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SECT. 8.

Bankruptcy
of patentee.

passes to a bankruptcy assignee; but held, that it did pass: *Bloxam v. Elsee*, 1827, 6 B. & C. 169, 9 D. & R. 215. In *Ex parte Granger* the question was raised whether a patent used and worked by a bankrupt patentee, after he had mortgaged it, continued in his "use and occupation," so as to pass to his creditors. The question was not decided: *Ex parte Granger*, 1812, Godson's Pat., 2nd ed., 225. If a bankrupt take out a patent before he obtains a certificate of discharge, it goes to his creditors, but if after his discharge he patent something that he had discovered before, it does not pass: *Hesse v. Stevenson*, 1803, 3 Bos. & P. 565.

A patentee whose patent has passed to his trustees in bankruptcy is not estopped from disputing its validity as against one who buys it from those trustees, for there is no privity whereby the estoppel may arise: *Cropper v. Smith*, 10 App. Cas. 249, 2 R. P. C. 17.

ante, p. 280.

9. Co-ownership and partnership in patents.—A patent is a franchise, that is to say, a privilege which may be enjoyed by a number of persons to the exclusion of others. If a patent be granted to A and B, each of them may use it, and it is clear that in the absence of some agreement for a partnership, neither is bound to share with the other the profits he makes out of it. In *Mathers v. Green*, 1865, 1 Ch. App. 32, the defendants had paid the patent fees, and the patent was taken out jointly by them and the plaintiff. Held, that the plaintiff had no right to share in their profits: see also *Steers v. Rogers*, 1892, 9 R. P. C. 185; confirmed on appeal, L. R. App. Cas. [1893] 232. These cases only decide that the mere fact of joint ownership creates no duty to share the profits, but if there are circumstances from which a joint adventure

could be inferred, as, for instance, joint contribution towards expenses, then it might well be argued that this gave rise to a duty to share the profits. The law has been differently laid down in the case of joint copyrights: *Powell v. Head*, 1879, 12 Ch. D. 686 (*per* Jessel, M.R.).

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Co-ownership
and partner-
ship in
patents.

The rights of co-owners are very curious. For in the absence of agreement each of them can cut his share into as many pieces as he pleases, each of which will give full powers of user to the grantee. Hence, to possess one-tenth of a patent is just as valuable as to possess the remaining nine-tenths. This seems to raise some inference that where a patent is divided into aliquot shares, it was intended that some division of profits should ensue, but this view was not taken in *Steers v. Rogers* above-mentioned.

In every case the question of partnership in the profits must be one of fact. Plaintiff agreed to try a patent, and if it succeeded to employ the patentee to work it for him, at a salary and a share of the profits. The experiment succeeded, but nothing was done. Plaintiff filed a bill for dissolution of the quasi-partnership; but held, that there was no partnership at all: *Osborne v. Jullion*, 1856, 26 L. J. Ch. 6. Plaintiff agreed to lend defendant £59 to perfect two inventions, on terms of receiving half profits. The question whether this constituted a partnership was raised, but not decided: *Elgie v. Webster*, 1839, 5 M. & W. 518; see also *Kenny's Patent Buttonholing Co. v. Somerville*, 1878, 38 L. T. (N.S.) 878; *Wilson v. Barbour*, 1888 (Ir.) 5 R. P. C. 675.

10. Assignments to the Secretary of State for War are regulated by Patents Act, 1883, sec. 44, which contains twelve subsections dealing with the matter. *post*, p. 459.

CHAPTER XXIII.

LICENSES.

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ante, p. 260.

ante, p. 275.

1. Licenses.—The form of the grant expressly gives power to the patentee to grant licenses to persons to use any part of the invention, in any way, for any time, or over any part of the area of the patent: Chap. XVII., sect. 1; and if each of two joint patentees may assign his share (Chap. XXII., sect. 2), it is to be presumed that each of them may also license. The somewhat extraordinary result seems to follow that one of two co-owners might by licensing everyone who asked for it, ruin the patent altogether if he were in the mind to do so.

The permission to use a patent, though in form a license, may in some cases, if the operative words are sufficiently wide and the license is exclusive, to one person, and for the whole invention and whole duration of the patent, amount to a grant, just as a lease of premises for the remainder of the term may amount to an assignment. *Renard v. Levinstein*, 1864, 3 N. R. 665; 5 N. R. 301; *Newby v. Harrison*, 1861, 1 J. & H. 393.

But it by no means follows that an exclusive license would always be construed as a grant, and accordingly in *Heap v. Hartley*, 1889, 6 R. P. C. 501, an exclusive license for a particular district for four years from the second year of the life of the patent was not considered as an assignment, and hence the licensee was held not entitled to sue without joining the patentee.

The law respecting the form which a licence ought to have is still somewhat obscure. For it is by no means clear from the terms of the grant whether licenses ought to be by deed or may be by parol. In the early part of the grant it is said "the patentee by himself his agents or licensees and no others, may . . . make use exercise and vend the said invention." But further on we find the words "the consent license or agreement of the said patentee in writing under his hand and seal," and at the end, "Provided also that nothing herein contained shall prevent the granting of licenses in such manner and for such considerations as they may by law be granted." This last proviso was originally attached to the old condition (now obsolete) rendering the patent void if assigned to more than twelve persons, and was inserted in order to prevent the wide grant of exclusive licenses for the life of the patent to a large number of persons from being considered as voiding the patent. When the main clause was removed the proviso was left, though its effect in its present position is difficult to determine.

Upon the whole it seems probable that in order to affect third parties, and give a real interest to the licensee as against all the world, a deed would be necessary.

But the cases shew that as between the patentee and his licensees, licenses by parol (*i.e.*, verbal or in writing) are not wholly inoperative.

For example, it is certain that a man who buys a patented article from an inventor acquires a license to use it, without any deed. And a person who uses an invention under a parol license would have to pay for that use. *Chanter v. Dewhurst*, 1844, 12 M. & W., 823, 13 L. J. Ex. 198. *Crossley v. Dixon*, 1863, 10 H. L. C. 293, 32 L. J. Ch. 617. *Wilson v. Union Oil Mills*, 1892,

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9 R. P. C. 63. *Crossthwaite v. Steel*, 1889, 6 R. P. C. 190, and compare *Chanter v. Leese*, 1838, 4 M. & W. 311, 5 M. & W. 698. A license in writing does not need any stamp, *Chanter v. Johnson*, 14 M. & W. 408, though it would if it amounted to an agreement. *Wilson v. Union Oil Mills*, cited supra. A license by deed must be duly stamped.

An agreement for a license, by which the preparation of a formal deed is in contemplation, differs from a parol license, for it can be specifically performed, and in equity will be equivalent for many purposes to the deed itself. *Postcard Automatic Supply Co. v. Samuel*, 1889, 6 R. P. C. 562.

A license may be granted after the provisional specification, but before the complete specification has been filed or the patent granted, *Otto v. Singer*, 1889, 7 R. P. C. 7. An agreement to work a patent "as long as it could be worked at a profit" was held as meaning profit after paying royalties. *Kernot v. Potter*, 1861, 30 Beav. 343. For an example of interpretation of a particular license see *Bown v. Humber*, 1889, 6 R. P. C. 9.

At common law a license is by its nature revocable, and therein differs from a grant. Brooke's Abridgment, License, pl. 9. And provided that it is only a license it is equally revocable whether it is by parol or by deed. *Wood v. Ledbitter*, 1845, 13 M. & W. 838, 14 L. J. Ex. 161. It is equally revocable even though a consideration had been paid for it, though if revoked the consideration would probably be recoverable, *ibid.*

If however the license be coupled with an interest this would make it irrevocable, and indeed every irrevocable license, depending not merely on the continuing will of the licensor, does give an interest.

In each case the question of revocability must depend upon the intention of the parties, but it seems clear, that

a mere license to use a patent without specifying any time would be interpreted as meaning only as long as the respective parties chose, *Clark v. Adie*, 1873, L. R. 2 App. Cas. 315. *Crossley v. Dixon*, 1863, 10 H. L. Cas. 293. *Redges v. Mulliner*, 1892, 10 R. P. C., 21. A revocation of a license granted by deed should be by deed.

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And notice of revocation is necessary. *Cornish v. Stubbs*, 1870, L. R. 5 C. P. 334. *Mellor v. Watkins*, 1874, L. R. 9 Q. B. 400.

The words “*upon the terms and conditions following*” in a license were held to give a right of revocation if those terms were broken: *Ward v. Livesey*, 1887, 5 R. P. C. 102. A right of rescission reserved in a patent license may of course be waived by receipt of royalties: *Warwick v. Hooper*, 1850, 3 Mac. & G. 60.

Where an exclusive license is given by deed there is no implied condition that the licensees shall pay the fees or keep up the patent: *Re Railway & Electrical Appliances Co.*, 1888, 38 Ch. D. 597. In *Mills v. Carson*, 1892, 9 R. P. C. 338, 10 R. P. C. 9, a patentee had granted a license by deed for the residue of the term of the patent, with covenants for quiet enjoyment and payment of the royalties during the term of the patent, royalties to cease if the patent should not be novel or the patentee should not defend his patent. The patent fees were not paid, and, therefore, the licensee refused to pay further royalties, and endeavoured to set up want of novelty in the patent. Held, (1) That it was doubtful whether the covenant for quiet enjoyment made it the duty of the plaintiff to pay the fees. (2) That even if it did, the covenant for quiet enjoyment and that for payment of royalties were not co-extensive, so that one was conditioned upon the other. (3) That inasmuch as the deed contained express provi-

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sions for defeasance of the royalties (among which failure to keep up the patent was not included), it must be held to have not been intended that the failure to keep up the fees absolved the licensee from paying royalties, and (4) That the condition making the royalties cease if the patent was not novel did not release the licensee from the ordinary doctrine of estoppel. A license may in its terms be assignable: *Hindmarch*, 242; *Bower v. Hodges*, 1853, 22 L. J. C. P. 194. An agreement for a license does not constitute a partnership, as was argued in *Ridge-way v. Philip*, 1834, 1 C. M. & R. 415.

2. Estoppel may arise either (a) by deed, (b) by conduct, that is to say, "in pais," or else (c) by record.—It is an equitable doctrine in its nature, though it has always been applied at common law, and arises in cases where it would be against good faith to assert facts which might be true. Hence, an estoppel can never be created by fraud: Chap. XXII., sect. 4. When the license comes to an end the licensee is released from his estoppel, *Dangerfield v. Jones*, 1865, 13 L. T. N.S. 142. *Axman v. Lund* 1874, 18 Eq. 330. *Neilson v. Fothergill*, 1841, 1 W. P. C. 290; (a) The parties to a deed are estopped by its recitals, but not their partners: *Heugh v. Chamberlain*, 1877, 25 W. R. 742; *Goucher v. Clayton*, 1865, 34 L. J. Ch. 239, 13 W. R. 336. Where the license is by deed, the licensee cannot dispute the validity of the patent, and it is not enough simply to allege that the licensor knew that the invention was not new, unless distinct fraud is alleged and proved: *Smith v. Scott*, 1859, 28 L. J. C. P. 325; *Oldham v. Langmead*, 1789, 3 T. R. 439; *Cutler v. Bower*, 1848, 11 Q. B. 973, 17 L. J. Q. B. 217; *Hills v. Laming*, 1853, 23 L. J.

ante, p. 270.

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Ex. 60; *Bowman v. Taylor*, 1834, 2 A. & E. 278; *Collinge v. Bowman*, 1834, 1 W. P. C. 294; *Grover Sewing Machine Co. v. Millard*, 1862, 8 Jur. (N.S.) 714; (b) Estoppel by conduct or in pais arises where the parties so act as to render it inequitable for them to deny the existence of the facts in question. Thus even where no regular license by deed has been made and subsists, yet a licensee who has used the license is estopped from denying the licensors title, just as a tenant is prevented from disputing his landlord's title. "A man has no right to work the patent of another without enquiry for a long time under an agreement whereby he contracted to pay royalty, and then when he is called upon to pay royalty to say, 'Oh, your patent is invalid'" (*per Charles, J.*): *Wilson v. Union Oil Mills*, 1892, 9 R. P. C. 63. *Crossthaite v. Steel*, 1889, 6 R. P. C. 190. *Clark v. Adie*, 1873, L. R. 2 App. Cas. 423. *Noton v. Brooks*, 1861, 7 H. & N. 499. *Crossley v. Dixon*, 1863, 10 H. L. C. 293. *Trotman v. Wood*, 1864, 16 C. B. (N.S.) 479. *Ashworth v. Law*, 1890, 7 R. P. C. 234. *Lawes v. Purser*, 1856, 6 Ell. & Bl. 930. (c) Estoppel by record would arise in a patent case by reason of a judgment between the same parties and in respect of the same subject matter. But the estoppel would have to be precise and clear. A mere *general* finding by an arbitrator that a patent is not illegal nor void would not estop the same defendant from raising the same plea to a fresh action by the same plaintiff: *Newall v. Elliot*, 1863, 32 L. J. Ex. 120. On the other hand, consenting to an injunction in an action where he had pleaded want of utility and novelty would certainly estop a defendant on a motion to attach him for again infringing from raising the question of the validity of the patent.

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Estoppel may arise either (a) by deed, (b) by conduct, that is to say, "in pais," or else (c) by record.

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A patentee by taking out a patent does not estop himself by record from denying the validity of his own patent: *Cropper v. Smith*, 1884, 1 R. P. C. 94.

Estoppel by record must not be confused with such quasi estoppel as arises from the prior decision of a Court of competent jurisdiction upon the validity of the patent. For the decision of a superior Court upon a patent, so far as it is upon law (*e.g.*, upon the construction of a patent), will be followed till it is reversed, but so far as the decision merely depends upon evidence (*e.g.*, as to novelty or utility), it might be varied on the production of evidence of a different description in an action between different parties: *Edison v. Holland*, 1889, 6 R. P. C. 243.

A licensee against whom an action is brought for royalties is in the position of an infringer, and though he may not dispute validity, he may of course shew that what he has done is outside the patent upon its true construction: *Young v. Hernand Oil Co.*, 1891, 8 R. P. C. 293, and cases there cited. This case was reversed on appeal (9 R. P. C. 373), on the ground that the licensee's acts constituted infringement, but the principle in the text was left untouched.

post, p. 476.

3. Compulsory licenses.—By the Patents Act, 1883, s. 22, it is provided that where the patent is not worked in the United Kingdom, or the reasonable requirements of the public are not complied with, or where any person is prevented from working to the best advantage an invention of which he is possessed, the Board of Trade may compel the patentee to grant licenses on terms to be settled: see Patent Rules, 1890, 60–66, Forms H., I. No petitions under this section appear to have been prosecuted.

post, p. 495.

CHAPTER XXIV.

INFRINGEMENT.

1. **Infringement in general.**—By the form of grant scheduled to the Act of 1883 (Chap. XVII., sect. 1), it is provided that the patentee, “by himself, his agents, or licensees, and no others, may at all times hereafter during the term of years herein mentioned, *make, use, exercise, and vend* the said invention within our United Kingdom of Great Britain and Ireland, and the Isle of Man, in such manner as to him or them may seem meet, and that the said patentee *shall have and enjoy the whole profit and advantage* from time to time accruing by reason of the said invention, and . . . we do by these presents . . . strictly command all our subjects that they do not at any time during the continuance of the said term of fourteen years *either directly or indirectly make use of, or put in practice, the said invention, or in any wise imitate the same, nor make, or cause to be made, any addition thereto, or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent,*” etc.

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These words have remained practically unaltered for a very long period: compare *Walton v. Bateman*, 1842, 1 W. P. C. 616. If an invention consist of several distinct and severable parts, it is obviously not needful to constitute an infringement that the thing done should

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infringe all of them: *Gillet v. Wilby*, 1839, 9 C. & P. 336; *Cornish v. Keene*, 1835, 6 L. J. C. P. 225. In considering an infringement two questions arise, first, whether the essence of the invention has been infringed by some machine or article or process which resembles it; and, secondly, what are the acts of user complained of.

2. **The infringement must infringe the essence of the invention.**—For an infringement is not a mere resemblance in outward appearance, nor a similarity of result, but a user of the essence of the invention: *Automatic Weighing Machine Co. v. National Exhibitions Association*, 1892, 9 R. P. C. 41.

The law as to this is thus laid down in *Dudgeon v. Thompson*, 1877, L. R. 3 App. Cas. 34. "The words 'colourable imitation' are words which appear to me not very happily chosen, and calculated to create some confusion. I am quite aware that they are words which are used sometimes in the argument of patent cases, but I doubt very much whether the particular expression is one which has any great authority for its use. There is a well known manner in which the word 'colourable,' or 'colourably,' is used in patent cases. I have referred to the ordinary form in which injunctions are granted in patent cases by the Court of Chancery, and I take from Mr. Seton's book an example which appears to me to be exactly in accordance with what I recollect to be the practice of the Court in granting injunctions. It is in a case which, I think, came before my noble and learned friend as Vice-Chancellor, the case of *De la Rue v. Dickenson*. The injunction restrains the defendants, their agents, and servants, during the continuance of the patent from 'using or employing any

machines similar to the machine in the plaintiff's bill stated, or any machinery, mechanism, or mechanical contrivance made or arranged according to the plaintiff's said patent inventions, or differing therefrom only colourably, or by the substitution of mere mechanical equivalents for the same.' Now, my Lords, what I understand by that is this, that if there is a patented invention it will not save you from the punishment of the Court that you have, at the same time that you have taken the invention, dressed it up colourably, added something to it, or taken, it may be, something away from it so that of the whole of it may be said, as is said in this injunction, 'Here is a machine which is either the plaintiff's machine, or differs from it only colourably . . . ' (*per Cairns, L.C.*).

"If part of the property in the invention be really taken, then there is an infringement, however much that may be disguised or sought to be hidden" (*per Lord Blackburn*): see also *Hill v. Thompson*, 1818, 1 W. P. C. 242. "There never were two things more different to the eye than the plaintiff's invention and what the defendant had done in contravention of his patent right": *Jupe v. Pratt*, 1836, 1 W. P. C. 146. "One (the infringement) is a servile copy of the other, with that degree of non-resemblance that shall operate to cast a blind over the attempt to mislead the public": *Minter v. Wells*, 1834, 1 W. P. C. 128. "The two machines are alike in principle . . . and though the defendant may have carried it into effect by substituting one mechanical equivalent for another, still, you are to look at the substance, not the mere form" (*per Alderson, B.*): *Morgan v. Seaward*, 1836, 1 W. P. C. 171. "Variations in form or immaterial circumstances of the subject matter of a

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patent will be infringements": *Walton v. Potter*, 1841, 1 W. P. C. 586; *Plimpton v. Malcolmson*, 1875, L. R. 3 Ch. D. 531; *Plimpton v. Spiller*, 1876, L. R. 4 Ch. D. 286; *Thorn v. The Worthing Skating Rink Co.*, 1876, L. R. 6 Ch. D. 415 (n), all deal with the patent for the Plimpton skate.—The patentee, recognising that it would be necessary in a roller skate to imitate the motion of the real skates, that is to say, to cause the skate to curve outwards on the side on which the skater

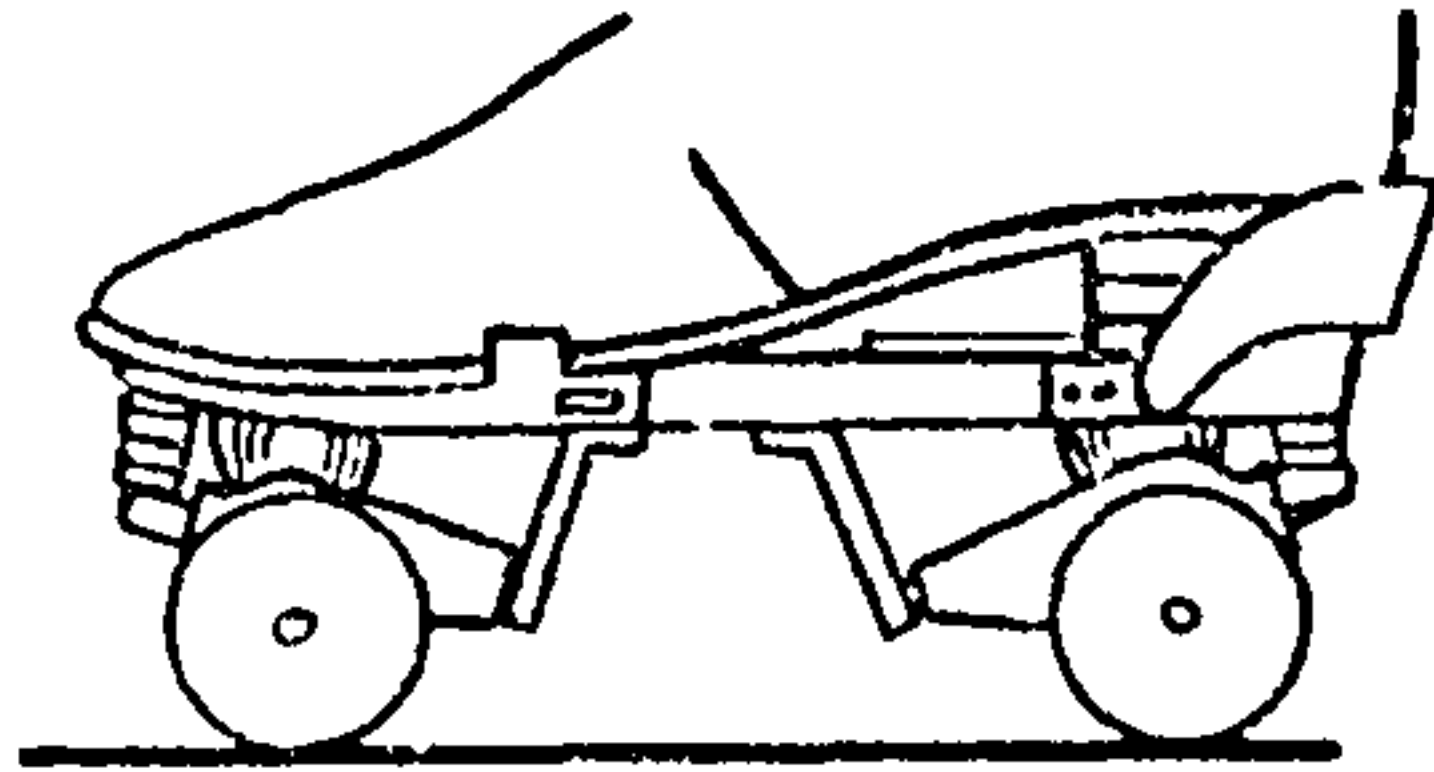


Fig. 3.

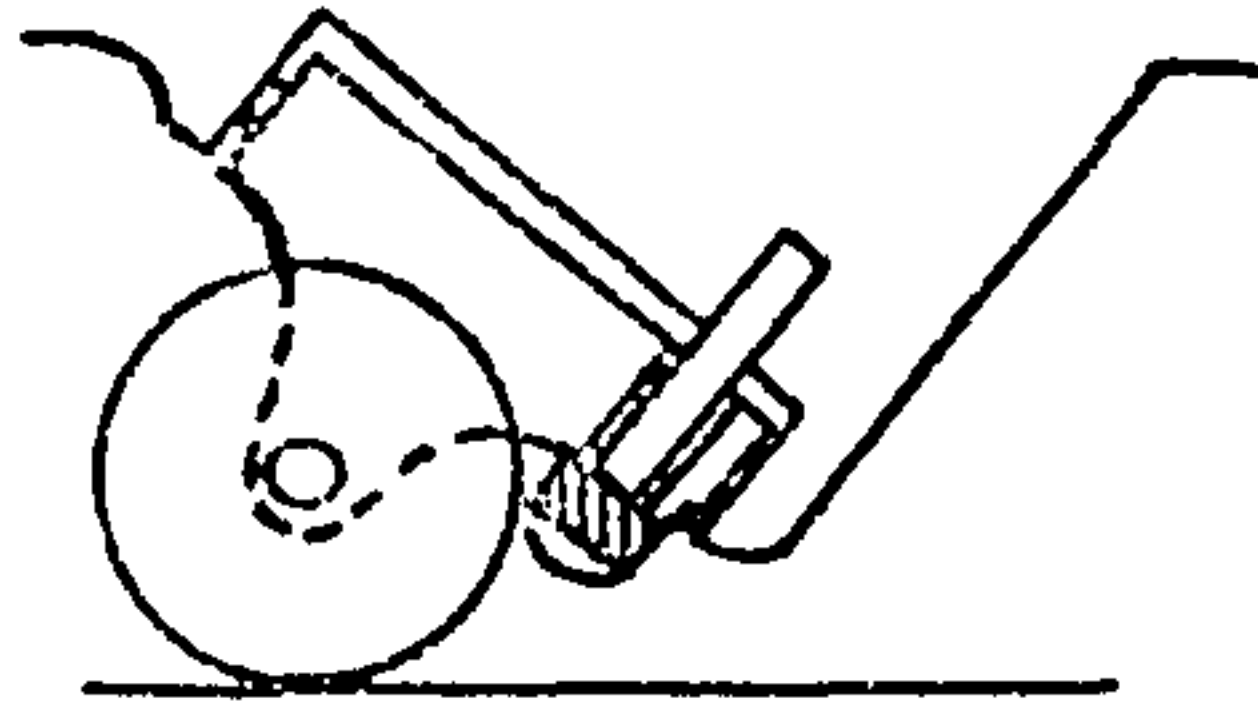


Fig. 1.

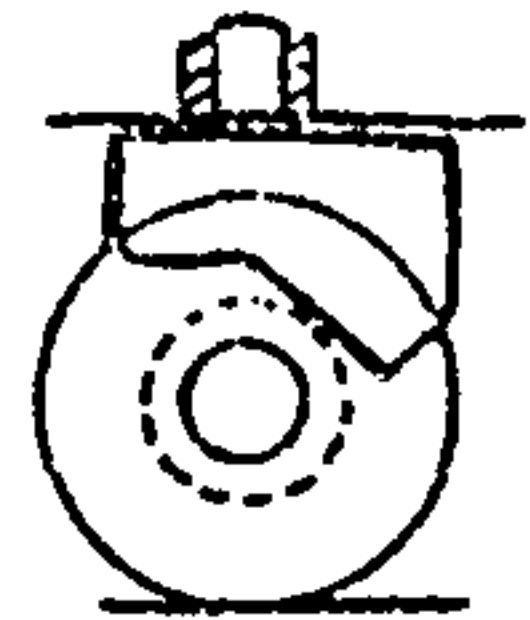


Fig. 2

leans, saw that for this purpose the wheel-axes must be caused to incline inwards, on the side on which pressure is applied. For this purpose he mounted his wheels in manner shewn in Fig. 1. The axes are horizontal, and fixed to a body which is pivoted at an inclined plane. Of course that pivoting must resist pressure, so a bolt is fixed through the body into the stand of the skate, but with an india-rubber washer beneath its head. When the skater leans on one side, the body is slightly pressed

round in its bearings, and this in turn causes the wheel-axles to become inclined to each other. Two infringements were complained of; one by Spiller, in which a spiral spring was substituted for the india-rubber pad. This of course was held to be an infringement. The other infringement was the Wilson skate. The body, which carried the wheels, was pivoted to the stand of the skate, by an elastic vertical bearing so that the axles of the wheels could become inclined. To cause them to do so, a cone, or inclined plane was fixed to each side of the skate, so as to press forward the body which carried the wheels, on that side on which the pressure was applied (Fig. 2). This was in appearance different, but was held to be an infringement, regard being had to the wide ambit of Plimpton's patent. The invention was also attacked on the ground of anticipation, for it had been previously patented in America, and a description of it then had come to England. The drawing, of which Fig. 3 is an outline, and some letterpress, which, with a figured drawing, will be found at p. 535 of the Law Reports, 3 Chancery Division (1876).

It was held that from this description no workman could have understood the invention sufficiently to carry it out, and hence this was no anticipation. And it was also held, that the drawing, having been on the shelf of a room in the Patent Office, not generally accessible to the public, had not been sufficiently published to constitute an anticipation.

Voeverk v. Evans, 1890, 7 R. P. C. 265.—This was a patent for (*inter alia*) a method of weaving curved ribbands with one edge longer than the other by the use of conical drawing-off rollers. The main features of the machinery were shewn to have been anticipated by a

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specification which, though not so drawn perhaps as to describe a workable machine, was sufficient to narrow very greatly the ambit of the plaintiff's patent. In consequence it was held that the defendant had not infringed it.

Automatic Weighing Machine Co. v. Knight, 1889, 6 R. P. C. 113; *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, 1889, 6 R. P. C. 120, 367; *Automatic Weighing Machine v. National Exhibitions Association*, 1892, 8 R. P. C. 345, 9 R. P. C. 41; *Automatic Weighing Machine Co. v. International Hygienic Society*, 1889, 6 R. P. C. 475.—This group of cases affords an example of the application of the rule under discussion.

The patent of Everitt was for a weighing machine, in which a counter-weighted lever rose when a person stood on a platform, and this indicated his weight. But that result was concealed. In order to render it visible, a penny put in a slot caused a visible arm to rotate till it came in contact with the counterweight, and thus the weight was indicated. Knight's alleged infringement was a machine so arranged that when a penny was put in a slot, it became possible for the person being weighed to draw out a handle, which, being done, the weighing mechanism came into play, and the result was visible. It was held that Everitt could not claim every mode of weighing people by means of a penny-slot arrangement, for that would be to claim a principle. Hence, therefore, the plan by which the person being weighed pulled a handle in order to operate the machine was so different from the plaintiff's as not to infringe his patent. The alleged infringement by the Combined Weighing Machine Company also operated as Knight's did, by

means of a button or handle pushed by the person being weighed, but with this difference, that whereas in Knight's machine, when the coin was put in it allowed the pushing of the knob to do the work of releasing the machinery, in the Combined Weighing Machine Company's machine when the knob was pushed in, it pressed against the coin, and the coin so pressed, then released the catch and set the machinery at work. This was held to make all the difference, and the latter machine was held to be an infringement. The test applied was whether substantially the coin did the work of releasing the catch, or whether the coin merely permitted the knob to do the work. The infringement of the National Weighing Machine Company consisted of an arrangement whereby when a penny was put into a slot, it made an electric contact, which caused an armature to revolve and carried a visible hand to the proper positions to indicate the weight. This was held an infringement, as it was clearly only a modification of Everitt's machine. The infringement by the International Hygienic Society was a machine so constructed that when a person stood on a platform he was weighed by the rotation of a counter-weighted lever, but the result was concealed until a penny was put into a slot, upon which a door was opened which enabled the result to be seen. This also was held to be an infringement. A patent directing the use of the finest copper for making an alloy for sheathing ships may be infringed by the use of an inferior copper: *Muntz v. Foster*, 1844, 2 W. P. C. 101. Patent for two iron retorts worked in connection with one another at different temperatures for two stages of the process of making sulphate of soda. Held, substantially an infringement to use a chamber of brick and an iron retort

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for the same purpose: *Gamble v. Kurts*, 1846, 3 C. B. 435. A patent for mixing two chemical substances and boiling them to produce a certain result may be infringed by mixing them in the presence of a third without boiling: *Simpson v. Holliday*, 1864, 20 Newton's Lond. Journal (N.S.) 111. A patent for prismatic reflecting pavement lights which were shewn made with prisms with plane surfaces. Held, infringed by the use of prisms with curved surfaces: *Hayward v. Pavement Light Co.*, 1884, 1 R. P. C. 207. The Edison telephonic speech transmitter consisted of a diaphragm in contact with a "tension-regulator," or piece of substance kept in contact with it either by its own resilience or by a spring. When vibrated by the voice the combination offered a tremulous varying resistance to an electric current passing through it, and thus transmitted speech. Defendant used a diaphragm of carbonised leather and a ball of carbon held on by a spring. Held, an infringement: *United Telephone Co. v. St. George*, 1886, 3 R. P. C. 321. A patent for an organette consisted of a circular perforated disc rotated over a fixed wind-chest so as to actuate levers and open and close organ-pipes, and thus play tunes. An organette in which the wind-chest rotated and the disc was fixed, was held an infringement, and though it might be an improvement, this made no difference: *Erhlich v. Ihlee*, 1888, 5 R. P. C. 453; see also *Stead v. Anderson*, 1847, 2 W. P. C. 155; *Pennycook v. Mackenzie*, 1882, 19 Scottish Law Reports 353; *Cochrane v. Braithwaite*, 1830, 3 Lond. Jour. C. S. 42; *Kaye v. Chubb*, 1888, 5 R. P. C. 651. In *Laine v. Herold*, 1892, 9 R. P. C. 447, it was held, that a patent for a beetle poison was infringed by the use of the same ingredients with immaterial alterations.

