provisions of Order LIV. r. 12, and Order LV. r. 15. No writ of injunction is to

(*i*) See also S. C. R. 1883, Ord. L. r. 6. 864; *Quartz Consolidated, etc. Co. v. Beall*, 20 Ch. D. 501.

(*u*) *Beddow v. Beddow*, 9 Ch. D. 89; *Thomas v. Williams*, 14 Ch. D. 138. (*x*) See *Frearson v. Loc*, 26 W. R. 138.

be issued. An injunction is to be by judgment or order, and any such judgment or order is to have the effect which a writ of injunction previously had (*y*).

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NOTE.

The words "impose such terms" are an addition to the corresponding section of the Act of 1852.

On an application for injunction the judge may make an order for an early trial without first going into the whole merits on affidavit or other evidence for the purposes of the application (*z*).

INJUNCTIONS (INTERLOCUTORY).

The rule as to granting interlocutory injunctions in patent actions is thus stated by Sir GEORGE JESSEL, M.R. :—

"The Court can grant an injunction before the hearing where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the court to say that as against the defendant himself there is no reason to doubt the validity of the patent" (*a*).

It will be convenient to consider these several cases in the order thus stated.

I.—Where the patent is old, and there has been long and undisturbed enjoyment.

On this point the rule is laid down by Lord ELDON in the following terms :—

"Where a patent has been granted, and an exclusive possession of some duration under it, the court will interpose its injunction without putting the party previously to establish 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 shown 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 dispute, act upon the presumed validity or invalidity of the patent, without the right having been ascertained by a previous trial (*b*).

Rule as to long enjoyment.

(*y*) S. C. R. Order L. r. 11. 707; *Stevens v. Keating*, 2 Webst. 177; *Harmer v. Plane*, 14 Ves. 130; (*z*) S. C. R. Order L. r. 1a. *Bichford v. Skewes*, 1 Webst. 211, 213; *Electric Telegraph Co. v. Nott*, 2 Coop. C. C. 41; *Wilson v. Tindal*, 1 Webst. P. C. 730; *Renard v. Levinstein*, 10 L. T. (N.S.) 94; (*a*) *Dudgeon v. Thomson*, 30 L. T. (N.S.) 244; S. C. 22 W. R. 464. *Davenport v. Jepson*, 4 D. F. J. 440. (*b*) *Hill v. Thompson*, 3 Mer. 622; S. C. 1 Webst. P. C. 229, 231. See also *Universities of Oxford and Cambridge v. Richardson*, 6 Ves.

Sect. 30.

NOTE.

Injunction,
Interlocutory.

The ground of this presumption in favour of the patent when there has been long enjoyment is that anybody might have proceeded by *scire facias* to repeal the patent, and yet for a length of time no one has done so (c).

Again, Lord COTTENHAM, C., said that in the case of patents "the rule steps in and says long and uninterrupted possession shall be *prima facie* evidence of title which ought to be respected. . . . *Prima facie* in that state of the case the court is not at liberty to exercise a discretion as to whether the patent be good or not" (d).

Comparative
inconvenience
not con-
sidered in
cases of long
enjoyment.

In these cases the court does not proceed on the ground of comparative inconvenience. In *Davenport v. Jepson* (e), TURNER, L.J., said: "If the case turned on the question of comparative injury, see what the position of the plaintiff would be if an injunction were refused. Supposing his patent is valid, a number of persons are infringing it. If the court refused an injunction in this case, it must refuse it in the case of each of the other infringers. Supposing the plaintiff to succeed at the hearing, the market will, in the meantime, have been flooded with articles wrongfully manufactured according to his patent." This also appears to have been the view of Lord ELDON in *Harmer v. Plane* (f), and of Lord COTTENHAM in *Stevens v. Keating* (g).

But enjoy-
ment must
have been
uninter-
rupted.

And there must also be clear evidence that the enjoyment by the patentee has been in fact uninterrupted and exclusive. When the evidence of this is not satisfactory, then, notwithstanding the patent may be of long standing, the interlocutory injunction will be refused till after the validity of the patent has been established (h). Thus, when a patent dated in 1825 was in 1838 assigned to the plaintiffs, who in that year filed a bill to restrain infringement and obtained an *ex parte* injunction against the defendant, but it was shown that for some years prior to the assignment the invention had been used by one of the plaintiffs without the licence of and adversely to the patentee, the injunction was dissolved (i).

And active
not passive

And the plaintiff must show not merely passive enjoyment of the patent, but an actual user of the invention. And therefore, where a patentee whose patent was ten years old applied for an injunction but did not produce any evidence of actual user except at a recent period,

(c) *Per* TURNER, L.J., *Davenport v. Jepson*, 4 D. F. J. 446; *Caldwell v. Vanvlissengen*, 9 H.L. 415, 424; *Electric Telegraph Co. v. Nott*, 2 Coop. Ch. Ca. 41.

(d) *Stevens v. Keating*, 2 Webst. 177.

(e) 4 D. F. J. 448.

(f) 14 Ves. 130.

(g) 2 Webst. 177.

(h) *Collard v. Allison*, 4 My. & Cr. 487.

(i) *Curtis v. Cutts*, 8 L. J. (N.S.) Ch. 184; 2 Coop. C. C. 60.

the application was refused (*k*). But the application for injunction is not defective merely because the plaintiff does not allege that his patent has never been disputed (*l*).

Where a patented invention was the subject of a prior substratum patent, and could not be used without the licence of the original patentee, it was held that the undisturbed enjoyment of the second patent only dated from the expiration of the substratum patent, and as on this view only one year's enjoyment could be shown, no injunction could be granted (*m*).

When the enjoyment of the patent has been long and uninterrupted the court will grant the interlocutory injunction, notwithstanding there may be doubts as to the validity of the patent (*n*). Thus, in *The Universities of Oxford and Cambridge v. Richardson* (*o*), Lord ELDON, C., said: "In the case of patent rights, if the party gets his patent and puts his invention in execution, and has proceeded to a sale, that may be called possession under it, however doubtful it may be whether the patent can be sustained, this court has lately said possession under colour of title is ground enough to enjoin, and to continue the injunction till it is proved at law that it is only colour and not real title."

And in *Losh v. Hague* (*p*) the injunction was granted although a prior specification was produced as an anticipation of the plaintiff's invention, which, on the face of it, seemed to be fatal to his patent (*q*).

So, also, in *Muntz v. Foster*, the patentee having had long possession and enjoyment of his patent, an injunction to restrain infringement was granted by Sir J. L. KNIGHT-BRUCE, V.-C. On appeal, objections to the specification were made, but Lord LYNTHURST, C., sustained the injunction, saying, "The patentee has been in the possession of his exclusive privilege for several years and the court will not, on any suggested defect of the specification, allow the enjoyment of that privilege to be disturbed until the title has been decided in a court of law" (*r*).

And in *Briggs v. Lardeur* (*s*), on an application for an injunction to restrain the infringement of a patent ten years old, where it was contended that the patent was, on the face of it, bad, PEARSON, J., said: "Whether this patent is a good patent or not I think I ought not to consider at

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*Injunction,
Interlocutory.*
Or dependent
on sub-
stratum
patent.

*Injunction
granted on
long enjoy-
ment, though
validity of
patent
doubtful.*

(*k*) *Plimpton v. Malcolmson*, L. R. 20 Eq. 38.

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

(*m*) *Heugh v. Magill*, W. N. 1877, 62.

(*n*) *Betts v. Menzies*, 3 Jur. (N.S.) 357, 359; *Dudgeon v. Thomson*, 30 L. T. (N.S.) 244.

(*o*) 6 Ves. 707. See also *Gardner v. Broadbent*, 2 Jur. (N.S.) 1041.

(*p*) 1 Webst. 201.

(*q*) See also *Beeston v. Ford*, 2 Coop. C. C. 58; *Bickford v. Skewes*, 1 Webst. P. C. 213.

(*r*) 2 Webst. 93, 95.

(*s*) 1 R. P. C. 129.

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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 I might consider it on interlocutory motion; but when the patent has been in existence 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 purposes 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 was ever taken out" (t).

Statements in an affidavit as to the invalidity of the patent, which are founded on mere information and belief, are not sufficient to prevent the grant of an injunction (u).

What length
of enjoyment
sufficient for
injunction

The following cases may be consulted as to the time of undisputed possession of a patent on which the court will grant an injunction before the patent has been established:—

In *Harmer v. Plane* (x) and *Read v. Andrew* (y), the patentee had had thirteen years' enjoyment; in *Neilson v. Thompson* (z), twelve years; in *Stevens v. Keating* (a), of one patent, thirteen years, of another, seven years; in *Wilson v. Tindal* (b), eleven years; in *Briggs v. Lardeur* (c) and *Shillito v. Larmuth* (d), ten years; in *Davenport v. Richards* (e), nine years; in *Betts v. Menzies* (f), eight years; in *Losh v. Hague* (g), and *Osmond v. Hirst* (h), seven years; and in *Bickford v. Skewes* (i), and *Rothwell v. King* (k), six years. (In *Neilson v. Thompson*, *Stevens v. Keating*, *Betts v. Menzies*, and *Briggs v. Lardeur* (l), the injunctions were ultimately dissolved, but not on any ground affecting the question of long enjoyment.)

In *Renard v. Levinstein* (m), Lord Hatherley, then Vice-Chancellor, said that if the patent had been six or seven years old, and up to that time undisputed, the *prima facie* right to an injunction would have been clear.

Where the invention related to a subject-matter in which inventors were very much on the alert, and in which several patents had been taken out, it was held by the same learned judge that the fact that the

(t) See also *Shillito v. Larmuth*, 2 R. P. C. 1.

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

(x) 14 Ves. 130.

(y) 2 R. P. C. 119.

(z) 1 Webst. 279.

(a) 2 Webst. 176.

(b) 1 Webst. 730.

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

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

(e) 3 L. T. (N.S.) 503.

(f) 3 Jur. (N.S.) 357. See also L. R. 3 Eq. p. 312.

(g) 1 Webst. 200.

(h) 2 R. P. C. 265.

(i) 1 Webst. 211, 213.

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

(l) 1 R. P. C. 192.

(m) 10 L. T. (N.S.) 94.

articles had been sold under the patent for three years at large profits to the patentee without any invasion of his patent, was sufficient to warrant the grant of an injunction on a patent rather more than three years old (n).

On the other hand, in *Hill v. Thompson*, the patent was dated July 1814, the bill was filed in 1817, but the plaintiff's works were not complete so as to enable him to carry on operations under the patent till July, 1816. Under these circumstances Lord ELDON dissolved an injunction which had been obtained (o).

And in *Renard v. Levenstein* (p), where the patent was only two years old at the time of the filing of the bill, and its validity had not been established in any proceeding, the Lords Justices refused to continue an injunction which had been granted by the Vice-Chancellor, notwithstanding the facts that the defendant had filed no affidavits in opposition to the original motion, and had since put in his answer and allowed three months to elapse before applying to dissolve the injunction, and although four infringers had submitted to the plaintiff's demands, one of whom had bought the articles complained of from the defendant's own agent (q). The defendant having suggested various defects in the plaintiff's specification, KNIGHT-BRUCE, L.J., said, after referring to the recent date of the letters patent: "There cannot have been any considerable length of enjoyment under them, and the defendant in such a case at least is entitled, I apprehend, to the benefit of any reasonable doubt and reasonable difficulty which he can show to exist as to the sufficiency and validity of the specification." And after referring to the suggested objections, his lordship continued: "It is only for the present purpose, the age of the patent considered, necessary to say, as far as I am concerned, that in my judgment, at least, the point is one of doubt and difficulty."

The circumstance that the court itself now tries the whole case without, as was the old practice of the Court of Chancery, directing an action to be tried at law, ought not, where there has been long and quiet enjoyment of the patent, to have any weight on the question whether or not an interlocutory injunction shall be granted (r).

Where the patent is recent the court will not interfere by interlocutory injunction, when there is a substantial question to be tried as to the validity of the patent. In such a case the proper course is, upon the

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(n) *Wheatstone v. Wilde*, Griffin, P. C. 247.

(o) 3 Mer. 622; 1 Webst. 232. See also *Plimpton v. Malcolmson*, L. R. 20 Eq. 37.

(p) 10 L. T. (N.S.) 177.

(q) These facts appear from the report before the V.-C., 10 L. T. (N.S.) 94.

(r) See *per* TURNER, L.J., *Davenport v. Jepson*, 4 D. F. & J. 447.

Sect. 30. defendant undertaking to keep an account, not to make any order on the plaintiff's motion (s).

NOTE. The above rule applies to patents under the Act of 1852; but in *Jackson v. Needle* (t), the Court of Appeal expressly refrained from giving any opinion as to what would be the proper course in any case arising under the present Act—"The question will be thereunder whether the investigation and protection which is given to the public under sections 10 and 11 may alter the rule which hitherto has existed, where a patentee of a patent of a recent date comes for an interim injunction."

But if the defendant does not appear, an injunction may be granted, even in the case of a new patent, on a proper affidavit being produced of its validity (u).

And where the patent was recent, but the infringement was not denied, and the only objection to the patent was that the specification was defective, which objection was founded on the circumstance that the plaintiff had given to a licensee certain instructions not embodied in the specification, and it was shown that a competent workman with no other assistance than the specification could work the invention, an interlocutory injunction was granted (x).

In *Tadman v. Owens* (y), where the court considered that the invention was not subject-matter for a patent, the injunction was refused with costs.

II.—Where the validity of the patent has been established elsewhere, and the court sees no reason to doubt the propriety of the result.

Patent established in one action injunction granted in action against new infringer.

In some of the earlier cases, as, for instance, in *Crosskill v. Tuxford* (z), *Crosskill v. Ivory* (a), it seems to have been considered that, notwithstanding previous suits establishing the patent against other persons, an interlocutory injunction could not be granted against a new infringer until after the patent had been established against him. This view, however, is inconsistent with the later cases, which lay down the rule that while the defendant in such a case may dispute the patent at the trial, the validity of the patent will be considered so far established by the previous suits as to warrant the Court in granting an interlocutory injunction (b).

(s) *Jackson v. Needle*, 1 R. P. C. 174, 177; *Lister v. Norton*, 1 R. P. C. 114; *Holophane, Ltd. v. Berend*, 15 R. P. C. 18. See also *Caldwell v. Van Vlissingen*, 9 Haro, 424, TURNER, L.J.

(t) 1 R. P. C. 177, judgment of COTTON, L.J.

(u) *Clarke v. Nichols*, 12 R. P. C. 310.

(x) *Coles v. Baylis*, 3 R. P. C. 178.

(y) 11 R. P. C. 349.

(z) 5 L. T. 342.

(a) 10 L. T. 459.

(b) *Newall v. Wilson*, 2 D. M. & G. 282; *Davenport v. Jepson*, 4 D. F. & J. 440; *Davenport v. Goldberg*, 2 H. & M. 282; *Bovill v. Smith*, W. N. 1867, 240; *Dudgeon*

The distinction is that, where the validity of the patent has not been made the subject of legal proceedings, then the patentee must prove its validity before a jury before the court will protect him ; but having once established its validity, then the court will protect him against any other person until that person proves its invalidity (c).

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In such a case the interlocutory injunction will be granted, although a fresh fact may be now brought forward tending to impeach the novelty of the invention (d). Even though new facts alleged against patent.

L. *Renard v. Levinstein* (e) it was held that the injunction ought to be granted notwithstanding the defendant offered to keep an account. In this case, it is true, the issues as to the validity of the patent which had been directed in the suit had been found in favour of the plaintiff, but there seems to be no reason why the rule should not apply in cases where credit for the purposes of the interlocutory injunction is given to the patent by reason of its having been established in previous suits against other persons.

An allegation as to the defendant's inability to be answerable in damages is not irrelevant upon a motion for injunction to restrain infringement (f).

And where a patentee had brought an action against a defendant, and on the trial an arbitration was agreed to, on which the arbitrator found in favour of the validity of a patent, the court, upon a subsequent infringement by the same defendant, considered the validity of the patent as sufficiently established by the award, and granted an interlocutory injunction (g).

And the fact of an interdict having been granted by the Court of Session in Scotland against the defendant, restraining him from infringing the patent, is sufficient *prima facie* evidence of its validity to warrant the grant of an interlocutory injunction by an English Court (h).

Under the old practice in Chancery, where an interlocutory injunction had been originally refused, or, having been granted, had been dissolved on the terms that the plaintiff should bring an action to try the validity of his patent, it was almost a matter of course, if the action resulted in judgment for the plaintiff, that the injunction should be Issues found in plaintiff's favour, injunction granted.

v. *Thomson*, 30 L. T. (N.S.) 244.
Farbenfabriken v. Dawson, 8 R. P. C. 397.

(c) Per Lord ROMILLY, M. R.,
Borill v. Goodier (2), L. R. 2 Eq. 200.

(d) *Newall v. Wilson*, 2 D. M. & G. 282; *Pneumatic Tyre Co. v. Marwood*, 13 R. P. C. 347.

(e) 2 H. & M. 628, 634.

(f) *Newall v. Wilson*, 2 D. M. & G. 282.

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

(h) *Dudgeon v. Thomson*, 30 L. T. (N.S.) 244.

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allowed (i) ; and this course has been followed in the practice under Sir John Rolt's Act and Lord Cairns' Act ; and where the usual issues in a patent suit had been tried by the court itself under those Acts, and the verdict had been in favour of the plaintiff, the latter was at once entitled to the interlocutory injunction, and this although the defendant volunteered to keep an account (k).

And where the plaintiff, having been directed to bring an action, had obtained a verdict upon a case stated, but the Court of Common Law was equally divided upon the question of the validity of the patent, Lord ROSSLYN, C., would not dissolve an injunction previously granted, but directed the patentee to bring a fresh action, and declined to impose terms on the plaintiff as to the Court in which the action should be brought (l).

But not if
proceedings
for new trial
pending.

But where after verdict in favour of the plaintiff the defendant had obtained a rule *nisi* for a new trial (m), or had stated his intention to move for a new trial (n), or tendered a bill of exceptions (o), the motion for an interlocutory injunction was ordered to stand over till the result of the application to the Court of Common Law should be known.

And where an injunction which had been obtained by a plaintiff pending the trial of an action at law was continued by the Vice-Chancellor, notwithstanding the first decision of the Court of Law against the validity of the patent, it was dissolved upon such first decision being affirmed by the Court of Exchequer Chamber (p).

The rule, however, was not invariable, and in *Bridson v. Benecke* (q) it was held that the Court would act according to the circumstances of each particular case.

After patent
established
injunction
granted on
prima facie
evidence of
infringement.

Where the validity of the patent has been established in another action, an injunction against a fresh infringer may be granted, if the Court, on the evidence before it, sees a *prima facie* case of infringement, even though it reserves to itself the right to decide finally on the infringement at the trial (r). And if the infringement is clear the injunction may be granted with costs (s).

(i) *Neilson v. Harford*, 1 Webst. P. C. 373 ; *Russell v. Cowley*, 1 Webst. P. C. 471.

(k) *Renard v. Lovenstein*, 2 H. & M. 628.

(l) *Boulton v. Bull*, 3 Ves. 140.

(m) *Collard v. Allison*, 4 My. & Cr. 487, 490.

(n) *Hill v. Thompson*, 3 Mer. 631 ; S. C. 1 Webst. P. C. 235, 238.

(o) *Bridson v. McAlpine*, 8 Bea. 229.

(p) *Betts v. Menzies*, cited by Sir W. P. WOOD, V.-C., in *Penn v. Bibby*, L. R. 3 Eq. 308, 312.

(q) 12 Bea. 1.

(r) *Thorn v. Worthing Skating Rink Co.*, 6 Ch. D. 415 n. ; *Plimpton v. Spiller*, 4 Ch. D. 286, 289 ; *Moser v. Sewell*, 10 R. P. C. 365 ; *Edison-Bell Phonograph Co. v. London Phonograph Co.*, 11 R. P. C. 193.

(s) *Hayward v. The Pavement Light Co.*, 1 R. P. C. 207.

And where a defendant in the previous action in which the certificate was granted had contested the patent up to trial, and had not appeared at the trial, and the defendant in a second action had taken a similar course, and submitted at the trial, an interlocutory injunction was granted in a third action (t).

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Although an interlocutory injunction will, at the suit of a patentee who has established his patent against previous infringers, be granted against a new defendant, the latter is nevertheless not bound at the trial by the previous decisions to which he has been no party, and he is not to be driven to contest the validity of the patent by proceedings for its revocation (u).

But new defendant not bound by proceedings in former action.

But if, in such a case, the Court is satisfied of the sufficiency of the specification, the utility of the invention, and the fact of infringement, although it may grant an issue as to the novelty of the invention, it will grant an injunction restraining infringement, reserving the further hearing of the cause till after the trial of the issue (r).

But injunction may be granted and issue as to novelty directed.

III.—*Where the conduct of the defendant is such as to enable the Court to say that as against him there is no reason to doubt the validity of the patent.*

Thus, where a licence is granted by deed, and the deed contains a recital necessarily implying the validity of the letters patent, the licensee is thereby estopped from disputing the patent (y). And where the deed merely recited the grant of letters patent, it was held that a plea by an exclusive licensee in an action for royalties that the invention was of no utility and not new could not be sustained, no fraud being alleged, first, because the contract being by deed the failure of consideration was immaterial; and secondly, because it is not competent to a defendant by plea to deny the effect of a deed which he has executed (z).

Licensee cannot dispute patent.

And apart from any question of estoppel by deed, a licensee, during the continuance of the licence, and whilst he is using the patented invention, will not be allowed to dispute the validity of the letters patent (a).

(t) *Edison Bell Phonograph Co. v. Bernstein*, 14 R. P. C. 153.

