

THE PRACTICE

AS TO

**LETTERS PATENT FOR INVENTIONS,
COPYRIGHT IN DESIGNS, AND
REGISTRATION OF TRADE MARKS, &c.**

P. D. Hughes,
1888

THE PRACTICE

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AS TO

LETTERS PATENT FOR INVENTIONS,
COPYRIGHT IN DESIGNS, AND
REGISTRATION OF TRADE MARKS,

UNDER

THE PATENTS, DESIGNS, AND
TRADE MARKS ACT, 1883,

*With the Practice in Actions for
Infringement of Patent.*

ARRANGED AS A COMMENTARY ON THE
ACT, WITH THE RULES AND FORMS,

AND AN APPENDIX OF ORDERS MADE IN PATENT ACTIONS.

BY

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P R E F A C E.

THIS work is not a treatise on the Law of Patents generally, nor on the Law of Trade Marks generally. It deals only with so much of the former as may be said to depend on the legislation of the present and preceding reign, and with so much of the latter as arises out of the Registration Acts.

With regard to the Law of Designs the case is somewhat different. This rests entirely on the Statutes of the early years of the present reign; and the new Act, with the decided cases (few in number) on the repealed and re-enacted provisions of the old Acts, comprises all the law on the subject. There seemed, therefore, to the writer no sufficient reason, in the case of Designs, for confining his work merely to the practice of registration, and the following pages contain also a statement of the General Law.

The present Act is virtually, so far as regards Patents, a consolidation, with considerable amendments, of the provisions of all the Acts on the subject since 1835. It includes, therefore, oppositions to the grant, disclaimers, amendments, and extensions, with the provisions as to provisional specifications and registration introduced by the Act of 1852, and the various enactments as to particulars of breaches and objections and costs which are contained in the latter Act. These subjects are all dealt with in the present volume, and the Author has endeavoured to collect the decided cases on the various matters above mentioned and arrange them under the corresponding heads in the Act; but, in accordance with his plan, he has not touched such questions as the subject-matter of patents, true and first inventor, novelty, utility, and the like, nor has he dealt in any way with the various points arising on the complete specification, or, except in

relation to the practice, with the question of infringement. For these the reader is referred to the well-known works on the General Law of Patents.

In addition to the special matters above mentioned as comprised in this volume, the following pages contain also a detailed statement of the practice in actions for infringement of patent. The general questions on this subject, such as the commencement of the action, the parties, consolidation of actions, and the nature of the relief to be obtained, are treated of under the heading in the Act "Legal Proceedings"; while, following the order indicated in the Act, the practice as to the mode of trial is dealt with under sect. 28; the questions of statement of claim, particulars of breaches, defence, particulars of objections, evidence, and costs, under sects. 29 and 31; and the practice as to injunctions, inspection, discovery, account, and damages, under sect. 30.

The subject of Trade Marks has been dealt with in the same manner as the Law of Patents. The General Law of Trade Marks has been left untouched, except so far as seemed to be necessary in order to elucidate the practice under the new Act, and the writer has confined himself, apart from the cases on the repealed Acts, to such cases as relate to the definition of trade marks, leaving the question of infringement, and other like questions, to books on the General Law.

The present Act is, as far as it relates to trade marks, a consolidation of the Acts of 1875 and 1876, adopting (with alterations) as part of the Act many provisions of the old Trade Marks Rules; and the cases on those Acts and Rules will, it is conceived, form useful guides to the interpretation of the new Act.

On a perusal of the Act, two important innovations in established practice become immediately apparent: one, the abolition, or, to speak perhaps more correctly, the disuse, of the jurisdiction of the Lord Chancellor in the granting of patents; and the other, the conferring quasi-judicial functions on the Board of Trade in certain matters relating to patents, designs, and trade marks.

In the first of these no matter of principle is involved. The Crown has always been advised by the Law Officer on

the question of the grant of Letters Patent, and it was only in exceptional cases and on special grounds that the jurisdiction of the Lord Chancellor was ever invoked.

The present Act substitutes an investigation by the Comptroller for the investigation by the Law Officer under the old practice, and gives to the latter a power of reviewing the Comptroller's decision, and throws on the Law Officer very much the same duties as the Lord Chancellor formerly performed. The change is thus, in effect, merely the substitution of one officer of the Crown for another as its final adviser in applications for patents.

But the other point to which attention has been called is a much greater departure from established usage.

In patent matters the jurisdiction as to compulsory licences is by the Act given to the Board of Trade, while in the case of designs and trade marks the Board of Trade is thereby constituted a Court of Appeal from the refusal of the Comptroller to register a design or a trade mark, and there is no expressed right of appeal from the decision of the Board. The case of compulsory licences is a new matter altogether; and the enactment as to designs is a return to the practice under the Act of 1843 before the transfer (made in 1875) of the control over designs to the Commissioners of Patents; but in the case of trade marks, if the decision of the Board of Trade is found to be in fact without appeal, an important change in the law has been effected, and the final decision on the right to register—in itself an important right, and on which other important matters, such, for instance, as the power of bringing actions for infringement (sect. 77), depends—has been taken from the ordinary jurisdiction of the Courts, and handed over to a Government Department.

Although, however, the Act contains no provisions as to an appeal from the Board of Trade, it may be that indirectly a review of the decision can in some cases be obtained. The orders of the Board as to compulsory licences are to be enforced by mandamus (sect. 22). It is not probable that the Court will consider its duties as merely ministerial, and that it is bound to issue the writ without inquiry, and on the application for a mandamus to enforce an

order for a licence, the patentee may perhaps be able to reopen the question.

Again, the 90th section gives large powers to the Court to rectify the Register in cases which seem to include refusal of an application to register a design or trade mark, and it would seem probable that if a person can show himself "aggrieved" within that section, the Court will exercise the powers thereby conferred, whether the decision of the Comptroller has or has not been affirmed by the Board of Trade.

But it is to be observed that if the decision of the Board of Trade can be reviewed as above suggested, then, at all events in the cases of designs and trade marks, a needless burden will have been thrown on an applicant by the interposition of a step between the office of the Comptroller and the Court.

Upon this question it may be further noticed that while in the cases of designs and trade marks the Act provides (sects. 47 (7) and 62 (4)) that the Board of Trade shall hear the applicant and Comptroller, there is no such provision in the case of compulsory licences for the use of patented inventions. The omission has, however, been supplied in the Patents Rules 57-63, by which directions (which have the force of an Act of Parliament) (sect. 101 (3)), have been given for the hearing of the parties in certain cases.

No machinery for the hearing of the appeal to the Board of Trade is, in designs and trade mark cases, given by the Act, but directions on this point are contained in the Rules. The Act (sect. 62 (5)) empowers the Board of Trade in trade mark cases to refer the appeal to the Court if it shall appear expedient.

A more important point is the omission from the Act of all power to the Comptroller or the Board of Trade over the costs of proceedings. In cases relating to the grant of patents and amendments, costs can only be obtained before the Law Officer, a provision which may have the effect of encouraging unfounded oppositions, since it may be worth while to oppose before the Comptroller on the chance of success when it is certain that the Comptroller cannot order payment of costs in the event of failure.

In the case of compulsory licences the absence of a power

as to costs is still more serious, since the jurisdiction is never likely to be invoked except in cases where large interests are involved, and where, in consequence, there is likely to be great conflict of evidence and a large number of witnesses, and the absence of the control over the proceedings which a power over costs affords would seem likely to lead to merely speculative applications, the burden of which must in any event fall on the patentee.

Considering now the general effect of the Act as to patents, it will be found that comparatively little change in the law itself is effected, the only changes in the law being the power to grant patents to applicants of whom only one need be the inventor, the more extensive power of amendment conferred by the Act, the rights of patentees against the Crown, the question of compulsory licences, and the abolition of the power of confirmation of invalid patents, and of the provisions of the 25th section of the Act of 1852 as to foreign patents.

The main alterations will be found to be alterations in the procedure for obtaining, amending, and revoking patents, and in the amount and mode of payment of fees, and some provisions as to trial of patent actions; but these taken together involve a very considerable amount of change. Upon other points the Act is, as has been already mentioned, a consolidation Act, consolidating and amending the various previous enactments.

Taking first the changes in the law.

The new provision that an applicant not an inventor may with the actual inventor obtain Letters Patent, was probably intended to meet the case of an inventor without capital desiring to purchase the assistance of a capitalist by giving him a share of the patent. Reasons will be found in the text for believing that although one of two joint grantees may alone work the invention without accounting to the other, the concurrence of both is requisite to a valid licence. It will therefore be very desirable, before the patent is obtained, that the parties should stipulate in writing how the patent is to be worked for their common benefit.

The powers of amendment given by the Act are consider-

ably wider than the old power of disclaimer. This was amendment by excision only, but now amendments may be made by way of correction or explanation also, and facilities are also given (sect. 19) for amending by way of disclaimer during the trial of an action. There is no express provision in the Act like that under the Act of 1852, under which the Law Officer's fiat was necessary in order to enable actions to be brought for infringements prior to amendment, but the Act gives power to the Law Officer to impose conditions on the grant of leave to amend, and it may be expected that this power will be exercised so as to protect in proper cases, as hitherto, persons who have embarked capital on the faith of the invalidity of the patent. Moreover, where an amendment has been allowed under the Act, the patentee cannot in any case recover damages for infringements before the amendment, unless he shows that his original claim was framed in good faith and with reasonable skill and knowledge (sect. 20).

The provisions as to compulsory licences are new. The Board of Trade is empowered to compel the grant of licences (sect. 22) in cases where the patent is not being worked in the United Kingdom, or the reasonable requirements of the public cannot be supplied, or any person is prevented from working to the best advantage an invention of which he is possessed, cases which seem to include all possible cases of hardship.

The provisions of the 25th section of the old Act of 1852, whereby, in the case of English patents granted after a foreign patent for the same invention, the English patent expired with the foreign patent, are not re-enacted; but there may be, in the cases of existing patents, some instances (referred to in the text) in which rights have been acquired under this section which may still, for a few years, make it necessary to consider its provisions. For these provisions are substituted those in sects. 103, 104, enabling the Crown to make arrangements with foreign countries and British Colonies for the mutual protection of patents, designs, and trade marks, and in such cases to grant certain preferences to foreign and Colonial inventors in respect of their inventions

over applicants for patents for the same inventions in this country.

The old system of granting patents for communications from abroad is, except so far as it may be affected by the provisions of the last-mentioned sections, left untouched.

Another alteration in the law effected by the Act is on the question of the right of a patentee to issue circulars warning the public against selling articles made according to his patent, where the circulars point to particular articles or affect a particular manufacturer. In such cases it had been held that the sole question as to these circulars was whether or not they were issued *bonâ fide*, and with reasonable and probable cause. This rule is now altered (sect. 32), and the *bona fides* of the circulars will not for the future be available as a defence to an action by the party complaining of their issue. The sole question will be whether the statements as to infringements are true. If they are not, the circulars must not be issued. But a patentee who brings an action for infringement is exempted from the operation of the section.

Thus much for alterations in the law effected by the Act. In the matter of procedure the changes are much more numerous, and are very important.

The most noticeable is the requirement of a complete specification before the patent is granted at all. This was the exception under the old law, which, though it required the patent, when a complete specification had not been filed before the patent was granted, to be made subject to the condition of filing such specification, allowed the complete specification to be deposited, if the applicant chose, with his petition for patent.

The rules as to the provisional specification, except as to matters of time, are much the same as under the old law, but provisions are contained in the Act for the examination of the provisional and complete specifications by examiners. This examination embraces not formalities only, but also an inquiry as to the sufficiency of the provisional specification and the title, and a comparison of the provisional and complete specifications as between themselves, and also with other specifications relating to applications then pending in the

Office. Every specification is to conclude with a distinct claim, a practice which, though usual, has not hitherto been necessary. The examination of the specification is, it would seem, merely an office matter. There is nothing in the Act making the examination conclusive as against third parties. It has been questioned whether the old objections to the specification can still be raised by way of defence to actions for infringement, and in the text will be found reasons for thinking that the law has not been changed in this respect.

In cases of opposition to grant of patents the changes of procedure are very marked. The Comptroller and Law Officer take the place of the Law Officer and Lord Chancellor respectively, and the jurisdiction of the latter, which was reserved specially by the Act of 1852, is not mentioned in this Act, and is probably gone.

Opposition to the grant of a patent is only allowed on certain specified grounds (sect. 11), which do not include such grounds as prior public user by third parties, want of subject-matter, and the like, which were grounds of opposition under the old law. One of the new grounds of opposition is that the specification comprises the same invention as is comprised in a previous application.

The old practice, under which the parties in opposition cases fought in the dark, neither being able to see his opponent's specification, will, as a general rule, no longer exist, since oppositions can only be entered after the complete specification has been accepted, and the acceptance advertised, when the specification becomes open to inspection (sect. 10); but where the opposition is grounded on the examiner's report that the application conflicts with another application then pending, or where the question is between rival applicants for the same invention (sect. 7 (6)), the parties will still be in the dark before the Comptroller, since it is only on an appeal to the Law Officer (sect. 9 (5)) that the report can be seen.

The Law Officer may examine witnesses *vivâ voce*, but as a rule the evidence before him, and before the Comptroller, is to be by declaration. No evidence which was not before the Comptroller is to be brought before the Law Officer without

special leave—a marked improvement on the old practice, under which the evidence, being by declaration before the Law Officer and by affidavit before the Lord Chancellor, was practically taken twice over. The witnesses can, by the Law Officers' Rules, be cross-examined before the Law Officer, but there is no power in the Comptroller to allow the examination or cross-examination of witnesses. The Comptroller, as has already been mentioned, has no power over costs.

The rule laid down in *Ex parte Bates and Redgate*, under which it had become in many cases a practice to refuse to a first applicant a patent for an invention if a second applicant for the same invention had first obtained the Great Seal, is now declared not to be obligatory; and express provision is made (sect. 13) that, in case of more than one application for a patent for the same invention, the sealing of a patent on one of these applications shall not prevent the sealing of a patent on an earlier application. Patents may now be granted to the representatives of deceased inventors, thus obviating a hardship which was felt under the old Acts. Proceedings for amendment are before the Comptroller, and only by way of appeal come before the Law Officer, but he has now power over the costs, which he has not had hitherto.

Proceedings for extension remain practically the same under the new Act as under the old law.

The old action of *scire facias* is abolished, but instead a simple process for obtaining revocation of the patent is substituted (sect. 26).

The law as laid down in *Feather v. The Queen* is changed, and patents for the future will bind the Crown; but provisions are introduced into the Act for securing the use of the invention by contractors for the Crown on proper terms (sect. 27).

The old Register of Proprietors is discontinued, but the Register of Patents will practically include all entries which have hitherto been made in the Register of Proprietors.

There is considerable alteration in the matter of fees payable in respect of patents. The fees for obtaining the patent will be 4*l.* instead of 25*l.* The duties of 50*l.* and 100*l.* are continued, but are made payable before the end of

the fourth and eighth year, instead of the third and seventh, as heretofore.

The patentee may, in lieu of the 50% and 100%, pay the duties by annual instalments, so that he will be able from year to year to judge whether his patent succeeds so as to make it worth while to keep it up. This provision applies to existing patents, but owing to an omission in the Act it is of no avail to a patentee who has already paid a 50% duty. In such a case, since the annual fees are only in place of both the 50% and 100%, there is no power in the Office to accept annual instalments in place of the 100% only.

The office of Commissioner of Patents is abolished, and the whole business formerly transacted by the Commissioners is placed under a Comptroller appointed by and acting under the superintendence of the Board of Trade.

An illustrated Journal of Patents is to be issued, with reports of patent cases; but by the Patents Rules the burden is imposed on the patentee of sending to the Office a drawing of his invention, with a description of the feature of novelty, for insertion in the journal, a burden which it is feared will press very hardly on poor inventors.

Applications for patents may be made through the post. Each application is to comprise one invention only. This, though nominally the rule hitherto, is a rule which has not been very strictly enforced, and its strict enforcement may give rise to considerable trouble and expense.

The practice in actions for infringement of patent is little, if at all, altered, except that for the future they are not to be tried by a jury unless the Judge shall otherwise direct, and except also that either party may require the Judge to call in the aid of an assessor (sect. 28 (1)). The Court of Appeal and the Privy Council may also call in such aid (sect. 28 (2)), and the Law Officer may avail himself of similar assistance (sect. 11 (4)).

There is very little alteration as to the Law of Designs, except that the whole matter is put under the Comptroller. Provisional registration is abolished, and there is no registration of useful designs as such. Such of those designs as are patentable will probably form the subject of patents, while

other designs which were formerly registered as useful can be registered under the general powers of the Act. The power to register works of sculpture conferred by the repealed Act of 1850 is not re-enacted; and for the different terms of copyright given by the old Acts there is now substituted for all designs an uniform term of five years. The fees on registration are very materially reduced.

In trade marks there are one or two notable alterations in the practice. The definition of trade mark under which new marks are registered (sect. 64) is enlarged by the addition of some particulars, the most important of which is "fancy words not in common use"; and "letters or figures" may now be registered as old marks, which could not be done under the Act of 1875.

The "three mark rule" is considerably modified, and apparently any number of marks may now be registered in the same class, subject, however, to the restriction that old marks used by more than three persons on the same or a similar description of goods are to be deemed common to the trade in such goods (sect. 74 (3)), and that except where the Court has decided that two or more persons are entitled as proprietors of the same mark, identical marks, or marks too nearly resembling those already on the Register, are not in any case to be registered for the same goods or description of goods (sect. 72).

Power is now given to register as "additions" to trade marks devices, &c., common to the trade if accompanied by a disclaimer on the part of the applicant of any exclusive right to such devices (sect. 74 (3)).

Registration of a series of marks in one registration is expressly permitted, and each mark is then to be considered as separately registered, except for the purposes of transmission, thus obtaining all the benefits, and obviating the inconveniences, of the old practice of what was called "representative registration" (sect. 66).

Trade marks may now be registered in any colour, and the registration is to confer the exclusive right to use the mark in that or any other colour (sect. 67).

The practice as to cutlery marks is materially changed

(sect. 81), and a Sheffield Registry is established, under the control of the Cutlers' Company, for marks in the Sheffield district; but the registration, when made, is to be notified to the Comptroller, who is to enter the same in the Register of Trade Marks; and, on the other hand, the Comptroller is to notify to the Sheffield Registry applications which he receives from that district. The Comptroller has power to stop registration of any mark by the Cutlers' Company, subject, however, to an appeal to the Court.

The Act contains stringent provisions for preventing the sale of articles as patented when there has been no patent granted; or the false representation of a design or trade mark as registered when it is not so (sect. 105); or the unauthorized use of the Royal arms in such a manner as to lead to the inference that the trade or calling in connection with which they are used is carried on under the authority of Her Majesty, or any of the Royal family, or any Government Department (sect. 106).

Under the old Act and Rules the question of registration of trade marks was assigned to the Chancery Division. This is no longer the case.

It remains to say a word as to the arrangement of this work.

The notes are placed at the end of each section of the Act, the various sub-sections being separately treated under numbers corresponding to the sub-section, and placed in the middle of the page. Immediately under each section are references (with Greek letters) to the various Rules, a mode of reference which appears to be very convenient when an Act is followed by Rules or Orders, and which the writer has taken the liberty of borrowing from Mr. Buckley's well-known book on the Joint Stock Companies Acts.

The Rules are printed at the end of the Act, and there is added an Appendix containing certain orders made in patent cases as to consolidation, inspection, and other matters, which have not, it is believed, been published. In the Appendix will be also found extracts from the "Instructions" relative to the registration of trade marks issued by the Patent Office.

The writer has to thank his friends, Mr. Hull, of the Chancery Bar, and Mr. C. E. E. Jenkins, of Lincoln's Inn, for

assistance in correcting the proof sheets ; and Mr. Johnson, President of the Patent Agents' Institute, for like help, and for many valuable suggestions during the progress of the work.

In conclusion, the writer begs leave to lay his work before the profession, in the hope that it may be found useful.

LINCOLN'S INN,
JANUARY 1884.

ABBREVIATIONS USED IN THIS WORK.

The Act of 1835	..	5 & 6 Wm. IV, c. 83 (Patents).
„ 1842	..	5 & 6 Vict. c. 100 (Designs).
„ 1843	..	6 & 7 Vict. c. 65 „
„ 1850	..	13 & 14 Vict. c. 104 „
„ 1852	..	15 & 16 Vict. c. 83 (Patents).
„ 1853	..	16 Vict. c. 5 (Patents).
„ 1858	..	21 & 22 Vict. c. 70 (Designs).
„ 1861	..	24 & 25 Vict. c. 73 „
„ 1875	..	38 & 39 Vict. c. 91 (Trade Marks Registration).
„ 1876	..	39 & 40 Vict. c. 33 „ „
Seb. Dig.	..	Sebastian's Digest of Cases of Trade Mark, &c.
S. J.	..	Solicitors' Journal.
Eng. Rep.	..	Notes of Cases reported in the "Engineer," reprinted from the "Engineer," 1881.

Mr. Webster's Reports of Patent Cases are referred to sometimes under the abbreviation Webst., and sometimes as Webst. P. C.

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[46 & 47 VICT. CH. 57.]

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ADDENDA.

Page 157, line 12, *add*—and such an undertaking may be added to the register on the *ex parte* application of the applicant, the consent in writing of the comptroller being produced (*Re Keep's Trade Mark*, W. N. 1884, p. 30).

Pages 163, 168, 187—*Re Ralph's Trade Mark* is now reported 25 Ch. D. 194.

Page 187, note (i)—In *Re Riviere's Trade Mark* it was held by the Court of Appeal that it could not be laid down that a foreigner not carrying on business in England, and not intending to do so, could by no possibility be aggrieved by the registration of a trade mark in England; and that it was a matter to be tried on the evidence whether he was aggrieved, and that if he was he could apply to have the register rectified (W. N. 1884, p. 27).

THE
PATENTS, DESIGNS, AND TRADE
MARKS ACT, 1883.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

46 & 47 VICT. c. 57.

An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks. A.D. 1883
[25th August, 1883.]

BE it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords spiritual and temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows :

PART I.

Part I.
Preliminary.

PRELIMINARY.

1. This Act may be cited as "The Patents, Designs, and Trade Marks Act, 1883." Short title.

2. This Act is divided into parts, as follows:—

Division of
Act into parts.

Part I.—Preliminary.

Part II.—Patents.

Part III.—Designs.

Part IV.—Trade Marks.

Part V.—General.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December one thousand eight hundred and eighty-three. Commence-
ment of Act.

A.D. 1883.

Part II.
Patents.

PART II.

PATENTS.

Application for and Grant of Patent.

4. (1.) Any person, whether a British subject or not, may make an application for a patent.

(2.) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly.

(1.)

A patent might always be granted to an *alien amy* (a) even though resident abroad (b).

(2.)

Joint grantees. This, so far as it relates to joint *inventors*, is only a statement of the existing law. It has been the common practice in such a case to grant patents to two or more persons jointly (c), and the fact that one of the joint grantees is an infant will not affect the validity of the patent (d).

In *Mathers v. Green* (e) it was held by Lord Cranworth, C., on the words of the grant in the patent, reversing the decision of Lord Romilly, M.R., that each one of three joint grantees might use the invention without the consent of the others, and without liability to account to them for the profits made by such use. In the same case Lord Romilly had held (f) that one of such grantees was bound to account to the others for royalties received under licences, but this point was left undecided on the appeal.

There is no decision as to the power of one grantee to grant a valid licence without the consent of his co-grantees. It appears, however, to be doubtful whether, except for the authority conferred by the granting and prohibitory clauses of the patent, any licence could be granted at all (g), and it will probably be found, therefore, that the question will in all cases turn on the words of the patent itself. If the grant is, as in the patent in *Mathers v. Green*, to the grantees, their executors, administrators, and assigns, that they and every of them, by themselves, their servants and agents, *and such others as they may agree with*, and no others, may use the invention, then, unless the effect of these words is modified by the prohibitory clause, it would

(a) *Beard v. Egerton*, 3 C. B. 130; citing *Chappell v. Purday*, 14 M. & W. 318.