3. The ambit of an invention.—From the above-mentioned rule it follows that every invention has an area or “ambit,” or, as it might be termed, certain “limits of deviation,” within which the patentee will be protected. And in every patent case the real difficulty is to determine what these limits are. The fixing of these limits depends on the language of the specification, but always with regard to the state of knowledge at the time. In the case of a very new and original invention which strikes out a fresh path in discovery these limits would be widely construed, whereas, if the invention is not of a novel character, the limits will be narrow. For instance, the Court would be much more liberal in construing a patent for the first invention of the telephone than it would be in construing a patent for some special sort of telephone at the present day. “Where the thing is wholly novel, and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machines for effecting the same purpose. . . . When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before has the right to extend very largely the interpretation of those means which he has adopted for carrying it into effect” (*per* Wood, V.-C.): *Curtis v. Platt*, 1863, L. R. 3 Ch. D. 136 n.; commented upon in *Thompson v. Moore*, 1889, 6 R. P. C. 426; see *Procter & Bennis*, 1887, 36 Ch. D. 756, 4 R. P. C. 333; and *Couchman v. Greener*, 1884, 1 R. P. C. 200, where weight is given by Lord Blackburn to the fact that the common object of the

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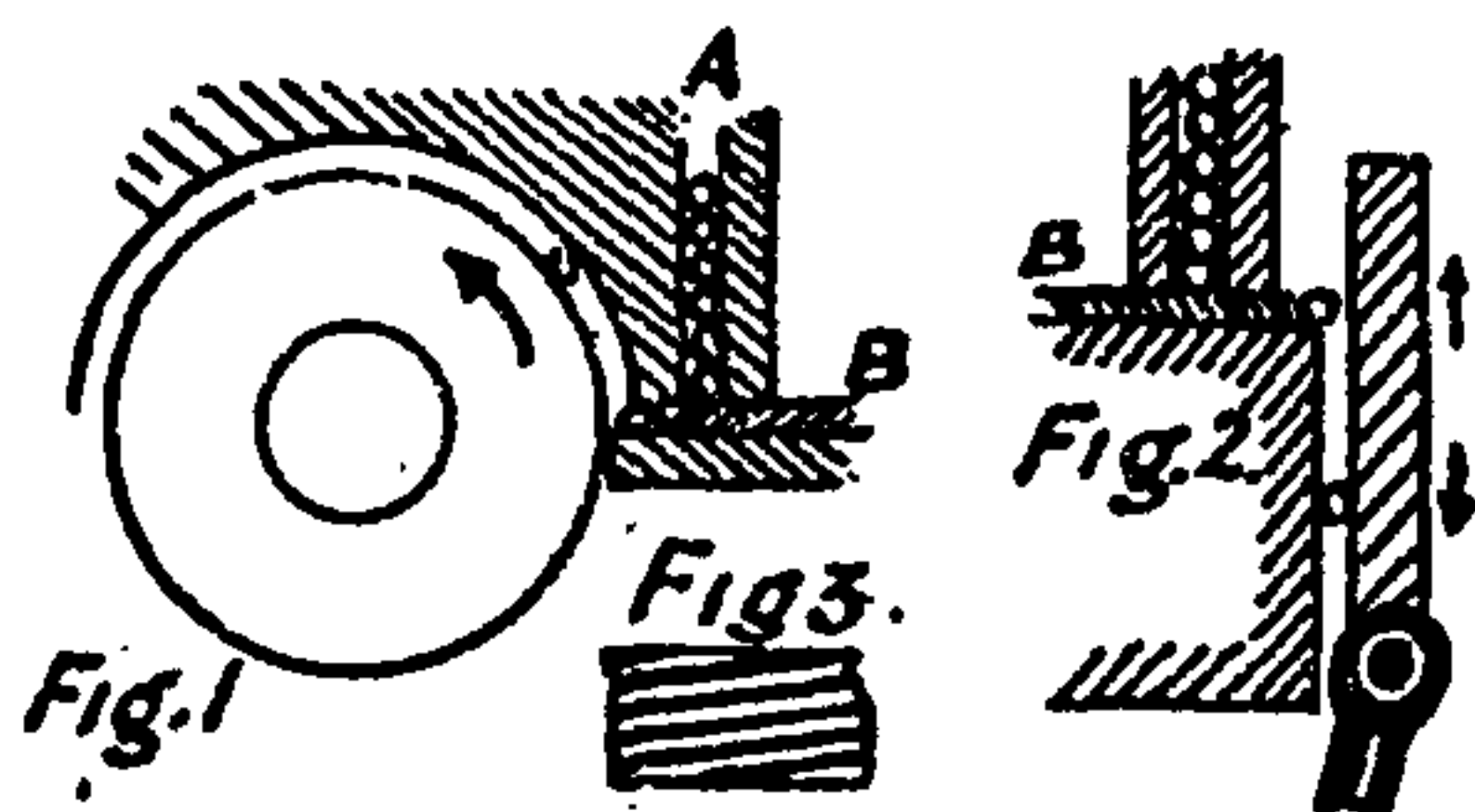
ante, p. 34.

plaintiff and defendant had been known before. In *Gosnell v. Bishop*, 1888, 5 R. P. C. 159, Bowen, L.J., says: "What is the law laid down in *Curtis v. Platt*? Precisely what the Lord Justice has said, that where you get a specific mechanism directed to a certain end which was previously well known directed to facilitate a certain result the benefit of which had been previously discovered, then in a patent of that description the doctrine of mechanical equivalents is not applicable, and that any other person is entitled to the use of old and known principles provided he does not take substantially the means in which the excellence of the patent alone consists": see also the same principles applied in *Hocking v. Hocking*, 1889, 6 R. P. C. 76, by the Lord Chancellor; *Bovill v. Pinn*, 1856, 11 Ex. 739; *Seez v. Higgins*, 1860, 8 H. L. C. 551; *per* Lindley, L.J., in *Jahncke v. Bell*, 1892, 9 R. P. C. at p. 100; *Nettlefold v. Reynolds*, 1892, 9 R. P. C. 270; where the doctrine of mechanical equivalents was held not to apply, because the ambit was so narrow; see also *Miller v. Clyde Bridge Street Steel Co.*, 1892, 9 R. P. C. 470.

Nettlefolds v. Reynolds, 1891, 8 R. P. C. 410. This was a patent for making carpenter's wood screw. Screws used formerly either to be cut out of the solid or else squeezed into shape by screwing them into screw-plates, which latter operation lengthened them. Gradually, however, the idea grew up that they might be made by rolling wire between grooved rollers. This does not appear to have been a success until the patent of Nettlefold in 1884. According to this invention, the wires which are to be made into screws fall down a trough A. When they arrive at the bottom they are pushed forward by a metal finger B., so as to be caught

between the outside of a revolving cylinder and a concentric circular recess (Fig. 1.) These are fluted on the inside in an ingenious manner (Fig. 3) so as to roll a thread on the screw, which falls out at the other side. But owing to previous inventions, this patent was held to have a very narrow ambit. The infringement complained of is shewn in Fig. 2, and consisted in the substitution of two flat dies for the curved ones of the plaintiffs. If the invention of the plaintiffs had been the first of its kind, there can be no doubt that the machine of the defendant would have been held to infringe it, but prior discovery had so narrowed it, that it was held good only for the particular arrangement of circular dies shewn in it, and the defendant's machine was held not to be an infringement.

Bailey v. Roberton,
1878, 3 App. Cas. 1055.



The plaintiff in his provisional specification described his invention as a means of preserving meat by coating it with a liquid made of certain proportions of bisulphite of lime, gelatine, and water. But in the complete specification he described the preparation of four liquids, viz:—No. 1, A certain solution of bisulphite of lime. No. 2, A mixture of No. 1 with gelatine in certain proportions. Nos. 3 and 4, a mixture of No. 1, with salt in two different defined proportions. The modes of using No. 2, 3, and 4 were described, but no mode of using No. 1 was given, except for cleansing vessels or mixing to form Nos. 2, 3, and 4. The claims were for the use of Nos. 1, 2, 3, and 4 for preserving animal substances, and a

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disclaimer of the use of No. 1, except for preserving animal substances, or in connection with salt or gelatine. The use No. 1 for cleansing vessels was also disclaimed. The infringement complained of, was the use of No. 1 solution alone for preserving meat. It was proved that the use of bisulphite of lime for preserving meat was old at the date of the patent.

The Court considered that the patent was bad. (1) For want of novelty in having claimed the use of No. 1, for preserving meat, which was old. (2) For want of sufficient description how to use No. 1. (3) For disconformity in not having described the use of No. 1 alone in the provisional; and further, that if the patent could be read as not claiming No. 1 for preserving meat (which would be the only way to save it) then there had been no infringement.

It is impossible to construe a patent, either for the purpose of determining whether it has been infringed or anticipated, without considering the specification, in the light of the knowledge at the time. Some patents will require much of this evidence to throw light upon them; some are so sharply defined and narrow as to enable it almost to be dispensed with; in most cases it is useful, if not indispensable. A patent with a very wide ambit is called a master-patent.

4. Infringement by the substitution of mechanical or chemical equivalents.—In the sections dealing with the necessity that the “essence” of the invention should have been infringed, and that in order to determine this essence the ambit must be determined in the light of the state of knowledge at the time the specification was sent in, examples were given of the mode in which

infringements have been considered: Chap. XXIV., sects. 2, 3. Some examples in which infringements have been considered to have been committed by the use of mere mechanical or chemical equivalents may be added, always, however, remembering that in order to be able to use these cases the ambit of the invention must be moderately wide: see cases cited in last section. "If you believe that the defendant's instrument, though he might have employed skill and knowledge upon it, was taken by him substantially from the plaintiff's, and that what he has produced is nothing more than a substitution of other and equivalent means for producing the same end, even though the means employed might be better than those of the plaintiff's, it is an infringement. . . . If it were permitted to persons of ingenuity to substitute, in lieu of the patent, some equivalent, it would be useless to grant patents of this kind, for an ingenious man could at any time infringe them by adopting other and possibly better means than those specified" (*per* Martin, B.): *Bateman v. Gray*, 1855, M. P. C. 102. "The next thing is to see what really has been done. In one sense what has been done is undoubtedly a mechanical equivalent, but whether it is a mechanical equivalent in the sense in which that expression is used in patent law is, of course, the question I have to decide" (*per* Jessel, M.R.): *Thorn v. Worthing Skating Rink Co.*, L. R. 6 Ch. D. 415 n.; *Saxby v. Clunes*, 1874, 43 L. J. Ex. 228. "The question, What is an equivalent? depends on the state of knowledge at the time; "and chemical equivalents are by no means so obvious as mechanical equivalents": *Stevens v. Keating*, 1847, 2 W. P. C. 188. A patent had been granted for using carburet of manganese for the manufacture of steel. The

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defendant mixed oxide of manganese and tar in the crucible to effect the same purpose. It was proved that this would really produce carburet of manganese, but it was not shewn that at the time the patent was taken out it was known that the mixture would be a chemical equivalent for carburet of manganese. The defendant's method was cheaper. Held, that it was not an infringement (*per* Lord Cranworth): *Heath v. Unwin*, 1850, 2 W. P. C. 319. On the other hand, a patent for improving caoutchouc by heating it with sulphur was held to be infringed by the process of heating it with hyposulphate of lead and artificial sulphuret of lead: *Hancock v. Moulton*, 1852, John. Pat. Man., 3rd ed., 208. In *Barrett v. Vernon*, 1877, 35 L. T. (N.S.) 755, the plaintiff had obtained a patent for stopping soda-water bottles by means of a plug of heavy wood. The defendant substituted a plug of light wood, but temporarily applied a weight to it to effect the stopping. Held, an infringement. In a door lock, the substitution of a V-spring acting on a lever for a spiral spring is merely a colourable variation: *Kaye v. Chubb*, 1888, 5 R. P. C. 651. In *Johnson v. Rylands*, 1873, Griff. 138, the patent was for an arrangement for testing wire and expanding it by rolling it off one drum on to another moving at a greater surface speed. The defendant rolled it on to one drum from another which was retarded by a clip, and thus it was strained and expanded. Held, no infringement: see *Winby v. Manchester Steam Tramways Co.*, 1889, 6 R. P. C. 365; *R. v. Lister*, 1826, 1 W. P. C. 80; in which the heating of rollers for a certain purpose with hot irons was held an infringement of a patent for heating them for the same purpose with steam: *Hills v. Liverpool Gas Light Co.*, 1862, 32 L. J. Ch. 28,

7 L. T. (N.S.) 537; see also *Peckover v. Rowland*, 1893, 10 R. P. C. 234. CHAP. XXIV.
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5. **Infringement of a combination.**—As the essence of a combination patent is the union of its parts, and not the parts themselves (Chap. I., sect. 8, Chap. VIII., sect. 5), it follows that an infringement must be, not of the individual parts, but of the combination. But a patent is infringed when its essence is infringed, although each particular part may not have been taken: Chap. XXIV., sect. 2. Applying this doctrine to patents for combinations, it follows that a combination may be infringed by a machine which, though it substantially consists of the combination, does not take every part of it. In fact, one combination may be a colourable imitation of the other. This was decided in *Lister v. Leather*, 1858, 8 Ell. & B. 1031. But the case was subsequently misunderstood, as if it meant that unless all the parts of the combination were taken there could not be an infringement. That view, however, was corrected in three cases in which the whole law of infringement of combinations is to be found: *Clarke v. Adie*, 1873, L. R. 2 App. Cas. 315. “One mode of infringement would be a very simple and clear one. The infringer would take the whole instrument from beginning to end, and would produce a clipper made in every respect like the clipper described in the specification. About an infringement of that kind no question could arise. The second mode would be one which might occasion more difficulty. The infringer might not take the whole of the instrument here described, but he might take a certain number of parts of the instrument he had described. He might make an instrument which in many respects might

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resemble the patent instrument, but would not resemble it in all its parts, and then the question would be, either for a judge, or for any tribunal which was judging of the facts of the case, whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented, and whether in what he had done he had not really taken and adopted the substance of the instrument patented. But there is a third way in which it is possible to conceive an infringement of a patent of the kind to which I have referred. Inside the whole invention there may be that which is a minor invention, and which does not extend to the whole, but forms only a subordinate part or integer of the whole. Now again, that subordinate integer may be a step or a number of steps in the whole, which is, or are, perfectly new, or the subordinate integer may not consist of new steps, but may consist of a certain number of steps so arranged as to form a novel combination within the meaning which is attached by the patent law to the term combination. Suppose that in a patent you have a patentee claiming protection for an invention consisting of parts which I will designate as A, B, C, and D. He may at the same time claim that as to one of those parts, D, it is itself a new thing, and that as to another of those parts, C, it is itself a combination of things which were possibly old in themselves, but which, put together and used as he puts together and uses them, produce a result so new that he is entitled to protection for it as a new invention. In a patent of that kind the monopoly would or might be held to be granted, not only to the whole and complete thing described, but to those subordinate integers entering into the whole, which I have described. But then the invention must be described in that way, it

must be made plain to ordinary apprehension upon the ordinary rules of construction that the patentee has had in his mind, and has intended to claim protection for, those subordinate integers, and, moreover, he is, as was said by the Lords Justices, at the peril of justifying those subordinate integers as themselves matters which ought properly to form the subject of a patent of invention" (*per* Lord Cairns).

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Harrison v. Anderston Foundry Co., 1876, 1 App. Cas. 593. —“The case of *Lister v. Leather* has been cited and commented upon as an authority for the proposition that a patent for a combination covers and protects all subordinate combinations or parts, or at least such of them as are new and material. It is plain, however, that the case did not go this length . . . it decided nothing more than this, that though the patent is for a combination, it does not follow that there can be no infringement of it unless every part of that combination without exception is pirated. What the Court said was, that the taking of a subordinate part or parts of the combination *might* be, not that it necessarily would be, an infringement of the patent; and that whether it would be so or not depended, as the Court of Error said, upon what the parts taken were, how they contributed to the object of the invention, and what relation they bore to each other. This only amounts to saying that on a question of infringement the essential nature of the invention will be regarded” (*per* Lord Penzance); and in *Nordenfelt v. Gardner*, 1884, 1 R. P. C. 10, 61, Lord Esher, M.R., says: “Some stress was laid by some of the counsel, not by all, I think, upon the words ‘the general construction.’ I take it that the general construction there means the whole of the construction. The arrangement, that is, the

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whole of the arrangement, and mode of using the feeding apparatus, that is, the general construction of the combination, or the construction of the whole combination. The general arrangement, that is, the whole arrangement, and the mode of using what?—the feeding apparatus. That seems to me to claim the feeding apparatus as a combination, and to claim the combination, and the combination alone. If that be so, how can such a combination be infringed? The machine which is challenged may have that combination actually, without any variance at all. If so, it is obvious that the challenged machine is an infringement. Or it may have that combination with some alteration. The alteration of a combination, as it seems to me, may be by addition, or subtraction, or substitution of parts. Any one of those alters the combination. If the alteration, whether it be by addition, or subtraction, or substitution, be merely colourable, then the two machines are substantially the same; although not mathematically exactly the same, they are substantially the same, and in any case, notwithstanding such colourable alteration, there may be an infringement. An alteration by addition may be an improvement, but then that will leave the whole of the original combination, and add something to it. If such an alteration of the combination be made, it seems to me that no good patent can be made with regard to the new machine except by claiming the invention as an improvement, and by shewing distinctly what the addition is so as to shew what the improvement is. An alteration by subtraction, if it were more than a colourable subtraction, would, as it seems to me, alter the combination. It would not be a combination of the same things. It would be a combination of different

things; and if the combination were altered by a material subtraction, I should think that it was a new combination. But an alteration by substitution, that is, by substitution of one of the material elements of the original combination, must, to my mind, be a new combination. The second combination, then, is a combination of different things from the first; there is the taking away of one of the elements, and a material element, of the old combination, and a putting in of a new material element, which is different from any of the elements of the former. Somebody tried to express these things by A, B, and C. But if the original combination is of A, B, C, and you take away C, and make a combination of A, B, and D, it seems to me as clear as possible that the new combination is a different combination from the old."

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ante, p. 306.

From these cases it is clear that an infringement of a combination may be committed by any substantial union of the essential parts composing it, whether or no anything is added, or anything immaterial be substituted, and that the question is one of fact in each case; but that as the essence of a combination patent is not the parts, but the combination, it must be the combination which is infringed, not the parts composing it: *Proctor v. Bennis*, 1886, 36 Ch. D. 740; *Parkes v. Stevens*, 1869, L. R. 8 Eq. 358; *Sellers v. Dickinson*, 1850, 5 Ex. 324, *Hill v. Thompson*, 1818, 8 Taunt. 391, 2 B. Moo. 448, 1 W. P. C. 242; *Flower v. Lloyd*, 1877, 6 Ch. D. 297, 10 Ch. D. 327. The following cases also may be referred to as examples of these principles.

Wenham Gas Co. v. May, 1887, 4 R. P. C. 303.—
Patent for a combination and arrangement of a gas lamp consisting (*inter alia*) of two gauze coverings to moderate

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and equalize the air. Held, that a substantially similar lamp with but one gauze covering was an infringement. Kekewich, J., after citing *Clarke v. Adie*, 1875, L. R. 2 App. Cas. 335, said: "One must ascertain whether the differences really go to the essence of the patent article."

Thompson v. Moore, 1889, 6 R. P. C. 426.—A patent for a compass-card, consisting of a large but very light rim of aluminium and card attached by silk threads to a group of very small needles. The object was to get a slow swing and yet with a small inertia, and a small magnetic moment. The defendants made a very similar compass-card, but with differently arranged needles, and aluminium wire was used instead of the silk thread. Held, by the Master of the Rolls, that as plaintiff's invention was only a new means of obtaining an old result, it must be strictly construed on the principles of *Curtis v. Platt*. But on appeal this judgment was reversed, on the ground that the results obtained by the plaintiff's invention were new, and that the essence of the combination had been infringed. This case is important as limiting and explaining the scope of *Curtis v. Platt*.

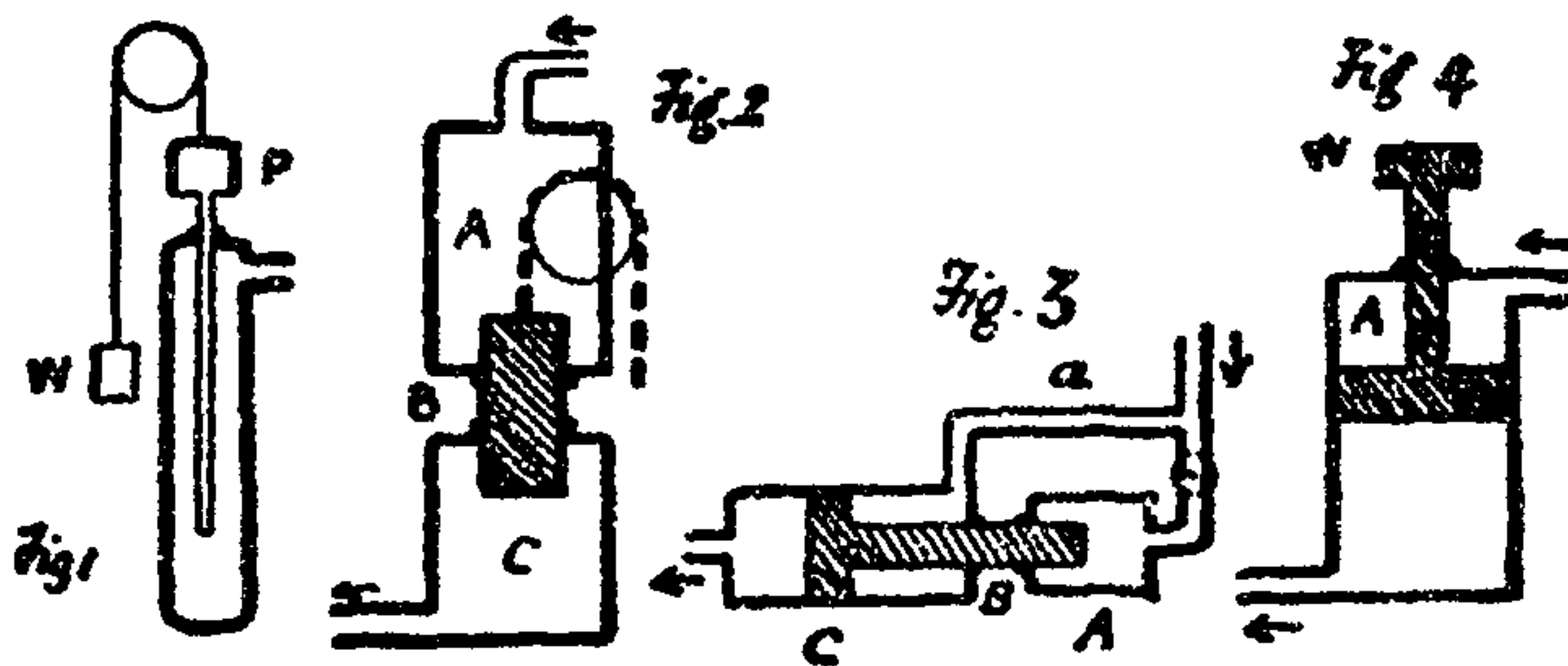
For infringements of combinations see also the following cases: *Smith v. London & N. W. Rail. Co.*, 1853, 2 Ell. & B. 76; *Bovill v. Keyworth*, 1857, 7 Ell. & B., 725; *De la Rue v. Dickenson*, 1857, 7 Ell. and B. 738, 3 Jur. (N.S.) 841; *Finlay v. Allen*, 1857, 19 Dec. C. Sess. 2nd Series, 1,087; *Patent Bottle Envelope Co. v. Seymer*, 1858, 5 C. B. (N.S.) 164; 28 L. J. C. P. 22; *Thomas v. Foxwell*, 1858, 5 Jur. (N.S.) 39; *Lister v. Eastwood*, 1864, 9 L. T. (N.S.) 766; *Bovill v. Crate*, 1867, 5 Griff. App. 46; *Bovill v. Smith*, 1867, Griff. App. 49; *White v. Fenn*, 1867, 15 W. R. 348, 15 L. T. (N.S.) 505; *Tatham v. Dania*,

1869, Griff. 213; *Saxby v. Clunes*, 1874, 43 L. J. Ex. 228; *Flower v. Lloyd*, 1877, W. N. 1877, 71, 132; Johnson's Pat. Man., 4th ed., 245; *Henderson v. Clippens Oil Co.*, 1883, 20 Scott, Law Rep. 423; *Lawrence v. Perry*, 1885, 2 R. P. C. 184; *United Telephone Co. v. Nelson*, 1887, W. N. 1887, 193; *Ellington v. Clark*, 1888, 5 R. P. C. 319; *Garrard v. Edge*, 1889, 6 R. P. C. 372, 563, 44 Ch. D. 224; *Mason v. Goodwin*, 1889, 6 R. P. C. 235; *Boyd v. Horrocks*, 1892, 9 R. P. C. 77; *Peckover v. Rowland & Co.*, 1893, 10 R. P. C. 118.

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Ellington v. Clarke, 1888, 5 R. P. C. 135, 319.—The



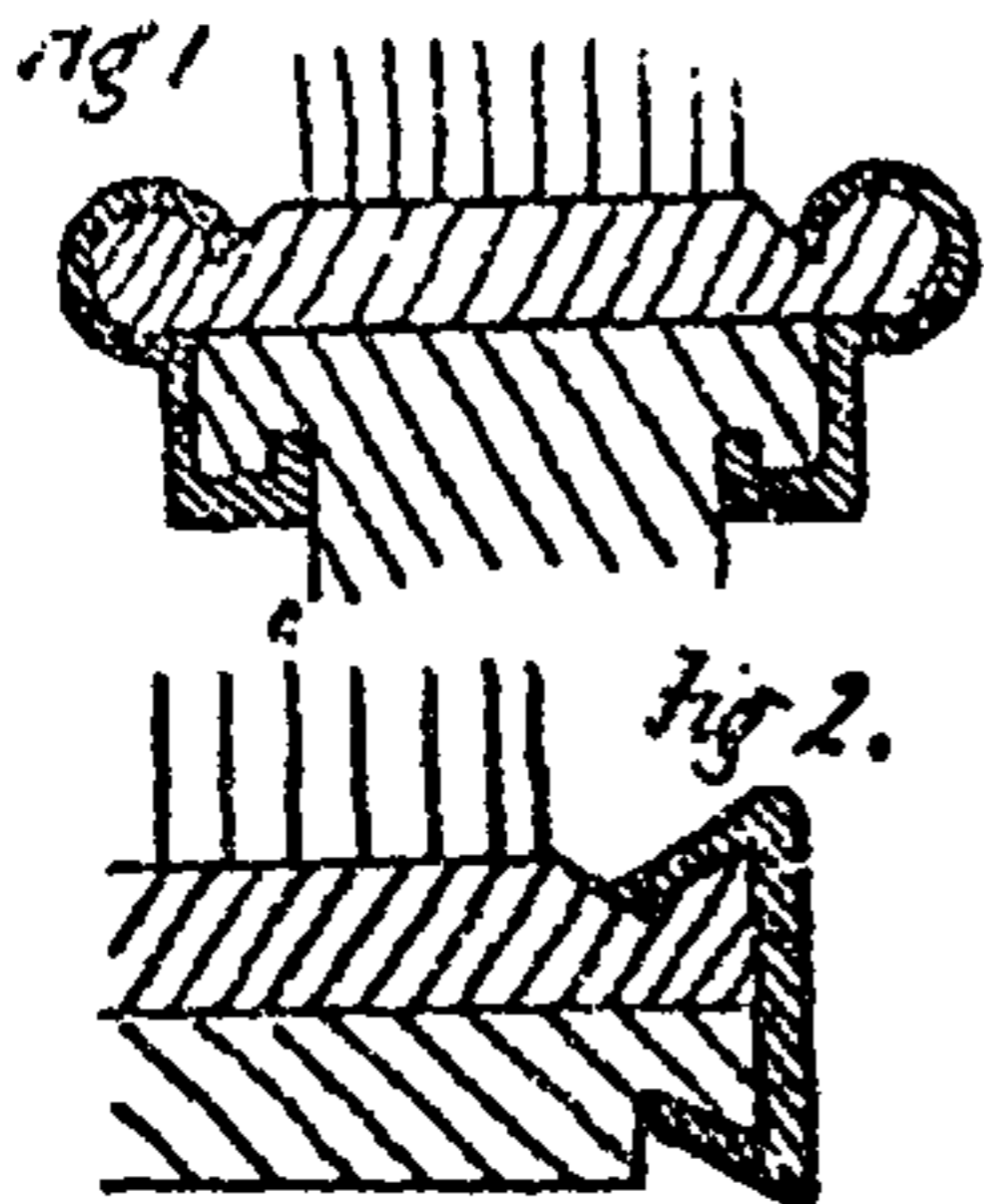
patent was for improvements in hydraulic lifts. The old form of hydraulic lift is shewn in Fig. 1. The cage (P) is raised by the pressure of water acting on a long piston working in a water-tight collar. The cage is balanced by a weight (W). A great deal of water is wasted upon each ascent. To remedy this, as also to get rid of the chain and weight, which are sometimes dangerous, Berly devised the form shewn in Fig. 2. The water is admitted to the chamber (A) and drives down the piston (B), which in its turn drives the water out of the cylinder (C) into the cylinder of the lift. B is counterweighted by a chain consisting of heavy weights linked together, and passing over a pulley; so that as it descends the

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weight pressing on it increases. Ellington's invention is shewn in Fig. 3. The cylinder (A) was made smaller and placed horizontal, so as to work with high pressure; but this was not specifically claimed, and the weight, pressing B downwards, was replaced by a water-tube (a) connected into the cylinder (c), which pressed on the back of the piston (B). The infringement complained of was made according to Andrews' patent. Fig. 4.—Here both cylinders are amalgamated. The arrangement is such that the upper cylinder (A) is really the smaller, as the water only acts on an annular surface. The weight on B is put at w; so that this machine is midway between 2 and 3. It was held that the weight (w) was really only a mechanical equivalent for the tube (A) in Fig. 3, but on appeal this was reversed on the ground that defendant's machine was essentially the same as Fig. 2.

In the case of *Tweedale v. Ashworth*, 1892, 9 R. P. C. 121, the plaintiff had invented a new mode of attaching the cards on to the flats of carding engines. The cards consist of "foundations" of some elastic substance in



which the carding-pins are fixed; and the foundation was fixed on to the flat by bent strips of metal, as shewn in section in Fig. 1. These metals gripped hold of the sides of the foundation, and the width of the card being rather smaller than that of the flat on which it was placed, the strips

stretched the card into its place. The defendant's method (complained of as an infringement) is shewn on Fig. 2. There is no gripping action of the metal clips, only a wedging or squeezing of the foundation

against the flat, and the foundation has to be stretched by a special machine. The case was carried to the House of Lords, where it was decided that the method of gripping flexible substances with metal strips was old; hence the patent could only be for a particular application of that method carried out in a particular way, and they considered that the defendant had not infringed it.

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6. A patent is not infringed by the use of the same means for a different purpose.—Thus, where a patent had been granted for treating sewage-water chemically by means of hydrate of lime in order to make manure, it happened that this process also purified water, but this purpose was not claimed in the patent. The defendants used the process for purifying water, and did not sell or use any of the precipitated manure so obtained. Held, no infringement: *Higgs v. Goodwin*, 1858, E. B. & E., 529, 27 L. J. Q. B. 421; compare *semble* by Parke, B., in *Morewood v. Tupper*, 1855, 3 C. L. R. 718; *Lister v. Eastwood*, 1864, 9 L. T. (N.S.) 766.

In *Fletcher v. The Glasgow Gas Commissioners*, a piece of metal attached to the latch of an oven to prevent the door flying open was held not to infringe a patent comprising a similar arrangement for keeping an oven door open to admit the air: 1887, 4 R. P. C. 389. On the other hand, if the different purpose for which the infringement was used were simply in addition to the purpose disclosed in the patent, there would be infringement: *Cannington v. Nuttall*, 1871, L. R. 5 H. L. 205; *Edison v. Holland*, 1888, 5 R. P. C. 482.

7. It is no answer to an allegation of infringement for the defendant to say that the means used

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It is no answer to an allegation of infringement for the defendant to say that the means used are an improvement on the original patent.

are an improvement on the original patent, for, as has been seen (Chap. I., sect. 5), a patent may be granted for an improvement on a previous patent, but the use of the second may be an infringement of the first: *Neilson v. Harford*, 1841, 1 W. P. C. 310; *per Parke, B., Russell v. Lednam*, 1843, 14 M. & W. 578; *Needham v. Johnson*, 1884, 1 R. P. C. 53.

8. Coextension of anticipations and infringements.—A test sometimes applied to decide whether a thing is an infringement is to ask whether it would have been sufficient as an anticipation to invalidate the patent. In *Davis v. Feldtman*, 1884, 1 R. P. C. 13, 193, the plaintiff had patented an improvement in umbrellas. It was found that, so far as the defendant had infringed, he had only used an old contrivance: *per Fry, L.J.*: “I think the plaintiff is in a dilemma. If his second claim covers the defendant’s user, then he has been anticipated by Weeks.” The Court, however, held there had been no infringement; see also *Downes v. Falcon Engine Works*, 1886, 3 R. P. C. 70, 2 R. P. C. 197. In *Young v. Rosenthal*, 1884, 1 R. P. C. 29, the patentee had been anticipated by the use of curved instead of straight lines for corsets. Held, that he was in a similar dilemma with regard to an infringement in which such curved lines were used.

In applying this principle, some care must be exercised. For the above rule assumes that at the supposed time of the hypothetical prior invention public knowledge is in the same condition as it is at the time of the infringement. For instance, take the case of an inventor who has tried a certain process imperfectly and abandoned it owing to a mistaken notion that it

would not work, and that his experiments and results are published and known. A subsequent experimenter tries it again, shews that it can be made a success, and patents it. No doubt this patent would be good (Chap. V., sect. 7). And yet, suppose the patent had been taken out before the operations of the first inventor? Those very operations of the first inventor would no doubt have been infringements, although, as has been said, they would not have been sufficient anticipations to have invalidated the patent; so that here you have a case in which infringement is not tested by seeing whether or no it would have been an anticipation. The explanation is, that the first process prior to the invention was conducted blindly, in the dark, whereas the very same process conducted subsequently to the invention would be in the light of the knowledge which the invention has conferred. This, it is submitted, is the true meaning of *Caldwell v. Van Vlissingen*, 1851, 9 Hare, 421, and *Murray v. Clayton*, 1872, L. R. 7 Ch. 585, where it was held, that "a clumsy imitation of a patented machine or a patented article may be an infringement, although it is not such as would have been an anticipation defeating an inventor's right to a patent: see also *Daw v. Eley*, 1865, L. R. 3 Eq. 501 n.; *Newton v. Grand Junction Rail. Co.*, 1846, 5 Ex. 334.

9. Time when an infringement may be committed.—An infringement may be committed after the publication of the complete specification and during the life of the patent (Patents Act, 1883, s. 13). Extensions are now dated the day after they are granted, but if an interval occurred between the expiration of a patent and its extension, no act done in the interval could constitute

CHAP. XXIV.
SECT. 8.

Coextension
of anticipa-
tions and in-
fringements.

post, p. 447.

CHAP. XXIV.
SECT. 9.

Time when an
infringement
may be
committed.

an infringement: *Russell v. Ledsam*, 1845, 14 M. & W. 574, 16 M. & W. 641, 1 H. L. C. 687.