(u) *Borill v. Goodier* (2), L. R. 2 Eq. 195. See also *Shaw v. Day*, 11 R. P. C. 185; *Russell v. Burnsley*, 1 Webst. 472; S. C. 2 Coop. C. C. 58. See, however, *Davenport v. Goldberg*, 2 H. & M. 286.

(r) *Borill v. Goodier*, *ubi supra*.

(y) *Bowman v. Taylor*, 2 S. & E.

278; 1 Webst. 292. See also *Cutler v. Bower*, 11 Q. B. 973.

(z) *Smith v. Scott*, 6 C. B. (S.S.) 771; 5 Jur. (S.S.) 1358. See also *Hall v. Couder*, 2 C. B. (S.S.) 22.

(a) *Clark v. Adie* (No. 2), 2 App. Cas. 423; *Charouse v. Sterenz*, W. N. 1874, p. 193; *Besseman v. Wright*, 6 W. R. 719; *Couchman v. Greener*, 1 R. P. C. 197.

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Thus, in *Lauges v. Purser* (b), there was an agreement by the defendants to pay a royalty of 10*d.* per ton in respect of a certain substance manufactured according to the patented invention. The defendants used the invention, and on action by the patentee for the royalty pleaded that the letters patent were void. The plea was overruled, and Lord CAMPBELL, C.J., said :—“There having been such an agreement, as stated in the declaration, and permission to use the invention having been enjoyed under it, can it be permitted to the defendants, after such a contract and such acquiescence on their part of the plaintiff’s claim, and such enjoyment by them of the invention, to say that they will not pay the stipulated price because the patent is void ?” And it was held that the defendants, not denying that they had so used the invention, could not set up this defence.

So, also, in *Noton v. Brooks* (c), a similar defence under similar circumstances was overruled, Sir F. POLLOCK, C.B., saying :—“The defendant agrees to pay the plaintiffs a royalty if they will allow him to use their patent invention, and he does use it ; then how can he turn round and say that it is worthless ?”

Even where
licence is
verbal only.

And even when the agreement was only verbal, but the defendant used the invention, and afterwards in a suit for the royalties denied the validity of the patent, it was held by Sir W. P. WOOD, V.-C., and afterwards by the House of Lords, that this defence was not open to him. Lord WESTBURY, C., said :—“It is an idle distinction that it is attempted to be set up by the respondent that he made an agreement and did not take a licence ;” and Lord CHELMSFORD said :—“The question is not whether the defendant is at liberty to dispute the right of the plaintiffs to their patent inventions, but whether, being under an agreement to pay royalties for goods manufactured by the plaintiff’s looms, and any other looms embodying their inventions, he is, while that agreement is subsisting, at liberty to use those inventions and to refuse to pay the royalties. I apprehend that he cannot do so. He cannot act under the agreement and at the same time repudiate it. He may, if he pleases, put an end to the agreement, and he may use the machines which he has purchased from the plaintiffs, but he must do so at his peril ; he must do so under the liability to be treated as an infringer, and to be subject to an action for damages for that infringement (d).

And where, in an action by patentees against licensees for an account and injunction against using the invention except on the terms of the licence, the defendants pleaded that if the specification was construed

(b) 6 E. & B. 930.
(c) 7 H. & N. 499.

(d) *Crossley v. Dixon*, 10 H. L. C. 293, 308, 310 ; *Clark v. Adie* (No. 2). 2 App. Cas. 423.

so as to include the process used by them, the patent would be invalid, the plea was struck out as embarrassing (*e*).

And in the same case where certain of the defendants pleaded that they were not bound by the licence, and that if it existed it had been cancelled, and also pleaded invalidity of the patent, the plea of invalidity was struck out.

And the above rules will apply as between the plaintiff and the defendant, his licensee, even though the patent has subsequently to the commencement of the action been, in another proceeding against a third person, declared invalid (*f*), or has been revoked (*g*).

And where a licensee had under an agreement which recited the patent, used the invention and paid royalties, and it having turned out that the patent was void, brought an action to recover from the patentee the amount so paid, it was held that the action must fail; and HEATH, J., said:—"There never has been a case, and there never will be, in which the plaintiff, having received benefit from a thing which has afterwards been recovered from him, has been allowed to maintain an action for the consideration originally paid" (*h*).

But where the defendant had agreed to pay an annuity of 400*l.* a year as the consideration for the exclusive use of certain patented inventions, but in fact never used them, it was held, in an action for payment of the annuity, that he could plead the invalidity of one of the patents as a defence to the action. The consideration was entire, and the payment to be made by the defendant was entire. The consideration, by failing partially, failed entirely (*i*).

And in *Hayne v. Maltby* (*k*), where there was in an agreement a recital that the plaintiffs were assignees of a patent, and that the defendant had applied to the plaintiffs for permission to use the invention, to which they assented, on condition of his working it in the manner described in the specification, and the defendant covenanted not to use any machines except one allowed to him by the agreement, and an action was brought on the agreement alleging two breaches of covenant, one for using patent machines other than that by the agreement allowed, and the other for using machines resembling the patent

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And the rule applies though patent declared bad in action against third party.

Nor can licensee recover from patentee because patent bad

(*e*) *Ashworth v. Law*, 7 R. P. C. 231.

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

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

(*h*) *Taylor v. Hare*, 1 B. & P. N. R. 260; 1 Webst. P. C. 292. See also

Collinge v. Bowman, 1 Webst. P. C. 295.

(*i*) *Chanter v. Leese*, 4 M. & W. 295; 5 M. & W. 698; 1 Webst. P. C. 295. See observations of CROMPTON, J., on this case in *Besseman v. Wright*, 6 W. R. 719.

(*k*) 3 T. R. 438; 1 Webst. P. C. 291.

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machines, it was held that the defendant was not estopped from pleading the invalidity of the patent. Upon this case it was observed by PATTESON, J., in *Bowman v. Taylor* (l), that the recital contained no assertion of right in the plaintiffs, except as assignees, and that the case was not properly one of estoppel; and by Lord COTTENHAM, C., in *Neilson v. Fothergill* (m), that the case of *Hayne v. Maltby* merely amounted to this, that although a party has dealt with a patentee, and has carried on business, yet that he may stop, and then the party who claims to be patentee cannot recover without giving the other party an opportunity of disputing his right, and that if the defendant successfully dispute his right, notwithstanding he has been dealing under a contract, it is competent to the defendant to do so.

The defendant is not estopped from disputing the patent if the only working has been under an agreement which has been entered into subject to an inquiry as to the validity of the patent, and such inquiry has not been unreasonably delayed (n).

Where the plaintiff brought an action for infringement, and the defendant claimed under an equitable agreement for a licence, which the plaintiff alleged was revoked, it was held that the defendant could not dispute the validity of the patent, and at the same time insist on his rights under the licence (o).

And where in a licence there was a covenant by a patentee that he would take proceedings against infringers, and that if the patent should become void or ineffectual by reason of his omission to do so, or by reason of the invention not being novel, or being an infringement of other letters patent, the payment of the annual sum covenanted to be paid by the licensees should cease, and the patentee, having let the patent lapse by non-payment of renewal fees, sued for the payment of the annual sum, it was held that the licensees could not plead want of novelty (p).

Inasmuch as a petition for revocation, by whomsoever presented, is a petition on behalf of the public, and is not personal to the petitioner (q), it would seem that a licensee may present a petition for revocation (r).

But licensee
may dispute
the patent
when licence
determined.

After the determination of a licence the licensee may dispute the validity of the patent as against his licensor (s).

(l) 2 Ad. & E. 278; 1 Webst. 294.

(m) 1 Webst. P. C. 290.

(n) *Wilson v. Union Oil Mills Co.*, 9 R. P. C. 57.

(o) *Postcard Automatic Supply Co. v. Samuel*, 6 R. P. C. 560.

(p) *Mills v. Carson*, 10 R. P. C. 9.

(q) *Deeley's Patent*, [1895] 1 Ch. 687; 12 R. P. C. 192, 199. See also

Shoe Machinery Co. v. Cutlan, 12 R. P. C. 530.

(r) See also *Martin's Patent*, Griffin, P. C. 320.

(s) *Dangerfield v. Jones*, 13 L. T. (N.S.) 142; *Armann v. Lund*, L. R. 18 Eq. 330; *Crossley v. Dixon*, 10 H. L. C. 293.

And equitable assignees of an exclusive licence, who, having used the invention, disclaimed any further use of it, were, in an action brought to restrain them from selling the patented article otherwise than in conformity with the covenants of the licence, held to be not estopped from disputing the validity of the patent (t).

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And it is open to a licensee to show that his licensor's right has expired, and therefore, where there was an agreement to pay royalties while certain English and foreign patents belonging to the licensors should last, the licensees were allowed to show that one of the patents, an American patent, had expired by reason of the prior expiry of an English patent for the same invention (u).

A licensee, however, is entitled to have it ascertained what is the ambit, what is the field, which is covered by the specification of the patent (x).

Licensee entitled to have ambit of licence determined.

If a tool used by a licensee, without payment of royalty, is found to be included in the patent, he may be restrained from using it, except in accordance with the licence, and upon such a question the conduct of the parties may be taken into consideration (y).

In an action for misrepresentation in a company prospectus, which had stated that a patent was valuable, evidence to show that the invention had been anticipated, and that the patent was therefore invalid, was held inadmissible (z).

A defendant, though not a licensee, may, by his acts, be prevented from disputing the patent on an application for interlocutory injunction.

Others besides licensee may be estopped from disputing patent.

Thus, where the patentee had at one time worked his invention in partnership with the defendants under an agreement reciting the patent, and during the subsistence of the partnership the defendants had joined the patentee as co-plaintiffs in suits against various infringers, it was held by KNIGHT-BRUCE, V.-C., that the partnership having been determined, and the defendants having commenced working the invention without the leave of the patentee, the latter was entitled to an interlocutory injunction against them before establishing his patent at law (a).

(t) *Pidding v. Franks*, 1 Mac. & G. 56.

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

(x) *Per Lord CAIRNS, L.C., Clark v. Adie* (No. 2), 2 App. Cas. 426. As to how far prior specifications may be looked at for the purpose of

construing the plaintiff's specification, see *ante*, p. 19.

(y) *Useful Patents Co. v. Rylands*, 2 R. P. C. 255.

(z) *Stavert v. Passburg Grains Syndicate*, 8 R. P. C. 400.

(a) *Muntz v. Grenfell*, 2 Webst. P. C. 88, 91.

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Interlocutory.*

And where defendants had agreed with the owner of a patent for a canopy for fire grates that they should be at liberty, on certain terms, to make and sell grates having the patent canopy, which they were to mark in a particular manner with the name of the patentee, and an action being brought to enforce this agreement, the defendants undertook not to sell any grates having the patent canopy without marking them in the manner agreed, it was held, on a motion to commit them for a breach of this undertaking, which motion was, by consent, turned into a motion for injunction, that the defendants could not now allege that they had lately discovered that the canopies they were making were the same as those which had been sold under a patent of prior date to the plaintiff's patent, and that the plaintiff's patent was therefore invalid (b).

Patentee
cannot after
assignment
dispute
patent.

No one can derogate from his own grant. And, therefore, where a patentee had worked his patent in partnership with the plaintiffs, and the partnership was dissolved, and the patentee assigned to the plaintiffs all his interest in the patent, it was held that he could not set up the invalidity of the patent in a suit by the plaintiffs to restrain infringement by him, and an interlocutory injunction was granted (c).

So also a patentee, who had assigned his patent, was not allowed to dispute its validity in an action brought against him by the assignee for infringement (d).

But it does not follow that a person who has assigned a patent can be restrained from mentioning to another person matters which may show that the invention was not a new invention (e), or from assisting as a scientific witness or otherwise persons against whom actions are brought for infringing the patent (f). And such a person may show that the specification does not cover what it is alleged by the plaintiff to cover. And, notwithstanding the principle that a grantor cannot defeat his own grant, the language of the specification cannot be forced from its true construction, even if the result is to show that what was granted was valueless (g).

Where the plaintiff, a patentee, immediately after the grant of his patent, and before filing his specification, employed the defendants to manufacture for him, and in course of such manufacture their servants discovered, as he alleged, an improvement which the defendants requested the plaintiff to introduce into his specification,

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

(c) *Chambers v. Crichley*, 33 Bea. 374.

(d) *Oldham v. Langmead*, cited 3 T. R. 439; *Walton v. Lavater*, 8 C. B. (N.S.) 162, 187

(e) *London and Leicester Hosiery Co. v. Griswold*, 3 R. P. C. 251, 253.

(f) *London and Leicester Hosiery Co. v. Griswold*, *ubi supra*.

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

and to allow them, in consideration of the improvement, a share of the profits of the patent, and on the plaintiff's refusal the defendants commenced working the plaintiff's invention, an application that the plaintiff might be ordered to try the validity of the patent at law was refused, and the injunction was granted; Sir J. STUART, V.-C., observing that it was not a mere matter of course because a patent was recent to call upon the patentee to establish his right at law before granting him the relief of an injunction, but it was in the discretion of the court according to the nature of the case, and that what had mainly or altogether led to the validity of the plaintiff's patent being disputed was his refusal of the proposition made by the defendants for amalgamation (*h*).

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NOTE.

*Injunction,
Interlocutory*

In *Cropper v. Smith* (*i*), it was held that a patentee who has become bankrupt is not estopped from disputing, on the ground of want of novelty, the validity of the patent as against a purchaser from his trustee in bankruptcy. In this case the purchasers were not shown to have relied in any way on the statements as to novelty made by the patentee in his petition for patent. If that had been shown the patentee might have been estopped from alleging want of novelty (*k*).

Where
patentee not
estopped
from disput-
ing patent.

A patentee is not estopped from disputing the validity of his patent either by matter of record, on the ground that the letters patent were of record, or by deed, by reason of the specification being under his seal (*l*).

Where the defendant, a foreign manufacturer, had, in a previous action brought against his agent, declined to assist in the defence, and the agent had submitted to an injunction, and the plaintiff had had eight years' undisturbed enjoyment, an injunction was granted until the validity of the patent could be established (*m*).

Defendant
not disputing
patent in
earlier pro-
ceedings.

And a defendant, who in an action for infringement submitted to a perpetual injunction, was not allowed, on a motion to commit for breach of the injunction founded on a sale by the defendant of an instrument different from that which was in question in the action, to dispute the validity of the patent, or the fact that the instrument sued on in the action was an infringement (*n*).

And a defendant who, having been sued in Scotland in an action which was decided in favour of the validity of the patent, had not

(*h*) *Clark v. Ferguson*, 1 Giff. 184.
See also *Gardner v. Broadbent*, 2
Jur. (N.S.) 1041.

(*i*) 26 Ch. D. 700; affirmed on
this point, 10 App. Cas. 249.

(*k*) See judgment of COTTON, L.J.,
26 Ch. D. 706.

(*l*) *Cropper v. Smith*, *ubi supra*.

(*m*) *Betts v. Menzies*, 3 Jur. (N.S.)
357.

(*n*) *Thomson v. Moore*, 6 R. P. C.
426; 23 L. R. Ir. 599; 7 R. P. C.
325 (H.L.).

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NOTE.

*Injunction,
Interlocutory,
Res judicata.*

raised in that action the defence of want of novelty of the invention, was not allowed to set up this defence in answer to an application in England for an interlocutory injunction to restrain the infringement of the same patent (o).

And where, in an action for infringement, the judge had found that the patent was valid, but that the defendants had not infringed, it was held in a subsequent action by the same plaintiffs against the same defendants that the validity of the patent was *res judicata*, and that the defendants could not dispute the patent even though they had new evidence against the patent which they did not know of in the first action (p).

And where, in an action for infringement, the patentee agreed to accept the decision of the judge on the question of disconformity between the provisional and final specification, and the action was dismissed on this ground, and also on the ground of want of novelty in the invention, and the patentee subsequently amended his specification so as to get rid of the last objection, but not further, it was held in a subsequent action against the same defendant on the amended specification that the plaintiff had agreed that the decision on the question of disconformity should be final, and the action was dismissed (q). And in the same case the court declined to express an opinion whether if there had been no undertaking the patent was after amendment to be considered as a new patent, so as to enable the plaintiff to raise again the question of disconformity decided against him in the first action (r).

But where proceedings in Chancery had been taken against a defendant in the course of which the validity of the patent was questioned, and the matter being referred to arbitration, the arbitrator found that the patent was not void or invalid, it was held that, in an action at law between the same parties to recover damages for infringement, the defendant was not estopped from disputing the validity of the patent (s).

And in *Axmann v. Lund* (t), where two persons had in partnership worked for their common benefit a patent belonging to one of them, and had together asserted its validity as against infringers, but having been advised that the specification was bad had refrained from taking legal proceedings, it was held by Sir R. MALINS, V.-C., that after the determination of the partnership the other partner was at liberty to dispute the validity of the patent (u).

(o) *Dudgeon v. Thomson*, 30 L. T. (N.S.) 244.

(p) *Shoe Machinery Co. v. Cutlan* (No. 2), 13 R. P. C. 141; [1896] 1 Ch. 667.

(q) *Horrocks v. Stubbs*, 13 R. P. C. 69.

(r) 13 R. P. C. 73.

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

(t) L. R. 18 Eq. 330.

(u) These circumstances appear to distinguish this case from *Muntz v. Grenfell*, *ante*, p. 259, which does not appear to have been cited in *Axmann v. Lund*.

Although one of several partners may be debarred by his acts from disputing the patent, there is no estoppel against the other partners who have not been concerned in such acts, and therefore, where a plaintiff sued two partners for infringement of a patent which had been granted to one partner, and by him assigned to the plaintiff, it was held that, although one partner was estopped, the other partner was at liberty to dispute the validity of the patent (x).

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NOTE.

*Injunction,
Interlocutory.*

A defendant may, by his conduct, be estopped from disputing the validity of the patent on an application for an interlocutory injunction where he is not so estopped at the trial. Thus, when the defendants had submitted to an action for infringement, and given judgment and paid costs, it was held by Sir W. P. Wood, V.-C., on the hearing of a suit against the same defendants for infringing the same patent, that if the present had been an interlocutory application, plaintiffs would have been entitled to an injunction till the hearing, but that the question being as to a perpetual injunction, the right of the defendants to deny the validity of the patent was not barred (y).

Defendant may be estopped on application for interlocutory injunction, though not at the trial.

Where a defendant proves non-infringement there is nothing in the nature of estoppel to prevent the court finding in his favour, because at some time he had stated that he had infringed (z).

The rules above stated only apply where the sole question between the parties is the validity of the patent (a). If there is a real doubt as to whether the patent has been infringed, the interlocutory injunction will be refused.

When real doubt as to infringement, injunction refused.

Thus, where the plaintiffs sued upon certain patents, of one of which there had been ten, and of the others seven and five years' enjoyment, Lord COTTENHAM, C., refused the injunction entirely on the ground of uncertainty as to the infringement, and, referring to the evidence on this point, which was very conflicting, said: "It would be rash in me if I were to give any opinion coming to a conclusion contrary to what is sworn by the most eminent scientific persons in this country. If, in a question so open to doubt as this, I should interfere with the defendant, I should be setting up my own judgment in opposition to those who, being practically acquainted with matters of this description, have deposed that, according to all rules and principles, the subject-matter of the defendant's patent may be perfectly new and unconnected

(x) *Heugh v. Chamberlain*, 25 W. R. 742. See also *Goucher v. Clayton*, 11 Jur. (N.S.) 107.

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

(z) *Osborne v. Board*, 13 R. P. C. 740, 749.

(a) *Electric Telegraph Co. v. Nott*, 11 Jur. 157; *S.C.* 2 Coop. C. C. 41; *Neilson v. Thompson*, 1 Webst. P. C. 277; *Stevens v. Keating*, 2 Webst. P. C. 179.

Sect 30. with anything claimed by the plaintiffs. I may not be satisfied that these gentlemen are right, or that the plaintiffs are wrong, but I am satisfied that the case is not one so free from doubt as to justify me in interfering" (b).

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*Injunction,
Interlocutory.*

So where, on a patent six years old, an *ex parte* injunction had been obtained, and, on a motion to dissolve, the question of infringement was the only question raised, Sir L. SHADWELL, V.-C., dissolved the injunction, and, after pointing out that the alteration made by the defendants was not merely colourable, but *prima facie* a decided improvement, said that that was the proper question for a jury to consider (c). And in *Muntz v. Vivian* (d), where the invention was the manufacture, by means of an alloy of zinc and copper in such proportions as will alone effect such purpose, of metal plates which may be rolled into slips at a red heat, and the defendants filed affidavits showing that they rolled cold, the same learned judge refused an interlocutory injunction.

Where, however, upon the material before it, the court can come to the conclusion that what is complained of is in substance an invasion of the plaintiff's patent, it will grant an interlocutory injunction, reserving to itself the right of finally deciding the question of infringement at the trial (e). And for this purpose a *prima facie* case of infringement is sufficient (f). And one instance of a clear infringement is sufficient ground for an injunction (g).

The mere possession of instruments made in infringement of a patent is of itself a ground for injunction; and an allegation of no intention to infringe will not prevent the injunction being granted (h).

**Undertaking
instead of
injunction.**

A plaintiff proving infringement is not entitled to an injunction as a matter of course, and where the infringement was small, and the defendant offered to give an undertaking not to infringe, the court accepted the undertaking and refused to grant an injunction (i).

**Expressed
intention to
infringe
sufficient to
found
injunction.**

And where there is a deliberate intention expressed and about to be carried into execution to infringe letters patent under the claim of a right to use the invention patented, the plaintiff will be entitled to an

(b) *Electric Telegraph Co. v. Nott*, 11 Jur. 157; *S.C.* 2 Coop. C. C. 41.

(c) *Morgan v. Seaward*, 1 Webst. P. C. 168.

(d) 2 Webst. P. C. 87.