(b) *Re Wirth's Patent*, 12 Ch. D. 303.

(c) See *Mathers v. Green*, L. R. 1 Ch. 29.

(d) *Per* Bacon, V.C., *Cheavin v. Walker*, 5 Ch. D. 858.

(e) L. R. 1 Ch. 29.

(f) 34 Bea. 170

(g) "Hindmarch on Patents," p. 238. See First Schedule, Form D, *post*.

seem that no licence could be granted without the concurrence of all the grantees (*h*). See further as to co-owners of a patent, sect. 87, *post*.

5. (1.) An application for a patent must be made in the form set forth in the first schedule to this Act, or in such other form as may be from time to time prescribed (*a*); and must be left at, or sent by post to, the Patent Office in the prescribed manner (*β*). Application and specification.

(2.) An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification.

(3.) A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required (*γ*).

(4.) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required.

(5.) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed (*δ*).

(*a*) Patents Rules, 1883, rr. 6, 8, 9, 10, *post*. Applications must be signed by the applicant: all other documents may be signed by an agent (r. 8).

(*β*) Patents Rules, 1883, r. 19.
(*γ*) *Ibid.* rr. 28-30.
(*δ*) *Ibid.* Forms B, C, Second Schedule.

(2.)

These provisions are new. Hitherto patents could only be granted to the true and first inventor, that is, either the actual inventor or inventors, or the first importer of the invention into this kingdom (*i*).

“*True and first inventor.*” These words, which are taken from the Statute of Monopolies (*k*), are, by what has been described as “an anomalous decision which has acquired by time the recognition and force of law” (*l*), held to include not merely the actual inventor but also the first importer of the invention into the country from abroad, even though not the actual inventor, and such an importer is entitled Communications from abroad.

(*h*) See also Judgment of Jessel, M.R., in *Powell v. Head*, 12 Ch. D. 690, a copyright case.

(*k*) 21 Jac. 1, c. 3, s. 5.
(*l*) *Per* Jessel, M.R. *Marsden v. Saville Street, &c., Co.*, 3 Ex. D. 203, 205.

(*i*) “*Hindmarch on Patents*,” 22, c. iii, ss. 2, 3.

to take out a patent, and if not in a confidential relation to the actual inventor, may hold it for his own benefit (*m*). The invention comprised in such a patent is therein described as "communicated from abroad," and it is required that the name, address, and calling of the person by whom the same was communicated should appear in the application (Patents Rules, 1883, Form A1). If a person takes out a patent as for an original invention, when, in fact, it was communicated to him from abroad by the inventor in order that he might obtain a patent for the inventor, the patent is void (*n*). It is not necessary that the person taking out the patent should be the *meritorious* importer, he may be the mere clerk or agent of the foreign inventor (*o*), and may himself be an alien resident abroad (*p*).

Patentee may be agent of inventor.

On question of specification, knowledge of the patentee, not of the inventor, is looked to.

The patent may be (*q*), and generally is, obtained by the agent as trustee for and on behalf of the actual inventor, and the latter is, in the eye of the law, a mere stranger. And so strictly has this distinction been observed that when it was objected that the inventor, a foreigner, for whom the patent was held by his English patent agent, to whom it had been granted as a communication from him, was possessed of knowledge which it was alleged ought to have been but was not embodied in the specification, and that therefore the patent was bad, it was held that, inasmuch as it was not suggested that this knowledge was possessed by the actual patentee, the objection failed altogether (*r*).

So also it was held that the fact that in the specification of a patent for a communication from abroad the patentee had stated all that had been communicated to him was no answer to an objection that the specification did not sufficiently describe the invention (*s*).

Rule as to communication from abroad not extended to communication in this country.

It was, however, held that the privilege thus granted to the importer of a foreign invention could not be extended so as to include a communication made in England from one British subject to another, and that the legal personal representative of an inventor deriving his knowledge only from the inventor's papers could not take out a patent (*t*). (See now, however, sect. 34, *post*.) But if a man from abroad communicates to A., who communicates to B., it seems that B. may take out the patent (*u*), and letters patent can be granted to an alien resident abroad for an invention communicated to him by another alien also resident abroad (*v*).

(3.)

Provisional specification.

It will be observed that the language of the Act (which in this particular is the same as the Act of 1852) (*y*), differs as regards the

(*m*) *Steadman v. Marsh*, 2 Jur. (N. S.) 391.

(*n*) *Milligan v. Marsh*, 2 Jur. (N. S.) 1083. The head-note appears incorrect.

(*o*) *Beard v. Egerton*, 3 C. B. 129.

(*p*) *Re Wirth's Patent*, 12 Ch. D. 303.

(*q*) *Beard v. Egerton*, 3 C. B. 97.

(*r*) *Plimpton v. Malcolmson*, 3 Ch. D. 531, 582.

(*s*) *Wegmann v. Corcoran*, 13 Ch. D. 66; 41 L. T. (N. S.) 357.

(*t*) *Marsden v. Saville Street, &c., Co.*, 3 Ex. D. 203. See also *Tenant v. ———*, 1 Webst. 125, n.

(*u*) *Per Jessel, M.R., Plimpton v. Malcolmson*, 3 Ch. D. 552.

(*x*) *Re Wirth's Patent*, 12 Ch. D. 303.

(*y*) 15 & 16 Vict. c. 83, s. 6.

provisional and complete specification. While the former is required only to *describe the nature* of the invention, the latter must *particularly describe and ascertain* the nature of the invention, *and in what manner it is to be performed* (z). The provisional specification need not enter into all the minute details as to the manner in which the invention is to be carried out (a). It is only to disclose the invention in the rough state (b). It need not describe the manner in which the invention is to be carried into effect, nor need it describe the nature of the invention otherwise than roughly, but it ought to do so fairly and honestly (c).

Difference of requirements in provisional and complete specification.

See also under sect. 9 (1), *post*.

(4.)

It is beyond the scope of this work to describe in detail the law as to complete specifications. On this subject the reader is referred to the well-known works on the General Law of Patents. An useful and complete summary of the rules as to specifications (with reference to the cases) will also be found in the Table of Contents to Mr. Good-
eve's "Abstract of Reported Cases relating to Letters Patent."

(5.)

Hitherto a "claim," though usual, has not been a necessary part of a specification (d); its object was not to claim anything which is not mentioned in the specification, but to disclaim something which is in it, and which the patentee does not profess to have invented (e). Henceforth a claim will be an essential part of every specification. See First Schedule, Form C, and Patents Rules, 1883, Second Schedule, Form C.

Claims.

As to correction of clerical errors in or in connection with an application for a patent, see sect. 91 (a), and Patents Rules, 1883, r. 18, *post*.

6. The comptroller shall refer every application to an examiner, who shall ascertain and report to the comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner (a), and the title sufficiently indicates the subject-matter of the invention.

Reference of application to examiner.

(a) Patents Rules, 1883, *post*, rr. 5-10, 27-30. The acceptance of an application is to be advertised, and notice of acceptance is to be given to the applicant. *Ibid.* r. 25.

"Fairly described." See under sect. 5 (3), *ante*.

"Title." See the cases collected in "Hindmarch on Patents," pp. 43-47 ;

(z) Sub-sect. 4.

(a) *Re Newall & Elliot*, 4 C. B. (N. S.) 269 ; *Penn v. Bibby*, L. R. 2 Ch. 127, 132.

(b) *Per Jessel, M.R., Stoner v. Todd*, 4 Ch. D. 58, 60.

(c) *Per Fry J., United Telephone Co. v. Harrison*, 21 Ch. D. 747.

(d) *Per Williams, J., Lister v. Leather*, 8 E. & B. 1004.

(e) See Judgment of James, L.J., *Plimpton v. Spiller*, 6 Ch. D. 426.

Johnson's "Patentees' Manual," 4th ed., pp. 93-97; "Agnew on Patents," pp. 143-149; Higgins' "Digest of Patent Cases," pp. 148-161.

Power for
comptroller to
refuse appli-
cation or
require amend-
ment.

7. (1.) If the examiner reports that the nature of the invention is not fairly described, or that the application specification or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may require that the application specification or drawings be amended before he proceeds with the application.

(2.) Where the comptroller requires an amendment, the applicant may appeal from his decision to the law officer (α).

(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the application shall be accepted.

(4.) The comptroller shall, when an application has been accepted (β), give notice thereof to the applicant.

(5.) If after an application has been made, but before a patent has been sealed, an application is made, accompanied by a specification bearing the same or a similar title, it shall be the duty of the examiner to report to the comptroller whether the specification appears to him to comprise the same invention; and, if he reports in the affirmative, the comptroller shall give notice to the applicants that he has so reported.

(6.) Where the examiner reports in the affirmative, the comptroller may determine, subject to an appeal to the law officer (α), whether the invention comprised in both applications is the same, and if so he may refuse to seal a patent on the application of the second applicant (γ).

(α) Law Officers' Rules, *post*.

(β) Whether with a provisional or complete specification (Patents Rules, 1883, *post*, r. 25), and the acceptance is to be advertised. *Ibid*.

(γ) The comptroller may require a statement in writing from or the attendance of the applicant's agent. *Ibid*. rr. 8, 13.

(6.)

Both applicants may attend the hearing, but each will be in ignorance of the nature of the rival specification so long as the matter remains before the comptroller (Patents Rules, 1883, r. 16). On appeal, however, to the law officer each will, under sect. 9 (5), be able to see the examiner's report. Neither can, however, in any case, see the rival

specification itself until its acceptance has been advertised (sect. 10).
See Patents Rules, 1883, rr. 25, 26.

“*He may refuse,*” &c. See *post*, pp. 14, 16.

8. (1.) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application. Time for leaving complete specification.

(2.) Unless a complete specification is left within that time the application shall be deemed to be abandoned.

(1.)

The nine months is to be reckoned exclusively of the day of the date of the application. The usual course in recent times has been to “construe the day (of the date) exclusively, wherever anything was to be done in a certain event after a given event or date” (*f*); and see note to First Schedule, Patents Rules, 1883, *post*, and sect. 98.

Month means calendar month (*g*).

A provisional specification which has been abandoned does not become public by abandonment, and therefore, when an applicant on the 10th April obtained, under the Act of 1852, provisional protection for four heads of invention, one of which formed the subject of a provisional specification lodged on the previous 17th March, which latter he thereupon abandoned and completed his patent on the provisional specification of the 10th April before that of the 17th March was made public by the Office, it was held that there was no publication of the invention sufficient to invalidate the patent (*h*). Abandoned provisional specification not made public by abandonment so as to vitiate subsequent patent for same invention.

And if a provisional specification contain an incomplete description which is omitted in the complete specification, the publication of the provisional specification is not necessarily such a publication as will invalidate a subsequent patent for the omitted part (*i*). Incomplete description in a provisional specification of part omitted in final.

9. (1.) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner (*a*), and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification. Comparison of provisional and complete specification.

(2.) If the examiner reports that the conditions hereinbefore contained have not been complied with, the comptroller may refuse to accept the complete specification unless

(*f*) *Per Parke, B., Russell v. Ledsam*, 14 M. & W. 582. *Williams v. Nash*, 23 Bea. 93. (*h*) *Oxley v. Holden*, 8 C. B. (N. S.) 666.

(*g*) 13 & 14 Vict c. 21, s. 4. (*i*) *Stoner v. Todd*, 4 Ch. D. 58.

and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer.

(3.) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the complete specification shall be accepted.

(4.) Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void.

(5.) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding, other than an appeal to the law officer under this Act, unless the Court or officer having power to order discovery in such legal proceeding shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed (β).

(α) Patents Rules, 1883, r. 31, *post*.

(β) *Ante*, p. 6.

(1.)

The object of the provisional specification, which was first introduced by the Act of 1852, was to ascertain the identity of the invention, and to make it certain that the patentee should ultimately obtain his patent for that invention which he presented to the Attorney-General in the first instance (*k*). This being so, it was held that the provisional and complete specification of a patent ought not so to differ as that the nature of the invention as described in the one shall be materially different from the nature of the invention as described in the other (*l*); and an objection that there is a material variation between the provisional and complete specification has been a common objection to the validity of a patent. The provisions of this section will probably render such objections less frequent in future, but there appears to be nothing in the Act which makes the examination which the section directs conclusive, except as between the Patent Office and the applicant on the question whether or not the patent shall be granted. It will be useful, therefore, to consider the cases on this point.

Where a provisional specification of an invention of "improvements in preserving animal substances" described the use for this purpose of

(*k*) *Per* Pollock, C.B., *Newall v. Elliott*, 10 Jur. (N. S.) 955.

(*l*) *Foxwell v. Bostock*, 4 D. J. S. 298.

gelatine mixed with bisulphite of lime, and in the complete specification described and claimed several solutions, one being a solution of bisulphite of lime alone, as to which no directions for using were given, it was held that the claim was larger than, and different from, that disclosed in the provisional specification, and that if the complete specification were construed so as to include the use of bisulphite of lime alone, the patent would be invalid (*m*).

And where the complete specification for an invention of an electrical telephone included an invention of a phonograph which was not sufficiently described in the provisional, the patent was held void (*n*).

But where a patentee of improvements in apparatus for laying down telegraph wires described in his provisional specification a cable passed round a cone so that the cable in being drawn off the coil was prevented from kinking by means of the cone, and also described a cylinder outside which prevented the coil shifting, and the complete specification mentioned and claimed in addition certain rings placed round the cone with the object of preventing the bight of the rope from flying out when going at a rapid speed and so preventing kinking, it was held that the omission of the rings from the provisional specification did not invalidate the patent (*o*).

And again, where a provisional specification of an invention of "an improvement in the bearings and bushes of the shafts of screw and submerged propellers," described the invention as consisting in employing wood for such bearings and bushes, and the complete specification gave a detailed description showing how the wood was to be arranged in the bearings, and included the application of wood to the shaft so as to revolve therewith, there was held to be no material variance between the provisional and complete specification (*p*).

And generally when something is found out during the period of provisional protection "to make the invention work better, or with respect to the mode in which the operation is performed, a thing which is very likely to happen, when in carrying out his invention the inventor finds that some particular bit will not work so smoothly as he expected, and it is necessary to add a little supplement to it, still the nature of his invention remains the same, and it is no objection that in the complete specification which comes afterwards the invention or application is described more particularly and in more detail, or even if it be shown that there has been more discovery made and so as to make the invention which he has described in the provisional specification really workable. If nothing more is done than that," the patent is good (*q*).

(*m*) *Bailey v. Robertson*, 3 App. Cas. 1055.

(*n*) *United Telephone Co. v. Harrison*, 21 Ch. D. 746. See also *Crossley v. Potter*, Macr. P. C. 240, 255.

(*o*) *Re Newall & Elliott*, 4 C. B. (N. S.) 269.

(*p*) *Penn v. Bibby*, L. R. 2 Ch. 127, 135.

(*q*) *Per Lord Blackburn, Bailey v. Robertson*, 3 App. Cas. 1055, 1075.

And a complete specification may omit something which is described in its provisional specification if there is no fraud, and the effect of the remainder is not altered (*r*). But if there is such an omission, the provisional specification cannot afterwards be read for the purpose of supplying a defect in the complete specification (*s*).

(2.)

There is nothing in the Act which makes the acceptance of the complete specification conclusive as to its sufficiency in point of law. Objections to the validity of a patent on the ground of insufficiency of specifications may, it is submitted, be taken as heretofore by way of defence to an action for infringement. See notes to sect. 29 (2), *post*.

Advertisement
on acceptance
of complete
specification.

10. On the acceptance of the complete specification the comptroller shall advertise the acceptance; and the application and specification or specifications with the drawings (if any) shall be open to public inspection (*a*).

(*a*) Patents Rules, 1883, rr. 25, 26, *post*.

Opposition to
grant of
patent.

11. (1.) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date, or on the ground of an examiner having reported to the comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application, but on no other ground (*a*).

(2.) Where such notice is given the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer.

(3.) The law officer shall, if required, hear the applicant and any person so giving notice and being, in the opinion of the law officer, entitled to be heard in opposition to the grant,

(*r*) *Thomas v. Welch*, L. R. 1 C. P. 192; *Penn v. Bibby*, L. R. 2 Ch. 127, 134. (*s*) *Mackelcan v. Rennie*, 13 C. B. (N. S.) 52.

and shall determine whether the grant ought or ought not to be made.

(4.) The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer, with the consent of the Treasury, shall appoint.

(a) As to proceedings on opposition, and Law Officers' Rules, *post*.
see Patents Rules, 1883, *post*, rr. 32-41,

(1.)

"*Any person.*" The 12th section of the Act of 1852 limited opposition to persons "having an interest in opposing the grant of letters patent." In the present section the first ground of opposition implies of necessity an interest in the opposer; but the second and third grounds are, on the face of them, available to any one of the outside public. The 3rd sub-section, however, limits this right to persons "being in the opinion of the law officer entitled to be heard in opposition to the grant." The old rule requiring an interest in the opposer therefore in substance appears still to prevail.

Opposer must have an interest.

There is a similar limitation in the case of opposition to amendment of the specification, sect. 18 (4), but there is no such limitation on opposition to extension of the term of a patent, sect. 25.

Prior public user (*t*)—want of utility (*u*)—or an objection that the invention is not subject-matter of a patent (*x*), were formerly, but are not now, grounds of opposition to the grant, which can now be opposed only on the three grounds mentioned in this section.

Prior user—non-utility—no subject-matter not now grounds of opposition.

Under the new practice the comptroller will, it would seem, fill very much the position in regard to the grant of patents formerly occupied by the law officer, while the law officer will perform the duties formerly belonging to the Lord Chancellor, whose jurisdiction as to patents, specially reserved by sect. 15 of the Act of 1852, is not mentioned in the present Act, and appears no longer to exist, unless, perhaps, under sect. 116, *post*.

It may be therefore useful to examine the principles which appear to have guided the decisions on oppositions under the old practice, but it must be remembered in considering these cases that some of them are cases in which the patent had not been opposed before the law officer, and was opposed for the first time at the Great Seal, and in such cases opposition was in the discretion of the Lord Chancellor (*y*) and a matter of indulgence (*z*), whereas by the present Act there is a distinct right of appeal from the comptroller to the law officer.

(*t*) *Re Adamson's Patent*, 6 D. M. G. 420; *Re Samuda and Griffiths* cited "Hindmarch on Patents," p. 534; *Re Tolhausen's Patent*, 14 W. R. 551.
(*u*) *Re Cutler's Patent*, 1 Webst. 426.

(*x*) *Re Spence's Patent*, 3 De G. & J. 523.
(*y*) *Ex parte Henson*, 1 Webst. 432.
(*z*) *Ex parte Manceaux*, L. R. 5 Ch. 518; *Re Mitchell's Patent*, L. R. 2 Ch. 343.

A collection of cases before the law officers not elsewhere reported will be found in Johnson's "Patentees' Manual," 4th ed., pp. 159 to 163.

Lord Chancellor would not interfere with law officer's decision unless in special cases.

When the law officer had, after hearing the parties, allowed his warrant to issue, the Lord Chancellor would not interfere with his decision unless a case were made of surprise or fraud, or unless some material fact which, if brought before the law officer, would probably have led him to decide differently, had subsequently come to the knowledge of the party appealing (*a*); nor would the Lord Chancellor interfere on the ground that some fact which was in the knowledge of the opponent at the time was not brought before the law officer (*b*); nor was the opponent allowed to adduce before the Lord Chancellor evidence which he might have brought before the law officer, or to raise before the Lord Chancellor an argument on those facts which he did not raise before the law officer (*c*).

In doubtful cases rule was to seal patent.

In *Re Russell's Patent* (*d*), Lord Cranworth, C., said that as a general rule when the matter was in much doubt it was better to run the risk of putting the party opposing to the costs of making out his case in some ulterior proceedings than to withhold the Great Seal from the patent in the first instance, for the obvious reason that the one course would create a remediable and the other an irremediable injury. And this rule was approved and acted on by Lord Chelmsford, C., in *Re Spence's Patent* (*e*), where it was objected that there was no novelty in the alleged invention, and that it consisted merely in the application of a well-known process to an equally well-known manufacture; and in *Ex parte Sheffield* (*f*) Lord Selborne, C., said that the burden lies on the opponent of showing that the proposed grant is wrong. The question is not whether the proposed patent will be good, but merely whether the applicant can be allowed to proceed.

On this principle letters patent have been sealed even when on the evidence there appeared to be considerable similarity between the alleged invention and one already patented (*g*), and where the evidence of prior user was contained in only one affidavit proving a sale which was not corroborated by the person alleged to have sold the goods (*h*).

Law officer was bound to decide between rival applicants.

It was the duty of the law officer to hear and determine which of two rival applicants was entitled to a patent, and the question was not to be remitted to the Lord Chancellor by directing warrants upon both patents (*i*).

(*a*) *Re Vincent's Patent*, L. R. 2 Ch. 341; see also *Re Daines' Patent*, 26 L. J. Ch. 298; *Re Simpson and Isaacs' Patent*, 21 L. T. 81.

(*b*) *Re Vincent's Patent*, cited above.

(*c*) *Ex parte Sheffield*, L. R. 8 Ch. 237; *Re Simpson and Isaacs' Patent*, 21 L. T. 81.

(*d*) 2 De G. & J. 130, 132. See also *Re Simpson and Isaacs' Patent*,

21 L. T. 81; *Re Spence's Patent*, 3 De G. & J. 523.

(*e*) 3 De G. & J. 523. Not now a ground of opposition.

(*f*) L. R. 8 Ch. 237.

(*g*) *Re Tolson's Patent*, 6 D. M. G. 422.

(*h*) *Re Tolhausen's Patent*, 14 W. R. 551. This is not now a ground of opposition.

(*i*) *Ex parte Henry*, L. R. 8 Ch. 167.

The Lord Chancellor would sometimes hear *virâ voce* evidence on an application for the Great Seal (*k*), but in general the evidence was taken by affidavit, though declarations were used before the law officer. The evidence is now to be by declaration (Patents Rules, 1883, rr. 35, 36). Power is given to the law officer to examine witnesses on oath (sect. 38), and they may be cross-examined (Law Officers' Rules, *post*, r. IX).

Upon the hearing of a petition for the Great Seal, the Lord Chancellor would not give effect to an objection founded on a mere matter of form, such as an objection to the jurat to a declaration (*l*). The Lord Chancellor could impose terms on the parties applying for a patent (*m*).

Virâ voce
evidence.

Mere formal
objections not
admitted.

As to costs in opposition cases, see notes to sect. 38, *post*.

GROUND OF OPPOSITION.

i. *That applicant obtained the invention from the person giving notice of opposition, or from a person of whom he is the legal representative.*

Where the grant of a patent was opposed on the ground that the invention was only an improvement on a previously patented invention, not the invention of the applicant, but in which he was interested, and which he and the patentee had assigned to the opponent, who had thereupon granted a licence to the applicant to use the patented invention; the new patent was ordered to be sealed, but (the Lord Chancellor being of opinion that the applicant had obtained his knowledge while working the original patent) only on the terms that it should be assigned to the owner of the first patent, to be subject, however, to the same arrangement as to licence and otherwise in favour of the applicant; the cost of obtaining the second patent to be considered as part of the costs of working the first patent (*n*).

Grounds of
opposition
under this
Act.

And when a master and his foreman had both invented improvements for which the master sought letters patent, they were granted only on the terms of the master and foreman being treated as joint grantees, the letters patent being vested in two trustees for their joint benefit, and each party to have a free licence for himself and his partners (*o*).