10. **The intention to infringe is not material.**—The question of infringement does not depend upon the intention of the infringing party. The view that intention is material was at one time held: *Heath v. Unwin*, 1845, 2 W. P. C. 227; but in the same case, at p. 300, it was negatived, and in *Stead v. Anderson*, 1847, 2 W. P. C. 156, the Court says: "We think it clear that the action is maintainable in respect of what the defendant does, not what he intends": *Wright v. Hitchcock*, 1870, 39 L. J. Ex. 103; *McCormick v. Gray*, 1861, 31 L. J. Ex. 48, 7 H. & N. 25; *Newall v. Elliot*, 1864, 10 Jur. (N.S.) 954, 13 W. R. 11; *Curtis v. Platt*, 1863, 11 L. T. (N.S.) 245. Nor is it necessary that the defendant should have known that the invention he infringes was the subject of a patent at all: *Walton v. Lavater*, 29 L. J. C. P. 279; *Nobel's Explosives v. Jones*, 1880, L. R. 17 Ch. D. 721; *Young v. Rosenthal*, 1884, 1 R. P. C. 39; *Davenport v. Rylands*, 1865, L. R. 1 Eq. 303; *Wright v. Hitchcock*, 1870, 39 L. J. Ex. 103; *Wittman v. Oppenheim*, 1884, 27 Ch. D. 260; *Geary v. Norton*, 1846, 1 De. G. & S. 9; *Plimpton v. Spiller*, 1876, L. R. 4 Ch. D. 286. Innocence of intention may, however, have a great effect upon costs: *post*, p. 408. Chap. XXVIII., sect. 39.

11. **In order to constitute an infringement, the act complained of must be one calculated to injure the trade profits of the patentee.**—Having regard to the words "*the whole profit and advantage of the invention*," and remembering that the object of patent law is not to reward scientific discovery, but to encourage trade, it

follows that in general only those acts will be treated as infringements which are held either directly or indirectly to injure the trade of the patentee.

And therefore, merely to use a patented invention for experiment will not be an infringement. And perhaps even to use a patent in a private way for self-instruction, not for profit or for business purposes, would not be an infringement, though that is more doubtful. But to make use or sell an object made according to the invention for the purposes of profit will be an infringement, and to buy an article made according to the patent would also be an infringement. The true test in every case will be whether the acts complained of are calculated substantially to interfere with the profits of the patentee.

CHAP. XXIV.
SECT. 11.

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In order to constitute an infringement, the act complained of must be one calculated to injure the trade profits of the patentee.

post, p. 320.

12. Infringement by manufacture.—It is an infringement to make a patented article with a view directly or indirectly to obtain profit therefrom. But inasmuch as the very nature of the power of the Crown to grant monopolies depends on its position as protector of *trade*, it follows that merely to make a thing is no infringement unless in some way the trade in the thing is affected. Thus, Patterson, J., considered that to “make a thing merely for amusement or as a model was not an infringement: *Jones v. Pearce*, 1832, 1 W. P. C. 125. But it is submitted that it would not be permissible to make a patented invention for private amusement unless for the purposes of experiment or of improving it, and if the article has been made for profit and is a piracy, the buyer would no doubt be liable as well as the seller, even though the buyer had merely purchased it for amusement, and not to make any profit by means of it (*per Kay, J.*): *United Telephone Co. v. Sharples*, 1885, L. R. 29 Ch. D. 164.

CHAP. XXIV.
SECT. 13.

Experimental
user.

13. Experimental user.—Mere experimental user will not infringe a patent provided no pecuniary benefit is obtained thereby. “If a man makes things merely by way of *bonâ fide* experiment, and not with the intention of selling and making use of the things so made for the purpose of which a patent has been granted, but with the view of improving upon the invention the subject of the patent, or with a view of seeing whether an improvement can be made or not, that is not an invasion of the exclusive rights granted by the patent. Patent rights were never granted to prevent persons of ingenuity exercising their talents in a fair way. . . . But when you see a man using a machine as this defendant has done, under a claim of a right to use it, and under that claim of right he makes a quantity of goods, even though a small quantity, I cannot call that an experiment within the meaning of the rule as to experiments. He has made a machine, and knowing it to be an infringement of a patent, he claims a right to make and use it, and his experiment is made to see how his machine works” (*per* Jessel, M.R.): *Frearson v. Loe*, 1878, L. R. 9 Ch. 67; see also *Muntz v. Foster*, 1844, 2 W. P. C. 101. An instructor who bought pirated instruments to teach his pupils so as to save the expense of the patented articles, was held to have infringed, as he had done so indirectly for profit: *United Telephone Co. v. Sharples* 1885, L. R., 29 C.D. 164, 54, L.J., Ch. 633.

14. Infringement by user.—Subject to what has been said as to experimental user, the unauthorized use of a patented invention will be an infringement of it. Thus, in *Betts v. Neilson*, 1865, 6 N. R., 221, L. R. 3 Ch. 429, the defendants sent some beer in bottles, fastened with a

capsule, from Scotland to an English port for shipment abroad. Held, that during the time the bottles were in England the capsules were being used to hold the beer. Wood, V.-C., said he could conceive a case in which foreign tools lying inert in boxes, and merely for transshipment, could not be said to be used so as to infringe a patent, and referred to the case of *Caldwell v. Van Vlissingen*, 1851, 21 L. J. Ch. 97; 9 Hare, 415, in which case the use of a screw-propeller in English waters was held an infringement. But custom-house agents merely receiving goods and storing them are not infringers: *Nobel's Explosives Co. v. Jones, Scott & Co.*, 8 App. Cas. 5, 17 Ch. D. 721. In *Adair v. Young*, 1879, L. R. 12 Ch. D. 13, an injunction was granted to prevent a master of a ship from using pumps which the owners had fitted up on the ship. This was on the ground, not that he had committed an infringement by simply having the pumps there, but that he might do so. In *Proctor v. Bailey*, 1889, 6 R. P. C., 106, the putting-up of fire-engines was held not to be experimental but an infringing user. The possession of a number of instruments by a trading company is sufficient to warrant the granting of an injunction, although they have not sold any: *United Telephone Co. v. Globe Telephone Co.*, 1884, 26 Ch. D. 766; *Forsyth v. Riviere*, 1819, 1 W. P. C. 97.

CHAP. XXIV.
SECT. 14.

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Infringement
by user.

15. After a patent has been granted, a man who has previously used the invention privately may not continue to do so except experimentally: *Smith v. Davidson*, 1857, 19 C. S. 697; and compare *Cornish v. Keene*, 1835, 1 W. P. C. 571. It thus appears as if by obtaining a patent a man can stop another from doing what he was doing before. This, however, is not

CHAP. XXIV.
SECT. 15.

After a patent has been granted, a man who has previously used the invention privately may not continue to do so except experimentally.

involved in the above proposition. For if the prior user were experimental and secret, the experimenter may still continue to experiment as before, and he will not infringe. If the prior user were abandoned, and had never been brought to perfection, then the rediscoverer and patentee is the true inventor. If on the other hand the prior user were public, then the patent would be invalid.

16. Infringement by sale or purchase.—The sale of a patented article or of an article made according to a patent is an infringement: *Gibson v. Brand*, 1841, 1 W. P. C. 630. It was apparently considered in *Minter v. Williams*, 1835, 1 W. P. C. 137, 5 Nev. & M. 647, 4 A. & E. 251, that the mere exposing for sale was not an infringement. In *Muntz v. Foster* the making of a quantity for sale was held to be an infringement: 1844, 2 W. P. C. 101; and offering for sale was also held to be an infringement in *Oxley v. Holder*, 1860, 8 C. B. (N.S.) 666, 30 L. J. C. P. 68. A buyer of a patent article infringes the patent as well as the seller: *United Telephone Co. v. Sharples*, 1885, L. R. 29 Ch. D. 164; though perhaps a small quantity bought in ignorance for private purposes would not render the buyer liable: *Wright v. Hitchcock*, 1870, 39 L. J. Ex. 106; *Davonport v. Rylands*, 1865, L. R. 1 Eq. 308.

In the *United Telephone Co. v. Henry & Co.*, 1885, 2 R. P. C. 12, a workman of the plaintiffs' went to the defendants to buy a pirated telephone which he saw in their shop. He, however, only got a loan of it, and promised to return it. Held, that the defendants were not proved to have sold or intended to sell the telephone, and the action was dismissed.

17. The sale in Great Britain of an article patented in Great Britain but made abroad is an infringement:

Walton v. Lavater, 1860, 29 L. J. C. P. 279; see also 1 W. P. C. 48 n.; and a sale in Great Britain of an article made abroad according to a process patented in Great Britain is an infringement, though the patent is not for the article but the process of making it: *Elmslie v. Boursier*, 1869, L. R. 9 Eq. 217, 39 L. J. Ch. 328; *Von Heyden v. Neustadt*, 1880, 14 Ch. D. 230; *Cartsburn Co. v. Sharpe*, 1884, 1 R. P. C. 181.

“If a man buys and sells he may be said to be ‘making’ by the hands of another”: *Holmes v. London & N. W. Rail. Co.*, 1852, M. P. C. 23.

It is no answer to an action of infringement to say that the number of articles made is small: *Cole v. Saqui*, 1888, 5 R. P. C. 489. Where, however, a patentee or his licensee sells an article to a purchaser there is an implied permission to use it and to resell it again and again within the area which the patent covers: *Thomas v. Hunt*, 1864, 17 C. B. (N.S.) 183; *Smith v. Buchanan*, 26 S. J. 347. But a license to manufacture articles in a foreign country under a foreign patent does not give an implied right to sell them here: *Betts v. Willmot*, 1870, L. R. 6 Ch. 239, 19 W. R. 369; *Société Anonyme des Glaces v. Tilghmans*, 1883, 25 Ch. D. 1. A person who buys from a patentee without notice of the area within which the patent may be used takes it with power to resell in the whole area of the patent: *Heap v. Hartley*, 1888, 5 R. P. C. 603, 6 R. P. C. 496.

18. It is no infringement of a patent to sell the materials for infringing it, provided that the vendor does not take such part or profit in the putting them

CHAP. XXIV.
SECT. 18.

It is no
infringement
of a patent to
sell the
materials for
infringing it.

together, or preparing them for being put together, as makes him a partner or joint tortfeasor. This was laid down by Jessel, M.R., in *Townsend v. Haworth*, 1875, L. R. 12 Ch. D. 831 n., but a fuller account of the judgment is given in Higgins' Digest of Patent Cases, 2nd Ed. p. 166; see also *Sykes v. Howarth*, 1879, L. R. 12 Ch. D. 832; *Goucher v. Clayton*, 1865, 11 Jur. (N.S.) 462, 13 L. T. (N.S.) 115; *McCormic v. Gray*, 1861, 31 L. J. Ex. 47. But to sell the component parts of an invention so adapted to one another that they merely require to be put together, would be an infringement: see *United Telephone Co. v. Dale*, 1884, 25 Ch. D. 778; and see *Newall v. Elliot*, 1864, 10 Jur. (N.S.) 958, where Bramwell, B., said: "If a man fits up on board a ship a part of a machine, and has the other part there so that he may apply the whole part of the invention when he gets out of England, he may infringe the invention": see also *Abbot v. Williams*, 1837, 9 Rep. Arts. 103.

19. Repairs.—When a machine has been purchased from a patentee or his licensees, and the patentee has thus been paid for the use of the patent, its component parts may not be restored if broken, if the parts form an essential part of the combination, except by persons duly licensed to do so: *United Telephone Co. v. Nelson*, 1887, W. N. 1887, 193.

20. Use on board ships.—The jurisdiction of the Courts to restrain patent infringements extends to British waters: *Adair v. Young*, 1879, L. R. 12, Ch. D. 13; but not to British vessels on the high seas: *Newall v. Elliot*, 1864, 10 Jur. (N.S.) 954, 13 W. R. 11. By Common

Law this jurisdiction extends also to foreign vessels in British waters. In *Caldwell v. Van Vlissingen*, 1851, 16 Jur. 115, 21 L. J. Ch. 97, a Dutchman was restrained from using on board a Dutch vessel a screw-propeller which was the subject of an English patent. In 1852, however, this law was altered by statute, and it is now provided by the Patents Act, 1883, s. 43, that a patent shall not prevent the use in a foreign vessel of anything, provided (a) that it is used for the purpose of navigation; (b) that it is not used for or in connection with the manufacture or preparation of anything intended to be sold or exported from the United Kingdom; (c) that the state to which the ship is subject shall afford like privileges to English vessels.

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SECT. 20.

Use on board
ships.

post, p. 458.

21. **Manufacture, use, and sale by agents.**—The ordinary law of principal and agent as applied to torts applies also to infringement of patents. Thus a principal is liable for the acts of his agent: “He that comes and procures articles to be made may well be said to have made them himself” (*per* Tindal, C.J.): *Gibson v. Brand*, 1842, 1 W. P. C. 631. If, however, the work is done by a contractor, he need not necessarily be the agent of the person who employs him, nor need the employer be necessarily liable for the contractor’s acts: *Denley v. Blore*, 1851, 38 Lond. Jour. 224. On the same principle, the mere fact that the defendants were contractors for the Crown, was held not to justify them in infringing a patent which *agents* of the Crown could have done with impunity under the then law: *Dixon v. Small Arms Co.*, 1877. L. R. 1 App. Cas. 632, 1 Q. B. D. 384. The defendant contracted to clothe a machine with cards, which infringed a patent if they were fixed

CHAP. XXIV.
SECT. 21.

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Manufacture,
use, and sale
by agents.

on in a peculiar manner, but not otherwise. The defendant paid a nailer to do the work who was, however, chosen by the owner of the machine. Held, that defendant had infringed: *Sykes v. Howarth*, 1879, L. R. 12 Ch. D. 832.

Directors of a company may make themselves liable by directing acts of infringement: *Betts v. De Vitre*, 1868, L. R. 3 Ch. 441, 37 L. J. Ch. 325; *Spencer v. Ancoats Vale Rubber Co.*, 1888, 6 R. P. C. 46, 4 T. L. R. 681.

Of course servants and managers can be restrained as well as principals: *Betts v. Neilson*, 1865, 6 N. R. 221; but a mere workman would not in general be treated as an infringer: *Townshend v. Haworth* (*per* Jessel, M.R.), *Higgins' Digest*, p. 168.

Custom-house officials merely storing goods, and not having possession or control over them, would not be considered as infringers: *Nobel's Explosive Co. v. Jones, Scott & Co.*, 1883, 8 App. Cas. 5, 17 Ch. D. 721; and public carriers would probably be in the same position. Where a defendant committed an infringement at the instance of the plaintiff who wished to entrap him, held that he did so as agent for the plaintiff, and the action failed: *Kelly v. Batchelar*, 1893, 10 R. P. C. 289.

22. The question of infringement is one of fact, and therefore is for the jury if the action is being tried by jury: *Walton v. Potter*, 1841, 1 W. P. C. 586; *Macnamara v. Hulse*, 1842, Car. & M. 471; *Newton v. Grand Junction Rail. Co.*, 1846, 5 Ex. 331; *Stevens v. Keating*, 1847, 2 W. P. C. 191; *Sellers v. Dickinson*, 1850, 5 Ex. 323; *De la Rue v. Dickinson*, 1857, 7 E. & B. 738; *Seed v. Higgins*, 1858, 8 H. L. C. 550. Sometimes, however,

it may be a mixed question: *Curtis v. Platt*, 1866, 35 L. J. Ch. 852; see also Chap. XXVIII., sect. 24. CHAP. XXIV.
SECT. 23.
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23. The opinion of an expert as to facts is admissible, but not to say whether or no there has been an infringement: *Seed v. Higgins*, 1860 (*per* Lord Wensleydale), 8 H. L. C. 550.

CHAPTER XXV.

EXTENSION OF LETTERS PATENT.

CHAP. XXV.
SECT. 1.
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1. Old practice.—Prior to the year 1835 patents were occasionally extended by Act of Parliament. A number of instances of such acts are given in Webster's Patent Cases (see Index, "Extension of Terms"). In 1835, by 5 & 6 Will. IV. c. 83, s. 4, power to extend patents for seven years was given upon report of the judicial committee of the Privy Council: see also 2 & 3 Vict. c. 7, and 7 & 8 Vict. c. 69, s. 2. Opposition to such extension was made by entering a caveat. For cases under the Act of 1835, see 1 W. P. C. 557.

2. Practice under the present law.—Under the Act of 1883, s. 25, a patentee may, at least six months before the expiration of his patent, petition for extension, upon which a further term of seven years, or in exceptional cases of fourteen years, may be granted, on such conditions as the judicial committee of the Privy Council thinks fit. Any one may enter a caveat against the petition. Rules of procedure may be made by the Privy Council, who may also award costs.

For the Rules
see *post*,
p. 565.

All petitions presented at present are for the extension of patents which were granted under the old acts,

and hence are governed by the old law: *Brandon's Patent*, 1884, 1 R. P. C. 154; though when once the extension is granted, a new patent is sealed under the Patent Act, 1883, as will be seen hereafter. Hence the limit of six months does not apply to applications for extension of patents granted under the old acts, and the rules of the Privy Council are still in force, and no new ones have been made. There is really no practical difference between the old practice and the new, except as to the requirement of petitioning six months before the expiration of the patent.

CHAP. XXV.
SECT. 2.

Practice
under the
present law.

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3. The persons who may petition.—The Patents Act, 1835, s. 4, provided that “if any person who now hath, or shall hereafter obtain, a patent, shall petition,” etc. The Patents Act, 1883, provides that “a patentee” may petition which now, by sect. 46, includes the persons for the time being entitled to the patent.

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462.

Under the Act of 1835, a patentee might petition though he were only trustee of the patent for an alien: *Newton's Patent*, 1861, 14 Moo. P. C. C. 156; and a public company may also be a petitioner: *Cook's Patent*, 1851, 38 Lond. Jour. 223; *Deacon's Patent*, 1887, 4 R. P. C. 119; and Patent Act, 1883, ss. 25, 46, 117.

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462.

An executor can petition: *Bodmer's Patent*, 1849, 6 Moo. P. C. C. 469; and an administrator: *Downton's Patent*, 1839, 1 W. P. C. 565; *Heath's Patent*, 1853, 2 W. P. C. 247; *Willacy's Patent*, 1888, 5 R. P. C. 690.

Under the Act of 1835, extensions were and are frequently granted on the petition of assignees: *Wright's Patent*, 1837, 1 W. P. C. 561; *Morgan's Patent*, 1843, 1 W. P. C. 737; *Whitehouse's Patent*, 1838, 1 W. P. C. 476; *Russell v. Ledsam*, 1845, 14 M. & W. 574, 16

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SECT. 3.

The persons
who may
petition.

M. & W. 633, 1 H. L. C. 687; *Norton's Patent*, 1863, 1 Moo. P. C. (N.S.) 339; *Pitman's Patent*, 1871, 8 Moo. P. C. C. (N.S.) 297; see also 1 W. P. C. 725 note (e.).

An equitable assignee is entitled to be a co-petitioner: *Noble's Patent*, 1850, 7 Moo. P. C. C. 191. An assignee's title must, however, be strictly proved: *Wright's Patent*, 1843, 1 W. P. C. 737; *Galloway's Patent*, 1843, 1 W. P. C. 725. The executor of an assignee may also petition: *Bodmer's Patent*, 1849, 6 Moo. P. C. C. 469.

It is usual to join in the petition all who have an interest in the patent. Thus, in *Deacon's Patent*, 1887, 4 R. P. C. 119, where a patentee had assigned to a company for a sum down and shares, both the patentee and the company joined in the petition. In *Church's Patent*, 1886, 3 R. P. C. 95, the Privy Council decided that where a patent had been mortgaged, the mortgagee as legal owner ought to have joined in the petition. In *Derosne's Patent*, a part assignment had been made, but only for the original term of the patent, the assignees did not join in the petition which was granted to the patentee: 1844, 2 W. P. C. 2, note e.

The claims of an inventor to an extension rest on his ingenuity, and are far more favourably considered than the claims of an importer of an invention, or of an assignee: *Electric Telegraph Co.'s Patent*, cited, 1 Moo. P. C. C. (N.S.) 339. Thus in *Norton's Patent*, 1863, 1 Moo. P. C. 339, the Master of the Rolls said, "It must always be borne in mind that the assignee of a patent does not, unless under peculiar circumstances, apply on the same favourable footing as the original inventor": see *Morgan's Patent*, 1843, 1 W. P. C. 737; *Normand's Patent*, 1870, 6 Moo. P. C. C. 477; *Pitman's Patent*, 1871,

8 Moo. P. C. C. (N.S.) 297; *Bovill's Patent*, 1863, 1 Moo. P. C. (N.S.) 348.

CHAP. XXV.
SECT. 3.

A mere importer of an invention is not so favourably regarded as the inventor: *Claridge's Patent*, 1851, 7 Moo. P. C. C. 394; *Soame's Patent*, 1843, 1 W. P. C. 733; *Berry's Patent*, 1850, 7 Moo. P. C. C. 187; *Betts' Patent*, 1846, 2 W. P. C. 160. As to the conditions sometimes inserted for the benefit of inventors, see "Conditions," sect. 17.

The persons
who may
petition.

post, p. 345.

4. Procedure.—The first step is to advertise, as provided by 4 & 5 Will. IV., c. 83, and P. C., rule ii. For forms of advertisement see Appendix and sect. 6, *infra*. The petition (sect. 7, *infra*) is presented within a week after the last advertisement (Privy Council Rules III.), accompanied by affidavits verifying the insertion of the advertisements (and under the Act of 1883, at least six months before the expiration of the patent).

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post, p. 330.

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post, p. 452.

By entering a caveat, any person (see sect. 9, *infra*) obtains the right to have served upon him by the petitioner a copy of the petition, within a fortnight of receiving which he must give notice of objections if he means to oppose the grant of the patent: Rule VI. (see sect. 10, *infra*). An application is then made by the petitioner, on the day named in the advertisement, to the Privy Council to fix a hearing day for the petition, on affidavit of service of the petition, on all persons who have entered caveats: Rule V. The hearing day is thus fixed, and the petitioner gives four weeks' notice of it to all the persons who have entered caveats: Rule III. Certain copies of the specification and accounts must be lodged at the Privy Council one week before the hearing day: Rule IX. (see sect. 11, *infra*),

post, p. 332.

post, p. 332.

post, p. 332.

CHAP. XXV.

SECT. 4.

Procedure.

and all parties at their own expense may have copies of any documents lodged in respect of any application.

5. Inspection by an opponent of the petitioner's accounts is not allowed before the hearing day: *Bridson's Patent*, 1852, 7 Moo. P. C. C. 499; but copies of them are sent from the Privy Council Office to the law officer for examination.

6. The advertisements should be inserted in newspapers in places where the patent is being worked: *Derosne's Patent*, 1844, 2 W. P. C. 2, and should contain the names of all who wish to support the petition, as, for instance, the equitable as well as the legal assignees: in *Re Noble's Patent*, 1850, 7 Moo. P. C. C. 191.

7. The petition.—The petition should contain all the facts upon which the petitioners rely, for it will be very difficult, if not impossible, for them to bring forward at the hearing facts which they have not set out in outline in their petition: *Pitman's Patent*, 1871, L. R. 4 P. C. 84. In drawing a petition great care must be taken to set out the facts clearly, fully, in order, without repetition, and yet in as condensed a form as possible. A well-drawn petition is of great influence in gaining the case. It should be in paragraphs, and, where necessary, clear marginal references should be given to the pages and lines of any documents cited. In all petitions to the Privy Council, the utmost good faith in their preparation is required. They are not like pleadings, where affirmations and denials are made in order to cast the burden of proof on other parties, and perhaps secure a right to reply, or for some such tactical advantage. They are supposed to be statements of the facts, and nothing but the facts, and

uberrima fides is expected in their preparation. In *Horsey's Patent* a petition set out an assignment to a company, but did not state (as the fact was) that the company, though registered, had not, in any commercial sense, been formed at all, and that the only real owners of the patent were the patentee and his creditors. The Privy Council considered that they had not been treated with candour, and though the invention had merit, and the patentee had not been sufficiently remunerated, the petition was rejected: 1884, 1 R. P. C. 225; see also *Pitman's Patent*, 1871, L. R. 4 P. C. 84, 8 Moo. P. C. C. (N.S.) 293; *Johnson's Patent*, 1871, L. R. 4 P. C. 83; *Adair's Patent*, 1881, L. R. 6 App. Cas. 176. In one case where certain facts relating to the petitioner's title had been omitted in the petition, leave to amend was granted, and the hearing postponed: *Hutchinson's Patent*, 1861, 14 Moo. P. C. C. 364. In *Fountain Livet's Patent*, where a petitioner knew of a prior patent, which might be held to anticipate his own; held, that he ought to have disclosed it in his petition: 1892, 9 R. P. C. 327. As to the grounds upon which the petition is granted, and which should be specified in the petition: see *infra*, sect. 13, and for a form of petition; see *e.g.*, *Nussey & Leachman's Patent*, 1889, 7 R. P. C. 22. The petition should state if the patent is an importation: *Pitman's Patent*, 1871, *supra*.

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SECT. 7.
—
The petition.

post, p. 333.

also *post*,
p. 597.
ante, p. 327.

8. The time for presenting the petition is shortly before the last six months of the patent's life. A petition presented too long before its expiration (*e.g.*, eighteen months) may be ordered to stand over to see what the profits will be: *Mackintosh's Patent*, 1837, 1 W. P. C. 739. The petition should be presented within a week of the publication of the last advertisement: Rule III.;

ante, p. 327.

post, p. 566.

CHAP. XXV.
SECT. 8.

The time for
presenting the
petition.

post, P. Act,
1883, sec. 25,
ss. 2, p. 452.

but a mistake of a few days has been allowed to be rectified: *Hutchinson's Patent*, 1861, 14 Moo. P. C. C. 364.

9. Caveators.—Any one may enter a caveat, but at the hearing the caveat must be supported by a real opponent, and not simply by a patent agent: *Lowe's Patent*, 1852, 8 Moo. P. C. C. 1.

10. Notice of objections to the extension should be full and detailed, but the committee may notice an anticipation not set forth in the objections, in which case they may deprive the opponents of costs: *Stewart's Patent*, 1885, 3 R. P. C. 7.

The Attorney-General is not bound to give any notice of objections, and may raise objections at the hearing without any notice: *Ball's Patent*, 1879, L. R. 4 App. Cas. 171; *Stewart's Patent*, 1885, 3 R. P. C. 7; *Church's Patent*, 1886, 3 R. P. C. 101; *Fountain Livet's Patent*, 1892, 9 R. P. C. 327.

11. Lodging of the documents at the Privy Council Office one week before the hearing day: P. C., r. ix. Non-compliance with this rule may not be fatal: *Bell's Patent*, 1846, 2 W. P. C. 159; but the accounts ought to be lodged in time, otherwise the committee may dismiss the petition (see *infra*, sect. 14, "As to Accounts").

post, p. 338.

12. The hearing.—The evidence follows as nearly as possible the rules of the H. C. J. The advertisements must be duly proved: *Perkins' Patent*, 1845, 2 W. P. C. 8; *Bell's Patent*, 1846, 2 W. P. C. 160; and the evidence is orally given. The Attorney-General appears to watch the case for the Crown: *Erard's Patent*, 1835, 1 W. P. C. 557 n.; and this whether or no a caveat has been entered: *Pettit Smith's Patent*, 1850, 7 Moo. P. C. C. 133.

No more than two counsel are heard in any one interest: *Woodcroft's Patent*, 1841, 3 Moo. P. C. C. 171 n. A preliminary objection is often taken that the accounts are on the face of them insufficient. If this is well founded the petition is at once dismissed, if not then the evidence proceeds. The Court, under the Patents Act, 1883, s. 28, sub-s. 2, may call in the aid of a skilled assessor: see Chap. XXVIII., sect. 21.

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SECT. 12.

The hearing.

post, pp. 385,
454.

13. Grounds upon which a petition is granted:
(a) Public interest in the extension.—In the Acts of Parliament by which prior to 1835 patents were extended, it was usual to recite matters shewing that it was for the public interest as well as that of the patentee, that the patent should be extended: see, e.g., *Liardet's Patent*, 1776, 1 W. P. C. 52; *Hartley's Patent*, 1777, 1 W. P. C. 55; and the same considerations will weigh with the Privy Council in granting extensions under the statute: 1 W. P. C. 557 n. In *McDougall's Patent*, the fact that the public would be excluded from using alum, clay, and charcoal in certain proportions for deodorizing manure, held, to weigh against the somewhat dubious utility of the patent: 1867, L. R. 2, P. C. 1, 5 Moo. P. C. C. 1; *Sillar's Patent*, 1882, Good. P. C. 581; see also *Morgan's Patent*, 1843, 1 W. P. C. 739; *Soame's Patent*, 1843, 1 W. P. C. 734. A patentee had granted an exclusive licence to a company for a patent, and any prolongation that should be granted. Held, to be against the extension, for such exclusive use is contra to public policy: *Cardwell's Patent*, 1856, 10 Moo. P. C. C. 488. But in *Shone's Petition for Prolongation*, 1892, 9 R. P. C. 438, this objection was not pressed, and the patent granted, but on condition that the exclusive licence

post, P. Act,
sec. 25, sub. 4,
p. 452.

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SECT. 13.

Grounds upon
which a
petition is
granted:
(a) Public
interest in the
extension.

See post,
p. 342.

should cease. It was held, no ground for refusing to extend a patent for smoke prevention (which had been recently rendered compulsory in furnaces in the metropolis by Act of Parliament) that the public might be compelled to use the invention: *Foarde's Patent*, 1855, 9 Moo. P. C. C. 376.

(b) The benefit already received by the public from the invention.—In *Derosne's Patent*, the patentee had made over £8000 by a patent for refining sugar. The public had benefited by from 1½d. to 2d. per lb. The committee considered that though the profit to the patentee had been great, that the public had so greatly benefited, that they gave an extension of six years: 2 W. P. C. 4; *Erard's Patent*, 1835, 1 W. P. C. 557; *Soame's Patent*.—"The public has somewhat gained": 1843, 1 W. P. C. 735; *Jones' Patent*, 1840, 1 W. P. C. 557.—"An invention may not be a very difficult one, but it may be of such usefulness to the public that it may seem fair that the patentee should have a further portion of remuneration" (*per* Lord Hobhouse): *Beanland's Patent*, 1887, 4 R. P. C. 491. In this case, however, the application was refused, as there was no exceptional merit in the invention.

(c) The merit of the invention.—The merit of the invention, that is to say, its ingenuity, novelty and utility, are looked upon from a different point of view in a petition for extension to that in which they are regarded in an action for infringement. For on the one hand, the mere fact that a patent would be supported on those grounds is not sufficient to make out a case of such exceptional merit as to warrant an extension. It is not every meritorious patent that will be extended, but only patents of exceptional character. On the other hand, the

Court, if convinced that the invention has exceptional merit, will not try out questions of novelty or anticipation. "It is not the practice of this tribunal to decide upon the novelty or utility of a patent; and although they would of course abstain in any case from prolonging a patent which was manifestly bad, yet they are in the habit . . . to consider not only that amount of utility which would be necessary to support a patent, but that sort of utility which might more properly be described as merit" (*per* Lord Cairns): *Saaby's Patent*, 1870, L. R. 3 P. C. 294, quoted with approval in *Cocking's Patent*, 1885, 2 R. P. C. 153; see *Stewart's Patent*, 1885, 3 R. P. C. 10. *Church's Patent*, 1886, was on the same principle extended for five years in spite of alleged anticipation: 3 R. P. C. 101 (an action of infringement was then pending: 2 R. P. C. 175, 3 R. P. C. 127). *Heath's Patent*, 1853, 2 W. P. C. 247, was extended, the Court expressing no opinion on its validity; it was ultimately found bad for want of novelty: *Heath v. Smith*, 1854, 2 W. P. C. 275. Similarly, *Kay's Patent*, for spinning machinery, was extended for three years in 1839: 1 W. P. C. 568; but Chancery proceedings which had been commenced in 1835, and which were then pending, ended in 1841 by the invalidation of the patent by the House of Lords: 2 W. P. C. 83; see also *Lane-Fox's Patent*, 1892, 9 R. P. C. 411, where pending proceedings were not considered as preventing an application for extension, even though the judgment of a Court of the High Court of Justice had recently declared the patent invalid. *Pinkus' Patent*, 1848, 12 Jur. 234; *Betts' Patent*, 1862, 1 Moo. P. C. C. (N.S.) 49. "Before their Lordships can recommend . . . the prolongation of a patent they must be convinced that the patentee has been inadequately

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SECT. 13.

Grounds upon
which a
petition is
granted:
(c) The merit
of the
invention.

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Grounds upon
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granted:
(c) The merit
of the
invention.

remunerated; . . . , but that is not all, . . . there must be some exceptional merit in the invention" (*per* Lord Hobhouse): *Beanland's Patent*, 1887, 4 R. P. C. 491; and see *Stoney's Patent*, 1888, 5 R. P. C. 522; *Swaine's Patent*, 1837, 1 W. P. C. 559; *Woodcroft's Patent*, 1846, 2 W. P. C. 32; *McInnes' Patent*, 1868, 5 Moo. P. C. C. (N.S.) 72, L. R. 2 P. C. 54.

It is, however, no objection against the merit of an invention for the purposes of an extension that great subsequent improvements have been made in it, which are being worked: *Galloway's Patent*, 1843, 1 W. P. C. 727; *Soame's Patent*, 1843, 1 W. P. C. 734.