(e) *Thorn v. Worthing Skating Rink Co.*, 6 Ch. D. 415, 418, n.; *Howes v. Webber*, 11 R. P. C. 586. See also *Grafton v. Watson*, 51 L. T. (N.S.) 143.

(f) See *Briggs v. Lardur*, 1 R. P. C. 128; *Skillito v. Larmuth*, 2 R. P. C. 1, 3.

(g) *United Telephone Co. v. Sharples*, 29 Ch. D. 164, 169.

(h) *United Telephone Co. v. London, etc. Telephone Co.*, 26 Ch. D. 766; *Adair v. Young*, 12 Ch. D. 13.

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

injunction without proving actual infringement, provided, of course, that what is threatened to be done would be an infringement (*k*).

And where an action was brought against the master of a ship, which was fitted exclusively with pumps which were an infringement of a patent, but the defendant was not a part owner, and had had nothing to do with putting the pumps on board, and they had never been worked in British waters, it was held by the Court of Appeal (*dissentiente* JAMES, L.J.), affirming a decision of BACON, V.-C., that the injunction must be granted, on the ground that the master, under the circumstances, must be considered as intending to use the patented invention (*l*).

And where the defendants had opposed the grant of a patent, and had infringed between the filing and acceptance of the specification, and had also infringed after the action was brought, it was held, that although there could be no action for the first infringements by reason of s. 13 of the Act, and the second infringements being after action commenced would not sustain the action, and therefore no damages could be awarded, there was evidence of an intention to infringe, and an injunction was granted (*m*).

If the action is based on threats to infringe, care must be taken that the defendant shall have fair notice of the special infringement he is alleged to be contemplating, and then if after action brought he commits that special infringement, or substantially that infringement, evidence of it can be given, as it is evidence to show that the plaintiff was right in his allegation that at the date of the action the defendant was threatening and intending to infringe. If the action is based on past infringements, and the plaintiff finds that the defendant has since action brought infringed in a way substantially different from his former infringements, leave would be given by the court to the plaintiff in a proper case and on proper terms to amend his action and bring those subsequent infringements before the court to be dealt with once for all with the prior infringements (*n*).

But where the plaintiffs at the trial of an action of the latter class admitted that the machines mentioned in the particulars of breaches were not in fact infringements, and, without asking to amend, offered evidence to prove as infringements mechanism of a different character, and which was made for the first time after action brought, such evidence was rejected (*o*).

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NOTE.

*Injunction,
Interlocutory.*

Infringe-
ments after
action
brought.

(*k*) *Freearson v. Loe*, 9 Ch. D. 48, 65.

(*l*) *Adair v. Young*, 12 Ch. D. 13.

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

(*n*) See *per* ROMER, J., *Shoe Machinery v. Cutlan*, 12 R. P. C. 342, 358, 359.

(*o*) *Shoe Machinery v. Cutlan*, *ubi supra*.

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The plaintiff's evidence on an application for an injunction should show distinctly the manner in which the alleged infringement has taken place (*p*).

NOTE.*Injunction,
Interlocutory.*

The court will, in general, at any time previously to the hearing of the motion, postpone the hearing to allow time for the filing of affidavits; but affidavits filed after the hearing has begun will not be allowed to be read (*q*).

But an undertaking to keep an account of sales was held, in the case of a patent nearly fourteen years old, not sufficient to induce the court to allow the motion for injunction to stand over for scientific evidence, the defendants refusing to undertake not to continue working (*r*).

Injunction
refused,
defendant
ordered to
keep an
account.

Where, under the old practice, the injunction was refused on the ground that the validity of the patent had not yet been established, and the plaintiff was directed to take steps to try the right, the defendant was directed to keep an account of all things made or sold by him according to the patented invention (*s*); and in *Jones v. Pearce* (*t*), Sir L. SHADWELL, V.-C., said that when this course would afford the court ample means of doing justice to the plaintiff should his right be established, the court rarely granted the interim injunction, the profits made by the defendant being generally no very inadequate compensation to the plaintiff for the infringement.

And, under the present practice, when the injunction is refused, the usual course is that defendant must undertake to keep an account (*u*); and this is the rule, even when the injunction is refused on the ground of delay (*x*). But the injunction may be refused although the defendant will not undertake to keep an account (*y*).

And this course was followed where the patent was of very recent date and there was doubt as to the infringement, and there had been an agreement between the patentees of the plaintiff's process and the defendant not to oppose the formation of a company for purchasing his invention which was now complained of as an infringement (*z*).

(*p*) *Hill v. Thompson*, 1 Webst. P. C. 231.

(*q*) *Electric Telegraph Co. v. Nott*, 11 Jur. 273.

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

(*s*) *Bacon v. Jones*, 4 M. & C. 436; *Hill v. Thompson*, 3 Mer. 626; *S.C.* 1 Webst. P. C. 232; *Morgan v. Seward*, 1 Webst. P. C. 169; *Neilson v. Thompson*, 1 Webst. P. C. 286. For the common form of order, see Seton p. 548.

(*t*) 2 Coop. C. C. 58.

(*u*) *Jackson v. Needle*, 1 R. P. C. 176; *Plimpton v. Malcolmson*, L. R. 20 Eq. 38; *Bacon v. Jones*, 4 My. & Cr. 436.

(*x*) *Borill v. Crate*, L. R. 1 Eq. 388; *Neilson v. Thompson*, 1 Webst. 286; *Lister v. Norton*, 1 R. P. C. 114.

(*y*) *British Tanning Co. v. Groth*, 7 R. P. C. 1.

(*z*) *Ibid.*

When a defendant had undertaken to keep an account of all monies received by reason of the manufacture or sale of the alleged infringing articles and had paid a sum of money into court, the court refused to grant an interlocutory injunction against the defendant's customers (a).

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NOTE.

Injunction,
Interlocutory.

A question may arise as to the form of this account. In *Neilson v. Thompson*, the account was not only for the time to come, but from the commencement of the infringement (b). On the other hand, in *Vidi v. Smith* (c), the Court of Queen's Bench said that a retrospective account should not be granted before final judgment. And the observations of BAGGALLAY, L.J., in *Plimpton v. Spiller* (d), seem to imply that the account should be prospective only.

Form of
account.

In *Plimpton v. Malcolmson* (e), and in *Russell v. Cowley* (f), the account was of "all moneys received or to be received" by the sale of the patented articles. But in some cases the account has referred only to the articles.

Thus, in *Beardsell v. Schwann* (g), the account was of "all mohair cloths and other textile fabrics finished by or for the defendants in the manner in the plaintiff's bill complained of." And in *Edison, etc., Co. v. Holland* (h), the undertaking was to keep an account of "all lamps alleged to be an infringement of the patent which the defendants may now be using or may hereafter use or which they may have used since" a date named (the date of judgment in a previous action).

It appears at one time to have been unusual for the court, in granting the interlocutory injunction, to require from the plaintiff any undertaking as to indemnifying the defendant in case it should ultimately turn out that the patent is bad, and that the injunction, therefore, ought not to have been granted (i), and there is no doubt of the competency of the court to grant an interlocutory injunction *simpliciter* (k). But this undertaking was required by Sir J. L. KNIGHT-BRUCE, V.-C., in *Muntz v. Grenfell* (l). And it is now settled that the court will always require it on granting the interlocutory injunction (m), and this not merely on *ex parte* applications, but also on injunctions granted upon motion after notice (n). But this does not apply to an order which is not

Injunction
granted,
plaintiff
required to
give under-
taking as to
damages.

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

(b) 1 Webst. 286.

(c) 3 E. & B. 969.

(d) 4 Ch. D. 291.

(e) Seton, 548.

(f) 1 Webst. 458.

(g) Seton, 3rd ed. p. 910. See also *Hill v. Thompson*, 3 Mer. 626; *Jackson v. Needle*, 1 R. P. C. 176.

(h) Edmunds on Patents, 2nd ed. p. 837.

(i) *Bickford v. Shewes*, 1 Webst. 214; *Tuck v. Silver*, Johnson, 218.

(k) *Bacon v. Jones*, 4 My. & Cr. 436; *Wilson v. Tindal*, 1 Webst. P. C. 730.

(l) 2 Webst. 91. See the order; 2 Coop. C. C. 59.

(m) *Chappell v. Davidson*, 8 D. M. & G. 1.

(n) *Tuck v. Silver*, Johns. 218; *Wakefield v. Duke of Buccleuch*, 11 Jur. (N.S.) 523; *Graham v. Campbell*, 7 Ch. D. 491.

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Interlocutory.*

interlocutory in the sense of not being interim or which leaves nothing for decision at a future time, and, therefore, where an injunction was granted to restrain certain advertisements pending an action for infringement no undertaking as to damages was required (*o*).

The undertaking is required even where the patent has been established in previous suits (*p*), and was required where the defendant in the present suit was one of a number of persons who had formed themselves into an association for the purpose of contesting the patent, and who had actually found the funds for defending one of the previous suits in which the plaintiff had obtained a decree in his favour (*q*). So also where issues involving the validity of a patent had been directed in a suit and found in the plaintiff's favour, and the plaintiff applied for an interlocutory injunction, the undertaking as to damages was required, the defendant having offered to keep an account (*r*).

For the forms of the undertaking and of the inquiry thereon as to damages, see Seton, pp. 452, 453. The ultimate dismissal (*s*) or discontinuance (*t*) of the action does not put an end to the undertaking, and it can be enforced when the injunction has been wrongly granted owing to a mistake of law by the judge (*u*). As to the time within which application to enforce the undertaking should be made, see *Ex parte Hall* (*x*).

The undertaking may be given by a married woman (*y*), and may be enforced against a married woman suing her husband, notwithstanding s. 12 of the Married Women's Property Act, 1882 (*z*).

The undertaking applies to all the defendants asking for it, though the injunction may not be granted against all (*a*).

The costs of the inquiry as to damages are provided for in the usual form of order for the inquiry (*b*), and need not be reserved (*c*).

**Injunction
granted on
terms.**

When, on a motion for injunction to restrain infringement of a patent which had been established in a former action, the defendants alleged that the plaintiffs had contracted to supply them with certain machines

(*o*) *Fenner v. Wilson*, 10 R. P. C. 283; [1893] 2 Ch. 656.

(*p*) See *United Telephone Co. v. Tasker*, 5 R. P. C. 628, 633.

(*q*) *Borill v. Smith*, W. N. 1867, 240.

(*r*) *Renard v. Levinstein*, 2 H. & M. 628, 634.

(*s*) *Newby v. Harrison*, 3 D. F. & J. 287; *Graham v. Campbell*, 7 Ch. D. 491.

(*t*) *Newcomen v. Coulson*, 7 Ch. D. 764.

(*u*) *Griffith v. Blake*, 27 Ch. D. 474, dissenting from the dictum of

JESSEL, M. R., in *Smith v. Day*, 21 Ch. D. 421. See also *Hunt v. Hunt*, 54 L. J. Ch. 289; *Rothwell v. King* (No. 2), 4 R. P. C. 76.

(*x*) 23 Ch. D. 644.

(*y*) *Re Prynne*, W. N. 1885, p. 144.

(*z*) *Hunt v. Hunt*, *ubi supra*.

(*a*) *Tucker v. New Brunswick, etc., Co.*, 44 Ch. D. 249.

(*b*) *Burdett v. Hay*, Seton, p. 453; *Hunt v. Hunt*, *ubi supra*.

(*c*) *Rothwell v. King* (No. 2), 4 R. P. C. 76.

to carry on their business, and had broken the contract, it was held that this fact did not justify the infringement; but the injunction was granted only on the terms that the plaintiffs should supply the defendants with a certain limited number of machines in the place of those which the injunction would prevent the defendants from using (*d*).

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Interlocutory.

It has been said by Lord ELDON that where there is one question as to whether the patent is valid, and another question whether it has been infringed, the court would be going a long way if it took upon itself to grant an injunction (*e*). In such cases it depends on the degree of doubt which exists on these questions whether the court will grant the interim injunction. It will cautiously consider the degree of convenience and inconvenience to the parties by granting or not granting the injunction (*f*). And in *Plimpton v. Malcolmson* (*g*) Sir GEORGE JESSEL, M.R., said that, when it appears that there is a serious question to be tried at the hearing, it is not the course of the court to grant an injunction on an interlocutory application.

When questions both as to validity of patent and fact of infringement.

In order to obtain an interlocutory injunction, the plaintiff must make out a *prima facie* case, that is, that, if the evidence remains as it is, it is probable that at the hearing he will get a decree in his favour. Unless the court is so satisfied, the injunction ought not to be granted (*h*).

The court on the interlocutory application avoids as far as possible expressing an opinion on the merits of the case (*i*), and will endeavour to ascertain what is the best method of keeping things *in statu quo*, either by granting an injunction and requiring from the plaintiff the undertaking as to damages, or by refusing the injunction, and requiring the defendant to keep an account (*k*).

Court considers best mode of keeping things *in statu quo*.

Where granting the injunction would be extremely prejudicial to the defendant, and do no possible good to the plaintiff, the injunction will be refused (*l*).

Circumstances leading to refusal of injunction

Thus, in *Morgan v. Seward* (*m*), where a contract had been entered into by defendant, and justice could be done to the plaintiff by directing the defendant to keep an account, the injunction was refused.

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

(*e*) *Wood v. Cockerell*, 2 Coop. C. C. 58.

(*f*) *Per* Lord LANGDALE, *Bridson v. McAlpine*, 8 Bea. 230.

(*g*) L. R. 20 Eq. 38.

(*h*) *Challender v. Royle*, 36 Ch. D. 425, 436, COTTON, L.J. See also *Preston v. Luck*, 27 Ch. D. 497, 506.

(*i*) *Plimpton v. Malcolmson*, L. R. 20 Eq. 38.

(*k*) *Plimpton v. Spiller*, 4 Ch. D. 289.

(*l*) *Neilson v. Thomproun*, 1 Webst. 275, 285.

(*m*) 1 Webst. 109.

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Interlocutory.*
Circum-
stances in
favour of
injunction.

But in estimating the balance of convenience and inconvenience the court will consider as a circumstance in favour of an injunction that the defendant's trade is a new trade, and that if the injunction were refused the plaintiff would be driven to commence actions against the purchasers from and customers of the defendant (*n*). And in a design case, where defendants had admittedly gone as near to plaintiff's design as they thought they safely could, the interlocutory injunction was granted on the balance of convenience and inconvenience (*o*).

An interlocutory injunction is usually granted only in general terms (*p*).

If a *prima facie* case has been made out, and the judge below has granted an injunction, the Court of Appeal will not interfere with that exercise of his discretion (*q*).

The circumstance that the old practice (*r*) is no longer in force under which, except in special cases, an injunction was not granted until the patent had been established at law, has not altered the practice of the court in granting interlocutory injunctions, though it may introduce considerations with which the court must deal on the question whether an injunction should be granted or not (*s*). The patentee may, if the injunction be granted, be put upon terms to bring the action to trial as speedily as possible (*t*), and this course was adopted in *Renard v. Levinstein* (*u*).

Under the old practice, if a plaintiff, having been put upon terms to try the action as speedily as possible, was guilty of undue delay, the injunction was dissolved (*x*).

*Ex parte
injunctions.*

Where an injunction is applied for *ex parte*, it is incumbent on the party making the application to swear, at the time of making it, that he is the original inventor; for although when he obtained his patent he might very honestly have sworn as to his belief of such being the fact, yet circumstances may have subsequently intervened, or information have been communicated, sufficient to convince him that it was not his

(*n*) *Plimpton v. Spiller*, 4 Ch. D. 286, 292. See also *Read v. Richardson*, 45 L. T. 54, 58.

(*o*) *Grafton v. Watson*, 51 L. T. (N.S.) 143 (C. A.).

(*p*) *Edison Bell Phonograph Co. v. London Phonograph Co.*, 11 R. P. C. 193; *Plimpton v. Spiller*, Seton, 547.

(*q*) *Baker v. White*, 1 Times R. 65.

(*r*) *Bacon v. Jones*, 4 My. & Cr. 436; *Jones v. Pearce*, 2 Coop. C. C. 58.

(*s*) *Davenport v. Jepson*, 4 D. F. & J. 440, 445, 446.

(*t*) *Davenport v. Jepson*, 4 D. F. & J. 448.

(*u*) 10 L. T. (N.S.) 94; S.C. on App., *Ibid.* 177.

(*x*) *Sterens v. Keating*, 2 Ph. 333; 2 Webst. P. C. 180. See also *Bell v. Bell*, 14 Jur. 1129; *Heath v. Unwin*, 14 Jur. 1129; *Baker v. McClellan*, 27 L. J. (N.S.) 57; *Arnold v. Thomson*, 9 Jur. (N.S.) 436.

own original invention, and that he was under a mistake when he made his previous declaration (*y*).

This rule was recognised by Lord LYNDHURST, C., in *Sturtz v. De la Rue* (*z*), and though this was an application for an *ex parte* injunction, the words of the judgment are wide enough to include all cases of interlocutory injunction, whether applied for *ex parte* or on notice; and it is remarked by Mr. Hindmarch that the reason for the rule laid down by Lord ELDON in *Hill v. Thompson*, as above mentioned, is quite as much applicable to the case of an application after notice as to a motion for an injunction *ex parte*, and that there can be little doubt that the rule was intended to apply to all interlocutory applications for injunction (*a*), and this view appears to be correct (*b*).

The court expects the utmost good faith from a plaintiff seeking an *ex parte* injunction. The plaintiff must state to the court all the facts in his knowledge which are material to the question whether the injunction ought to be granted, and it is no excuse for the plaintiff to say that he was not aware of the importance of such facts, and the omission to bring those facts under the notice of the court when the *ex parte* injunction was obtained is a sufficient ground for dissolving it (*c*). And it is a rule without exception that, if the defendant has appeared, the plaintiff must inform the judge of the fact. *Ex parte* injunctions may be, but are not usually, granted when the defendant has appeared (*d*).

According to the usual practice *ex parte* injunctions are not now granted. The court generally grants an interim order restraining the defendant till after a day named, liberty being given to the plaintiff to serve notice for an injunction for the day before such day. The plaintiff is also required to give an undertaking to abide by the order of the court as to any damages the defendant may be put to by reason of the interim order, and such other terms are imposed on him as the case may require (*e*).

And if the interim order is irregularly obtained in consequence of a suppression of facts the court may, on the hearing of a motion for an injunction or in the alternative to continue the interim order, discharge the *ex parte* order without any cross notice of motion for that purpose

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NOTE.

*Injunction,
Interlocutory.*

(*y*) *Hill v. Thompson*, 3 Mer. 624 ;
S.C. 1 Webst. P. C. 231.

(*z*) 5 Russ. 322, 329. See also
Gardner v. Broadbent, 2 Jur. (N.S.)
1041.

(*a*) Hindmarch on Patents, 334.

(*b*) *Whitton v. Jennings*, 1 Dr. &
Sm. 110 ; *Mayer v. Spence*, 1 J. & H.

87 ; *Clarke v. Nichols*, 12 R.P.C. 310.

(*c*) *Dalglish v. Jarric*, 2 Mac. &
G. 231. See *Curtis v. Cutts*, 3 Jur.
34.

(*d*) *Mexican Co. of London v.
Maldonado*, W. N. 1890, 8.

(*e*) Daniell's Chancery Practice,
6th ed. p. 1611.

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by the defendant, though the court may upon the evidence on the plaintiff's motion grant the injunction (*f*).

NOTE.*Injunction,
Interlocutory.*

Where two persons had obtained patents for the same invention, the court would not interfere between them by interlocutory injunction, but left them to try the legal right by *scire facias* (*g*) (now by petition of revocation, s. 26).

Application for interlocutory injunction to be made without delay.

Delay fatal to injunction even though patent established in previous actions.

A patentee desiring to obtain an interlocutory injunction must apply to the court without delay. If the application be *ex parte*, it should be at the earliest possible period, and if upon notice, it should be made early (*h*). If this rule be not complied with, the injunction will be refused. And the rule will be enforced even where there have been previous suits in which the validity of the patent has been established against other defendants. Thus, in *Bridson v. Benecke*, cited above, the patent had been established in a previous suit against one McAlpine, but the present bill was not filed till December, although the plaintiff knew of the infringement in January, and gave the defendant notice to desist. Lord LANGDALE, M.R., refused the injunction, notwithstanding he had a strong impression in favour of the plaintiff's right.

Again, in *Borill v. Crate* (*i*), there had been several previous suits, but the plaintiff, having knowledge in August of the defendant's proceedings, and having written in November to complain of the infringement, and being told by the defendant's solicitor in the following April that service of a bill would be accepted on defendant's behalf, did not file a bill till July; the injunction was refused on the ground of delay (*k*).

And in *Greer v. Bristol Tanning Co.* (*l*), an application on December 2nd for an interim order to restrain infringements, which plaintiff knew of on November 13th and 23rd, was held too late, but leave was given to serve notice of motion.

And where the action was not brought till June although the plaintiff had known of the alleged infringement in December, but it was alleged that there were a number of small infringers of no means, who, if proceeded against, contested the matter till the day of trial and

(*f*) *Boyce v. Gill*, W. N. 1891, 108.

(*g*) *Copeland v. Webb*, 11 W. R. 134; S.C. 1 N. R. 119. See also *Baskett v. Cunningham*, 2 Ed. 137.

(*h*) *Bacon v. Jones*, 4 My. & Cr. 438; *Bridson v. Benecke*, 12 Bea. 1, 3; *Baxter v. Coombe*, 1 Ir. Ch. R. 284.

(*i*) L. R. 1 Eq. 388.