But the fact that another person has been making experiments and working towards the same invention as the applicant is no ground for refusing the Seal (*p*).

ii. *That the invention has been patented in this country on an application of prior date.*

If the opponent could show that the proposed patent was for an invention, part of which was clearly identical with the subject of an

(*k*) *Re Gething*, L. R. 9 Ch. 633.

(*l*) *Re Wirth's Patent*, 12 Ch. D.

303.

(*m*) *Re Daines' Patent*, 26 L. J. (N. S.) 298; *Re Russell's Patent*, 2 De G. & J. 130.

(*n*) *Re Daines' Patent*, 26 L. J. (N. S.) 298.

(*o*) *Re Russell's Patent*, 2 De G. & J. 130.

(*p*) *Ex parte Henry*, L. R. 8 Ch. 167.

existing patent, the Great Seal would not (*q*), at all events where both parties were *bonâ fide* inventors and there was no fraud (*r*), be affixed to a patent for that part, even though the validity of the original patent was disputed (*s*). And in *Ex parte Bates and Redgate* (*t*) this principle was applied when the owner of the existing patent was, in fact, the second applicant for the patent, but had first obtained the Great Seal (*u*). See notes under sect. 13, *post*.

But in *Re Vincent's Patent* (*x*), where the opposer brought forward a prior patent of his own, and the applicant alleged that he was the real inventor, and had confidentially communicated the invention to the opposer, who had applied for and obtained a patent in fraud of the applicant's rights, it was held that the case being thus within sect. 10 of the Act of 1852 (sect. 35 of the present Act), the applicant's patent ought to be sealed in order that he might have the opportunity of trying the question before a jury.

And the patent was sealed when the only ground of opposition was that the invention was borrowed from an existing patented invention, it being an improvement thereon (*y*).

But where, in a case of rival applicants, each opposed the other, and it appeared that the alleged invention was the subject of a previous patent, both applications were refused (*z*).

Where the law officer certified against an application on the ground that the invention was similar to an invention comprised in an existing patent, the application was refused, with costs (*a*).

Concurrent applications.

iii. *That the examiner has reported that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application.*

Where two parties applied for a patent, and each opposed the other on the ground that he alone was the inventor, and the evidence on this point was conflicting, the patent of the first applicant was sealed (*b*).

Where there were concurrent applications for the same invention, and the first application having been delayed, the second applicant was in a position to seal his patent first, Lord Eldon, C., held that the applicant who first obtained the Great Seal was to be preferred, and said, "I can see no other mode of deciding than by awarding the patent to

(*q*) *Ex parte Bates and Redgate*, L. R. 4 Ch. 577; comp. *Ex parte Scott and Young*, L. R. 6 Ch. 274.

(*r*) *Ex parte Manceaux*, L. R. 6 Ch. 272.

(*s*) *Ex parte Manceaux*, L. R. 6 Ch. 272.

(*t*) L. R. 4 Ch. 577.

(*u*) See also *Ex parte Bailey*, L. R. 8 Ch. 61; *Re Simpson and Isaacs' Patent*, 21 L. T. 81.

(*x*) L. R. 2 Ch. 341.

(*y*) *Ex parte Fox*, 1 Webst. 431; 1 V. & B. 67.

(*z*) *Re Samuda and Griffiths*. "Hinmarch on Patents," p. 534.

(*a*) *Ex parte Yates*, L. R. 5 Ch. 1. See also *Re Stoll's Patent*, 21 L. T. 233.

(*b*) *Re Lowe's Patent*, 25 L. J. Ch. (N. S.) 454.

him who runs the quickest through the process" (c). And this rule was subsequently recognized by Lord Cranworth (d).

As to applications on the same day in respect of the same invention, see *In re Dering's Patent* (e), *post*, sect. 13.

12. (1.) If there is no opposition, or, in case of opposition, if the determination is in favour of the grant of a patent, the comptroller shall cause a patent to be sealed with the seal of the Patent Office. Sealing of patent.

(2.) A patent so sealed shall have the same effect as if it were sealed with the Great Seal of the United Kingdom.

(3.) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of application, except in the cases hereinafter mentioned, that is to say—

(a.) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.

(b.) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative and sealed at any time within twelve months after the death of the applicant.

(2.)

"As if it were sealed with the Great Seal of the United Kingdom." That is, it will prove itself and cannot be denied (f).

(3.)

(a.) Under the 20th section of the Act of 1852 it was held that when the delay was caused by opposition, the patent might be sealed even though the hearing took place after the expiration of the provisional protection, and the additional month allowed by the 6th section of the Act of 1853 (g).

On the analogy of this case it would seem that under similar circumstances the patent may be sealed though the hearing does not take place till after the fifteen months.

(b.) A re-enactment with modifications of sect. 21 of the Act of 1852.

(c) *Ex parte Dyer*. "Hindmarch on Patents," p. 535.

(d) *Re Simpson and Isaacs' Patent*, 21 L. T. 81.

(e) 13 Ch. D. 393.

(f) "Hindmarch on Patents," pp. 37, 264, 438.

(g) *Re Johnson's Patent*, 13 Ch. D. 398, n; *Re Somerset and Walker's Patent*, *Ibid.* 397.

Date of patent. **13.** Every patent shall be dated and sealed as of the day of the application: Provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification: Provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application.

“*Dated and sealed as of the day of the application.*” This provision is new. Under the Act of 1852, sect. 23, the Lord Chancellor or the law officer had a limited discretion as to the date of the patent. And under this section it was sometimes made a condition of sealing the patent that it should bear a particular date (*h*). Such a condition cannot now be imposed.

The patent will, subject to the next proviso, take effect as from the day of application, whatever be the day when the seal is actually affixed (*i*).

“*Provided that no proceedings,*” &c. The result of this, and the proviso at the end of sect. 15, appears to be that until the patent is actually granted, no proceedings for infringement can be instituted at all, nor even then in respect of infringements committed before the publication of the complete specification (see sect. 10), but that in an action brought after the grant of the patent, relief may be had in respect of infringements committed between the date of the publication of the complete specification and the time of the grant, as well as in respect of infringements after the grant.

Rival applications at different dates for same invention.

“*Provided also that in case,*” &c. Certain expressions in the Judgment of Lord Hatherley, C., in *Ex parte Bates and Redgute* (*k*), and of Lord Selborne, C., in commenting on that case in *Ex parte Bailey* (*l*) and *Ex parte Henry* (*m*), appear to throw doubt on the power of the Crown, in the case of rival applications on different dates for patents for the same invention, to seal both patents. On the other hand, in *Saxby v. Hennett* (*n*) Kelly, C.B., said that in such case of the competency of the Crown to seal both patents there could be no doubt, and this appears also to have been the view of Earl Cairns, C., in *Re Dering's Patent* (*o*). The doubt is now removed as to the case mentioned in this proviso. But the proviso is only permissive and not obligatory, and it is therefore necessary to consider what was the old practice on this point.

(*h*) *In re Johnson's Patent*, 13 Ch. D. 398 n; *Ex parte Bailey*, L. R. Ch. 60; *In re Harrison*, L. R. 9 Ch. 631.

(*i*) See *Saxby v. Hennett*, L. R. 8 Ex. 210; *Holste v. Robinson*, 4 Ch. D. 9.

(*k*) L. R. 4 Ch. 580.

(*l*) L. R. 8 Ch. 63.

(*m*) L. R. 8 Ch. 169.

(*n*) L. R. 8 Ex. 213.

(*o*) 13 Ch. D. 395.

It was at one time considered that under the Act of 1852 the provisional specification secured the invention for six months, and that the letters patent would be dated as of the date of the provisional specification; and the ordinary practice was to wait until the expiration of four months (*p*) before giving notice of intention to proceed with the patent, and then to wait two months more before obtaining the Great Seal (*q*).

Rule in
Ex parte Bates
and *Redgate*.

But in *Ex parte Bates and Redgate* (*r*) it was held by Lord Hatherley, C., that leaving a provisional specification and obtaining provisional protection did not prevent a second applicant from leaving a provisional specification of a similar invention, and obtaining valid letters patent for his invention before the expiration of the first provisional protection, and that in such a case letters patent would not be granted to the first applicant for any part of his invention which was covered by the letters patent already obtained by the second applicant.

The ground of this decision was that a person could not, by filing a provisional specification only, not choosing to file a complete specification, obtain anything more than a right to be protected against the consequence of his own publication, and does not obtain a right to priority over any other person who had independently and originally hit upon the same idea, and, in anticipation of the other, first gave the world the benefit of it (*s*).

In *Ex parte Manceaux* (*t*) Lord Hatherley, C., again acted on this principle, and refused to seal the patent of a first applicant when the law officer had reported that part of the invention for which the patent was sought was comprised in a patent which had before the expiration of the first applicant's provisional protection been granted to a second applicant. His Lordship pointed out the inconvenience of granting two patents for the same invention arising from the fact that the question is not between the patentees only, but affects the public, who will be at a loss to know with whom to deal. In this last case the circumstances that the invention had been previously published abroad, so that neither of the parties was in the position of an original inventor, and that there was no case of fraud, nor was the first patentee a servant of the applicant, were considered as bearing on the question of affixing the Seal.

In *Ex parte Scott and Young* (*u*), however, in a case where servants had filed a provisional specification, after which the master filed a provisional specification of a similar invention, and before the servants had obtained their patent filed a complete specification, and had his patent sealed, and the evidence disclosed grounds for serious suspicion

(*p*) The period allowed by the rules of Dec. 12, 1853.

(*q*) *Lee v. Walker*, L. R. 7 C. P. 121, 125. Judgment of Brett, J.

(*r*) L. R. 4 Ch. 577.

(*s*) *Per* Lord Hatherley, C., *Ex*

parte Scott and Young, L. R. 6 Ch. 274.

(*t*) L. R. 6 Ch. 274. See also *Ex parte Yates*, L. R. 5 Ch. 1; *Re Stoll's Patent*, 21 L. T. 233.

(*u*) L. R. 6 Ch. 274.

that the master had derived his knowledge from the servants, the same learned Judge held that *Ex parte Bates and Redgate* did not apply, and ordered the servants' patent to be sealed and dated as of the date of their provisional specification.

But in *Ex parte Bailey* (x) Lord Selborne, C., treated the case of *Ex parte Bates and Redgate* as laying down the rule that if an application to seal a patent is made after the sealing of another, care shall be taken that the new patent does not cover the ground which is covered by the earlier patent, and when a second applicant had first obtained the Great Seal, refused to antedate the patent of the first applicant, and ordered it to be dated as of the day of his application for the Seal, and this notwithstanding the conduct of the first applicant was alleged to be fraudulent.

Rival applications on same day.

Where, however, rival applicants had applied on the same day for patents for inventions alleged to be identical, and had afterwards mutually agreed to withdraw opposition, and one of the applicants, having obtained his patent, opposed the other at the Great Seal, and stated that the agreement only extended to proceedings before the law officer, Lord Cairns, C., being of opinion that the parties had agreed to withdraw opposition at all stages, treated both patents as having been unopposed, and sealed the second patent, dating it also the day of application (y).

And in similar circumstances, where, however, there had been no mutual agreement, the same learned Judge sealed both patents as of the day of the date of their respective applications; and after holding that the case was distinguishable from *Ex parte Bates and Redgate*, thus stated his objections to that case: "It has always seemed to me that if Parliament held out to inventors the advantage they should get from provisional protection, the inventor should have the enjoyment of that advantage for the six months given to him. Parliament intended the six months to be for the completion of the invention, and for the perfecting the specification, and never said that the applicant should be deprived of that advantage by want of any due diligence on his part." And again: "*Primâ facie* the Crown ought to seal both patents. The contract with each of them on provisional protection was that he should have six months' protection. Now, if it is true that both have acted in good faith, what right have I to confiscate the invention of one, because it happens to be identical with the invention of the other? Why should they not have become joint proprietors of this invention by agreement between themselves? I cannot see any reason why they should not, and, if so, why cannot they in effect be made co-proprietors by the grant of separate letters patent?" (z).

Effect of the rule in *Ex parte Bates and Redgate*.

Since the decision in *Ex parte Bates and Redgate* it has been necessary to get a patent sealed as soon as possible in order to prevent a

(x) L. R. 8 Ch. 60.

(y) *Re Gething*, L. R. 9 Ch. 633.

(z) *In re Dering's Patent*, 13 Ch. D. 393.

rival inventor from stepping in and obtaining a patent, and in a case where a patent agent retained to obtain a patent for an applicant had, in ignorance of this decision, followed the old practice, and the result had been that a rival inventor had first obtained the Great Seal, and the applicant was refused a patent, the agent was held liable in an action for negligence (a).

If two patents have been sealed for the same invention, acts done by virtue of the patent dated last are infringements of the first-dated patent (b). Infringement when two patents for same invention

Provisional Protection.

14. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is in this Act referred to as provisional protection. Provisional protection.

This provision is substantially the same as the corresponding provision in the Act of 1852, sect. 8, except as to the time of duration of the provisional protection.

The effect of provisional protection was thus stated by Lord Hatherley, C. (c), (referring to the Act of 1852):— Provisional protection.

“Under sect. 8” the patentee “may use his invention for six months (d) without prejudice to his patent by that user, but he obtains no rights against the public until his patent has been sealed, and even then the patent will not relate back to acts done in the interval. He is only protected against the consequences of his own publication, and thus may employ workmen and obtain machinery without the risk of being betrayed. But that is all, and he has no right or privilege against any other person. If he wishes to have more he may, under sect. 9, file a complete specification, and then he is absolutely protected for six months, and has a right to proceed as if he had a patent for that period.”

These latter words must now be read subject to the proviso at the end of the 15th section of this Act.

Protection by Complete Specification.

15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the Effect of acceptance of complete specification.

(a) *Lee v. Walker*, L. R. 7 C. P. 121.

(b) *Saxby v. Hennett*, L. R. 8 Ex. 210.

(c) *Ex parte Bates and Redgate*, L. R. 4 Ch. 578.

(d) Now for the period between date of application and date of sealing.

expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: Provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him.

The first clause of this section is a re-enactment with modifications of part of sect. 9 of the Act of 1852, which authorized the filing of a complete specification with the petition for letters patent.

Under that section it was held that the principle of *Ex parte Bates and Redgate* could not be applied to enable an applicant who lodged a complete specification to acquire the rights of a patentee so as during the term of protection to prevent any other person who had previously applied for a patent for a similar invention from obtaining a patent (e).

"*Provided that an applicant,*" &c. A re-enactment with modifications of the last clause of the 24th section of the Act of 1852. See note under sect. 13, *ante*.

Patent.

Ext-nt of
patent.

16. Every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man.

The Channel Islands, which under the Act of 1852, sect. 18, were included in letters patent, will be omitted from the patents to be granted under the present Act. See First Schedule, Form D.

Term of
patent.

17. (1.) The term limited in every patent for the duration thereof shall be fourteen years from its date.

(2.) But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to make the prescribed payments within the prescribed times.

(3.) If, nevertheless, in any case, by accident mistake or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the comptroller for an enlargement of the time for making that payment (a).

(4.) Thereupon the comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions:

(e) *Ex parte Henry*, L. R. 8 Ch. 167.

(a.) The time for making any payment shall not in any case be enlarged for more than three months.

(b.) If any proceeding shall be taken in respect of an infringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the Court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

(a) Patents Rules, 1883, *post*, rr. 46, 47. By r. 47 the time for doing any act or taking any proceeding under the Rules may be enlarged, and by r. 18 irregularities in procedure may be corrected.

(1.)

The term includes the day of the date, therefore the patent will expire at midnight of the 14th anniversary of the day before the date of the patent (*f*).

(2.)

See notes to sect. 8 (1), and First Schedule, Patents Rules, 1883, *post*.

(3) and (4.)

These provisions are new.

Amendment of Specification.

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

(2.) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the Patent Office of opposition to the amendment (*b*).

(3.) Where such notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer (*c*).

(4.) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition

(*f*) *Russell v. Ledson*, 14 M. & W. 574.

to the request, and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(5.) Where no notice of opposition is given, or the person so giving notice does not appear, the comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed.

(6.) When leave to amend is refused by the comptroller, the person making the request may appeal from his decision to the law officer.

(7.) The law officer shall, if required, hear the person making the request and the comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed.

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

(9.) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all Courts and for all purposes be deemed to form part of the specification.

(10.) The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.

(a) Patents Rules, 1883, *post*,
rr. 48-56.

(b) The notice is to state the
grounds of opposition. *Ibid.* 49.

(γ) The evidence is to be by declara-
tion (*Ibid.* 51), and before the law
officer witnesses may be cross-exa-
mined. Law Officers' Rules, *post*, r. IX.

(1.)

Disclaimers
under old law.

“*Disclaimer, correction, or explanation.*” The power to amend a specification or drawings by way of correction or explanation is new. The only amendment hitherto allowed, except in the case of clerical errors has been under the Act of 1835 (*g*), sect. 1, which gave power to file, with the leave of the law officer, “a disclaimer of any part of the title of the invention or of the specification,” or to enter with the like leave “a memorandum of any alteration in the said title or specification not being such disclaimer, or such alteration as should extend the exclusive right granted” by the letters patent.

Under this Act the only authority conferred on the patentee was “the power of rejecting” (*h*). The invention might be “reduced or

(*g*) 5 & 6 Wm. 4, c. 83.

(*h*) *Per* Lord Westbury, C., in
Ralston v. Smith, 11 H. L. C. 245.

diminished, but it must not be extended or enlarged" (*i*). But slight additions required to render intelligible what remains after something had been cut out of the specification were always admissible in a disclaimer (*k*), such, for instance, as the addition or transfer from a disclaimed part of the specification of the words "herein described" (*l*).

Mere clerical errors in a specification could be corrected on applica- Clerical errors, tion to the Master of the Rolls, as Keeper of the Records, on obtaining old law. the consent of the law officer (*m*); and it would seem that this course will still be necessary if the amendment of a clerical error would bring the specification within the mischief of sub-sect. 8. Except in such a case a clerical error in a specification can be corrected under this section, or under sect. 91 (*a*), and the Patents Rules, 1883, r. 18 (see Second Schedule, Form P, *post*).

In *Dixon's Patent* (*n*), the order for correction was only made on the undertaking of the petitioner not to sue any person in respect of infringements committed previously to the date of the order. But this undertaking was not required in the subsequent case of *Re Johnson's Patent* (*o*).

As to amendment of errors in patents or specifications, see the cases collected in 1 Webst., p. 647, in a note to *Re Sharp's Patent*, and "Hindmarch on Patents," c. viii, s. 3. In all cases notice of the correction was required to be given to the Commissioner of Patents (*p*).

From a case of *Re Pullan's Patent* (*q*), it seems that drawings omitted by inadvertence could not be added to a specification, and it may be a question whether the words of the present section are wide enough to include such an amendment.

In *Re Blamond's Patent* (*r*) an application to amend a clerical error was refused on the ground of delay.

(2.)

This and the following two sub-sections relate to opposed applications; unopposed cases are dealt with in sub-sects. 5, 6, and 7.

"*Any person.*" It does not appear that the applicant for leave to amend can object before the comptroller that the opposer is not a person entitled to be heard in opposition. This objection can apparently be only taken on appeal before the law officer under sub-sect. 4.

(3.)

Under the Act of 1835 there was no appeal on the question of leave to file a disclaimer (*s*). Under this sub-section either party may appeal

(*i*) *Foxwell v. Bostock*, 4 D. F. J. 298, 306

(*k*) *Per* Lord Westbury, C., *Ralston v. Smith*, 11 H. L. C. 245.

(*l*) *Thomas v. Welch*, L. R. 1 C. P. 192, 195.

(*m*) *Johnson's Patent*, L. R. 5 Ch. D. 503; *Sharp's Patent*, 1 Webst. 641, and cases cited in the notes to that case.

(*n*) Eng. Rep. Jan. to Mar. 1881, xvi.

(*o*) Eng. Rep. Ap. to June, 1881, xiii.

(*p*) *Re Dixon's Patent*; *Re Johnson's Patent*, *ubi sup.*; see also *Sharp's Patent*, 1 Webst. 649.

(*q*) Reported *Johnson's "Patentees' Manual,"* 4th ed. p. 103.

(*r*) 3 L. T. (N. S.) 800.

(*s*) *Medlock's Patent*; *Johnson's "Patentees' Manual,"* p. 187, 4th ed.

from the comptroller to the law officer. An appeal from the comptroller in unopposed cases is given by sub-sect. 6. There is no provision, however, for any appeal from the law officer, and his decision, it would seem, is final.

(4.)

The limitation of opposition in this sub-section is new. See the Act of 1835, sect. 1.

The law officers may now examine witnesses on oath, sect. 38, *post*.

Law officer
may now give
costs.

There was, under the Act of 1835, no power to give costs in disclaimer cases (*t*), but now, by sect. 38, *post*, the law officer is empowered to order payment of costs.

It does not appear that the comptroller has any power as to costs.

Conditions
limiting retro-
spective effect
of amendment.

“*Subject to what conditions, if any.*” Under the Act of 1835 it was provided (sect. 39) that no action should be brought on any letters patent on which a disclaimer had been filed in respect of any infringement prior to the disclaimer, without the leave of the law officer certified on his fiat. Under this section the law officers have been accustomed to impose conditions as to the user by opponents of apparatus in use before the disclaimer. The above provision is not contained in the present Act, but is replaced by sect. 20 (*post*). It appears, however (see note to (9)), that, subject to sects. 19 and 20, amendments will have a retrospective effect. The power of the law officer or of the comptroller to impose conditions on the allowance of amendments is, however, not limited by the Act, and it may therefore be useful to consider the cases under the old practice as to conditions limiting the right to sue on the amended specifications.

It was said by Sir A. E. Cockburn, A.G., that the cases where the disclaimer should be made retrospective and give the patentee power to proceed against those who have infringed before the disclaimer was filed are the exception and not the rule, and that it lies on the party applying for a certificate giving a disclaimer that retrospective power to make out a case entitling him to that certificate (*u*).

The law officer has also imposed terms preventing a patentee from suing in respect of continued infringements by the use of certain specified machines actually in use before the disclaimer (*x*), and in one case this principle was extended so as to prohibit suits in respect of new infringements committed by particular persons by the continued use of a process employed by them at the date of the disclaimer (*y*).

And in *Smith's Patent* (*z*) Sir A. J. E. Cockburn, A.G., said that the

(*t*) *Kynock v. National Small Arms Co., Limited*, 37 L. J. (N. S.) 31

(*u*) *Per* Sir A. J. E. Cockburn, A.G., *Lucas' Patent*, Macr. Pat. Cas. 234, 239.

(*x*) *Harrison's Patent*, Macr. Pat. Cas. 31.

(*y*) *Re Medlock's Patent*, Newton's

“*London Journal*,” vol. 22 (N. S.) p. 69. See, however, the earlier case of *Lucas' Patent*, cited above, when Sir A. J. E. Cockburn, A.G., said he ought not to impose a condition that the opponent should have a licence to continue his manufacture

(*z*) Macr. Pat. Cas. 232, 234.

undertaking not to sue in respect of past infringements must be general enough to include not only those who appeared and opposed the allowance of the disclaimer, but every one. However, in the same case he refused to prohibit the patentee from suing in respect of infringement after the disclaimer committed by persons who had previously entered into contracts for the supply of the patented article, and who asked that their immunity from suit should extend up to the termination of those contracts.

When the patent has been allowed to remain in its imperfect state for a long time, and manufacturers have embarked large capital in the trade, the law officer has imposed conditions for their protection (a).

There are some cases in which it is proper that a disclaimer should be retrospective.

“It is not right that a person should gain his information from a patentee, and, acting on that information, copy and use his invention. He must not presume upon some defect in the specification and infringe upon the valuable part of the patent” (b). And when this appeared to have been done, and the opponent had worked in secret, and had otherwise acted unfairly, the Attorney-General considered it right that the opponent should pay for his past infringement, and imposed on him the payment of a definite sum as a condition of the patentee not being allowed to bring an action for infringements prior to the disclaimer (c).