(d) **Utility of the invention as evidenced by its successful working:** *Downton's Patent*, 1839, 1 W. P. C. 565. If the invention has not been practically and successfully worked, this, on petition for its extension, will put its merits as to utility in an unfavourable light unless some explanation be forthcoming as to why it was not made a success: *Allan's Patent*, 1867, 4 Moo. P. C. C. (N.S.) 443; *Pinkus' Patent*, 1848, 12 Jur. 234; *Hughes' Patent*, 1879, L. R. 4 App. Cas. 174; *Norton's Patent*, 1863, 1 Moo. P. C. C. 339; *Simister's Patent*, 1842, 4 Moo. P. C. C. 161, 1 W. P. C. 721. "We expect a very strong case of hardship to be made out, as well as a strong case upon the utility of the invention" (*per* Lord Lyndhurst): *Erard's Patent*, 1835, 1 W. P. C. 559; *Willacy's Patent*, 1888, 5 R. P. C. 694; *Perkins' Patent*, 1845, 2 W. P. C. 6. But even though the invention may not have been largely used, if the non-user is explained by difficulties in the way of making it known or working it, an extension may be granted. Thus, where the very nature of the invention rendered it difficult to introduce, the non-user may be explained: *Woodcroft's Patent*, 1846, 2 W. P. C. 32;

Stoney's Patent, 1888, 5 R. P. C. 522; *Herbert's Patent*, 1867, 4 Moo. P. C. C. (N.S.) 300; *Roper's Patent*, 1887, 4 R. P. C. 201; *Kohlman's Patent*, 1839, 1 W. P. C. 564. A fire believed to be by an incendiary and a combination of workmen, and piracies, were held to excuse non-user in *Roberts' Patent*, 1839, 1 W. P. C. 573. (Bankruptcy and legal proceedings), *Southworth's Patent*, 1837, 1 W. P. C. 487; (pecuniary embarrassment of inventor), *Wright's Patent*, 1839, 1 W. P. C. 575; (prejudice against the inventor), *Jones' Patent*, 1840, 1 W. P. C. 578; (prejudice and impecuniosity of patentee), *Stafford's Patent*, 1838, 1 W. P. C. 563; *Payne's Patent*, 1854, Coryton 220; (prejudice and difficulty of teaching workmen), *Erard's Patent*, 1835, 1 W. P. C. 558; (prejudice and litigation), *Heath's Patent*, 1853, 2 W. P. C. 247; (derangement of the labour market), *Napier's Patent*, 1861, 13 Moo. P. C. C. 543; (actions at law), *Pettit Smith's Patent*, 1850, 7 Moo. P. C. C. 133. In *Southby's Patent*, where great merit was admitted by the Crown, an extension was granted though no user was proved; the non-user was accounted for by the fact that unforeseen difficulties of detail had presented themselves, and that the machine was large and expensive: 1891, 8 R. P. C. 433. But the mere fact that the patentee had disputes with assignees: *Patierson's Patent*, 1849, 6 Moo. P. C. C. 469; or that he tried in vain to form a company, without which he could not work it, are not sufficient: *Bakewell's Patent*, 1862, 15 Moo. P. C. C. 385.

(e) The position, circumstances and conduct of the petitioners are also matters to be considered. Thus, in *Stewart's Patent*, the committee "were not quite satisfied that the patentee had at all times been so ready to give the public the benefit of his invention as might be

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Grounds upon which a petition is granted:
(d) Utility of the invention as evidenced by its successful working.

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Grounds upon
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petition is
granted.
(e) The posi-
tion, circum-
stances and
conduct of the
petitioners.

desired," and rejected his petition, but on the ground of want of merit: 1885, 3 R. P. C. 10. Where the petitioner had not made large profits, but had slumbered on his rights, and not brought an action of infringement, the extension was refused: *Simister's Patent*, 1841, 1 W. P. C. 721.

(f) **Smallness of profit made by the inventor:** see "Accounts," sect. 14 (*post*, p. 340).

(g) **Pending legal proceedings is no bar to obtaining an extension:** see *supra*, sect. 13 (c).

(h) **The having taken out foreign patents was formerly a reason against extension, but it is doubtful whether it is so now:** *Fountain Livet's Patent*, 1892, 9 R. P. C. 327.

14. Accounts shewing the profits made from the invention.—At the hearing, after the formal proofs of advertisements have been put in, the accounts are first looked at to see if they are *primâ facie* in order. For if they are not, or if they shew no case for the petitioner, the petition may be dismissed at once: *Saxby's Patent*, 1870, 7 Moo. P. C. C. 82; *Trotman's Patent*, 1866, L. R. 1 P. C. 118; *Clark's Patent*, 1870, 7 Moo. P. C. C. (N.S.) 255; *Wield's Patent*, 1871, 8 Moo. P. C. C. (N.S.) 300; *Thomas' Patent*, 1892, 9 R. P. C. 367. On the other hand, if they are satisfactory *primâ facie*, the petitioner may prove the merits of his invention before going further into them: *Houghton's Patent*, 1871, 7 Moo. P. C. C. 309 (Saxby and Clark's cases explained).

The accounts presented must be clear and full: *Adair's Patent*, 1881, L. R. 6 App. Cas. 176; *Quarril's Patent*, 1 W. P. C. 740; *Saxby's Patent*, 1870, 7 Moo. P. C. C. 85; *Hill's Patent*, 1863, 1 Moo. P. C. C. (N.S.) 258; *Betts' Patent*, 1862, 1 Moo. P. C. C. (N.S.) 49; *Lake's*

Patent, 1891, 8 R. P. C. 228. They should be kept clear and separate for each part of the invention, if severable, so that if part only is to be extended the accounts for that part may be severable: *Willacy's Patent*, 1888, 5 R. P. C. 690. If the patent has been assigned, the assignee's accounts ought also to be presented: *Deacon's Patent*, 1887, 4 R. P. C. 119. In some cases where books had been destroyed, and their non-production was accounted for, an affidavit of want of profits was allowed: *Hutchinson's Patent*, 1861, 14 Moo. P. C. C. 364; *Heath's Patent*, 1853, 8 Moo. P. C. C. 222; *Lowe's Patent*, 1846, 10 Jur. 363; *Markwick's Patent*, 13 Moo. P. C. C. 310. But in *Yates & Kellett's Patent* the destruction of books was considered fatal. "The destruction of his books, for aught their Lordships know, may have been a perfectly honest and perfectly reasonable operation for him to perform, but he cannot escape from the consequences" (*per* Lord Hobhouse): 1887, L. R. 12 App. Cas. 147, 4 R. P. C. 150; see also *Lawrence's Patent*, 1892, 9 R. P. C. 85. The accounts ought also to shew clearly licensee's and manufacturer's profits, so that the Privy Council may see what has been made out of the patent altogether: *Thomas' Patent*, 1892, 9 R. P. C. 370, and cases there cited. The same view was taken in *Lane-Fox's Patent*, 1892, 9 R. P. C. 411, where, though the patentee had received no remuneration, the omission to shew all the profits made by licensees and others in his accounts was held fatal. See also *Newton's Patent*, 1884, L. R. 9 App. Cas. 592.

In the case of very heavy losses, the exact accounts need not be proved with that accuracy which is required when the losses are not heavy, or when there has been a gain: *Darby's Patent*, 1891, 8 R. P. C. 380.

The accounts must, previously to the hearing, have been

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Accounts.

filed in accordance with the rules: *Johnson & Atkinson's Patent*, 1873, L. R. 5 P. C. 87; *Chatwood's Patent*, *ibid.*, 88 n. One reason of this is, in order that they may be sent for the inspection of the law officer: *Perkins' Patent*, 1845, 2 W. P. C. 14. But as has been said *supra*, the opponents are not allowed to inspect them until the hearing.

The question of remuneration must be considered as a whole, not for each separate part of the invention: *Perkins' Patent*, 1845, 2 W. P. C. 9.

The fact that the profits have been very recent, and that in the earlier years nothing was got, is no reason for granting an extension if the total is sufficient: *Ryder's Patent*, 1855, John. 213; but see *Perkins' Patent*, 1845, 2 W. P. C. 16; *Downton's Patent*, 1839, 1 W. P. C. 566.

Amendment of the accounts is sometimes, but very rarely, allowed: *Perkins' Patent*, 1845, 2 W. P. C. 17; *Heath's Patent*, 1853, 2 W. P. C. 257, *contra*, *Yates & Kellett's Patent*, 1887, 4 R. P. C. 150. The following deductions in favour of the applicant have been allowed in the accounts:—

(a) Expenses of taking out and defending the patent at law: *Roberts' Patent*, 1839, 1 W. P. C. 573; *Kay's Patent*, 1839, 1 W. P. C. 572; *Galloway's Patent*, 1843, 1 W. P. C. 729; *Betts' Patent*, 1862, 1 Moo. P. C. C. (N.S.) 49. But where a case was compromised, and costs surrendered, this would not be a proper deduction, for benefit was obtained thereby: *Hill's Patent*, 1863, 1 Moo. P. C. C. (N.S.) 258.

(b) Patentee's time devoted to perfecting the invention and bringing it into use: *Roberts' Patent*, 1839, 1 W. P. C. 575; *Carr's Patent*, 1873, L. R. 4 P. C. 539; *Newton's Patent*, 1861, 14 Moo. P. C. C. 156; *Furness' Patent*, 1885, 2 R. P. C. 175; *Bailey's Patent*, 1884, 1 R. P. C. 2.

(c) Making experiments: *Kay's Patent*, 1839, 1 W. P. C. 572; *Bates' Patent*, 1836, 1 W. P. C. 739 n.

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(d) Manufacturer's profits; and these should be kept strictly separate from the patentee's profits: *Betts' Patent*, 1862, 1 Moo. P. C. C. (N.S.) 49; *Galloway's Patent*, 1843, 1 W. P. C. 729; *Saxby's Patent*, 1870, 7 Moo. P. C. C. 82. By manufacturer's profits is here meant that part of the total profit which may have arisen, not by reason of the patent monopoly, but as a fair return to the capital employed, and the manufacturer's labour of superintendence. It will of course only be deducible where the patentee is himself the manufacturer, or where manufacturers have been selling under a license and making profits. Two-thirds of total profit would be considered an excessive share to assign to this head: *Hill's Patent*, 1863, 1 Moo. P. C. C. (N.S.) 258; *Duncan & Wilson's Patent*, 1884, 1 R. P. C. 257 (which affords an example of the way in which accounts are criticised). Where the manufacturing profits only arise by reason of the patent and not otherwise, they should all be reckoned as profits made by the patent: *Johnson's Patent*, 1871, 8 Moo. P. C. C. (N.S.) 291; *Muntz' Patent*, 1846, 2 W. P. C. 121.

(e) Expenses of bringing the invention into use: *Galloway's Patent*, 1843, 1 W. P. C. 729; such as allowing half profits to an agent for introducing the invention: *Poole's Patent*, 1867, L. R. 1 P. C. 514.

It is quite evident that, in dealing with the profits, it is not only the *patentee's* profits that are to be considered, but the *profits made out of the invention* over and above the ordinary trade profits, that are really in question, no matter in whose hands, or by whom such profits have been made. For a patentee would have no right to sell his patent for a small sum to assignees who made an

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—
Accounts.

enormous profit out of it, and then come and say that the invention had been improperly rewarded. The insufficient remuneration of the inventor is one circumstance, but only one, in the various questions that have to be considered.

The following items must be reckoned into the profits: (a) Gains from foreign patents: *Adair's Patent*, 1881, L. R. 6 App. Cas. 176; *Johnson's Patent*, 1871, 8 Moo. P. C. C. (N.S.) 291, explaining *Poole's Patent*, 1867, 4 Moo. P. C. C. (N.S.) 456. (b) Gains from articles made and exported must also be reckoned in as profits: *Hardy's Patent*, 1849, 6 Moo. P. C. C. 441.

Gains or losses by speculative dealings with the patent, as by buying and re-selling it, are not to be reckoned either as profits or losses: *Wield's Patent*, 1871, 8 Moo. P. C. C. (N.S.) 300; nor the rise in values of shares taken in payment for it: *Child's Patent*, 1883, John. 214. Of course the high dividends will have been counted, but if the dividends paid had been small through (say) the creation of an enormous reserve fund which caused the share values to rise, surely this should be reckoned?

The following are examples of cases in which the remuneration was held insufficient, and the patent was extended: *Deacon's Patent*, 1887, 4 R. P. C. 119, where three years' extension was granted though the patentee had made £6000 and his accounts were not very satisfactory; *Bischof's Patent*, 1884, 1 R. P. C. 162, for purification of water. A loss had been made here, and seven years' extension was granted: *Derosne's Patent*, where over £8000 had been made, but the public benefit had been very great: 1844, 2 W. P. C. 4. In *Fountain Livet's Patent*, where extension was refused, it was said that if the invention had possessed merit, £6000 profit

would not be too much for fourteen years' work: 1892, 9 R. P. C. 327. In *Joy's Patent* an extension for seven years was granted, though the patentee had made over £6000: 1893, 10 R. P. C. 89. In *Thomas' Patent* a profit had been made of £250,000: 1892, 9 R. P. C. 367. This was considered far too large. In *Nussey & Leachman's Patent*, 1889, 7 R. P. C. 22, the patentees had made £4000, including payment for patentees' whole time, and were working another patent which had practically superseded the old one. The merit was not considered very great, and extension refused. *Beanland's Patent*, 1887, 4 R. P. C. 489, where a patent for keeping windows open had brought in about £1000, and there was no exceptional merit, extension refused. *Furness' Patent*, 1885, 2 R. P. C. 175, extension refused where the patentee had made £6000. *Muntz' Patent*, 1846, 2 W. P. C. 113, the invention was considered most valuable, but the patentee had made £55,000, and therefore extension was refused. See also *Betts' Patent*, 1846, 2 W. P. C. 160.

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The account should be entered debtor and creditor for each year of the patent, and a summary be put at the end. The following form may give some idea of what is required:

IN THE PRIVY COUNCIL. ————'s PATENT, 18 , No. .
[Title .]

PETITIONS FOR PROLONGATION.

Account of expenditure and receipts of Petitioner for the th year,
from 18 , to 18 .

EXPENDITURE.			RECEIPTS.				
	£.	s.	d.		£.	s.	d.
Expenses of experiments, i.e. :—				Royalties on			
Models				articles from			
Journeys				Fees (from licensees?)			
Materials				Cash on account of			
Labour				expenses			

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	£.	s.	d.		£.	s.	d.
Expenses of taking out patent:—				By sale of			
Paid to				articles less discount			
for making articles				and commission, if			
Travelling expenses.				any			
Trials				Value of articles on			
Law expenses				hand, plant, furni-			
Experiments				ture, less deprecia-			
Photographs.				tion			
Models				Any other receipts .			
Law expenses:—							
In connection with							
action — v. —							
for infringement .							
Salaries.							
Rates and taxes							
Exhibition expenses .							
Show cases, rent of							
show rooms.							
Commissions to agents							
Bank commission							
Advertising							
Stationery and print-							
ing							
Insurance							
Postage							
Bad debts							

N.B.—Many of the above items would be proportioned if other business was being carried on as well as the patent business.

The above is a patentee's account, but where there have been licenses or assignments the account will of course be much more elaborate.

15. The period of extension.—By the Act of 1835, power was given to extend for seven years, but this was increased to fourteen years by the Act of 1844. Under the Act of 1883, c. 25, seven years' extension is permitted,

or in exceptional cases, fourteen years. *Stoney's Patent*, for rollers for sluice gates, to which the patentee devoted his attention for fourteen years, and which at last ended in a success, was considered an exception, and was extended for ten years; 1888, 5 R. P. C. 524.

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SECT. 15.

—
The period of
extension.

16. When an extension has been granted, the powers of the committee are exhausted, and no second extension can be given: *Goucher's Patent*, 1865, 2 Moore P. C. C. (N.S.) 532.

17. Conditions of extension.—In extending a patent the committee frequently stipulate for some further remuneration to the patentee, if he have parted with his rights. Thus, in *Whitehouse's Patent*, 1838, 1 W. P. C. 476, extension was granted on condition that the assignees executed an agreement to pay the inventor an increased annuity (this agreement afterwards became the subject of a lawsuit: *Russell v. Ledsam*, 1845, 14 M. & W. 574, 1 H. L. Cas. 687); see also *Markwick's Patent*, 1860, 13 Moo. P. C. C. 310; *Pitman's Patent*, 1871, L. R. 4 P. C. 87. But this will not be done where the patentee has sold for value, and the assignee has made a loss: *Bodmer's Patent*, 1849, 6 Moo. P. C. C. 468; *Napier's Patent*, 1861, 13 Moo. P. C. C. 543.

Where contractual relations exist between the petitioner and others, the committee will protect them. Thus, on extension granted to the assigns of a moiety of a patent, it was stipulated that they should hold a moiety in trust for the legal representatives of a deceased inventor who possessed the other moiety: *Herbert's Patent*, 1867, 4 Moo. P. C. C. (N.S.) 300; and see *Normanby's Patent*, 1855, 9 Moo. P. C. C. 441. Two

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SECT. 17.

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Conditions of
extension.

apprentices opposed an extension on the ground that they had served the patentee in the expectation of using the patent on its expiration. Held, that if that had been proved they might have been entitled to a clause in their favour, but it was not proved: *Baxter's Patent*, 1849, 13 Jur. 593.

Conditions as to the price at which the patent article is to be sold are sometimes put for the benefit of the public. This extension was granted to assignees on terms of securing half profits to the patentee, and selling to the public at a fixed price: *Hardy's Patent*, 1849, 6 Moo. P. C. C. 441. Extension granted on terms of licensing the public upon terms not higher than those licenses already granted: *Mallet's Patent*, 1866, 4 Moo. P. C. C. (N.S.) 175.

In *Pettit Smith's Patent*, 1850, 7 Moo. P. C. C. 133, a condition was imposed that the Admiralty Commissioners might use the invention without license; see also *Napier's Patent*, 1881, L. R. 6 App. Cas. 174. But like conditions were refused to the Crown in *Lancaster's Patent*, 1864, 2 Moo. P. C. C. (N.S.) 189, and *Carpenter's Patent*, 1854, 2 Moo. P. C. C. (N.S.) 191 n.

post, p. 452.

18. **Costs.**—Under the Patents Act, 1883, s. 25, sub-s. 7, costs are in the control of the committee. This power they always had. Costs are usually given to a successful petitioner where there is no good ground of opposition: *Downton's Patent*, 1839, 1 W. P. C. 567; but where there is good ground of opposition, and the patent is doubtful, they may be refused: *Church's Case*, 1886, 3 R. P. C. 102.

Costs are usually given to a successful opponent: *Westrupp & Gibbin's Patent*, 1836, 1 W. P. C. 554;

Wield's Patent, 1871, 8 Moo. P. C. C. (N.S.) 300; unless where the opponents have been guilty of misconduct: *Honiball's Patent*, 1855, 9 Moo. P. C. C. 394; or where the petitioner has very fully and fairly stated all the facts both for and against himself, and the opposition has not been of any assistance to the committee: *Muntz's Patent*, 1846, 2 W. P. C. 122; or where an opponent raises at the hearing a new ground of opposition not mentioned in his objections: *Stewart's Patent*, 1885, 3 R. P. C. 7.

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SECT. 18.

Costs.

These costs are sometimes assessed by the committee at a gross sum: *Jones's Patent*, 1854, 9 Moo. P. C. C. 41, where £100 was directed to be divided between two successful opposers; and *Hill's Patent*, 1863, 1 Moo. P. C. C. (N.S.) 282, where £1000 was similarly apportioned; see also *Johnson's Patent*, 1871, 8 Moo. P. C. C. (N.S.) 282.

In the case of an abandoned petition the opposer's costs are also given: *Macintosh's Patent*, 1837, 1 W. P. C. 739; *Bridson's Patent*, 1852, 7 Moo. P. C. C. 499; *Morgan Brown's Patent*, 1886, 3 R. P. C. 212 (on motion by opposer for costs after notice of withdrawal of the petition). Sometimes in such case of abandonment a lump sum is given: *Milner's Patent*, 1853, 9 Moo. P. C. C. 503.

19. The extension and new grant.—Formerly, when the committee had decided to extend a patent in part, but not to extend all of it, they used to put the patentee on terms of disclaiming part of his patent before the extension was granted: *Bodmer's Patent*, 1853, 6 Moo. P. C. C. 282. But this mode of attaining the result is not needed now, and it is customary to direct a new patent to be sealed only for such part of the patent as the committee has seen fit to prolong: *Lee's Patent*, 1856, 10 Moo. P. C. C. 226; *Napier's Patent*, 1881, L. R. 6 App.

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SECT. 19.

The extension and new grant.

Cas. 174; *Church's Patent*, 1886, 3 R. P. C. 102; *Willacy's Patent*, 1888 (*per* Sir Barnes Peacock), 5 R. P. C. 695.

The extension of the patent has always been virtually considered as a new grant: *Betts' Patent*, 1862, 1 Moo. P. C. C. (N.S.) 49; *Stoney's Patent*, 1888, 5 R. P. C. 524. Under the Patents Act, 1883, the Privy Council may either extend the time, or make a new grant commencing at or after the expiration of the old one. The usual practice is to make a new grant dated the day after the expiration of the old one. It hence follows that patents extended after the Act of 1883 are subject to the conditions of patents granted under that Act, *e.g.* sect. 22 as to licenses, and sect. 27 as to the Crown: *Cooking's Patent*, 1885, 2 R. P. C. 152; *Wasteney's Smiths' Patent*, 1885, 2 R. P. C. 14. No new specification need be filed; *ibid.*

post., p. 497.

An office copy of the order of the Privy Council must be left at the Patent Office: Patent Rules, 1890, r. 74. It used to include the Channel Islands, but having regard to the provisions of the Patents Act, 1883, s. 16, it is doubtful how far the provisions of such a grant would apply to them. If a gap occurred between the expiration of the patent and the new grant, the patent would not be considered as existing during that period: see "Infringement," Chap. XXIV., sect. 9.

ante., p. 314.

20. There is power to revoke an order for extension when it has not been acted on by reason of the grantee's laches and long delay: *In re Schlumberger's Patent*, 1853, 9 Moo. P. C. C. 1.

CHAPTER XXVI.

CONFIRMATION OF PATENTS.

By the Patents Act, 1835, 5 & 6 Wm. IV., c. 83, s. 2, it was provided, that if in any suit or action it should be found that a patent had been anticipated, the patentee might petition the King in Council to confirm the patent. CHAP XXVI.
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This Act is now abolished, but since, by Patents Act, 1883, s. 113, the privileges of patents granted prior to that Act are preserved (*Brandon's Patent*, 1884, 1 R. P. C. 154), it would still be possible to apply for confirmation of patents granted prior to the coming into force of the Patents Act, 1883: *Jablochkoff's Patent*, 1891, 8 R. P. C. 281. In such case, however, the applicant cannot have a confirmation on grounds dependent on the privileges conferred by the Act of 1883. If, for the purpose of obtaining a confirmation, he relies on the older law, his patent must be treated as subject to the older law, and not to the new. post, p. 473.

It is not very likely that a similar application will again occur, as the patents granted prior to the Act of 1883 are rapidly running out. The following cases were decided under the old law, and may serve as examples of the practice then in vogue: *Westrupp & Gibbin's Patent*,

CHAP. XXVI. 1836, 1 W. P. C. 555; *Heurteloup's Patent*, 1836, 1
— W. P. C. 553; *Robinson's Patent*, 1845, 5 Moo. P. C. C.
65; *Stead's Patent*, 1846, 2 W. P. C. 146; *Card's Patent*,
1848, 2 W. P. C. 161; *Lamenaude's Patent*, 1850, 2
W. P. C. 164; *Honiball's Patent*, 1855, 2 W. P. C. 201;
Stead v. Carey, 1845, 1 C. B. 496.

CHAPTER XXVII.

INTERIM INJUNCTIONS AND INTERIM ACCOUNTS.

1. **General principles.**—Prior to the Judicature Acts, the power of granting injunctions was only possessed by the Court of Chancery. The usual practice was to grant an interim injunction, and then send certain issues to be tried before a jury in a court of law. But the necessity for this is now removed by the Judicature Acts, and the modern practice is to apply for an interim injunction as soon as the writ has been issued: J. A. 1873, s. 25, sub-s. 8. The object of the application is to preserve the rights of the parties until the trial, and the “balance of convenience” is generally considered as the foundation of the order: *Harmer v. Plane*, 1807, 14 Ves. 130; *Neilson v. Thompson*, 1840, 1 W. P. C. 278; *Bridson v. McAlpine*, 1845, 8 Beav. 229; approved in *Plimpton v. Spiller*, 1876, 4 Ch. D. 290; *Thomson v. Hughes*, 1890, 7 R. P. C. 77; *Bracher v. Bracher*, 1890, 7 R. P. C. 422.

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SECT. 1.
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P. Act, 1883,
sect. 30, *post*,
p. 455.

2. **Long and uninterrupted user** is good ground for an application for an interim injunction. In *Jackson v. Needle*, where the patent was of very recent date, the Court refused an interim injunction: 1884, 1 R. P. C. 176. In *Lister v. Norton*, 1884, Chitty, J., intimated an opinion that more than three years' peaceful enjoyment

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Long and
uninterrupted
user.

of a patent was needful to support the application: 1 R. P. C. 115. In *Briggs v. Lardeur*, 1884, 1 R. P. C. 126, where a patent was ten years old, an interim injunction was granted; see also *Shillito v. Larmouth*, 1884, 2 R. P. C. 1. And in *Rothwell v. King*, 1886, 3 R. P. C. 380, user for six years, coupled with the fact that the plaintiffs had on four occasions induced infringers to abstain, was sufficient. In the *British Tanning Co. v. Groth*, 1889, 7 R. P. C. 1, two years' user was held too little.

In earlier cases also some period of user was required to warrant the Court in granting an injunction: *e.g.*, *Harmer v. Plane*, 1807, 14 Ves. 130; *Hill v. Thompson*, 1817, 3 Mer. 622; *Beeston v. Ford*, 1839, 2 Coop. Ch. Cas. 58; *Bickford v. Skewes*, 1838, 1 W. P. C. 213; *Collard v. Allison*, 1839, 4 My. & C. 487; *Curtis v. Cutts*, 1839, 2 Coop. C. C. 60 n.; *Muntz v. Foster*, 1843, 2 W. P. C. 95; *Electric Telegraph Co. v. Nott*, 11 Jur. 273; *Stevens v. Keating*, 1847, 2 W. P. C. 177; *Caldwell v. Van Vlissingen*, 1851, 9 Hare 424; *Hancock v. Moulton*, 1852, Monthly Digest, 506; *Lister v. Eastwood*, 1855, 26 L. T. 4; *Betts v. Menzies*, 1857, 3 Jur. (N.S.) 358; *Davenport v. Richards*, 1860, 3 L. T. (N.S.) 503; *Bernard v. Levinstein*, 1864, 10 L. T. (N.S.) 177 (in which Knight, V.-C., thought that three years might be sufficient); *Davenport v. Goldberg*, 1865, 2 H. & M. 282; *Dudgeon v. Thomson*, 1874, 30 L. T. (N.S.) 244.

The user must have been an actual active user by the plaintiff, even where the patent is eight years old, for it is not simply the age of the patent, but the long public user of it, on which the interim injunction is founded: *Plimpton v. Malcolmson*, 1875, L. R. 20 Eq. 37, 44 L. J. Ch. 257.

The period of user ought to be computed from and

after the time when the patentee ceases to pay royalty under a prior patent: *Heugh v. Magill*, 1877, W. N. p. 62.

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Long and
uninterrupted
user.

3. **Prior judicial establishment of the patent**, though not absolutely conclusive, greatly strengthens the application: *Farbenfabrik Co. v. Dawson*, 1891, 8 R. P. C. 397; *Hayward v. Pavement Light Co.*, 1884, 1 R. P. C. 206; *Dudgeon v. Thomson*, 1877, 30 L. T. (N.S.) 244; *Newall v. Wilson*, 1852, 2 De G. M. & G. 282; *Lister v. Eastwood*, 1855, 26 L. T. 4 (where an award of an arbitrator had previously affirmed the validity); *Bovill v. Goodier*, 1866, 35 L. J. Ch. 174; *Davenport v. Jepson*, 1862, 1 N. R. 173.

4. **The inability of the defendant, if defeated in the action, to compensate the plaintiff, or to pay costs**, is also considered: *Newall v. Wilson*, 1852, 2 De G. M. & G. 282; *Plimpton v. Spiller*, 1876, 4 Ch. D. 291; *Kensington Co. v. Lane-Fox Co.*, 1891, 8 R. P. C. 277.

5. **Delay greatly prejudices an application for an interim injunction**: *Thomson v. Batty*, 1888, 4 T. R. 36; and even a delay of three weeks after knowledge of defendant's infringement was fatal in *Greer v. Bristol Tanning Co.*, 1885, 2 R. P. C. 268; see also *Bovill v. Crate*, 1866, L. R. 1 Eq. 388; *Baxter v. Coombe*, 1850, 1 Ir. Ch. R. 284; *Bridson v. Benecke*, 1849, 12 Beav. 3; *Bacon v. Jones*, 1839, 4 My. & Cr. 439; *Smith v. London & S. W. Rail. Co.*, 1854, 23 L. J. Ch. 564; *Lister v. Norton*, 1884, 1 R. P. C. 116.

But the delay may be accounted for and explained. Thus, where the plaintiffs had been advised not to take action on mere threats of infringement, but to

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Delay greatly
prejudices an
application for
an interim
injunction.

wait for actual infringement, their delay did not prevent an interim injunction being obtained: *United Telephone Co. v. Equitable Telephone Co.*, 1888, 5 R. P. C. 233. And where the plaintiff had reasonably spent some two months in making enquiries, the application was held not to be too late: *Losh v. Hague*, 1837, 1 W. P. C. 201; see also *Osmond v. Hirst*, 1885, 2 R. P. C. 265. Acquiescence by the plaintiff in the infringement will generally be fatal to the application: *Neilson v. Thompson*, 1841, 1 W. P. C. 280.

Interim injunctions may be granted "quia timet": *Frearson v. Loe*, 1878, 9 Ch. D. 65; *Adair v. Young*, 1879, 12 Ch. D. 13, 20; *United Telephone v. London & Globe Telephone*, 1884, 1 R. P. C. 117; *Proctor v. Bailey*, 1888, 6 R. P. C. 106, 538.

6. In rare cases interim injunctions are granted *ex parte*: *Gardner v. Broadbent*, 1856, 2 Jur. (N.S.) 1041; but only when there is a danger of some property being lost or destroyed, and such cases will be very rare in patent practice: R. S. C., O. L., r. 6.

7. The infringement must be plain and clear to give rise to an application for an interim injunction: *Electric Telegraph Co. v. Nott*, 1847, 2 Coop. 41.

8. Affidavits in support of the application should clearly state the nature of the patent, that it is valid, that the plaintiff was the first and true inventor, and that there has been infringement, and the nature of the infringement should be set forth: *Hill v. Thompson*, 1817, 1 W. P. C. 230; *Whitton v. Jennings*, 1860, 1 Dr. & S. 110; *Mayer v. Spence*, 1860, 1 J. & H. 87. The affidavits

should always be made in the utmost good faith: *Dagleish v. Jarvis*, 1850, 2 Mac. & G. 231 (a copyright case).

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SECT. 8.

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Affidavits in
support of the
application.

9. In granting interim injunctions the Court endeavours to avoid any expression of opinion as to the validity of the patent: *Plimpton v. Malcolmson*, 1875, 20 Eq. 37; *Briggs v. Lardeur*, 1884, 1 R. P. C. 128; *Shillito v. Larmouth*, 1885, 2 R. P. C. 3; *Plimpton v. Spiller*, 1876, 4 Ch. D. 289.

10. An interim injunction is most frequently refused on the defendant undertaking to keep an account till the hearing: *Lister v. Norton*, 1884, 1 R. P. C. 114; *Jackson v. Needle*, 1884, 1 R. P. C. 174; *Copeland v. Webb*, 1862, 11 W. R. 134; *Gardner v. Broadbent*, 1856, 2 Jur. (N.S.) 1041.

11. Sometimes the interlocutory application is ordered to stand over till the hearing without any undertaking to keep an account: *British Tanning Co. v. Groth*, 1889, 7 R. P. C. 1. This is done in order to postpone the consideration of the costs on the interlocutory application, and is preferable where there is some case against the motion, as delay, or acquiescence: *Lister v. Norton*, 1884, 1 R. P. C. 114.

12. Terms upon which interlocutory injunctions are granted.—Upon the grant of an interim injunction, the Court always requires that the plaintiff should give an undertaking to be responsible in damages, supposing it should turn out that it ought not to have been granted: *Fenner v. Wilson*, 1893, 10 R. P. C. 287. In addition to

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Terms upon
which inter-
locutory
injunctions
are granted.

this, other terms are also sometimes imposed. Thus, where it was alleged by the plaintiffs that the defendants were infringing, but by the defendants that the plaintiffs had contracted to supply them with instruments, an interim injunction was granted upon the usual terms as to damages, but also, lest the injunction should ruin the defendants' business, the plaintiffs were compelled to undertake till the hearing to supply the defendants with telephones on the usual terms of payment: *United Telephone Co. v. Tasker*, 1888, 5 R. P. C. 633; see also *Bovill v. Smith*, 1866, L. R. 2 Eq. 459. An undertaking is also sometimes required as to prompt procedure: *Muntz v. Grenfell*, 1842, 2 W. P. C. 91.

13. By consent, the hearing of the interim injunction is sometimes treated as the final hearing to save expense where the point is chiefly one of law: *e.g.*, *United Telephone Co. v. Townshend*, 1885, 3 R. P. C. 10.

14. An interim injunction, when granted, may be dissolved upon application if the plaintiff makes undue delay in prosecuting his action: *Stevens v. Keating*, 1847, 2 W. P. C. 175. Interim injunctions are also granted in case of threats: *Kensington Co. v. Lane-Fox Co.*, 1891, 8 R. P. C. 277; see Chap. XXIX., sect 5.

post, p. 402.

15. Breach of the interim injunction, and committal for contempt: *United Telephone Co. v. Dale*, 1884, 25 Ch. D. 778. If the injunction be against a company, the proper remedy is by a sequestration order against the company, and committal against the directors: *Spencer v. Ancouts Vale Co.*, 1888, 6 R. P. C. 68.

CHAPTER XXVIII.

ACTION FOR INFRINGEMENT.

(*The nature of infringements is dealt with in Chapter XXIV.*) *ante*, p. 189.