(*k*) See also *Smith v. London and South-Western Rail. Co.*, Macr. P. C. 209; S.C. Kay, 417; *North British Rubber Co. v. Gormully, etc., Co.*, 12 R. P. C. 17; *Lister v. Norton*, 1 R. P. C. 114; *Leonhardt v. Kallé*, 11 R. P. C. 531; *Aluminium Co. v. Domciere, etc., Actien Gesellschaft*, 15 R. P. C. 32.

(*l*) 2 R. P. C. 268. See also *Thomson v. Batty*, 4 Times R. 36.

then disappeared, on the defendant undertaking to pay a sum into court, and to keep the usual account, the interlocutory injunction was refused, the action to be prosecuted without delay (*m*).

On the other hand, delay was held no bar to an interlocutory injunction where the plaintiff, having established his patent in several previous suits, and there being a combination of persons against him interested in resisting his claims, had not filed bills against the separate members of this combination until he had succeeded in again establishing his patent in a suit against one of them (*n*).

And where the plaintiff, having known of the infringement on March 23rd, spent some time in making inquiries, on May 8th gave notice to the defendant to desist, and, after some correspondence, filed his bill on July 7th, he was held to have come in sufficient time, and the injunction was granted (*o*).

So also where the solicitor of a company formed to work certain patents wrote, shortly after its incorporation, to the plaintiffs in February, 1887, that the company were about to manufacture instruments which might be alleged by the plaintiffs to be infringements, and offered inspection, and the plaintiffs, who had already been engaged in extensive litigation in which they had established their patent, took no notice of the letter, and did not bring an action till March, 1888, shortly after the company had actually begun to manufacture, and alleged that they had been advised not to commence proceedings until they found the company had a substantial capital, and were actually infringing, the delay was held to be sufficiently explained (*p*).

And the mere existence of a rival patent of the defendant is no ground of itself for imputing to the plaintiff knowledge of the defendant's infringement so as to affect the plaintiff with *laches* (*q*). And a defendant cannot avail himself of the plaintiff's *laches* with respect to a person not a defendant (*r*).

If there is an independent case, such as *laches*, against the motion for injunction, the better course is to order the motion to stand to the trial if the defendant asks for it; but when the case on the motion is the same as the case at the trial, the proper course is to make the costs of the motion costs in the action (*s*).

Sect. 30.**NOTE.**

*Injunction,
Interlocutory.*

When delay
no bar.

(*m*) *Edison Bell Phonograph Co. v. Hough*, 11 R. P. C. 594. See also *North British Rubber Co. v. Gormully, etc., Co.*, *ubi supra*.

(*n*) *Bovill v. Smith*, W. N. 1867, 240.

(*o*) *Losh v. Hague*, 1 Webst. P. C. 201.

(*p*) *United Telephone Co. v. Equitable Telephone Association*, 5 R. P. C. 233.

(*q*) *Osmond v. Hirst*, 2 R. P. C. 265, 267.

(*r*) *Pneumatic Tyre Co. v. Warrilow*, 13 R. P. C. 284.

(*s*) *Lister v. Norton*, 1 R. P. C. 114.

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NOTE.
Injunction,
Interlocutory.

—
Acquiescence.

Where the costs of a motion for injunction which was refused on the ground of *laches* were reserved, and the plaintiff succeeded at the trial, the costs of the motion were made costs in the action (*t*).

Acquiescence by the plaintiff in defendant's proceedings will also defeat the right to an interlocutory injunction. Thus, in *Neilson v. Thompson* (*u*), the plaintiff, not being himself a manufacturer, and whose practice was not to work the invention himself, but to grant licences under his patent, had permitted the defendants to erect their works on the expectation that they would take a licence to use the invention on the terms on which other licences had been granted, and had expressed his willingness to grant the defendants a licence on those terms. The defendants began to work the invention without the licence of the plaintiff: but it was held upon the defendants undertaking to keep an account, and to deal with that account as the court might direct, that the acquiescence was a bar to an injunction (*x*).

**Delay no
 bar at trial.**

At the trial, however, the court decides on the rights of the parties, and therefore it may be that delay or acquiescence, which would be fatal to an interlocutory application, will not necessarily debar a plaintiff from obtaining an injunction at the trial (*y*). Mere delay to enforce a legal right is no bar to an action, unless the delay is such as to cause a statutory bar (*z*). But acquiescence may be a ground for refusing an account of profits (*a*), or for limiting it to the date of commencing the action (*b*), or for granting damages instead of an injunction (*c*).

Where the patentee brought an action for infringement against purchasers from a rival manufacturer, and the defendants set up a case of acquiescence, and proved that the patentee, knowing of their intention to purchase, and believing the rival machines to be infringements, had called on the defendants and asked them to try his machine, but without intimating that he considered the other machine an infringement, it was held that as the defendants did not allege, and there was no reason to suppose, that they were ignorant of the plaintiff's patent, or that the plaintiff supposed them to be ignorant of it, the plaintiff

(*t*) *Thomson v. Batty*, 6 R. P. C. 84, 109.

(*u*) 1 Webst. 275, 285.

(*x*) *Neilson v. Thompson*, 1 Webst. P. C. 287.

(*y*) *Johnson v. Wyatt*, 2 D. J. & S. 18, 25; *Fullwood v. Fullwood*, 9 Ch. D. 176; *Rowland v. Mitchell*, 14 R. P. C. 37, 45.

(*z*) *Three Towns Banking Co. v. Maddox*, 27 Ch. D. 531. See also

observations of PEARSON, J., *Wood v. Lambert*, 3 R. P. C. 84.

(*a*) *Crossley v. Beverley*, 1 Webst. 120; *Harrison v. Taylor*, 11 Jur. (N.S.) 498; *Beard v. Turner*, 13 L. T. (N.S.) 746.

(*b*) *Ford v. Foster*, L. R. 7 Ch. 627, 634.

(*c*) *Sayers v. Collyer*, 28 Ch. D. 103, FRY, L.J.

had not, on the ground of acquiescence or estoppel, lost his right to bring the action (*d*).

And where the plaintiff knew of the defendant's infringement in July, 1886, and a correspondence took place between the parties and their respective solicitors, but the action was not brought till March, 1888, it was held at the trial that there had been no acquiescence to bar the plaintiff's right to relief (*e*).

But where the plaintiff, having a common law trade mark, had been aware of its use by other persons than the defendant and had not attacked them, though one of such persons had expressly declined to discontinue the use of the mark, an action against the defendant for infringement was dismissed (*f*).

INJUNCTION (PERPETUAL).

If the plaintiff establishes the validity of his patent and the fact of infringement, he will obtain judgment for a perpetual injunction to restrain infringement, and may also have further relief in the shape of damages or account of profits.

But the court will not grant such perpetual injunction unless the validity of the patent has been conclusively established (*g*).

And an injunction is not a matter of course at the trial. When the defendant had infringed inadvertently and had subsequently made an offer to undertake not to infringe and to pay costs and damages, which the court considered ought to have been accepted, the court declined to grant an injunction, but accepted the defendant's undertaking (*h*).

If the plaintiff moves for judgment on admission in the pleadings under S. C. R. Order XXXII. r. 6, he is bound to accept as true the statements of fact in the defence; and therefore where defendant admitted in his defence ten infringements, but denied any further infringements, an inquiry as to damages was refused, except as to the ten instances (*i*).

Where persons had been brought in by the defendants under the third-party rules as liable to indemnify the defendants, but had not been made defendants to the action, though they had, in fact, had the conduct of the defence, it was held by the court of appeal that no injunction could be granted against them. They were, however, ordered to pay costs (*k*).

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NOTE.

*Injunction,
Interlocutory.*

(*d*) *Proctor v. Bennis*, 36 Ch. D. 741.

(*e*) *Shaw v. Jones*, 6 R. P. C. 329.

(*f*) *Ripley v. Bandy*, 14 R. P. C. 591, 944.

(*g*) See *Hill v. Evans*, 4 D. F. & J. 288, 289.

(*h*) *Jenkins v. Hope*, 13 R. P. C. 57; and see *ante*, p. 237.

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

(*k*) *Edison, etc. Co. v. Holland*, 41 Ch. D. 28.

Sect. 30.**NOTE.****Injunction,
Perpetual.**

For forms of orders for interlocutory and perpetual injunctions in patent cases, see Seton, pp. 547, 548, and 565, and Pemberton, pp. 483, 484, and 485. Names of manufacturers not parties to the action ought not to appear in the injunction, even for the purpose of identifying the machines affected (*l*).

May by consent be obtained without bringing action to trial.

If a defendant desires to submit to the plaintiff's demands, it is not necessary to bring the action to trial in order to have the injunction made perpetual.

This may be done on motion by the plaintiff with the consent of the defendant (*m*). And if the defendant submits to a perpetual injunction and to pay the costs of the action, the proceedings may be stayed without the consent of the plaintiff, when the only object of the action is an injunction (*n*), or when the plaintiff is willing to waive the other relief prayed by the statement of claim (*o*).

When an interlocutory injunction is granted the injunction may, at defendant's instance, and on his paying costs, be made perpetual as to some of the acts sought to be restrained so as to get rid of that part of the case (*p*).

Since the powers of this section are conferred on "the court or a judge," an order for a perpetual injunction may be made in chambers (*q*), subject to the provisions of Order LIV. r. 12, and Order LV. r. 15.

Where defendants offered by their defence to submit to an injunction and pay costs, it was held that an order ought to have been obtained on summons in chambers, and the extra costs occasioned by bringing on the matter in court were refused (*r*).

Consent to a perpetual injunction may be withdrawn if given under mistake or surprise, but not on the mere ground of subsequent discovery of facts on which a defence may be founded (*s*).

No stay of proceedings pending appeal.

By S. C. R. 1883, Order LVIII. r. 16, there is to be no stay of proceeding pending appeal, except so far as the court appealed from, or any judge thereof, or the Court of Appeal may order. The practice on this point has not been uniform.

Under the old practice, where after a trial before the court without a jury the Vice-Chancellor found in favour of a plaintiff, and a motion for a new trial was refused by the Vice-Chancellor, and afterwards by

(*l*) *Shoe Machinery Co. v. Cutlan*, 12 R. P. C. 342, 359.

(*m*) *Morrell v. Pearson*, 12 Beav. 284. But see *Jenkins v. Hope*, 13 R. P. C. 57.

(*n*) *Hume v. Beale*, cited Seton, p. 630.

(*o*) *Curtis v. Pape*, 5 R. P. C. 146.

(*p*) *Curtis v. Pape*, 5 R. P. C. 150.

(*q*) Judicature Act, 1873, s. 39: *Frearson v. Lee*, 26 W. R. 138.

(*r*) *London Steam Dyeing Co. v. Digby*, W. N. 1888, 35; *Allen v. Oakley*, W. N. 1890, 121.

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

the Lord Chancellor, the court refused to suspend the final order for injunction pending an appeal to the House of Lords (*t*). And a perpetual injunction granted after a trial will not be suspended pending an appeal, merely because the defendants may, by the injunction, be prevented from carrying out contracts already entered into by them to deliver the articles complained of, notwithstanding the defendants may offer to undertake as to damages (*u*).

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*Injunction,
Perpetual.*

But in some cases the operation of the injunction has been suspended pending appeal. Thus the injunction has been suspended for fourteen days, provided defendants gave notice of appeal within that time, defendant undertaking to keep an account of machines made by them (*x*). And defendants have been required, as a condition of stay of the injunction, to give security for the amount of damages as well as to keep an account (*y*). And the taking of the account of profits and the injunction were suspended pending appeal, on the defendant undertaking to keep an account and to appeal forthwith, liberty being given to the plaintiff to apply if the appeal was not diligently prosecuted (*z*).

Injunction
sometimes
suspended
pending
appeal.

And where a defendant company applied for stay of execution pending an appeal, and it appeared that they were making only for the government, a receiver was appointed to receive all moneys coming to the defendants from the government, and the injunction was stayed so far as related to the supply of articles to the government (*a*).

And an order for an attachment, for breach of an injunction by the sale of an article different from that on which the injunction was founded, was suspended pending an appeal to the House of Lords on the terms that the defendant should pay the costs (the plaintiff's solicitor undertaking to refund the same if the order should be reversed) and should keep an account of the infringing articles made and sold (*b*).

And in some cases, although the injunction has not been interfered with, the taking of the account of profits has been stayed pending appeal, on the defendant undertaking to appeal promptly (*c*). And where it appeared that the discovery given by the account would enable the plaintiff to take proceedings against the customers of the defendants,

Sometimes
account only
stayed.

(*t*) *Penn v. Bibby*, L. R. 3 Eq. 308.

(*u*) *Flower v. Lloyd*, 36 L. T. (N.S.) 445.

(*x*) *Hocking v. Fraser*, 3 R.P.C. 7; *North British Rubber Co. v. Mackintosh*, 11 R. P. C. 477.

(*y*) *National Opalite, etc., Syndicate v. Ceralite Syndicate*, 13 R. P. C. 649.

(*z*) *Kaye v. Chubb*, 4 R. P. C. 23.

(*a*) *Nordenfelt v. Gardner*, 1 R. P. C. 63. See also *Pneumatic Tyre Co. v. East London Rubber Co.*, 14 R. P. C. 77, 104.

(*b*) *Thomson v. Moore*, 6 R. P. C. 426, 464; 23 L. R. Ir. 599. See also *Thomson v. Hughes*, 7 R. P. C. 71.

(*c*) *Woodward v. Sansum*, 3 R. P. C. 366; *Humpherson v. Syer*, 4 R. P. C. 184.

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and that the defendants, if ultimately successful, might find that in the meantime their business had been ruined, the Court of Appeal stayed proceedings under the account till the hearing of the appeal, the appeal being advanced (*d*).

This course, however, was not followed when the patent had been established in a previous action, and the infringement was not contested in the second action (*e*).

Delivery up
of infringing
articles
suspended.

In *Washburn Manufacturing Co. v. Patterson* (*f*), the court declined to suspend the order for the delivery up of infringing machines and articles, the defendant refusing to undertake not to remove them out of the country; but subsequently, on the defendant giving this undertaking, and undertaking also to deliver up all wire made by the machines, and not to sell or import like wire into this country, the order was suspended during the appeal (*g*).

No stay of
execution for
costs.

When judgment was given for defendant with costs, stay of execution was refused, the defendant's solicitors giving their personal undertaking to repay any costs received by them if the judgment should be ultimately reversed (*h*). This has been said to be the usual practice (*i*). But a special reason for such an order is required by the Court of Appeal (*l*).

Staying pro-
ceedings
pending
appeal to
House of
Lords.

A motion by defendant to stay proceedings pending an appeal to the House of Lords was refused, it being admitted by the defendant that he was not now making the machines complained of, but machines of a different character, and the object being only to prevent the judgment deterring those who would otherwise buy machines from the defendant (*l*). And an application to stay a new trial pending a like appeal was refused (*m*). So also where the machines in respect of which the stay of proceedings was asked had been ordered since the commencement of the action (*n*). But defendants out of the jurisdiction obtained a stay of the injunction to enable them to decide as to an appeal on increasing the amount already in court (*o*).

(*d*) *Adair v. Young*, 11 Ch. D. 136.

(*e*) *Otto v. Steel*, 3 R. P. C. 109
121.

(*f*) 1 R. P. C. 158, 162.

(*g*) *Washburn, etc. Co. v. Patter-
son*, 1 R. P. C. 191.

(*h*) *Easterbrook v. Great Western
Rail. Co.*, 2 R. P. C. 201, 212. See
also *Merry v. Nickalls*, 8 Ch. 205;
Morgan v. Elgood, 4 Ch. D. 387.

(*i*) *Dreley's Patent*, 12 R. P. C.
65, 75; *Ticket Punch, etc. Co. v.
Colley's Patents*, 12 R. P. C. 1, 10;
Chadburn v. Mehan, 12 R. P. C.
120.

(*k*) *Pneumatic Tyre Co. v. East
London Rubber Co.* 14 R. P. C. 573,
590; *Badische Anilin und Soda
Fabrik v. Johnson*, 14 R. P. C. 405,
418.

(*l*) *Proctor v. Bennis*, 4 R. P. C.
363.

(*m*) *Edge v. Johnson*, 9 R. P. C.
134, 142.

(*n*) *Lyon v. Goddard* (2), 10
R. P. C. 348.

(*o*) *North British Rubber Co. v.
Gormully, etc. Co.*, 14 R. P. C. 283.

Where the order of the court of first instance, which had been reversed by the Court of Appeal, is restored on appeal to the House of Lords, an order is necessary making the order of the House of Lords an order of the High Court of Justice (*p*). This may be obtained on *ex parte* application to the judge of the High Court to whom the action is assigned (*q*). The order is not necessary if the order of the Court of Appeal is affirmed by the House of Lords (*r*).

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Injunction,
Perpetual.

It is not necessary for the plaintiff, in order to justify an application for the committal of a defendant for breach of an injunction, to show that the order granting the injunction has been served upon him, if it is proved that he had notice of the order *aliunde*, and knew that the plaintiff intended to enforce it (*s*). Breach of injunction.

A defendant will not escape committal if, while himself purporting to observe the injunction, he connives at the continuance by others of the work prohibited (*t*). And persons, though not servants or agents of the defendant or enjoined by the injunction, may be committed for contempt of court if with full knowledge of the injunction they assist the defendant in disobeying it (*u*).

After an injunction has been granted, it is no contempt to publish advertisements asking for subscriptions towards the expenses of an appeal (*v*), or advertisements asking for documentary evidence of anticipation of the patent (*x*).

Although the mere sale of the component parts of a machine is not of itself an infringement (*y*), it seems that an injunction to restrain the sale of a complete machine would be violated by the sale of the component parts of the machine in such a manner as that they may be put together by anyone (*z*).

It is, of course, open to a person charged with having committed a breach of an injunction restraining infringement of a patent to show that since the injunction the patent had ceased to be in force (*a*).

(*p*) See *Man v. Ricketts*, Seton, 746.

(*q*) *British Dynamite Co. v. Krebs*, 11 Ch. D. 448; *Badische Anilin und Soda Fabrik v. Levinstein*, 4 R. P. C. 470.

(*r*) *A.-G. v. Scott*, 1 Ves. sen. 412, 418.

(*s*) *United Telephone Co. v. Dale*, 25 Ch. D. 778.

(*t*) *Graydon v. Bassett*, 13 R. P. C. 613, 614. See, however, *S. C.* in H. L., 14 R. P. C. 701, 711, 718.

(*u*) *Seaward v. Paterson*, [1897] 1 Ch. 545, and see *Graydon v. Bassett*, *ubi supra*.

(*v*) *Plating Co. v. Farquharson*, 17 Ch. D. 49.

(*x*) *Plating Co. v. Farquharson*, *ubi supra*.

(*y*) *M'Cormick v. Gray*, 7 H. & N. 25; *Townsend v. Haworth*, 12 Ch. D. 831, n., more fully reported 48 L. J. Ch. (N.S.) 770, Higgins, 165; *Sykes v. Howarth*, 12 Ch. D. 826.

(*z*) *United Telephone Co. v. Dale*, 25 Ch. D. 778.

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

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Perpetual.*

It seems that if, after an injunction, the defendant has infringed the patent, a contempt of court has been committed, even though the defendant thought he was not infringing (b).

But cases may occur where breach of an injunction may be justified, and may even be a duty. Thus, where an injunction had been granted to restrain the master of a ship from using certain patented pumps with which exclusively the ship was fitted, and the judgment was affirmed by the majority of the Court of Appeal (*dissentiente* JAMES, L.J.), the following remarks were, on a subsequent day, made in reference to this case by the last-named learned judge: "Whatever appliances there may happen to be on board, however they came there, pumps, anchors, fire extinguishers, stolen or not stolen, pirated or not pirated, it is his (the master's) bounden duty to use them according to the exigencies of navigation for the safety of ship, cargo, and life. To the master when out to sea (injunction or no injunction), *salus navis est suprema lex*. And for myself, I believe that a master would be practically as safe in disobeying an injunction under a pressing emergency as he would be in shooting a mutineer" (c).

Injunction
against
specific
article on
motion to
commit.

On a motion to commit for breach of an interlocutory injunction restraining infringement of a patent for skates, the skate now complained of being different from that which was put in evidence on the application for the injunction, the court, being of opinion that the new skate was also an infringement, but not then finally deciding the question, did not make an order for committal, but upon the plaintiff undertaking as to damages, granted an injunction restraining, until further order, the manufacture of the new skate, and this course was approved of by the majority of the Court of Appeal (d). But in a similar case, upon an undertaking by the defendant to keep an account of the infringing articles, the injunction was on the balance of convenience refused, the costs of the motion being reserved (e).

In *Spencer v. The Ancoats Vale Rubber Co.* (f), it was held to be doubtful whether, on a motion for sequestration against the company and committal against the directors for breach of a perpetual injunction, the court could direct an account of profits or delivery up of infringing articles, but the order for sequestration and committal was made, such order, however, not to issue if the defendants should within a named time elect to account for profits and deliver up the article complained of and pay costs.

(b) *Plimpton v. Spiller*, 4 Ch. D. 287; *Lyon v. Goddard*, 11 R. P. C. 113.

(c) *Adair v. Young*, 12 Ch. 21.

(d) *Plimpton v. Spiller*, 4 Ch. D. 287.

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

(f) 6 R. P. C. 46, 66.

On a motion to commit, costs as between solicitor and client may sometimes be given to the party moving, by way of indemnifying him, instead of committing the respondent (*g*).

But in the above-cited case of *Spencer v. The Ancoats Vale Rubber Co.* (*h*), where it appeared that the acts complained of had not been done vexatiously, but in the probable belief that the company were entitled to do what they did, solicitor and client costs were refused, but costs on the higher scale were given (*i*).

Solicitor and client costs cannot be given to a respondent on such a motion (*k*).

Motions to commit where no case for committal is made, and only an apology and costs are asked for, will be discouraged (*l*).

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NOTE.