Disclaimers
sometimes
retrospective.

(8.)

“*Substantially larger than,*” &c. These words, it will be observed, are considerably wider than the corresponding words of the Act of 1835, but under that Act it was held that a patentee could not by disclaimer convert a bad specification, in the sense of its containing no description of any useful invention at all, into a good specification by adding words that would convert “a barren and unprofitable generality” into a specific and definite and practical description. Nor, when the original description was wholly bad, and contained no new invention, could it be converted into a description containing a good invention, nor could the patentee by disclaimer make material additions to the original specification, so as by the aid of the corrected form of words, and the additions so made, to introduce into the specification an accurate and perfect description of an invention which was sought for in vain in the original specification (d).

Amended
specification
not to claim
invention
larger than
or different
from that in
original
specification.

Thus, where a patentee of improvements in embossing fabrics claimed the use of grooved, fluted, or indented rollers of metal, wood, or other suitable material, driven at a greater speed than the bowl or bowls connected with them, so as to exert a rubbing action on the fabric, and

(a) *Tranter's Patent; Jones' Patent*, reported Johnson's "Patentees' Manual," 4th ed. p. 182. *Lucas' Patent*, Macr. Pat. Cas. 238.
 (b) *Per Sir A. J. E. Cockburn, A.G.* (c) *Lucas' Patent, ubi sup.*
 (d) *Per Lord Westbury, C., Ralston v. Smith*, 11 H. L. C. 243, 244.

thereby produce an indefinite variety of pattern, and afterwards disclaimed the use of any pattern rollers except metal rollers with circular grooves, and it appeared that only circular grooves would produce the effect required, and further that the making the roller and bowl revolve at different speeds was not new, it was held that the disclaimer extended the exclusive right granted by the patent, and that the patent was therefore bad. These rollers not being specifically described in the original specification, but merely involved in the general terms used, the patentee had not sufficiently described his invention, and therefore when by disclaimer he confined his claim to circular grooved rollers as his sole invention, though in one sense he might be said to narrow a right, yet he really extended it, because he thereby described his invention sufficiently to enable him to assert a right which he never could have successfully maintained upon the original specification alone (*e*).

But when a specification of a patent for an improvement in machinery for roving cotton described a particular method of the application of centrifugal force, and claimed the "application of the law or principle of centrifugal force to the particular or special purpose above set forth," and by a disclaimer he declared that he intended to claim only the application of centrifugal force in the manner described in the specification, the specification thus amended was held good (*f*).

So under a patent for "improvements in instruments used for writing and marking, and in the construction of inkstands," a patentee disclaimed four out of eleven parts of his invention, the parts disclaimed relating to pens and to instruments used for marking with a stamp, the parts which remained untouched by the disclaimer being for improvements relating to penholders, pencil-cases, and in the construction of inkstands, it was held that the specification as amended satisfied the title of the letters patent and that the patent was good (*g*).

Claiming clauses might formerly be struck out on disclaimer.

And all the claiming clauses might be struck out of the specification if there remained in the body of the specification words sufficiently distinguishing what invention the patentee claimed (*h*).

(But it would seem that, having regard to sect. 5, sub-sect. 5, of the present Act, this could not be done now.)

Jurisdiction of Master of the Rolls as Keeper of Records.

In *Re Sharp's Patent* (*i*) it was held that the Master of the Rolls had no authority as Keeper of the Records to remove from the records of the Court of Chancery a memorandum of alteration which had been enrolled, the application being grounded on an allegation that the memorandum of alteration extended the exclusive right granted by the patent.

But when a disclaimer was filed without the consent of the patentee, it was held that the Master of the Rolls, as Keeper of the Records, had jurisdiction on the motion of the patentee, without bill filed, to take it off the file (*k*).

(*e*) *Ralston v. Smith*, 11 H. L. C. 223, 254; and see *Lucas' Patent*, Macr. P. C. 235, 236.

(*f*) *Seal v. Higgins*, 8 H. L. C. 550.

(*g*) *R. v. Mill*, 10 C. B. 379.

(*h*) *Thomas v. Welch*, L. R. 1 C. P. 192.

(*i*) 1 Webst. 641.

(*k*) *Re Berdan's Patent*, L. R. 20 Eq. 346.

The effect of a disclaimer is merely to strike out from the specification those parts of the machinery which are disclaimed. It cannot operate by way of a claim of the residue, nor can what remains of the specification be construed by the disclaimer (*l*).

The reasons for the disclaimer form no part of the specification as amended by it, and ought not to be referred to in construing such amended specification (*m*).

The mere fact of entering a disclaimer as to part of a specification does not necessarily import that the patent is bad (*n*).

(9.)

A re-enactment of part of sect. 39 of the Act of 1852.

Under the Act of 1835 it was doubted whether, when the disclaimer violated the statutory condition, it was not itself void (*o*). There was no express enactment that the disclaimer, if it transgresses the statutory limit by extending the exclusive right, shall be void to all intents and purposes, but it was said that it might be proper to hold that the disclaimer is as inoperative for the excess only (*p*). This would appear to apply also to amendments under the present Act.

“*Except in case of fraud.*” Such, for instance, as where leave was given to file a disclaimer on certain conditions which the patentee refused to accept, and the disclaimer was afterwards filed without his consent (*q*).

“*Shall in all Courts and for all purposes,*” &c. A re-enactment of the corresponding part of sect. 1 of the Act of 1835. Amendments retrospective.

Under that Act it was held in *Perry v. Skinner* that a disclaimer was not retrospective, so as to enable an action to be brought in respect of an infringement committed prior to the disclaimer (*r*). But in *R. v. Mill* (*s*) the correctness of the decision in *Perry v. Skinner* was doubted, and it was held that the disclaimer was to be considered as part of the original specification as from the date of the letters patent, except in pending actions, an exception expressly made by a proviso in sect. 1. And one ground of the decision was that otherwise the proviso as to pending actions would be inoperative. This present Act does not contain the proviso of sect. 39 of the Act of 1852, mentioned above, nor any restriction on the retrospective effect of amendments, except (10) *post*, and sect. 19 (which deal only with pending actions), and sect. 20. The ground of decision in *R. v. Mill*, above mentioned, appears to apply equally to the last-mentioned sections, and it is therefore submitted that the words at the head of this note will receive the construction

(*l*) *Per* Cresswell, J. *Tetley v. Easton*, 2 C. B. (N. S.) 730.

(*m*) *Cannington v. Nuttall*, L. R. 5 H. L. C. 205, 228.

(*n*) *Per* Tindal, C. J., *Stocker v. Warner*, 9 Jur. 136, 138, 1 C. B. 198.

(*o*) *Foxwell v. Bostock*, 4 D. F. J. 298.

(*p*) *Foxwell v. Bostock*, *ubi sup.*

(*q*) *Re Berdan's Patent*, L. R. 20 Eq. 346.

(*r*) 1 Webst. 250; *Stocker v. Warner*, 1 C. B. 148.

(*s*) 10 C. B. 379.

given in *R. v. Mill* to the corresponding words of the Act of 1835, and that subject to the provisions of sub-sect. 10 and sect. 19, and in the absence of conditions to the contrary imposed by the law officer or comptroller, actions may be brought in respect of infringements committed prior to the amendment.

(10.)

This must be read in connection with sect. 19, *post*, and it is presumed will be construed to mean that the provisions of sect. 18 are not to apply to patents in respect of which legal proceedings are pending, except in cases provided for by the 19th section. Otherwise the 19th section will not work at all, since on a strict construction of sect. 18, sub-sect. 10, there will be no jurisdiction in the case of such patents to entertain applications for amendment, notwithstanding the party may, under sect. 19, obtain leave to make the application. The difficulty arises from the circumstance that when the Bill was introduced into the House of Commons the 19th section gave power in pending actions for the Court or a Judge to allow the plaintiff to disclaim, and to give the disclaimer in evidence, and the section was altered to its present form in its passage through Parliament. It will be noticed that the marginal note to sect. 19 is incorrect, as also the figure (1) in brackets.

Power to
disclaim part
of invention
during
action, &c.

19. (1.) In an action for infringement of a patent, and in a proceeding for revocation of a patent, the Court or a Judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the Court or a Judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed (a).

(a) Patents Rules, 1883, r. 56.

A disclaimer could, under the express terms of the Act of 1835, be received in evidence in an action of *scire facias* commenced before it was filed (t), and when after the disclaimer the action failed the prosecutor had to pay all the costs subsequent to the disclaimer (u).

But where a disclaimer had been filed after the commencement of a suit for injunction, it was held that the suit could not be continued by amendment of the bill, but a fresh bill must be filed (v).

And a patentee having obtained an injunction and then altered his specification by disclaimer, was held not entitled to enforce the injunction (x).

Now, however, all pending proceedings, whether for infringement

(t) *R. v. Mill*, 10 C. B. 379.

(u) *R. v. Mill*, 11 Bea. 312.

(v) *Lister v. Leather*, 3 Jur. (N. S.)

(x) *Dudgeon v. Thomson*, 3 App.

Cas. 34.

or for revocation of the patent (*post*, sect. 26) will be governed by this and the preceding section (see note to sect. 10), and in a proper case it is presumed the Court may order the amendment, when made, to be given in evidence.

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

Restriction on recovery of damages.

This provision is new. It will probably render it unnecessary on allowance of an amendment of a clerical error in a specification, to require the condition imposed in *Dixon's Patent* (*y*). It does not appear to limit in any way the power of the law officer or the comptroller to impose conditions as to actions in respect of infringements committed before amendment.

21. Every amendment of a specification shall be advertised in the prescribed manner (*a*).

Advertisement of amendment.

(*a*) Patents Rules, 1883, *post*, r. 56.

Compulsory Licences (a).

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

Power for Board to order grant of licences.

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

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

(*c*) Any person is prevented from working or using to the best advantage an invention of which he is possessed,

the Board may order the patentee to grant licences on such terms as to the amount of royalties, security for payment, or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

(*a*) See notes under Patents Rules, 1883, *post*, rr. 58-64.

(*y*) Eng. Rep. Jan. to Mar. 1881, xvi.

*Register of Patents.*Register of
patents.

23. (1.) There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed (a).

(2.) The Register of Patents shall be *prima facie* evidence of any matters by this Act directed or authorized to be inserted therein.

(3.) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.

(a) Patents Rules, 1883, *post*, rr. 64-76.

See *post*, sects. 87, 88, 89, 90, 91, 93.

The Act of 1852 provided (sect. 34) for a Register of Patents, and (sect. 35) for a Register of Proprietors. Under the present Act there will be no separate Register of Proprietors, but all the matters included in that Register will be entered on the Register of Patents.

Under the Act of 1852 it was held that the Register of Proprietors was to contain not merely a register of documents, but any other fact which the Court or the Commissioners might think it desirable should be entered on the Register (z).

It was not the practice of the Patent Office to enter on the Register of Proprietors documents affecting provisional protections only (a), and it is presumed this rule will still prevail, since this and the other sections of the present Act refer in terms to "patents," that is, by sect. 46, "letters patent."

The office would register deeds of trust (b), but now this will not be done (sect. 85).

*Fees.*Fees in
schedule.

24. (1.) There shall be paid in respect of the several instruments described in the Second Schedule to this Act, the fees in that schedule mentioned, and there shall likewise

(z) *Re Morrey's Patent*, 25 Bea. 583.

(a) Johnson's "Patentees' Manual," 4th ed. p. 221.

(b) *Ibid.*

be paid, in respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury may from time to time direct (a).

(2.) The Board of Trade may from time to time, if they think fit, with the consent of the Treasury, reduce any of those fees.

(a) Patents Rules, 1883, rr. 42-45. See *post*, under sect. 45.

Extension of Term of Patent.

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

Extension
of term of
patent on peti-
tion to Queen
in Council.

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

(3.) If Her Majesty shall be pleased to refer any such petition to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same, and the petitioner and any person who has entered a caveat shall be entitled to be heard by himself or by counsel on the petition.

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

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

(6.) It shall be lawful for Her Majesty in Council to make,

from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee (a).

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

(a) No Rules have been made under the present Act. The old Rules are therefore in force (see Judicial Committee Rules, *post*).

The powers of the Judicial Committee to grant extensions were conferred by the repealed Acts 5 & 6 Wm. 4, c. 83, s. 4, and 2 & 3 Vict. c. 67.

By the first of these Acts (sect. 3) power was also given to the Judicial Committee to confirm letters patent in certain cases where the patentee, though a real inventor, was not the first inventor. The jurisdiction has been very little exercised, and is not re-enacted in the present Act.

The Judicial Committee may now call in an assessor in extension cases (see sect. 28 (2) *post*).

(1.)

Application
by assignees.

“*Patentee.*” This word (sect. 46) includes the person for the time being entitled to the benefit of a patent. An assignee can, therefore, as he could under the old Acts (c), obtain an extension. But an assignee has not been viewed with the same favour as the original patentee (d), and applications by assignees when no benefit could come to the patentee have been refused (e). Moreover, conditions for the benefit of the patentee have, where extension has been granted to assignees, been inserted in the new letters patent (f), and when a petition was presented by a patentee and his mortgagees extension has been granted to the patentee alone (g).

But extension may be granted to an assignee without any such conditions as above, if the patentee has ceased to have any connection with the working of the patent (h), or has received a large sum from the assignee (i).

(c) 5 & 6 Wm. 4, c. 83; 7 & 8 Vict. c. 69; *Russell v. Ledsam*, 14 M. & W. 588, affirmed 1 H. L. C. 687.

(d) *Norton's Patent*, 1 Moo. P. C. (N. S.) 39; *Claridge's Patent*, 7 Moo. R. C. 394; *Normand's Patent*, 1. R. 3 P. C. 193.

(e) *Norton's Patent*, *ubi sup.*; *Pitman's Patent*, L. R. 4 P. C. 87.

(f) See *post*, p. 41.

(g) *Borill's Patent*, 1 Moo. P. C. (N. S.) 348.

(h) *Napier's Patent*, 13 Moo. P. C. 543.

(i) *Bodmer's Patent*, 6 Moo. P. C. 469.

An agreement by a patentee to grant an exclusive licence to a company, and to obtain an extension of the patent, was held to be against public policy, and an application for extension by the patentee was refused (*j*).

The assignee's title must be strictly proved, whether admitted or not (*k*). An equitable assignee cannot appear as co-petitioner unless his name has been inserted in the advertisements (*l*).

"*Petition.*" Prolongation is a matter of favour and not of right (*m*), and a petitioner seeking the grace and favour of the Crown is bound to strict truth, to *uberrima fides*, in his statements (*n*), and in *Pitman's Patent* (*o*) the Judicial Committee stated that for the future they would invariably act on the principle that a petition which failed to state everything belonging to the patent fairly and fully should therefore be dismissed.

Among the matters which should be thus stated in the petition were the names and dates of, and material facts affecting, any foreign patents obtained by the English patentee. This was mainly in regard to the 25th section of the Patent Act, 1852 (now repealed and not re-enacted in the present Act, see *post*, under sect. 45), which made the duration of an English patent depend in certain cases on the date of the foreign patent (*p*). But the petitioner is also bound to state in his petition and accounts the remuneration which the patentee has derived from his foreign patents, as well as from his English patent (*q*).

So also where the petition was nominally by one company, but really was for the benefit of another company, to whom the shares in the first company had been transferred, and no statement of this fact appeared in the petition, and the real facts were only brought forward by the Attorney-General, the omission to state the real circumstances was held sufficient ground for refusing the petition (*r*).

In *Hutchinson's Patent* (*s*) a petitioner was allowed to amend his petition, but the rules above stated had not then been expressly laid down. A petitioner, however, who had, in ignorance of their Lordships' rule, omitted in his petition to give the proper information as to his foreign patents, was allowed, on application made before the hearing, to add a supplementary paper giving the necessary information (*t*).

"*Such petition must be presented,*" &c. Under the repealed Acts (*u*) the presentation of the petition six months before the expiration of the patent was only required in cases where the petition was not prose-

(*j*) *Cardwell's Patent*, 10 Moo. P. C. C. 488.

(*k*) *Galloway's Patent*, 1 Webst. 725; *Wright's Patent*, 1 Webst. 561.

(*l*) *Noble's Patent*, 7 Moo. P. C. 191.

(*m*) *Adair's Patent*, 6 App. Cas. 178.

(*n*) *Clark's Patent*, L. R. 3 P. C. 421, 426; *Johnson's Patent*, L. R. 4 P. C. 75, 83.

(*o*) L. R. 4 P. C. 86; see also *Adair's Patent*, 6 App. Cas. 178.

(*p*) *Johnson's Patent*, L. R. 4 P. C. 82; *Pitman's Patent*, L. R. 4 P. C.

81; *Adair's Patent*, 6 App. Cas. 178.

(*q*) *Johnson's Patent*; *Adair's Patent*, *ubi sup.*

(*r*) *Reece's Patent*, Eng. Rep. Jan. to Mar. 1881, xiv.

(*s*) 14 Moo. P. C. 364.

(*t*) *Reece's Patent*, Eng. Rep. Jan. to Mar. 1881, xiv.

(*u*) 5 & 6 Wm. 4, c. 83, s. 4; 2 & 3 Vict. c. 67, s. 2.

cuted with effect during the existence of the patent. The requirement is now general.

Opposition.

“*Any person.*” There is no requirement of interest in the opponent as in the case of opposition to the grant of patents or the amendment of specifications (sect. 11 (3) and sect. 18 (4)) (*x*). See *post*, under (7) “*Costs.*”

“*Caveat.*” The caveat must be entered in the name of the actual opposer, not in that of his agent (*y*).

The statutory provisions as to particulars of objections were held not to apply to proceedings for extension under the old Acts, and opponents who had objected on the ground of want of novelty were allowed to give evidence of instances not mentioned in their objections (*z*). The present Act, like the repealed Acts, contains no provision requiring particulars of objection in extension cases.

(3.)

The Judicial Committee had, under sect. 4 of the Act of 1835, jurisdiction to entertain a petition referred to them by the Crown, seeking to revoke an Order in Council made on their recommendation, on an application by patentees for a prolongation of letters patent, and to recall the warrant for sealing (*a*).

“*By counsel.*” The Judicial Committee will not hear in opposition more than two counsel in the same interest (*b*). The Attorney-General always appears, whether the extension be opposed or not, to watch the case on behalf of the Crown (*c*), and he so far represents the Government and the public generally that a Government Department who had not entered a caveat in time were not allowed, the Attorney-General being present, to enter a caveat and be heard in opposition (*d*). See also Judicial Committee Rules, *post*, under r. IX.

(4.)

The rules laid down by this and the next sub-section do little more than state in express terms the practice which has hitherto been followed by the Judicial Committee in applications for extension under the repealed Acts. “The general object of the statutable jurisdiction of the Committee, in respect to advising an extension of the terms of the letters patent, is the reward of the inventor in cases where there has been extraordinary merit in the invention, but where, from circumstances, he has failed to reap any adequate remuneration for his invention during the currency of the term of the letters patent” (*e*).

Merit of invention.

“*Nature and merits,*” &c. It is of course not easy to define the degree of merit which will justify extension of a patent.

- | | |
|---|--|
| (<i>x</i>) <i>Lowe's Patent</i> , 8 Moo. 1. | (<i>d</i>) <i>Pettit Smith's Patent</i> , 7 Moo. 133. |
| (<i>y</i>) <i>Lowe's Patent</i> , <i>ubi sup.</i> | (<i>e</i>) <i>Per Sir J. Colvile, Pitman's Patent</i> , L. R. 4 P. C. 87; see also <i>Honiball's Patent</i> , 9 Moo. P. C. 393; <i>Markwick's Patent</i> , 13 Moo. P. C. 313; <i>Derosne's Patent</i> , 2 Webst. 4; <i>Norton's Patent</i> , 1 Moo. P. C. (N. S.) 339. |
| (<i>z</i>) <i>Ball's Patent</i> , L. R. 4 App. Cas. 171. | |
| (<i>a</i>) <i>In re Schlumberger</i> , 9 Moo. P. C. 1. | |
| (<i>b</i>) <i>Woodcroft's Patent</i> , 3 Moo. P. C. 172, n. | |
| (<i>c</i>) 1 Webst. 557, n. | |

An invention "may have been the successful result of long and patient labour, and of great and unaided ingenuity, without which, for all that appears, the public would never have had the benefit of the discovery; or it may have been but a happy accident or a fortunate guess; or it may have been very closely led up to by an earlier and, in a true sense, more meritorious but still incomplete experiment. Different degrees of merit must surely be attributed to an inventor under these different circumstances" (*f*).

The smallness of the step made is not to lead to any inference against the merit of the invention (*g*), nor is it any objection that great improvements have been made on the original invention (*h*), nor that the invention is an improvement on a former patent taken out by the patentee in consequence of a communication from abroad (*i*), nor that some alteration has since the patent been made in the actual working of the invention (*k*).

But if the original invention was a failure, there is no ground for extension, although the defect has since been remedied (*l*).

So also where the invention as described in the specification succeeded to a limited extent, but was only rendered a success by improvements introduced from abroad by persons other than the patentee (*m*).

The fact that the patent may tend to fetter the public in the use of known sanitary agents has been considered a reason for refusing extension (*n*).

The public utility of the invention is an essential element to be taken into account on the question of extension (*o*).

Utility in relation to merit.

The utility to be considered is not that amount of utility which would be necessary to support a patent, but that kind of utility which might more properly be described as merit (*p*).

Where the invention has not been brought into use notwithstanding the efforts of the patentee, there is a very strong presumption against its utility (*q*). But this presumption may be rebutted (*r*), as where the subject of the invention has a limited market (*s*) or is an article which would not

(*f*) *Per Coleridge, J., Hills' Patent*, 1 Moo. P. C. (N. S.) 265.

(*g*) *Soames' Patent*, 1 Webst. 735; *Derosne's Patent*, 4 Moo. P. C. 418.

(*h*) *Galloway's Patent*, 1 Webst. 727.

(*i*) *Borill's Patent*, 1 Moo. P. C. (N. S.) 348.

(*k*) *Heath's Patent*, 2 Webst. 257.

(*l*) *Bell's Patent*, 2 Webst. 160.

(*m*) *Woodcroft's Patent*, 1 Webst. 740.

(*n*) *McDougal's Patent*, L. R. 2 P. C. 1; *McInnes' Patent*, L. R. 2 P. C. 54.

(*o*) *Woodcroft's Patent*, 2 Webst. 29; *Betts' Patent*, 1 Moo. P. C. (N. S.)

49; *McDougal's Patent*, L. R. 2 P. C. 1.

(*p*) *Saxby's Patent*, L. R. 3 P. C. 294. See also *Betts' Patent*, *ubi sup.*

(*q*) *Allan's Patent*, L. R. 1 P. C. 507; *Simister's Patent*, 1 Webst. 723; *Bakewell's Patent*, 15 Moo. P. C. 385.

(*r*) *Allan's Patent*, L. R. 1 P. C. 507; *Bakewell's Patent*, 15 Moo. P. C. 385; *Hughes' Patent*, 4 App. Cas. 174.

(*s*) *Herbert's Patent*, L. R. 1 P. C. 39; *Ruthven's Patent*, Johnson's "Patentees' Manual," 4th ed., p. 210.

be used by the public generally, as a soldier's knapsack (*t*), or was of such a nature as not to be likely to come into immediate use (*u*), or where the article would not be likely to be remunerative within the ordinary term of a patent (*r*), or was an article which the public viewed with distrust (*q*), or where, from circumstances beyond the control of the patentee, its merits had not been sufficiently appreciated (*z*).

Circumstances
in favour of
extension.

So also effect will be given in favour of extension to the circumstance that the invention had been violently resisted in the trade (*a*), that litigation had prevented the patentee and his assignees from receiving remuneration (*b*), or that the patentee had been in embarrassed circumstances (*c*).