1. Courts in which actions can be brought.—Actions on patents must be brought in the superior Courts wherever the “title to the franchise” comes in question. For titles to franchises cannot be tried in the County Court: see County Court Act, 1888, s. 56; and besides, the County Courts have not the machinery for trying a patent action properly: *Reg. v. County Court of Halifax*, 1891, 8 R. P. C. 338. CH. XXVIII.
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In *Procter v. Sutton Lodge Co.* 1887, 5 R. P. C. 184, Day, J., seems to have thought that the Chancery Court of the Duchy of Lancaster was not a superior Court within the meaning of the Patents Act, 1883. But it has been decided that it is; *Reg. v. County Court of Halifax*, 1891, 8 R. P. C. at p. 344; *per* Brett, M.R., and by a recent Act, 53 & 54 Vict. c. 23 (1890), it has now the full powers of a Court of Chancery.

2. Parties: Plaintiffs.—As a general rule it is desirable, and, where an account is claimed, necessary, that all the persons interested in a patent should be joined in a suit for its infringement—as plaintiffs, if they will; if not, then as defendants. For the Court will then be able to assess the damages and divide them, and the account can be taken once for all. A case which illus-

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SECT. 2.Parties:
Plaintiffs.

trates this is *Bergman v. Macmillan and Willeringham*, 1881, 17 Ch. D. 423. M. appointed W. his sole licensee, and assigned to R. half of the profits of his patent, who assigned same to B. M. also assigned other portions to other persons. B. sued M. and W. for an account; M. did not appear. It was argued that W., though liable to account to M., was not liable to account both to M. and to B. (*per Fry, L.J.*: He may not be liable to account, but can he not give the assignee the same account which he has given the principal?). Held, that B. had a right to an account against M., and might have proceeded against him alone, but that if he joined W. he ought also to have joined in the action all the other owners, so that W. would only have to account once, and for this, and other reasons, his bill was dismissed with costs. See also *Westhead v. Keene*, 1838, 1 Beav. 289, 8 L. J. Ch. 89.

If, however, the defendant does not object, one part-owner of a patent can sue alone: *Davenport v. Richards*, 1860, 3 L. T. R. (N.S.) 503; and where the plaintiff is owner of a complete and severable part of the patent, he ought to sue alone: *Dunncliffe v. Mallet*, 1859, 7 C. B. (N.S.) 209, 29 L. J. C. P. 70. If the defendant desires joinder of other owners, so as to free him from liability to multiplicity of actions, he ought to come promptly to have them joined: *Sheehan v. G. E. Rail. Co.*, 1880, 16 Ch. D. 59.

Assignees have the same right to sue as the original patentee: *Boulton v. Bull*, 1795, 2 H. Bl. 464; *Electric Telegraph Co. v. Brett*, 1851, 10 C. B. 838; and the assignees of a bankrupt are in the same position: *Bloxham v. Elsee*, 1827, 6 B. & C. 169. An assignee of a half share in a patent sued thereon in *Anderson v. Patent Oxonite Co.*, 1886, 3 R. P. C. 279.

In order to sue third parties it seems the better opinion that the plaintiff ought to have a regular assignment to him by deed: *Stewart v. Casey*, 1891, 8 R. P. C. 259. But where the action is between assignor and assignee, an agreement to assign would no doubt be treated in equity as an assignment. There is no enactment rendering registration necessary to enable an assignee to sue, but it is better to register before commencing the action. It was formerly necessary: see *Hassall v. Wright*, 1870, L. R. 10 Eq. 509; and *Chollet v. Hoffmann*, 1857, 7 Ell. & Bl. 686.

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SECT. 2.

Parties:
Plaintiffs.

A mortgagor in possession of a patent should sue alone without joining the mortgagee, unless there is reason to fear that the defendant might be prejudiced by his non-joinder: *Van Gelder v. Sowerby Bridge Flour Co.*, 1890, 7 R. P. C. 208. In this case the important rule was laid down that where it is desirable that parties should be joined, the judge *ought* to join them, and not allow the action to be defeated by reason of non-joinder: *per* Bowen, L.J., 215.

But a licensee is not in such a position that he can sue, even though his license be exclusive: *Heap v. Hartley*, 1889, 6 R. P. C. 501; *Derosne v. Fairie*, 1835, 1 W. P. C. 155. But Lord Eldon thought that damages might be given him for losses he might have suffered by the infringement: *Beaumont v. George*, 1815, 1 C. P. C. 294.

The general agent of a foreigner owning English patents is not in a position to sue for infringement of them: *Adams v. N. B. Rail. Co.*, 1873, 29 L. T. R. 367.

There is a case given in the *Times*, March 13, 1884, which decides that a *cestui que trust* of a patent may sue,

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Parties:
Plaintiffs.

even if the patent be registered in the name of his trustee, and trustees could sue in their own name, though, if needful, the *cestui que trust* might be joined. This branch of the subject belongs to the general principles as to joinder of parties, as to which see R. S. C., O. XXI.

3. Parties: Defendants.—The person who really uses the infringing machine is the true defendant, provided he be not a mere workman or servant. Thus, the contractor who infringed a patent for house-building should be the defendant, not the architect: *Denley v. Blore*, 1851, 38 Lond. Jour. 224; *Washburn v. Cunard*, 1889, 6 R. P. C. 398. It has been pointed out elsewhere that a foreign government cannot be made liable for an action of infringement. Directors of a company whose workmen infringe may be liable personally: *Betts v. De Vitre*, 1868, L. R. 3 Ch. 441, 37 L. J. Ch. 325. But assignees who have become so after action cannot of course be joined at defendant's request against the plaintiff's consent: *Briggs v. Lardeur*, 1884, 2 R. P. C. 13.

Third parties, who have agreed to indemnify the defendants even after action brought, may be allowed to appear, but if they have not been regularly made defendants, an injunction cannot be granted against them. If they appear, costs may be given against them: *Edison v. Holland*, 1886, 3 R. P. C. 395, 6 R. P. C. 243.

A plaintiff sued an infringer for using his patented machine. The maker of the infringing machine, who claimed to be making it under a subsequent patent, applied to be joined as a defendant against the will of the plaintiff, and suggested that the defendant would not fight the action properly. Held, that he could not be so joined: *Moser v. Marsden*, 1892, 9 R. P. C. 214.

4. When the action of infringement can be brought.—No action of infringement can be brought until the patent is actually sealed: Patents Act, 1883, s. 15; and then not in respect of infringements committed prior to the publication of the complete specification: sects. 10, 13. Hence the effect of provisional protection is not to enable the patentee to proceed for infringements during its currency, but only to protect him against publication during the nine months which intervene between the sending in of his provisional specification and the sending in of his complete specification.

5. Writ in a patent action.—The service of the writ is the same as in any other action: see S. C. Rules, O. IX. As to service on a London agent of a writ against a Scotch firm, see *Baillie v. Goodwin*, 1886, 3 R. P. C. 285.

Leave to serve the writ in Scotland out of the jurisdiction has been given where the defendant has infringed by sending articles into England. For although the defendant had no place of business in England, yet since an injunction was sought the case came within O. XI., r. 1: *Speckhart v. Campbell*, W. N. 1884, p. 24; see also *Washburn Co. v. Cunard Co.*, 1889, 6 R. P. C. 398. As to these points, see the new rules of the S. C. J. which have just come into force (1893-4).

6. Consolidation of actions.—The consolidation of actions was originally in its essence a temporary stay of all actions but one, made at the request of the defendant or defendants to avoid vexatious multiplicity. The procedure is now under O. XLIX., r. 8, of the S. C. Rules, 1883. Where a plaintiff brought 134 actions against different defendants, they moved in groups to consolidate

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SECT. 6.

Consolidation
of actions.

them. Kindersley, V.-C., refused the application, on the ground that each defendant ought to answer on affidavit and interrogatories, and that they had come too soon. But on appeal Lord Westbury ordered either consolidation or else that an issue should be tried as to the validity of the patent between the plaintiffs and certain selected defendants, reserving to each individual defendant his right to a separate issue as to infringement by him, all the defendants to file affidavits as to their user of the machines, and whence they obtained them: *Foæwell v. Webster*, 1863, 4 De G. J. & S. 77.

In case of consolidation the stay is only temporary, so that unless the plaintiff consents to be bound by the issue of the first test action, he can pursue his actions against the other defendants after the first action has been disposed of.

7. Statement of claim.—The claim usually asks for an injunction, damages, an account, and for the delivery up or destruction of the infringing articles, or for one or more of these. The plaintiffs discontinued an action against the defendants, and paid costs in consequence of evidence given by them. Having ascertained the falsity of this evidence, the plaintiffs brought a fresh action, claiming relief and also the costs which they had paid in the first action. This was struck out as embarrassing under O. XVIII., r. 1, and O. XIX., r. 27: *United Telephone Co. v. Tasker*, 1889, 6 R. P. C. 38.

8. Particulars of breaches.—In an action for infringement, the plaintiff must deliver with his claim (or by order at any subsequent time) particulars of breaches, and his evidence at the trial will be confined to them: Patents Act, 1883, s. 29, sub-ss. 1, 4. The necessity for these particulars arose from the fact that with a compli-

post, p. 455.

cated patent, it was impossible for a defendant to know what part of the patent the plaintiff alleged to have been infringed, and therefore the ordering of particulars was usual under the general powers of the Court long before it became statutory: *Perry v. Mitchell*, 1840, 1 W. P. C. 269; *Electric Telegraph Co. v. Nott*, 1847, 16 L. J. C. P. 174, 4 C. B. 471, and in Chancery; *Curtis v. Platt*, 1861, 35 L. J. Ch. 853; and these particulars could be amended if needful: *Bovill v. Goodier*, 1867, 36 L. J. Ch. 360. For most purposes particulars of breaches may be regarded as forming part of the statement of claim: *United Telephone Co. v. Smith and Mitchell*, 1889, 38 W. R. 70.

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Particulars of
breaches.

The following are the principles which appear to have guided the Courts in ordering particulars of breaches:—

(a) The plaintiff must specifically point out what part of his invention has been infringed: *Haslam v. Hall*, 1887, 4 R. P. C. 203; *Germ Milling Co. v. Robinson*, 1884, 1 R. P. C. 219; *Needham v. Oxley*, 1863, 1 H. & M. 248. And, if need be, he must refer to the pages and lines of his specification: *Wren v. Weild*, 1869, L. R. 4 Q. B. 213, 38 L. J. Q. B. 88; *Lamb v. Nottingham Manufacturing Co.*, 1874: Seton's Decrees, ed. 4, p. 349.

In the case of a simple patent it is enough if the plaintiff specifies which of the claims he says are infringed, without giving special references to lines and words in the specification: *Cheetham v. Oldham*, 1888, 5 R. P. C. 624; *Batley v. Kynoch*, 1874, L. R. 19 Eq. 232; *Church Engineering Co. v. Wilson*, 1886, 3 R. P. C. 123; *Moseley v. Victoria Rubber Co.*, 1886, 3 R. P. C. 357; *Ehrlich v. Ihlee*, 1887, 5 R. P. C. 41. Where the plaintiffs specify the claims which they say have been infringed, they are not bound to say what it is they mean by their claims, so as to specify whether they claim a particular

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(a) The plaintiff must specifically point out what part of his invention has been infringed.

described lamp having certain features, or all lamps which have these features. In short, while they are compelled to say what claims have been infringed, they are not, for the defendant's convenience, bound to put an interpretation upon those claims and explain them: *Wenham Co. v. Champion Co.*, 1891, 8 R. P. C. 22; see also *Cassella v. Levinstein*, 1891, 8 R. P. C. 473.

(b) The plaintiff must specify what portions or characteristics of the articles complained of infringe his patent: *Jones v. Lees*, 1856, 25 L. J. Ex. 241; *Wren v. Weild*, 1869, L. R. 4 Q. B. 213, 38 L. J. Q. B. 88. Where, however, the article complained of is simple, and the nature of the alleged infringement is obvious, this need not be done. Thus, where some cartridges had been made an exhibit, it was held enough to say that they were an infringement: *Batley v. Kynoch*, 1874, L. R. 19 Eq. 229; *Haslam v. Hall*, 1887, 4 R. P. C. 203.

(c) The plaintiff must give such instances of infringement as he knows of, and this may be done by reference to some actual article or exhibit in the action: *Batley v. Kynoch*, 1874, L. R. 19 Eq. 229; *Tilghman's Patent Sand Blast Co. v. Wright*, 1884, L. R. 1 R. P. C. 103; *Maudleberg v. Morley*, 1893, 10 R. P. C. 256.

But when the plaintiff has indicated a type of infringing article, he may allege in general terms that the defendant has made or sold it without specifying each instance of sale, which will be better in the defendant's knowledge than the plaintiff's: *Talbot v. La Roche*, 1854, 15 C. B. 310; *Russell v. Hatfield*, 1885, 2 R. P. C. 144; *Tilghman's Patent Sand Blast Co. v. Wright*, 1884, 1 R. P. C. 103.

(d) But the plaintiff is not allowed to group together generally infringements which may differ in type, for this might lead to the defendant coming

prepared to meet one alleged infringement but being required to defend another: *Patent Typefoundry Co. v. Richards*, 1859, 2 L. T. (N.S.) 359. In this view the words, "In particular, by way of illustration," are embarrassing, and ought not to be allowed: *Church Engineering Co. v. Wilson*, 1886, 3 R. P. C. 123. Examples of particulars of breaches will be found in the Forms in the Appendix.

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SECT. 8.

(d) But the plaintiff is not allowed to group together generally.

9. Amendment of particulars of breaches.—Amendments may be made with the leave of the Court or a judge at the instance of the party who has delivered them, or of his opponent: Patents Act, 1883, s. 29, sub-s. 5. The rules as to the amendment of particulars of breaches are very similar to those for the amendment of particulars of objections: sect. 14.

post, p. 455.

post, p. 375.

10. The defence.—The defence to an action of infringement is usually a formal document raising the questions of infringement, novelty, that plaintiff is not the first and true inventor, utility, and that plaintiff is not the assignee, &c. See Form of Defence in the Appendix.

post, p. 576.

11. Particulars of objections—old practice.—Prior to the year 1834 the defendant, by pleading "not guilty," could raise every defence to a patent, but the rules in that year required special pleas to raise objections to the validity of the patent. The Act of 1835 (5 & 6 Wm. 4, c. 83, s. 5) required particulars, but the particulars ordered were often of a very unsatisfactory kind: see *Bulnois v. Mackenzie*, 1837, 1 W. P. C. 260; *Fisher v. Dewick*, 1838, 1 W. P. C. 267; *Losh v. Hague*, 1838, 1 W. P. C. 203 n.; *Galloway v. Bleaden*, 1839, 1 W. P. C. 268 n.; *Gillett v. Wilby*, 1839, 1 W. P. C. 270; *Carpenter v. Walker*,

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SECT. 11.

Particulars of
objections—
old practice.

1 W. P. C. 268 n.; *Neilson v. Harford*, 1841, 8 M. & W. 806, 1 W. P. C. 331; *Walton v. Bateman*, 1842, 1 W. P. C. 616; *R. v. Walton*, 1842, 2 Q. B. 969; *Macnamara v. Hulse*, 1842, 2 W. P. C. 128 n.; *Heath v. Unwin*, 1842, 10 M. & W. 687; *Russell v. Ledsam*, 1843, 11 M. & W. 647; *Bentley v. Keighley*, 1844, 7 M. & G. 652; *Jones v. Berger*, 1843, 1 W. P. C. 544; *Leaf v. Topham*, 1845, 14 M. & W. 146; *R. v. Mill*, 1850, 10 C. B. 379; *Betts v. Walker*, 1850, 14 Q. B. 363.

The Patents Act, 1852, s. 41, made the requirements as to particulars of objections stricter, and under this Act the following cases were decided:—

Holland v. Fox, 1853, 1 C. L. R. 440, 1 W. R. 448; *Palmer v. Cooper*, 1853, 9 Ex. 231; *Palmer v. Wagstaffe*, 1853, 8 Ex. 840, 22 L. J. Ex. 295; *Hull v. Bollard*, 1856, 1 H. & N. 134; *Chollet v. Hoffman*, 1857, 7 E. & B. 686; *Curtis v. Platt*, 1863, 8 L. T. (N.S.) 657; *Renard v. Levinstein*, 1864, 11 L. T. (N.S.) 505, 13 W. R. 229; *Daw v. Elcy*, 1865, L. R. 1 Eq. 38; *Bovill v. Goodier* 1865, L. R. 1 Eq. 35; *Morgan v. Fuller*, 1866, L. R. 2 Eq. 297; *Bovill v. Smith*, 1866, L. R. 2 Eq. 459; *Penn v. Bibby*, L. R. 1 Eq. 548; *Bovill v. Goodier*, 1867, 36 L. J. Ch. 360; *Grover v. Wilson*, 1870, W. N. 1870, p. 78; *Finnegan v. James*, 1874, L. R. 19 Eq. 72; *Wilson v. Gann*, 1875, 23 W. R. 546; *Flower v. Lloyd*, 1876, 45 L. J. Ch. 746, in which Field, J., said: "I cannot follow the cases which have been cited; we have advanced in our ideas since they were decided" (viz., since 1853): see *Solicitors' Journal*, 1876, p. 860; *Baird v. Moule*, 1876, 17 Ch. D. 139 n.; *Sugg v. Silber*, 1877, 2 Q. B. D. 493; *Edison Telephone Co. v. India Rubber Co.*, 1881, 17 Ch. D. 137; *Birch v. Mather*, 1883, 22 Ch. D. 629; *Cropper v. Smith*, 1885, 10 App. Cas. 249, 2 R. P. C. 17.

12. Practice as to particulars of objections under the Patents Act, 1883, s. 29.—This Act provides for particulars being given of any objections in support of the statement of defence: sub-ss. 2, 3; and that except by leave at the hearing no evidence shall be given of any alleged objection of which particulars are not so delivered: sub-s. 4, see *Britain v. Hirsch*, 1888, 5 R. P. C. 230. In *Hill v. Adams*, 1893, 10 R. P. C. 105, leave to raise a new objection at the hearing was given, but the case was postponed. In *Peckover v. Rowland & Co.*, 1893, 10 R. P. C. 118, leave to amend was refused. It also provides for amendment of particulars: sub-s. 5; and necessitates a certificate by the judge that they were reasonable and proper, in order that the costs of them may be allowed: sub-s. 6.

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post, p. 339.

If the defendant objects to part only of the invention as old or as defective, he should, in his particulars, specify the part to which he objects.

The particulars sometimes take a hypothetical form, as, for example, in *Hocking v. Hocking*, 1886, 3 R. P. C. 291. "If such a construction is put upon the claims . . . as would include within them the condensers, etc., . . . used by the defendant, such construction would cause the said claims to be bad for want of novelty," and then followed the alleged anticipations. On a summons to strike this out as embarrassing, the Court of Appeal refused to do so, saying that the worst that could be said of such a form was that it was not necessary.

Where a defendant objects on the ground of prior *general* user, he must give instances if he knows of them, so as to put the plaintiff on enquiry.

The following are the kinds of particulars most usually employed:—

see also the
forms in the
Appendix,
pp. 576 et seq.

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Practice as to
particulars of
objections
under the
Patents Act,
1883, s. 29.

(a) **Denial of plaintiff's title.**—“*That the plaintiff is not the patentee, or that the patent has lapsed through non-payment of fees.*”

(b) **Denial of infringement.**—“*That the defendant has not infringed the letters patent in the statement of claim mentioned, nor any of them.*” Under this plea of course no objections to the validity of the patent can be raised: *Russell v. Crichton*, 1837, 1 W. P. C. 677, n.; *Househill Co. v. Neilson*, 1843, *ibid.*

(c) **Plaintiff not the true inventor.**—“*That the plaintiff was not the true and first inventor of the alleged invention in respect of which the letters patent in the statement of claim mentioned were alleged to have been granted.*” This form has been used very loosely, but the true meaning is not that the invention has been anticipated, but that the patentee got the invention from some one else. It should therefore only be used for the purpose of that defence (*per Kekewich, J.*): *Thomson v. Macdonald & Co.*, 1890, 8 R. P. C. 8; *Househill Co. v. Neilson*, 1843, 1 W. P. C. 689. It is submitted that, if it is so used, the name of the person from whom the invention is alleged to have been obtained ought to be given; see *e.g.*, *Siddell v. Vickers*, 1887, 5 R. P. C. 85. It was declared unnecessary in *Russell v. Ledsam*, 1843, 11 M. & W. 647, 12 L. J. Ex. 439, but that was under the old law.

(d) **Invention not proper subject-matter for patent.**—“*That the said alleged invention is not the proper subject-matter of letters patent.*” This would be on the ground either that the patent is for a principle, or else that it is for some mathematical object, as for a mathematical theory, or again that it is contrary to public policy. In each of these cases the reason should be stated in the objection.

(e) **The Patent a derogation from a former grant.** —“*That the said alleged letters patent are void by reason that the invention in respect of which they purport to be granted formed the subject of a grant to (name, date, and number), which said grant was prior to the alleged grant to the plaintiff.*” This defence could only be useful in a case where the plaintiff’s patent had been applied for previously to the publication of the specifications of the prior patent, and thus where the specifications of the prior patent could not be used as an anticipation. It is no doubt a good defence, but it has this peculiarity, that the plaintiff would probably reply that the prior patent, from which his is alleged to be a derogation, is bad. Of course he would not dare to set up its invalidity on the ground of want of novelty, for that would be to destroy at the same time the very patent upon which he had founded his action. But he might attack it on the ground of disconformity or fraud, or almost on any other ground. In this case the question of the validity of the prior patent would then be fought out in the absence of the patentee. This would not be very satisfactory. No case has as yet settled the mode of procedure, but the point very nearly arose in *Hill v. Adams*, 1893, 10 R. P. C. 102. The mode of pleading adopted there was the allegation that the acts constituting the alleged infringement were done by virtue of the prior patent, for in this case the prior patent belonged to the defendant.

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particulars of
objections
under the
Patents Act,
1883, s. 29.

ante, pp. 8, 37.

(f) **Want of utility.**—“*That the said alleged invention (or some specific part thereof) was not useful, or not of public utility.*” No details are required to be given here specifying the particular points wherein the invention is not useful, and with regard to this particular of

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1883, s. 29.

objection there do not appear to be any decided cases. It is as a rule not very easy to procure the invalidation of a patent for want of utility.

(g) **Want of novelty.** (See Patents Act, 1883, s. 29, ss. (31).)

(1.) **Through public common knowledge.**—“*That the said alleged invention was not new or the proper subject of letters patent, having regard to the common and public knowledge at the date of the aforesaid patent.*” No detailed allegations of prior publications are here needful, nor are they proper, and if inserted would be held embarrassing. For the gist of this objection is not any particular anticipation, the true meaning of the objection is public *general* knowledge: *Holliday v. Heppinstall*, 1889, 6 R. P. C. 320; *Philips v. Irel Cycle Co.*, 1890, 7 R. P. C. 82; *Automatic Weighing Machine Co. v. Knight*, 1889, 6 R. P. C. 302; *Boyd v. Horrocks*, 1886, 3 R. P. C. 281 (objection to second particular); *Siemens v. Karo*, 1891, 8 R. P. C. 377. At the trial, under this objection, though evidence of general knowledge could be given, and perhaps common and well-known scientific books referred to, yet no prior specifications, or particular or rare books, could be adduced in evidence as these ought to have formed the subject of separate particulars. *Solvo Laundry Co. v. Mackie*, 1893, 10 R. P. C. 68 (leave given to amend particulars). In *Siemens v. Karo*, above quoted, the defendant objected “*By the general use of . . . for several years prior to the patent.*” This was objected to, and struck out by consent as being embarrassing, for it was really a plea of *user*, not of general knowledge, in which case particulars of that user ought to be given.

(2.) Through prior publication.—“That the said invention was not new at the date of the said letters patent, but was published within the realm before the date thereof, in and by the publications, and by the persons at the times and places, and in the manner following . . . ”

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Practice as to
particulars of
objections
under the
Patents Act,
1853, s. 29.

(a) By a prior specification.—By the specifications of letters patent, No. , of 18 , granted to , page , line .

In many cases it has been held that the pages and lines must be set out. For prior publication in a printed book is an objection, not merely evidence of an objection, and hence must be specified: *Jones v. Berger*, 1843, 1 W. P. C. 550; *Fowler v. Gaul*, 1886, 3 R. P. C. 247; *Boyd v. Horrocks*, 1886, 3 R. P. C. 285; *Boyd v. Farrar*, 1887, 5 R. P. C. 36; *Harris v. Rothwell*, 1886, 3 R. P. C. 246. But later cases have dispensed with this necessity where the parts of the specification alleged as an anticipation are made clear and distinguishable: *Holliday v. Heppenstall*, 1889, 6 R. P. C. 320. Each case must stand on its own ground: *Siemens v. Karo*, 1891, 8 R. P. C. 378. Thus, a reference to a specified drawing or figure, and “that part of the letter-press which refers to it,” has been held sufficient (*ibid.*, p. 379). The defendant, where he honestly cannot distinguish a part of the anticipating specification, is allowed to rely on “the whole”: *Sidebottom v. Fielden*, 1891, 8 R. P. C. 266; *Nettlefolds v. Reynolds*, 1891, 8 R. P. C. 410. In all cases of particulars, if the defendant objects to part only of the invention as old or as defective, he should specify the part to which he objects: *London & Leicestershire Hosiery Co. v. Higham*, 1883, Lawson, 498, approved in *Boyd v. Horrocks*, 1886, 3 R. P. C. 288: see also *Harris v. Rothwell*, 1886,

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particulars of
objections
under the
Patents Act,
1883, s. 29.

3 R. P. C. 243; *Boyd v. Farrar*, 1887, 5 R. P. C. 33;
Law v. Ashworth, 1890, 7 R. P. C. 89.

(β) **By a book or other publication.**—“*By an article in (translated by), published at , date , No. , volume , page (or by drawings).*”

The parts of the book must be specified: *Harris v. Rothwell*, 3 R. P. C. 246. The practice of giving too many references of anticipation in the particulars when only a very few will be used is condemned by Kekewich, J., in *Thomson v. Batty*, 1888, 6 R. P. C. 96. If the instances are so numerous as to amount to public knowledge, it is better to plead that distinctly (*per Kekewich, J.*): *Phillips v. Ivel Co.*, 1890, 7 R. P. C. 82. On the other hand, in *Cole v. Saqui*, 1888, 5 R. P. C. 496, Kekewich, J., compared a large number of specified anticipations to “reserve forces” not called into action, but which “it was prudent to have at hand.”

(γ) **By user.**—“*By the (use, manufacture, sale, exposure for sale) of at on , etc. (or of models.)*”

A sufficient description of the anticipating articles must be given. It is not enough to say merely “by the sale of articles”: *Boyd v. Farrar*, 1887, 5 R. P. C. 35. Nor would it be enough to say “by the use of ‘the Wenham Lamp,’” which might mean any lamp made by Wenham: *Siemens v. Karo*, 1891, 8 R. P. C. 379. On the other hand, it is not needful to describe minutely each of the alleged anticipating articles: *Sidebottom v. Fielden*, 1891, 8 R. P. C. 272 (*Boyd v. Farrar* distinguished). It is not enough to say “*by the manufacture, sale, use, or public exhibition of wire rope made*

according to the alleged invention by . . . from 1832 to 1862." Better and more precise particulars must be given: *Smith v. Lang*, 1890, 7 R. P. C. 150; *Palmer v. Wagstaffe*, 1853, 8 Ex. 840, decided that under a general objection of "user in London and its vicinity," detailed instances need not be given; but in *Alliance Pure White Lead Syndicate v. MacIvor*, 1891, 8 R. P. C. 321, an interrogatory as to the particular instances was allowed. The true distinction seems to be whether the plea is only one of "general knowledge," or whether it is really a plea of public user in a particular place, such as London. In the former case, as pointed out above, detailed particulars are impossible, but in the latter they should be given: see p. 370, *supra*.

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SECT. 12.

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Practice as to
particulars of
objections
under the
Patents Act,
1883, s. 29.

(h) Specification defective.

(1.) Disconformity.—“*That the alleged invention described in the complete specification (as amended), is a different invention from that described in the provisional specification (and title) in that . . .* (here the disconformity must be specified): *Anglo-American Brush Co. v. Crompton*, 1886, 4 R. P. C. 27; *Boyd v. Horrocks*, 1886, 3 R. P. C. 288 (objection to tenth particular); *Fisher v. Dewick*, 1838, 1 W. P. C. 551, n.; and see “Provisional Specification,” Chap. VII., s. 3; Chap. VIII., s. 8.

ante, pp. 170,
185.

(2.) Disconformity by amendment.—“*That the alleged invention described in the complete specification as amended is a different invention from that described in the provisional specification, and in the complete specification as originally drawn and accepted, in that . . .*” This objection is directed against an amendment, which alters the scope of the invention; see *Farben Fabrik v. Bowker*, 1891, 8 R. P. C. 391, line 52.

ante, p. 225.

(3.) New not distinguished from old.—“*That the*

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particulars of
objections
under the
Patents Act,
1883, s. 29.

plaintiff did not by his complete specification or his claims sufficiently distinguish which of the parts he claimed to have invented from those which he admits to be old . . ." (Here specify parts complained of): *Fisher v. Dewick*, 1838, 1 W. P. C. 551, n.

(4.) **Ambiguity.**—“*That the complete specification of the plaintiff is vague and ambiguous in its terms, and does not sufficiently or intelligibly describe the alleged invention, and that the same is calculated to mislead, in that . . .*” Particulars should here be given of the points wherein the specification is ambiguous: *Farben Fabrik v. Bowker*, 1891, 8 R. P. C. 391.

(5.) **That the letters patent contain false suggestions.**—These must be specifically set out; most of them, however, come more properly under other titles.

(6.) **Insufficient description.**—“*That the complete specification is insufficient inasmuch as it does not contain sufficient direction to enable a workman skilled in trade to . . .*” (Here details should be given): *Crompton v. Anglo-American Brush Co.*, 1887, 4 R. P. C. 197.

(7.) **Most beneficial method known to inventor not described.**—“*That the plaintiff in his complete specification did not state the most beneficial method with which he was then acquainted of practising his said invention . . .*” Held enough in *Jones v. Berger*, 1843, 5 M. & G. 208. This case was not followed in *Russell v. Ledsam*, 1843, 11 M. & W. 651, and it is submitted that now it would be necessary to specify wherein the directions were insufficient.

13. Amendment of defence and particulars.—A defence denying infringement may be amended so as to impeach the patent, after the action is set down for trial, on

ante, p. 185.

ante, p. 188.

payment of all costs, in spite of the fact that the validity of the patents has been previously affirmed in a court of law: *United Telephone Co. v. Bassano*, 1885, 2 R. P. C. 70.

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SECT. 13.

Amendment
of defence and
particulars.

Striking out pleas.—The court, under R. S. C., O. XIX., r. 27, can strike out an embarrassing plea or objection: *McDougall v. Partington*, 1890, 7 R. P. C. 216, but, unless the objection be really embarrassing, it need not be struck out, though it may be considered unnecessary: *Hocking v. Hocking*, 1886, 3 R. P. C. 291.

14. Amendment of particulars of objections before hearing.—This rests on Patents Act, 1883, s. 29, sub-s. 5, and in *Holste v. Robertson* it was said that the Court would at any time allow the defendant to raise a fresh issue on discovery of facts which he could not with due diligence have discovered before: 1876, L. R. 4 Ch. D. 9; *Tildsley v. Harper*, 1878, L. R. 10 Ch. D. 393. Amendments may be made at the instance of either party. The particulars of objection may be amended after the cause is in the list for trial, or by adding fresh instances of anticipation, on giving the plaintiff full opportunity to inspect the newly-particularized machines, and reserving plaintiff's rights at the trial, if he should be embarrassed: *Otto v. Sterne*, 1885, 2 R. P. C. 139; *Baird v. Moule's Earth Closet Co.*, 1876, 17 Ch. D. 139, and *Aveling v. Maclaren*, 1880, 17 Ch. D. 139. But sometimes the amendment is only allowed on terms that the plaintiffs may have an option to discontinue with their costs: *Edison Telephone Co. v. India Rubber Co.*, 1881, 17 Ch. D. 137. In *Ehrlich v. Ihlee*, 1887, 4 R. P. C. 115, after the action had been set down for trial, the plaintiff was to have six weeks after amendment to elect to discontinue, in which case he was to have his costs from the date of

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Amendment
of particulars
of objections
before
hearing.

the defendant's first delivery of particulars, but was to pay defendant the other costs of the action (see the order, p. 119). In *Parker v. Maignen's Filtre Rapide Co.*, 1888, 5 R. P. C. 207, after the cause had been entered for trial, an order for amendment was made on payment of costs. In *Darrah v. Purser*, 1889, 6 R. P. C. 365, an order for leave to amend was made on terms that the plaintiffs should have four weeks time to discontinue as in the case of the *Edison Telephone Co. v. India Rubber Co.* (*supra*); see also *Wilson v. Gann*, 23 W. R. 546; *Morris v. Coventry Co.*, 1891, 8 R. P. C. 353.

The application is usually made at Chambers in the Queen's Bench Division, Judicature Act, 1883, s. 39; R. S. C. 1883, O. XIX., r. 7, and to the Court on motion in Chancery.

15. Amendments at the hearing.—At the trial, either an amendment can be allowed, or else the Court, or the Court of Appeal, can permit the evidence to extend beyond the particulars: *Britain v. Hirsch*, 1888, 5 R. P. C. 231. But where the defendant did not shew that with reasonable care he could not have discovered the new facts earlier, leave to amend at the trial was refused: *Moss v. Malins*, 1886, 33 Ch. D. 603, 35 W. R. 165. An amendment during the trial was reluctantly allowed in *Blakey v. Latham*, 1889, 6 R. P. C. 36.

In Chancery a defendant was allowed to amend his particulars of objections at the hearing, even after the close of the plaintiff's case, but on payment of all costs: *Renard v. Levinstein*, 1864, 11 L. T. (N.S.) 505, 13 W. R. 382; and a somewhat similar leave was given in *Daw v. Eley*, 1865, L. R. 1 Eq. 38. Amendment at the hearing is a question of discretion, and when it appeared clear that

the defendant's amendment would not be of avail, and that the case was really undefended, leave to amend was refused: *Edison Electric Light Co. v. Shippey*, 1887, 4 R. P. C. 471. In *Pascall v. Toope*, the defendants in their objections and interrogatories had alleged that a certain method was in common use, which had anticipated the plaintiff's patent. At the trial they gave evidence of another method which seemed an anticipation. Held, that they might amend their particulars—action to stand over—and plaintiff to have leave to discontinue: 1890, 7 R. P. C. 125.