*Injunction,
Perpetual.*Costs on
motion to
commit.

INSPECTION.

The earliest reported patent case in which inspection was ordered is *Brown v. Moore* (*l*), which appears (*m*) to be the same as that the judgment in which is reported, under the name of *Bovill v. Moore*, in 2 Cooper's Chancery Cases, p. 56. In that case Lord ELDON rests the jurisdiction on the necessity of inspection to enable the court to have the case properly tried (*n*).

Inspection is not a matter of right, and the court, before granting it, must be satisfied that there really is a case to be tried at the hearing of the cause.

Inspection
not a matter
of right.

In *Piggott v. The Anglo-American Telegraph Co.* (*o*), the plaintiffs were owners of a patent for improvements in the mode of generating electric currents, manufacturing submarine telegraph cables, and transmitting signals, and the invention was alleged to consist, not in the construction of any particular electric cable, but in the use of a cable in such a manner as that it should always retain a "static charge." The plaintiffs insisted that the defendants so used their own cable (which was not alleged to be, and was, indeed, proved not to be, similar to the plaintiffs' cable) as to infringe the patent; and having filed a bill for an injunction they moved for leave to inspect the defendants' mode of working; but GIFFARD, V.-C., being of opinion, upon the specification and evidence, that the plaintiffs' patent was, in fact, only for the construction of a

What is
required on
application
for inspec-
tion.

(*g*) *Plating Co. v. Farquharson*, 17 Ch. D. 49, 57; *Steele v. Hutchings*, W. N. (1879), 18.

(*h*) 6 R. P. C. 67, 68.

(*i*) *Spencer v. The Ancoats Vale Rubber Co.*, 6 R. P. C. 46, 66.

(*k*) *Plating Co. v. Farquharson*, *ubi supra*.

(*l*) 3 Bligh, 178.

(*m*) See *post*, p. 287.

(*n*) See also *Russell v. Cowley*, 1 Webst. 458.

(*o*) 19 L. T. (N.S.) 46.

Sect. 30.**NOTE.***Inspection.*

Inspection
must be
shown to be
of material
importance.

particular cable, and that in that view there could be no question of infringement to try at the hearing, refused the motion.

Moreover, before making an order for inspection, the court will require to be satisfied that the inspection is of material importance to the plaintiff's case as made out by his evidence (*p*).

Thus, where in an action for infringing a patent for making cartridges, the plaintiff did not allege that he could not make out his case without inspection, and the defendants filed an affidavit stating that they made several improved cartridges, many of which did not in any way resemble the plaintiff's, and stating further their belief that the inspection was not required for the purposes of the action, but for the purposes of copying their improvements, and the plaintiff did not meet this by any evidence, an application to inspect defendants' manufactory was refused (*q*).

When in an action for infringement of a patent for improvements in spinning machines the particulars of breaches alleged the use by the defendants of certain bobbins and spindles, and the plaintiff had specimens of the bobbins and spindles complained of, an order for liberty to the plaintiff to enter the defendants' works, and work and examine the bobbins and spindles there was refused (*r*).

And when the action was for the specific performance of a contract relating to the working of patents, which contract was denied by the defendant, the court declined to make an order for inspection by the plaintiff of defendant's works (*s*).

An inspection will not be ordered upon an affidavit which simply states that the machine used by the defendants is the same for which the plaintiff has obtained a patent. Such an affidavit is too vague. It ought to state that there is such a machine, and that the plaintiff has reason to believe it is an infringement (*t*). And an affidavit merely stating a belief that the defendants infringe is not enough; the deponent must show grounds for his belief (*u*). The plaintiff must also show what his own invention is; and an order for inspection was refused when the plaintiff merely stated the commencement of the action, but did not disclose his invention, and the defendant stated on oath that

(*p*) *Piggott v. Anglo-American Telegraph Co.*, 19 L. T. (N.S.) 46; *McDougall v. Partington* (2), 7 R. P. C. 351, 472.

(*q*) *Batley v. Kynock*, L. R. 19 Eq. 90. See also *Amies v. Kelsey*, 22 L. J. (N.S.) Q. B. 84; *Meadows v. Kirkman*, 29 L. J. Ex. 205.

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

(*s*) *McDougall v. Partington* (2), 7 R. P. C. 351, 472.

(*t*) *Shaw v. Bank of England*, 22 L. J. (N.S.) Ex. 26.

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

he had used no machinery, and only employed the same process as had been used many years before the patent (*x*).

Nor will inspection be granted if the plaintiff has already had, in an action against the defendant, which action he has discontinued, an inspection of the machinery complained of (*y*).

Where, however, a *prima facie* case of infringement is made out against a defendant, an order for inspection is almost a matter of course (*z*), at all events, when such inspection is essential for the purpose of enabling the plaintiff to prove his case (*a*).

Where an officer of a defendant company, in an action against the company for infringing a patent for carriage wheels, stated in answer to interrogatories, asking as to the construction of defendant's wheels, that the manner of their manufacture could be explained on an inspection, but could not be made intelligible by mere verbal statement, it was ordered that the plaintiff, with certain witnesses on his behalf, should be at liberty to inspect one of the defendant's wheels, and that unless the officer attended and gave information on such inspection he should be examined orally respecting the manner in which such wheels were manufactured (*b*).

The court will not, however, permit inspection to be made the means of oppressing a defendant, nor to be carried beyond what is necessary for the purposes of the cause. Thus, where a defendant, who was sued for infringing the plaintiff's patent for a sewing machine, and against whom a *prima facie* case was made out, objected to an order which the plaintiff sought for inspection of all the sewing-machines of every kind on the defendant's premises, on the ground that such an order would be oppressive, the court allowed the defendant to verify, on affidavit, the several classes of sewing-machines which he had sold or exposed for sale since the date of plaintiff's patent, and confined the inspection to one of each class (*c*). But the court has no jurisdiction to require the defendant to make such an affidavit if it is objected to (*d*).

And the inspection will be limited to processes of the defendant as to which a *prima facie* case of infringement has been made out (*e*).

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NOTE.

Inspection.

But inspection allowed if *prima facie* case of infringement made out.

Inspection not allowed so as to be oppressive.

(*x*) *Meadows v. Kirkman*, 29 L. J. Ex. 205.

(*y*) *Shaw v. Bank of England*, 22 L. J. (N.S.) Ex. 26.

(*z*) Per Lord HATHERLEY, *Singer Manufacturing Co. v. Wilson*, 13 W. R. 560; S. C. 5 N. R. 505.

(*a*) *Batley v. Kynock*, L. R. 19 Eq. 90, 92; *Cheetham v. Oldham* (1), 5 R. P. C. 617.

(*b*) *Smith v. London and Great Western Rail. Co.*, Macr. P. C. 227; 6 E. & B. 405.

(*c*) *Singer Manufacturing Co. v. Wilson*, 13 W. R. 560; S. C. 5 N. R. 505. See the order, Pemberton, p. 485.

(*d*) *Drake v. Muntz's Metal Co.*, 3 R. P. C. 43.

(*e*) *Cheetham v. Oldham* (1), 5 R. P. C. 617.

Sect. 30.**NOTE.****Inspection.****Inspection of books.**

In *Vidi v. Smith* (*f*), it was held that the "inspection" mentioned in s. 42 of the Act of 1852 referred to an inspection of the instrument or machinery 'manufactured or used by the parties with a view to evidence of infringement, and not to an inspection of books.

And an inspection of defendant's books was not ordered on affidavits which only showed the mere possibility of thereby discovering matters advantageous to the plaintiff's case. Thus, where a plaintiff filed affidavits stating that defendants, who were charged with infringing a patent for railway wheels, had kept certain books called the wheel register books, containing particulars as to number, size, etc., of the wheels made by them, but the plaintiff did not show that the wheels mentioned in the books were infringements of the patent, an inspection of the books was refused (*g*).

Where a plaintiff asked, under the Judicature Rules, Order L. Rule 3 (of which Order L. r. 3, S. C. R. 1883, is substantially a re-enactment), for an order to inspect defendant's works, and "upon and during such inspection to make such observations *and experiments* as might be necessary and expedient for the purpose of obtaining full information and evidence" as to the mode in which the articles complained of were made by the defendant, the order asked for was made, but with the omission of the words "and experiments" (*h*).

When production ordered.

In *Sidebottom v. Fielden* (*i*) the court ordered production of articles in defendant's possession which were alleged as prior user; but the court cannot order production of such articles if not in defendant's possession (*k*).

Where the defendants applied for inspection of machines not the property of the plaintiff, and there was a *prima facie* case for saying he could procure inspection, it was held that plaintiff must apply to the owner of the machines to permit inspection and make an affidavit as to the result of such application, and the motion stood over for this purpose (*l*).

By S. C. R. 1883, Order XXXI. r. 20, where inspection is objected to the court or a judge may, if satisfied that the right to inspection depends on the determination of any issue or question in the cause, or that for any other reason it is desirable that any issue or question in the cause should be determined before deciding on the right to inspection, order that such issue may be determined first, and reserve the question as to the inspection.

(*f*) 3 E. & B. 969.

(*g*) *Smith v. London and Great Western Rail. Co.*, Macr. P. C. 223.

(*h*) *Flower v. Lloyd*, W. N. 1876, 169, 170; Seton, p. 561.

(*i*) 8 R. P. C. 266.

(*k*) *Garrard v. Edge*, 6 R. P. C. 372.

(*l*) *Rylands v. Ashley's etc. Co.*, 7 R. P. C. 175. And see *Germ Milling Co. v. Robinson*, 3 R. P. C. 11.

Where the plaintiff refused to permit inspection by the defendants on the ground that he was making improvements of his machines and that it would be injurious to him to allow rival manufacturers to inspect the works, it was held that he must make an affidavit whether there were any of the patented machines in existence without modifications (*m*).

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NOTE.

Inspection.

An objection sometimes urged by a defendant, in answer to a motion for inspection, is that the inspection would lead to disclosures of trade secrets. In *Piggott v. Anglo-American Telegraph Co.* (*n*), some weight was given to this objection, but there were other reasons above stated for refusing the inspection asked.

Trade
secrets.

But in general this allegation will be insufficient to bar the plaintiff's right to inspection if he be otherwise entitled thereto. Thus, in *Renard v. Levenstein* (*o*), discovery of the defendant's process was resisted on the ground that the plaintiffs would thereby obtain the defendant's secret, and ruin his trade. But Sir W. P. WOOD, V.-C., ordered the discovery to be given, observing that the court would, at the proper time, be able to protect the defendant from an improper disclosure of his secret.

And in *Russell v. Crichton* (*p*), a Scotch case, inspection of defendant's manufactory was resisted on the ground that his manufacture involved a secret process, the value of which would be lost if inspection were permitted, but the court said that some mode of inspection must be allowed, otherwise any patent might be infringed with impunity.

The court will, however, endeavour to prevent the inspection being used to the injury of the defendant. Thus, in *Russell v. Crichton*, cited above, the Court of Session, when ordering the inspection, said that all those who were admitted to it must be aware of its being their bounden duty to make no further disclosure afterwards than was required for doing justice in the action.

And in *Flower v. Lloyd*, cited above (p. 284), the court below had, notwithstanding an objection that the plaintiff was a trade competitor with the defendant, ordered that the plaintiff should himself be at liberty to inspect the defendant's works, but when the order came before the Court of Appeal, an arrangement was made that the defendant's works should be inspected by scientific men to be agreed upon, and not by the plaintiff (*q*). In *Cheetham v. Oldham* (*r*), however,

(*m*) *Rylands v. Ashley's etc. Co.*,
ubi supra.

(*n*) 19 L. T. (N.S.) 46. See also
Smith v. London and Great Western
Co., *ubi supra*.

(*o*) 10 L. T. (N.S.) 94. See also
Ashworth v. Roberts, 7 R. P. C. 451 ;

45 Ch. D. 623 ; *Benno Jaffé, etc.*
Fabrik v. Richardson, 10 R. P. C.
136.

(*p*) 15 Dec. of the Court of
Session, 1st Series, p. 1270.

(*q*) W. N. (1876), 230.

(*r*) 5 R. P. C. 617.

Sect. 30. the plaintiff, though a rival manufacturer, was allowed to take part in the inspection.

NOTE.

Inspection.

It is stated in Seton, p. 561, that in the order in *Flower v. Lloyd*, as drawn up, the words "under the obligation of confidence," used by their Lordships, were not inserted; and that on mentioning the matter to the court, their Lordships stated that all they meant was that the inspectors were not to communicate to the plaintiff any special or secret process which the defendant might be using, but were to be at liberty to report to the solicitors whether the process was or was not, in their opinion, an infringement of the plaintiff's patents, and state whether it was the ordinary process or not which the defendant used. The order for inspection made by the Court of Session in *Russell v. Crichton*, cited above, did not contain any direction to the inspectors as to not disclosing the information they might acquire by the inspection. But such a direction may be inserted (s).

The inspector may be ordered to report to the court whether the defendant's machines are trade secrets (t), and he has been directed to state his opinion whether the defendant's machines are infringements (u); but this course has not been followed in later cases, and it is believed that the direction now usually given is, in general terms, that the inspector shall "report to the court upon the facts, and his opinion founded upon them" (c). The court will not allow the inspector to be called as a witness or cross-examined (y).

What evidence sufficient to found inspection in cases of alleged trade secret.

The case of *Brown v. Moore* (z) is important, as showing what evidence is sufficient to found an application for inspection when the defendant's manufacture is alleged to be a trade secret. In that case the plaintiff was the patentee of a machine for making bobbin net; and, suspecting infringement by the defendant, he bought a piece of his net, which, from certain peculiarities in the work, it was sworn by plaintiff's witnesses must have been manufactured by a frame essentially similar to the plaintiff's (a); moreover, certain parts of defendant's machine which had been shown to the plaintiff were exactly similar to the latter's patent machine; and a former partner of the defendant had explained to a witness the construction of the defendant's machine, which, according to that description, was exactly like plaintiff's machine. An *ex parte* injunction having been obtained, a motion to

(s) See order in *Plating Co. v. Farquharson*, Appendix, *post*, Griffin, P. C. 187.

(t) *Hill v. Tombs*, Appendix, *post*. See also an order in *Hall v. New Sidgwick Co.*, M. R. 5 April, 1881.

(u) *Hill v. Tombs*, *ubi supra*.

(x) *Plating Co. v. Farquharson*, Appendix, *post*.

(y) *Plating Co. v. Farquharson*, Griffin, P. C. 187.

(z) 3 Bligh, 178.

(a) See remarks of KAY, J., in *Germ Milling Co. v. Robinson*, 1 R. P. C. 217, 219.

dissolve it was made, but the injunction was continued, the plaintiff being put under terms to bring an action. The action was brought and failed (*b*), partly for want of sufficient proof of the resemblance of the machines. Thereupon an application was made for an issue as to the novelty of the invention. This was refused, but on the plaintiff's undertaking to bring an action against the defendant for infringement, it was ordered (on the undertaking of the defendant) that he should admit on the trial that since the trial of the former action he had made lace with the machines inspected by A. Upon these facts the reporter observes that there had been an inspection of defendant's machines, and that he had been informed by plaintiff's solicitor that such inspection had been made under the order of the court, but he had been unable to find it in the Registrar's book. He mentions, however, a subsequent order for the inspection of a model of the plaintiff's machine.

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NOTE.
Inspection.
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The report of the case cited in Cooper's Reports as *Bovill v. Moore* (*c*) appears, from the dates and other particulars, to refer to the judgment delivered by Lord ELDON on the occasion of the application for the issue, and it would seem most probable that it was on this occasion that the order to which the author of the report in Bligh refers was made. Lord ELDON's judgment, which alone is reported in 2 Cooper, was in the following terms —

“The plaintiff has a patent for a machine used in making bobbin lace. The defendant is a manufacturer of that article, and, as the plaintiff alleges, he is making it with a machine constructed on the principle of the machine protected by the plaintiff's patent. Now, the manufactory of the defendant is carried on in secret. The machine which the defendant uses to make bobbin lace, and which the plaintiff alleges to be a piracy of his invention, is in the defendant's own possession, and no one can have access to it without his permission. The evidence of the piracy at present is the bobbin lace made by the defendant. The witnesses say that this lace must have been manufactured by the plaintiff's machine, or by a machine similar to it in principle. This is obviously in a great measure conjecture. No court can be content with evidence of this description. There must be an order that the plaintiff's witnesses shall be permitted, before the trial of the action, to inspect the defendant's machine, and see it work.”

The court, when it orders inspection, will not stop short of what is necessary to make the jurisdiction effectual, and therefore, in a proper

Samples
 allowed to
 be taken.

(*b*) This seems to be the action reported as *Bovill v. Moore* in Carpmael's Reports, pp. 320, 348.

(*c*) 2 Coop. C. C. 56.

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case, it will give the plaintiff liberty to take and carry away samples of the article the manufacture of which is complained of.

Thus, in *Russell v. Cowley* (*d*) (which, however, appears to have been by consent), the order provided that the viewers should be at liberty to carry away with them any specimen of the tubes operated on by them as they might think proper, in order to their production in court on the trial of the action. And this precedent was followed by Lord HATHERLEY, then Vice-Chancellor, in *The Patent Type Founding Co. v. Walter* (*e*), where, in a suit to restrain infringement of a patent for making type, the substance of the invention being the use of a large proportion of tin to give greater toughness, for which purpose a mixture of antimony and lead, with little or no tin, had been previously employed, the defendants were ordered to permit inspection of their type, and to deliver a competent part to the plaintiffs (*f*).

And this power to order samples to be taken is now expressly conferred by S. C. R. 1883, Order L. r. 3, cited above, p. 246 (*g*).

In *Morgan v. Seaward* (*h*), a case of a patent relating to paddle-wheels, the defendant having entered into a contract to make certain paddle-wheels which plaintiffs alleged were a violation of their patent, it was ordered that the plaintiffs and their witnesses be at liberty to inspect, at all seasonable times, giving reasonable notice, the paddle-wheels or machinery relating to paddle-wheels made, or to be made, pursuant to the said contract.

Reasonable notice to be given.

The order for inspection usually provides for reasonable notice being given to the parties against whom it is made (*i*), and in the case of machinery that the machine be put to work (*k*), and in the presence of persons named in the order (*l*). It has, however, been said that the court has no jurisdiction to order the defendant to work in the plaintiff's presence the machines inspected (*m*).

The number of inspections to be allowed ought to be named in the order (*n*).

(*d*) 1 Webst. 459.

(*e*) Johnson, 727.

(*f*) See also *Davenport v. Jepson*, 1 N. R. 308, where samples of chenille were ordered to be delivered. The orders in both these cases are given in Pemberton, pp. 484, 485.

(*g*) See also *Germ Milling Co. v. Robinson*, 3 R. P. C. 11. The order is printed p. 14.

(*h*) 1 Webst. 169.

(*i*) *Russell v. Cowley*, 1 Webst. P. C. 458; *Davenport v. Jepson*, Pemberton, p. 484; *Flower v. Lloyd*, Seton, p. 561; *Germ Milling Co. v. Robinson*, *ubi supra*.

(*k*) *Russell v. Cowley*, 1 Webst. P. C. 458; *Beardsell v. Schwann*, Seton, 3rd ed. p. 910; *Davenport v. Jepson*, Seton, 5th ed. p. 554; Pemberton, p. 484; *Morgan v. Fuller*, Seton, p. 555; *Bovill v. Moore*, 2 Coop. C. C. 56; *Germ Milling Co. v. Robinson*, 3 R. P. C. 11.

(*l*) *Russell v. Cowley*, 1 Webst. 458.

(*m*) *Drake v. Muntz's Metal Co.*, 3 R. P. C. 43.

(*n*) *Heathfield v. Braby*, Seton, p. 561. See, however, the order in *Germ Milling Co. v. Robinson*, *ubi supra*.

In *Russell v. Cowley* (o), the order provided for inspection of the plaintiff's machine by defendant, as well as for the inspection by the plaintiff of the machine of the defendant. This order was by consent. A similar course was pursued in *Davenport v. Jepson* (p). It does not appear from the report whether or not that order was by consent, but in *Germ Milling Co. v. Robinson* (q) an adverse order for inspection of the plaintiff's machine was made at the instance of the defendant, upon the ground that, looking to the nature of the patent and the questions at issue, the court would very probably be under some disadvantage if it had not very complete evidence as to the process which the plaintiff actually carried out under the patent, and also and mainly upon the question whether, in point of fact, what the defendants were doing was an infringement, and upon the further ground that inspection might materially assist the defendants in contesting the latter question. See also the judgments in *Brown v. Moore* (r) and *The Patent Type Founding Co. v. Walter* (s), where it is stated that the inspection is for the purpose of enabling the court to have the case properly tried, and to assist the court in forming a right conclusion at the trial. A plaintiff, however, cannot, in an action for infringement, be compelled to produce a specimen of the patent article to enable the defendant to prepare his defence (t).

It has been held that the court does not direct a forcible inspection. The usual form of an order was only to permit inspection; obedience could be enforced only by the ordinary process of contempt (u). But now, by S. C. R. 1883, Order L. r. 3, cited above (p. 246), the court may authorize any person, for the purpose of inspection, to enter any land or building in the possession of any party.

The inspection might, under the old practice, be ordered at common law before the delivery of the pleadings in the action (x). And where a plaintiff, on the application of the defendant, was ordered to deliver better particulars of breaches, the plaintiff was allowed to inspect the machines at the defendant's factory, and to examine the defendant *viva voce* (y). And now, by S. C. R. 1883, Order L. r. 3, cited above, it would seem that an order for inspection may be made at any stage of the action. "The court or a judge" being empowered to grant

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NOTE.

Inspection.

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Inspection by
defendant of
plaintiff's
machines.

(o) 1 Webst. P. C. 459.