And in every case where the invention has not been actually used the question is whether the evidence is sufficient to rebut the presumption arising from its non-use that the invention is one of no practical utility, and where there was strong and unanswered evidence of utility an extension was granted, although the invention had not been used in England during the whole term (*d*).

But it is not enough to rebut the presumption of inutility to allege that the invention can only be carried on by a company, and that existing companies would not adopt it (*e*).

Profits of
patent to be
shown.

"*Profits made by the patentee as such.*" An applicant for prolongation has always been required to produce to the Judicial Committee accounts showing in the clearest manner the *profit and loss* of working the patent (*f*), and the *onus* is upon him of satisfying the Committee, in a manner which admits of no controversy, what has been the amount of remuneration which, in every point of view, the invention has brought to him, and it is his duty to frame his accounts in such a shape as to leave no doubt on this point (*g*).

Necessity of
accurate
accounts.

For this purpose the patentee should be prepared to give the clearest evidence of everything which has been paid and received on account of the patent, and should keep distinct and separate patent accounts (*h*).

The balance-sheet is to be handed over to the Solicitor for the Treasury before the hearing (*i*).

Profits of
licensees to be
included.

It must be remembered that the question is not what the patentee

(*t*) *Berrington's Case*, cited in *Hughes' Patent*, 4 App. Cas. 179, and Higgins' "Digest," p. 274.

(*u*) *Southworth's Patent*, 1 Webst. 487.

(*x*) *Jones' Patent*, 1 Webst. 579.

(*y*) *Payne's Patent*, cited Higgins' "Digest," p. 266.

(*z*) *Kollmann's Patent*, 1 Webst. 565.

(*a*) *Roberts' Patent*, 1 Webst. 573; *Stafford's Patent*, 1 Webst. 563.

(*b*) *Pettit Smith's Patent*, 7 Moo. P. C. 133; *Heath's Patent*, 2 Webst. 257.

(*c*) *Wright's Patent*, 1 Webst. 575; *Southworth's Patent*, *ubi sup.*

(*d*) *Hughes' Patent*, 4 App. Cas. 174.

(*e*) *Bakewell's Patent*, 15 Moo. P. C. 385.

(*f*) *Trotman's Patent*, L. R. 1 P. C. 118; *Betts' Patent*, 1 Moo. P. C. (N. S.) 49; *Hills' Patent*, 1 Moo. P. C. (N. S.) 258.

(*g*) *Sarby's Patent*, L. R. 3 P. C. 292; *Clark's Patent*, L. R. 3 P. C. 421.

(*h*) *Betts' Patent*, 1 Moo. P. C. (N. S.) 61; *Adair's Patent*, 6 App. Cas. 178.

(*i*) *Perkins' Patent*, 2 Webst. 14.

has received, but what has been made, or by proper judgment and application might have been made, by the patent, and therefore the profits made by licensees must appear in the accounts (*k*), and the applicant must also show what are the profits derived from any foreign patents he may have for the invention, as well as the profits from the English patent (*l*), and also the profits from the sale of the patented article for exportation (*m*). And of foreign patents.

The remuneration from the patent as a whole is to be looked to (*n*).

An allowance may be made in the accounts to a patentee who is a manufacturer for his personal superintendence of the business of the patent (*o*), and a patentee may deduct his personal expenses for the exclusive devotion of his time in bringing the invention into practical operation and public notice (*p*). Allowances in accounts.

But where the patentee did not manufacture but only granted licences, a charge for expenses in visiting and superintending the licensees' establishments was disallowed (*q*).

An allowance may also be made for the expenses of taking out and defending the patent (*r*) and for experiments (*s*).

But though deductions for law expenses in defending the patent are in general a fair head of deduction, still, if the patentee has compromised actions and given up claims to costs to which he had an apparent title, it is not proper to deduct these expenses in an unexplained lump (*t*).

A foreign patentee residing abroad may also be allowed to deduct moneys paid by him to an agent for the purpose of getting the patented article into use in England (*u*).

Where a patentee had sold his patent for a small sum when it was thought to be of little value, and afterwards bought it back at an increased value, the item was not allowed in the accounts as one of loss (*x*).

The Judicial Committee have also required that the profits made by the patentee as manufacturer, although not in a strict point of view profits of the patent, should be taken into consideration on the question of remuneration. It may be that possession of the patent virtually Manufacturers' profits to be taken into account.

- (*k*) *Trotman's Patent*, L. R. 1 P. C. 123; *Sarby's Patent*, L. R. 3 P. C. 298; *Hills' Patent*, 1 Moo. P. C. (N. S.) 258, 268.
- (*l*) *Johnson's Patent*, L. R. 4 P. C. 82 (disapproving of *Poole's Patent*, L. R. 1 P. C. 517); *Adair's Patent*, 6 App. Cas. 178.
- (*m*) *Hardy's Patent*, 6 Moo. P. C. 441.
- (*n*) *Perkins' Patent*, 2 Webst. 9.
- (*o*) *Perkins' Patent*, 2 Webst. 8, 17; *Roberts' Patent*, 1 Webst. 575.
- (*p*) *Carr's Patent*, L. R. 4 P. C. 539; *Newton's Patent*, 14 Moo. P. C. 156; *Roberts' Patent*, 1 Webst. 575.
- (*q*) *Trotman's Patent*, L. R. 1 P. C. 125.
- (*r*) *Roberts' Patent*, 1 Webst. 575; *Kay's Patent*, 1 Webst. 572; *Galloway's Patent*, 1 Webst. 729; *Betts' Patent*, 1 Moo. P. C. (N. S.) 49.
- (*s*) *Kay's Patent*, 1 Webst. 572.
- (*t*) *Hills' Patent*, 1 Moo. P. C. (N. S.) 258, 268.
- (*u*) *Poole's Patent*, L. R. 1 P. C. 514.
- (*x*) *Weild's Patent*, L. R. 4 P. C. 89.

secures to the patentee his power of commanding orders as a manufacturer (*g*). In such a case it was held that the two heads of profit could not be severed, and a very considerable sum having been in fact received, an extension was refused (*z*). And this principle was applied to manufacturing profits arising from the manufacture of the materials of which the patented article was made (*a*).

But deductions for these sometimes allowed.

The principle, however, was not to be pushed to an unreasonable extreme (*b*), and in some cases the profits as manufacturer have been deducted in ascertaining the profits of the patent (*c*). But the Committee refused to accept as reasonable, without explanation, an estimate by the patentee that the manufacturing profits were two-thirds of the total profits (*d*).

Practice when accounts imperfect.

The hearing of a petition has been adjourned for the purpose of enabling the petitioner to produce further evidence as to his profits, but this was only as an indulgence (*e*), and would probably not be now allowed (*f*). And where accounts were unsatisfactory, extension was refused even though the Committee considered the invention meritorious, and were not satisfied that the petitioner had been sufficiently remunerated (*g*).

If the accounts are on the face of them unsatisfactory, the Committee will adjudicate on the accounts without reference to the merits of the invention (*h*); but if the accounts are *prima facie* satisfactory, the petitioner will be allowed to prove the merits without going first into the accounts (*i*).

Opposers have not been allowed production and inspection of the petitioner's accounts prior to the hearing (*k*), but under the Judicial Committee's rules they can obtain copies of the accounts lodged by the petitioner. See Judicial Committee Rules, rr. VII, IX, *post*.

"*All the circumstances of the case.*" It has been considered that it is no objection to an extension that during the existence of the patent an Act of Parliament has been passed which might in effect compel the use of the patented article (*l*).

The applicant must show that he has used his best endeavours to

(*g*) *Sarby's Patent*, L. R. 3 P. C. 295; *Betts' Patent*, 1 Moo. P. C. (N. S.) 49; *Hills' Patent*, 1 Moo. P. C. (N. S.) 258; *Johnson's Patent*, L. R. 4 P. C. 75.

(*z*) *Muntz's Patent*, 2 Webst. 121; see also *Sarby's Patent*, L. R. 3 P. C. 292.

(*a*) *Newton's Patent*, Eng. Rep. Jan. to Mar. 1881, xvi.

(*b*) *Hills' Patent*, 1 Moo. P. C. (N. S.) 258, 270.

(*c*) *Betts' Patent*, 1 Moo. P. C. (N. S.) 49; *Galloway's Patent*, 1 Webst. 729.

(*d*) *Hills' Patent*, *ubi sup*.

(*e*) *Perkins' Patent*, 2 Webst. 17; *Heath's Patent*, *Ibid.* 256.

(*f*) See *Clarke's Patent*, L. R. 3 P. C. 421.

(*g*) *Adair's Patent*, 6 App. Cas. 178.

(*h*) *Sarby's Patent*, L. R. 3 P. C. 292; *Clark's Patent*, L. R. 3 P. C. 421; *Weild's Patent*, L. R. 4 P. C. 89.

(*i*) *Houghton's Patent*, L. R. 3 P. C. 461.

(*k*) *Bridson's Patent*, L. R. 7 Moo. P. C. 499.

(*l*) *Foarde's Patent*, 9 Moo. P. C. 376.

introduce his invention (*m*). If he has slumbered on his rights and permitted parties to infringe with impunity (*n*), or if there has been intentional delay on his part in bringing out the invention (*o*), or the proper working the invention has been postponed by reason of disputes between the co-owners of the patent (*p*), extension may be refused. And in any case he must prove that the circumstances have ceased which prevented the invention being lucrative, and that it is really coming into use (*q*).

The merit of an importer is less than that of an inventor (*r*), but in a proper case an importer may obtain an extension (*s*). Imported inventions.

The circumstances, however, that the invention was imported, and that the owners of the English patent were foreigners, who made the article abroad and sent it over to England for sale, were considered as being against a prolongation (*t*).

The fact that the patentee at a late period of the patent disclaimed part of the invention has been urged, and apparently successfully, against an extension, as, if granted, it would interfere with what others had been doing in reliance on the invalidity of the patent (*u*).

In applications by assignees the Judicial Committee have considered in some respects the expenses incurred by the assignee in bringing the patent into notice, and the merit of the assignee patronizing the patentee, but the general rule is, as was stated by Lord Brougham in *Morgan's Patent* (*v*), that "they are, though not directly, yet mediately and consequentially, as it were, giving a benefit to the inventor, because, if the assignee is not remunerated at all, it might be said that the chance of the patentee of making an advantageous conveyance to the assignee would be materially diminished, and consequently his interest damnified" (*x*). Assignees.

An English patent may be renewed though a foreign one taken out by the same inventor for the same invention has been allowed to expire (*y*).

It has never been the practice of the Judicial Committee to decide on the validity of a patent, though they would abstain in any case from prolonging a patent which was manifestly bad (*z*). A *prima facie* case of validity was all that was required, the question being left to the Validity how far considered.

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| <p>(<i>m</i>) <i>Honiball's Patent</i>, 9 Moo. P. C. 393; <i>Norton's Patent</i>, 1 Moo. P. C. (N. S.) 339.</p> <p>(<i>n</i>) <i>Simister's Patent</i>, 1 Webst. 723.</p> <p>(<i>o</i>) <i>Norton's Patent</i>, 1 Moo. P. C. (N. S.) 339.</p> <p>(<i>p</i>) <i>Patterson's Patent</i>, 6 Moo. P. C. 469.</p> <p>(<i>q</i>) <i>Woodcroft's Patent</i>, 2 Webst. 29.</p> <p>(<i>r</i>) <i>Swames' Patent</i>, 1 Webst. 733; <i>Johnson's Patent</i> (Wilcox & Gibbs), L. R. 4 P. C. 75; <i>Bell's Patent</i>, 2</p> | <p>Webst. 160; <i>Claridge's Patent</i>, 7 Moo. P. C. 394.</p> <p>(<i>s</i>) <i>Berry's Patent</i>, 7 Moo. P. C. 187; <i>Claridge's Patent</i>, <i>ubi sup</i>.</p> <p>(<i>t</i>) <i>Johnson's Patent</i>, L. R. 4 P. C. 80; <i>Pitman's Patent</i>, <i>Ibid.</i> 88.</p> <p>(<i>u</i>) <i>Simister's Patent</i>, 1 Webst. 723.</p> <p>(<i>v</i>) 1 Webst. 738.</p> <p>(<i>x</i>) <i>Per</i> Sir J. Colvile, <i>Pitman's Patent</i>, L. R. 4 P. C. 87.</p> <p>(<i>y</i>) <i>Adair's Patent</i>, 6 App. Cas. 176.</p> <p>(<i>z</i>) <i>Hill's Patent</i>, 1 Moo. P. C. (N. S.) 262; <i>Saxby's Patent</i>, L. R. 3 P. C. 294.</p> |
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determination of the Courts of Law (*a*), and consistently with this view, applications for extension have been entertained while proceedings impeaching the patent were actually pending (*b*).

The Committee have, however, where on the face of the specification it appeared doubtful whether the alleged invention was proper subject-matter of a patent, refused, in the exercise of their discretion, to grant a prolongation (*c*).

(5.)

Remuneration.

“*Inadequately remunerated,*” &c. On the question whether a patentee has been adequately remunerated, the Judicial Committee will take into consideration, in favour of the patentee, the benefit which has resulted to the public as compared with that which the patentee has received (*d*).

If the invention be meritorious, the facts that no profit has been made (*e*), or that from want of capital and means the inventor has not obtained an adequate return (*f*), or that a loss has resulted to the petitioner (*g*), or that the remuneration is insufficient having regard to the expense incurred (*h*), are grounds for extension, subject, of course, to the limitations above mentioned, that the want of profit has not arisen from the non-utility of the invention or the default of the owner of the patent (*i*). But extension was refused to an assignee who had purchased the petitioner's stock-in-trade at a fair value and had not lost by the transaction (*k*).

If the remuneration is adequate, it is no ground for extension that it was made only during the last few years of the patent (*l*).

Term of extension.

“*Extend the term of the patent,*” &c. Where a loss had been incurred by the patentee, and there appeared to be no reasonable chance of that loss being counteracted by profit unless seven years' extension were granted, the patent was extended for that term (*m*). So also where pending litigation would be likely to prevent the parties availing themselves of the extension (*n*).

A detailed statement of several cases of application for prolongation, showing in each instance the remuneration made and the term of extension granted, will be found in Johnson's “*Patentees' Manual,*” 4th edition, pp. 205 to 211, from which it will appear that the usual prac-

(*a*) *Kay's Patent*, 1 Webst. 568.

(*b*) *Kay's Patent*, *ubi sup.*; *Heath's Patent*, 2 Webst. 257.

(*c*) *McDougal's Patent*, L. R. 2 P. C. 1; *McInnes' Patent*, L. R. 2 P. C. 54.

(*d*) *Derosne's Patent*, 2 Webst. 4; *Newton's Patent*, 14 Moo. P. C. 156.

(*e*) *Houghton's Patent*, L. R. 3 P. C. 461.

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

(*g*) *Swaine's Patent*, 1 Webst. 560; *Stafford's Patent*, 1 Webst. 564;

Jones' Patent, 1 Webst. 579; *Napier's Patent*, 6 App. Cas. 174; *Morton's Patent*, Eng. Rep. Apr. to June 1881, vii.

(*h*) *Martin's Patent*, Eng. Rep. Jan. to Mar. 1881, xiii; *Bate's Patent*, 1 Webst. 739.

(*i*) *Ante*, p. 35.

(*k*) *Quarrill's Patent*, 1 Webst. 740.

(*l*) *Ryder's Patent*, cited Johnson's “*Patentees' Manual,*” 4th ed., p. 210.

(*m*) *Jones' Patent*, 1 Webst. 579.

(*n*) *Heath's Patent*, 2 Webst. 257.

tice of the Judicial Committee has been to grant extensions only for periods of less than seven years, and that in one case only has this limit been exceeded, viz., in *Ruthven's* patent for water-propellers, when an extension for ten years was granted.

It is not a matter of course that a patent should be extended, even though the Attorney-General offers no objection, and the application is otherwise unopposed (*o*). See *post*, under Judicial Committee Rules, r. IX.

“*Grant of a new patent.*” Under the Act of 1835 it was held that renewed letters patent were not void if granted after the expiration of the term if the preliminary steps required by the 4th section of that Act were taken before the term ended (*p*), and this seems to be still the law if the provisions of sub-sect. (1) are complied with. New patent.

The new letters patent must be granted to parties having a legal interest in the existing letters patent (*q*), as the administrator of a deceased patentee (*r*) or the executors of a surviving assignee (*s*), or to trustees of a Company (*t*), or to the patentee being the agent for the foreign inventor (*u*).

Where an annuity to the patentee is part of the terms of the extension, the new letters patent may recite the conditions and contain a proviso avoiding the same if the annuity be not paid (*x*), or the letters patent may be withheld until the petitioner has executed a proper annuity deed (*y*).

“*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 (*z*) or his representatives (*a*). Thus the assignee has been required to secure to the inventor an annuity (*b*) or a share of the profits (*c*). 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 (*d*), or who might be prejudiced by the delay of the patentee in getting the new patent sealed (*e*). Or persons dealing with him.

But such conditions were only imposed when the patentee had made

(*o*) *Cardwell's Patent*, 10 Moo. P. C. 490.

(*p*) *Russell v. Ledsam*, 14 M. & W. 575.

(*q*) *Southworth's Patent*, 1 Webst. 488.

(*r*) *Heath's Patent*, 2 Webst. 247; *Downton's Patent*, 1 Webst. 565.

(*s*) *Bodmer's Patent*, 6 Moo. P. C. 469.

(*t*) *Pettit Smith's Patent*, 7 Moo. P. C. 133.

(*u*) *Newton's Patent*, 14 Moo. P. C. 156.

(*x*) *Whitehouse's Patent*, 1 Webst. 476, note (*h*); see also *Ibid.* 723.

(*y*) *Morton's Patent*, Eng. Rep., Apr. to June 1881, vii.

(*z*) *Pitman's Patent*, L. R. 4 P. C. 87.

(*a*) *Herbert's Patent*, L. R. 1 P. C. 399.

(*b*) *Whitehouse's Patent*, 1 Webst. 473 (reported as *Russell's Patent*, 2 Moo. P. C. 496); *Markwick's Patent*, 13 Moo. P. C. 310; *Russell v. Ledsam*, 14 M. & W. 574.

(*c*) *Hardy's Patent*, 6 Moo. P. C. 441; *Morton's Patent*, Eng. Rep. Apr. to June 1881, vii.

(*d*) *Normandy's Patent*, 9 Moo. P. C. 452. See also *Baxter's Patent*, 3 Jur. 593.

(*e*) *Schlumberger's Patent*, 8 Moo. P. C. 282.

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 (*f*).

Conditions in favour of the public or the Crown.

Conditions on behalf of the public have also been imposed, as that the patentee shall grant licences upon terms similar to one already granted by him (*g*), or shall sell the patented article at a fixed price (*h*), or shall disclaim so much of the specification as relates to parts of the invention not worked out (*i*).

In *Pettit Smith's Patent* (*k*) 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* (*l*), but since the decision in *Dixon v. London Small Arms Co.* (*m*) a condition permitting the use of the invention by the Crown and all contractors employed by the Crown has become usual in all cases of inventions likely to be required by Government (*n*).

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

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

The Judicial Committee have no jurisdiction to grant a second extension after one prolongation has been granted (*q*).

(7.)

Costs in extension cases.

“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 *bonâ fide* opposition should rather be encouraged in order that the Court may be put into possession of all that can be alleged against the continuance of the patent (*r*). 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 (*s*). And where there was no ground for the opposition, the opponents were made to pay the extra costs occasioned thereby (*t*). And when the petition is abandoned, the petitioner will in general have to pay the costs of opposers (*u*). But this rule is not invariable (*x*).

(*f*) *Bodmer's Patent*, 6 Moo. P. C. 468.

(*g*) *Mallet's Patent*, L. R. 1 P. C. 308.

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

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

(*k*) 7 Moo. 133.

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

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

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

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

(*p*) *Napier's Patent*, 6 App. Cas. 174; *Lee's Patent*, 10 Moo. P. C. 226; *Bodmer's Patent*, *ubi sup.*

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

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

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

(*t*) *Downton's Patent*, 1 Webst. 567.

(*u*) *Macintosh's Patent*, 1 Webst. 739; *Bridson's Patent*, 7 Moo. P. C. 499; *Hornby's Patent*, 7 Moo. P. C. 503.

(*x*) *Re Milner's Patent*, 9 Moo. P. C. 39.

When there are several opponents the petitioner has been allowed the option of paying a named sum to be divided among the opponents, or of having the costs of all the opponents taxed in the usual way (y).

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 (z).

Revocation.

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

(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 authorized 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.

(y) *Hill's Patent*, 1 Moo. P. C. 9 Moo. P. C. 39; *Jones' Patent*, 9 (N. S.) 258; *Johnson's Patent*, Moo. P. C. 41.
L. R. 4 P. C. 75; *Wield's Patent*, (z) *Bridson's Patent*, 7 Moo. P. C.
L. R. 4 P. C. 89; *Milner's Patent*, 499.

(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, 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 sect. 109, *post*.

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

“*The Court.*” Having regard to sub-sect. (4) (a), (b), and to sect. 109, “the Court” would seem to be in England the High Court of Justice in England (sect. 117), in Scotland the Court of Session, and in Ireland the High Court of Justice in Ireland (sect. 111); and since the word “patent” means (sects. 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.

(3.)

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

General rule
as to *scire
facias*.

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 (a).

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

3. When the King doth grant anything which by law he cannot grant (b).

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

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

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

“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* (c), *Alcock v. Cooke* (d). 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* (e), and *Brunton v. Hawkes* (f); 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” (g).

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” (h).

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 (i).

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 (k).

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

(c) 3 Lev. 134.

(d) 5 Bing. 340.

(e) 8 Taunt. 375.

(f) 4 B. & A. 541.

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

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

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

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

(l) See “Hindmarch on Patents,” p. 106.

(m) 1 Webst. 42, n.

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.

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

Practice in
scire facias.

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

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 (p).

In *R. v. Arkwright* (q) 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 (r).

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 (s), and if the action resulted in favour of the Crown, could order the patent to be restored into Chancery to be cancelled (t). 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 (u), and when a plaintiff had obtained a 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 (x).

(4.)

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

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 sect. 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*

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

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

(p) *R. v. Belts*, 15 Q. B. 540.

(q) 1 Webst. P. C. 64, n.

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

(s) *R. v. Neilson*, 1 Webst. 872; but see *R. v. Prosser*, 14 Bea. 306.

(t) *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.

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

(x) *Ibid.* p. 486.

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* (*y*), "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 sect. 109 that the letter 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 sect. 109.

(4.) (*b*.) By sect. 109 the party at whose instance the proceedings are taken in Scotland must have *an interest*.

The words do not occur in this sub-section as limiting the power of the Attorney-General to authorize proceedings, but under the old practice, although in the above case of *R. v. Mussey* (*z*) it is stated, on the authority of *Butler's Case* (*a*), 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* (*b*); and the fiat of the Attorney-General was, in fact, necessary in all cases, and was not issued as of course (*c*).

In *Re Young's Patent* (*d*) 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

Attorney-General's fiat required in England.

Attorney-General's fiat refused.

(*y*) 3 Ch. D. 660.

(*z*) 1 Webst. 41.

(*a*) 2 Ventr. 344.

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

(*c*) 1 Webst. 671, n; *Ibid.* 672;

R. v. Prosser, 14 Bea. 306.

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

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 (c) 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 (f).

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 (g).

(4.) (c), (d), (e). In these cases the fiat of the Attorney-General is not required.

"*In fraud of his rights*," such for instance, as in the cases of *Steedman v. Marsh* (h), *Ex parte Scott and Young* (i), *Re Vincent's Patent* (k).

(5), (6.)

See notes under sects. 29 (2), (3), (4), (5).

(7.)

A re-enactment of the latter part of sect. 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 (l).

(8.)

This provision is new.

Crown.

Patent to bind
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.

(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.

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

(f) 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.

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

(h) 2 Jur. (N. S.) 391.

(i) L. R. 6 Ch. 274.

(k) L. R. 2 Ch. 341.

(l) See *R. v. Cutler*, Macr. P. C. 124, 133, 134.

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

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

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 (p). This also seems to have been the view of Lord Eldon in *Walker v. Congreve* (q).

Legal 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 (r); 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 (s). Nor is a plaintiff compelled to rely on the promise of the offending party not to infringe again, but is entitled to the protection of an injunction (t). If, however, this right is exercised oppressively, the plaintiff may lose the costs of the action (u).

No proceedings are to be taken in respect of an infringement committed before the publication of the complete specification (x), and if the time for making any of the prescribed payments has been enlarged, the Court may refuse to award damages in respect of any infringement

Plaintiff need not apply to defendant before commencing proceedings.

Limitation as to proceedings for infringement.

(m) 6 B. & S. 257.

(n) *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. C. (N. S.) 189.

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

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

(q) *Ubi sup.*

(r) *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.

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

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

(u) See *post*, p. 83.

(x) Sect. 13, *ante*, p. 16.

committed after the failure to pay, and before the enlargement of the time for payment (*y*).

Several
infringements
at one time.

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 (*z*), but the patentee, by reason of his laches (*a*), may be unable to obtain the interlocutory injunctions to which, having established his patent in one action, he would be otherwise entitled (*b*).

In such a state of things the course which has been suggested by Lord Hatherley, C. (*c*), 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."

All parties
claiming
interest should
be joined in
the action.

All parties claiming an interest in the letters patent, if they do not join as co-plaintiffs, may properly be made, and ought to be made, defendants to the action, in order that the infringing defendants may not be compelled to account twice, first to the plaintiff, and then to the other defendants who claim an interest (*d*). 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 may 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 (*e*).

Patent vested
in trustees.

If the letters patent are vested in trustees for any person, the

(*y*) Sect. 17 (4) (*b*).

(*z*) *Borill v. Goodier* (2), L. R. 2 Eq. 195; *Borill v. Smith*, W. N. 1967, 340; *Croskill v. Tuxford*, 5 L. T. 342.

(*a*) See *post*.

(*b*) *Borill v. Crate*, L. R. 1 Eq. 358.

(*c*) *Borill v. Crate, ubi sup.*

(*d*) *Westhead v. Keene*, 1 Bea. 287, 295; *Bergmann v. McMillan*, 17 Ch. D. 423; "Hindmarch on Patents," p. 308.

(*e*) Supreme Court Rules, 1883, Ord. XVI, Rule 11.

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 (*f*).

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 (*g*).

Where simple licences granted patentee can sue alone.

An exclusive licence may sometimes 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 (*h*).

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 for damages for infringement of that part of the patent without joining the persons interested in the other parts (*i*).

Assignee of distinct and several part of patent.

In *Walton v. Larater* (*k*), 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

(*f*) Supreme Court Rules, 1883, Ord. XVI, Rule 8.

(*h*) *Smith v. London and North-Western Railway Co.*, 2 E. & B. 69; s.c. Macr. P. C. 207.

(*g*) See *Newby v. Harrison*, before Lord Campbell, cited in *Renard v. Lerinstein*, 2 H. & M. 628.

(*i*) *Dunncliff and Mallet*, 7 C. B. (N. S.) 209.

(*k*) 8 C. B. (N. S.) 184.

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 Railway Co.* (l), 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 (m); and in *Bergmann v. McMillan* (n) 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. On the other hand, it was held by Malins, V.C., in *Sheehan v. Great Eastern Railway Co.* (o), that one of several co-owners of a patent could sue alone without making the other co-owners parties (p).

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 (q), and this seems to have been admitted 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 (r).

But in *Renard v. Levinstein* (s) 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

(l) Macr. P. C. 203.

(m) See also remarks of Jessel, M.R., in *Powell v. Head*, 12 Ch. D., a copyright case, 686.

(n) 17 Ch. D. 427.

(o) 16 Ch. D. 59, following the analogy of *Dent v. Turpin*, 2 J. & H. 139, a case of two owners of the same trade mark. See also "Lindley on Partnership," 4th ed., p. 68; *Davenport v. Richards*, 3 L. T. (N. S.) 503.

(p) 17 Ch. D. 427.

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

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

(s) 2 H. & M. 633.

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.

However, in the course of the litigation which followed the establishment of the validity of the rolling skate patent (*t*), 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*.

As to the effect of the requirement of registration on the right to sue, see *post*, sect. 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 (*u*), and the common form of injunction against the master restrains the repetition of the infringement by him, his servants, agents, or workmen (*x*).

Defendants to
action for
infringement.

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 (*y*).

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 (*z*).

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

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

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

(*x*) "Seton on Decrees," 4th ed., p. 352.

(*y*) 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.

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

the manufacturer, but of the cardmaker, and that the latter was properly sued for infringement (a).

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

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

An account directed against the manufacturer of a patented article does not license the use of the article in the hands of purchasers from him, and therefore, when a patent is infringed by a manufacturer who sells to others who make 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 (c).

Distinct
infringements
by different
persons, sepa-
rate actions
necessary.

If there are distinct invasions of a patent by different persons, there must be separate actions against each infringer (d); 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 (e).

Foreigners
infringing.

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 (f). 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 (g).

Company
defendant,
directors may
be personally
liable.

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 (h).

Threat to
infringe
sufficient to
found action.

A threat to infringe under a claim of right 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

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

(b) *Nobel's Explosive Co. v. Jones*, 8 App. Cas. 1.

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

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

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

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

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

(h) *Betts v. De Vitre*, 11 Jur. (N. S.) 9, affirmed L. R. 3 Ch. 442.

assertion from his amended defence, it was held that the original statement of defence might be used against him as evidence (i).

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

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

Where there are several actions on the same patent against different infringers, they may be consolidated so as to have the validity of the patent, and any other questions common to all the actions, tried once for all in one action (m); and by the Supreme Court Rules, 1883, Order XLIX, Rule 8, re-enacting Order LI, Rule 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 (n), and this is now the rule under the above Order (o). 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 (p).

The order in *Foxwell v. Webster* was binding upon the plaintiff as well as the defendants (q), but it would appear from the Report (r) 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 order for consolidation should, if made adversely, be framed so as only to bind the defendants (s).

At common law it was held that the consolidation order could be made as soon as the defendants had appeared, and before declaration (t), 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 (u), 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

(i) *Frearson v. Loe*, 9 Ch. D. 66.

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

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

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

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

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

(p) "Lush's Practice," cited above.

(q) See the order in "Seton on Decrees," 4th ed., p. 347.

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

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

(t) "Lush's Practice," 965, 3rd ed.

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

restraining the plaintiff he was greatly stretching the power of the Court (*x*).

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 (*y*).

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 next step in several of the actions, and staying proceedings therein till after one has been tried as a test action (*z*).

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 (*a*).

In addition to the remedies by injunction and account of profits or damages (see sect. 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 (*b*). 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 (*c*).

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 (*d*), or the Court may make an order in the alternative for delivery up or destruction of the articles complained of (*e*).

28. (1.) In an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and

(*x*) *Foxwell v. Webster*, 4 D. J. S. 82. See the order in *Bovill v. Ainscough* in the Appendix, *post*.

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

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

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

(*b*) *Betts v. De Vitre*, 34 L. J. Ch.

289, 291; *s.c.* 11 Jur. (N. S.) 9, 217; "Seton on Decrees," 4th ed., p. 354; *Emperor of Austria v. Day*, 3 D. F. J. 217.

(*c*) *Needham v. Oxley*, 8 L. T. (N. S.) 604; "Pemberton on Judgments," 3rd ed., p. 236.

(*d*) *Tangye v. Stott*, 14 W. R. 386; *Young v. Fernie*, "Pemberton on Judgments," 3rd ed., p. 236.

(*e*) *Plimpton v. Malcolmson*, "Seton on Decrees," 4th ed., p. 354; *Badische Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. 176.

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* (*f*), 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 could be tried without a jury" (*g*). (See Order XXXVI, Rule 26, of the Judicature Rules, re-enacted in Order XXXVI, Rule 4, of the Supreme Court Rules, 1883.) The section, it will be observed, relates only to the trial of the action.

By Lord Cairns' Act (*h*) 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 (*i*) 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.

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 (*k*),

(*f*) 1 Q. B. D. 362,

(*g*) *Patent Marine Inventions Co. v. Chadburn*, L. R. 16 Eq. 447. See also *Swindell v. Birmingham Syndicate*, 3 Ch. D. 127; *Back v. Hay*, 5 Ch. D. 235; *Bordier v. Burrell*,

5 Ch. D. 515; cases under the Judicature Rules.

(*h*) 21 & 22 Vict. c. 27.

(*i*) 25 & 26 Vict. c. 42.

(*k*) 46 & 47 Vict. c. 49.

out by the 57th section of the Judicature Act, 1873, the Court may, in any cause or matter requiring scientific 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 ordinary officers (and a patent action has been held to be an action requiring scientific investigation within the meaning of this section) (*l*), order any question or issue of fact to be tried before an official referee; and by Order XXXVI, Rule 5, of the Supreme Court Rules, 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 special referee with or without assessors. Issues may therefore still be granted in patent actions, but the more usual practice in such actions is not to direct issues, but to bring the action on for trial in the ordinary way.

By Order XXXIII, Rule 1, of the Supreme Court Rules, 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 (*m*).

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

When questions of fact are referred for trial under sect. 57 of the Judicature Act, 1873, the particular issues need not be specified in the order, but the reference may be in general terms (*o*).

By the Supreme Court Rules, 1883, Order XXXIV, Rule 9, when the parties to a cause or matter are agreed as to the questions of fact to be

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

(*m*) For the technical form of the above issues, and for other issues in patent actions, see "Seton on Decrees," 4th ed., p. 347.

(*n*) Supreme Court Rules, 1883, Ord. XXXVI, Rule 7(*a*). See under the old practice *Henderson v. Runcorn, &c., Co.*, W. N. 1868, p. 250; 19 L. T.

(N. S.) 277; *Arnold v. Bradbury*, W. N. 1871, p. 120; L. R. 6 Ch. 706.

(*o*) 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 Supreme Court Rules, 1883, Appendix K, No. 33.

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 (*p*). See *post*, sect. 29.

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 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 (*q*).

Sufficiency of specification treated as question of fact.

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 (*r*).

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 (*s*).

Variance between provisional and complete specification.

An invention may be a new manufacture within the Statute of Monopolies (*t*), but the patentee may not be the true and first inventor, and the patent may consequently be void, and therefore a defendant may have the question of newness of manufacture tried apart from the question of newness of invention (*u*). But an issue that "the invention is not the subject of letters patent" is not a proper issue (*x*).

Newness of manufacture and of invention separate issues.

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

Not subject-matter—not proper issue. Infringement.

"*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.

Patent actions generally not cases for a jury.

(*p*) See the order in *Davenport v. Jepson*, "Seton on Decrees," 4th ed., p. 346; *Bovill v. Bird*, W. N. 1867, p. 96.

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

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

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

(*t*) 21 Jac. 1 c. 3, s. 5.

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

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

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

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

Thus, in *Bovill v. Hitchcock* (a), 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* (b), 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 it ever 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" (c).

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 (d). And in the case of *Henderson v. The Runcorn Soap and Alkali Co.* (e), 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* (f), it was held by the same learned Judge, then Lord Justice, that though there was no inflexible rule as to the 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.

Where a patent had been the subject of previous proceedings, and on one occasion a trial had been heard 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

(a) L. R. 3 Ch. 417. See also *Young v. Fernie*, 1 D. J. S. 853; *Saxby v. Gloucester Wagon Co.*, W. N. 1880, p. 28; *Downes v. Hughes & Co.*, 69 L. T. 150.

(b) L. R. 16 Eq. 447.

(c) See also observations of Cock-

burn, C.J., in *Sugg v. Silber*, 1 Q. B. D. 362.

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

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

(f) L. R. 5 Ch. 459.

Issues to a jury, when granted and when refused.

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 (g).

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 (h).

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 (i).

The circumstance that, as a matter of fact, a patent case arising in the Court of Chancery was, before Lord Cairns' Act (k) and Sir John Rolt's Act (l), 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. "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" (m).

Under the 2nd section 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 (n).

By the 29th section of the Judicature Act, 1873, any party to any cause or matter involving the trial of a question or issue of fact, or

(g) *Davenport v. Goldberg*, 2 H. & M. 282.

(h) *Tangye v. Stott*, 14 W. R. 128.

(i) *Bovill v. Goodier*, L. R. 2 Eq. 195; and see Supreme Court Rules, 1883, Ord. XXXVI, Rule 8.

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

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

(m) *Per* Lord Cairns, C., L. R. 3 Ch. 419.

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

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 Supreme Court Rules, 1883, Order XXXVI, Rule 44.

Trial by jury cannot be had before a Judge of the Chancery Division (o).

By Order XXXIV, Rule 2, of the Supreme Court Rules, 1883 (a re-enactment of the Judicature Rules, Order XXXIV, Rule 2), 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 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, Rule 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 modes of trial, or that one or more questions of fact be tried before the others, and may appoint the places for such trial, and in all cases may order that one or more issues of fact may 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 (p). 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 (q).

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

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 (r).

And where a Judge had, under the 57th section of the Judicature Act, 1873, referred a question of fact in a patent action to the official

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

(p) 24 W. R. 362.

(q) See Judgment of Lord Westbury, C., in *Young v. Fernie*, 1 D. J. S. 355.

(r) *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; *Wharlon v. Boffin*, W. N. 1883, p. 97.

referee, the Court of Appeal refused to interfere with his discretion (s).

By the 56th section of the Judicature Act, 1873, any question arising in a cause may be referred for inquiry and report to an official or special referee, and the report of any such referee may be adopted wholly or partially by the Court (t).

This section was acted on by Pearson, J., in *Badische Anilin und Soda Fabrik v. Levinstein* (u), where certain experiments were directed to be performed by a special referee for the purpose of advising the Court.

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 the action or motion for judgment without waiting for such trial or determination. And the Court may give such leave upon such terms as may appear just (x).

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 has expired (y); but if a motion for a new trial was refused, the injunction was at once granted (z).

Practice where issues found in favour of plaintiff.

Where an action (other than an action in the Probate, Divorce, and Admiralty Division), or any issue therein, has been tried by a jury, application for a new trial must be made to a Divisional Court of the Queen's Bench Division; where the trial has been without a jury, the application must be by appeal to the Court of Appeal (a).

Upon motion for a 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 (b).

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 (c). And see now Supreme Court Rules, 1883, Order XXXIX, Rules 6, 7, and 8.

Where, after verdict for plaintiff, the Court, on an application for a

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

(t) See now Supreme Court Rules, 1883, Ord. XXXVI, Rule 55.

(u) 24 Ch. D. 156.

(x) Supreme Court Rules, 1883, Ord. XL, Rules 7, 8.

(y) *Macdougall v. General Sewage and Manure Co.*, W. N. 1875, 64,

following *Fernie v. Young*, L. R. 1 H. L. 63, 84.

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

(a) Supreme Court Rules, 1883, Ord. XXXIX, Rule 1; and see *Hunt v. City of London Real Property Co.*, 3 Q. B. D. 19.

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

(c) *Penn v. Bibby*, ubi sup.

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 (*d*).

On a trial of questions of fact under Lord Cairns' Act, the Court of Appeal had no power to reverse the findings of the Judge on the questions of fact, but could only direct a new trial (*e*). 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 (*f*). And now, by the Supreme Court Rules, 1883, Order LVIII, Rule 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 by Rule 4 of the same Order very full powers of dealing with the case are given to the Court of Appeal.

Where the issues were settled at the commencement of the trial, then, whether the Judge delivered his finding on the facts and his judgment on the whole case on separate days or at one time, his finding of fact was an interlocutory order which, under the Judicature Rules, Order LVIII, Rule 15 (*g*), could only be appealed within twenty-one days. But if no definite issues of fact were settled at the commencement of the trial, the finding of fact, as well as the judgment on the whole, could be appealed at any time within a year (*h*).

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 (*i*).

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

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

(*f*) *Simpson v. Holliday*, cited above.

(*g*) Re-enacted with variations, Su-

preme Court Rules, 1883, Ord. LVIII, Rule 15.

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

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

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. Delivery of particulars.

(2.) The defendant must deliver with his statement of defence, or, by order of the Court or a Judge, at any subsequent time, particulars of any objections on which he relies in support thereof.

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

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

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

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

(1.)

“*Statement of claim.*” The plaintiff must state on the face of his statement of claim a sufficient case to justify the injunction asked (k). 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 throws upon the defendant the *onus* of disputing the novelty (l). Nor has the Court required the plaintiff to allege that the stamp duties necessary for keeping the patent alive have been paid (m). 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

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

(m) *Sarazin v. Hamel* (No. 1), 32 Bea. 145.

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

this allegation is not contained in the model form given in the Appendix to the Supreme Court Rules, 1883 (*n*).

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 (*o*). 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 specification, 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.

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 (*p*).

Act of 1852.

Particulars of breaches were required by the Act of 1852 (*q*), but were by that Statute only applicable to actions at law. However, under Lord Cairns' Act and Sir John Rolt's Act (*r*) (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 practice of requiring particulars of breaches and notices of objections was adopted by that Court, at all events when issues were directed (*s*). In *Finnegan v. James* (*t*), 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.

Particulars of breaches adopted in Chancery.

There was a difference in the requirements of the Act of 1852 (*u*) 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.

What detail required in particulars of breaches.

Thus, in *Talbot v. La Roche* (*x*), the Court of Common Pleas refused

(*n*) Appendix C, Form No. 6.

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

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

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

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

(*s*) *Curtis v. Platt*, 35 L. J. (N. S.) Ch. 853; see *Bovill v. Goodier*, L. R. 1 Eq. 35.

(*t*) L. R. 19 Eq. 72.

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

(*x*) 15 C. B. 310.

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 in what respects he had been guilty of infringement. And in an action for infringement a patentee will not be compelled to produce to the defendant a specimen of the patent article (y).

Again, in *Needham v. Oxley* (z) 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 plaintiff simply pointed to certain specified machines, and stated in general terms that they infringed the plaintiff's patent, and it was contended, but unsuccessfully, that the plaintiff ought to specify in what respects the defendant's machines were an infringement.

So also in *Batley v. Kynock* (No. 2) (a), where the thing alleged to be an infringement had been made an exhibit in the cause, it was held that it was not necessary that the particulars of breaches should point out the precise portion of the specification alleged to have been infringed. And 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 the particulars asked for (b).

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* (c), 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 in respect of which infringement was alleged. And in *Lamb v. The Nottingham Manufacturers' Co.* (d), 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.

(2), (3.)

"Statement of defence." See notes on sect. 26 (3). A defendant in an action for infringement desiring to dispute the validity of the patent

Defence to state all the grounds of defence.

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

(z) 1 H. & M. 248.

(a) L. R. 19 Eq. 229.

(b) *Electric Telegraph Co. v. Nott*, 4 C. B. 462. This case was, however, before the Patent Law Amendment Act, 1852.

(c) 1 Webst. P. C. 269.

(d) "Seton on Decrees," 4th ed., p. 349, 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.

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 (e), the Court refused at the hearing to allow this objection to be raised (f). 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 (g).

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 (h).

Invention not new manufacture.

In *Walton v. Potter* (i) it was held that a plea that the invention was not a new manufacture admitted the invention to be a novelty, and put in issue the novelty (k). But in *Bush v. Fox* (l) it was held by the House of Lords that this plea put in issue both the novelty of the invention and its being a new manufacture; and in *Spencer v. Jack* (m) 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 (n). Nor will a plea that the invention is now a new manufacture allow the defendant to raise the defence of want of utility (o).

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 (p), or upon a plea denying infringement (q).

Proper plea to raise issue of utility.

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 (r), but is rather an inference from the enactment in that

(e) Repealed, and not re-enacted in the present Act.

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

(g) *Morgan v. Fulier* (1), L. R. 2 Eq. 296.

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

(i) 1 Webst. 601, 611. See also 1 Webst. 598, *Note* (h).

(k) *Spilsbury v. Clough*, 1 Webst. 255.

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

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

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

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

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

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

(r) 21 Jac. 1, c. 3, s. 6.

Statute that the monopoly granted must "not be mischievous to the State, or to the hurt of trade, or generally inconvenient" (s). 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.

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

Every patent for a new invention has, at least since the time of Queen Anne, contained a condition making the same void if a specification were not filed within a definite time, or, in case a complete specification had been filed before the grant of the patent, then avoiding the patent if that specification were insufficient. Such a condition was not required by the common law or the Statute of Monopolies, but it was the practice to insert it in patents (x), and the practice was expressly recognized in the 10th section of the Act of 1852. Insufficiency of specification.

The condition required that the specification should "particularly describe and ascertain the nature of the invention, and in what manner the same is to be performed," words which have been followed in sect. 5 (4) of this present Act.

The form of patent given in the first schedule to the present Act (which, however, is not compulsory (y)) contains no condition avoiding the patent if the specification be insufficient. A question may therefore arise whether the old objections to the specification can be still taken by way of defence to an action for infringement. It is to be observed that there is nothing in the Act which makes the examination and approval of the specification under sects. 6, 7, and 9, *ante*, conclusive, either as against the Crown or as between the patentee and third parties; and if the complete specification does not, in fact, particularly describe and ascertain the nature of the invention, and in what manner the same is to be performed, then the statement in the specification (Patents Rules, 1883, Second Schedule, Form C), on the acceptance of which the patent has been granted, is untrue. So also, if the complete specification differs materially from the provisional, the Crown has granted a patent for an invention of which the nature was wrongly stated in the provisional specification (Patents Rules, 1883, Second Schedule, Form B). In either case the Crown has been deceived, and this was a ground for *scire facias* at the commencement of this Act, and by sect. 26 will therefore be available by way of defence to an action for infringement (z). See notes under sect. 26.

(s) *Morgan v. Seward*, 1 Webst. 197.

(t) "Hindmarch on Patents," 275, and the cases there cited.

(u) *Simpson v. Holliday*; *Renard v. Levinstein*; *Morgan v. Fuller*; "Seton on Decrees," 4th ed., p. 347; *Plimp-*

ton v. Malcolmson, 3 Ch. D. 531, 536.

(x) See the Schedule to 15 & 16 Vict. c. 83, and "Hindmarch on Patents," p. 151.

(y) Sect. 33, *post*.

(z) See also Judgment of Buller, J., *R. v. Arkwright*, 1 Webst. 66.

Moreover, the new form of patent contains a recital (a) that the patentee has, by his complete specification, "particularly described the nature of his invention." If this recital be untrue, no doubt the grant is void (b).

But a question may arise whether, if the specification literally complies with the statements in the recital (which it will be observed does not go beyond what is required for the provisional specification), and describes only the nature of the invention, without ascertaining the manner in which it is to be performed, the grant is not still good.

It is submitted that the considerations above mentioned, arising from the recitals in the specification itself, show that the patent is in such a case invalid. On the whole, therefore, it is submitted that the old law as to specifications is still in force, though it may not, in patents in the form given in the First Schedule, rest as formerly on the express words of the patent itself. See also notes under sect. 9 (1), and sect. 26 (3).

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 as the title (c), nor, apparently, that the patent is for a principle only, and therefore void (d), nor that the invention is not the subject-matter of letters patent (e).

Under plea of insufficiency of specification, objection of variance between final and provisional specification may be taken.

Upon an issue as to the sufficiency of the specification, it seems to have been doubted (f) whether a defendant could prove that the complete specification differed materially from the provisional specification, a fact which, if established, would invalidate the patent (g). But in *Penn v. Bibby* (h), 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 (i), or was not aware that the article complained of was an infringement (k), or that the acts complained of were done by workmen employed by the defendant, but contrary to orders (l).

(a) See Form D, First Schedule.

(b) "Hindmarch on Patents," p.48.

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

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

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

(f) *Morgan v. Fuller* (1), L. R. 2 Eq. 297; *Derosne v. Fairie*, 1 Webst. 161; *Neilson v. Harford*, 1 Webst. 812,

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

(h) L. R. 2 Ch. 127, 130.

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

(k) *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.

(l) *Bells v. De Vitre*, L. R. 3 Ch. 430.

Nor is the intention of the defendant material if he has, in fact, invaded the rights of the patentee (*m*); 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 (*n*). Nor the fact of no intention to infringe.

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 had sold none of the patent article 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 (*o*). In this case the patent had expired pending the litigation, and therefore no injunction could be granted.

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 (*p*). When defendant infringed in ignorance, injunction not always granted.

“*Particulars of objections.*” By the 4 & 5 Wm. 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 (*q*) did not require any more detail in the objections than in the particulars of breaches. Particulars of objections. Under Act of 1835

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 (*r*).

(*m*) *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.

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

(*o*) *Davenport v. Rylands*, L. R. 1 Eq. 305.

(*p*) *Betts v. Willmott*, 18 W. R. 946; *Uymann v. Elkan*, L. R. 12 Eq. 145.

(*q*) Sect. 5.

(*r*) *Bulnois v. Muckenzie*, 1 Webst. P. C. 260.

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

Some difference of opinion seems to have prevailed as to the detail which the Court, under the Act of Wm. 4, could require to be given of alleged prior user of the patented invention. In *Bulnois v. Mackenzie* (*u*) 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* (*x*), *Heath v. Unwin* (*y*), and *R. v. Walton* (*z*). In *Jones v. Berger* (*a*), 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* (*b*), the names, addresses, and descriptions of alleged prior users were ordered to be furnished. The question was again considered in *Russell v. Ledsam* (*c*), 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 (*d*).

And objections that the invention was not properly set forth in the specification (*e*), or that the specification is calculated to deceive (*f*), or that the specification does not sufficiently distinguish between what is new and what is old (*g*), or did not describe the most beneficial method with which the patentee was acquainted of practising his invention (*h*), or did not sufficiently describe the nature of the invention (*i*), or that the invention does not produce the effect stated (*k*), were all held sufficient without going into particulars.

But upon an objection that the invention for which the patent was granted was more extensive than that described in the specification, and

(*s*) *Bulnois v. Mackenzie, ubi sup.*; *Jones v. Berger*, 1 Webst. P. C. 544; and see Judgment of Cresswell, J., in *Walton v. Bateman*, 1 Webst. P. C. 616.

(*t*) *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.

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

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

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

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

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

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

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

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

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

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

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

(*h*) *Ibid.*; *s.c.* 1 Webst. P. C. 546.

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

(*k*) *Ibid.*

another objection founded on discrepancy between the drawings and specification, the defendant was required to call the plaintiff's attention to the particular parts (*l*). 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 (*m*).

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, &c., this was held not precise enough, and the word "other" was ordered to be inserted before the word "specification" in the second objection (*n*).

The Act of 1852 (*o*) defined the detail as to prior user necessary in particulars of objection, 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 Act of 1852.

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.

Thus, in *Curtis v. Platt* (*p*), 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 relies on prior specifications as anticipating the plaintiff's patent, he must point out the particular pages and lines of the prior Pages and lines.

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

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

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

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

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

specification on which he relies, and where he relies on prior user he must state which part of plaintiff's machine he alleges to have been so used (q).

Flower v. Lloyd.

Limits of rule in *Flower v. Lloyd.*

It has, however, been 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 (r). 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 to the words objected to being struck out (s). 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 (t). And a plaintiff may, on making out a proper case, administer interrogatories to a defendant who has delivered particulars of objection, 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 (u).

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* (x).

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

Objections to be precise.

It has always been held that the objections must be precise and

(q) *Grover & Baker Sewing Machine Co. v. Wilson*, W. N. 1870, 78. See also *Fisher v. Dewick*, 1 Webst. P. C. 264.

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

(s) 20 "Solicitor's Journal," 860.

(t) *Birch v. Mather*, 22 Ch. D. 629.

(u) *Ibid.*

(x) *Plimpton v. Spiller*, 20 "Solicitor's Journal," 860.

(y) *Palmer v. Cooper*, 9 Ex. 236.

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 in some of them had been used long before" (z). And where the prior user was alleged to be by persons named and "*divers other persons*" (a), or at Nottingham "*and elsewhere*" (b), or "*by other persons* in London and Birmingham" (c), 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 (d).

And a defendant has been ordered to state what portions of the specifications alleged as prior publications are alleged to anticipate the plaintiff's patent, with a reference to pages and lines of such specifications, and also what portions of plaintiff's inventions are alleged to have been published prior to the date of the letters patent, with reference to the claiming clauses of the specifications of such letters patent (e).

It would seem, however, from the case of *Penn v. Bibby* (f), 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* (g) 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 (h). *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 the invention was used "*by candle-makers generally in London and the*

(z) *Fisher v. Dewick*, 1 Webst. P. C. 264; *Heath v. Unwin*, 1 Webst. P. C. 552, n; *Russell v. Ledsam*, 11 M. & W. 647.

(a) *Galloway v. Bleden*, 2 Chit. Arch. Prac. 1031, cited 1 Webst. 268, n; *Fisher v. Dewick*, 1 Webst. P. C. 551, n.

(b) *Jones v. Berger*, 1 Webst. P. C. 544; *Holland v. Fox*, 1 C. L. Rep. 440.

(c) *Flower v. Lloyd*, 20 "Solicitor's Journal," 860.

(d) *Fisher v. Dewick*, 1 Webst. P. C. 264; *Russell v. Ledsam*, 11 M. & W. 647.

(e) *London & Leicester Hosiery Co. (Limited) v. Higham*, see order, *post*, Appendix.

(f) L. R. 1 Eq. 549.

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

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

vicinity thereof" (i). 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" (k).

Allegation of
general user
when
sufficient.

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 (l).

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 (m).

The best test of the sufficiency or insufficiency of objection will probably be found in the words of Parke, B., in *Palmer v. Cooper* (n): "The defendant's particulars ought to give the plaintiff such information as will enable him to make the necessary inquiries at the places named."

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 (o).

Objections not
in place of
pleas.

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 (p); 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 (q).

"*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; but having regard to the cases cited above, and especially to the observation of the Court of Appeal in *Flower v. Lloyd*, it may be anticipated that the information necessary to satisfy the present Act will be, in substance, the same as what was required under the Act of 1852.

(4.)

A defendant will not be allowed, at the trial, to adduce evidence of prior user not disclosed by his particulars of objection, even though

(i) *Palmer v. Wagstaff*, 8 Ex. 841.
(k) *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. 652; 8 Scott (N. R.) 372.

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

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

(n) 9 Ex. 236.

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

(p) *Macnamara v. Hulse*, 2 Webst. P. C. 128, n; *Jones v. Berger*, 1 Webst. P. C. 544.

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

such evidence has only come to his knowledge since the particulars were delivered. In such a case the right course is to apply at once, on learning the new evidence, for leave to amend the particulars (*r*).

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 (*s*).

But if the evidence is within the literal meaning of the words of the particulars, however general the statement, the evidence will be received at the trial (*t*). The only question then is whether the words of the notice are sufficiently large to include the objection (*u*). 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 (*x*).

And where the particulars of objection alleged that the invention had been publicly used in corn-mills, evidence of user in Cheshire was admitted (*y*).

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, sect. 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 (*z*).

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 (*a*). For this purpose 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 (*b*).

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

(*s*) *Penn v. Bibby*, L. R. 2 Ch. 127, 137.

(*t*) *Per Pollock, C B., 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.

(*u*) *Per Alderson, B., Neilson v*

Harford, 1 Webst. 332. See also p. 370.

(*x*) *Sykes v. Howarth*, 12 Ch. D. 826; 48 L. J. Ch. 769.

(*y*) *Hull v. Lollard, ubi sup.*

(*z*) *Adair v. Young*, W. N. 1879, p. 8.

(*a*) *Turner v. Winter*, 1 Webst. 81.

(*b*) *Cornish v. Keene*, 1 Webst.

503.

Evidence within literal meaning of particulars of objections admitted.

The parcel evidence of the patentee has been held admissible to prove that the patent was not obtained for some of the things claimed in the specification (c).

Where the defendant denies the novelty of the invention, the affirmative of the issue thus raised rests with him (d).

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 to call on the other side (e), and therefore the plaintiff will be allowed to call evidence in reply, for the purpose of rebutting the case set up by the defendant (f).

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 (g).

But after the evidence of the defendant has been summed up, the defendant will not be allowed to adduce further evidence in answer to that given by the plaintiff in reply (h).

Evidence of
infringement.

In ordinary cases the burden of proving infringement lies upon the plaintiff (i), 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 (k). 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 (l).

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 defendants, is sufficient to satisfy an allegation that he made those articles (m).

(c) *Crossley v. Potter*, 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.

(d) *Penn v. Jack*, L. R. 2 Eq. 314; *Minter v. Wells*, 1 Webst. P. C. 129.

(e) *Galloway v. Bleaden*, 1 Webst. P. C. 526; *Cornish v. Keene*, 1 Webst. P. C. 509.

(f) *Penn v. Jack*, L. R. 2 Eq. 314.

(g) *Telley v. Easton*, Macr. P. C. 61.

(h) *Penn v. Jack*, L. R. 2 Eq. 314.

(i) *Neilson v. Betts*, L. R. 5 H. L. 1, 11.

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

(l) *Neilson v. Betts*, L. R. 5 H. L. 1.

(m) *Gibson v. Brand*, 1 Webst. P. C. 631.

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 (*n*).

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 (*o*). Trade secret.

But 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 (*p*).

The Court looks with suspicion upon evidence which is only brought into existence for the purpose of a cause (*q*), as, for instance, experiments conducted with a view of making evidence for the trial (*r*), or experiments made in the course of the trial (*s*).

(5.)

If the particulars delivered are too general, it is the business of the parties who mean to object to them to procure an order for better particulars (*t*), and this is important, otherwise, as above stated, evidence within the literal meaning of the particulars may be admitted, although the particulars are, in fact, too general. 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 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" (*u*). Amendment of particulars.
Importance of requiring amendment when necessary.

(*n*) *Hall v. Boot*, 1 Webst. P. C. 103.

(*r*) *Young v. Fernie*, 4 Giff. 609.

(*o*) *Huddart v. Grimshaw*, 1 Webst. P. C. 91. See also *Davenport v. Richards*, 3 L. T. (N. S.) 503.

(*s*) *Plimpton v. Mulcolmsen*, 3 Ch. D. 576.

(*p*) *Badische Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. 156, 170.

(*t*) Per Pollock, C.B., *Hull v. Bolland*, 1 H. & N. 134.

(*q*) *Betts v. Neilson*, L. R. 3 Ch. 433.

(*u*) Per Mellish, L.J., *Sugg v. Silber*, 2 Q. B. D. 495.

Allowed at any stage.

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 (*x*), and has even permitted a defendant, during the progress of the trial, to give short notice of motion for leave to amend his particulars so as to admit the fresh evidence (*y*).

Terms on which amendment allowed.

The defendant will, however, have to pay the costs of, and occasioned by, such an application (*z*). And where a defendant, after amending his objections in compliance with an order to that effect, applied for leave to reamend by adding certain instances of prior user, leave was granted, but on the terms that defendant paid the costs of the application, and the additional costs occasioned by the re-amendment were reserved (*a*).

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 insuring to the plaintiff an opportunity of filing affidavits in answer, the costs of and consequent on the application being reserved (*b*).

But in *Edison Telephone Co. v. India Rubber Co.* (*c*), 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.

Where the Court is of opinion that the new objection is on the face of it unsustainable, leave to amend will be refused (*d*).

On new trial further particulars allowed.

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 (*e*).

Costs of amending insufficient particulars.

As to amendment of particulars, see also Supreme Court Rules, 1883, Order XIX, Rule 7. The order to amend may be obtained on summons at Chambers, or by motion in Court (*f*). If the particulars delivered are insufficient, the party delivering them may be ordered to pay the costs of the application for better particulars (*g*). By Rule 8 of the last-

(*x*) *Holste v. Robertson*, 4 Ch. D. 9.

(*y*) *Dato v. Eley*, L. R. 3 Eq. 38.

See also *Renard v. Levinstein*, 13 W. R. 229; *s.c.* 11 L. T. (N. S.) 505.

(*z*) *Renard v. Levinstein*, *ubi sup.*

(*a*) *Penn v. Bibby*, L. R. 1 Eq. 548.

(*b*) *Wilson v. Gunn*, W. N. 1875, p. 78.

(*c*) 17 Ch. D. 137, following *Baird v. Moule's Earth Closet Co.* (M.R., Feb. 3, 1876) and *Aveling v. Maclaren*

(C. P. D., Dec. 23, 1880); both orders are printed 17 Ch. D. 139.

(*d*) *Holste v. Robertson*, 4 Ch. D. 9.

(*e*) *Bovill v. Goodier*, 36 L. J. (N. S.) Ch. 360.

(*f*) See Judicature Act, 1873, s. 39. *Frearson v. Loe*, 26 W. R. 138.

(*g*) *Grover & Baker Sewing Machine Co. v. Wilson*, W. N. 1870, p. 78; *Penn v. Bibby*, L. R. 1 Eq. 548.

mentioned Order, an order for particulars does not, except as mentioned in the Rule, operate as a stay of proceedings or give any extension of time.

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 (*h*).

(6.)

“*Shall not be allowed any costs, &c., unless,*” &c. The words, “or to have been reasonable and proper,” are in addition to the corresponding provisions of the Act of 1852 (*i*), of which this sub-section is substantially a re-enactment. Those provisions 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 objection and evidence in support of them (*k*). But if there were a trial, and the plaintiff was non-suited, the defendant was not entitled to any costs in respect of his particulars of objections, unless the Judge certified that they had been proved (*l*). And where the patent was held void the Court would not certify that the plaintiff had proved his particulars of breaches, even though it was of opinion, on the evidence, that the defendant had infringed (*m*).

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 (*n*).

Where a plaintiff in a patent action succeeded on the issue as to validity of the patent, but failed as to infringement, the costs were apportioned (*o*). And where plaintiffs sued on two patents, and suc-

(*h*) *Nobel's Explosives Co. v. Krebs*, W. N. 1880, p. 77.

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

(*k*) *Greaves v. The Eastern Counties Railway Co.*, 1 Ell. & Ell. 961; s.c. 28 L. J. (N. S.) Q. B. 290; *Batley v. Kynock*, L. R. 20 Eq. 632.

(*l*) *Honiball v. Bloomer*, 10 Ex. 538; s.c. 24 L. J. (N. S.) Ex 11.

(*m*) *United Telephone Co. v. Harrison*, 21 Ch. D. 721.

(*n*) *Wegmann v. Corcoran*, 27 W. R. 357, 362.

(*o*) *Simmonds v. Hitchman*, Eng. Rep. Jan. to Mar. 1881, p. xvi. See the order in the Appendix.

ceded 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 (*p*). And by the Supreme Court Rules, 1883, Order LXV, Rule 2, it is provided that where issues of fact and law are raised upon a claim or counter-claim, the costs of the several issues respectively, both in law and fact, shall, unless otherwise ordered, follow the event.

“*Certified by the Court or a Judge.*” See notes under sect. 31, *post*.

General rule
as to costs.

“*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 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” (*q*).

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 (*r*), or never intended to do wrong (*s*). Nor will the plaintiff be refused costs because before suing he made no application to the defendant (*t*). 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 (*u*).

When defen-
dant 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* (*x*) 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

(*p*) *United Telephone Co. v. Harrison*, 21 Ch. D. 747.

(*q*) *Cooper v. Whittingham*, 15 Ch. D. 504. See also *Edelsten v. Edelsten*, 1 D. J. & S. 185, 204.

(*r*) *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.

(*s*) *Cooper v. Whittingham*, 15 Ch.

D. 507. See also *Davenport v. Rylands*, L. R. 1 Eq. 303.

(*t*) *Burgess v. Hateley*, 26 Bea. 249 ; *Upmann v. Forrester*, 24 Ch. D. 231.

(*u*) 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.

(*x*) 1 Webst. P. C. 200.

interferes, notwithstanding any promise the defendant may make not to offend again."

And in *Geary v. Norton* (y), 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.

And in *Upmann v. Elkan* (z), 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 (a).

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 (b).

And the plaintiff may have his costs, even though the injunction is submitted to, and the plaintiff waives the account at the hearing (c).

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 (d). But if plaintiff's conduct oppressive, he may be refused costs.

And if, after the commencement of the action, the defendant offers to

(y) 1 De G. & Sm. 9.

(z) L. R. 12 Eq. 144, 145, affirmed L. R. 7 Ch. 131.

(a) *Colburn v. Simms*, 2 Ha. 543.

(b) *Nunn v. D'Albuquerque*, 34 Bea. 595.

(c) *Burgess v. Hateley*, 26 Bea. 249; *Burgess v. Hills*, 26 Bea. 244; *Upmann v. Forrester*, 24 Ch. D. 236.

(d) *Nunn v. D'Albuquerque*, 34 Bea. 595. See also *Hudson v. Bennett*, 14 W. R. 911.

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 (e).

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% only was allowed him for costs (f).

And may be made to pay costs.

And 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 (g).

What defendant should do to avoid costs.

But the defendant, to bring himself within these principles, 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 (h)—*à fortiori* if the defendant has actually refused to pay costs (i).

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 (k).

A defendant who desires to submit before suit ought to offer to pay the plaintiff's costs of consulting his solicitor (l).

Defendant bankrupt, trustees defending, and failing, pay costs.

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 provable 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 (m).

Directors of company may be made personally liable for costs.

The directors of a limited company may be made personally liable to the costs of an action against the company to restrain infringement of

(e) *Colburn v. Simms*, 2 Ha. 543.

(f) *Caruncho v. Highmore*, L. J. No. Ca. 1883, p. 15.

(g) *De Vitre v. Betts*, L. R. 6 H. L. 319, 326.

(h) *Burgess v. Hateley*, 26 Bea. 249; *Fradella v. Weller*, 2 R. & M. 247; *Geary v. Norton*, 1 De G. & Sm. 9, 12.

(i) *Burgess v. Hills*, 26 Bea. 248.

(k) *Betts v. Willmott*, 18 W. R. 946.

(l) *Nunn v. D'Albuquerque*, 34 Bea. 596.

(m) *Watson v. Holliday*, 30 W. R. 747, affirmed 31 W. R. 536; 52 L. J. Ch. 543.

a patent, even though they may show that the acts complained were done by workmen contrary to orders (*n*).

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 (*o*).

In a trade mark case the plaintiff has been held entitled to a lien for his costs on the goods complained of (*p*). But this decision has since been questioned (*q*). Lien for costs.

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 (*r*). 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, and his bill was dismissed for want of prosecution (*s*).

But 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 (*t*). Motion for injunction ordered to stand to hearing.

The general rule is that the applicant must pay the costs of an application to stay proceedings pending an appeal (*u*); 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 (*x*). Staying proceedings pending appeal.

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 (*y*). Party and party costs.
Costs for "luxuries" not allowed.

(*n*) *Bette v. De Vitre*, 11 Jur. (N. S.) 9, affirmed L. R. 3 Ch. 429, 442; 6 H. L. 319. See as to this *A. G. v. Vestry of Bermondsey*, 23 Ch. D. 60; *Mathias v. Yetts*, 46 L. T. 497.

(*o*) *Ward v. Key*, 10 Jur. 792.

(*p*) *Upmann v. Elkan*, L. R. 12 Eq. 140, affirmed 7 Ch. 131; *Moet v. Pickering*, 6 Ch. D. 770.

(*q*) *Moet v. Pickering*, 8 Ch. D. 372.

(*r*) *Stevens v. Keating*, 1 Mac. & G. 659.

(*s*) *Betts v. Clifford*, 1 J. & H. 74.

(*t*) *Mounsey v. Earl Lonsdale*, L. R. 6 Ch. 141.

(*u*) *Merry v. Nickalls*, L. R. 8 Ch. 205; *Cooper v. Cooper*, 2 Ch. D. 493.

(*x*) *Adair v. Young*, 11 Ch. D. 136.

(*y*) *Per Sir R. Malins, V.C., Smith v. Buller*, L. R. 19 Eq. 473.

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 (z).

Proper remuneration to scientific witnesses allowed.

But proper remuneration to scientific witnesses will be allowed, and also the expense of preparing a model for the trial (a). And the costs of reference by the Court to an expert will be costs in the cause (b).

Costs of preparing for trial.

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 (c); and in *Curtis v. Platt* (d), 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 was 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."

However, in *Batley v. Kynock* (e), where the plaintiff shortly before the hearing dismissed his bill with costs, and the taxing-master had allowed to the defendant the expenses of drawing particulars of objections (f) 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 sort of defence he could lawfully use. But his Lordship intimated that if complaint is made that the charge is unreasonable, or that the

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

(a) *Batley v. Kynock*, L. R. 20 Eq. 632.

(b) *Badische Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. 156, 176.

(c) *Freeman v. Springham*, 14 C. B. (N. S.) 197.

(d) 10 Jur. (N. S.) 823; *s.c.* 33 L. J. (N. S.) C. P. 255.

(e) L. R. 20 Eq. 632.

(f) The report speaks of particulars of breaches, but this is clearly a clerical error.

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.

It is said that at common law, where several sections 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 (*g*). 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 (*h*).

Costs in consolidated actions.

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, &c., in action.

This is substantially a re-enactment of the corresponding section of the Act of 1852 (*i*); 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 (*k*), 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 (*l*) or inspection as he could have in equity (*m*). 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 sect. 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.

By sect. 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 the

(*g*) "Lush's Practice," 3rd ed., 965.

(*h*) *Amos v. Chadwick*, 9 Ch. D. 459.

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

(*k*) *Holland v. Fox*, 3 E. & B. 977; *s.c.* 1 Jur. (N. S.) 13.

(*l*) *Gillins v. Symes*, 15 C. B. 362.

(*m*) 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, when 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.

Supreme Court Rules, 1883, Order L, Rule 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 (*n*).

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 wherever it shall think proper so to do, and this jurisdiction can be exercised by any Judge of the Court (*o*). 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 (*p*), subject, however, to the provisions of Order LIV, Rule 12, and Order LV, Rule 15. No writ of injunction is for the future to 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 (*q*).

In *Vidi v. Smith* (*ante*, p. 87) it was held that the "inspection" mentioned in sect. 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.

(*n*) See also Supreme Court Rules, 1883, Rule 6. 864; *Quartz Consolidated, &c., Co. v. Beall*, 20 Ch. D. 501.

(*o*) *Beddow v. Beddow*, 9 Ch. D. 89; *Thomas v. Williams*, 14 Ch. D. 138. (*p*) See *Frearson v. Loe*, 26 W. R.

(*q*) Supreme Court Rules, 1883, Order L, Rule 11.

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” (r).

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 when 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” (s).

Rule as to long enjoyment.

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 (t).

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” (u).

(r) *Dudgeon v. Thomson*, 30 L. T. (N. S.) 244; s.c. 22 W. R. 464.

(s) *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. 707; *Stevens v. Keating*, 2 Webst. 177; *Harmar v. Plane*, 14 Ves. 130; *Bickford 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; *Davenport v. Jepson*, 4 D. F. J. 440.

(t) Per Turner, L.J., *Davenport v. Jepson*, 4 D. F. J. 446; *Caldwell v. Vanvylsengen*, 9 Ha. 415, 424; *Electric Telegraph Co. v. Nott*, 2 Coop. Ch. Ca. 41.

(u) *Stevens v. Keating*, 2 Webst. 177.

Comparative inconvenience not considered in cases of long enjoyment.

In these cases the Court does not proceed on the ground of comparative inconvenience. In *Davenport v. Jepson* (x), 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 appears to have been the view of Lord Eldon in *Harmar v. Plane* (y), and of Lord Cottenham in *Stevens v. Keating* (z).

But enjoyment must have been uninterrupted.

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 (a). 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 (b).

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, the application was refused (c).

Or dependent on substratum patent.

And 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 (d).

Injunction granted on long enjoyment, though validity of patent doubtful.

But 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 (e). Thus, in *The Universities of Oxford and Cambridge v. Richardson* (f), 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,

(x) 4 D. F. J. 448.

(y) 14 Ves. 130.

(z) 2 Webst. 177.

(a) *Collard v. Allison*, 4 My. & Cr. 487.

(b) *Curtis v. Cutts*, 8 L. J. (N. S.) 184; 2 Coop. C. C. 60.

(c) *Plimpton v. Malcolmson*, L. R. 20 Eq. 38.

(d) *Heugh v. Magill*, W. N. 1877, 62.

(e) *Betts v. Menzies*, 3 Jur. (N. S.) 357, 359; *Dudgeon v. Thomson*, 30 L. T. (N. S.) 244.

(f) 6 Ves. 707. See also *Gardner v. Brocabent*, 2 Jur. (N. S.) 1041.

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 injoin, 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* (*g*) 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 (*h*).

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 Lyndhurst, 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" (*i*).

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 :—

What length of enjoyment sufficient for injunction.

In *Harmar v. Plane* (*k*) the patentee had had thirteen years' enjoyment; in *Neilson v. Thompson* (*l*), twelve years; in *Stevens v. Keating* (*m*), of one patent, thirteen years, of another, seven years; in *Davenport v. Richards* (*n*), nine years; in *Betts v. Menzies* (*o*), eight years; in *Losh v. Hague* (*p*), seven years; and in *Bickford v. Skewes* (*q*), six years. (In *Neilson v. Thompson*, *Stevens v. Keating*, and *Betts v. Menzies*, the injunctions were ultimately dissolved, but not on any ground affecting the question of long enjoyment.)

In *Renard v. Levenstein* (*r*), Lord Hatherley, C., 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.

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 (*s*).

And in *Renard v. Levenstein* (*t*), where the patent was only two years old at the time of the filing of the bill, and its validity had not been

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| (<i>g</i>) 1 Webst. 201. | (<i>o</i>) 3 Jur. (N. S.) 357. See also |
| (<i>h</i>) See also <i>Beeston v. Ford</i> , 2 | L. R. 3 Eq., p. 312 |
| Coop. C. C. 58; <i>Bickford v. Skewes</i> , | (<i>p</i>) 1 Webst. 200. |
| 1 Webst. P. C. 213. | (<i>q</i>) 1 Webst. 211, 213. |
| (<i>i</i>) 2 Webst. 93, 95. | (<i>r</i>) 10 L. T. (N. S.) 94. |
| (<i>k</i>) 14 Ves. 130. | (<i>s</i>) 3 Mer. 622; 1 Webst. 232. |
| (<i>l</i>) 1 Webst. 279. | See also <i>Plimpton v. Malcolmson</i> , |
| (<i>m</i>) 2 Webst. 176. | L. R. 20 Eq. 37. |
| (<i>n</i>) 3 L. T. (N. S.) 503. | (<i>t</i>) 10 L. T. (N. S.) 177. |

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 those had bought the article complained of from the defendant's own agent (*u*). 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, the validity of the patent, without, as was the old practice of the Court of Chancery, sending the question of the validity of the patent 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 (*x*).

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 *Croskill v. Tuxford* (*y*), *Croskill v. Ivory* (*z*), 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*).

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

(*u*) These facts appear from the report before the V.C., 10 L. T. (N. S.) 94.

(*x*) *Per* Turner, L.J., *Davenport v. Jepson*, 4 D. F. J. 447.

(*y*) 5 L. T. 342.

(*z*) 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; *Buvill v. Smith*, W. N. 1867, 240; *Dudgeon v. Thomson*, 30 L. T. (N. S.) 244.

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).

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.

In *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 allowed (i), and this course has been followed under 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). Issues found in plaintiff's favour, injunction granted.

(c) *Per* Lord Romilly, M.R., *Bovill v. Goodier* (2), L. R. 2 Eq. 200.

(d) *Newall v. Wilson*, 2 D. M. G. 282.

(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.

(i) *Neilson v. Harford*, 1 Webst. P. C. 373; *Russell v. Cowley*, 1 Webst. P. C. 471.

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

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*).

But new defendant not bound by proceedings in former action.

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 (*s*).

But injunction may be granted and issue as to novelty directed.

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 (*t*).

(*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. Bilby*, L. R. 3 Eq. 308, 312.

(*q*) 12 Bea. 1.

(*r*) *Thorn v. Worthing Skating Rink Co.*, 6 Ch. D. 415, n.

(*s*) *Bovill v. Goodier* (2), L. R. 2 Eq. 195. See also *Russell v. Barnsley*, 1 Webst. 472; *s.c.* 2 Coop. C. C. 58. See, however, *Davenport v. Goldbery*, 2 H. & M. 286.

(*t*) *Bovill v. Goodier*, *ubi sup.*

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 for disputing the patent (*u*). 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 (*x*). 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 (*y*).

Thus, in *Lawes v. Purser* (*z*), 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* (*a*), 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?"

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 Even when licence is verbal only.

(*u*) *Bowman v. Taylor*, 2 Ad. & E. 278; 1 Webst. 292. See also *Cutler v. Bower*, 11 Q. B. 973.

(*x*) *Smith v. Scott*, 6 C. B. (N. S.) 771; 5 Jur. (N. S.) 1358. See also *Hall v. Conder*, 2 C. B. (N. S.) 22.

(*y*) *Clark v. Adie* (No. 2), 2 App. Cas. 423; *Chavasse v. Stevens*, W. N. 1874, p. 193.

(*z*) 6 E. & B. 930.

(*a*) 7 H. & N. 499.

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 plaintiffs’ 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” (b).

And the rule applies though patent declared bad in action against third party.

And the above rules will apply as between the plaintiff and the defendant, his licensee, even though subsequently to the commencement of the action the patent has, in another proceeding against a third person, been declared invalid (c).

Nor can licensee recover from patentee because patent bad.

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” (d).

But otherwise if licensee has not used the invention.

But where the defendant had agreed to pay an annuity of 400*l.* a-year as the consideration for using 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 (e).

And in *Hayne v. Maltby* (f), 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

(b) *Crossley v. Dixon*, 10 H. L. C. 293, 308, 310; *Clark v. Adie* (No. 2), 2 App. Cas. 423.

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

(d) *Taylor v. Hare*, 1 B. & P. N. R. 260; 1 Webst. P. C. 292. See

also *Collinge v. Bowman*, 1 Webst. P. C. 295.

(e) *Chanter v. Leese*, 4 M. & W. 295; 5 M. & W. 698; 1 Webst. P. C. 295.

(f) 3 T. R. 438; 1 Webst. P. C. 291.

covenant, one for using patent machines other than that by the agreement allowed, and the other for using machines resembling the patent 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* (g), 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* (h), 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.

After the determination of a licence the licensee may dispute the validity of the patent as against his licensor (i). But licensee may dispute the patent when licence determined.

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 (k).

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 (l). Licensee entitled to have ambit of licence determined.

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 stopped 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 (m).

And 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

(g) 2 Ad. & E. 278; 1 Webst. 293.

(h) 1 Webst. P. C. 290.

(i) *Dangerfield v. Jones*, 13 L. R. (N. S.) 142; *Armann v. Lund*, L. R. 18 Eq. 330; *Crossley v. Dixon*, *ubi sup.*

(k) *Pidding v. Franks*, 1 Mac. & G. 56.

(l) *Per* Lord Cairns, L.C., *Clark v. Adie* (No. 2), 2 App. Cas. 426.

(m) *Muntz v. Grenfell*, 2 Webst. P. C. 88, 91.

restrain infringement by him, and an interlocutory injunction was granted (*n*).

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 (*o*).

Again, where a 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, 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 (*p*).

And 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 (*q*).

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 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 (*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*).

(*n*) *Chambers v. Orichley*, 33 Bea. 374.

(*o*) *Oldham v. Langmead*, cited 3 T. R. 439; *Walton v. Lavater*, 8 C. B. (N. S.) 162, 187.

(*p*) *Clark v. Ferguson*, 1 Giff. 184.

(*s*) *Newall v. Elliott*, 1 H. & C. 797.

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

(*q*) *Betts v. Menzies*, 3 Jur. (N. S.) 357.

(*r*) *Dudgeon v. Thomson*, 30 L. T. (N. S.) 244.

And in *Armann 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*).

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*).

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.

The rules above stated only apply where the sole question between the parties is the validity of the patent (*z*). 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,

(*t*) L. R. 18 Eq. 330.

(*u*) These circumstances appear to distinguish this case from *Muntz v. Grenfell*, *ante*, p. 97, which does not appear to have been cited in *Armann v. Lund*.

(*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*) *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.

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 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" (a).

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 (b). And in *Muntz v. Vivian* (c), 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 (d).

Expressed
intention to
infringe
sufficient to
found
injunction.

But 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 injunction without proving actual infringement, provided, of course, that what is threatened to be done would be an infringement (e).

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 (f).

Evidence
should clearly
show infringe-
ment.

The plaintiff's evidence on an application for an injunction should show distinctly the manner in which the alleged infringement has taken place (g).

(a) *Electric Telegraph Co. v. Nott*, 11 Jur. 157; s.c. 2 Coop. C. C. 41.

(b) *Morgan v. Seward*, 1 Webst. P. C. 168.

(c) 2 Webst. P. C. 87.

(d) *Thorn v. Worthing Skating Rink Co.* 6 Ch. D. 415, 418, n.

(e) *Frearson v. Loe*, 9 Ch. D. 48, 65.

(f) *Adair v. Young*, 12 Ch. D. 13.

(g) *Hill v. Thompson*, 1 Webst. P. C. 231.

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 (*h*); and in *Jones v. Pearce* (*i*), 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.

Injunction refused, defendant ordered to keep an account.

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 (*k*), and there is no doubt of the competency of the Court to grant an interlocutory injunction *simpliciter* (*l*). But this undertaking was required by Sir J. L. Knight Bruce, V.C., in *Muntz v. Grenfell* (*m*).

Injunction granted, plaintiff required to give undertaking as to damages.

And it is now settled that the Court will always require it on granting the interlocutory injunction (*n*), and this not merely on *ex parte* applications, but also on injunctions granted upon motion after notice (*o*).

And the undertaking has been required even where the patent had been established in previous suits, and 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 (*p*). 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 (*q*).

For the form of the undertaking see "Seton on Decrees," 4th ed., p. 171. The ultimate dismissal of the action does not put an end to the undertaking (*r*), but it is doubtful if it can be enforced when the injunction has been wrongly granted owing to a mistake of law by the Judge (*s*).

(*h*) *Hill v. Thompson*, 3 Mer. 662; *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 on Decrees," 4th ed., p. 344.

(*i*) 2 Coop. C. C. 58.

(*k*) *Bickford v. Skewes*, 1 Webst. 214; *Tuck v. Silver*, Johnson, 218.

(*l*) *Bacon v. Jones*, 4 My. Cr. 436; *Wilson v. Tindal*, 1 Webst. P. C. 730.

(*m*) 2 Webst. 91. See the order, 2 Coop. C. C. 59.

(*n*) *Chappell v. Davidson*, 8 D. M. G. 1.

(*o*) *Tuck v. Silver*, Johns. 218; *Wakefield v. Duke of Buccleuch*, 11 Jur. (N. S.) 524; *Graham v. Campbell*, 7 Ch. D. 491.

(*p*) *Bovill v. Smith*, W. N. 1867, 240.

(*q*) *Renard v. Levinstein*, 2 H. & M. 628, 634.

(*r*) *Newby v. Harrison*, 3 D. F. G. 287; *Graham v. Campbell*, *ubi sup.*

(*s*) *Smith v. Day*, 21 Ch. D. 421. *Ex parte Hall*, 23 Ch. D. 644.

Whether questions both as to validity of patent and fact of infringement.

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 (*t*). 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 (*u*). And in *Plimpton v. Malcolmson* (*v*) 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.

Court considers best mode of keeping things *in statu quo*.

The Court on the interlocutory application avoids as far as possible expressing an opinion on the merits of the case (*x*), 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 (*y*).

Circumstances leading to refusal of injunction.

Where granting the injunction would be extremely prejudicial to the defendant, and do no possible good to the plaintiff, the injunction will be refused (*z*).

Thus, in *Morgan v. Seward* (*a*), 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.

Circumstances 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 (*b*).

The circumstance that the old practice (*c*) 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 ought to be granted or not (*d*). The patentee may, if the injunction be granted, be put upon terms to bring the action to trial as speedily as possible (*e*), and this course was adopted in *Renard v. Levinstein* (*f*).

(*t*) *Wood v. Cockerell*, 2 Coop. C. C. 58.

(*u*) Per Lord Langdale, *Bridson v. McAlpine*, 8 Bea. 230.

(*v*) L. R. 20 Eq. 38.

(*x*) *Plimpton v. Malcolmson*, L. R. 20 Eq. 38.

(*y*) *Plimpton v. Spiller*, 4 Ch. D. 289.

(*z*) *Neilson v. Thompson*, 1 Webst. 275, 285.

(*a*) 1 Webst. 169.

(*b*) *Plimpton v. Spiller*, 4 Ch. D. 286, 292. See also *Read v. Richardson*, 45 L. T. 54, 58.

(*c*) *Bacon v. Jones*, 4 My. & Cr. 436; *Jones v. Pearce*, 2 Coop. C. C. 58.

(*d*) *Davenport v. Jepson*, 4 D. F. J. 440, 445, 446.

(*e*) *Davenport v. Jepson*, 4 D. F. J. 448.

(*f*) 10 L. T. (N. S.) 94; s.c. on App., *Ibid.* 177.

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 (*g*).

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 own original invention, and that he was under a mistake when he made his previous application (*h*).

Ex parte
injunctions.

This rule was recognized by Lord Lyndhurst, C., in *Sturz v. De la Rue* (*i*), 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 (*k*), and this view appears to be correct (*l*).

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 (*m*).

According to the present practice *ex parte* injunctions are not very frequent. The Court more generally grants an interim order restraining the defendant till after a day named, liberty being given to the plaintiff to serve notice of motion for an injunction for 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 (*n*).

If two persons have obtained patents for the same invention, the

(*g*) *Stevens 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. M'Clellan*, 27 L. J. (N. S.) 57; *Arnold v. Thomson*, 9 Jur. (N. S.) 436.

(*h*) *Hill v. Thompson*, 3 Mer. 329; s.c. 1 Webst. P. C.

(*i*) 5 Russ. 322, 329. See also

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

(*k*) "Hindmarch on Patents," 334.

(*l*) *Whitton v. Jennings*, 1 Dr. & Sm. 110; *Mayer v. Spence*, 1 J. & H. 87.

(*m*) *Dalglis v. Jarvie*, 2 Mac. & G. 231. See *Curtis v. Cutts*, 3 Jur. 34.

(*n*) "Daniell's Chancery Practice," 4th ed., p. 1507.

Court would not interfere between them by interlocutory injunction, but left them to try the legal right by *scire facias* (o) (now by petition of revocation, sect. 26).

Application for 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 (p). 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 *Bovill v. Crate* (q), 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 (r).

When delay no bar.

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 (s).

And where the plaintiff, having known of the infringement on the 23rd March, spent some time in making inquiries, on the 8th May gave notice to the defendant to desist, and, after some correspondence, filed his bill on the 7th July, he was held to have come in sufficient time, and the injunction was granted (t).

Acquiescence.

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 same terms on which other licences had been granted,

(o) *Copeland v. Webb*, 11 W. R. 134; *s.c.* 1 N. R. 119. See also *Baskett v. Cunningham*, 2 Ed. 137.

(p) *Bacon v. Jones*, 4 My. & Cr. 438; *Bridson v. Benecke*, 12 Bea. 1, 3; *Baxter v. Combe*, 1 Ir. Ch. R. 284.

(q) L. R. 1 Eq. 388.

(r) See also *Smith v. London and South-Western Railway Co.*, Macr. P. C. 209; *s.c.* Kay, 417.

(s) *Bovill v. Smith*, W. N. 1867, 240.

(t) *Losh v. Hague*, 1 Webst. P. C. 201.

(u) 1 Webst. 275, 285.

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*).

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*). But acquiescence may be a ground for refusing an account of profits (*z*). Delay no bar at trial.

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. Perpetual injunction.

But the Court will not grant such perpetual injunction unless the validity of the patent has been conclusively established (*a*).

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 the Lord Chancellor, the Court refused to suspend the final order for injunction pending an appeal to the House of Lords (*b*). 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 (*c*). Not suspended pending appeal.

For forms of orders for interlocutory and perpetual injunctions, and in patent cases, see "Seton on Decrees," 4th ed., pp. 343, 344, 352, and 353, and "Pemberton on Judgments," 3rd ed., pp. 235 and 236.

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. May by consent be obtained without bringing action to trial.

This may be done by motion (*d*), or, 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 (*e*), subject to the provisions of Order LIV, Rule 12, and Order LV, Rule 15.

(*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.

(*z*) *Crossley v. Beverley*, 1 Webst. 120.

(*a*) See *Hill v. Evans*, 4 D. F. J. 288, 289.

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

(*c*) *Flower v. Lloyd*, 36 L. T. (N. S.) 445.

(*d*) *Morrell v. Pearson*, 12 Bea. 284.

(*e*) Judicature Act, 1873, s. 39; *Frearson v. Loe*, 26 W. R. 138.

Breach of injunction.

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 has ceased to be in force (*f*).

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 (*g*).

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 at sea (injunction or no injunction), *salus navis est suprema lex*. And for myself, I believe that a master would be practically as safe in disobeying an injunction under a pressing emergency as he would be in shooting a mutineer" (*h*).

On a motion to commit for breach of a perpetual injunction restraining infringement of a patent for skates, the skate now complained of being different from that which was put in evidence at the trial, 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 (*i*).

INSPECTION.

The earliest reported patent case in which inspection was ordered is *Brown v. Moore* (*k*), which appears (*l*) 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 (*m*).

Inspection not a matter of right.

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.

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

(*g*) *Plimpton v. Spiller*, 4 Ch. D. 287.

288.

(*h*) *Adair v. Young*, 12 Ch. 21.

(*i*) *Plimpton v. Spiller*, 4 Ch. D. 287.

(*k*) 3 Bligh, 178.

(*l*) See *post*, p. 110.

(*m*) See also *Russell v. Cowley*, 1 Webst. 458.

In *Piggott v. The Anglo-American Telegraph Co.* (n), the plaintiffs were owners of a patent for improvements in the mode of generating electric currents, manufacturing submarine telegraph cables, and transmitting signals. 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 particular cable, and that in that view there could be no question of infringement to try at the hearing, refused the motion.

What is required on application for inspection.

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 (o).

Inspection must be shown to be of material importance to plaintiff.

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 (p).

And 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 (q). 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 he had used no machinery, and only employed the same process as had been used many years before the patent (r).

Nor will inspection be granted if the plaintiff has already had in an action against the defendant, which action he had discontinued, an inspection of the machinery complained of (s).

Where, however, a *prima facie* case of infringement is made out But inspection allowed if

- (n) 19 L. T. (N. S.) 46. 22 L. J. Q. B. 84; *Meadows v. Kirkman*, 29 L. J. Ex. 205.
 (o) *Piggott v. Anglo-American Telegraph Co.*, 19 L. T. (N. S.) 46. (q) *Shaw v. Bank of England*, 22 L. J. (N. S.) Ex. 26.
 (p) *Batley v. Kynock*, L. R. 19 Eq. 91. See also *Amies v. Kelsey*, (r) *Meadows v. Kirkman*, 29 L. J. Ex. 205.
 (s) *Shaw v. Bank of England*, 22 L. J. (N. S.) Ex. 210.

prima facie case of infringement made out.

against a defendant, an order for inspection is almost a matter of course (*t*), at all events, when such inspection is essential for the purpose of enabling the plaintiff to prove his case (*u*).

Inspection not allowed so as to be oppressive.

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 ordered 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 (*x*).

And where a plaintiff asked, under the Judicature Rules, Order L, Rule 3 (of which Order L, Rule 3, of the Supreme Court Rules, 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" (*y*).

And an inspection of defendant's books will not be ordered on affidavits which only show 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, &c., 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 (*z*).

Trade secrets.

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.* (*a*) some weight was given to this objection, but there were other reasons above stated for refusing the inspection asked.

But in general this allegation will be insufficient to bar the plaintiff's

(*t*) Per Lord Hatherley, *Singer Manufacturing Co. v. Wilson*, 13 W. R. 560; s.c. 5 N. R. 505.

(*u*) *Battley v. Kynock*, L. R. 19 Eq. 90, 92.

(*x*) *Singer Manufacturing Co. v. Wilson*, 13 W. R. 560; s.c. 5 N. R. 505. See the order, "Pemberton on Judgments," 3rd ed., 236.

(*y*) *Flower v. Lloyd*, W. N. 1876, 169, 170.

(*z*) *Smith v. London and Great Western Railway Co.*, Macr. P. C. 223.

(*a*) 19 L. T. (N. S.) 46, *ubi sup.* See also *Smith v. London and Great Western Railway Co.*, *ubi sup.*

right to inspection if he be otherwise entitled thereto. Thus, in *Renard v. Levinstein* (b), 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* (c), 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. 108), 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 (d).

This order is set out in "Seton on Decrees," 4th ed., p. 351, and it is there said that in the order as drawn up the words, "under the obligation of confidence," used by their Lordships, were not inserted; and 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 plaintiff's patents, and state whether it was the ordinary process or not which 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 (e).

The inspector may be ordered to report to the Court if the defendant's machines are trade secrets (f), and he has been directed to state his opinion whether the defendant's machines are infringements (g),

(b) 10 L. T. (N. S.) 94.

(c) 15 Dec. of the Court of Session, 1st Series, p. 1270.

(d) W. N. 1876, 230.

(e) See order in *Plating Co. v. Farquharson*, Appendix.

(f) *Hill v. Tombs*, Appendix. See also an order in *Hall v. New Sidgwick Company*, M. R. 5 April, 1881.

(g) *Hill v. Tombs*, Appendix.

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" (*h*).

What evidence sufficient to found inspection in cases of alleged trade secret.

The case of *Brown v. Moore* (*i*) 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; 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 the plaintiff's machine. An *ex parte* injunction having been obtained, a motion to 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 (*j*), 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 the 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 an inspection of a model of the plaintiff's machine.

The report of the case cited in Cooper's Reports as *Bovill v. Moore* (*k*) 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

(*h*) *Plating Co. v. Farquharson*, Appendix.

(*i*) 3 Bligh, 178.

(*j*) This seems to be the action reported as *Bovill v. Moore* in Carpenter's Reports, pp. 320, 348.

(*k*) 2 Coop. C. C. 56.

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 case, it would give the plaintiff liberty to take and carry away samples of the article the manufacture of which is complained of.

Samples allowed to be taken.

Thus, in *Russell v. Cowley* (l) (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* (m), 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 (n).

And this power to order samples to be taken is now expressly conferred by the Supreme Court Rules, 1883, Order L, Rule 3, cited above.

In *Morgan v. Seward* (o), 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.

The order for inspection usually provides for reasonable notice being given to the parties against whom it is made (p), and in the case of

Reasonable notice to be given.

(l) 1 Webst. 459.

(m) Johnson, 727.

(n) 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 on Judgments," 3rd ed., p. 236.

(o) 1 Webst. 169.

(p) *Russell v. Cowley*, 1 Webst. P. C. 458; *Davenport v. Jepson*, "Pemberton on Judgments," 3rd ed., p. 236; *Flower v. Lloyd*, "Seton on Decrees," 4th ed., p. 351.