It is dangerous for a plaintiff not to insist upon the limitation and definition of the defendant's particulars of objections, for if he leave them vague, he may be surprised at the trial: *Sugg v. Silber*, 1876, L. R. 2 Q. B. D. 493; *Neilson v. Harford*, 1841, 1 W. P. C. 332; *Hull v. Bollard*, 1856, 1 H. & M. 137, 25 L. J. Ex. 304; *Curtis v. Platt*, 1866, 35 L. J. Ch. 852.

16. Amendment of particulars of objection on appeal.—This will not often be allowed, and never except in case of discovery of new evidence, which could not with reasonable diligence have been previously obtained. In a new trial, the defendant was always considered entitled to amend: *Bovill v. Goodier*, 1865, 36 L. J. Ch. 369. But in *Hinde v. Osborn*, a motion for leave to adduce fresh evidence alleged to have been discovered since the trial, and raising a new issue as to novelty, was dismissed: 1885, 2 R. P. C. 45. The Court, however, said that had it been the case of a lost document suddenly discovered it might have been allowed, but not mere anticipations in books, which were sought for, but could not before the trial be found.

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SECT. 15.

Amendments
at the
hearing.

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SECT. 16.

Amendment
of particulars
of objection
on appeal.

When an order to amend particulars of breaches or objections is not obeyed, the proper course is to apply to strike out the particulars which were ordered to be amended.

The other party has (unless it is otherwise ordered) the same time to plead from the delivery of the amended particulars, as he would have had from the return day of the summons: R. S. C., O. XIX., r. 8.

17. Inspection : Old practice.—As early as the year 1815 Lord Eldon intimated that the plaintiff might be empowered by a Court of Chancery to inspect the machines of a defendant, who was alleged to be making lace which must have been made by an infringing machine: *Bovill v. Moore*, 1815, 2 Coo. C. C. 56 n. Similar inspection was ordered in *Brown v. Moore*, 1816, 3 Swan 264; *Russell v. Cowley*, 1832, 1 W. P. C. 458; *Morgan v. Seaward*, 1835, 1 W. P. C. 169; and in *Russell v. Crichton*, 1837, 1 W. P. C. 677; viewers were appointed to inspect, who were not to reveal what they saw, except for the purposes of the action: 1837, 15 Dec. of Court of Sessions, 1270.

By the Patents Act, 1852, s. 42, this power was extended to courts of law on the application of plaintiff or defendant, under which Act were decided: *Amies v. Kelsey*, 1852, 22 L. J. Q. B. 84; *Shaw v. Bank of England*, 1852, 22 L. J. Ex. 26; *Harrison v. Spire*, 1853, 22 L. T. 92; *Jones v. Lees*, 1856, 25 L. J. Ex. 241; *Meadows v. Kirkman*, 1860, 29 L. J. Ex. 205; where inspection was refused on the defendant swearing that he had no such machinery as was suggested. In *Patent Type-founding Co. v. Lloyd*, 1860, 5 H. & N. 192, 29 L. J. Ex. 207, the Court was asked not merely to give inspection, but to

allow samples to be taken. The Court doubted its power, but a Chancery Court made the order: Johns. 727. In *Davenport v. Jepson* the plaintiffs were empowered to take samples, and to work the defendant's machines; 1862, 1 N. R. 307. In the *Singer Machine Co. v. Wilson*, it was treated as of course that inspection should be allowed when a *prima facie* case had been made out: 1865, 5 N. R. 505; see also *Neilson v. Betts*, 1871, L. R. 5 H. L. 11. In *Piggott v. Anglo-American Telegraph Co.*, 1868, 19 L. T. (N.S.) 46, inspection was refused where it would have disclosed important secrets, and where plaintiffs could have no difficulty in otherwise proving the infringement. Where plaintiff and defendant are competitors in trade the order to inspect, it was thought, should not be given except to an expert to report to the Court: *Flower v. Lloyd*, 1876, 10 Ch. D. 327; and the Court will not necessarily allow that report to be seen: *Plating Co. v. Farquharson*, 1883, Griff. 187. In *Morgan v. Seaward*, 1835, 1 W. P. C. 169, inspection was given of paddle-wheels made, or to be made, by defendants, under a contract, which wheels were alleged by plaintiffs to be an infringement.

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Old practice.

18. Inspection: Practice under Patents Act, 1883, s. 30.—The powers under this Act are wider, and under R. S. C., O. xxx., r. 3, not only may samples be taken, observations made, and experiments conducted, but any lands or buildings in the possession of any party may be entered for the purpose: R. S. C., O. L., r. 3. Moreover, orders may be made for the inspection of the alleged infringing articles, or the articles alleged to be anticipations, or else the articles made by the plaintiff according to the patent sued on, provided that those articles are in the

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possession of the parties. For the inspection order would not apply to strangers to the suit, nor to the witnesses (see *infra*).

There is thus hardly any limit to the powers of the Court to grant inspection of machines in the possession or on the lands of any party to the action, and to examine and experiment as may be deemed necessary. In the *Germ Milling Co. v. Robinson*, the plaintiffs applied for inspection of the defendant's mills. This was refused, as the plaintiffs could make out no *prima facie* case of infringement. The defendants then consented to the inspection, and then asked that they might inspect the plaintiffs' processes. The plaintiffs did not allege the possession of any trade secret. Ordered that an expert, and the defendants' solicitor, might inspect and take samples, and that the mills should be worked before them: 1884, 1 R. P. C. 217; 1885, 3 R. P. C. 11. In *Drake v. Muntz Metal Co.*, 1886, 3 R. P. C. 43, Bacon, V.-C., seemed to think he had no right to order the machines to be worked for the experts appointed to inspect the defendants' processes. In *Moore v. Bennett*, where most conflicting evidence had been given as to whether a machine would work or not, the Court of Appeal ordered a thorough trial in the presence of an expert and both parties, and acted upon his report: *Moore v. Bennett*, 1884, 1 R. P. C. 134. Inspection by the defendants of the plaintiff's glass bottles was ordered, where the utility of the plaintiff's invention was denied by the defendants—the machinery to be worked if necessary: *Rylands v. Ashley's Patent Bottle Co.* 1890, 7 R. P. C. 175. In *Cheetham v. Oldham* it was held, that to entitle a party to inspection a *prima facie* case must be made out: 1888, 5 R. P. C. 617. Where a plaintiff

applied to inspect the defendant's alleged anticipations of the plaintiff's patent in the possession of the defendant's witnesses; held, that there was no jurisdiction to make it, except by consent, and this ruling was upheld by the Court of Appeal: *Garrard v. Edge*, 1889, 6 R. P. C. 374. But where the alleged anticipations are in his custody a defendant must produce them for inspection: *Sidebottom v. Fielden*, 1891, 8 R. P. C. 266; and where the anticipating articles were in the custody of the Court as exhibits, the Court ordered inspection of them to be given to the plaintiff. But as it turned out that they were exhibits in another action, the Court thought that the parties in that other action ought to consent: *Smith v. Lang*, 1890, 7 R. P. C. 151. Hence then, it appears that the party applying for inspection must make out a strong case for the belief that articles exist, which are infringements, or which ought to be inspected, and that they are in the other party's possession, and that they are material to his case, together with the grounds for his belief: *Germ Milling Co. v. Robinson*, 1884, 1 R. P. C. 217. This may be met by the demand that only an independent expert shall see them, and report to the Court: *Flower v. Lloyd*, W. N. 1876. p. 169; *Plating Co. v. Farquharson*, 1883, Griff. 187; *Hill v. Tombs*, 1881, Lawson, 499.

The application may be made at any stage of the action, and is obtained on motion or summons at Chambers in the Queen's Bench Division: S. C. R., O. xxxiv., r. 12; O. xxxv., r. 6; O. liv., r. 12; O. lv., r. 15; and *Frearson v. Loe*, 1878, 26 W. R. 138. Delay in applying is no objection to the granting it: *Patent Type-founding Co. v. Walter*, 1860, Johns, 727.

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19. Discovery and production of documents.— There is nothing special about discovery and inspection of documents in a patent action. Thus the case of *Haslam v. Hall*, 1887, 5 R. P. C. 1, decided that documents other than those which have come into existence for the purpose of the litigation ought to be produced. *Bown v. Sansom*, 1888, 5 R. P. C. 510, decided that affidavits and shorthand notes used in a former action, relative to the same patent, must be produced: *Westinghouse v. Midland Rail. Co.*, 1883, 48 L. T. (N.S.) 98, 462. Where discovery has not been pressed for certain documents in Chambers, the Court of Appeal does not willingly extend the order made by the Court below: *Thomson v. Hughes*, 1890, 7 R. P. C. 190. When the validity of a patent is questioned, the plaintiff is not at liberty to see books or documents which would tend to shew a number of acts of infringement, until the validity of the patent is established. Hence application for such documents would be refused, but without prejudice to an application at the trial, or at some later stage. "It may over and over again occur that it would be a very oppressive and wrong thing to order a defendant, who disputes the validity of the patent, to produce to a rival in trade the details of what he has had, simply because he is alleged to have infringed" (*per* Lindley, L.J.): *Rawes v. Chance*, 1890, 7 R. P. C. 281; see *Lister v. Norton*, 1885, 2 R. P. C. 68; *Smith v. G. W. Rail. Co.*, 1854, 3 W. R. 69.

20. Interrogatories.—The principles governing interrogatories in patent cases are the same as those in ordinary actions with some modifications, chiefly with the purpose of protecting genuine trade secrets.

The proper time for interrogatories is after issue joined: *Jones v. Pratt*, 1861, 30 L. J. Ex. 365.

Interrogatories as to the existence of documents are not allowed where a conclusive and complete affidavit of documents has been filed: *Hall v. Trueman*, 1885, 29 Ch. D. 307; but where the affidavit appears inconclusive, interrogatories, not of a roving, but of a definite character, as to particular documents believed to exist, may be permissible: *Moseley v. Victoria Rubber Co.*, 1886, 3 R. P. C. 355; *Edison v. Holland*, 1888, 5 R. P. C. 217.

Interrogatories may enquire into the same matter as particulars, so that it is no ground for refusing to answer an interrogatory to say that it would be a proper matter for particulars: *Birch v. Mather*, 1883, 22 Ch. D. 629. The interrogatories must only enquire into questions of fact, not into the details of the evidence by which the facts will be established: *Delta Metal Co. v. Maxim Nordenfelt*, 1891, 8 R. P. C. 169. But where a defendant pleads as anticipation, "Prior user in London and its vicinity," he must answer interrogatories as to the names and addresses of the particular persons who have used the invention: *Alliance Pure White Lead Syndicate v. MacIvor*, 1891 8 R. P. C. 321. Here the case of *Palmer v. Wagstaffe*, 1853, 8 Ex. 840, was cited to shew that particulars of a similar nature need not be given. But that was an old case, and North, J., decided that each case must stand on its own footing. For form of interrogatories see *Thomas v. Tillie*, 1866, 17 Ir. C. L. R. 783.

A patentee may by interrogatories be asked to indicate what portions of his patent he says are infringed; but neither plaintiff nor defendant can be asked in answers to interrogatories, or in particulars, to tie himself down to a particular construction of a patent:

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Moseley v. Victoria Rubber Co., 1886, 3 R. P. C. 352. Compare also *Wenham Co. v. Champion Co.*, 1890, 8 R. P. C. 22; *Delta Metal Co. v. Maxim Nordenfelt*, 1891, 8 R. P. C. 169. It will from this case be noticed that a good deal depends upon the form in which the questions are put: see also cases given in Chap. XXVIII. sect. 8., "Particulars of Breaches"; and see *Hoffman v. Postill*, 1869, 4 Ch. 680.

Where the utility of a patent machine is denied, a plaintiff may be asked whether he has successfully made articles with a machine made according to his patent, or whether it has been necessary to introduce alterations or additions, but he is not obliged to answer what those alterations or additions were, for that is his secret, and not necessarily relevant: *Rylands v. Ashley's Patent Bottle Co.*, 1890, 7 R. P. C. 175; *Renard v. Levinstein*, 1864, 11 L. T. (N.S.) 505; *Rolls v. Isaacs*, 1878, W. N. 37; *Crossley v. Tomey*, 1876, 2 Ch. D. 533.

If a defendant admits infringement, but rests his case on invalidity of the patent, he will not, before the plaintiff's rights have been established, be compelled to reveal the names of the persons who bought from him: *Lister v. Norton*, 1885, 2 R. P. C. 68; *Crossley v. Tomey*, 1876, 2 Ch. D. 533.

If a defendant denies infringement, then he must answer all questions tending to establish infringement. Thus, if asked whether he did not sell certain specified goods to certain specified persons he must answer in detail unless he admits the sale of such goods, to an amount sufficient to enable the plaintiff to prove his case: *Lister v. Norton*, 1885, 2 R. P. C. 68; *De la Rue v. Dickenson*, 1857, 3 K. & J. 391; *Lea v. Saxby*, 1875, 32 L. T. (N.S.) 731; *Howe v. M'Kernan*, 1862, 30 Beav. 547.

Where, however, the taking of an account or assessing of damages is proceeding, the defendant must set out the sales, and give the names of his customers, and it is no answer to say that such discovery might expose them to actions: *Tetley v. Easton*, 1856, 25 L. J. C. P. 293, 18 C. B. 643; *Jourdain v. Palmer*, 1866, L. R. 1 Ex. 102; *Swinborne v. Nelson*, 1853, 16 Beav. 416.

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In interrogatories, just as in general in all cases of discovery in patent cases, caution will be observed in not compelling the disclosure of trade secrets to rivals: *Moore v. Craven*, 1870, L. R. 7 Ch. 94 n. A form of interrogatories by defendant will be found in *Pascall v. Toope*, 1890, 8 R. P. C. 2; and another in *Benno Jaffé v. Richardson & Co.*, 1893, 10 R. P. C. 136.

21. The mode of trial in patent actions is regulated by the rules of the Supreme Court, O. xxxvi. Prior to the Patents Act, 1883, patent actions were generally tried at common law with a jury, and issues were sent for that purpose from Chancery. The method being considered unsatisfactory, it was provided by the Patents Act, 1883, s. 28, that in all proceedings for infringement or revocation, the Court may and shall, on the request of either party, call in the aid of a specially qualified assessor, whose remuneration is to be paid in the same manner as the other expenses of the execution of that act, that is to say, out of public money: sect. 83, subsect. 2; and that the action should be tried without a jury, unless the Court should otherwise direct. The power of calling in an assessor was first exercised in a patent case in *Pearce v. Thompson*, tried before Wills, J., on February 1st, 1893. The appointment of an assessor should enable the Court to dispense with much scientific

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evidence, and thus reduce costs; and may be useful to a party who fears that his means will not admit of his procuring sufficient expert evidence to meet the expert evidence of his opponent. There are already, attached to the Board of Trade, scientific advisers in railway, electrical, and other matters, whose position would probably make them desirable assessors. Jury trials of patent cases have been sometimes allowed after the Act of 1883: *Westinghouse v. Lancashire Rail. Co.*, 1884, 1 R. P. C. 229; *Young v. Rosenthal*, 1884, 1 R. P. C. 29; but are becoming quite obsolete, except where a fraudulent conspiracy is alleged: *e.g.*, *Edge v. Harrison*, 1891, 8 R. P. C. 74; or in action for threats.

ante, p. 381.

The Court has, under R. S. C., O. xxxvi., r. 8, power to direct that one or more issues of fact may be tried before the others. Under the Arbitration Act, 1889, s. 13, the judge has power to appoint referees to report upon any particular questions to be referred to an official or special referee for enquiry or report (see Chap. XXVIII., sect. 18, and "Notes" in the Annual Practice). This power is frequently used in patent cases. The order may provide for assistance to the referee in performance of his duties (as was done in the *United Telephone Co. v. Leeds Tramways Co.*, tried before Kekewich, J., in January, 1893), and should contain directions as to what is to be reported, how the enquiry is to be made, and what parties on each side may attend the referee, and should appoint a date for the sending in of the report. The referee who made the report, Mr. Macrory, Q.C. (assisted by the author), was in that case placed in the box to answer questions relating to his report, but the questions that might be asked of him would be under the control of, and in the discretion of, the judge.

In an action for infringing a telephone patent the defendants had sold separately, magnets and bobbins. They admitted the validity of the plaintiffs' patent for a telephone, but denied that it included the parts of a telephone. On application by the defendants that the infringement question should be tried first, the judge pointed out that the question of infringement was so mixed up with the question of construction of the patent that they could not be tried separately, and refused the order, unless defendants admitted validity of patent: *United Telephone Co. v. Mottishead*, 1886, 3 R. P. C. 213.

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Postponement or expedition of trial.—Under the old practice an action of infringement was sometimes postponed, pending the trial of a sci. fac., for repeal of the patent: *Smith v. Upton*, 1843, 6 M. & G. 251; *Patteson v. Holland*, 1845, Hindmarch, Pat. 293. But it was sometimes refused: *Muntz v. Foster*, 1844, 2 W. P. C. 93 n. As a rule the Court will not order the expedition of a trial, except upon very strong grounds: *Farben Fabrik v. Bowker*, 1890, 8 R. P. C. 136.

22. Change of venue.—Chancery actions may be put down to be tried at assize towns: *Edmond's Patent*, 1889, 6 R. P. C. 355; and if so put down, ought not to be sent back to London by the assize judge on the ground of want of time. The proper mode would be to apply to the Chancery judge in London to change the venue: *Fairburn v. Household*, 1885, 2 R. P. C. 195.

23. The hearing: Evidence.—At the hearing any question which would settle the whole action is frequently disposed of first: *Richardson v. Castrey*, 1887, 4 R. P. C. 265; *Badham v. Bird*, 1888, 5 R. P. C. 238.

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The proof of letters patent is given by producing the original or a certified copy, and if the patent professes to be an improvement on a previous patent, the previous patent must be put in: *Lewis v. Davis*, 1829, 1 W. P. C. 489. The production of a printed copy is *prima facie* evidence of the originality of the invention, and of the grant of the patent: *Russell v. Crichton*, 1837, 1 W. P. C. 677. But it seems that the plaintiff ought also to give some, though it may be slight, evidence of the nature of his invention, if that has been disputed: *Turner v. Winter*, 1787, 1 T. R. 606; *Galloway v. Bleaden*, 1839, 1 W. P. C. 525; and if the alleged infringement is not an infringement of the invention exactly as it is described, but is an infringement of its essence, then evidence should be given of the ambit of the invention, shewing that on its true interpretation the defendant has infringed it: Chap. XXIV., sects. 2, 3. A commission to examine a witness abroad was granted in *Lister v. Norton*, 1884, 2 R. P. C. 138.

The evidence of infringement necessary to entitle a plaintiff to succeed may also be slight. Thus, it is enough to prove that an article was made by the defendant, and to produce skilled witnesses who say that it must, in their opinion, have been produced by the plaintiff's patent method. This, unless displaced, would be sufficient: *Huddart v. Grimshaw*, 1803, 1 W. P. C. 91. On the other hand, where other machinery exists, capable of producing the article complained of, and which machinery is not an infringement of the patent, the plaintiff is not entitled to succeed unless he gives some reason for thinking that it is by his patent the article was manufactured: *Cartsburn Co. v. Sharpe*, 1884, 1 R. P. C. 186; compare *Palmer v. Wagstaffe*, 1854, 9 Ex. 494,

23 L. J. Ex. 217. Distinct evidence should be given that the article was not made by the plaintiff: *Betts v. Willmot*, 1871, L. R. 6 Ch. 239, 25 L. T. (N.S.) 188; see also *Farben Fabrik v. Bowker*, where mere proof of sale of an infringing article by defendant, with no proof of non-manufacture by plaintiff, was held to be insufficient, but an opportunity was given to the plaintiff to correct this if he could, after his case was closed, 1891, 8 R. P. C. 395.

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Scientific evidence is allowed to explain mechanical and chemical expressions and operations: *Batley v. Kynoch*, 1875, L. R. 20 Eq. 637; but not to say whether there has or has not been an infringement, for that is a matter for the tribunal: *Seed v. Higgins*, 1860, 8 H. L. C. 550, 30 L. J. Q. B. 314.

Sometimes evidence of a secret process is allowed to be given in Camera so as not to be disclosed: *Badische Anilin und Soda Fabrik v. Levinstein*, 1883, 24 Ch. D. 156.

Experiments are frequently made by experts with a view of giving evidence. In *Young v. Fernie*, 1864, 4 Giff. 609, it was said that such experiments should be looked upon with distrust; and indeed they do, to a great extent, depend on the good faith of those who have made them. Evidence is allowed of persons who have made articles in accordance with the patent and with no other description than that contained in the specifications: *Cornish v. Keene*, 1835, 1 W. P. C. 502. Sometimes a "specimen ordinary workman" is put into the box to shew what such a man would make of the instructions in the specification.

Experiments and inspection are often ordered by the Court to be made by an expert, selected by the Court, to which they make a secret report: S. C. R. 1883, O. L., r. 3. *ante*, p. 381.

In preparing the evidence in support of a patent case,

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the chief points to be attended to are, to convince the Court that the inventor has behaved honestly and with *bona fides*—that the invention was a real and solid improvement at the time it was made—that it resulted in a commercial (Chap. IV.), or at least a practical success; that there was a wide desire for the invention at the time; and that others had tried to do it and failed, or had after experiment abandoned it as not practicable. Evidence should also be given of the utility of the invention, and, if possible, of its beneficial nature to the public, as in making things cheaper, or better than before, or in introducing a new article or manufacture.

So far as the evidence of experts is adduced, it should be considered with reference to their callings and experience, and to their ingenuity and readiness in surmounting the attempt of the opposing counsel to confuse and puzzle them. The prolixity of counsel in patent cases has been more than once the subject of remark; thus, in *Ehrlich v. Ihlee*, 1888, 5 R. P. C. 446, it was commented upon at some length. In *Ungar v. Sugg*, 1892, 9 R. P. C. 116, Brett, L.J. says: "There is something catching in patent cases, which is, that it makes everybody argue and ask questions to an interminable extent. A patent case, with no more difficult question to try than any other case, instead of lasting six hours is invariably made to last six days if not twelve. I am sure there ought to be some remedy for it."

The Court will sometimes look at a model which has not been strictly proved if it is used to explain counsel's argument (and no doubt sketches might be similarly employed): *Boyd v. Horrocks*, 1889, 6 R. P. C. 152.

Hearsay evidence is of course not allowable, so that

where a witness proved that a dead man had sold a certain article to another, that other was not allowed to give evidence that on a subsequent occasion the deceased had said he did not wish it to be publicly known. If the declarations had accompanied the act of selling the article in question, the decision would have been different: *Hyde v. Palmer*, 1863, 3 B. & S. 657, 32 L. J. Q. B. 126.

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The plaintiff is entitled to call evidence in reply to the defendant's evidence of prior user, but the defendant is not entitled as of right to call further evidence rebutting this: *Penn v. Jack*, 1866, L. R. 2 Eq. 314, 14 L. T. (N.S.) 495.

In the basement of the Royal Courts of Justice there are rooms which are let out to parties in patent actions, and in which they can deposit, and in some cases work, machines and models under lock and key. The judge, if desired, will sometimes go and inspect them with the parties.

Considerable experience and care is needed in the preparation of the evidence in a patent case. The issues must be carefully looked at to see what the plaintiff will have to prove. The patents and specifications are generally admitted by consent; if not, they must be proved by means of certified copies; merely to produce a printed copy of the specifications will not be enough. Anticipations by means of books are most simply proved, if they exist, in the Patent Office Library, by a gentleman from the Patent Office. The librarians keep a record of the date on which each book is placed in the library, which greatly facilitates the proof. To prove the infringement it is not enough simply to produce an article, evidence must be given of its sale by defendants. If the patent be for a process, proof must be given that

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the article was made by that process. This, if other means fail, may be by an expert, who, looking at it, can say how he believes it was made. Comparatively slight evidence of this will be enough to establish a *prima facie* case, but if the article might have been made by other processes, which are not infringements of the plaintiff's process, some reasons must be given why the patentee concludes that it was made by his process. In such cases interrogatives are generally expedient. The plaintiff should be prepared with proof that the invention is useful, new, and that the specification is clear and easy to be comprehended. In addition to this, he should also be provided with evidence of the state of knowledge in the trade at the time the patent was granted, so that light may be thrown upon the manner in which it ought to be interpreted, and its true ambit determined. The evidence on these heads is very important. For even though the utility be not directly questioned, yet the whole position of the plaintiff is greatly strengthened if he can show that the patent has been the means of putting the public in possession of a desired result which had previously been sought in vain, and that the patent was a commercial success.

In his choice of witnesses, the plaintiff has to elect between employing regular scientific witnesses, and witnesses specially engaged in the trade. The advantage of the former is, that they really serve almost as advocates. They foresee difficulties, their ingenuity overcomes objections, and they are usually accustomed to being cross-examined.

The danger of employing only mechanics engaged in the trade is, that they will generally insist on being too clever, and in making some point on which they are

bent, without seeing that they are damaging the other parts of the case. But if a reticent and experienced witness of this class can be got who thoroughly and honestly believes in the case, he is of great assistance.

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In patent cases there is a great tendency to multiply witnesses, and to secure quantity at the expense of quality. Nothing is a greater mistake. Each witness put into the box is a source of danger to his own side, for it is impossible to foresee what damaging admissions or silly remarks he may not be induced to make under cross-examination.

Another danger to be avoided is to be too nervous over unimportant parts of the case, and to take a number of false points. When each of a dozen weak objections to a patent is insisted on, a judge is apt to think that there cannot be much in any of them. A case, like a chain, depends not on the aggregate weight of its links, but on the strength of the weakest of them.

Wherever the subject admits of it, models are very useful, and some judgment is required in making them easy to move about, and yet large enough for their action to be seen. The important parts may be painted in distinctive colours, and they should be labelled clearly. Before they are finally finished it is of advantage for counsel and the expert witnesses to see them, so as to suggest alterations or improvements. Sometimes it is useful to have the drawings of the machine mounted on cards and coloured, to make the parts more clear. If there are many patents, they should be bound in books, and provided with parchment tags with the names on them, so as to be easily referred to.

Care is also needed in preparing the briefs. After they have been written they should be gone through and

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condensed as much as possible, and great pains taken with the arrangement. A table of events with their dates, including the applications, sending in of specifications, etc.; of all the patents, every step in the action, and every circumstance of importance is very useful. In preparing a brief, when in doubt, always adopt chronological order. A *short* abstract or table of the witnesses names, and what they can prove, is of advantage. It is a help to understanding the brief, if small sketches are made in it. They are not allowed on taxation, but a great deal can be done by an intelligent clerk with a pen and two or three chalk pencils of different colours. An abstract of the patents with small sketches, shewing the important feature of each, will often be useful.

24. Questions of law and fact.—A decision upon a question of construction in a specification is one of law, and hence, when it has been decided, it ought to be followed in other cases, by Courts of inferior or co-ordinate jurisdiction: *Slazenger v. Feltham*, 1889, 6 R. P. C. 132; *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, 1889, 6 R. P. C. 120, 367.

But this only applies to findings upon points of law, not findings of fact, as to which, if fresh evidence is brought in a new case, the decision may be different: *Edison Co. v. Holland*, 1888, 5 R. P. C. 459, where, after the Court of Appeal had decided on the validity of a patent, Kay, J. in a subsequent action *in which new and different evidence of want of novelty was brought*, declared the same patent invalid. His decision was reversed by the Court of Appeal, 1889, 6 R. P. C. 243, but the principle upon which he had acted was approved. As to questions of Infringement, see Chap. XXIV., sect. 22 (*ante*, p. 324).

25. Construction of documents.—In general the construction of documents which are not susceptible of evidence to explain them, is for the Court. If then it is necessary merely to compare specifications without evidence, this will be done by the Court: *Tetley v. Easton*, 1852, M. P. C. 68; *Otto v. Linford*, 1882, 46 L. T. (N.S.) 44. But where they need to be supplemented by expert or other evidence, they are questions of fact for a jury, if there is one: *Neilson v. Harford*, 1841, 1 W. P. C. 350, and see p. 678; *Stead v. Williams*, 1843, 2 W. P. C. 137; *Stead v. Anderson*, 1846, 2 W. P. C. 147; *Thomas v. Foxwell*, 1858, 5 Jur. (N.S.) 38, 6 Jur. (N.S.) 271; *Seed v. Higgins*, 1860, 8 H. L. C. 561; and see remarks on this case in *Clark v. Adie*, 1873, 2 App. Cas. 332.

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26. In determining the quantum of invention, the question will be one of fact if the evidence of experts is needful: *Thorn v. Worthing Skating Co.*, 1876, 6 Ch. D. n. 415; *Steiner v. Heald*, 1851, 6 Ex. 607, 17 Jur. 875, 20 L. J. Ex. 410; *Bush v. Fox*, 1851, M. P. C. 166, 23 L. J. Ex. 257, 5 H. L. C. 707, 25 L. J. Ex. 251.

27. The question of anticipation, by prior publication, is also one of fact if the matter is one which depends on scientific evidence to connect the two documents: *Muntz v. Foster*, 1844, 2 W. P. C. 107.

The question of prior publication by user will invariably be one for the jury, as it is a matter of fact: *Elliot v. Aston*, 1840, 1 W. P. C. 224; *Cornish v. Keene*, 1837, 1 W. P. C. 519, 2 Hodg. 294, 3 Bing. N. C. 588; *Spencer v. Jack*, 1864, 11 L. T. (N.S.) 242.

28. The question of utility is one of fact, and is for the jury: *Neilson v. Harford*, 1841, 1 W. P. C. at p. 315;

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The question
of utility is
one of fact.

Hill v. Thompson, 1817, 3 Mer. 630, 1 W. P. C. at p. 237; *Bloxam v. Elsee*, 1825, 1 C. & P. 365, Ry. & Moo. 187, 1 C. P. C. 434; *Cornish v. Keene*, 1835, 1 W. P. C. 501, 2 C. P. C. 314; *Macnamara v. Hulse*, 1842, C. & M. 471, 2 W. P. C. 128. On this ground, the finding as to utility, of a Court of first instance, will be very difficult to disturb: *Siddell v. Vickers*, 1888, 5 R. P. C. 429-30. On the other hand, the finding of a Court below as to utility is not absolutely conclusive, especially if coupled with what the Court of Appeal considers as an erroneous construction of the specification: *Edison v. Holland*, 1889, 6 R. P. C. 284.

29. The question of the intelligibility of a specification or whether it is covered by the title, or by another specification, will in general be for the Court: *Betts v. Menzies*, 1862, 10 H. L. C. 134; but when it becomes necessary to take evidence as to materials or ingredients, or to make experiments to see if the methods described sufficiently explain the nature of the invention, the question will then become one of fact for the jury: *Hills v. Evans*, 1862, 31 L. J. Ch. 457, 8 Jur. (N.S.) 525, 6 L. T. (N.S.) 90; *Bickford v. Skewes*, 1839, 1 W. P. C. at p. 216, 218; *Elliot v. Turner*, 1845, 2 C. B. 446; *Wallington v. Dale*, 1852, 7 Ex. 888; *Muntz v. Foster*, 1844, 2 W. P. C. 107; *Parkes v. Stevens*, 1869, L. R. 8 Eq. 358, 38 L. J. Ch. 627, L. R. 5 Ch. 36, 22 L. T. (N.S.) 635. This, however, always presupposes there is sufficient evidence to go to the jury: *Derosne v. Fairie*, 1835, 1 W. P. C. at p. 159. The question whether from the specification a workman could perform the invention is also one of fact for the jury: *Walton v. Bateman*, 1842, 1 W. P. C. 621.

The above questions of what for the Court, and what for the jury, are now of less importance owing to the extended powers of the Court of Appeal in reviewing facts, and the disuse of juries to try patents. But still they cannot altogether be ignored, as they are useful in determining how far the Court of Appeal will review cases submitted to it. For errors in law are freely reviewed and corrected; conclusions drawn from evidence are only reversed with great difficulty. As to questions of Infringement, see Chap. XXIV., sect. 22.

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The question of the intelligibility of a specification or whether it is covered by the title, or by another specification, will in general be for the Court.

ante, p. 324.

30. Judgment.—Various forms of judgments will be found given at length in the following cases: *Westinghouse v. Lancashire & Yorkshire Rail. Co.*, 1884, 1 R. P. C. 252; *Washburn Co. v. Patterson*, 1884, 1 R. P. C. 191; *Moore v. Bennett*, 1884, 1 R. P. C. 133. *post*, p. 591.

As to the power of counsel and solicitors to agree to a compromise: see *Alliance Pure White Lead Syndicate v. McIvor*, 1891, 8 R. P. C. 323.

Where a plaintiff sued two persons, one of whom allowed judgment to go by default, but the other made a successful defence and invalidated the patent. Held, that the judgment against the other must be reversed: *Cropper v. Smith*, 1884, 2 R. P. C. 23.

A judgment in an action will, of course be conclusive, not only as between the parties, but as against all actions in Court of co-ordinate jurisdiction, in so far as such judgment decides questions of law: *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, 1889, 6 R. P. C. 120, 367. But in so far as mere questions of fact are concerned, they may be raised again: *Edison v. Holland*, 1882, 6 R. P. C. 343; *Slazinger v. Feltham*, 1889, 6 R. P. C. 130, 232. The above cases

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however shew, that where a case has been once fought out on the merits, the judges discourage the trial of the same questions of fact over again.

P. Act, 1883,
sect. 30, *post*,
p. 455.
post, p. 406.

post, p. 410.

31. Judgment for an account.—A finding for the plaintiff is followed by a judgment for damages or else for an account—with or without a perpetual injunction, and at the same time certificates may be given that the validity of the patent came in question. On judgment for the defendant, a certificate should be demanded of the sufficiency of the objections.

Formerly, the granting of an account was attendant upon the granting of an injunction, but now accounts may be ordered to be taken whether the action is brought before or after the infringement of the patent; R. S. C. 1883, O. xv., r. 1: *York v. Stowers*, 1883, W. N. 1883, 174.