(p) Pemberton, p. 484; S. C. 1 N. R. 308. See also *Russell v. Crichton*, 15 Dec. of Court of Session, p. 1270.(q) 3 R. P. C. 11. See also *Cheatham v. Oldham* (2), 5 R. P. C. 622; *Rylands v. Ashley's etc. Co.* 7 R. P. C. 175.

(r) 2 Coop. C. C. 56, cited above.

(s) Johnson, 728.

(t) *Crofts v. Peach*, 1 Webst. P. C. 268.(u) *East India Co. v. Kynaston*, 3 Bligh, 153, 163, 166.(x) *Amies v. Kelsey*, 22 L. J. (N.S.) Q. B. 84.(y) *Jones v. Lee*, 25 L. J. (N.S.) Ex. 241.

Sect. 30. inspection, the order may be made either on motion in court or on summons at chambers (*z*), subject, however, in the Chancery Division, to the provisions of Order LV. r. 15, and in the Queen's Bench Division to the provisions of Order LIV. r. 12.

NOTE.
Inspection.
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As to the proceedings on applying for inspection, see S. C. R. 1883, Order L. r. 6.

The machines inspected may be ordered to be produced on any examination of witnesses in the action (*a*).

Delay no bar
to inspection.

We have seen that undue delay is a bar to an application for an interlocutory injunction. In *The Patent Type Founding Co. v. Walter* (*b*) it was urged that such delay would be likewise a bar to a motion for inspection, on the ground that the inspection could be of no use for the injunction, as that could not be granted by reason of the *laches*, and it was too soon to ask for inspection for evidence for the hearing, because the cause was not at issue. But Sir W. P. WOOD, V.-C., after citing the rule laid down by Lord COTTENHAM in *Bacon v. Jones* (*c*), to the effect that a plaintiff ought, in a patent case, to bring his cause to a hearing in a state in which the court can adjudicate upon it, held that the delay was no bar to the inspection, and that it was reasonable and right for a plaintiff to come on an interlocutory motion and ask inspection, with a view to assist the court in arriving at a right conclusion at the hearing.

Upon an application for inspection the court will not consider the question of disconformity of the provisional and complete specification (*d*).

DISCOVERY.

By S. C. R. 1883, Order XXXI. r. 1, the plaintiff or defendant may in every cause or matter (other than certain specified actions which do not include patent actions), by leave of the court or a judge, deliver interrogatories in writing for the examination of the opposite parties, or any one or more of such parties. These rules apply to patent actions, notwithstanding particulars have been delivered in compliance with the statutory requirements (*e*).

On applying for such leave it is sufficient to state the general scope and object of the interrogatories (*f*), and the judge will not decide as

(*z*) Judicature Act, 1873, s. 39 ;
Frearson v. Lee, 26 W. R. 138.

(*a*) *Drake v. Muntz's Metal Co.*, 3
R. P. C. 43, 44.

(*b*) *Johnson*, 728.

(*c*) 4 My. & Cr. 433.

(*d*) *Cheetham v. Oldham* (1), 5
R. P. C. 617.

(*e*) *Birch v. Mather*, 22 Ch. D.
629. See also *Haddan's Patent*, 54
L. J. Ch. (N.S.) 126.

(*f*) *Hall v. Liardet*, W. N. 1883,
165.

to the relevancy of particular interrogatories (*g*). The costs of discovery by interrogatories or otherwise must be secured by the party seeking discovery (*h*).

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NOTE.
Discovery

The Rules of the Court of Chancery as to discovery (which rules regulated the discovery to be obtained under the Judicature Rules (*i*), for which the Supreme Court Rules, 1883, are now substituted) were thus stated by Lord ROMILLY, M.R. :—

Discovery
under old
practice.

“A fundamental principle is to be found in all the decisions on this point, which is usually thus stated : that a defendant who submits to answer must answer fully (*k*). That is, that if a *prima facie* case for relief be made by the bill, calling for an answer, the defendant may, if the circumstances of the case will permit it, bring forward any fact or series of facts, by way of plea, to dispute the right of the plaintiff to call upon him to answer either the whole bill or some particular portion of it ; but that if he be unable or decline to adopt this course, he must, technically and categorically, answer every statement in the bill to which he is interrogated which can assist the plaintiff in making out his title to relief” (*l*).

In accordance with this principle, the defendant, in a suit to restrain infringement of a patent, is bound, if the infringement be denied, to set forth in his answer to the full extent of the interrogatories everything showing or merely tending to show the fact of infringement (*m*). Thus, where the defendant was charged with infringing a patent for making an aniline dye, it was held that he was bound to answer whether he used the ingredients mentioned in the plaintiff’s specification, whether he added anything else, and whether the additions made any difference in the process (*n*). And, speaking generally, the plaintiff in an action for infringement is entitled to specific answers to specific interrogatories, taking the claims of the specification step by step (*o*). And the rule is the same in actions against a licensee (*p*).

Defendant
must answer
everything
tending to
show fact of
infringement.

(*g*) *Hall v. Liardet* (No. 2), W. N. 1883, 175 ; corrected, *ibid.* 194.

(*h*) Supreme Court Rules, 1883, Order XXXI. rr. 25 to 27.

(*i*) *Anderson v. Bank of British Columbia*, 2 Ch. D. 644 ; *Saunders v. Jones*, 7 Ch. D. 435 ; *Att.-Gen. v. Gaskill*, 20 Ch. D. 519.

(*k*) See now, however, Supreme Court Rules, 1883, Order XXXI. r. 20, and observations of CHITTY, J., in *Lister v. Norton*, 2 R. P. C. 69 ; *post*, p. 295.

(*l*) *Per* Lord ROMILLY, M.R., *Swinborne v. Nelson*, 16 Bea. 416, 417.

See also *Elmer v. Creasy*, L. R. 9 Ch. 69 ; *Saull v. Browne*, L. R. 9 Ch. 364.

(*m*) *De la Rue v. Dickinson*, 3 K. & J. 388, 391 ; *Lister v. Norton*, 2 R. P. C. 68.

(*n*) *Renard v. Levinstein*, 10 L. T. (S.S.) 94. See also *Rolls v. Isaacs*, W. N. 1878, 37.

(*o*) *Benno Jaffé v. Richardson*, 10 R. P. C. 136. See also *Badische Anilin etc., Fabrik v. Levinstein*, 29 Ch. D. 366, 395.

(*p*) *Ashworth v. Roberts*, 45 Ch. D. 623.

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And where a plaintiff had filed several bills against previous infringers, and had succeeded in such suits, it was held that in a subsequent suit the defendant might be required to state whether his process was the same as that used by some one who had been a defendant in one of the former suits (*q*).

And in a suit against defendants, who were alleged to be selling, under the names "Nelson's Patent Refined Isinglass," and "Nelson's Gelatine Isinglass," articles made in infringement of the patent, but who denied infringement, the defendants were compelled to answer questions as to when they first manufactured, and to whom by name they first sold, any and what quantity of the articles sold by them under the above names, and what were the processes of manufacture. They were also compelled to set forth an account of all articles manufactured and sold by them since the date of the specification under the name of "Nelson's Gelatine Isinglass," etc., and the quantities thereof respectively, and the names and addresses of the persons to whom sold, and at what prices, and the profits which the defendants had realized thereby (*r*).

Names of
customers
required.

In *Tetley v. Easton* (*s*), which was an action at common law, it was said that if the infringement was admitted, the plaintiff was entitled to an answer to interrogatories asking the names and addresses of the persons to whom the defendant's machines had been sold, and a motion to strike out these interrogatories was refused.

So, also, where the bill alleged that the defendant had sold looms made in violation of a patent, and had received royalties for their use, and the defendant had, in answer to interrogatories, set forth the names and addresses of the persons, resident in England, from whom such royalties were received, he was ordered further to set forth the names and addresses of persons, resident abroad, from whom royalties had been received, in respect of machines made in England, on the ground that the answer might lead to very important discoveries as to the infringement (*t*).

A defendant was not allowed to refuse to answer an interrogatory as to the names of his customers merely on the ground that they might thereby be exposed to actions (*u*). And where a number of persons

(*q*) *Borill v. Smith*, L. R. 2 Eq. 459, 461.

(*r*) *Swinborne v. Nelson*, 16 Bea. 416. This decision as to profits is at variance with the decision in *De la Rue v. Dickinson*, 3 K. & J. 388, cited below. From statements of counsel in the latter case, it appears that *Swinborne v. Nelson* was appealed.

(*s*) 18 C. B. 643.

(*t*) *Crossley v. Stewart*, 1 N. R. 436; S. C. 7 L. T. (N.S.) 848. And see further, *Leather Cloth Co. v. Hirschfield*, L. R. 1 Eq. 299; *Darropport v. Rylands*, L. R. 1 Eq. 302, 308.

(*u*) *Tetley v. Easton*, 18 C. B. 643. See also *Howe v. McKernan*, 30 Bea. 549.

had formed themselves into an association for the purpose of supporting each other against a patentee seeking to restrain them from infringing his patent, it was held that a member of the association against whom the patentee had filed a bill must give the names of the members of the association, but that he was not bound to disclose its proceedings unless they were shown to be connected with the matters in question in the suit (*x*).

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But the rule that a defendant who elects to answer must answer fully has been dispensed with where it has been seen plainly that the point raised is one which must be determined at the hearing, and that the discovery will be unnecessary for the purpose of the hearing, and useless if the decision be in one way (*y*).

Limits of rule as to answering fully.

Thus, in the case of *De la Rue v. Dickinson* (*z*), which was a suit to restrain infringement of a patent for the manufacture of envelopes by machinery, the plaintiff required the defendants to set out an account of machines in their possession, and a discovery from whom the same were procured, and whether they were purchased or hired, and, if purchased, the consideration of the purchase; an account of envelopes manufactured by any machine used by the defendants, and discovery of the persons to whom such had been sold; also accounts of the sales of such envelopes, the profits made by defendants, the stock in hand of such envelopes, and an account of moneys received by and due to the defendants for such envelopes. Lord HATHERLEY, when V.-C., refused to enforce an answer to these interrogatories, observing that they assumed the fact of infringement, and would be obtained under the decree at the hearing, as a matter of course, provided the fact of infringement were then established, while, on the other hand, if the fact were not established at the hearing, the discovery required would be utterly immaterial (*a*).

Defendant not bound to answer questions which assume infringement.

And in *Moore v. Craven* (*b*) it was laid down by Lord HATHERLEY, C., that although, where discovery is a matter of indifference to the defendant, the court does not weigh in golden scales the question of materiality or immateriality, still, where the nature of the discovery required is such that the giving of it may be prejudicial to the defendant, the court takes into consideration the special circumstances of the case; and whilst on the one hand it takes care that the plaintiff

(*x*) *Bovill v. Cowan*, W. N. 1867, 115.

(*y*) Per Lord HATHERLEY when V.-C., *Swabey v. Sutton*, 1 H. & M. 514, 516.

(*z*) *De la Rue v. Dickinson*, 3 K. & J. 388. Compare *Elmer v. Creasy*,

L. R. 9 Ch. 69, 73; and see now *Parker v. Wells*, 18 Ch. D. 477; *Fennessy v. Clark*, 37 Ch. D. 184.

(*a*) See also *Lea v. Saaby*, 32 L. T. (N.S.) 731; and Supreme Court Rules, 1883, Ord. XXXI. r. 6.

(*b*) L. R. 7 Ch. 94, 96, n.

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obtains all the discovery which can be of use to him, on the other it is bound to protect the defendant against undue inquisition into his affairs.

What
discovery
refused.

Therefore, in a suit to restrain infringement of a patent for making dyes, where the interrogatories, after requiring the defendant to set forth the particulars of various ingredients therein named, which particulars the defendant did set out in his answer, also required him to state the name and address of each person who sold, and each person who delivered, each of the said ingredients at the defendant's premises, and the sum paid by him and any agent or clerk of his, and the use the defendant had made of each of the substances, and fully to account for each packet and parcel of the same, and the application, use, and disposal thereof, and the defendant declined to answer the latter part of the interrogatory, exceptions to the answer were overruled (c).

And the defendants to a suit charging infringement of a patent for making cartridges were held entitled to refuse to state the size of the wire used by them in making their cartridges, and the names of the persons from whom, and the places from which, they had purchased their wire (d).

And where a patentee of a new material for protecting stone, wood, and the like, sought to restrain infringement by the defendants, who used under their own patent a liquid in which the resinous part of gum euphorbia was employed, and required the defendants to state whether they used a composition in which euphorbia gum was an ingredient, and "not being a composition prepared exactly in accordance with their own specification," and if so to set forth the ingredients of such composition, an objection to the interrogatory was allowed (e).

So, also, in *Crossley v. Stewart* (f), the defendant was not required to set out the names and addresses of persons resident *abroad* to whom he had sold looms manufactured *abroad* in alleged infringement of plaintiff's patent.

And in *Rolls v. Isaacs*, cited above, the defendants were held to be not bound to answer an interrogatory asking not merely as to certain vessels mentioned in the particulars of breaches, but also as to the names and owners of the ships to which the defendants had, since the date of plaintiff's patent, applied any composition in which euphorbia gum was an ingredient, and requiring them to state how and in what

(c) *Simpson v. Charlesworth*, W. N. 1866, 255.

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

(e) *Rolls v. Isaacs*, W. N. 1878, 37.

(f) 1 N. R. 436; S. C. 7 L. T. (N.S.) 848.

manner the gum entered into the composition, and when and by whom the same was manufactured, and by whom applied or used.

The plaintiff is not entitled by interrogatories to get at the names of defendant's witnesses, or to inquire into defendant's case merely for the purpose of finding out how the defendant intends to prove it (*g*).

The principle laid down in *Moore v. Craven* was cited with approval by the Lords Justices in the case of *Carver v. Pinto Leite* (*h*), where the court refused to compel a defendant in a suit to restrain infringement of trade mark to disclose the names of his customers, or the prices at which the goods marked with the mark complained of had been sold to them or bought from anybody else.

But where ship-owners had shipped goods bearing counterfeits of the plaintiffs' trade marks, it was held that an action would lie against them for discovery of the names of the consignors of the goods, on the ground that the plaintiffs could not otherwise know who were the invaders of their right (*i*).

The right to discovery is now, however, subject to S. C. R. 1883, Ord. XXXI. r. 20, under which, if the party from whom the discovery is sought objects to the same, the court or a judge may, if satisfied that the right to discovery depends on the determination of any issue or question in dispute in the cause, or that for any other reason it is desirable that any issue or question in dispute in the cause should be determined before the right to the discovery, order that such issue or question be determined first, and reserve the question as to the discovery. Under this rule (which has limited to a considerable extent the old rule that a defendant answering must answer fully (*k*)), it was held that, where discovery cannot possibly help the plaintiff to obtain a decree, and will only be of use to him if he obtains a decree, the court has a discretion as to whether it will order it to be given before decree, and will not do so if to compel it would be oppressive (*l*).

And accordingly, in *Lister v. Norton* (*m*), it was held that if the defendant would admit infringement, he also admitting sales which in the event of plaintiff succeeding would give a right to damages or an account, he need not answer interrogatories as to sales to particular named customers; but that if he did not admit infringement the interrogatories must be answered. An admission of infringement contained in an affidavit filed by the secretary of a defendant company

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Discovery of sales to named customers.

(*g*) *Daw v. Eloy*, 2 H. & M. 730, 731.

(*h*) L. R. 7 Ch. 90, 97.

(*i*) *Orr v. Diaper*, 4 Ch. D. 92.

(*k*) See *per* CHITTY, J., *Lister v. Norton*, 2 R. P. C. 69.

(*l*) *Parker v. Wells*, 18 Ch. D. 477. See also *Fennessy v. Clark*, 37 Ch. D. 184. Also observations of BOWEN, L.J. on this rule, *Rawes v. Chance*, 7 R. P. C. 275.

(*m*) 2 R. P. C. 68.

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in answer to interrogatories is not a sufficient admission to enable the court to dispense with an answer to an interrogatory asking as to sales to particular customers (*n*).

And in an action against a licensee for an account, the names of customers were ordered to be given (*o*).

Where it was not clear that the production of the defendant's books, containing analyses of the materials operated on in his process, was necessary to enable the plaintiff to prove either the validity of the patent or infringement, production was refused without prejudice to any application which the plaintiff might make during the trial (*p*).

It is very often right that the plaintiff should not be allowed to see his opponent's books under colour of trying to find out whether he is infringing a patent which is disputed. The defendant is justified in saying "Prove your patent first" (*q*). But a defendant in an action for infringement cannot refuse to answer interrogatories as to his process, framed on the lines of the allegations in plaintiff's specification, on the ground that till the validity of the patent is established the discovery is not material (*r*).

Where a defendant, being required to state whether he was not making water-gauges identical with those patented by the plaintiff, and to set forth in what particulars they differed from those of the plaintiff, stated that he had for many years before the date of the patent applied to water-gauges the same mode of treatment as that described in the plaintiff's specification, and that he now made water-gauges which, save so far as his own method or process adopted before the patent was similar to that described in the plaintiff's specification, differed from the water-gauges there described, but that it was impossible, without ocular demonstration, to show in what they differed, the answer was held sufficient (*s*).

Communica-
tions with
patent agents
not privi-
leged.

Communications with a patent agent are not privileged, and therefore when plaintiff's solicitor was also a patent agent, and the plaintiff resisted the production of documents as being confidential communications between himself and his solicitor, he was ordered to make a further affidavit, and it was held that he was bound to distinguish between communications made to the solicitor in his character of solicitor and communications made to him in his character of patent agent (*t*).

(*n*) *Lister v. Norton, ubi supra.*

(*o*) *Ashworth v. Roberts*, 45 Ch. D. 623; 7 R. P. C. 451.

(*p*) *Rawes v. Chance, ubi supra.*

(*q*) *Ibid.*, 281.

(*r*) *Benno Jaffé v. Richardson*, 10 R. P. C. 136.

(*s*) *Crossley v. Tomey*, 2 Ch. D. 533. See *Smith v. London & G. W. Rail. Co.*, Macr. P. C. 227; S. C. 6 E. & B. 405, where, after a similar answer, inspection was ordered.

(*t*) *Moseley v. Victoria Rubber Co.*, 3 R. P. C. 351.

Where an action was commenced on two cognate patents, both taken out by the plaintiff in two successive years, and the plaintiff discontinued as to one of the patents, it was held that he was nevertheless bound to answer interrogatories relating to communications as to that patent between the plaintiff and his patent agent (*u*).

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The principle of *De la Rue v. Dickinson* will not extend to excuse defendants from answering fully on the ground that, if the plaintiff fails in proving the validity of the patent, such answers will be useless to him; and therefore, where defendants to numerous separate bills filed by a patentee moved before answer to consolidate the suits and to try the question of the validity of the patent in one suit, they undertaking to be bound by that decision, but not undertaking to be bound as to the infringement, it was held that the application was premature, and the defendants could not be absolved from giving discovery, but without prejudice to any proceedings for consolidating the suits after answer (*x*).

If the plaintiff be otherwise entitled to discovery, the mere fact that the disclosure asked may, if given, make the plaintiff acquainted with the defendant's trade secrets has been said to be no ground for refusing it. The court will be able at the proper time to protect the defendant from any improper disclosure of his secret. If the defendant in such a case might say, "I deny any infringement; I will give you no further discovery," there would be no use in filing a bill at all (*y*). Trade secrets.

The court will not carry the discovery further than is necessary for enabling the plaintiff to establish his case; and therefore, in *Renard v. Levinstein* (*z*), although the defendant was compelled to answer whether he used the ingredients mentioned in the specification, whether he added anything else, and whether the addition made any difference, he was not compelled to disclose in what proportions he used the specified materials, or the nature and quantities of the addition. Discovery not enforced beyond what necessary to prove plaintiff's case.

This was a case of alleged infringement of a patent for making a dye, and the plaintiff's specification described the invention as consisting in boiling a mixture of red aniline dye and aniline with hydrochloric acid and water. Interrogatories were delivered requiring the defendant to state:—

Whether he used in his process the red aniline dye of commerce or red aniline dye in some and what form or some and what substances

(*u*) *Moseley v. Victoria Rubber Co.*, 3 R. P. C. 351.

(*x*) *Foxwell v. Webster*, 3 N. R. 193; 2 Dr. & Sm. 250; 4 D. J. & S. 77, 81. See also *Benno Jaffé v. Richardson*, 10 R. P. C. 136.

(*y*) Per Lord HATHERLEY, C., *Renard v. Levinstein*, 10 L. T. (N.S.) 94. *Ashworth v. Roberts*, 45 Ch. D. 623.

(*z*) 10 L. T. (N.S.) 94.

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combined which in combination form or are the chemical equivalents of red aniline dye.

Whether the defendant used in his said process aniline or some and what chemical equivalent to aniline.

On exceptions to the answer the defendant was not compelled to answer the parts of the above questions printed in italics (a).

And where, in an action for infringement of a patent, the only plea was that the plaintiff was not the true and first inventor, it was held, that the defendant need not answer interrogatories as to the inaccuracy of the specification or the novelty of the process, or the question of infringement (b).

So, also, a plaintiff who had not made his election between damages and account of profits, was held not entitled, before he had succeeded in the action, to discovery of the sales effected by the defendant, and production of defendant's books for that purpose (c).

Secret process.

And a defendant was allowed to refuse in cross-examination to answer questions tending to disclose his alleged secret process, but the court having during the arguments formed an opinion that the plaintiff's patent was valid, gave leave to the defendant to describe his secret process if he should think fit to do so, in order that the court might come to a conclusion on the question of infringement; and the defendant having elected to disclose his secret process, the hearing of the evidence and arguments was continued *in camera*, and the shorthand notes, which would disclose the secret process, were directed to be impounded in court (d).

Interrogatories as to prior user, notwithstanding particulars of objections delivered.

A defendant may be compelled to answer interrogatories requiring particulars of the prior user alleged by him (e), and this even though particulars of objections literally complying with the statutory requirements have been delivered (f).

And where defendant by his objections alleged "manufacture and sale by white lead manufacturers generally, in London and the vicinity" over a named period, it was held that he was bound to answer interrogatories asking for the names and addresses of such manufacturers and the places and dates of user (g).

(a) *Renard v. Levinstein*, 3 N. R. 665.

(b) *Young v. White*, 17 Beav. 532.

(c) *Fennessy v. Clark*, 37 Ch. D. 184.

(d) *Badische Anilin und Soda Fabrik v. Lorenstein*, 24 Ch. D. 156, 158.

(e) *Finnegan v. James*, L. R. 19 Eq. 72; *Crossley v. Tomey*, 2 Cl. D.

533; *Saunders v. Jones*, 7 Ch. D. 449 (per JAMES, I.J.), contrary to what was formerly held; *Daw v. Eley*, 2 H. & M. 725; *Borill v. Smith*, L. R. 2 Eq. 459.

(f) *Birch v. Mather*, 22 Ch. D. 629.

(g) *Alliance Pure White Lead Syndicate v. MacIvor's Patents*, 8 R. P. C. 321.

But a plaintiff cannot require a defendant to state the names of the persons to whom the defendant alleges he sold articles similar to the patented article before the date of the patent. Such a question is a mere fishing question to help the plaintiff to get at the defendant's witnesses and see what he can make of them (*h*). Nor can a defendant be required to set forth a description of all machines similar to plaintiff's made or used by him prior to the patent (*i*), but he may be asked whether the machines mentioned in his objections are in existence, and the names and addresses of the alleged prior users (*k*). As to the right to production of articles alleged as prior user, see cases cited *ante*, p. 284.

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Limits of the discovery.

A plaintiff is not allowed to put interrogatories depending on the construction of the patent (*l*).

The Merchandise Marks Act, 1887 (*m*), contains various provisions making the forging or false application of trade marks, etc., criminal offences, but the Act does not exempt any person from any action which might otherwise be brought against him or entitle him to refuse to make a complete discovery or to answer any question or interrogatory in any action. Such discovery or answer, however, is not to be evidence against such person in any prosecution under the Act (*n*).

In *Hoffmann v. Postill* (*o*), it was said that interrogatories delivered by a defendant for the examination of a plaintiff are on a different footing from those for the examination of a defendant, in this respect, that a plaintiff is not entitled to a discovery of the defendant's case, but the defendant may ask questions tending to destroy the plaintiff's claim (*p*).

Interrogatories for examination of plaintiff.

A plaintiff may be compelled to answer interrogatories as to his specification, and therefore the plaintiffs, owners of a patent for making blue and violet dye, were compelled to answer interrogatories administered by the defendant, asking in effect—

Interrogatories as to plaintiff's specification.

Whether it was not the fact that no true or pure blue could be produced according to the specification?

Whether they had not in their own manufacture added materials not mentioned in their specification?

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

(*i*) *Daw v. Eley*, cited above; and see *Delta Metal Co., v. Maxim-Nordenfelt, etc., Co.*, 8 R. P. C. 169.

(*k*) *Birch v. Mather*, 22 Ch. D. 629.

(*l*) *Delta Metal Co. v. Maxim-Nordenfelt, etc., Co.*, *ubi supra*.

(*m*) 50 & 51 Vict. c 28.

(*n*) Section 19.

(*o*) L. R. 4 Ch. 673.

(*p*) As to this case, see observations of KAY, J., *Bidder v. Bridges*, 29 Ch. D. 29. See also *Minet v. Morgan*, L. R. 8 Ch. 361, 364; *Commissioners of Sewers v. Glasse*, L. R. 15 Eq. 302; *Benbow v. Low*, 16 Ch. D. 98.

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Whether they had not wholly or to some extent abandoned making blue dyes strictly according to their patented process; and what quantity of blue dye made strictly according to the specification had been made and sold by them, as compared with the quantity not so made?

What was the chemical composition of the substance known at the date of the patent as "red aniline dye," mentioned in the specification?

Exceptions to an answer refusing to answer these questions were allowed, the defence being that the specification was insufficient, and that the invention as therein described was not useful (*q*).

To questions—

What was the meaning of an expression, "the acid being mixed with a large quantity of water"?

What was the proportion of water to hydrochloric acid used in the mixture for violet dye? Would any proportion of water to acid be sufficient, and what was the strength of the acid? State the lowest and greatest proportions respectively of water to be used in making the mixture. Would any proportion do?

What was the meaning of "hydrochloric acid of commercial strength"? What was that strength, and did not hydrochloric acid as sold in commerce vary much in strength, and what were the limits of such variation?

The plaintiffs put in an answer, submitting to the court, as a question of construction, what the words "acid being mixed with a large quantity of water" meant, and as to what was the proportion of water to hydrochloric acid used in the mixture for violet dye, as mentioned in the specification. They said the proportion was that described in the specification, and that they submitted to the court as a question of construction, and (save as aforesaid) they declined to answer the interrogatory, except by stating what they believed to be the specific gravity of the hydrochloric acid of commerce.

To this answer exceptions were taken, and Lord HATHERLEY, then V.-C.; said that the exceptions related to plain matters of fact as to which the plaintiffs were bound to answer. They were not bound to answer as to the intentions of the patentee, but those who practise an invention are bound to say what they do themselves. They must state the proportions they use. They must also state of their own knowledge the variations of strength of the acid (*r*).

(*q*) *Renard v. Levinstein*, 11 L. T. (N.S.) 79. See also *Few v. Guppy*, 1 My. & Cr. 509.

(*r*) *Renard v. Levinstein*, *ubi supra*.

So also, in *Hoffmann v. Postill*, cited above, exceptions were allowed to an answer by which the plaintiff refused to answer questions as to certain improvements described in specifications prior to plaintiff's specification, and requiring him to point out the difference between those improvements and the invention comprised in the plaintiff's patent.

An interrogatory whether the patentee has not found it necessary to introduce modifications into his process in order to enable the article to be successfully manufactured thereby for commercial purposes, is relevant to the issue of utility and must be answered (s).

And in a trade mark case, where the plaintiff alleged that the defendant's user of his trade mark was calculated to induce, and had, in fact, induced, divers persons to purchase his goods as the goods of the plaintiff, the defendant was held entitled to discovery of the names and addresses of such persons, notwithstanding they might be called at the trial as witnesses on the part of the plaintiff (t).

When the particulars of breaches are sufficient, and the plaintiff in his answer pledges his oath to their correctness, he will not be compelled to answer further questions as to the particulars of infringement (u).

And where defendant had, in answer to interrogatories, stated his process in detail, and afterwards delivered to plaintiff interrogatories requiring him to refer to defendant's answer, and show by reference to page and line which parts of plaintiff's specification were thereby infringed, it was held that plaintiff was not bound to answer this interrogatory (x).

And where an interrogatory referred to the defendant's instrument, and asked in what particulars it was identical with or a colourable imitation of the instrument described in the claim of plaintiff's specification with reference to five different specified heads, and required the plaintiff to state which of these heads he considered to be new, and which he admitted to be old, and to state which portions of the combination of the defendant's instrument plaintiff alleged to be infringements of his first claim, it was held that an answer that the several heads were, as to some (which were named), entirely new in form and arrangement, and as to another, new in a particular pointed out, was sufficient, the plaintiff having delivered particulars of breaches which were, with a slight alteration now made by consent, sufficient in form, and which referred to a particular instrument as an infringement (y).

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Interrogatories by defendant as to infringement.

(s) *Rylands v. Ashley's, etc., Co.*, 7 R. P. C. 175.

(t) *Humphries v. Taylor Drug Co.*, 39 Ch. D. 693.

(u) *Hoffmann v. Postill*, L. R. 4 Ch. 673, 679.

(x) *Moseley v. Victoria Rubber Co.*, 3 R. P. C. 351.

(y) *Ehrlich v. Inlee*, 5 R. P. C. 37.

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A plaintiff need not answer matters which are clearly immaterial to the defendant's case, and, therefore, it was held that the plaintiffs need not set forth the particulars of certain legal proceedings which had taken place in Saxony against infringers of their patent, which proceedings the defendant alleged had been unsuccessful (z).

An interrogatory by defendant in an action for infringement of a patent for a mechanical musical instrument, in which rotative perforated discs were used for actuating the levers by which the reeds were sounded, asking whether it was not the fact that the plaintiff's instrument could only play a short tune, and would continue repeating the same tune till the disc containing it was removed, while, if they were provided with an endless band, the performance might be extended to a long composition; and an interrogatory requiring the plaintiff to state in which particulars he considered the perforated rotative disc to be superior to endless bands in the plaintiff's instrument, or in endless band instruments, were held not sufficiently relevant (a).

Interrogatories as to documents.

By S. C. R. 1883, Order XXXI. r. 12, any party may apply for an order directing any other party to any cause or matter to make discovery on oath of the documents in his possession or power, relating to any matter in question therein. And on the hearing of such application the court or a judge may either refuse or adjourn the same or make such order, either generally or limited to certain classes of documents, as may be thought fit (b).

Where the affidavit of documents is sufficient, a general roving interrogatory as to documents will not be allowed, but interrogatories may, with leave of court, be administered, directed to specific documents which the party interrogating has reason to suppose are in the possession of the party giving discovery, and which have not been disclosed (c); but it is doubtful whether an affidavit as to the existence and nature of such documents is admissible (d).

Where plaintiff has made a sufficient affidavit of documents, and the defendant desires to administer interrogatories as to particular documents, the court may require an affidavit that the application is not for vexation or delay (e).

A contentious affidavit to show that the affidavit of documents is insufficient will not be admitted (f). But under Order XXXI. r. 18,

(z) *Hoffmann v. Postill*, L. R. 4 Ch. 673; and see Supreme Court Rules, 1883, Ord. XXXI. r. 6.

(a) *Ehrlich v. Ihlee*, 5 R. P. C. 37.

(b) As to this rule see *Downing v. Palmouth Board*, 37 Ch. D. 234.

(c) *Edison, etc. Co. v. Holland*, 5 R. P. C. 216; *Hall v. Truman, Han-*

bury & Co., 29 Ch. D. 307; and see S. C. R. Order XXXI. r. 19a.

(d) *Edison, etc. Co. v. Holland*, *ubi supra*.

(e) *Ibid*.

(f) *Jones v. Monte Video Gas Co.*, 5 Q. B. D. 556, 558; *Morris v. Edwards*, 37 W. R. 721; 23 Q. B. D.

upon an affidavit specifying the documents of which inspection is asked, and stating they are in the opposite party's possession, the court may order inspection, even though they have not been disclosed in the affidavit of documents (*g*). Where a patent had been the subject of litigation between two companies, who afterwards compromised the action, and joined as co-plaintiffs in an action for infringement against a third person, it was held that the defendant in the latter action was entitled to administer interrogatories with reference to the particulars of objections delivered in the first action by one of the new co-plaintiffs, but which had not been referred to in the affidavit of documents in the present action (*h*).

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NOTE.

Discovery.

When it appears probable from a document produced by a plaintiff or defendant that he has in his possession relevant documents besides those which are scheduled to his affidavit of documents, the proper course is to make an order calling upon him to make a further and better affidavit, and in particular to state whether he has not in his possession those documents which, from what has been said by him on affidavit, or from the documents he has produced, in all probability are in his possession. And a plaintiff who had, in an affidavit made in the present action, referred to certain affidavits made in a previous action on the same patent against another defendant, and omitted these latter from his schedule of documents, was ordered to make a further affidavit with especial reference to the affidavits in the first action (*i*).

Further affidavit of documents, when required.

Where a defendant company had been warned by a plaintiff that he considered they were infringing his patent, but there was no threat of litigation, and the company obtained from their officers reports and letters as to the alleged infringement, it was held in an action which was subsequently commenced that these reports and letters were not privileged, and production of them was enforced (*k*).

Reports, etc., obtained by defendant as to infringements.

And where, before purchasing the patent, the plaintiffs had contested, or made preparations for contesting, the patent in various legal proceedings, the documents relating to which were scheduled to their affidavit of documents, and included reports from witnesses and scientific advisers, it was held, on an application by the defendant for production, that the plaintiffs were bound to produce all the documents,

287; affirmed H. L., 15 App. Cas. 309.

(*g*) *Wiedeman v. Walpole*, 24 Q. B. D. 537; reversed on the facts without giving an opinion as to the law, *ibid*, 626.

(*h*) *Edison, etc., Co. v. Holland*, *ubi supra*.

(*i*) *Bown v. Sansom*, 5 R. P. C. 510. See also *Jones v. Monte Video Gas Co.*, 5 Q. B. D. 556. And see S. C. R. Order 31, r. 19*a*.

(*k*) *Westinghouse v. Midland Rail. Co.*, 48 L. T. (N.S.) 98; affirmed, *ibid*. 462.

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except such as they should state on oath came into existence merely to be communicated to their solicitor for the purpose of litigation, actual or intended, and either as materials for briefs or for his advice or consideration (*l*).

ACCOUNT AND DAMAGES.

Account in
Court of
Chancery.

The Court of Chancery, in addition to granting an injunction restraining infringement of a patent, was accustomed (although before Lord Cairns' Act unable to give damages) to grant the further relief of an account of profits, in order that the remedy might be complete (*m*). But if the plaintiff was not entitled to an injunction, as, for instance, if the patent had expired before (*n*), or during (*o*), the litigation, the account could not be granted unless in cases of fraud (*p*).

After Lord Cairns' Act it was held that, although the patent had expired pending the litigation, so that there could be no injunction, the plaintiff might have damages, though he could not have an account (*q*), but not if the bill were filed immediately before the expiration of the patent, and no application for an injunction was made (*r*).

May now be
had in all
Divisions of
the High
Court

Now, however, that all the jurisdiction exercised by the old Courts of Chancery and Common Law is, by the Judicature Act, 1873, s. 16, transferred to the High Court of Justice, these questions cannot arise, and an account may be had in any Division of the Court (*s*), and every Division may grant damages for infringement, and this whether the action be commenced before or after the expiration of the patent.

Plaintiff
cannot have
both account
of profits and
damages.

It is now settled, in opposition to earlier cases (*t*), that a plaintiff must elect between an account of profits or damages, and that he cannot have both: "The two things are hardly reconcilable, for if you take an

(*l*) *Haslam Co. v. Hall*, 5 R. P. C. 1. And see *Anderson v. Bank of British Columbia*, 2 Ch. D. 644; *Smithwark, etc., Co. v. Quick*, 3 Q. B. D. 815, 320.

(*m*) *Baily v. Taylor*, 1 R. & M. 73, 75. And see *Hacking v. Fraser*, 3 R. P. C. 8.

(*n*) *Smith v. London and South-Western Railway*, Macr. P. C. 209; *S. C. Kay*, 417.

(*o*) *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.*, 4 K. & J. 727. See, however, *Fox v. Dellestable*, 15 W. R. 194.

(*p*) *Crossley v. Derby Gas Co.*, 1 Webst. 119.

(*q*) *Davenport v. Rylands*, L. R. 1 Eq. 302, 307.

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

(*s*) See S. C. R. 1883, Order XV. r. 1. *York v. Stowers*, W. N. 1883, 174. The order for the account is to contain the necessary inquiries and directions usual in the Chancery Division. See Order XV. r. 1.

(*t*) *Hill v. Evans*, 4 D. F. & J. 288, 309; L. R. 6 H. L. 321, note 2; *Betts v. De Vitre*, 11 Jur. (N.S.) 217; *Elmslie v. Boursier*, L. R. 9 Eq. 223.

account of profits you condone the infringement" (u). The rule applies generally and without distinction to every case of infringement (x).

But although a plaintiff cannot have both account of profits and damages against the same defendant, he may have both remedies, though against different persons, in respect of the same article.

Thus, in *Penn v. Bibby*, and *Penn v. Jack* (y), a plaintiff obtained in one suit an injunction against the manufacturer of the patented article, and in another suit an injunction against a person who had used the same article, having purchased it from the manufacturer above mentioned; an account of profits was granted against the manufacturer, and damages against the person using, and Lord HATHERLEY, then Sir W. P. WOOD V.-C., said: "It has never been held that an account directed against a manufacturer of a patented article licences 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" (z). In such a case, however, if the plaintiff is paid by the wrongful user of his invention a sum equal to the ordinary royalty which he had been accustomed to demand from his licensees, he cannot, in respect of the same article, recover any further sum from the manufacturer (a).

And if damages are paid by the manufacturer to the patentee in respect of infringing instruments equal to the royalty which the latter has been accustomed to receive for such instruments, they become "free instruments" in the market, and the purchasers of such instruments are under no liability in respect of them (b).

The patentee may, however, warn such purchasers not to pay the manufacturer, and that if the latter do not pay the damages the patentee will claim the amount from the purchasers (c).

But where, in an action against the manufacturer, the plaintiff accepted an agreed sum for damages, and it was part of the order that the manufacturer should give the names of the purchasers and the instruments he had supplied to them, it was held, in an action against

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NOTE.

Account and Damages.

(u) *Per* Lord WESTBURY, *Neilson v. Betts*, L. R. 5 H. L. 1, 22. See also *Watson v. Holliday*, 30 W. R. 747.

(x) *De Vitro v. Betts*, L. R. 6 H. L. 319. See also *Holland v. Fox*, 3 E. & B. 977; *Vidi v. Smith*, 3 E. & B. 969, as to the practice of Courts of Common Law under the corresponding section of the Act of 1852.

(y) L. R. 3 Eq. 309.

(z) See also *United Telephone Co. v. Walker*, 4 R. P. C. 63, 67, and *Boyd v. Tootal, etc. Co.*, 11 R. P. C. 175.

(a) *Penn v. Jack*, L. R. 5 Eq. 81, 86.

(b) *Per* CHITTY, J., *United Telephone Co. v. Walker*, 4 R. P. C. 63.

(c) *Cropper v. Smith*, 24 Ch. D. 305, 312.

Sect. 30.**NOTE.**
*Account and Damages.***Extent of account of profits.**

purchasers, that the acceptance by the plaintiff of the agreed damages did not make the purchased instruments free in their hands (*d*).

The account of profits may extend not only to direct profits, but also to collateral benefits derived by the defendant from using the patented invention.

Thus, where a defendant company had made and sold gas-meters in infringement of plaintiff's patent, and had also used them in carrying on their works, an account was directed, not only of what profit had been received, but of what benefit had been derived from the use of such gas-meters (*e*).

Where a defendant alleged that he had made no *profit* by the use of the patented apparatus, but it appeared that such use had been the cause of *saving* to the defendant in his manufacture, it was held that the plaintiff was entitled to claim something on account of the pecuniary value of that saving (*f*).

But if such an account be desired, it must be alleged in the pleadings and proved (*g*).

In a trade mark case, when defendants only sold to middlemen and not to retail purchasers, it was held that the plaintiffs were entitled to an account of the profit made by the defendants by selling the article in the form in which they were not entitled to sell it, without excluding from the account that which the retailers sold to persons who bought it as the defendants' article (*h*).

An account of profits will not be directed if it is clear that no profits have been made (*i*), or if the evidence of sale is insufficient to make it worth while (*k*).

Under the corresponding section of the Act of 1852 (*l*), it was held in the courts of common law that no retrospective account of profits made before action would be ordered before final judgment (*m*). Nor would such an account be ordered where at the trial there had been a verdict with damages; the plaintiff's loss up to that time is considered to be compensated by the damages (*n*).

(*d*) *United Telephone Co. v. Walker*, 4 R. P. C. 53, 67.

(*e*) *Crossley v. Derby Gas Light Co.*, 1 Webst. 119.

(*f*) *Househill Co. v. Neilson*, 1 Webst. 697, note (*r*).

(*g*) *Bacon v. Spottiswoode*, 1 Bea. 382, 387. As to the practical difficulties of taking such an account see *Crossley v. Derby Gas Light Co.*, 3 My. & Cr. 428; *Automatic Coal Gas Retort Co. v. Mayor of Salford*, 14 R. P. C. 450.

(*h*) *Lerer v. Goodwin*, 36 Ch. D. 1; *Saelechner v. Apollinaris Co.*, [1897] 1 Ch. 893.

(*i*) *Bergmann v. McMillan*, 17 Ch. D. 423.

(*k*) *Sanitas Co. v. Condy*, 4 R.P.C. 530.

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

(*m*) *Vidi v. Smith*, 3 E. & B. 969; S. C. 1 Jur. (N.S.) 14.

(*n*) *Holland v. Fox*, 3 F. & B. 977.

The court had, however, power to order, pending the action and before the trial, an account of profits to be kept, but in such a case the plaintiff was required to give *prima facie* evidence of infringement and of profit being made by the defendant, and to waive his claim for damages, and to undertake, in the event of the verdict being against him, to pay the expenses of keeping the account (o).

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The amount due under an account of profits is not a demand in the nature of unliquidated damages within s. 31 of the Bankruptcy Act, 1869 (s. 37, Bankruptcy Act, 1883), and is provable in the infringer's liquidation (p).

In taking an account of profits the plaintiff is only entitled to an account of the profits which have been made by the defendant. He is not entitled to any account of the loss which he has sustained by reason of the infringement (q).

On taking account of profits plaintiff not entitled to account of his own loss.

Where the invention was for an appliance for operating on large forgings, and an account was directed of all forgings manufactured by the defendants by the use of the invention and of the profits made by the defendants by reason of such use, it was held that for the purpose of ascertaining these profits the defendants were bound to furnish an account of the cost of forging iron and steel forgings manufactured by the defendants prior to the use of the invention, as well as the cost of forging like forgings during such use (r). In such a case, the true test of comparison seems to be with what the defendants were likely to use, looking at all the circumstances of the case, if they had not used the plaintiff's appliance (s).

It was held by the Court of Common Pleas, under the Act of 1852, s. 2, that the court would not, on taking an account, order an inspection of the manufactures and warehouses of the defendant, in order to see if he had any articles in course of manufacture in violation of the patent (t).

Inspection not ordered on taking account.

In the prosecution at Chambers of the inquiry as to damages, a defendant will be compelled to disclose the number of machines made by the defendant since the patent, and the names and addresses of the persons to whom they have been sold; and it is no objection to such a disclosure that the plaintiff might attack those persons and so injure the

Names and addresses of customers to be disclosed on an inquiry as to damages.

(o) *Vidi v. Smith, ubi supra.*
 (p) *Watson v. Holliday*, 30 W. R. 747, affirmed 31 W. R. 536; 52 L. J. Ch. 543.
 (q) *Ellwood v. Christy*, 18 C. B. (N.S.) 494, overruling *Walton v. Lavater*, 8 C. B. (N.S.) 191. See also *Penn v. Jack*, L. R. 5 Eq. 81.

(r) *Siddell v. Vickers*, 6 R. P. C. 464.
 (s) *Siddell v. Vickers*, 9 R. P. C. 152, 163.
 (t) *Ellwood v. Christy*, cited above.

Sect. 30.**NOTE.***Account and Damages.*

And books may be produced and interrogatories administered.

business of the defendant (*u*). And the same principles apply on taking an account of profits in trade mark cases (*x*).

And in an action for an account against a licensee, the defendant will be compelled to answer inquiries as to the names of customers (*y*).

Where the plaintiff obtained a verdict in an action for infringement, and a rule to enter the verdict for defendants was discharged, and the defendants appealed, and subsequently an order was made for an account of profits which was not appealed against, it was held that the defendants' books must be produced, and that interrogatories might be administered notwithstanding the pendency of the appeal (*z*).

On an inquiry as to damages, the defendant will be ordered to make the usual affidavit of documents without the plaintiff being required first to give particulars or heads of his claim (*a*).

Where plaintiff did not surcharge defendant to extent of one-sixth, plaintiff ordered to pay costs of inquiry.

Where a defendant had filed an affidavit as to his profits it was ordered that if the plaintiff did not succeed in surcharging him to the extent of one-sixth beyond the amount admitted in the affidavit, the plaintiff should pay the costs of the inquiry before the master (*b*).

Where the defendant, a licensee under two patents belonging to the plaintiffs, was sued for infringing their third patent, and for an account of royalties, and for an account of profits of infringement, and did not appear, it was held that under S. C. R. Order XV., r. 1, an account of the royalties, but not of the profits of infringement might be granted (*c*).

Delay in suing may affect account of profits.

If a plaintiff lies by and does not prosecute his rights against the defendant, the delay, if unexplained, may affect his right to an account of profits (*d*), and, in actions to restrain infringement of trade mark, it has been held that where there is undue delay in taking proceedings the account will only be granted as from the commencement of the action (*e*).

Account of profits in trade mark cases.

In trade mark cases where the trade mark is used by the defendant in ignorance of the plaintiff's rights, the account of profits or compensation will only be directed as from the time when the defendant became

(*u*) *Murray v. Clayton*, L. R. 15 Eq. 115, 120; *Leather Cloth Co. v. Hirschfeld*, 1 H. & M. 295; *American Braided Wire Co. v. Thomson* (2), 5 R. P. C. 375.

(*x*) *Powell v. Birmingham Vinegar Brewery*, 14 R. P. C. 1.

(*y*) *Ashworth v. Roberts*, 45 Ch. D. 623.

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

(*a*) *Maxim-Nordenfelt v. Nordenfelt*, [1893] 3 Ch. 122.

(*b*) *Ellwood v. Christy*, 18 C. B. (N.S.) 494, 48.

(*c*) *Pneumatic Tyre Co. v. Ferguson*, 11 R. P. C. 459.

(*d*) *Crossley v. Derby Gas Co.*, 1 Webst. 120; *Harrison v. Taylor*, 11 Jur. (N.S.) 408; *Beard v. Turnor*, 13 L. T. (N.S.) 746.

(*e*) *Ford v. Foster*, L. R. 7 Ch. 627.

aware of the prior ownership (*f*). And if a man buys goods from a third party, believing them to be genuine, while in fact they are spurious, it is not until he has been told that they are so that he can be considered guilty of any fraud, or liable to render any account (*g*).

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But the principle does not apply in patent cases. In the case of a trade mark "the article is open to all the 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 licence of a patented article must be a damage to the patentee" (*h*). And where the defendant had purchased in open market the article complained of, in ignorance of the process of its manufacture, and of the fact of infringement, the inquiry as to damages was nevertheless ordered to extend to the sale within six years of the filing of the bill (*i*).

Same rule does not apply in patent cases.

From the above considerations it results that the proper form of the inquiry as to damages in a patent case is, "what damage the plaintiff has sustained," not "what damage, if any," he has sustained (*k*). And it should be an inquiry as to the particular articles proved in the action as infringements, and all others made in infringement of the patent (*l*).

Damages, form of inquiry.

As to various grounds of damages to be considered on an inquiry see the finding of the official referee in *American Braided Wire Co. v. Thomson* (*m*), and see also the summing up of MARTIN, B., in *Smith v. L. & N. W. Rail. Co.* (*n*).

The measure of damages is the extent to which the sales of the infringing articles interfered with the sales of the plaintiff's own goods, and the plaintiff can only recover compensation for the actual loss he has sustained by reason of the unlawful sales (*o*).

Measure of damages.

(*f*) *Edelsten v. Edelsten*, 1 D. J. & S. 185, 199. See also *Ellin v. Slack*, L. J. Notes of Cases, 1880, p. 15.

(*g*) Per Lord ROMILLY, M.R., *Moet v. Causton*, 10 L. T. (N.S.) 396.

(*h*) Per Sir W. PAGE WOOD, V.-C., *Davenport v. Rylands*, L. R. 1 Eq. 308; *United Horse Shoe and Nail Co. v. Stewart*, 13 App. Cas. 401. See also *Leather Cloth Co. v. Hirschfeld*, L. R. 1 Eq. 299, and *Alexander v. Henry*, 12 R. P. C. 360 (a trade mark case).

(*i*) *Davenport v. Rylands*, *ubi supra*.

(*k*) *Davenport v. Rylands*, *ubi supra*.

(*l*) *Shoe Machinery Co. v. Cutlan*, 12 R. P. C. 342, 360.

(*m*) 44 Ch. D. 274.

(*n*) Macr. P. C. 201, 202.

(*o*) *United Horse Shoe and Nail Co. v. Stewart*, *ubi supra*, p. 408; *Ledgard v. Bull*, 11 App. Cas. 648, 654.

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The loss must be the natural and direct consequence of the defendant's acts; and loss of profit to the plaintiffs by reason of their having, in consequence of the defendant's competition, reduced the price of their articles, is not to be taken into account (*p*). But this rule was held not to apply when the defendants were the first to reduce the prices and the official referee found that the reduction by the plaintiffs was made in consequence of the sales of the defendants (*q*).

Where
licence
granted.

In a simple case, as, for instance, of a licence having been granted, and of a fixed and definite royalty having been received, the court has the means of forming a judgment as to the injury sustained by the plaintiff, and will not send the parties to a jury. In such a case the court would simply ascertain the amount sold by the defendant and fix the wrongdoer with that (*r*).

Where the patentees were not in the habit of selling the patented article, but more usually let it out at a rent, the measure of damages was held to be the profit rent for the entire period during which the article was in the hands of defendants, whether it had or had not been used (*s*).

Reference to
a jury.

Under the old practice, it was said that where no licences have been granted, or where for any reason there is extreme difficulty in the assessment by the court itself, the court would send the patentee before a jury. A jury composed of persons of business-like habits, and accustomed to deal with difficulties of this description, are more fit arbiters than the court can be in dealing with such a question (*t*).

And where the defendants in an action for infringement of trade mark commenced in the Chancery Division submitted, by their defence, to a perpetual injunction, and, the plaintiff waiving an account of profits, the question of damages was the only question to be tried, the action was, under the present practice, transferred to the Queen's Bench Division in order that it might be tried by a jury (*u*).

Where the action was tried in the Chancery Division, and the Court of Appeal granted an injunction and an inquiry as to damages, the plaintiffs applied to the judge before whom the action was tried that the inquiry as to damages might be referred to a judge and jury, and were refused, on the ground that the court at that stage had no jurisdiction

(*p*) *United Horse Shoe and Nail Co. v. Stewart, ubi supra*; judgment of Lord MACNAGHTEN.

(*q*) *American Braided Wire Co. v. Thomson*, 44 Ch. D. 274.

(*r*) *Betts v. De Vitre*, 11 Jur. (N.S.) 10.

(*s*) *United Telephone Co. v. Walker*, 4 R. P. C. 63.

(*t*) *Betts v. De Vitre*, 11 Jur. (N.S.) 10. See also *Penn v. Jack*, L. R. 5 Eq. 81, 83.

(*u*) *Fennessy v. Rabbits*, 56 L. T. (N.S.) 138.

to make such an order (x). On appeal, it was arranged that the inquiry should be referred to an official referee, and the court refrained from expressing an opinion on the question of jurisdiction, but ordered the plaintiffs to pay the costs of the appeal, on the ground that they ought to have made the present application when the order of the Court of Appeal was made, and that, after the order of the Court of Appeal, it was wrong to make the application to the judge of the court below (y).

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In *The United Horse Shoe and Nail Co. v. Stewart* (z), it was held by the Lord Ordinary that the plaintiffs' loss was the amount of profit which they would have gained from the sale of the articles sold by the defendant if the defendant had not interfered so as to prevent the appellants from effecting those sales themselves, and this profit was the difference between the cost of manufacture and the prices at which the plaintiffs were at that time selling; and the decision was affirmed by the House of Lords.

Measure of plaintiff's loss.

Damages may be recovered against both manufacturer and user until the plaintiff has recovered the full amount of damage sustained, and, therefore, where plaintiff had succeeded in an action against the manufacturer, and obtained an order for damages which the manufacturer could not pay, he was held entitled to damages in respect of the same articles against the user (a).

A plaintiff's right to damages is not affected by his not having given notice to the defendant before the purchase of the infringing machine (b).

Where the plaintiff has been in the habit of granting licences, he will not be allowed to claim by way of damages a manufacturing profit, or any sum beyond the ordinary royalty, and if he has received this royalty from the user he cannot have anything further from the manufacturer.

Plaintiff cannot claim manufacturing profit and royalty.

This was decided in the case of *Penn v. Jack* (c), in which the principle on which the court acts in the assessment of damages for infringement of patent, where the court is able itself to assess them, was considered; and in that case the plaintiff had obtained an injunction against the defendants, who were manufacturers, to restrain them from using and selling his invention of "an improvement in the bearings or bushes for the shafts of screw and submerged propellers," with a decree for payment of damages sustained by the plaintiff "by reason of the user or

(x) *American Braided Wire Co. v. Thomson* (3), 5 R. P. C. 538.

(y) *American Braided Wire Co. v. Thomson* (4), 5 R. P. C. 696.

(z) 3 R. P. C. 139; 13 App. Cas. 401, 415. See also *Betts v. De Vitro*,

11 Jur. (N.S.) 9, 10; *Boyd v. Tootal, etc. Co.*, 11 R. P. C. 175.

(a) *Boyd v. Tootal, etc. Co.*, 11 R. P. C. 175.

(b) *Ibid.*

(c) L. R. 5 Eq. 81.

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vending of the said invention." The plaintiff, who was not in the habit of manufacturing the patent article, but was accustomed to grant licences for its use at a royalty of 2s. 6d. per horse-power for each ship in which the invention was to be used, claimed to be paid not merely the ordinary royalty which he had been in the habit of accepting from the trade, but also, and in addition, the profits which the defendant's firm had made on the various items of material and labour expended in fitting the propeller shafts with the invention in the cases where it had been used by the defendants. This claim, however, was not allowed, and Lord HATHERLEY, then V.-C. WOOD, said :—

"It has been contended that the plaintiff has lost more than this 2s. 6d. per horse-power ; he is said to have lost a profit besides. But he has himself estimated that profit at 2s. 6d. per horse-power. If he had fitted these ships with his invention himself, he would no doubt have had to run risks of bad debts, of bad materials, of losses upon contracts arising from the rise and fall of timber, from strikes and the like ; and he would have expected to make a profit sufficient to cover these risks ; but he has shown that he considers he may as well hand over the right to everybody else on being paid 2s. 6d. per horse-power. He might prevent any ship-builder from using this invention at all, and there would then be the chance of business being brought to his yard ; but, taking everything into consideration, he finds he can afford to surrender all profit from fitting these ships, and all chance of profit from being employed to build ships himself, upon being paid this royalty."

In *English and American Machinery Co. v. Union Boot, etc. Co. (d)*, the damages were ascertained by inquiring what amount of profits from licences the plaintiffs had been deprived of, and it was held that the plaintiffs were not entitled to the profits which had been made on the sale of the machines.

And although the court will assume that every sale of the patented article without licence is a damage to the patentee, it will not assume that the defendant's profit is the measure of the plaintiff's loss, or that the plaintiff would have been employed to make every machine in which the patented article has been used without licence ; but loss of sales by reason of the defendant's competition will be taken into consideration (e). And a deduction may be made in favour of the defendants of a percentage representing sales due to increased activity produced by the rivalry of two competitors (f).

(d) 13 R. P. C. 64.

(e) See *Penn v. Jack*, L. R. 5 Eq. 84 ; *Ellwood v. Christy*, 18 C. B. (N.S.) 494 ; *United Horse Shoe and*

Nail Co. v. Stewart, 13 App. Cas. 413.

(f) *United Horse Shoe and Nail Co. v. Stewart*, *ubi supra*, p. 417.

Defendant's profit not necessarily measure of plaintiff's loss.

But the principles above stated will not necessarily apply if a patentee has been in the habit of charging a higher royalty to infringers than to ordinary licensees (*g*); nor can a plaintiff be compelled to accept from a litigant the same royalties as he has accepted from other persons (*h*).

Although where the plaintiff has elected to take an account of profits it is material to ascertain how much of the invention was actually appropriated, the case is altogether different when the claim is for damages, and the patentee does not grant licences. In that case every sale is an illegal transaction, however small a part of the invention is taken (*i*). But in such a case a deduction may be made on account of the non-patented part of the instrument complained of (*k*).

Where the patent was for improvements in the bearings of propeller shafts, the invention consisting in the use of certain wooden strips, the question arose whether the plaintiff was entitled as damages to the profit on the labour and materials only of putting the strips into the propellers, or upon the labour of the whole job of taking out the propeller shafts, fitting them with the strips, and putting them in again, and of all the labour and materials required in so doing; and Lord HATHERLEY, then V.-C. WOOD, while deciding against the plaintiff's claim on other grounds, said that if it had been necessary to go into the case he should have said that the plaintiff's claim for compensation for not having had the whole job to do was quite extravagant, and that it was clear that all the plaintiff was entitled to was the profit of putting in the particular article patented, and that he could not be heard to say that he had lost the job of taking out the propeller and putting it in again, and was consequently entitled to a profit on it (*l*).

In estimating damages the profit made by the infringer is of no consequence. However large his gains, he is only liable in nominal damages so long as his illegal sales do not injure the trade of the patentee (*m*).

Where the patent was for the manufacture of certain horse-shoe nails, and other nails besides the patented nails were in the market, it was held, on a question of damages, that it was immaterial whether the defendant could have made nails equally good and equally cheap

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Plaintiff may charge more to infringers than others.

(*g*) *Penn v. Jack*, L. R. 5 Eq. 87.

(*h*) *Penn v. Bibby*, L. R. 3 Eq. 310, 312; *Boyd v. Tootal, etc., Co.*, 11 R. P. C. 175.

(*i*) *United Horse Shoe and Nail Co. v. Stewart, ubi supra*. See judgment of Lord WATSON.

(*k*) *United Telephone Co. v. Walker*, 4 R. P. C. 63. See as to this *United Horsenail Co. v. Stewart*, 3 R. P. C. 143, Lord KINNEAR.

(*l*) *Penn v. Jack*, L. R. 5 Eq. 86.

(*m*) *United Horse Shoe and Nail Co. v. Stewart, ubi supra*; judgment of Lord WATSON.

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without infringing the patent, it being admitted that the patented nails had in fact been sold by the defendant (*n*).

When damages are given there is no set-off in respect of the value of any infringing instruments which are ordered to be given up (*o*).

Effect of former verdict against patent in reduction of damages.

If there has been a verdict against the patent, it would seem that in a subsequent action for infringement the defendant would be allowed, in reduction of damages, to go into evidence to show to what extent persons have acted upon the faith of the former verdict (*p*).

As to the effect on the question of damages of plaintiff lying by with knowledge of defendant's infringement for several years before taking proceedings, see *Smith v. London and North Western Rail. Co.* (*q*).

Annoyance and vexation to plaintiff not taken into account.

The annoyance and vexation to the plaintiff of the necessity of a law-suit to establish his rights is not to be estimated in the assessment of damages; the compensation for such annoyance and vexation, though possibly inadequate, is to be found in the costs of the suit (*r*).

Damages may be awarded, though not specifically prayed in the action (*s*).

But before the plaintiff can have an inquiry as to damages he must prove some damage not merely nominal (*t*). And where no damage had been proved at a trial before a judge without a jury, an inquiry as to damages was refused (*u*).

If the plaintiff prays in the alternative for an account of profits or damages, and, the case having been tried by a jury, no issue as to damages was submitted to the jury, the court will not send an inquiry as to damages to chambers, but will grant the account of profits. In such a case, if the plaintiff desires damages, it would seem that he ought to lay the matter before the jury for assessment (*x*).

Where by an oversight an inquiry as to damages and an order for delivery up of infringing articles, though claimed in the statement of claim, were not asked for at the trial, the minutes of the judgment

(*n*) *United Horse Shoe and Nail Co. v. Stewart*, 13 App. Cas. 409. See also *Boyd v. Tootal, etc., Co.*, 11 R. P. C. 175.

(*o*) *United Telephone Co. v. Walker*, 4 R. P. C. 63.

(*p*) *Per* Lord LOUGHBOROUGH, *Arkwright v. Nightingale*, 1 Webst. P. C. 61.

(*q*) *Macr. Pat. Cas.* 201, 202, MARTIN, B.

(*r*) *Penn v. Jack*, L. R. 5 Eq. 84, 86; but *qu.* see the charge of the

Lord Justice Clerk to the jury, *Househill Co. v. Neilson*, 1 Webst. 697, n. (*r*).

(*s*) *Betts v. Neilson*, L. R. 3 Ch. 429, 441.

(*t*) *Dicks v. Brooks*, 15 Ch. D. 39, JAMES, L.J. See also *Cole v. Saqui*, 5 R. P. C. 489, 496; *Sanitas Co. v. Condy*, 4 R. P. C. 530.

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

(*x*) *Needham v. Oxley*, 8 L. T. (N.S) 604.

were, on motion by the plaintiff made by special leave, subsequently varied so as to include this relief (*y*).

Where several defendants are infringing, and are liable to be sued jointly, each is liable for the whole of the damages caused to the plaintiff by the infringement (*z*).

The account and also the inquiry as to damages extends to the sale of the articles complained of within six years of the commencement of the action (*a*). This, however, will be subject to the provisions of ss. 13 and 17 (4) (*b*). But where the plaintiff was assignee of a patent, the account of profits was only ordered from the date of the registration of the assignment (*b*).

Where, however, the plaintiffs took over a business and certain patents, it was held that in estimating damages and to ascertain the loss of sales by the competition of the defendants, the plaintiffs might take into account the total quantities sold by the defendants before the plaintiffs acquired the business, they having succeeded to all the rights of their predecessors in title (*c*).

If damages are granted in substitution for an injunction, the court may assess the damages accrued after as well as before the issue of the writ (*d*); and by S. C. R. 1883, Order XXXVI. r. 58, where damages are to be assessed in respect of any continuing cause of action, they shall be assessed down to the time of assessment.

There is no jurisdiction under Lord Cairns' Act to award damages in substitution for an injunction when no wrongful act has been committed by the person against whom an injunction is sought (*e*).

The orders for account or for damages usually provide that the defendants shall pay the amount found due within a definite time after the filing of the certificate of the finding (*f*). But sometimes this is left to be dealt with on further consideration (*g*).

As to ascertainment of damages in the Queen's Bench Division, where the amount is a matter of calculation, see S. C. R. 1883,

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Extent of inquiry.

(*y*) *Edison, etc., Co. v. Holland*, 5 R. P. C. 459, 483.

(*z*) See *Clarke v. Newsom*, 1 Ex. 130. *Hume v. Oldacre*, 1 Starkie, 352.

(*a*) *Davenport v. Rylands*, L. R. 1 Eq. 302, 308.

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

(*c*) *United Horse Shoe and Nail Co. v. Stewart*, 13 App. Cas. 401, 417.

(*d*) *Fritz v. Hobson*, 14 Ch. D. 543.

(*e*) *Dreyfus v. Peruvian Guano Co.* 43 Ch. D. 316.

(*f*) *Plimpton v. Malcolmson*, Seton, p. 565; *Cunningham v. Colling*, *ibid*, 567; *Young v. Fernie*, *Bovill v. Crate*, *Needham v. Oxley*, Pemberton, 485; *Westinghouse v. L. & Y. Rail. Co.*, 1 R. P. C. 253; *Otto v. Linford*, Appendix, *post*.

(*g*) *Davenport v. Rylands*, Pemberton, 484; *Betts v. Noel*, Seton, p. 567; *Hocking v. Fraser*, 3 R. P. C. 7.