A plaintiff cannot take both damages and an account, he may have which he pleases, but he must elect between them: *Neilson v. Betts*, 1871, L. R. 5 H. L. 1; *De Vitre v. Betts*, 1873, L. R. 6 H. L. 321; *Siddell v. Vickers*, 1892, 9 R. P. C. 162.

The mere taking of an account of profits or the assessing of damages do not of themselves so purge the tort, that the articles in respect of which accounts are taken or damages paid become thereby licensed, and they may still be stopped in the hands of purchasers: *Penn v. Bibby*, 1866, L. R. 3 Eq. 308—unless such account or damages is paid and accepted as a royalty: *Penn v. Jack*, 1867, L. R. 5 Eq. 81; *Cropper v. Smith*, 1882, 24 Ch. D. 305, 312. The amount of a royalty usually received by the plaintiff is not necessarily the measure, or the limit of the damages he may receive, though it is evidence of it: *Penn v. Bibby*, 1866, L. R. 3 Eq. 308.

Trivial accounts would not be gone into: *Bergman v. Macmillan*, 1831, L. R. 17 Ch. D. 427; *Sanitas Co. v. Condy*, 1887, 4 R. P. C. 533; *Watson v. Holliday*, 1882, L. R. 20 Ch. D. 780, 30 W. R. 747, 31 W. R. 536.

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Where it is suspected that the account may turn out insignificant, it is sometimes referred to a referee with power over costs: *Shaw v. Jones*, 1889, 6 R. P. C. 328.

It by no means follows that the money payable under an account would be the same as the money payable as damages. In damages the plaintiff receives compensation for the injury he has suffered: *United Horseshoe and Nail Co. v. Stewart*, 1888, 5 R. P. C. 260, 13 App. Cas. 401; *Ledgard v. Bull*, 1886, 11 App. Cas. 648, 654.

But in an account he treats the defendants, as it were, as his agents, and takes the profits they make. Hence, a patentee who has never attempted to put his invention into practice, would probably prefer an account, for he might have great difficulty otherwise in shewing what his profits would have been, whereas a manufacturing patentee, against a defendant who had only used the invention, might prefer damages.

At the same time, however, an account does not merely extend to the profits made by the infringer, it also includes any indirect savings or collateral profits, or advantages which he may have reaped: *Crossley v. Derby Gaslight Co.*, 1834, 3 M. & Cr. 428; *Househill Co. v. Neilson*, 1843, 1 W. P. C. 697 n.; *Bacon v. Spottiswoode*, 1839, 1 Beav. 387.

Where the plaintiff is assignee, the account or damages would only run from the date of the assignment, unless the assignment were wide enough to cover all the patentee's past rights.

Acquiescence or delay is prejudicial to the demand

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an account

for an account: *Crossley v. Derby Gaslight Co.*, 1834, 1 W. P. C. 120.

On the taking of an account, the defendants must disclose the profits made by them before the infringement for the purpose of comparison with those made afterwards, so that the difference may be estimated: *Siddell v. Vickers*, 1889, 6 R. P. C. 464, and this is the proper basis to take them upon: *ibid.* 1892, 9 R. P. C. 152.

The account is taken down to the last article sold or used by the defendant. In the case last cited, the Court of Appeal having heard, and by consent, having assessed the amount, ordered a lump sum of £3000 and costs to be paid to satisfy all claims.

32. Damages may be awarded, though not specifically claimed in the proceedings: *Betts v. Neilson*, 1868, 18 L. T. (N.S.) 159, and are measured by the loss consequent upon the defendant's acts: *United Horseshoe Co. v. Stewart*, 13 App. Cas. 413, 5 R. P. C. 260. Damages, if they cannot be assessed at the trial, are referred to an officer of the Court for inquiry: O. xxxvi, rr. 57, 58, and are taken down to the date of the assessment, and an enquiry will not be granted where the damage appears to be only trivial: *Dicks v. Brooks*, 1880, L. R. 15 Ch. D. 39; *United Telephone Co. v. Sharples*, 1885, 2 R. P. C. 28; *Cole v. Saqui*, 1888, 5 R. P. C. 489. If, by oversight at the trial, the plaintiff forgets to ask for damages, a subsequent application for them may be made: *Edison v. Holland*, 1888, 5 R. P. C. 483.

The royalties, usually reserved by the plaintiff, though not a conclusive measure of his damages, are evidence of it: *United Telephone Co. v. Walker*, 1886, 4 R. P. C. 64.

In certain old cases exemplary damages were given, but recent decisions have been entirely against the giving of exemplary or vindictive damage.

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Damages.

If a plaintiff has obtained judgment on admissions of infringement in the pleadings, his enquiry into damages can only go for the admitted infringements: *United Telephone Co. v. Donohoe*, 1886, 31 Ch. D. 399.

When the defendant only partly used the plaintiff's invention the measure of damages was held only to be a portion of the defendant's profits. *United Horseshoe Co. v. Stewart*, 1887, 4 R. P. C. 130; but this was reversed on appeal.

After an order has been made for an enquiry into damages, it is doubtful whether the plaintiff is entitled to have such an enquiry made by a jury. At all events, if he so desire it, he should apply at the trial, and not subsequently: *American Braided-Wire Co. v. Thomson*, 1888, 5 R. P. C. 696.

Acquiescence on the part of the plaintiff is evidence against his having sustained damage: *Smith v. Lond. & N. W. Rail. Co.*, 1853, M. P. C. 188.

33. Perpetual injunction.—An injunction will be granted to restrain the sale of all articles made in infringement of the patent, whether they are sold after the patent has expired or not: *Crossley v Beverley*, 1829, 1 W. P. C. 119, 1 R. & M. 166; *Crossley v. Derby Gas-light Co.*, 1834, 4 L. J. Ch. 25. post, p. 455.

The injunction impliedly depends on the patents continuing in force. If it were determined then quoad all articles made after that date, it would cease: *Daw v. Eley*, 1867, 3 Eq. 496.

Injunctions may be granted, "quia timet," where there

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injunction.

is no actual infringement, but only a clear intention to infringe, as, for instance, where the defendants had made articles, similar to those patented, before the date of the acceptance of the complete specification, and announced their intention of going on doing so: *Frearson v. Loe*, 1878 L. R. 9 Ch. D. 48; *Dowling v. Billington*, 1890, 7 R. P. C. 208.

A defendant who has consented to an injunction by mistake or surprise may be allowed to withdraw such consent: *Elsas v. Williams*, 1884, 1 T. R. 144.

34. Disobedience to an injunction.—An order for an injunction is enforced by commitment, and this may be done as soon as the existence of the order for the injunction is served on the defendants or brought to their notice: *United Telephone Co. v. Dale*, 1884, 25 Ch. D. 778. But the evidence must be very strong and clear of the breach of the injunction: *Dick v. Haslam*, 1891, 8 R. P. C. 196. In order to obtain an order for commitment, the procedure must be very strictly followed, and attention paid to the special rules which exist as to the practice of obtaining commitment orders, non-observance of any of which will generally be fatal. It is not proposed to go through these rules in detail as they will all be found in the "Annual Practice," but attention may be called to the necessity of personal service, the necessity of serving a copy of the affidavits with the notice of motion and other kindred regulations.

Even when a defendant does not know that he has infringed, a commitment order might be made against him if in fact he has done so: *Plimpton v. Spiller*, 1876, 4 Ch. D. 287; *Thomson v. Moore*, 1889, 6 R. P. C. 445. Nor again need the act of infringement which is com-

plained of as a breach of the injunction be the same sort of infringement as caused the making of the order for the injunction: *Thomson v. Moore*, 1889, 6 R. P. C. 445; and *Plimpton v. Spiller*, 1876, 4 Ch. D. 285.

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to an injunction.

Mere selling of materials to perform the invention would not in general be an infringement of the injunction, unless it was done in such a way as to be really a colourable evasion, as, for instance, the selling of parts which merely required to be put together: see Chap. XXIV., sect. 18.

ante, p. 321.

Nor again is it any breach of an injunction to publish advertisements asking for subscriptions towards the expense of an appeal: *Plating Co. v. Farquharson*, 1883, 17 Ch. D. 49.

As a matter of practice, commitments rarely, if ever, take place; the defendant on promising not to repeat his offence, and to pay the costs of the motion, is generally absolved: *Edlin v. Pneumatic Tyre Agency*, 1893, 10 R. P. C. 317. But such costs are usually made as between solicitor and client: *Plating Co. v. Farquharson* 1883, 17 Ch. D. 49; *Steele v. Hutchinson*, 1879, W. N. 18, unless the infringement was committed in the *bonâ fide* belief that the injunction was not being broken, in which case only ordinary costs would generally be given: *Spencer v. Ancoats Vale Co.*, 1888, 6 R. P. C. 46.

If the defendant be a company, an attachment may be asked against any directors who have personally given orders for the commission of the breach of the injunction, and in addition a writ of sequestration may be demanded against the goods and chattels of the company: *Spencer v. Ancoats Vale Co.*, 1888, 6 R. P. C. 46.

Public necessity will justify the breaking of an injunction, as where a master of a ship uses a patent pump

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which he has been enjoined not to use, to extinguish a fire (semble, *per* L.J. James): *Adair v. Young*, 1879, 12 Ch. D. 21. This wise and reasonable expression of opinion seems to set at rest doubts which formerly prevailed upon such points as this. For it is narrated that a fire having broken out in the Temple, in the chambers of a barrister, his neighbours debated whether it would be a trespass to break in and enter his room to put it out. They could not resolve the point, and while they were debating it, his books were burned.

35. Delivering up of the infringing articles.—Where a number of the infringing articles exist they may be ordered to be ascertained and given up, and if they have been removed from the country after such order they must be brought back and surrendered: *Washburn Co. v. Patterson*, 1884, 1 R. P. C. 191. They are sometimes ordered to be marked by the plaintiff so as to prevent them from being sold: *Westinghouse v. Lancashire Rail. Co.*, 1884, 1 R. P. C. 253.

It must, however, be observed that this jurisdiction to order the articles to be given up so as to be marked or destroyed, does not affect the *property* in them, over which the Court has no power. Therefore the plaintiffs cannot sell them and retain the proceeds. But they may be ordered to be destroyed: *Vavasseur v. Krupp*, 1878, L. R. 9 Ch. D. 351, and in order that such an order may be made, it is necessary (as it affects the goods) that the owner of them should be cited before the Court (*ibid.* 360).

36. Discovery in aid of execution is given by S. C. R., O. XXXIII. and XLII. Under the powers thus

conferred a defendant may be compelled to file an affidavit showing what goods he has made or sold and the names and addresses of the purchasers: *Murray v. Clayton*, 1872, L. R. 15 Eq. 115; and he may also be ordered to produce his books and documents: *American Braided Wire Co. v. Thompson*, 1888, 5 R. P. C. 375; *Saxby v. Easterbrook*, 1872, L. R. 7 Ex. 207.

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Discovery in aid of execution.

37. Stay of execution.—This can be granted by R. S. C., O. LVIII., r. 16, and is sometimes done pending an appeal: *Hocking v. Fraser*, 1886 (on terms of appealing in fourteen days and keeping an account), 3 R. P. C. 7; *Woodward v. Sansum*, 1886 (on terms of appealing promptly), 3 R. P. C. 366; *Kaye v. Chubb*, 1887, 4 R. P. C. 23; *Nordenfelt v. Gardner*, 1884, 1 R. P. C. 63. In *Humpherson v. Sayer*, 1887, 4 R. P. C. 184, a stay was refused, pending an appeal, but a stay of the taking of the account was allowed. Kekewich, J., commenting on *Hocking v. Fraser* and *Kaye v. Chubb*, said he considered that the orders in those cases had been made by consent.

In the case of *Otto v. Steel*, a motion was made subsequently to the judgment for a stay pending an appeal, of the taking of an account, and of the injunction, on the ground of the irreparable injury that would be done to the defendant by the disclosure of the names of his customers. Pearson, J., refused the application. On appeal, and application to the Court of Appeal to advance the hearing day, the Court of Appeal refused the application, saying that if it were allowed, a stay would have to be granted in every case: 1886, 3 R. P. C. 120; and see *Edge v. Johnson*, 1892, 9 R. P. C. 142. In *Thomson v. Moore*, 1889, 6 R. P. C. 426, a stay of an order for attachment for disobedience to an injunction

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execution.

was ordered upon certain terms pending an appeal (see p. 464).

post, p. 455.

38. Certificate of validity of the patent.—By the Patents Act, 1835, s. 3, when a patentee in an action had obtained a certificate that the validity of his patent had been in question, he was entitled to treble costs in subsequent actions (unless the judge certified to the contrary). Treble costs are now abolished, but after such a certificate he may now get “his full costs,” charges, and expenses as between solicitor and client: Patents Act, 1883, s. 31.

In *United Telephone Co. v. Patterson* these costs were given, although in that case the defendant had not again questioned the validity of the patent, but only denied infringement: 1889, 6 R. P. C. 142; *Davenport v. Rylands*, 1865, L. R. 1 Eq. 302, 35 L. J. Ch. 204.

In an earlier case, however, where the validity was attacked on different grounds to those on which it had been considered valid in the first action, the extra costs were refused: *Otto v. Steel*, 1886, 3 R. P. C. 120.

The certificate may be asked for by the plaintiff whether he has or has not been successful: *Haslam v. Hall*, 1887, 5 R. P. C. 27; and see *Automatic Machine Co. v. Knight*, 1889, where the certificate was given, though the plaintiff lost the action by failing to prove infringement: 6 R. P. C. 120; and see p. 129, where, in a second action on the same patent, the higher costs were refused on the ground that when the second action was tried, the first (in which the certificate had been granted) was already on the paper for trial.

From the form of the statute, when a certificate has

been given, the higher costs follow unless otherwise ordered, so that great care must be taken to ask for them to be disallowed.

The second action must, however, be commenced after the date of the certificate in the prior action, in order that the rule may apply: *Automatic Weighing Machine Co. v. International Hygienic Society*, 1889, 6 R. P. C. 480, and see the decision at 6 R. P. C. 120, cited supra.

The certificate may be granted in an undefended action: *Haydock v. Bradbury*, 1887, 4 R. P. C. 75, but see *Peroni v. Hudson*, 1884, 1 R. P. C. 263; and see *Ball v. Lelm*, 1881, Times, April 14th, and *Stocker v. Rodgers*, 1843, 1 C. & K. 99. The certificate may be granted where the action has been compromised and judgment given by consent: *Delta Metal Co. v. Macim Nordenfelt*, 1891, 8 R. P. C. 248.

The certificate is not granted more than once: *Edison v. Holland*, 1889, 6 R. P. C. 287, except when the attack on the validity of the patent proceeds on different grounds from those on which it was made in the first, in which case a certificate of validity may be given as regards some particular claim: *Otto v. Steel*, 1886, 3 R. P. C. 120.

Where there has been a previous action, and a certificate of the question of validity given, it is more prudent to put a claim founded on it into the statement of claim in the second action, so as to give the defendant warning that such costs will be demanded if he proceeds. On the other hand, in *Newall v. Wilkins*, 1851, 17 L. T. 20, in a jury case, it was considered that such prior trial ought not to be put in evidence so as to prejudice the defendant's case, but ought to be proved after the verdict. It is hence no flaw in pleading not to plead it,

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but not to have done so might be considered unfair, if thereby the defendant had been kept in ignorance of the fact.

No appeal lies from the grant or refusal of a certificate of validity: *Haslam v. Hall*, 1888, 20 Q. B. D. 491; 5 R. P. C. 144.

39. Costs.—In general only two counsel are allowed, and it will be very exceptional that the costs of three counsel are allowed on taxation: *Betts v. Clifford*, 1860, 1 J. & H. 74; *Betts v. Cleaver*, 1872, L. R. 7 Ch. 513; *Smith v. Buller*, 1875, L. R. 19 Eq. 473. The fee allowed is from £5 5s. to £7 7s. a day (*ibid*).

Charges “for luxuries” are not allowed, as for instance, drawings on margin of counsel’s briefs; or a solicitor’s clerk in addition to a solicitor (*ibid*).

Costs of scientific witnesses will be allowed in moderation, and also costs of models in proper cases: *Batley v. Kynoch*, 1875, L. R. 20 Eq. 632.

The ignorance of a defendant as to the existence of a patent, and his offer to submit will affect costs: *Nunn v. D’Albuquerque*, 1865, 34 Beav. 595. Where a retail dealer had sold articles which unwittingly infringed the plaintiff’s patent, and on being informed, gave every information, and promised not to do so again, it was held that plaintiff was not entitled to the costs of the action: *Betts v. Willmot*, 1870, 18 W. R. 946, L. R. 6 Ch. 239; *Nunn v. D’Albuquerque*, 1865, 34 Beav. 595; *Upman v. Elkan*, L. R. 7 Ch. App. 130.

In a case where a defendant had infringed, but discontinued his infringement before action, and offered to pay reasonable damages, but the plaintiff persisted in his action, the Court considered his action vexatious, and

made him pay the defendant's costs: *Fletcher v. Glasgow Gas Co.*, 1887, 4 R. P. C. 386.

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Costs.

As a rule, however, a successful plaintiff who has conducted his action fairly, and not been guilty of any misconduct, is entitled to his costs: *Cooper v. Wittingham*, L. R. 15, Ch. D. 501; *Upman v. Forrister*, 1883, 24 Ch. D. 231; *Burgess v. Hateley*, 1858, 26 Beav. 249; *Fradella v. Weller*, 1828, 2 Russ. & M. 247; *Colburn v. Sims*, 1843, 2 Hare, 543.

In *Upman v. Forrister* (a trade-mark case), Chitty, J., held that a plaintiff was not always bound to give notice to the defendant before commencing his action, if there were a fear of his making away with the spurious articles, and that hence the want of such notice was by no means fatal to costs; 1883, 24 Ch. D. 231.

40. Costs of separate issues as a rule follow the event: R. S. C. 1883, O. LXV. r. 2. This apportionment may be made in patent actions in either of two ways, by dividing the issues, and ordering the costs of each to be separately dealt with, or else by giving a certificate of particulars, under the Patents Act, 1883, s. 29, sub-s. 6. If no order about costs is made, the successful party will get the costs of the action, but, as will be seen below, neither would get the costs of proving his particulars.

post, p. 455.

The result of this is, that in patent actions the duty of considering the issues and deciding who is to bear the cost of them, will in every case fall on the Court, and that a successful party may either ask to have a certificate of particulars, or else for an apportionment of costs, under O. LXV. r. 2.

41. Certificate of particulars of breaches and

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particulars of
breaches and
objections.

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objections.—In the Patents Act, 1835, provisions were made for the costs of issues, on which the plaintiff had not succeeded.

The Patents Act, 1852, went further, and required a successful plaintiff or defendant to obtain a certificate of the particulars from the judge.

By the Patents Act, 1883, s. 29, sub-s. 6, it is provided that no plaintiff or defendant shall be allowed costs in respect of any particulars, unless the same are certified by the Court or a judge, to have been proven, or else to have been reasonable and proper.

It was at one time doubted whether these words, “the Court or a judge,” included the judge of the Court of the Duchy of Lancaster (*per* Day, J.): *Proctor v. Sutton Lodge Co.*, 1888, 5 R. P. C. 184; but see *Heyes v. Hallmark*, 1892, 9 R. P. C. 27; *Ashworth v. Law*, 1892, 9 R. P. C. 194; and the opinion of Brett, L.J., in *R. v. C. C. of Halifax*, 1891, 8 R. P. C. 344; and see 53 & 54 Vict., c. 23, 1890, which now gives it the full powers of a Court of Chancery.

The Court of Appeal can also give a certificate, and will do so, where it reverses the decision of the Court below: *Cole v. Saqui*, 1889, 6 R. P. C. 41; but it will not on appeal re-try an issue which is not material to its judgment, merely in order to decide whether or no to grant the certificate: *Boyd v. Horrocks*, 1886, 6 R. P. C. 162. Approved in *Longbottom v. Shaw*, 1888, 6 R. P. C. 147, 510: *Kaye v. Chubb* (*post*, p. 298).

A certificate of objections cannot be given unless a trial has taken place (*per* Bristowe, V.-C. of Lancaster): *Rothwell v. King*, 1887, 4 R. P. C. 399. If, however, by mistake omission was made to ask it at the trial, it may be asked for subsequently, but no costs of the motion

will be granted (*per* Bristowe, V.-C.): *Roucliffe v. Morris*, 1886, 3 R. P. C. 145. As a general rule, certificates are not given in respect of particulars which have not been proved: *Billington v. Hill*, 1891, 8 R. P. C. 332; and see next section.

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Certificate of
particulars of
breaches and
objections.

42. Apportionment of costs.—The apportionment of costs depends upon the facts of each case, and the conduct of the parties, but as a general rule, the costs of the issues are severed, and made, so far as is possible, to follow the event.

The Court sometimes certifies for particulars, under Patents Act, 1883. s. 29, sub-s. 6; sometimes gives directions as to the costs of issues: under O. LXV. r. 2. The following cases are examples: *Wegman v. Corcoran*, 1878, 27 W. R. 357, 362; *Simmonds v. Hitchman*, 1881, 29 Ch. D. 417 n; *United Telephone Co. v. Harrison*, 1882, 21 Ch. D. 747;—where a certificate for particulars of breaches was refused, because, though the infringement was proved, the patent was held bad.

post, p. 455.

Young v. Rosenthal, 1884, 1 R. P. C. 29, 41.—Plaintiff's proved infringement, but failed as to novelty and utility. Certificate of breaches for plaintiff, but only as to cost of delivering them, and subpoenaing witnesses, defendants entitled to certificate for part of their particulars of objections.

Needham v. Johnson, 1884, 1 R. P. C. 49, 59.—The Court below had found for the plaintiffs with costs. On appeal the Court of Appeal found no infringement, they gave the defendants the general costs of the action, with no costs on either side on the issues of novelty.

Nordenfelt v. Gardner, 1884, 1 R. P. C. 61.—Judgment for plaintiff; on appeal held no infringement.

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Apportion-
ment of costs.
Examples of
cases.

Costs to be defendant's, but plaintiff to have costs on issue of novelty.

Westinghouse v. Lancashire Rail. Co., 1884, 1 R. P. C. 229, 253.—Where a trial had been by jury, the Court of Appeal directed the costs to be according to the findings.

Badische Anilin Fabrik v. Levinstein, 1885, 29 Ch. D. 366.—A patentee proved infringement, but his patent was proved invalid. Held that the plaintiff must pay the general costs of the action, but that the defendant must pay costs on the issue of infringement. (A collection of cases will be found in the argument.)

Pooley v. Pointon, 1885, 2 R. P. C. 167.—Plaintiff to have costs of Nos. 1 and 2, particulars of objections; defendant, of Nos. 3, 5, 6. No order as to 4.

Lawrence v. Perry, 1885, 2 R. P. C. 179.—Certificate refused as to all the alleged anticipating specifications which had not been actually put in, and out of these, certificate given for 8.

Laurie v. Baker, 1885, 2 R. P. C. 213.—Defendant held not to have infringed, but to be liable for nominal damages, for passing off his goods as the plaintiff's, plaintiff to have general costs of action, but costs on issue of infringement to be defendant's.

Sugg v. Bray, 1885, 2 R. P. C. 248.—Each party ordered to pay his own costs.

Hocking v. Fraser, 1885, 3 R. P. C. 7.—Costs apportioned where plaintiff succeeded on one patent, but offered no evidence on the other.

Edison v. Woodhouse, 1886, 3 R. P. C. 167.—Plaintiff sued on three patents; as to two of them there was no evidence of infringement. Defendant held entitled to costs occasioned by plaintiff's including them.

Guilbert-Martin v. Kerr, 1886, 4 R. P. C. 23.—Where

a patent was held invalid; Kekewich, J., gave defendants who had pleaded invalidity, want of utility, and no infringement, all the costs, on the ground that the issues could not be distinguished sufficiently to apportion them.

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SECT. 42.

Apportionment of costs.
Examples of cases.

Kaye v. Chubb, 1887, 4 R. P. C. 300, 302.—Defendant's appeal allowed, and certificate of objections given by Court of Appeal.

American Braided Wire Co. v. Thompson, 1887, 4 R. P. C. 322.—Defendants, though successful in action, ordered to pay costs of particulars of objections which they had not raised. (Judgment reversed on appeal.)

Blakey v. Latham, 1888, W. N. p. 126, 6 R. P. C. 38, 186, 190.—The Court found infringement, but that patent was invalid. They refused to apportion the costs of the issue of infringement in plaintiff's favour.

Badham v. Bird, 1888, 5 R. P. C. 238.—Defendants put to plaintiff an anticipation which at once broke down his case. Their certificate of objections was limited to what was put to plaintiff on cross-examination.

Blank v. Footman, 1888, 5 R. P. C. 661.—“As a rule costs of issues ought to follow the event.” General costs of action ought to follow the event in spite of some of the issues being found against the successful party (*per* Kekewich, J.).

Edison v. Holland, 1888, 5 R. P. C. 483.—Certificate that objections were reasonable and proper. (Judgment reversed on appeal.)

43. Costs on the higher scale are sometimes allowed in cases of special difficulty: R. S. C., O. LXV. r. 9. Thus in *Ellington v. Clark*, the Court of Appeal considered that inasmuch as the plaintiffs had brought

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higher scale.

scientific witnesses, and thus forced the defendants also to bring scientific witnesses, the successful defendants should have costs on the higher scale: 1888, 5 R. P. C. 328; see also *Moseley v. Victoria Rubber Co.*, 1887, 4 R. P. C. 241, 57 L. T. (N.S.) 148; *Wenham v. May*, 1887, 4 R. P. C. 310; *Kaye v. Chubb*, 1887, 4 R. P. C. 303; *Kurtz v. Spence*, 1887, 5 R. P. C. 184; *Westinghouse v. Lancashire Rail Co.*, 1884, 1 R. P. C. 103; *Easterbrook v. G. W. R. Co.*, 1885, 2 R. P. C. 212; *Watling v. Stevens*, 1886, 3 R. P. C. 43; *Otto v. Steel*, 1886, 3 R. P. C. 120; *Davies v. Davies*, 1887, 56 L. J. Ch. 481; *Farben Fabrik v. Bowker*, 1891, 8 R. P. C. 397.

The special grounds must rest not merely on the importance of the case, but on the necessity for special expense: *Grafton v. Watson*, 1884, 51 L. T. (N.S.) 141; *American Braided Wire Co. v. Thompson*, 1890, 7 R. P. C. 163. In *Crampton v. Patent Investments Co.*, 1888, 5 R. P. C. 382, the consideration of an application for costs on the higher scale was postponed till after taxation on the lower scale had been made. In *Fraser v. Brescia Tram. Co.*, 1887, 56 L. T. (N.S.) 771, 3 Times' Rep. 587, permission was given to the master to give all or any part of the costs which he thought fit, on the higher scale.

Where, however, the necessity for specially expert evidence arose from the dubious wording of the plaintiffs' specification, costs on the higher scale were refused to him: *Wenham Gas Co. v. Champion Gas Co.*, 1891, 8 R. P. C. 315. In *Siemens v. Taylor*, 1892, 9 R. P. C. 401, costs on the higher scale were refused.

CHAPTER XXIX.

ACTIONS FOR THREATS.

1. **Old practice.**—Actions for damages and injunction to restrain threats were not unknown before the Patents Act of 1883: see *Wren v. Wiold*, 1869, L. R. 4 Q. B. 730; *Dalziel v. Railway Carriage Co.*, cited, L. R. 13 Eq. 358; *Rollins v. Hinks*, 1872, L. R. 13 Eq. 355, 41 L. J. Ch. 358; *Azman v. Lund*, 1874, L. R. 18 Eq. 330; *Halsey v. Brotherhood*, 1881, 19 Ch. D. 386; *Burnet v. Tak*, 1882, 45 L. T. 743; *Sugg v. Bray*, 1886, 1 R. P. C. 45, 2 R. P. C. 223; *Société Anonyme des Glaces v. Tilghman's Sand Blast Co.*, 1883, 25 Ch. D. 1, 53 L. J. Ch. 1; *Sharp v. Brauer*, 1884, 3 R. P. C. 193.

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Actions founded upon threats made before the Act of 1883 proceeded under the old practice. The principles of the old law were, that in order to succeed in the action, the plaintiff must show (1) that the threats were uttered in bad faith, and (2) that he had not infringed. The validity of the patent was assumed, and not allowed to be questioned in such an action.

2. **Modern practice.**—The law relating to threats is now governed by the Patents Act, 1883, s. 32, and provides that an action for damages or an injunction may be brought by any one aggrieved by the threats, provided (1) that the alleged manufacture or use to which post, p. 456.

such threat refers is not an infringement of any legal right of the person making the threat, and (2) that the said person making the threat does not with due diligence commence and prosecute an action for infringement. To say of a person that his patent has been proved to be an infringement is libellous, and an action of libel will lie for it: *Crampton v. Swete*, 1886, 58 L. T. 516.

3. What constitutes a threat.—A threat may be directed not only against something which is going to be done, but against something which has been done, and either will give rise to an action: *Challender v. Royle*, 1887, 36 Ch. D. 427, 4 R. P. C. 363, or it may be directed against the continuance of something which has been done: *Kurtz v. Spence*, 1887, 5 R. P. C. 171. The words “otherwise” in section 32 cover any sort of threat, whether by circulars or by letters directed to the infringer: *Crampton v. Patent Investments Co.*, 1888, 5 R. P. C. 393; *Walker v. Clarke*, 1887, 4 R. P. C. 113; *Driffield v. Waterloo*, 1886, 3 R. P. C. 46, 31 Ch. D. 638; *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, 1889, 6 R. P. C. 367; *Burt v. Morgan*, 1887, 4 R. P. C. 278; *Colley v. Hart*, 1888, 6 R. P. C. 18.

If the threats are addressed to the customers of the plaintiff, he is a person aggrieved, or if the threats are addressed to the customers of his licensees he is aggrieved and can sue: *Burt v. Morgan*, 1887, 4 R. P. C. 278; *Kensington Co. v. Lane Fox Co.*, 1891, 8 R. P. C. 277. General threats may give rise to an action on the part of the person aggrieved by them: *Johnson v. Edge*, 1892, 9 R. P. C. 142; *Challender v. Royle*, 1887, 4 R. P. C. 363, explained in *Day v. Foster*, 1890, 7 R. P. C. 54. In *Skinner & Co. v. Perry*, a letter by a patentee saying in

answer to enquiries, that he considered a certain machine an infringement of his patent, and would stop it, was held to be a threat: 1892, 9 R. P. C. 406, 10 R. P. C. 1.

Any person who by his threats "claims" to be entitled to a patent, may be proceeded against, whether he is really so entitled or not; and as a person who has claimed, but really has no patent rights, cannot protect himself by bringing a patent action, nor by shewing that the article complained of is an infringement, such person is in a very awkward position: see *Kensington Co. v. Lane Fox Co.*, 1891, 8 R. P. C. 277.

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What constitutes a threat.

4. What issues may be raised in an action for threats.—In an action of threats the plaintiff may deny that he has infringed, and may deny the validity of the patent: *Challender v. Royle*, 1887, 4 R. P. C. 363; *Kurtz v. Spence*, 1888, 5 R. P. C. 161, in which the plaintiff maintained that the defendant was not the first and true inventor. The plaintiff will have to give particulars of objections exactly as the defendant would be obliged to do in an infringement action: *Union Electrical Power Co. v. Electrical Power Storage Co.*, 1888, 5 R. P. C. 329; *Law v. Ashworth*, 1890, 7 R. P. C. 86 (Duchy of Lancaster Court case). The defendant will have to give particulars of the patents on which he relied in issuing his threats: *Union Electrical Power Co. v. Electrical Power Storage Co.* (supra). A certificate that the validity of the patent came in question may be granted: *Crampton v. Patents Investments Co.*, 1888, 5 R. P. C. 382. The burden of proof of infringement is on the defendant: *Ungar v. Sugg*, 1889, 6 R. P. C. 337.

5. Interim injunction to restrain threats.—The

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injunction to
restrain
threats.

applicant must show a *primâ facie* case of non-infringement: *Challender v. Royle* (*per* Bowen, L.J.), 1887, 4 R. P. C. 376; *Barney v. United Telephone Co.*, 1885, 2 R. P. C. 173, 28 Ch. D. 394; *Colley v. Hart*, 1889, 6 R. P. C. 20; *Walker v. Clarke*, 1887, 4 R. P. C. 111, must now be considered doubtful law as to part of the dicta contained in it. The application should not be made *ex parte*; *Wilson v. Church Engineering Co.*, 1885, 2 R. P. C. 175. Plaintiff commenced an action to restrain threats, and defendant commenced an action for infringement. Plaintiff moved to restrain the threats, but no order was made, defendant to proceed with diligence and not threaten in the meantime: *Mackie v. Solvo Laundry Co.*, 1892, 9 R. P. C. 465.

The bringing of an infringement action as a justification of the threats.—The action which, if brought promptly, will protect the utterer of the threats from an action against him, need not necessarily be against the person threatened, but against any one who may have infringed the patent: *Challender v. Royle*, 1887, 4 R. P. C. 375; *Day v. Foster*, 1890, 7 R. P. C. 60; nor need such action, if brought *bonâ fide*, necessarily be successful, to protect the person making the threats: *Colley v. Hart*, 1890, 7 R. P. C. 101, 44 Ch. D. 179; *Brauer v. Sharpe*, 1886, 3 R. P. C. 193.

It must be commenced and prosecuted *bonâ fide*, and with due diligence. Thus, where it was only begun a year after the threat, this was held not enough: *Herburger v. Squire*, 1889, 5 R. P. C. 589; but see *Edlin v. Pneumatic Tyre Agency*, 1893, 10 R. P. C. 311. The action must be brought substantially for the same infringement as that in respect of which the threats were made: *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*,

1889, 6 R. P. C. 367. Sometimes the hearing of the motion for an injunction for threats is postponed till the trial of the action for infringement: *Barnett v. Barretts Co.*, 1884, 1 R. P. C. 10.

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threats.

6. Damages for threats were not given where no real stoppage of works occurred in consequence: *Driffield Co. v. Waterloo Co.*, 1886, 3 R. P. C. 46. In *Kurtz v. Spence*, 1887, 5 R. P. C. 161, forty shillings damages were given. The question of damages for threats ought to be tried by the Court on hearing of the action, and not referred: *Ungar v. Sugg*, 1892, 9 R. P. C. 115, and *Herrburger v. Squire*, 1888, 5 R. P. C. 596, 6 R. P. C. 194 (in which also an injunction was granted).

7. Issuing warning circulars. — Even, however, where a plaintiff is suing for infringement, and thus protected from the consequences of uttering threats, under the Patents Act, he is still not at liberty to issue circulars warning the public against using the defendant's goods, for there is a general jurisdiction in the Court to protect the fair trial of the action, and to keep all rights intact till it can be decided. Each case must be considered on its own footing, for it is one thing to warn against the commission of infringements, but another thing to assert that infringements have taken place: *Goulard v. Lindsay*, 1887, 4 R. P. C. 189; *Fusee Vesta Co. v. Bryant & May*, 1887, 4 R. P. C. 191. But where there is no *mala fides* the defendants to an action for threats may, if they continue to prosecute their proceedings for infringement with vigour, go on issuing their circulars—for in this case there is really no statutory case against them—and the only remedy would be by an

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warning
circulars.

interlocutory application by the defendant in the patent suit, on the ground that the action against him was being prejudiced: *Household v. Fairburn*, 1884, 2 R. P. C. 140; and injunctions on this ground ought not to be lightly granted: *Fenner v. Wilson*, 1893, 10 R. P. C. 287.

CHAPTER XXX.

PROCEDURE FOR REVOCATION OF THE PATENT.

1. **Old method.**—The old method of revoking a patent was by *scire facias*, on suggestion that the Queen had been deceived. This made the patent utterly void: Chap. XVII., sect. 1.

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ante, p. 258.

The writ of *scire facias* issued out of the Petty Bag Office of the Court of Chancery directed to the sheriff of the county where the defendant dwelt, commanding him to “give notice” (*scire facias*) to the patentee that the Queen had been informed that his patent was invalid, and requiring him to come into Court to shew why it should not be cancelled. As soon as the writ had been served, and the patentee was “in Court,” the Attorney-General on behalf of the Queen filed a declaration against him, to which he pleaded, and when all the issues were joined, a writ of *venire facias* was issued to summon a jury returnable in the Queen’s Bench. The trial having taken place the verdicts were returned into the Chancery, and if the verdict was against the patentee, the patent was ordered to be brought in to be cancelled, which could be enforced by attachment. As the proceedings on *scire facias* were between the Crown and the subject, no costs could be given on either side, the patentee could not plead double; in fact, the proceedings all bore the stamp of a suit in which the

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—
Old method.

Crown was prosecutor. The party who set the proceedings on foot, had to give a bond to secure the payment of costs to the patentee, if the patent were upheld, but if the patent were cancelled the petitioner got no costs.

The Patent Act, 1883, substituted proceedings by way of petitions for revocation. In them, interrogations can be administered and discovery had; in fact the petition resembles an action, though perhaps it is a moot point whether on such proceedings estoppel arising from a previous trial between the same parties could be set up.

post, p. 452.

2. New procedure.—The proceedings by *scire facias* are now abolished and proceedings for revocation are substituted, which may be presented in all cases in which *scire facias* would have lain: Patents Act, 1883, sect. 26, 109 (Scotland); except where the patent is assigned to the Secretary of State for War: sect. 44, sub-s. 3, 9.

A petition may be presented by the Attorney-General or by any one authorized by him, or by any one alleging that the patent was obtained in fraud of his rights, or that he was the true inventor, or that he had previously publicly used the invention.

3. Attorney-General's fiat.—This is obtained by sending to Room No. 519, Royal Courts of Justice, the following documents:—

- (1.) Memorial to the A.-G. asking for his authority and stating all the circumstances.
- (2.) Statutory declaration verifying the statements in the memorial.
- (3.) Two copies of the proposed petition and of the

particulars proposed to be delivered with it under sect. 26 (5).

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(4.) Certificate of a barrister that the petition is proper to be authorized by the A.-G.

Attorney-
General's fiat

(5.) Certificate by a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is competent to answer the costs of all proceedings in connection with the petition if unsuccessful.

The Attorney-General may grant leave *ex parte*, or else may direct the patentee to appear before him. The fiat has been granted without notice to the patentees: *Goulard & Gibbs' Patent*, 1887, Griff. 320.

The grounds of such an application to the Attorney-General may be, that the person who desires to petition has made an invention which the respondent has claimed as embraced in his patent: *Ferranti's Application (Goulard & Gibbs' Patent)*, Griff. 320, 5 R. P. C. 529, 6 R. P. C. 215. A fiat was granted on a similar ground to *King's Trustees*, against whom *Rothwell* had commenced an action which was abandoned: 1886, Griff. 320, 3 R. P. C. 379, 4 R. P. C. 76, 397. The fiat was refused where an action was pending in Scotland: *Bell & Coleman's Patent*, Griff. 320. The fiat was refused in *Siddell's Case* upon the patentee undertaking to bring an action: Griff. 320. Where the application is abandoned, there is no power to give costs: *Martin's Patent*, Griff. 320.

No costs can be given on such application, though by consent they may be made costs in the cause: Griff. 320.

4. Locus of petitioner who has not obtained the Attorney-General's fiat.—This is regulated by Patents Act, 1883, sect. 26, sub-s. 4.

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SECT. 4.

Locus of
petitioner
who has not
obtained the
Attorney-
General's fiat.

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(a.) **Patent obtained in fraud of another:** *Edge v. Harrison*, 1891, 8 R. P. C. 74. A certain Mrs. Edge, who happened to be in the employ of a patentee of the same name, took out, in conjunction with the patentee's foreman, Harrison, a patent for a wrapper for blue dye, and then with Harrison proceeded to sell dye wrapped up in the wrapper under the name of "Edge's Blue." A petition was lodged for revocation of the patent, and an action of fraud brought against Harrison. The action and petition came on for hearing before a jury who found a verdict for £500 damages, and the patent was revoked. See also *Gale's Patent*, 1891, 8 R. P. C. 438.

(b.) **First and true inventor.**—A person to whom a patent had been granted petitioned for the revocation of a patent subsequently granted to another, on the ground that he was the first and true inventor. This was held to give him a good locus, but the inventions were considered different; so his petition failed: *Walker v. Hydro-Carbon Syndicate*, 1884, 2 R. P. C. 3; *Gale's Patent*, 1891, 8 R. P. C. 439.

(c.) **Any one who has publicly used the invention prior to the date of the patent may present a petition for its revocation:** *Haddan's Patent*, 1885, 2 R. P. C. 218; *Morgan's Patent*, 1888, 5 R. P. C. 186; *Edmond's Patent*, 1889, 6 R. P. C. 355.

5. **When once a petitioner has a locus, he may impeach the patent on any ground:** *Morgan's Patent*, 1888, 5 R. P. C. 186. A petition for revocation may be ordered to be tried at the same time as an action for infringement: *Edge's Patent*, 1890, W. N. 149.

6. **A petition for revocation is in reality precisely analogous to a defence to an action for infringement:**

Goulard & Gibbs' patent, 1887, 34 Ch. D. 396. Hence interrogatories may be allowed: *Haddan's Patent*, 1885, 54 L. J. Ch. 126; and query whether the writ may be served out of the jurisdiction on a Scotchman resident in Scotland: *Drummond's Patent*, 1889, 6 R. P. C. 576, 43 Ch. D. 80.

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A petition for revocation is in reality precisely analogous to a defence to an action for infringement.

7. Particulars of objections must be delivered with the petition: Patents Act, 1883, sect. 26, sub-s. 5; which may by leave be amended: ss. 6. For forms of such particulars, see 2 R. P. C. 219, 3 R. P. C. 356. No certificate of particulars under sect. 29, ss. 6, can be given on a petition for revocation: *Goulard & Gibbs' Patent*, 1888, 5 R. P. C. 526; hence it is to be presumed that a successful party would get his costs without such certificate. But costs of issues might no doubt be apportioned under the Supreme Court rules, which would come to the same thing as a certificate.

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8. The defendant begins on a petition for revocation: Patents Act, 1883, sect. 26, sub-s. 7.

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9. On the order for revocation being made, a copy of it must be left at the Patents Office: P. R., 1890, r. 74.

post, p. 497.

10. On revocation for fraud, the comptroller may, on the application of the true inventor, grant a patent to him of co-ordinate date and term with that revoked.—Patents Act, 1883, sect. 26, sub-s. 8. All parties interested in the patent should be joined as defendants. *Re Avery's Patent*, 1887, 4 R. P. C. 159.

CHAPTER XXXI.

APPEALS.

CHAP. XXXI.
SECT. 1.
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1. Appeals are now by way of re-hearing: R. S. C., 1883, O. LVIII., r. 1. If the respondent is also dissatisfied with the judgment or order, he should give notice of a cross appeal: *ibid.* r. 6. Security for costs of appeal is ordered in case of bankruptcy: *United Telephone Co. v. Bassano*, 1886, 31 Ch. D. 630; and if such security is not given, the appeal may, after a reasonable period (say three months), be dismissed: *Washburn Co. v. Patterson*, 1885, 2 R. P. C. 27, 29 Ch. D. 48.

ibid., p. 454.

The Court of Appeal may either order a new trial or re-try the case themselves: R. S. C., O. LVIII., rr. 4, 5; and may call in an assessor.

2. The Court of Appeal may receive further evidence, but only by special leave, and on special grounds: R. S. C., O. LVIII., r. 4; and they may do so upon appeals from interlocutory orders and *inter alia* on motions for interim injunctions, sequestrations, and attachments: *Spencer v. Ancoats Vale Co.*, 1888, 6 R. P. C. 54. The usual test which applies in such a case is whether the party asking to adduce fresh evidence could, with reasonable diligence, have obtained it at the trial; if so,

he will in general not be allowed to bring it forward on appeal: *Hinde v. Osborne*, 1885, 2 R. P. C. 47.

Walker v. Hydro-Carbon Syndicate, 1886, 3 R. P. C. 253:—A petition was presented for revocation on the ground of a prior patent granted to the petitioner for the same invention. At the trial the respondents produced a patent to one Wise, which they contended rendered the petitioner's patent invalid. The petitioner, being defeated, appealed, and on the appeal applied to adduce further evidence on the ground that he was surprised by the production of Wise's patent. But this was refused, as it was shewn that *before the hearing* he had been cross-examined as to Wise's patent on an examination before an examiner, and therefore he knew of it, and ought to have come prepared with his evidence.

Blakey v. Latham, 1889, 6 R. P. C. 186: Where it was alleged that two witnesses had sworn falsely in the court below, the C.-A. allowed them to be re-summoned.

American Braided Wire Co. v. Thomson, 1888, 5 R. P. C. 113: Further evidence was admitted on the ground that defendants had been misled by the opening of the plaintiffs' case. In *Nordenfeldt v. Gardner*, where a plaintiff had made one omission in a chain of assignments, this would in the Court of Appeal have been allowed to be corrected had the objection been insisted on: 1884, 1 R. P. C. 61.

The application to hear further evidence should be made in time, and where an appellant only produced on the second day of the appeal an affidavit that the facts had not been previously known to him, it was held that his application was too late: *Watling v. Stevens*, 1886, 3 R. P. C. 150.

Where the judge below is believed to have deterred

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The Court of Appeal may receive further evidence, but only by special leave.

CHAP. XXXI.
SECT. 2.

The Court of Appeal may receive further evidence, but only by special leave.

a party from adducing evidence, the C. A. will allow his recall: *Britain v. Hirsch*, 1888, 5 R. P. C. 226.

3. The judge's notes in the Court below must be ready, and it is the duty of the appellants to get a copy of them and lodge it. The notes of counsel may be referred to, and also the notes of a regular professional shorthand writer, if verified; but notes even in shorthand made by a solicitor's clerk would not be permitted to be referred to: *Ellington v. Clark*, 1888, 5 R. P. C. 322. The Court of Appeal as a rule requires that reports cited before it should have been taken by barristers as a guarantee that the legal questions are properly stated.

If the judge's notes are not ready, the case may be ordered to stand over at the appellant's expense.

4. Costs on appeals.—On appeal, costs generally follow success; but an appellant who appeals on two grounds, and only succeeds on one, and has the other decided against him, may lose his costs: *Moore v. Bennett*, 1884, 1 R. P. C. 129. Costs paid below may be ordered to be refunded on appeal: *Kaye v. Chubb*, 1888, 5 R. P. C. 653.

In granting costs the conduct of the parties is looked to. Thus where, after judgment given in the Court below, the Appeal Court in another case decided the same point differently:—the appellants wrote to the respondents desiring that they would consent to a modification of the judgment in accordance with the law just laid down, but otherwise offering to withdraw the appeal which they had lodged. The respondents insisted on their going on with the appeal. Held, that this conduct was unreasonable, and defendants ordered to pay

all the costs from the date of their unreasonable refusal: **CHAP. XXXI.**
De Vitre v. Betts, 1873, L. R. 6 H. L. C. 319. **SECT. 4.**

(N.B.—It will be understood that the above notes on practice only embrace such points as are peculiar to, or have been decided in, patent cases. The practice in patent actions, in general, of course follows the usual rules of the H. C. J.)

Costs on
Appeals.

In jury cases, of course, a new trial may be ordered:
 R. S. C., O. xxxix.

CHAPTER XXXII.

OFFENCES.

CH. XXXII.
SECT. I.

1. **Selling unpatented articles as patented.**—By the Common Law it was actionable to pass off goods as those of another person, either by putting them in wrappers or by marking them so as to deceive. This Common Law right existed quite independently of the Trade Marks Act or of other Statutes: *Sykes v. Sykes*, 1824, 3 B. & C. 541; *Blofield v. Payne*, 1833, 4 B. & Ad. 410; and was also enforced by injunction: *Ransome v. Bentall*, 1834, 3 L. J. (N.S.) Ch. 161; *Knott v. Morgan*, 1839, 2 Keen. 213. By the Patents Act, 1835, a penalty was imposed for doing so, but this Act is repealed by the Patents Act, 1883, which provides that “any person who represents that any article sold *by him* . . . is a patented article when no patent *has been granted* for the same shall be liable to a fine not exceeding £5 on summary conviction.” Under this section, in order to justify the sale of the alleged patented article, it is necessary that the patent should have been *granted*, not merely applied for: *Reg. v. Crampton*, 1886, 3 R. P. C. 367; nor provisionally protected: *Reg. v. Wallis*, 1886, 3 R. P. C. 1.

post, p. 470.

The section is somewhat obscure. If a man sold an article marked “patent,” would it be competent for him to shew that it once was patented though the patent had expired? Or again, would he be liable if he sold an

article marked patent, when in truth it was an infringement of someone else's patent? The words, "has been granted *for the same*," seem to shew that the patent must have been granted for the article sold, and that therefore, an infringer would be liable if he sold an unauthorized infringement of someone else's patent. The point arose in *Reg. v. Walliss*, but was not decided.

CH. XXXII.
SECT. 1.

Selling
unpatented
articles as
patented.

2. **Falsification of registers** is a misdemeanour: Patents Act, 1883, s. 93. This includes "causing falsification." Falsely assuming the name of a patent agent is also punishable: see Chap. XIV., sect. 1; Patents Act, 1888, s. 1. *post*, p. 465. *post*, p. 479.

3. **To assume the Royal Arms, or a colourable imitation of them** is also punishable on summary conviction by a fine not exceeding £20: Patents Act, 1883, s. 106. *post*, p. 471.

CHAPTER XXXIII.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

(As to practice, see *P. O. Circular*, *post*, p. 555.)

CH. XXXIII. THE growth of trade and increase of intercourse among nations, made the want of international patent arrangements felt, and on March 20th, 1883, a convention was signed at Paris by several Powers to which a number of others have now adhered.

post, p. 458.

post, p. 469.

post, p. 472.

This convention is given in the appendix. By Patents Act, 1883, ss. 103, 104, powers were given to the Crown to join in this convention. The effect of the convention is to give any one who applies for a patent in one of the countries or colonies seven months within which to apply in any of the other countries. During the seven months he is protected from the effects of publication of his invention by other persons, and he has a prior right to have the patent granted to him over other persons. In fact, by applying for a patent in one country, he obtains what is very analogous to a seven months' provisional protection in all the others.

post, p. 488.

An application in Great Britain for a patent for an invention which has been previously patented in one of the countries of the Union must be made on Form A2, and see Patent Rules, 1890, rr. 24-29; several cases have been decided under this branch of the Act of 1883, viz., *Re Everett*, 1888, Griff. App. 29.

Main's Patent, 1890, 7 R. P. C. 13, which decided that when a country adopts the convention, patents in that country prior to the date of the convention acquire the advantages of it. CH. XXXIII

The rights granted by the convention are personal rights, and hence the contemporaneous patents can only be granted to the same persons as those who took out the foreign patent: *Re Shallenberger*, 1889, 6 R. P. C. 550; *Re Van de Poele*, 1889, 7 R. P. C. 69. A corporation can apply: *Re Carez*, 1889, 6 R. P. C. 552.

It is necessary for the person who wishes to avail himself of the privileges of sects. 103, 104, to apply properly, for if he applies in the ordinary way, and has his patent dated as of the date of the application and not antedated back to his first patent in the other country, he will be taken to have elected to take out simply an English patent, and not to be entitled to the protection against publication given by sect. 103: *British Tanning Co. v. Groth*, 1891, 8 R. P. C. 113. This disposes of the doubts raised in *L'Oiseau & Pierraud's Patent*, 1887, Griff. App. 36. post, p. 469.

A copy of a translation of the Convention of Paris will be found in the Appendix. The following countries and colonies have adopted it:—

Belgium.	New Zealand.
Brazil.	Norway.
Curaçao.	Portugal.
Surinam.	Queensland.
East Indian Colonies of the Netherlands.	San Domingo.
France.	Servia.
Great Britain.	Spain.
Guatemala.	Sweden.
Italy.	Switzerland.
Netherlands.	Tunis.
	United States.

CH. XXXIII. and similar arrangements have also been made with Mexico, Paraguay, Roumania (Designs and Trade Marks only), Hungary: (see Circular of Information, para. 22, Appendix).

post, p. 474.

ante, p. 263.

Note that by Patents Act, 1883, s. 117, the Channel Islands are not included in the words, "British Possessions." On the other hand, the Patents Acts do not apply to it.

It is not the purpose of the present work to deal with foreign patents. The patent laws of the world have been collected in a most useful work by Mr. Carpmael, which has been continued and brought up to date by a Committee of the Institute of Patent Agents. Mr. Lloyd Wise has also a book in the press upon the same subject, portions of which have been published in the weekly journal, *Work*.

APPENDIX OF STATUTES.

The only Statutes in force as to Patents are the Statute of Monopolies, 21 James I. c. 3, and the Patent Acts of 1883, 1885, 1886, and 1888.

21 JAC. 1, c. 3.

[A.D. 1623 (*k*).] 21 Jac. 1, c. 3.

An Act concerning Monopolies and Dispensations with Penal Laws, and the Forfeitures thereof.

“Forasmuch as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did, in the year of our Lord God one thousand six hundred and ten, publish in print to the whole realm, and to all posterity, that all grants of monopolies, and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty’s laws, which your Majesty’s declaration is truly consonant and agreeable to the ancient and fundamental laws of this realm: And whereas your Majesty was further graciously pleased expressly to command that no suitor should presume to move your Majesty for matters of that nature; yet nevertheless upon misinformations and untrue pretences of public good, many such grants have been unduly obtained, and unlawfully put in execution, to the great grievance and inconvenience of your Majesty’s subjects, contrary to the laws of this your realm, and contrary to your Majesty’s most royal and blessed intention so published as aforesaid.” For avoiding whereof, and preventing the like in time to come, may it please your excellent Majesty, at the humble suit of the Lords spiritual

All monopolies, &c., shall be void.

and temporal, and the Commons, in this present parliament assembled, that it may be declared and enacted, and be it declared and enacted, by authority of this present parliament, that all monopolies and all commissions, grants, licenses, charters, and letters patent heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of any thing within this realm or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty to dispense with any others, or to give license or toleration to do, use, or exercise any thing against the tenor or purport of any law or statute, or to give or make any warrant for any such dispensation, license, or toleration to be had or made; or to agree or compound with any others for any penalty or forfeitures limited by any statute; or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money, that is or shall be due by any statute, before judgment thereupon had; and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same, or any of them, are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in nowise to be put in ure or execution.

Monopolies,
&c., shall be
tried by the
common laws
of this realm.

2. And be it further declared and enacted by the authority aforesaid, that all monopolies, and all such commissions, grants, licenses, charters, letters patent, proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things tending as aforesaid, and the force and validity of them and of every of them, ought to be and shall be for ever hereafter examined, heard, tried and determined, by and according to the common laws of this realm, and not otherwise.

All persons
disabled to
use monop-
lies, &c.

3. And be it further enacted by the authority aforesaid, that all person and persons, bodies politic and corporate whatsoever, which now are or hereafter shall be, shall stand

and be disabled and incapable to have, use, exercise, or put in use any monopoly, or any such commission, grant, license, charter, letters patent, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, or any liberty, power or faculty, grounded or pretended to be grounded upon them or any of them.

4. And be it further enacted by the authority aforesaid, that if any person or persons, at any time after the end of forty days next after the end of this present session of parliament, shall be hindered, grieved, disturbed, or disquieted, or his or their goods or chattels any way seized, attached, distrained, taken, carried away, or detained, by occasion or pretext of any monopoly, or of any such commission, grant, license, power, liberty, faculty, letters patent, proclamation, inhibition, restraint, warrant of assistance or other matter or thing tending as aforesaid, and will sue to be relieved in or for any of the premises; that then, and in every such case, the same person or persons shall and may have his and their remedy for the same at the common law, by any action or actions, to be grounded upon this statute; the same action or actions to be heard and determined in the Courts of King's Bench, Common Pleas, and Exchequer, or in any of them, against him or them, by whom he or they shall be so hindered, grieved, disturbed, or disquieted, or against him or them by whom his or their goods or chattels shall be so seized, attached, or distrained, taken, carried away, or detained; wherein all and every such person and persons, which shall be so hindered, grieved, disturbed, or disquieted, or whose goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained, shall recover three times so much as the damages which he or they sustained by means or occasion of being so hindered, grieved, disturbed, or disquieted, or by means of having his or their goods or chattels seized, attached, distrained, taken, carried away, or detained, and double costs; and in such suits, or for the staying or delaying thereof, no essoin, protection, wager of law, aid-prayer, privilege, injunction, or order of restraint, shall be

The party grieved by pretext of a monopoly, &c., shall recover treble damages and double costs.

He that delayeth an action grounded upon this statute incurs a præmunire.

in any wise prayed, granted, admitted, or allowed, nor any more than one imparlance: And if any person or persons shall, after notice given, that the action depending is grounded upon this statute, cause or procure any action at the common law, grounded upon this statute, to be stayed or delayed before judgment, by colour or means of any order, warrant, power or authority, save only of the Court wherein such actions as aforesaid shall be brought and depending, or after judgment had upon such action, shall cause or procure the execution of or upon any such judgment to be stayed or delayed by colour or means of any such order, warrant, power, or authority, save only by writ of error or attain; that then the said person and persons so offending, shall incur and sustain the pains, penalties, and forfeitures ordained and provided by the statute of provision and præmunire made in the sixteenth year of the reign of King Richard the Second.

[Sec. 5 is repealed, Stat. Law Rev. Act, 1883.]

Letters patent hereafter to be granted for fourteen years, for new manufactures, saved.

ante, p. 19.

6. Provided also, and be it declared and enacted, that any declaration before-mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures within this realm to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patent and grant shall not use, so as also they be not contrary to the law nor mischievous to the state by raising prices of commodities at home, or hurt of trade, or generally inconvenient: The said fourteen years to be accomplished from the date of the first letters patent or grants of such privilege hereafter to be made, but that the same shall be of such force as they should be if this Act had never been made, and of none other.

This Act not to extend to grants sanctioned by Parliament.

7. Provided also, and it is hereby further intended, declared, and enacted by authority aforesaid, that this Act, or any thing therein contained, shall not in any wise extend or be prejudicial to any grant, or privilege, power, or authority whatsoever, heretofore made, granted, allowed

and confirmed by any Act of Parliament now in force, so long as the same shall continue in force.

8. Provided also, that this Act shall not extend to any warrant or privy seal, made or directed or to be made or directed by his Majesty, his heirs or successors, to the justices of the Courts of the King's Bench or Common Pleas, and barons of the Exchequer, justices of assize, justices of oyer and terminer and gaol-delivery, justices of the peace, and other justices for the time being, having power to hear and determine offences done against any penal statute depending in suit and question before them, or any of them respectively, after plea pleaded by the party defendant.

Warrants
granted to
justices, saved.

9. Provided also, and it is hereby further intended, declared, and enacted, that this Act, or any thing therein contained, shall not in any wise extend or be prejudicial unto the city of London, or to any city, borough, or town corporate within this realm, for or concerning any grants, charters, or letters patent, to them or any of them; or unto any corporations, companies, or fellowships of any art, trade, occupation, or mystery, or to any companies or societies of merchants within this realm, erected for the maintenance, enlargement, or ordering of any trade of merchandise; but that the same charters, customs, corporations, companies, fellowships and societies, and their liberties, privileges, powers, and immunities, shall be and continue of such force and effect as they were before the making of this Act, and of none other; any thing before in this Act contained to the contrary in any wise notwithstanding.

Charters
granted to
corporations,
saved.

[The rest of the Statute is repealed by Stat. Law Rev. Act, 1863, and P. Act, 1883.)

THE 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. [25th August, 1883.]

post, p. 475. 48 & 49 VICT. c. 63.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [14th August, 1885.]

post, p. 477. 49 & 50 VICT. c. 37.—An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions. [25th June, 1886.]

post, p. 479. 51 & 52 VICT. c. 50.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883. [24th December, 1888.]

(The repealed parts are printed in italics, and the additions in heavier type.)

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.

PRELIMINARY.

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

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

Division of
Act into parts.

- Part I.—PRELIMINARY.
- II.—PATENTS.
- III.—DESIGNS.
- IV.—TRADE MARKS.
- 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.

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.

Persons en-
titled to apply
for patent.

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

ante, p. 228.

Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent.

Act 1885,
s. 5.

Power to
grant patents
to several
persons
jointly.

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; and must be left at, or sent by post to, the Patent Office in the prescribed manner.

Application
and specifica-
tion.

ante, p. 337.

(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.

post, p. 510.

Act 1885,
s. 2.
(5 & 6 Will. 4,
c. 62.)

The declaration may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed.

ante, pp. 201,
177.

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

(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.

The same drawings may accompany both specifications.

Act 1886,
s. 2.
ante, p. 201.

The requirement of this sub-section as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provisional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings, but referred to those which accompanied the provisional specification.

ante, p. 168.

(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.

ante p. 195.

Reference of application to examiner.

ante, p. 240.

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, and the title sufficiently indicates the subject-matter of the invention.

Power for comptroller to refuse application or require amendment.

Repealed by
Act 1888, s. 2.

[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.*

(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, 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, 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.]*

“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 refuse to accept the application, or require that the application, specification, or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with.*

“(2.) *Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision 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 application shall be accepted.*

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

“(5.) *If, after an application for a patent has been made,*

Act 1888

s. 2.

Power of
comptroller to
refuse appli-
cation or
require
amendment.

ante, p. 241.

but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon."

Time for leaving complete specification.

Act 1885,
s. 3.
ante, p. 242.

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.

A complete specification may be left within such extended time, not exceeding one month after the said nine months, as the comptroller may on payment of the prescribed fee allow.

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

Comparison of provisional and complete specification.
ante, p. 243.

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, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional 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 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.

ante, p. 244.

(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.

A complete specification may be accepted within such extended time, not exceeding three months after the said twelve months, as the comptroller may on payment of the prescribed fee allow.

Act 1885,
s. 3.

(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.

ante, p. 241.

Repealed.
Act 1888,
s. 3.

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.

Advertisement
on acceptance
of complete
specification.
ante, p. 244.

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], or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification, but on no other ground.

Opposition to
grant of
patent.
ante, p. 246.

Repealed.
Act 1888,
s. 4.

Act 1888,
s. 4.

(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, 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.

Sealing of
patent.
ante, p. 258.

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.

(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.

Act 1835,
s. 3.

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine and twelve months respectively as the comptroller may on payment of the prescribed fee allow, and where such extension of time has been allowed, a further extension of four months after the

said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

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.

Date of patent.
ante, p. 315.

ante, p. 266.

Where an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanying or left in connexion with such application, shall not at any time be open to public inspection or be published by the comptroller.

Specifications, &c., not to be published unless application accepted.

Act 1885,
s. 4.

ante, p. 176.

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.
ante, p. 176.

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 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 proceedings for infringement unless and until a patent for the invention has been granted to him.

Effect of acceptance of complete specification.

Patent.

Extent of
patent.
ante, p. 263.
Term of
patent.

16. Every patent when sealed shall have effect throughout the United Kingdom and the Isle of Man : (*post*, p. 472).

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.

ante, p. 270.

(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.

(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 :

post, p. 551.

(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 he shall think fit, refuse to award or give any damages in respect of such infringement.

Amendment of Specification.

Amendment
of specifica-
tion,
ante, p. 215.
post, p. 494.

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.

(2.) The request and the nature of such proposed amend-

ment 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.

(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.

(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 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. *ante*, p. 225.

(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.*] Repealed. Act 1888, s. 5.

(10.) The foregoing provisions of this section do not apply Act 1888, s. 5.

when and so long as any action for infringement or proceeding for revocation of a patent is pending.

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

ante, p. 215.

19. 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.

Restriction on recovery of damages.

ante, p. 225.

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.

Advertisement of amendment.

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

Compulsory Licenses.

Power for Board to order grant of licenses.

ante, p. 290.

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 licenses on reasonable terms—

- (a) The patent is not being worked in the United Kingdom; or
- (b) The reasonable requirements of the public with respect to the invention cannot be supplied; or
- (c) Any person is prevented from working or using to the best advantage an invention of which he is possessed,

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

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 licenses under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed.

Register of patents.

See sects. 85, 87, 88, 89, 90, 91, 93, 101, 114. and ante, p. 267.

(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, licenses, and any other documents affecting the proprietorship in any letters patent or in any license thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.

Fees.

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 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.

Fees in schedule. ante, p. 270.

(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.

post, pp. 493, 505.

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

ante, p. 326. Extension of term of patent on petition to Queen in Council.

petition must be presented at least six months before the time limited for the expiration of the patent.

ante, p. 332.

(2.) Any person may enter a caveat, addressed to the registrar of the council at the council office, against the extension.

ante, p. 329.

(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.

ante, p. 333.

(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.

ante, p. 344.

(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.

post, p. 567.

(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.

ante, p. 452.

(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.

Revocation.

Revocation of patent.

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

(2.) Revocation of a patent may be obtained on petition to the Court. *See Chap. XXX. ante, p. 422.*

(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.

(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.

Crown.

Patent to bind
Crown.
ante, p. 272.

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.

Legal Proceedings.

Hearing with
assessor.

ante, p. 385.

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

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

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

sect. 83, p. 463.

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. *ante*, p. 352.

(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. *ante*, p. 365.

(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.

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. *ante*, pp. 379, 397, 401.

31. In an action for infringement of a patent, the Court or a judge may certify that the validity of the patent came in question; and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action on obtaining a final order or judgment in his favour shall have his full costs, charges and expenses, as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same. Certificate of validity questioned and costs thereon. *ante*, p. 406.

Remedy in case of groundless threats of legal proceedings.

ante, p. 415.

32. Where any person claiming to be the patentee of an invention, by circulars, advertisements or otherwise threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to which the threats related was not in fact an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent.

Miscellaneous.

Patent for one invention only.

sect. 102 (2),
post, p. 467.

33. Every patent may be in the form in the First Schedule to this Act, and shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.

Patent on application of representative of deceased inventor.

ante, p. 229.

34. (1.) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.

(2.) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

Patent to first inventor not invalidated by application in fraud of him.

ante, p. 256.

35. A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that of a fraudulent application during the period of provisional protection.

Assignment for particular places.

36. A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as

if the patent were originally granted to extend to that place or part only. *ante*, p. 275.

37. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may at any time cause a duplicate thereof to be sealed. *Loss or destruction of patent. ante*, p. 164

38. The law officers may examine witnesses on oath and administer oaths for that purpose under this part of this Act, and may from time to time make, alter, and rescind rules regulating references and appeals to the law officers and the practice and procedure before them under this part of this Act; and in any proceeding before either of the law officers under this part of this Act, the law officer may order costs to be paid by either party, and any such order may be made a rule of the Court. *Proceedings and costs before law officer. post*, p. 500. *ante*, p. 255.

39. The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely,— *Exhibition at industrial or international exhibition not to prejudice patent rights. ante*, p. 149.

(a) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so; and

(b) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

Whereas it is expedient to provide for the extension of this section to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:

Protection of
patents and
designs ex-
hibited at
international
exhibitions.

Act 1886,
s. 3.

It shall be lawful for Her Majesty, by Order in Council, from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to Her Majesty in Council may seem fit.

Publication of
illustrated
journal, in-
dexes, &c.

40. (1.) The comptroller shall cause to be used periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and any other information that the comptroller may deem generally useful or important.

(2.) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents for the time being in force, with their accompanying drawings, if any.

(3.) The comptroller shall continue, in such form as he may deem expedient, the indexes and abridgments of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgments of specifications, catalogues and other works relating to inventions, as he may see fit.

Patent
Museum.

41. The control and management of the existing Patent Museum and its contents shall from and after the commencement of this Act, be transferred to and vested in the Department of Science and Art, subject to such directions as her Majesty in Council may seem fit to give.

Power to re-
quire models
on payment.

42. The Department of Science and Art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model; the amount to be settled, in case of dispute, by the Board of Trade.

Foreign vessels
in British
waters.

43. (1.) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel