

that this order was made with the plaintiff's consent, and therefore it constitutes no exception to the rule of common law which is still in force.

SECT. 5.—STATEMENT OF CLAIM.

Statement of claim.

The form of statement of claim in an action of infringement, given in the Appendix to the Rules of the Supreme Court, 1883 (*c*), contains the following material allegations, viz., the number, term, date, and subject-matter of the plaintiff's patent, the plaintiff's interest therein, the fact of infringement by the defendant, and a claim for injunction and damages.

More complete forms of statement of claim will be found in the Appendix (*d*).

Unnecessary allegations.

It is not necessary to allege the novelty of the invention (*e*), or that the patentee has duly paid the instalments of stamp duties necessary to keep the patent alive (*f*), nor is any reference to the specification required, as formerly (*g*).

The statement of claim must state such a case, however, as will justify the Court in granting the injunction asked for (*h*).

In *Edison and Swan Electric Light Co. v. Holland* (*i*), an inquiry as to damages and delivery up of infringing articles were asked for by the statement of claim, but by an oversight were omitted to be claimed at the trial. Kay, J., on a motion by special leave on behalf of the plaintiffs, who were successful in the action, ordered the minutes of the decree to be varied so as to include the relief asked for in the statement of claim.

A separate cause of action from that endorsed on the writ must not be set out in the statement of claim. A recent action (*j*) for infringement of a patent was commenced by a writ claiming the usual relief. In their statement of claim the plaintiffs introduced a statement that they had discontinued, and paid the costs of a previous action brought by them against the same defendants for infringement, in consequence of evidence given by the defendants,

(*c*) Appendix C. Sect. VI. No. 6; and see p. 782.

(*d*) Pages 782 *et seq.*

(*e*) *Amory v. Brown*, 1869, L. R. 8 Eq. 663-64, per Sir W. M. James, V.-C.: "The allegation of the grant, and the production of the letters patent, throw upon the defendant the *onus* of disputing the novelty."

(*f*) *Sarazin v. Hamel*, 1863, 32 Beav.

145.

(*g*) *Kay v. Marshall*, 1836, 2 Web. P. C. 39; *Westhead v. Keene*, 1838, 1 Beav. 289; 2 Web. P. C. 36, n., per Lord Langdale, M. R.

(*h*) *Curtis v. Cutts*, 1839, 8 L. J. Ch. 184.

(*i*) 1888, 6 P. O. R. at p. 483.

(*j*) *United Telephone Co. v. Tasker* (No. 2), 1889, 6 P. O. R. 38.

which evidence the plaintiffs had since ascertained to be false, and they claimed that the present action might be treated as supplemental to the previous action, and that the defendants might be ordered to repay the costs paid to them and to pay the plaintiffs' costs, charges, and expenses of that action as between solicitor and client. The defendants moved, under Ord. XIX. r. 27, to strike out such statement and claim as embarrassing. It was held, that it was irregular under such a writ to introduce a separate cause of action in the statement of claim; that it would be inconvenient to try such separate causes in this action; that the Court had power to strike out such pleadings, either under Ord. XVIII. r. 1, or Ord. XIX. r. 27; and that the proper order to make was to strike out those claims and leave the plaintiffs at liberty, if they pleased, to bring a separate action, the judge expressing an opinion that such action ought to be brought in the Queen's Bench Division. The motion was therefore allowed with costs.

SECT. 6.—PARTICULARS OF BREACHES (*k*).

In an action for the infringement of a patent, the plaintiff must deliver with his statement of claim, or by order of the Court or a judge at any subsequent time, particulars of the breaches complained of (*l*); and at the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement of which particulars are not so delivered (*m*).

Particulars of breaches with the claim.

The history of these provisions is as follows:—

At common law the Courts had, under their general jurisdiction, and irrespective of any statute to that effect, power to order particulars of an alleged infringement, and so prevent a defendant from being taken by surprise (*n*). The two cases in which this doctrine was laid down illustrate the principles on which the Courts acted in dealing with applications of this nature.

History of particulars in patent actions.

Perry v. Mitchell (*n*) was an action for the infringement of two letters patent for improvements in pens, and the specification set forth and described thirteen different pens, containing an indefinite number of slits and adjustments. The declaration assigned as breaches the making, &c. pens and nibs, in imitation of parts

(*k*) For forms, see pp. 784 *et seq.*

(*l*) Patents Act, 1883, s. 20, sub-s. 1.

(*m*) *Ibid.* sub-s. 4.

(*n*) *Perry v. Mitchell*, 1840, 1 Web. P. C. 269; *Electric Telegraph Co. v. Nott*, 1847, 16 L. J. C. P. 174; 4 C. B. at p. 471, per Wilde, C. J.

of the said invention, with divers additions thereto and subtractions therefrom. It was pointed out, on behalf of the defendant, that inasmuch as neither the parts, nor the additions or subtractions, were mentioned, it would be impossible to prepare the notice of objections to be delivered with the pleas, or to know what evidence to adduce. The Court of Exchequer ordered the plaintiff to give particulars by the number of the pens on which infringements were alleged, and the following notice was given accordingly: "The pens to which the declaration in this cause refers, and the number of such pens in the specification, referred to in the declaration, are as follows" (setting forth the number and figures of the diagrams).

In *Electric Telegraph Co. v. Nott* (*k*), the specification claimed a combination of numerous improvements in electric telegraphs. The defendant obtained a rule nisi for particulars in writing of the alleged infringements, but it was discharged by the Court of Common Pleas on the grounds that the plaintiff would be greatly embarrassed thereby, and that, as the matter had already (*l*) been the subject of a motion for an injunction in Chancery, there was little probability of surprise on the defendant for want of the information required.

Particulars
of objections
under Lord
Brougham's
Act.

5 & 6 Will 4, c. 83, s. 5, provided, that in actions for infringement notice of objections should be given by the defendant, but this statute left the position of the plaintiff as to giving particulars in such actions unaltered.

Particulars of
breaches
under Act of
1852.

The Patent Law Amendment Act, 1852, s. 41, required the plaintiff "in any action in any of her Majesty's Superior Courts of Record at Westminster, or in Dublin, for the infringement of letters patent," to deliver with his declaration particulars of the breaches complained of; and provided that at the trial of such action no evidence should be allowed to be given in support of any alleged infringement which was not contained in the particulars so delivered.

This section applied only to actions in the Courts of law; but the practice which it made compulsory was so obviously convenient that it was soon adopted by the Court of Chancery. When Lord Cairns' Act (*m*), and Sir John Rolt's Act (*n*), enabled that Court to try by itself, or with a jury, questions of fact, and required it to try all questions of law arising in a cause, particulars of breaches

(*k*) See note (*n*), *ante*, p. 281.
(*l*) 2 Coop. 47.

(*m*) 21 & 22 Vict. c. 27.
(*n*) 25 & 26 Vict. c. 42.

as well as notices of objections were ordered when issues were directed (o).

And in *Finnegan v. James* (p), Jessel, M.R., said that he saw no reason why the practice as to furnishing particulars should be confined to such cases, and that in all suits in equity the practice at law ought to be followed as closely as circumstances would admit.

Neither the Patent Law Amendment Act, 1852, nor the Patents Act, 1883, describes the nature of the particulars of breaches which it requires a plaintiff to furnish; and it was, and still is, the law that particulars of breaches are sufficient if, taken together with the pleadings, they give the defendant full and fair notice of the case to be made against him (q).

When particulars sufficient.

The cases bearing upon this point are not very numerous, and the principles on which the Courts act in determining the sufficiency of a plaintiff's particulars will be best discovered by a consideration of them.

Cases.

Talbot v. La Roche (r) was an action for the infringement of a patent for "improvements in obtaining pictures or representations of objects." The particulars of breaches charged infringement generally by selling pictures, and further stated, "that one of such pictures was made and sold by defendant to one A. H. C. on 27th April, 1854; but plaintiff states this by way of example only, and not so as to preclude him at the trial from insisting on other infringements." A rule for the delivery of further and better particulars was refused by the Court of Common Pleas.

In this case two points were raised (a) as to the sufficiency of the general allegation of infringement, and (b) as to whether the plaintiff should be allowed to give instances by way of example. Under (a) the Court refused to compel the plaintiff to specify persons and occasions, or the particular parts of the specification alleged to have been infringed. "Under a plea of want of novelty," said Jervis, C. J., "the Court requires the particulars of objections to condescend upon particular instances. But that is very different from this case; the matter there is not in the knowledge of the patentee. But the defendant must know whether, and in what respects, he has been guilty of an infringement. If the two pro-

Sufficiency of general allegation of infringement.

(o) *Curtis v. Platt*, 1863, 35 L. J. (N. S.) Ch. 853. In *Borill v. Goodier*, 1867, 36 L. J. Ch. 360, it was laid down that the object of directing issues to be tried at law is to ascertain the real facts of the case, and therefore that the Court, in an action for infringement, would allow further particulars of prior user

of the invention to be brought forward upon proper notice.

(p) 1874, L. R. 19 Eq. 72.

(q) *Needham v. Oxley*, 1863, 1 H. & M. 248.

(r) 1854, 15 C. B. 310, 320. Cp. *Russell v. Hatfield*, 1885, 2 P. O. R. 144.

Whether instances should be specified.

cesses described in the specification are wholly distinct from each other, and the defendant's process might be an infringement of the one and not of the other, he ought to have better particulars. But if the whole is substantially one process he is not entitled to them. We must not make the particulars more complicated than the specification." Under (b) the plaintiff was allowed to give one exhibit, and to add the general words above referred to, stating that they did not mean to confine themselves to that. The ground of the decision on this point seems to have been that, as the plaintiff's specification disclosed substantially one process, one instance of infringement would be representative, and there was no probability of surprise (s).

In *Jones v. Lee* (t), an action by a patentee against his licensee on a covenant to pay for roving machines made with the plaintiff's invention, and to make none without, the breaches alleged were, first, not paying for roving machines made with the invention, and secondly, making machines without it. The defendant, in answer to interrogatories, admitted the making of many hundreds of roving machines, but not with the plaintiff's invention, and declared that he could not state to whom they were sold, nor give any further information about them, without disclosing his own evidence. The plaintiff claimed in respect of all the machines the defendant had made under one or other of the covenants, and asserted that he had seen some of them which had his invention applied. It was held that the defendant was entitled to such particulars as should describe those portions of the machines to which the plaintiff contended that his invention had been applied, so as to enable the defendant to understand, as far as possible, the nature of the machines as to which he was to be charged under either of the covenants; and that it was no answer to the application for such particulars that the defendant's answer to the interrogatories was insufficient to enable the plaintiff to furnish the particulars, for if the answers were insufficient they should have been objected to (u).

Instances by way of example.

The Patent Type Founding Co. v. Richards (x) was an action for the infringement of a patent for "improvements in the manufacture of type." Upon an order for the delivery of further parti-

(s) Cp. *Tilghman's Patent Sand Blast Co. v. Wright*, 1884, 1 P. O. R. 103.

(t) 1856, 25 L. J. Exch. 241; *Higgins*, p. 407.

(u) Cp. *Elsay v. Butler*, 1884, 1 P. O.

R. at p. 189.

(x) 1860, 2 L. T. N. S. 359. See this case distinguished from *Tilghman's Patent*, 1884, 1 P. O. R. 104, per Pearson, J.

culars of breaches, the plaintiffs enumerated certain instances, and added—"and the plaintiffs state these particular instances by way of example only, and not so as to preclude them from proving any of the infringements mentioned in the former particulars of breaches." Keating, J., ordered this clause to be struck out.

This case is distinguishable from *Talbot v. La Roche*, where a reference to a specific instance, "by way of example," was allowed. In that case, the infringing articles—sun pictures—could only be made by one process. But type might be manufactured in various ways, so that the general words left room for surprise on the defendant at the trial of the action.

Needham v. Oxley (y) was a suit to restrain from infringing a patent for machinery for expressing liquids or moisture from substance. The plaintiffs stated in their bill that a machine supplied by the defendant to Messrs. T. was substantially identical with their invention, and pointed out the only difference between them. The particulars of breaches specified three machines belonging to the defendant which they alleged in general terms to be infringements of their patent. Vice-Chancellor Wood refused to make an order upon a summons for better particulars. "The object," said his lordship, "in having these particulars delivered is to give the defendant fair notice of what is the complaint against him, not to tie the plaintiff down to the precise terms of any verbal definitions, or to make the trial of the issue turn upon a point of form. Full and fair notice the defendant is entitled to; but I should be very sorry to introduce anything like special pleading into the practice of this Court, or to allow verbal criticism to interfere with a determination of the merits of the contest."

Batley v. Kynock (z).—Here the plaintiff delivered particulars of breaches, charging infringement by the making and selling of cartridges (whereof one was made an exhibit), having cases and metal heads, together with cups or chambers, formed or described in the specification. The defendant moved for further and better particulars. Vice-Chancellor Bacon, in refusing the motion, said: "Here the very thing in dispute, which is no bigger than one's

Infringing
article made
exhibit.

(y) 1863, 1 H. & M. 248, 251. Cp. the language of Mr. Justice Grove in the *Walter C. Church Engineering Co. v. Wilson*, 1886, 3 P. O. R. at p. 127: "No one can ever try patent cases by looking at particulars. Sometimes you may by looking at the specifications and the drawings, but it is, in practice,

very seldom limited to that. I cannot call to mind a case, except some very simple cases, where there have not been illustrative models of the parts in dispute, which are as well known to both parties as can be."

(z) 1874-75, L. R. 19 Eq. 232.

thumb, and is not a complicated machine, is made an exhibit. What ground, therefore, is there for the objection as to insufficiency of the particulars when a plaintiff produces the exhibit, and says, 'I hold in my hand the very article by which you infringe?' It would be only hampering the plaintiff to compel him to specify minutely the particular portions of his specification alleged to have been infringed."

In *Petman v. Bull* (a), a patentee brought an action in India for the infringement of three patents, all of which related to one article—a kiln for burning bricks—and the second and third in date were for improvements upon the invention specified in the first. The Indian Patent Act XV. of 1859 provided that "in an action for the infringement of (an) exclusive privilege, the plaintiff shall deliver with his plaint particulars of the breaches complained of in the said action, and . . . no evidence shall be allowed to be given in support of any alleged infringements . . . which shall not be contained in the particulars delivered as aforesaid." (Sect. 34.) The plaintiff did not deliver any particulars of breaches, but his plaint pointed out a particular kiln constructed and used by the defendant, and not only referred to his patents, but indicated in the case of each of them the distinctive features of his invention alleged to have been appropriated by the defendant. It was held by the Privy Council that the plaint in itself was a sufficient compliance with the requirement of sect. 34 of the Indian Patent Act. Putting upon that section the same construction which, as we have seen, was put upon the corresponding section of the Patent Law Amendment Act, 1852, s. 41, Lord Watson said: "The sole object of these enactments is to give the defendant fair notice of the case which he has to meet; and it is quite immaterial whether the requisite information be given in the plaint itself or in a separate paper."

Instances by way of illustration.

In *Walter C. Church Engineering Co. v. Wilson* (b), the C. Co. brought an action for infringement of a patent against the W. Co., and delivered particulars of breaches, alleging infringement of the second, third, and fourth claims of the patent, but not referring to any pages or lines of the specification, and complaining "in particular, by way of illustration," of certain specified machines. The defendants took out a summons for further and better particulars, which was dismissed by A. L. Smith, J. Grove, J., and

(a) 1886, 3 P. O. R. 390; S. C., reported as *Ledgard v. Bull*, 11 App.

Cas. 640.

(b) 1886, 3 P. O. R. 123.

Stephen, J., on appeal, held that the words "in particular, by way of illustration," were too wide, and ought to be omitted (c). "Complaining of a thing in particular," said Mr. Justice Grove, "and by way of illustration, might leave the plaintiffs open to complain of other things, and saying these are illustrations of others will lead to controversy." Subject to that limitation, their lordships held that the particulars were sufficient, inasmuch as the plaintiffs gave the machines that he complained of, and the heads of the invention in respect of which infringement was alleged.

Haslam & Co. v. Hall (d).—In this case, which was an action for the alleged infringement of a patent for refrigerative processes and apparatus for preserving meat, the plaintiffs, by their particulars of breaches, complained of the manufacture, &c., by the defendants of certain refrigerating machines containing an arrangement of machinery described and claimed in the plaintiffs' patent; and also "by way of example, and not of limitation," of the machines fitted by the defendants on board the *Selembria*. The defendants applied for further and better particulars, and obtained an order from a master in chambers that the plaintiffs, *so far as concerned machines fitted to ships* might be confined to the *Selembria* unless further names were given. Part of the defendants' application asked for a direction that the plaintiffs should state whether they claimed in respect of all, or only of some, and which, of the claims in the specification. And it was held by Wills and Day, JJ., reversing the decisions of the master and Huddleston, B., that the defendants were entitled to the direction asked for.

We are now in a position to attempt a generalisation upon the law of this subject. Summary of law.

Particulars of breaches are not intended to be so full as to enable an action of infringement to be tried by a reference to them alone. Their object is not so much to put the judge in possession of the facts, as to give the defendant fair and full notice of the case to be made against him, and they are sufficient if they do this, either independently of, or taken together with, the pleadings, models and exhibits. In considering the sufficiency of the particulars of breaches delivered in an action of infringement, the Court will apply such tests as these:—Is the matter, as to which further

(c) Cp. *Ehrlich v. Ihlee*, 1888, 5 P. O. R. at p. 40, where the words "by way of illustration" were struck out by consent.

(d) 1887, 4 P. O. R. 203. Cp. *Elsley v. Butler*, 1884, 1 P. O. R. 189; *Cheetham v. Oldham* (No. 3), 1888, 5 P. O. R. 624; *Lamb v. Nottingham Manufacturers Co.*, Seton, 349.

particulars are required, one peculiarly within the knowledge of the defendant? Is he likely to be surprised at the trial if the information asked for is withheld? Will the embarrassment to the plaintiff of furnishing better particulars be greater than the convenience to the defendant?

Subject to these general considerations, it may be laid down that a plaintiff must specify, by a reference to page and line, the parts of his specification in respect of which the alleged breaches have been committed (*e*), unless the case is a simple one, and either the plaintiff's is clearly identified with the defendant's process (*f*); or there is a general allegation of infringement with a reference to the claiming clauses (*g*); or the thing alleged to be an infringement has been made an exhibit in the cause (*h*).

A plaintiff will not, in general, be compelled to specify the persons with respect to whom, and the occasions on which, the alleged infringement occurred, such facts being peculiarly within the knowledge of the defendant (*i*).

Particulars of breaches which specify particular instances of infringement "by way of example," or "illustration," and not "by way of limitation," will not be allowed unless the infringing article can be made in one way only, so that a simple instance is representative, and there is little probability of the defendant being taken by surprise.

SECT. 7.—DEFENCE.

(1.) *General.*

General character of defence.

The general consideration of the questions of subject-matter, novelty, and utility, and the sufficiency of the specifications, have already been dealt with, as also has the general question of infringement. We shall, therefore, confine ourselves now to the way in which these matters may be formally raised by way of defence to an action of infringement.

The statement of defence to an action of infringement must raise the case which the defendant intends to make at the trial.

Thus, in *Borill v. Goodier* (*k*), it was held that an objection to

(*e*) *Lamb v. The Nottingham Manufacturers Co.*, Seton, 349; *Haslam & Co. v. Hall*, 1887, 4 P. O. R. 203.

(*f*) *Elbey v. Butler*, 1884, 1 P. O. R. 189; *Walter C. Church Engineering Co. v. Wilson*, 1886, 3 P. O. R. 123.

(*g*) *Cheetham v. Oldham* (No. 3), 1888, 5 P. O. R. 624.

(*h*) *Batley v. Kynock* (No. 2), 1874-75, L. R. 19 Eq. 229.

(*i*) *Talbot v. La Roche*, 1851, 15 C. B. 310.

(*k*) 1866, L. R. 2 Eq. 195.

the validity of a patent on the ground that it was included in an expired foreign patent for the same invention, and was therefore void under 15 & 16 Vict. c. 83, s. 25, could not be taken at the hearing of a suit to restrain the infringement of the patent unless it had been raised at the trial; and in *Morgan v. Fuller* (l), a defendant was not allowed to add a totally new issue of fact not in any way suggested by his answer to the issues which had been already directed for trial, and it was held that in order to raise such new issue the defendant must file a supplemental answer.

In *The United Telephone Company v. Bassano* (m), the plaintiffs, as the owners of two patents, brought two actions of infringement against the defendants, who delivered defences denying infringement, but not impeaching the validity of the patents. The plaintiffs having joined issue on these defences, and set the actions down for trial, the defendants applied some time afterwards for leave to amend their defences by raising issues as to the validity of the patents. Mr. Justice Pearson held that the leave asked for must be granted, but he declined to postpone in any way whatever the hearing of the action, ordered the defendants to pay all costs, and required the amended defences to be delivered within three days. The ground on which liberty to amend was granted in this action was the public importance of the issue which the defendants proposed to raise.

Amendment
of defence.

A defendant in a patent action is at liberty to avail himself of two different kinds of defence to the action; *firstly*, he may deny that he has committed any infringement of the plaintiff's patent right (n). And every defendant may avail himself of both or either of these different lines of defence to a patent action; and, *secondly*, he may deny that the plaintiff has any title to the privilege stated in the claim, either on the ground that there is no such patent in existence as the plaintiff alleges, or that the patent is defective and void, and therefore the same as if there were no patent at all (o).

Two main
lines of de-
fence to action
of infringe-
ment.

In the form of defence to an action for infringement, given in

Particular
pleas.

(l) 1866, L. R. 2 Eq. 296.

(m) 1885, 2 P. O. R. 70. Cp. *Otto v. Steel*, 1884, 1 P. O. R. 139; *Otto v. Sterne*, 1885, 2 P. O. R. 139.

(n) In an action for infringement, the defendant denied infringement, and in the alternative alleged that the article, the sale of which was complained of, was purchased from one L., with whom the plaintiffs had some agreement not to

take proceedings. It was held, that the plaintiffs had made a *prima facie* case of infringement by showing that the defendant had sold the patented article, and that the defendant had not discharged the *onus* which lay on him of proving his alternative defence, there being no evidence of the agreement. *Badische Anilin v. Dawson*, 1889, 6 P. O. R. 387.

(o) See Hindmarch, p. 262.

Two main defences to action of infringement.

the Appendix to the Rules of the Supreme Court 1883 (*p*), the following pleas are inserted: 1. The defendant did not infringe the patent. 2. The invention was not new. 3. The plaintiff was not the first or true inventor. 4. The invention was not useful. 5. [*Denial of any other matter of fact affecting the validity of the patent.*] 6. The patent was not assigned to the plaintiff. It will be apparent that these pleas enable a defendant to resist an action for infringement substantially upon two lines—of no infringement and no title. It may be convenient to consider these points in turn.

(2.) *Denial of Infringement.*

As to what is an infringement, see Chapter XIII. on Infringement.

Denial of infringement.

Before the pleading rules, made in pursuance of the statute 3 & 4 Will. 4, c. 42, s. 1, the only plea used in patent actions was the comprehensive plea of “not guilty,” under which the defendant might take any objection he pleased to the validity of the patent. The Rules of 1834 (*q*), however, restricted the operation of this defence to a mere denial of the wrongful acts imputed to the defendant by the plaintiff, and it neither put in issue nor denied the novelty or utility of the invention, the sufficiency of the specification, or anything alleged in the declaration, except the breaches. In the case of *Stead v. Anderson* (*r*), it was held that upon an issue of “not guilty” the question of whether there had been a fraudulent evasion of the patent did arise.

Under the Rules of the Supreme Court, 1883 (*s*), the general issue cannot now be pleaded, except in the cases where a plea of “not guilty by statute” is competent; but the specific denial of infringement has the same scope as “not guilty” under the pleading rules of 1834.

Ignorance no defence.

A defendant is not entitled under this, or any other plea, to set up as an answer to an action for infringement his *ignorance* of the existence of the patent (*t*); or that the article complained of was an infringement (*u*); or of an infringement having been committed, when the infringers were employed by him, and were

(*p*) App. D. Sect. VI., and see Appendix, p. 786.

(*q*) Reg. Gen. H. T. 4 Will. 4, 1834.

(*r*) 1847, 16 L. J. C. P. 250.

(*s*) Ord. XIX. rr. 13–17; and Ord. XXI. r. 19.

(*t*) *Davenport v. Rylands*, 1865, L. R. 1 Eq. 303; *Wright v. Hitchcock*, 1870, 39 L. J. Ex. 103; *Wittman v. Oppenheim*, 27 Ch. D. 260.

(*u*) *Geary v. Norton*, 1846, 1 De G. & S. 9; *Walton v. Lavater*, 1860, 29 L. J. C. P. 275; 8 C. B. N. S. 162.

acting within the scope of their apparent authority (*x*). See also Chapter XIII. on Infringement (*y*).

The intention of the defendant, as already stated, is immaterial (*z*); nor is a plaintiff's right of action barred by a discontinuance of, and a promise not to repeat, the infringement of a patent.

But the Court will look into all the circumstances of the case, and particularly into the conduct of the defendant in considering whether or not an injunction ought to be granted.

Thus, in *Betts v. Willmott* (*a*), a suit to restrain from infringing a patent for the manufacture of capsules, it appeared that the defendant had unwittingly sold a bottle of Rimmel's toilet vinegar, having a capsule similar to those manufactured under the patent, but had given the plaintiff full information as to the persons from whom he obtained the infringing article, and had promised not to sell any more. James, V.-C., whose decision was confirmed by the House of Lords (*b*), dismissed the bill, leaving the plaintiff to recover damages, if he could, in an action at law.

Injunction not always granted where infringement.

An objection to the subject-matter of a patent cannot be competently raised under a plea denying infringement (*c*).

In an action by the assignee against the assignor of a patent the defences were a denial of infringement, and an allegation that if what the defendant had done was covered by the patent, the patent was void for want of novelty, as having been anticipated by certain other specifications mentioned. The plaintiff took out a summons under Ord. XIX. r. 27, to strike out the second plea, as tending to prejudice, embarrass, or delay the fair trial of the action. North, J., in chambers, refused to do so; and it was held, on appeal, that the second plea, so far as admissible by way of defence, was included in the first, and therefore was unnecessary; but that, as it did not tend to prejudice, embarrass, or delay the fair trial, it need not necessarily be struck out; and that as the judge, in the

(*x*) *Betts v. De Vitre*, 1865-73, per Wood, V.-C., 11 Jur. N. S. 11; and per Lord Chelmsford, L. C., 3 Ch. at p. 429.

(*y*) Pages 216—244.

(*z*) See authorities *ante*, pp. 219-20; *Young v. Rosenthal*, 1884, 1 P. O. R. 29, per Grove, J., at p. 39: "Intention is not a part of infringement. A man may infringe a patent, although he does not know he has infringed it, as a patentee may claim as a novelty that which is not a novelty. But then, if it is not a novelty, he must suffer; and if a man in-

fringes he must suffer, whether he intentionally infringes, or whether he does not intentionally infringe." Cp. *Plimpton v. Spiller*, 1876-77, L. R. 4 Ch. D. 286.

(*a*) 1870, 18 W. R. 946.

(*b*) 19 W. R. 369. Cp. *United Telephone Co. v. Henry*, 1885, 2 P. O. R. 11; *Fletcher v. Glasgow Gas Commissioners*, 1887, 4 P. O. R. 386.

(*c*) *Russell v. Crichton*, 1837, 1 Web. P. C. 677, n. (*e*); *Househill Co. v. Neilson*, 1843, *ibid.*

exercise of his discretion, had thought fit not to strike it out, his discretion ought not to be interfered with (*d*).

(3.) *Denial of Plaintiff's Title.*

Denial of title. The plaintiff's title to the patent privilege may be impeached on various grounds:—

Not new. (a.) *Want of novelty.*—There was formerly some doubt as to the exact scope of this plea in one direction. In the case of *Walton v. Potter* (*e*), the Court of Common Pleas held, that an issue raising the question whether an invention was a new manufacture known in England at the time the patent was granted, admitted the invention to be a manufacture within the meaning of the Statute of Monopolies, and merely put in issue the novelty.

In *Bush v. Fox* (*f*), however, substantially the same plea was held to put in issue both the novelty of the invention and the question of its being a manufacture.

The case of *Spencer v. Jack* (*g*) may be said to have settled the difficulty. In this suit—instituted to restrain an infringement—“an issue was directed as to the novelty of the plaintiff's invention. On the defendant's motion for their issue was substituted one as to the novelty of the plaintiff's ‘invention or manufacture.’ On appeal, it was directed that the question of novelty should be tried on two separate and distinct issues—one as to whether the plaintiff's improvement constituted a new invention; the other, whether it constituted a new manufacture.”

Under a plea of want of novelty, the following issues cannot be raised: Want of utility (*h*), no subject-matter (*i*), insufficiency of specification (*k*), or a denial that the patentee is the true and first inventor (*l*).

As to novelty in general, see Chapter IV. Sect. 3 (*m*).

Not true and first inventor. (b.) *A denial that the plaintiff was the true and first inventor.*—This plea is, as has already been pointed out (*n*), distinct from the issue as to the novelty of the invention.

The two objections are perfectly distinct and different from

(*d*) *Hocking & Co. v. Hocking*, 1886, 3 P. O. R. 291.

(*e*) 1841, 1 Web. P. C., per Tindal, C. J., at p. 601; per Maule, J., at p. 611. See also *ibid.* n. (*g*), p. 598.

(*f*) 1852-56, Muer. P. C. 166, 179.

(*g*) 1862, 3 De G. J. & S. 346; *Higgins's Digest*, 1246.

(*h*) *Walton v. Bateman*, 1842, 1 Web.

P. C., per Cresswell, J., at p. 623.

(*i*) *Walton v. Potter*, 1841, 1 Web. P. C. 598, n. (*g*).

(*k*) *Bateman v. Gray*, 1853, 22 L. J. Ex. 290; 8 Ex. R. at p. 911.

(*l*) *Househill Co. v. Neilson*, 1843, 1 Web. P. C. at p. 689.

(*m*) Page 32.

(*n*) *Supra*.

each other. The one objection is applied to the patentee, and shows that he is not a person capable of sustaining such a grant; and the other objection is applied to the invention, and shows that it could not be made the subject of a patent privilege (*o*).

It is true that if it be shown that the invention comprised in a patent was known to the public before the date of the patent, although the patentee may, in fact, have invented it, yet he cannot have been the *first* inventor, for some one must have invented and given the invention to the public before the date of his patent. But an invention may be perfectly new to the public, and yet the patentee may not be the true and first inventor, for he may have purloined it from another, or it may have been communicated to him by one of his fellow-subjects, in either of which cases he could not be the *true* inventor. The objection that the patentee was not the true and first inventor is, in fact, something more than the objection that the invention is not new, for it shows that the patentee did not make the invention (*p*).

Objection
"not true and
first inventor"
wider than
objection
"not new."

In the case of an invention communicated from abroad, this plea would enable a defendant to deny that the plaintiff was the first importer. The words "true and first inventor" mean within the scope and construction of the Statute of Monopolies (*p*).

Importer.

(*c.*) *Want of utility*.—The objection to a patent because the invention is not useful seems originally to have rested not on the failure of the consideration bargained for by the Crown, as the representative of the public, but on the ground that the patent was, in the words of the Statute of Monopolies, "contrary to law," as "mischievous to the State," or "to the hurt of trade," and "generally inconvenient" (*q*). In the case of *Morgan v. Seaward* (*r*), it was doubted by the Court of Exchequer whether the proper form of plea ought not to follow the language of the statute; and in *Jupe v. Pratt* (*s*) Mr. Baron Alderson expressed an opinion that it was not sufficient for such a plea to say that the invention was not useful, but that it ought to allege the invention to be prejudicial. In spite, however, of these authorities, it was the almost invariable practice, both at common law and in equity (*t*), merely to deny the utility of the invention in general terms; and the form of stating

Not useful.

(*o*) Hindmarch, p. 268.

(*p*) *Ibid.*

(*q*) See also Chap. IV. p. 48.

(*r*) 1836, 1 Web. P. C. 187—197.

(*s*) 1837, 1 Web. P. C. 146.

(*t*) Seton, 347; *Plimpton v. Malcolmson*, 1875, 3 Ch. D. 531, 536.

this defence prescribed in the Appendix to the Rules of the Supreme Court, 1883, has left no room for further difficulty upon the subject.

In the case of *Losh v. Hague* (*x*)—a suit for the infringement of letters patent for improvements in the construction of railway carriage wheels—the defendant pleaded that the said supposed improvements were only trifling and insignificant alterations in the mode of making wheels before then known and in public use, and were not legal subjects for the grant of letters patent. The plaintiff, however, joined issue on this plea, and therefore no decision was necessary upon the question of its sufficiency.

In *Morgan v. Seaward* (*y*), and *Bedells v. Massey* (*z*), it was held that a plea denying the utility of an invention was quite different from a plea alleging that the plaintiff had falsely alleged his invention to be improvements. The plea of want of utility cannot, as already stated (*a*), be raised under a plea of want of novelty.

Specification
insufficient.

(*d*.) *Insufficiency of the specification*.—In the old form of letters patent there was a proviso or condition requiring the patentee particularly to describe and ascertain the nature of his invention, and the manner in which it was to be performed by an instrument, called a specification, and to cause it to be enrolled in Chancery within a certain time after the date of the patent. Under this condition two objections might formerly be taken to a patent—one on the ground that a specification had not been enrolled at all, or in due time; the other, upon the ground that the specification did not particularly describe and ascertain the nature of the patented invention. The form of letters patent prescribed in the first schedule to the present Act, contains no condition for avoiding the grant on the ground that the specification is insufficient (*b*); but this objection, having been at the commencement of the new Act a ground for *scire facias* (*c*), is, in the case of patents granted thereunder, available by way of defence to an action for the infringement. The form of letters patent now in use is not compulsory, but may be altered at the discretion of the Crown (*d*), or by rules made by the Board of Trade.

Variance;
insufficiency.

Under the plea of insufficiency the following issues may be raised—that there is a fatal variance between the complete and the

(*x*) 1838, 1 Web. P. C. at p. 202.

(*y*) 1836, 2 M. & W. 544.

(*z*) 1844, 2 Dowl. & Low. 322.

(*a*) *Supra*, p. 292.

(*b*) See *infra*, pp. 530-33.

(*c*) Webst. Lett. Pat. 42, (n); *infra*, sect. 26, sub-sect. 3, p. 474.

(*d*) Cp. sects. 33 and 116.

provisional specifications (*e*); or that the whole of the complete specification and the statement of claim taken together are so indefinite that it cannot be discovered either what the invention claimed is, or how it is to be carried into effect (*f*); or in the case of an amended specification, that the amendment is not valid.

It is not, however, competent for a defendant to set up under this plea the defences of "no subject-matter" (*g*), or that the patent is for an abstract principle only, and therefore invalid (*h*).

(*e*.) *No subject-matter*.—"The assertion that the invention is not the subject-matter of letters patent means that if ever so new and useful, it is for some other reason, as being too simple, or too abstract, or from its peculiar character and nature, not the class or kind of thing intended to be protected by the Statute of James (*i*).

No subject-matter.

As to this, however, see Chapter IV. on the subject-matter of patents.

SECT. 8.—PARTICULARS OF OBJECTIONS.

(1.) *General*.

In an action for the infringement of a patent, 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. 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; and at the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged objection of which particulars are not so delivered (*k*).

Objections to be delivered with defence.

The defendant in an action of infringement was originally permitted to raise, under a plea of "not guilty," every possible objection to the patent which he was alleged to have infringed, and in such actions, therefore, the plaintiff was frequently surprised at the trial by some new and entirely unexpected ground of defence being stated.

Former effect of plea "not guilty."

The pleading rules, which came into operation in Hilary Term, Rules, 1834.

(*e*) *Penn v. Bibby*, 1866, per Lord Chelmsford, L. C., L. R. 2 Ch. at p. 130.

1 Web. P. C. 677.

(*h*) *Jupe v. Pratt*, 1837, 1 Web. P. C. 145.

(*f*) *Siddell v. Vickers*, 1888, per Cotton, L. J., 39 Ch. D. at p. 106.

(*i*) 1 Web. P. C. 598, n. (*g*).

(*g*) *Walton v. Potter*, 1841, 1 Web. P. C. 598; *Househill Co. v. Neilson*, 1843,

(*k*) Patents Act, 1883, s. 29, subss. 2, 4.

1834, limited the scope of the plea of "not guilty" to a bare denial of the alleged infringement, and required the defendant to raise by his pleas every objection which he intended to press against the patent.

(2.) *Under Act of 1835.*

Lord
Brougham's
Act requiring
particulars.

Before the beneficial operation of these rules had been fully appreciated, the statute 5 & 6 Will. 4, c. 83, s. 5, enacted that the defendant should give to the plaintiff at the time of pleading notice of any objections on which he meant to rely, and that no objection should, without the leave of a judge at chambers, be allowed to be made on behalf of such defendant, unless he proved the objection stated in his notice.

This enactment having been passed after the new pleading rules had come into operation, was, of course, deemed to have been made for the purpose of giving the plaintiff in a patent action some benefit other than that which he enjoyed under the existing law.

Decisions
under this
Act.

It was accordingly held that, while the notice of objections should not disclose the evidence on which the defendant relied (*l*), it was not a sufficient compliance with the statute merely to specify every objection in general terms, as in a plea (*m*). "In some cases, indeed," observes Hindmarch, writing in 1846 (*n*), "a plea states an objection with as much particularity as can be required in a notice. Thus, the objection that the patentee was not the true and first inventor, is stated with as much particularity in a plea as can possibly be required in a notice of objections; for the nature of the subject does not admit of anything more being stated, unless the defendant was to mention the evidence by which he would establish his objection; and it is clear that the statute was not intended to compel a defendant to state his evidence in the notice. But whenever a plea will enable a defendant at the trial to raise several different and distinct objections to the patent, the patentee is entitled under the statute to notice of the objection upon which the defendant intends to rely, in a form more specific and particular than the plea."

(*l*) *Russell v. Ledsam*, 1843, per Alderson, B., 11 M. & W. 649; *Leaf v. Topham*, 1845, per Parke, B., 14 M. & W. 146; 14 L. J. Ex. 231.

(*m*) *Neilson v. Harford*, 1841, 8 M. & W. 806; *Heath v. Unwin*, 1842, 10 M. & W. 684; *Russell v. Ledsam*, *ubi supra*; *Jones v. Berger*, 1843, 5 M. & G. 215;

Reg. v. Mill, sci. fac., 1850, 1 L. M. & P. 696; *Betts v. Walker*, 1850, 14 Q. B. 363. On the other hand, the defendant was not entitled to go beyond his pleas: *Macnamara v. Hulce*, 1842, 2 Web. P. C. 128, n., per Lord Abinger, C. B.

(*n*) Page 295.

The degree of precision required in a notice of objections under the Act of 1835 was the subject of considerable judicial discussion. Decisions on precision in objections.

In one case (*o*), it was said that the extent of the information to be afforded should be that to which a plaintiff would be entitled on a bill in equity for discovery.

In another case (*p*), it was observed that the detail in a notice of objections ought not, perhaps, to exceed what the knowledge of the party objecting might be presumed to enable him to give.

Perhaps, the only general proposition that can be laid down upon this subject is that stated by Hindmarch (*q*), in terms based upon the language of Tindal, C. J., in *Fisher v. Dewick* (*r*):—

“Although plaintiffs always profess to apply for further and better particulars of objections, on the ground that the notice does not furnish them with sufficient information, the real motive generally is to get rid of some of the objections, or to restrict the defence as much as possible. The object of the statute, however, was not to limit the defence, but to diminish the expense at the trial, and prevent the patentee from being taken by surprise.” Object of Act of 1835.

The following points were decided as to the degree of particularity required in a notice of objections under the Act of 1835:— Cases on objections under Act of 1835.

1. The notice of objections should (*semble*) specify the pleas to which the several objections were intended to apply (*s*).

2. In an objection for want of novelty, the defendant would not be compelled to state who was the first inventor, or under what circumstances the invention was used before the date of the patent. “To require the defendant to afford this information would be throwing the burden of proof on the wrong party” (*t*).

3. The following objections were held sufficient:—

That the plaintiff did not state the best mode with which he was acquainted (*u*); that the invention was not properly set forth in the specification (*v*); that the plaintiff's specification did not suffi- Objections held sufficient.

(*o*) *Att.-Gen. v. Corporation of London*, 1849, 2 M. & G. 247.

(*p*) *Bentley v. Keighley*, 1844, per Maule, J., 7 M. & G. 652; 13 L. J. C. P. 167.

(*q*) Page 291.

(*r*) 1838, 1 Web. P. C. at p. 267.

(*s*) *Walton v. Bateman*, 1842, per Cresswell, J., 1 Web. P. C. 268, n. (*d*). Cp. *Gillett v. Wilby*, 1839, 1 Web. P. C. 270, in which it was held not to be sufficient to state an objection in the notice, unless there was a plea to which it could be applied: *Walton v. Bateman*, 1842, *ibid.* 616.

(*t*) *Russell v. Ledsam*, 1843, 11 M. & W. 647, following *Heath v. Unwin*, 1842, 10 M. & W. 684; *Bulnois v. Mackenzie*, 1837, 1 Web. P. C. 260; 4 Bing. N. C. 132; *Reg. v. Walton, sci. fac.*, 1842, 2 Q. B. 969; *Bentley v. Keighley*, 1844, 1 Dowl. & Low. 946, and dissenting from *Jones v. Berger*, 1843, 1 Web. P. C. 549. Cp., also, *Fisher v. Dewick*, 1838, 1 Web. P. C. 551, n.; *Galloway v. Bleadon*, 1839, *ibid.* 268, n.; *Carpenter v. Walker, ibid.*

(*u*) *Jones v. Berger*, 1843, 1 Web. P. C. 546.

(*v*) *Heath v. Unwin*, 1842, 10 M. & W.

ciently distinguish between what was old and what was new (*x*); that the specification was calculated to deceive (*y*).

4. The following objections were held insufficient:—

Objections held insufficient.

That the invention was more extensive than, and did not correspond with, that described in the specification (*z*); that there was a discrepancy between the drawings and the specification (*a*); that an extension of the patent term had been obtained by fraud, covin, and misrepresentation (*b*); that the plaintiff had not caused *any* specification sufficiently describing the nature of the supposed invention to be duly enrolled in Chancery (*c*).

In (*a*) and (*b*) it would be necessary that the attention of the plaintiff should have been called to the particular part or parts. In (*c*) it was held that the notice of objections ought to state the species of misrepresentation by which the defendant meant to allege that an extension of the patent term had been obtained from the Privy Council. In (*d*) the Court ordered an amendment, which was made by inserting the word “other” before “specification.”

In this last case Baron Parke observed (*d*):—

“I think the meaning of the last objection is too obscure. It may either mean that there is no specification existing among the rolls of the Court, or that that which has been enrolled is defective in not sufficiently describing the invention. It is not necessary that the notice of objections should set out the evidence on which the defendant relies, but it ought to be more specific than this is. The Act of Parliament which requires the notice of objections was passed at a time when the general issue was the usual plea in cases of this kind, and it was, no doubt, intended to pass in the place of special pleas.”

Jurisdiction over notices of objection at common law.

It was decided (*e*) that the Courts of Common Law had jurisdiction over the notices of objections given in pursuance of the Act of 1835, and whenever such a notice was not sufficient the defendant

687, per Lord Abinger, C. B.: “The legislature never intended that the defendant should argue his case in the statement of objections which he delivers in compliance with the Act.”

(*x*) *Jones v. Berger*, 1843, 1 Web. P. C. 546.

(*y*) *Neilson v. Harford*, 1841, 1 Web. P. C. 324, n., 332. It was held that this statement was sufficient to let in evidence as to any particular passage being false: and that where the objection simply states the specification to be insufficient, and the plaintiff is contented to take that

as notice, any objection to the sufficiency of the specification may be taken at the trial.

(*z*) *Fisher v. Dewick*, 1838, 1 Web. P. C. 551, n.

(*a*) *Ibid.*

(*b*) *Russell v. Leddam*, 1843, 11 M. & W. 647.

(*c*) *Leaf v. Topham*, 1845, 14 M. & W. 146.

(*d*) *Ibid.* at p. 148.

(*e*) *Bulnois v. Mackenzie*, 1837, 4 Bing. N. C. 127; *Losh v. Hague*, 1837-39, 1 Web. P. C. 200.

might be ordered to amend it. This power was derived from the general jurisdiction of the Courts over all proceedings in actions before them, precisely as they derived their power over particulars pleaded by a defendant in pursuance of the statute of set-off (*f*).

(3.) *Under Act of 1852.*

The Patent Law Amendment Act, 1852, s. 41, repeated in substance the provisions of 5 & 6 Will. 4, c. 83, s. 5, and added that the particulars of objections delivered in pursuance of the statute should state "the place or places at or in which, and in what manner, the invention is alleged to have been used or published prior to the date of the letters patent." Act of 1852.
Additional particulars.

The requirements of this statute, it should be observed, are confined to notices of objections affecting the validity of the patent, and it was therefore held that a defendant might object to the want of registration of an assignment of the patent to the plaintiff, although it was not specially mentioned in his notice of objections (*g*). It is thought that the following propositions give an accurate statement of the judicial construction placed on the section in question:— Construction of Act of 1852, s. 41.

1. An order for further and better particulars of objection, made under the Patent Law Amendment Act, 1852, s. 41, was required to be, in form, confined to the words of the section; but this did not relieve the defendant from the obligation to furnish full and sufficient particulars (*h*). Order for further particulars to follow section 41.

Cases on these points are:—

Flower v. Lloyd (*h*).—This was an action of infringement, in which the defendant relied, *inter alia*, upon prior user and publication of the plaintiff's invention. Bacon, V.-C., required the defendants to state "the names and addresses of the persons by whom, and the places where, and the dates at and the manner in which," the alleged prior user and publication had taken place. The Court of Appeal held that this order must be varied so as not to go beyond the words of the statute; but when the defendants, in pursuance of the amended order, delivered particulars alleging prior user by three persons, and whose names and ad- Order in *Flower v. Lloyd*.

(*f*) Hindmarch, p. 286.

(*h*) *Flower v. Lloyd*, 1876, 45 L. J. N.

(*g*) *Chollet v. Hoffman*, 1857, 26 L. J. S. Ch. 746.
Q. B. 249; 7 E. & B. 686.

dresses were given, and "by other persons in Birmingham and London respectively," these words were held by Field, J., to be too indefinite, and the defendants were ordered either to give better particulars or to submit to their being struck out.

Birch v. Mather (i).—In this case the particulars of objections alleged prior user of the invention at certain works, which they specified, but gave no further information. It was held by Chitty, J., that to satisfy an order in the form settled in *Flower v. Lloyd* the defendant *must* give the names and addresses of prior users, and that the defendants must answer interrogatories, not only as to the particulars which they were required to furnish, but also as to whether the machines in question were in existence.

Plimpton v. Spiller (j).—Here the defence was, "that a prior American patent had been surrendered, and that the invention had been published in certain journals of specified dates, and in sketches and drawings deposited at a specified time in the Patent Office Library." It was held that "the defendant must state the date of the American patent, the name of the patentee, and the date of the alleged surrender, and specify also the pages, but not the lines, of the journals referred to, and that the drawings must be referred to in writing, whether contained in books or not, the rest of the order to be in terms" of *Flower v. Lloyd*.

Present residence of prior users.

2. When it was necessary to give the names and addresses of parties alleged to have been prior users of an invention, the present residence was required to be stated, "as otherwise the plaintiff would not know where to go for his evidence" (*k*).

General user at a place.

3. Where in an action for infringement the defendant relied not upon a specified user by certain persons named, but on a general user at a particular place, it was a sufficient compliance with sect. 41 to state that the invention was used by manufacturers generally at a particular place, without naming any person or specifying any manufactory.

Objections held sufficient.

The justification of this rule was thus expressed by Mr. Baron Alderson in *Palmer v. Wagstaffe (l)*: "If a defendant rests his case on a general user, proof of user by one person will not do. . . . The plaintiff has no reason to complain of the generality of the

(i) 1883, L. R. 22 Ch. D. 630; *Finnegan v. James*, 1874, L. R. 19 Eq. 72; *Crossley v. Tomty*, 1876, L. R. 2 Ch. D. 533.

(j) 1877, 20 S. J. 860.

(k) *Palmer v. Cooper*, 1853, per Alderson, B., 9 Exch. at p. 236; 23 L. J. Ex. 82.

(l) 1853, 22 L. J. Ex. 295; 8 Exch. 840, 842.

statement, for the more general it is the more the defendant must prove under it." It was accordingly held that the following allegations of general user were sufficient: "By candle makers generally in London, and the vicinity thereof" (*m*), "by persons engaged in finishing lace at Nottingham" (*n*). On the other hand, it was necessary that the defendant's particulars of general user should give the plaintiff such information as would enable him to make inquiries at the places named (*o*).

Thus, in a suit to restrain the infringement of a patent for improvements in the construction of carriages (*p*), particulars of objections alleging prior user "by carriage builders generally throughout Great Britain," and "by various carriage builders in or near London, Liverpool, Manchester, and Southampton, and various other of the principal towns of Great Britain," were held insufficient (*p*).

The Court, however, expressed its opinion in this case—that when an objection pointed to the public use of a particular preparation, such words as "by various makers in or near London" might be sufficient; and that if the defendant could not give the names of the carriage builders "in or near London," he would be required to specify the class or classes of carriages with respect to which the alleged prior user had taken place.

4. Subject to the special requirements of the Act of 1852, s. 41, in the case of notices affecting the validity of letters patent, particulars of objection, like particulars of breaches, were generally sufficient if precise enough to prevent surprise at the trial of an action of infringement. Where the evidence relied on by a defendant was prior publication he was generally obliged to state the particular work or document, the volume of the work (*q*), and, in the case of a specification (*r*), the particular pages and lines where the alleged prior publication was to be found.

General rule as to sufficiency of objections.

Particulars of prior publication.

(*m*) 1853, 8 Exch. 840, 842.

(*n*) *Jones v. Berger*, 1843, 5 M. & G. 208. Cp. per Tindal, C. J., at p. 216: "The notice of objection does limit the alleged user to a particular class of persons, viz., those engaged in the trade of lacemaking in a particular place, Nottingham; and it is quite as open to the plaintiff as it is to the defendant to make inquiries in that place among that class of persons." In the original notice of objections in this case, the words "and elsewhere" were inserted; but the Court held that they were too

general, might mislead the plaintiffs, and should be struck out.

(*o*) *Palmer v. Cooper*, 1853, per Parke, B., 9 Exch. at p. 236.

(*p*) *Morgan v. Fuller*, 1866, L. R. 2 Eq. 297; cp. *Holland v. Fox*, 1853, 1 C. L. R. 440.

(*q*) *Curtis v. Platt*, 1863, 8 L. T. N. S. at p. 657.

(*r*) *Grover and Baker Sewing Machine Co. v. Wilson*, W. N. 1870, p. 78; cp. *Fisher v. Dewick*, 1838, 1 Web. P. C. 264; *Plimpton v. Spiller*, 1877, L. R. 6 Ch. D. 412; Higgins's Supplement, p. 79.

The same test was applied in other matters. "It is incumbent," said Coltman, J., in *Fisher v. Dewick* (s), "on the Court to see that the objections are stated in a definite and intelligible form before the parties go down to trial, that the patentee may not be taken by surprise. The defendant is not precluded from bringing forward any number of objections, but he must state with precision what they are" (t).

(4.) *Under Act of 1883.*

Changes in law.

Sect. 29 of the Act of 1883 differs from sect. 41 of the Act of 1852 in two points only. The words "time and place" are substituted for "place" and "manner" which appear in the earlier Act; and the provision against the admission of evidence in support of any objection of which particulars have not been delivered is no longer absolutely peremptory, but may be relaxed by leave of the Court or a judge (u).

Except in these particulars, and, perhaps, it should be added (r), in the recognition of the practice by which the validity of a patent is now simply denied in the defence, "on the grounds stated in the particulars of objection delivered" therewith, the present Act and the Act of 1852 do not materially differ, so far as notice of objections are concerned.

Cases under this Act are :—

Cases under Act of 1883.

If a defendant disputes the validity of a patent on the ground of want of novelty he must state reasonably on what grounds, in respect of want of novelty, he relies; and must also state the time and place of the alleged prior publication or user (x).

Pages, lines, &c. to be given of prior publication.

Where anticipation in (a) a prior specification, or (b) publication, is alleged, the defendant must, as was necessary under the Act of 1852, in the case of (a), refer to pages, lines, and claiming clauses (y), and in the case of (b) to the part or parts of the work where the alleged prior publication is to be found (z).

Details of variance of provisional

In the *Anglo-American Brush Electric Corporation v. Crompton* (a), the defendant, who alleged, *inter alia*, variance between the pro-

(s) 1833, 1 Web. P. C. at p. 268.

(t) See *supra*, p. 297.

(u) *Britain v. Hirsch*, 1888, 5 P. O. R. 226.

(r) Cp. *Kurtz v. Spence*, 1887, 36 Ch. D. 776.

(x) *Fowler v. Gaul*, 1886, 3 P. O. R. per Denman, J., at p. 250. Cp. *Boyd v. Horrocks*, 1886, 3 P. O. R. per Bris-

towe, V.-C., at p. 287.

(y) *Harris v. Rothwell*, 1886, 3 P. O. R. 243; *Fowler v. Gaul*, *ibid.* 247; *Boyd v. Horrocks*, *ibid.* 285; *Boyd v. Farrar*, 1888, 5 P. O. R. 32, 36.

(z) *Harris v. Rothwell*, *ubi supra*, at p. 246.

(a) 1887, 4 P. O. R. 27.

visional and the complete specifications of the plaintiffs' invention, was compelled to point out in his particulars the alleged nonconformity. and complete specifications necessary.

In the subsequent case of *Crompton v. Anglo-American Brush Electric Corporation (b)*—an action for the infringement of a patent for improvements in dynamo-electric machines—the defendants denied the validity of the patent, and alleged as one of their particulars of objection insufficiency of the specification. The notice of objection upon this point originally ran: "The specification does not sufficiently describe the nature of the said invention, and in what manner the same is to be performed." The plaintiffs having obtained an order for further and better particulars of this objection, the defendants so amended it as, in effect, to allege that the specification was insufficient to enable a competent workman to construct a machine which would answer the purpose of the alleged invention. It was held by the Court of Appeal, affirming the decision of Kay, J., in chambers, that the objection, even in its amended form, was insufficient, and that if the defendants knew exactly where the defect was they were bound to point it out. Insufficiency of specification.

Their lordships, however, expressly guarded themselves from affirming that a defendant must show a plaintiff how to amend his specification; and the decision seems to have turned upon *the admission by the defendants* that they knew something more than they had disclosed in the objections.

This case differs from that of the *Anglo-American Brush Electric Corporation v. Crompton (c)*, because there the question was whether the complete specification agreed with the provisional specification; and it was obvious that if the particular point in which that difference was said to exist was not stated, the plaintiffs would not be able to bring the evidence which might have entirely

(b) *Ibid.* 157. In *Blakey v. Latham* (1889, 6 P. O. R. 36), the particulars of objections stated that an alleged anticipation was exhibited by a person travelling for orders. At the trial evidence was given that hundreds of these alleged anticipations were made. The plaintiffs asked for and obtained leave to bring rebutting evidence to disprove the making of these hundreds, on the ground that the particulars only described an experiment. In their rebutting evidence the plaintiffs attempted to prove that the article was never made at all. The defendants were allowed to bring further evidence on this point.

An example of the class of machines in question in an action may, in order to explain counsel's argument, be handed up and looked at, and cannot be objected to on the ground that it is not in evidence: *Boyd v. Horrocks*, 1889, 6 P. O. R. 154.

In an action on a licensing agreement, evidence as to the state of public knowledge at the date of the patent is inadmissible, except in cases where the licensor's specification is ambiguous and requires explanation: *Crossthwaite v. Steel*, 1889, 6 P. O. R. 192.

(c) 1867, 4 P. O. R. 27.

displaced the apparent objection from merely looking at the two documents (*c*).

Evidence of general knowledge.

There is no enactment that particulars of objections should be given of general public knowledge, though the defendant, in order to rely on general public knowledge, must take that objection. General public knowledge must be proved by ordinary evidence, with reference to well-known books if necessary (*d*).

Evidence of anticipation.

In framing particulars of objections, care should be taken not to put forward a long list of anticipations of which only two or three are relied on at the trial (*e*).

Where a large number of specifications and books were relied upon as anticipations, defendants were required to specify where in particular the anticipation was to be found without giving pages and lines (*f*).

SECT. 9.—AMENDMENT OF PARTICULARS.

By summons or motion.

An order for further and better particulars may be made on summons, by a judge in chambers (*g*), or on motion in Court (*h*).

Where the particulars of breaches or objections, originally delivered, are too general, it is the business of the parties who mean to object to them to bring the case before a judge in chambers, and procure an order, otherwise evidence which is within the literal meaning of the particulars, however general the statement, may be received at the trial (*i*).

Full particulars should be obtained before trial.

“In my opinion,” said Mellish, L. J., dealing with this point in *Sugg v. Silber* (*j*), “there is a very large difference between a case where a judge has been applied to and has ordered further particulars in order to state an objection more specifically, and a case where at the trial the plaintiff asserts that the defendant ought to be prevented from availing himself of an objection. If, wherever the Court would order further particulars because the objection had

(*c*) 1887, 4 P. O. R., per Cotton, L. J. at p. 200.

(*d*) *Holliday v. Heppenstall*, 1889, 6 P. O. R. 326. Cp. *Automatic Co. v. Knight*, 1889, 6 P. O. R. 302; *Phillips v. Ivel Cycle Co.*, 1890, 7 P. O. R. 77.

(*e*) *Thomson v. Batty*, 1889, 6 P. O. R. 84.

(*f*) *Holliday v. Heppenstall*, *ubi supra*, 320.

(*g*) R. S. C. 1883, Ord. XIX. r. 7.

(*h*) J. A. 1873, s. 39; Patents Act, 1883, s. 29; R. S. C. 1883, Ord. LII. r. 1. In *Blakey v. Latham*, 1889, 6

P. O. R. 29, particulars were allowed to be amended in the course of the trial. In *Darrah v. Purser*, 1889, 6 P. O. R. 365, an objection of alleged common user for analogous purposes was allowed to be added by amendment, but particulars of time and place were ordered to be given. See form of order for amendment in *Baird v. Moule's, &c. Co.*, 1876, L. R. 17 Ch. D. 139.

(*i*) *Hull v. Bollard*, 1856, per Pollock, C. B., 1 H. & N. at p. 137; 25 L. J. Ex. 304.

(*j*) 1874-77, L. R. 2 Q. B. D. 493, 495.

not been particularly specified, it would also hold that the party was precluded from raising it at the trial, nobody would be foolish enough to apply to a judge for further particulars."

In *Hull v. Bollard* (*k*)—an action for the infringement of a patent for a mill-stone—the particulars of objections delivered under the Act of 1852, s. 41, stated that the alleged invention had been "*publicly used in corn-mills for many years previously.*" At the trial the defendant tendered evidence of prior user at certain mills in Cheshire. It was held that the evidence was admissible. "It is true," said Pollock, C. B., "that the statute contains a proviso that the *place or places* at which the invention is alleged to have been used shall be stated, but that proviso does not prevent particulars not containing such statement from being available if not objected to on that ground before the trial."

If a defendant fail to comply with an order for better particulars, it would seem that the proper course is to apply to have the insufficiently-stated objection struck out (*l*); and if the particulars delivered are insufficient, the party delivering them may be ordered to pay the costs of the application for better particulars (*m*).

By the Rules of 1883 (*n*), the party at whose instance particulars have been delivered under a judge's order shall, unless the order otherwise provides, have the same length of time for pleading after the delivery of the particulars that he had at the return of the summons. Save as in this rule provided, an order for particulars shall not, unless the order otherwise provides, operate as a stay of proceedings, or give any extension of time (*o*).

Failure to comply with order for better particulars.

Time for pleading after delivery of particulars.

SECT. 10.—INSPECTION AND DISCOVERY.

(1.) *Inspection.*

"There is no use in this Court," said Lord Eldon in 1815 (*p*), "directing an action to be brought, if it does not possess the power to have the action properly tried."

Former practice as to.

The right to order an inspection is here treated as inherent in the jurisdiction of the Courts, at least of Equity.

Such orders were, in fact, chiefly made by these Courts till 1852.

(*k*) *Hull v. Bollard*, 1856, per Pollock, C. B., 1 H. & N. at p. 137.

(*l*) *Flower v. Lloyd*, 20 S. J. 860.

(*m*) *Penn v. Bibby*, 1866, L. R. 1 Eq. 548; *Grover and Baker Sewing Machine Co. v. Wilson*, W. N. 1870, p. 78.

(*n*) R. S. C. 1883, Ord. XIX. r. 8.

(*o*) *Boyd v. Farrar*, 1888, 5 P. O. R. 33, 36.

(*p*) *Bovill v. Moore*, 1815, 1816, 2 Coop. C. C. 56, n.; reported as *Brown v. Moore*, 3 Bligh, 178. See Lawson, 219.

In that year the Patent Law Amendment Act extended this equitable jurisdiction to the Courts of Common Law (s. 42). The power to order inspection conferred by that Act was, however, limited as regards its subject-matter to machinery and did not extend to books (*q*).

The production and inspection of documents might be obtained under the provisions of the Common Law Procedure Acts, 1852 and 1854; but such inspection was not ordered where the applicant's affidavits disclosed a mere possibility of advantage accruing to him thereby (*r*).

Practice
under R. S. C.
1883.

Under the Rules of the Supreme Court, 1883, Ord. L., the widest powers of ordering an inspection are conferred on the various divisions of the High Court. The only practical limit to the discretion of the Court is the necessity of the information claimed for the purposes of the trial (*s*).

Samples, &c.

Samples may now be taken, observations made, and experiments conducted (*t*).

Application
for, how
made.

An application for inspection may be made and in exceptional cases will be granted (*u*) *ex parte* (*s*); it may be made at any time during the progress of an action, even before the delivery of claim (*x*), and the express terms of Ord. L. r. 6 leave no doubt that an adverse order for inspection may be made upon the plaintiff in an action for infringement (*y*).

Under Ord. L. r. 3, the Court may now authorize any person for the purpose of inspection to enter any land or building in the possession of any party. Obedience to an order for inspection may, therefore, be asserted forcibly, and not simply as before by process of contempt (*z*).

The application in the Chancery Division should be made by motion to the Court, and notice of motion should be given (*a*).

(*q*) *Vidi v. Smith*, 1854, 23 L. T. 231; *Saxby v. Easterbrook*, 1872, L. R. 7 Ex. 207; *Amies v. Kelsey*, 1852, 22 L. J. Q. B. 81.

(*r*) *Smith v. G. W. Rail. Co.*, 1854, 3 W. R.; 69 Macr. P. C. 221.

(*s*) Where the right to inspection appears to depend on the determination of any issue or question in the cause, the Court may if it thinks fit order that such issue shall be determined first, and reserve the question as to the inspection. Ord. XXXI. r. 20.

(*t*) Ord. XXX. r. 3; cp. *Baileische Anilin, &c. v. Levinstein*, 24 Ch. D. 156; *Germ Milling Co. v. Robinson*, 1886, 3 P. O. R. 11.

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

(*x*) Dan. Proc. Ch. 1451.

(*y*) *Germ Milling Co. v. Robinson*, 1886, 3 P. O. R. 11; *Cheetham v. Oldham*, 1888, 5 P. O. R. at p. 623; and see earlier cases, *Russell v. Cowley*, 1832, 1 Web. P. C. 459, by consent; *Russell v. Crichton*, 1837, 1 Web. P. C. 677 n., 15 Dec. Court of Sess. 1270; *Patent Type Founding Co. v. Walter*, 1860, 29 L. J. Ex. 207; *Havenport v. Jepson*, 1862, 1 N. R. 307.

(*z*) *East India Co. v. Kynaston*, 1821, 3 Bligh, 153, 163, 166.

(*a*) *Habershon v. Gill*, W. N. 1875, 231.

In the Queen's Bench Division the application is to a judge in Chambers (*b*).

Laches sufficient to defeat the plaintiff's right to an interlocutory injunction is no bar to an order on the same motion for inspection and samples (*c*). Laches.

In order to succeed on an application for inspection, the applicant must show by affidavit:

1. That he is the patentee of an invention, and what it is (*d*).
2. That the defendant has infringed.

Evidence to support motion for inspection.

The Court will not grant an order for the inspection of a machine upon an affidavit "that the machine used by the defendants is the same for which the plaintiff has obtained a patent." The affidavit ought, at least, to state that there is such a machine, and that the plaintiff has reason to believe it is an infringement (*e*), and should set forth the grounds of such belief (*f*).

Primá facie evidence of infringement will be sufficient (*g*).

3. That the inspection sought for is material to his case (*h*). Inspection is not "material" in this sense, when the plaintiff has already had, in a discontinued action against the defendant, inspection of the machinery complained of (*i*).

If the *primá facie* evidence above referred to is satisfactory, an order for inspection will be made, almost of course (*k*).

Inspection will, however, be refused where, in the opinion of the Court— Refusal to order inspection.

(1.) There is no case to try at the hearing (*l*);

(2.) The effect of an order would be to oppress the defendant, or make him disclose more than was necessary for the purposes of the cause (*m*).

An objection that an order for inspection would lead to the Objection that in-

(*b*) Ord. XXXIV. r. 12; Ord. XXXV. r. 6.

(*c*) *Patent Type Founding Co. v. Walter*, 1860, Johns. 727.

(*d*) *Meadows v. Kirkman*, 1860, 29 L. J. Exch. 205.

(*e*) *Shaw v. Bank of England*, 1852, 22 L. J. Ex. 26.

(*f*) *Germ Milling Co. v. Robinson*, 1884, 1 P. O. R. 217.

(*g*) *Shaw v. The Bank of England*, *ubi supra*; *Singer Manufacturing Co. v. Wilson*, 1865, 13 W. R. 560; *Batley v. Kynock*, 1874-75, L. R. 19 Eq. 90, 92.

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

graph Co., 1868, 19 L. T. N. S. 46.

(*i*) *Shaw v. Bank of England*, *ubi supra*.

(*k*) *Singer Manufacturing Co. v. Wilson*, 1865, 13 W. R. 560.

(*l*) *Piggott v. Anglo-American Telegraph Co.*, *ubi supra*. The question of dis-conformity between the complete and the provisional specification will not be considered on an application for inspection. *Cheetham v. Oldham*, 1888, 5 P. O. R. at p. 618.

(*m*) *Singer Manufacturing Co. v. Wilson*, *supra*; *Cheetham v. Oldham*, 1888, 5 P. O. R. 617.

inspection will lead to disclosure of trade secrets.

disclosure of trade secrets will not generally prevail if the case for inspection is otherwise satisfactory (*n*).

If this were not the law, any patent might be infringed with impunity (*o*).

The Court will, at the proper time, protect the defendant from an improper disclosure of his secret (*n*).

Form of order.

The order for inspection (*p*) usually specifies the number of inspections allowed (*q*), the names of the inspectors, and the notice to which the person against whom the order is made shall be entitled (*r*).

(2.) *Discovery.*

Existing law.

The existing law as to discovery is contained in Ord. XXXI. of the Rules of the Supreme Court, 1883. Its chief provisions, so far as relate to actions of infringement, are as follows:—

Application for interrogatories.

The plaintiff or defendant in a patent action may (the statutory right to particulars notwithstanding (*s*)), by leave of the Court or a judge, deliver interrogatories in writing for the examination of the opposite parties, or any one or more of such parties (*t*). The Court or a judge has the same power to prevent premature discovery as it has to prevent premature inspection (*u*).

The costs of discovery, by interrogatories or otherwise, must be secured in the first instance by the applicant (*x*).

An application for interrogatories is formally sufficient if it state their general object and scope, and the judge will not, in such a case, decide upon the relevancy of particular interrogatories (*y*).

Interrogatories must be answered categorically and completely.

A defendant against whom an order for discovery is made must answer, technically and categorically, every question which can assist the plaintiff in making out his title to relief (*z*).

The following illustrations will show at once the application and the limits of this rule:—

Cases.

A defendant denying infringement must answer everything tending to show the fact of infringement, but not questions which

(*n*) *Renard v. Levinstein*, 1864-65, per Wood, V.-C., 10 L. T. N. S. 95; *Cheetham v. Oldham*, 1888, 5 P. O. R. 617.

(*o*) *Russell v. Crichton*, 1837, 15th Dec., Court of Sess. 1st Ser. 1270.

(*p*) See Seton, 350.

(*q*) *Heathfield v. Braby*, Seton, 1661. But see *Germ Milling Co. v. Robinson*, 1886, 3 P. O. R. 11.

(*r*) Pemberton, p. 236.

(*s*) *Birch v. Mather*, 1883, 22 Ch. D. 629; *Haddan's Patent*, 1884-85, 54 L. J. Ch. 126; *Germ Milling Co. v. Robinson*, 1884, 1 P. O. R. 218; *Moseley v. Victoria Rubber Co.*, 1886, 3 P. O. R. 351, 356.

The law is the same as to administering interrogatories to a plaintiff. *Hoffmann v. Postill*, 1869, L. R. 4 Ch. 673, 679; *Ehrlich v. Ihle*, 1888, 5 P. O. R. 37.

(*t*) Rule 1.

(*u*) Rule 20.

(*x*) Rule 25.

(*y*) *Hall v. Liardet*, W. N. 1883, 165, 175, 194.

(*z*) *Swinborne v. Nelson*, 1852-53, per Romilly, M. R., 16 Beav. 416, 417; 22 L. J. Ch. 331; *Elmer v. Creasy*, 1873, L. R. 9 Ch. 69; *Saull v. Browne*, 1874, *ib.* 364; *Bown v. Sansom*, 1888, 5 P. O. R. 510.

assume that infringement has taken place, and answers to which will be obtained at the hearing, provided that infringement be then established (*a*).

Under this proposition, the following matters have been held (a) to show the fact of infringement; (b) to assume the infringement, and to be more properly reserved for the trial:—

(a) Whether the defendant used the materials mentioned in the plaintiff's specification.

Whether he added anything else.

Whether the additions made any difference in the process (*b*).

Whether the defendant's process was the same as that used by A. B., against whom the plaintiff had already instituted and prosecuted a successful suit (*c*).

(b) Whether machines of which the defendant was required to set out an account were purchased or hired, and, if purchased, what was the consideration for the purchase.

An account of envelopes manufactured by any machine used by the defendants, and discovery of the persons to whom such envelopes had been sold.

Accounts of the sales of such envelopes, the profits made by defendants, the stock in hand of such envelopes, and an account of moneys received by and due to the defendants in respect thereof (*d*).

When a defendant does not deny infringement, he is bound, in answer to interrogatories, to furnish the names and addresses of the persons to whom the infringing machines were sold, although his answers may expose such persons to legal proceedings (*e*).

Defendant not denying infringement.

When, however, in such a case the defendant admits sales which will give to the plaintiff at once, in the event of his establishing the validity of his patent, a right to damages, or to an account, he need not answer interrogatories as to sales to particular customers (*f*).

Although, when discovery is a matter of indifference to the defendant, the Court does not weigh in golden scales the question of materiality or immateriality, still, when the nature of the dis-

Principles on which Court acts in allowing inspection.

(a) *De la Rue v. Dickinson*, 1857, per Wood, V.-C., 3 K. & J. 391; *Lister v. Norton*, 1885, 2 P. O. R. 68; *Lea v. Saxby*, 32 L. T. N. S. 731.

(b) *Renard v. Levinstein*, 1864, 10 L. T. N. S. 94; *Rolls v. Isaacs*, 1878, W. N. 1878, 37.

(c) *Bovill v. Smith*, 1866, L. R. 2 Eq.

459.

(d) *De la Rue v. Dickinson*, 1857, 3 K. & J. 388.

(e) *Tetley v. Easton*, 1856, 18 C. B. 643; *Jourdain v. Palmer*, 1866, L. R. 1 Ex. 102.

(f) *Lister v. Norton*, 1885, 2 P. O. R. 68; cp. *Crossley v. Tomey*, 2 Ch. D. 533.

covery required is such that the giving of it may be prejudicial to the defendant, the Court takes into consideration the special circumstances of the case, and whilst, on the one hand, it takes care that the plaintiff obtains all the discovery which can be of use to him, on the other, it is bound to protect the defendant against undue inquisition into his affairs (*g*).

A plaintiff has no right to inquire by interrogatories into the defendant's case, or to ask for the names of the witnesses whom he intends to produce, or the names of persons to whom he has sold articles similar to the machine alleged to be infringed, or to require a description of all machines similar to the plaintiff's made or used by him prior to the patent (*h*).

In *Garrard v. Edge* (*i*), an action for infringement, the defendants alleged that the patent was anticipated by the sale of articles made according to the alleged invention by various persons named in the particulars. The plaintiff applied before the trial for an order for the production by the defendants of the articles to be proved by the specified persons at the trial. Kay, J., refused the application. The plaintiff appealed. It was held, on appeal, that there was no precedent for such an order, and that, on principle, it ought not to be made.

Disclosure of trade secrets by inspection. The law above stated (*j*) as to the disclosure of trade secrets by inspection applies to discovery (*k*).

In *Badische Anilin, &c. v. Levinstein* (*l*), Pearson, J., allowed the defendant's secret process to be disclosed *in camera*, and ordered the shorthand notes to be impounded in Court.

Communications to patent agent not privileged. Disclosures of documents. Communications made to a solicitor in his capacity of patent agent are not privileged from disclosure (*m*).

Reports and letters obtained from their officers by a company which had been warned, but not threatened, with actual litigation in respect of an alleged infringement of a patent, were held not to be privileged (*n*).

Interrogatories. In answering interrogatories filed by a defendant for the exa-

(*g*) *Moore v. Craven*, L. R. 7 Ch. 94, 96, n.; *Daw v. Eley*, 1865, 2 H. & M. 725; *Simpson v. Charlesworth*, W. N. 1866, 255; *Rolls v. Isaacs*, 1878, W. N. 1878, 37. As to administering interrogatories to a plaintiff, see *Hoffmann v. Postill*, 1869, L. R. 4 Ch. 673; *Edison, &c. Co. v. Holland*, 1888, 5 P. O. R. 216; *Hall v. Truman, Hanbury & Co.*, 1885, 29 Ch. D. 347.

(*h*) *Daw v. Eley*, *ubi supra*.

(*i*) 1889, 6 P. O. R. 372.

(*j*) *Supra*, p. 307.

(*k*) *Renard v. Levinstein*, 1864, 10 L. T. N. S. 94.

(*l*) 1883, 24 Ch. D. 156, 158.

(*m*) *Mosley v. The Victoria Rubber Co.*, 1886, 3 P. O. R. at p. 354.

(*n*) *Westinghouse v. Midland Rail. Co.*, 1883, 48 L. T. N. S. 98, 462; and *cp. Haslam Co. v. Hall*, 1888, 5 P. O. R. 1.

mination of the plaintiff, the general rule applies, that he who is bound to answer must answer fully. tories by defendant.

There is, however, this difference: A plaintiff is not entitled to discovery of the defendant's case, whereas a defendant may ask any question tending to destroy the plaintiff's claim (o).

SECT. 11.—MODE OF TRIAL.

(1.) *Former Practice and Objections thereto. Issues.*

Actions for infringement were originally tried before a judge and a special jury, taken from the same class of persons as those who were engaged in the trial of ordinary causes (p). Judge and jury.

The unfitness of the constitutional tribunal for the trial of patent actions gradually came, however, to be recognised, and was strongly insisted upon by the most eminent legal and scientific witnesses before the Parliamentary Committees of 1851, 1865, 1871, and 1872.

“Where there are long and difficult specifications to be read through, and to be construed and understood, and drawings and models to be looked at, it is quite impossible for twelve men in a jury-box to understand either the specifications, the drawings, or the models. They have no opportunity of inspecting the models, which require to be seen from different points of view, and thoroughly explained and examined. Yet the jurymen have to decide upon those very models, and upon the minute differences which may happen to exist in complicated machinery. The consequence is that trials now frequently become abortive. There was one case before Vice-Chancellor Wood occupying nine days, where the jury were unable to give a verdict; and in the same week there was a case before Lord Chief Justice Erle, which took six trying days, in which the jury were again discharged without coming to a decision” (q). Objections to trial of patent actions by jury.

“In consequence of their being unable to understand the merits they look out for some topic of prejudice upon which they can hang their verdict. If they can be induced to think that a man has had advantages for looking at a machine, or if they think that he has obtained information from a servant, they are very apt to be led away by that which they do understand—namely, that there

(o) *Hoffmann v. Postill*, 1869, L. R. 4 Ch. 673.

(p) Report, &c., 1865, Ans. 1274.

(q) Report, 1865; Evidence of Montague E. Smith, Esq., Q.C., M.P., Ans. 1272.

has been some attempt made, at all events, to get at the means of imitation, and they are very apt to jump at the conclusion that the thing has been imitated" (r).

"In the case of *Betts v. Menzies*—which was tried before Mr. Justice Erle, then a judge of the Court of Queen's Bench—after a trial of six days, the jury brought in a verdict, but some of them accompanied it with the remark that it was very unsatisfactory, for that they believed that they did not understand it; and Mr. Justice Erle said upon that: 'Well, then, gentlemen, I am afraid that that remark of yours has rendered our week's work of no value!'" (s).

The general consensus of opinion at these inquiries upon the subject of the mode of trial of patent actions, may be summed up as follows:—

(1) That in actions of infringement the advantages (t) of trial by jury might safely be surrendered;

(2) That in any arrangement which might be made the ultimate power to decide such actions must rest with the judge; and

(3) That the least objectionable change would be to give the judge trying an action for infringement the option of calling in the aid of a specially qualified assessor, selected *pro re nata*.

Lord Cairns
on trial by
jury at com-
mon law.

"If," said Lord Cairns in *Borill v. Hitchcock* (u), "the Court thinks it best that a question should be tried before a jury, a jury can be had, but if in the opinion of the Court a trial without a jury is preferable, neither party can claim a jury as a matter of right. It is a fallacy to say that under the old practice the Court required a legal question to be tried by jury. What it required was the judgment of a Court of Common Law. In most cases it was a necessary incident to proceedings at law that there should be the verdict of a jury before judgment, but these cases were sent to law not that they might be tried by a jury, but because this Court had not jurisdiction to decide upon a legal right."

The general objections to a jury as a tribunal for the trial of

(r) Report, &c., 1865, Ans. 1273.

(s) *Ibid.* 1279.

(t) Cp. Evidence of Mr. Grove, Report, 1865, Ans. 1077. "I have always had a very strong feeling in favour of trial by jury, but I think that it hardly suits patent cases upon the whole. The advantages of a jury are very great; it prevents the fixity of character of mind which exists in a single judge, or in a

judicial tribunal; however anxious to do right, they probably will have certain views of their own. The dual advantage of a jury, to my mind, is that it is a constantly fluctuating tribunal, consisting of a number of men, each of whom is devoting his individual mind to the particular question."

(u) 1868, L. R. 3 Ch. 417.

patent cases were forcibly stated by Lord Selborne in the *Patent Marine Inventions Co. v. Chadburn* (x) :—

“It is to be observed that such cases almost always involved questions of law and fact, not only mixed, but mixed in such a way as to render the extrication of them extremely difficult; secondly, that very often much must depend upon the construction of documents, as to which a jury must take their direction entirely from the judge; thirdly, that much of the evidence, or that which is to be permitted to be given as evidence, in such cases is argumentative and relative to matters of opinion, so as to make it extremely hard, even for the judge himself, to keep it under proper control; and, lastly, that even the questions of fact are often, to a very great extent, questions of science, which, to say the least, are as likely to be as well decided by a judge as by any jury. It very rarely happens, if it ever does, when the thing is not reduced to a narrow question of fact, that the jury do not simply follow, after a very elaborate discussion of the case by the judge, the direction of the judge.”

Lord Selborne on objections to trial of patent cases by jury.

The following issues were granted by the Court of Chancery under the old practice :—

Issues granted by Court of Chancery under old practice.

1. Is the invention a new manufacture?
2. Was the patentee the true and first inventor?
3. Is the specification sufficient?
4. Has the defendant infringed?
5. Is the invention one of public utility?
6. Is the invention described in the specification the same as that for which the patent is granted?

Of these issues, 1, 2, 3, 4, were those directed in *Davenport v. Jepson* (y); 5, was added in *Renard v. Levinstein* (z), and 6, was allowed in *Nedham v. Oxley* (a). In *Plimpton v. Malcolmson* (b), upon an issue as to the sufficiency of the specification, the defendant was permitted to dispute the utility of parts of the alleged invention; and in *Penn v. Bibby* (c), the objection of material variance between the provisional and complete specifications was allowed to be taken under the same issue.

The first and second of the issues above mentioned, were

(x) 1873, L. R. 16 Eq. 447.
 (y) 1862, 1 N. R. 173.
 (z) 1864, 1865, 11 L. T. N. S. 766;
 cp. *Spencer v. Jack*, 1862, 1864, 11 L. T.
 N. S. 242; *Penn v. Jack*, 1866, 14 L. T.

N. S. 496.
 (a) 1863, 8 L. T. N. S. 532.
 (b) 1875, 3 Ch. D. 531, 336.
 (c) 1866, L. R. 2 Ch. 127, 130.

treated as distinct; and in *Spencer v. Jack* (c), where on a motion for injunction, Lord Romilly, M.R., had directed an issue—Is it a new invention or manufacture? the Lords Justices on appeal severed the question of newness of invention from that of newness of manufacture. An objection that “the invention is not the subject of letters patent” is not a proper issue (d).

An issue as to infringement was not directed by the Court of Chancery unless the infringement was denied by the defendants (e). A defendant was not allowed to add a totally new issue of fact not in any way suggested by his answer to issues already directed for trial: but in order to raise such a new issue was required to file a supplemental answer (f).

Old rule as to sending case to jury, and issues.

Neither party could insist, *ex debito justitiæ*, upon having a patent case referred to a jury, and a reference was, in general, refused where either the case was clear or the issues had been already determined. But if there was a really doubtful question at issue, the Court would not decide it for itself if either party desired a jury (g).

In the case of *Davenport v. Goldberg* (g), in which these rules were laid down, it appeared that the patent in question had been the subject of three previous proceedings. In the first (h), there had been a trial before a jury: the plaintiffs had been non-suited on the ground that the specification was insufficient; but the non-suit was afterwards set aside by the Court of Queen’s Bench, and the plaintiffs signed judgment and obtained a decree. In the second proceeding (i), the plaintiffs had filed a bill against one Jepson, when a decree was made for a perpetual injunction. In a subsequent action against Jepson he did not appear and a verdict was taken for the plaintiffs. The defendant in *Davenport v. Goldberg* put in issue every point which had been raised in *Davenport v. Jepson*, and moved for a reference to a special jury (k) of the disputed questions of fact. Wood, V.-C., refused to grant issues on the questions of novelty and invention, but put the plaintiffs to prove the alleged infringement before a jury.

Issue of infringement alone sent to jury.

(c) See note (z), *ante*, p. 313.

(d) *Penn v. Jack*, 1866, 14 W. R. 760.

(e) *Davenport v. Phillips*, 1865, 5 N. R. 485.

(f) *Morgan v. Fuller*, 1866, L. R. 2 Eq. 296.

(g) *Davenport v. Goldberg*, 1865, 2 H. & M. 282.

(h) *Davenport v. Richards*, 1860, 3 L. T.

N. S. 503.

(i) *Davenport v. Jepson*, 1862, 1 N. R. 173, 307.

(k) When questions of fact were determined by a special jury before the Court of Chancery itself, it was not necessary to certify, under 21 & 22 Vict. c. 27, for the special jury. *Needham v. Oxley*, 2 N. R. 388.

“No person,” said his lordship (*l*), “is entitled to come here and say, ‘I raise such and such a question, and ask for a jury *ex debito justitiæ*,’ although there are certain classes of cases in which the course of the Court is, if the matter be new, not to decide important disputed questions of fact without the assistance of a verdict. . . . On the question of infringement, it appears that the matter is so doubtful that the plaintiffs did not venture to prove their motion for an interlocutory injunction, and I must therefore take it that there is such a *bonâ fide* contest of fact on that point that I ought to send that question to a jury if the defendant desire it.”

When the plaintiff’s counsel, in his opening statement, made charges which were not raised by the pleadings, and the defendant’s counsel thereupon asked for a jury, the application was acceded to, and the cause ordered to stand over (*m*).

The usual issues might be granted in a patent suit *before* the hearing of the cause, although the defendant denied the validity of the patent (*n*).

In *Roskell v. Whitworth* (*o*), Giffard, L. J., held, that while there was no inflexible rule as to the stage of a cause at which issues would, on the application of the defendant, be directed to be tried by a jury, the Court would require strong proof that the case was one which it could not satisfactorily try, if the defendant made the application not on the occasion of a motion for injunction or a motion to dissolve an injunction, but by an independent motion at any other time, and especially if it was after the disclosure of the plaintiff’s evidence.

In *Hoffmann v. Postill* (*p*), Giffard, V.-C., intimated that in future he should treat the hearing of issues in patent cases as the hearing of the cause, and would not advance them before the cases in the paper except upon a special case made.

In *Henderson v. Runcorn Soap and Alkali Co.* (*q*) the same learned judge stated that he would never grant a trial of issues at the request of the defendant, when opposed by the plaintiff.

Under the Rules made in pursuance of the Judicature Act, 1875, an adverse order for the trial of a patent action without a

Effect of Judicature Act and Rules on trial by jury.

(*l*) 2 H. & M. at p. 285; Cp. *Bovill v. Goodier*, 1865-67, L. R. 2 Eq. 195; *Bovill v. Hitchcock*, 1868, L. R. 3 Ch. 417.

(*m*) *Tangye v. Stott*, 1865, 14 W. R. 128.

(*n*) *Arnold v. Bradbury*, 1871, L. R. 6 Ch. 706, reversing the decision of the V.-C., 24 L. T. N. S. 613.

(*o*) 1870, L. R. 5 Ch. 459.

(*p*) 1868, 19 L. T. N. S. 276.

(*q*) 1868, 19 L. T. N. S. 377.

jury might be made, such an action having been, before the passing of the Judicature Acts, one which "without any consent of parties could be tried without a jury" (r).

On the other hand, there was no power given by the Judicature Rules to a Court of law to take away from a defendant his right under Ord. XXXVI. r. 26, of those rules to insist upon trial by jury (s).

When the Court was sitting without a jury, it did not require the same strictness in matters of pleading as was necessary in a trial before a jury, but followed that course of procedure which it deemed best to diminish expense, and to hasten the determination of the suit.

Thus in *Renard v. Levinstein* (t), where the defendant had given no notice of objection to the plaintiff's patent, on the ground of prior publication up to the time of hearing, and only gave notice of such objection after the plaintiff's case was closed and his own had been opened, a motion by him to amend his particulars of objection by adding an allegation of prior publication in a given document was allowed.

In order to bring a case within the proviso contained in sect. 2 of Sir John Rolt's Act (25 & 26 Vict. c. 42), authorizing the Court of Chancery, notwithstanding the Act, whenever it appeared that a question of fact might be more conveniently tried by a jury at the assizes, to direct such trial, it was held in *Young v. Fernie* (u) that the Court of Chancery must be satisfied that the administration of justice would be more conveniently exercised and promoted by directing such issues, than by completing the hearing and inquiry before itself.

The practice introduced into Chancery of having separate issues was not peremptory, and was merely a convenient mode of arranging the questions to be decided by the Court (x).

(2.) Existing Practice.

The Patents Act, 1883 (y), provides that actions for infringement shall be tried *without* a jury, unless the Court shall otherwise direct.

(r) See R. S. C. 1883, Ord. XXXVI. r. 4, re-enacting r. 26 of the order of 1875; *Patent Marine Inventions Co. v. Chadburn*, 1873, L. R. 16 Eq. 447; cp. also, *Swindell v. Birmingham Syndicate*, 1876, L. R. 3 Ch. D. 127; *Back v. Hay*, 1877, L. R. 5 Ch. D. 235; *Bordier v. Burrell*, 1877, L. R. 5 Ch. D. 515.

(s) *Sugg v. Silber*, 1874-77, 1 Q. B. D. 362.

(t) 1864-65, 11 L. T. N. S. 505; Agnew, 320.

(u) 1863, 1 De G. J. & S. 353.

(x) *Curtis v. Platt*, 1864, 11 L. T. N. S. 250.

(y) Sect. 28, sub-sect. 1.

The Judicature Acts, and the Rules of the Supreme Court, 1883, contain a number of provisions applicable to the trial of patent actions.

Rules of Supreme Court as to trial of patent actions.

The Court or a judge may, in any cause or matter requiring any scientific investigation, which cannot, in the opinion of the Court or a judge, conveniently be made before a jury, or conducted by the Court through its ordinary officers, order any question or issue to be tried before an official referee (z); and an action for infringement has been held to be an action requiring "scientific investigation" within the meaning of this rule (a).

The Court or a judge may direct the trial without a jury of any cause, matter, or issue requiring any prolonged examination of documents or accounts, or any scientific or local investigation which cannot, in their or his opinion, conveniently be made with a jury (b).

The Court or a judge may at any time order any cause, matter, or issue, to be tried by a judge with a jury (c), or by a judge sitting with assessors, or by an official referee or special referee with or without assessors (d).

The report of any such referee may be wholly or partially adopted by the Court (e).

Where, in any cause or matter, it appears to the Court or a judge that the issues of fact in dispute are not sufficiently defined, the parties may be directed to prepare issues, and such issues shall, if the parties differ, be settled by the Court or a judge (f).

Power to direct issues.

When the parties to a cause or matter are agreed as to the questions of fact to be decided between them, they may, after writ issued, and before judgment, by consent and order of the Court or a judge, proceed to the trial of any such question of fact without formal pleadings (g).

Trial without pleadings.

If it appear to the Court or a judge that there is, in any cause or matter, a question of law which it would be convenient to have decided before any evidence is given or any question or issue of fact is tried, or before any reference is made to a referee or an

Determination of question of law before issues of fact gone into.

(z) Jud. Act, 1873, r. 57.

(a) *Sarby v. Gloucester Waggon Co.*, 1880-81, W. N. 1880, p. 28; L. R. 7 Q. B. D. 305.

(b) R. S. C. 1883, Ord. XXXVI. r. 5.

(c) Trial by jury cannot be had before a judge of the Chancery Division. *Warner v. Murdoch*, 1877, 4 Ch. D. 750.

(d) R. S. C. 1883, Ord. XXXVI. r. 7.

(e) R. S. C. 1883, Ord. XXXVI. r. 55; Cp. *Badische Anilin und Soda Fabrik v. Levinstein*, per Pearson, J., 24 Ch. D. 156; *Moor v. Bennett*, 1881, 1 P. O. R. C. A. pp. 129, 133; *Edison Co. v. Holland*, 1888, 5 P. O. R. 459, 480.

(f) R. S. C. 1883, Ord. XXXIII. r. 1.

(g) *Ibid.*, Ord. XXXIV. r. 9.

arbitrator, the Court or judge may make an order accordingly, and may direct such question of law to be raised for the opinion of the Court, either by special case, or in such other manner as the Court or judge may deem expedient, and all such further proceedings as the decision of such questions of law may render unnecessary may thereupon be stayed (*h*).

Questions of fact may be tried differently or one before the other.

The Court or a judge may, in any cause or matter, at any time or from time to time, order that different questions of fact arising therein be tried by different modes of trial, or that one or more questions of fact be tried before the others, and may appoint the places for such trials, and in all cases may order that one or more issues of fact be tried before any other or others (*i*).

There have been several decisions under this rule.

Cases.

In *United Telephone Co. v. Mottishead* (*k*), where the defendants denied both the validity of the patent, and the alleged infringement, it was held by Mr. Justice Kay that an order for the trial of the latter question by itself could not be made unless the defendants admitted the validity of the patent for the purposes of the action, and his lordship declined to take a qualified admission.

Prior user.

In *Richardson v. Castrey* (*l*), where the defendants denied infringement, put in issue the validity of the patent, and alleged prior user of the invention by several persons, North, J., at the trial, decided to dispose of the alleged evidence of one user before going into the others.

In *Batham v. Bird* (*m*), at the close of the examination of the plaintiff, who was called as first witness, the defendant's counsel undertook to prove prior user of articles admitted to be similar in all essential points to the patented article. A witness was accordingly examined on behalf of the defendant who had superintended the manufacture of such articles for some years prior to the date of the patent, and the action was thereupon dismissed.

Setting down a motion for judgment where issues have been directed and tried.

Where issues have been tried, the plaintiff may at once set down a motion for judgment as soon as the issues have been determined; and where some only of the issues have been tried or determined, any party who considers that the result renders the trial or determination of the others unnecessary, or renders it desirable that such trial or determination should be postponed, may

(*h*) R. S. C. 1883, Ord. XXXIV. r. 2. Only such questions of law can properly be raised under this rule as must necessarily arise in the action. *Republic of Bolivia v. National Bolivian*

Navigation Co., 1876, 24 W. R. 361.

(*i*) R. S. C. 1883, Ord. XXXVI. r. 8.

(*k*) 1886, 3 P. O. R. 213.

(*l*) 1887, 4 P. O. R. 265.

(*m*) 1888, 5 P. O. R. 233.

apply to the Court for leave to set down the action or motion for judgment without waiting for such trial or determination. And the Court may give such leave upon such terms, if any, as shall appear just (*n*).

In *Blakey v. Latham* (*o*), where the judge was of opinion that if the patent was valid the defendants had infringed, held that the patent being invalid, the defendants were entitled to the whole costs of the action, including the costs of the issue of infringement. Costs of issues.

In *Automatic Weighing Co. v. Knight* (*p*), an action for infringement, a successful defendant was ordered to pay the costs of issues on the validity of the patent unsuccessfully raised by him.

In *Boyd v. Horrocks* (*q*), the judge at the trial found numerous issues in favour of the plaintiffs, including infringement; the Appeal Court heard the question of infringement first, and on that dismissed the action reversing the decision of the judge. It was held, that the only order that could be made was to reverse the judgment and dismiss the action with costs without any apportionment (*r*).

(3.) *Scientific Assessors.*

Before the Act of 1852 the law officers had for some time been occasionally in the habit of summoning scientific experts to their assistance, in dealing with applications for letters patent.

The Act of 1852, s. 8, gave legislative sanction to this practice, providing that "the provisional specification shall be referred to the law officer, who shall be at liberty to call to his aid such scientific or other person as he may think fit, and to cause to be paid to such person by the applicant such remuneration as the law officer shall appoint." Reference of provisional specification to expert.

This power was, however, rarely made use of, as numerous practical difficulties arose.

The Patents Act, 1883, invested the Courts with the power conferred on the law officer by the Act of 1852. It is provided that— Power to call in assessor.

In an action or proceeding for infringement or revocation of a

(*n*) R. S. C. 1883, Ord. XL. rr. 7, 8.
 (*o*) 1889, 6 P. O. R. 29.
 (*p*) 1889, 6 P. O. R. 366.
 (*q*) 1889, *ibid.* 162.
 (*r*) In an action to restrain threats by a patentee the plaintiff alleged the patent was invalid and that he had not infringed. At the trial he gave up the issue of validity, but a jury found there was no infringement. The plaintiff was given the general costs of the action, except the costs of the issue of validity, which were given to the defendant: *Ungar v. Sagg*, 1889, 6 P. O. R. 337.

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 (*a*).

Also, that 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 (*b*).

And that the remuneration, if any, to be paid to an assessor 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 the Act (*c*).

This power of trying with an assessor has been practically in abeyance, and there seems little likelihood of its coming into common practice.

Position of
assessors.

The rule laid down by Lord Esher in the case of *The Beryl* (*d*), that the judgment was that of the judge alone, who was not bound to follow the opinion of the nautical assessors to the Admiralty Division, would, no doubt, be applied in actions of infringement also should a necessity for deciding this point arise.

SECT. 12.—PERPETUAL INJUNCTION.

When
granted.

After a patentee has conclusively (*e*) established the validity of his patent, he may obtain a perpetual injunction, extending to the whole duration of the patent privilege, and applying not merely to the particular mode of infringement proved against the defendant, but to all other modes in which the patent privilege may be violated (*f*).

How validity
of patent may
be estab-
lished.

The validity of a patent may, of course, be established by decree after trial; or the patentee may move for judgment on admissions in the pleadings (*g*); or the defendant may, as to the whole or any

(*a*) Sect. 28, sub-sect. (1).

(*b*) *Ibid.* sub-sect. (2).

(*c*) *Ibid.* sub-sect. (3).

(*d*) 1884, 9 P. D. 137, 141.

(*e*) *Hills v. Evans*, 1862, 31 L. J. Ch. 457; 4 De G. F. & J. 289.

(*f*) Hindmarch, p. 361.

(*g*) R. S. C. 1883, Ord. XXXII. r. 6. Where in an action for infringement of a patent, the defendant in the defence

admitted certain instances of infringement, but denied that he had committed any others, and the plaintiff thereupon moved for judgment upon the admissions in the pleadings, it was held that the plaintiff was entitled to an inquiry as to damages arising from the admitted infringements only. *United Telephone Co. v. Donohoe*, 1886, 31 Ch. D. 349.

part (*h*) of the plaintiff's case, submit to a perpetual injunction, on terms of paying the costs of the action (*i*).

Where a defendant has consented to a perpetual injunction against him, the Court will allow such consent to be withdrawn when it has been given by surprise, error, or mistake; but the subsequent discovery by the defendant of certain facts on which he conceives he can found a defence, is not a sufficient ground for such withdrawal (*k*).

Withdrawal of consent to perpetual injunction.

As to stay of proceedings or execution, see *infra*, p. 343. For forms of orders for perpetual injunctions, see Appendix, pp. 797 *et seq.*

If a defendant continues the infringement after an order granting an injunction has been (a) served upon him (*l*), or (b) brought to his knowledge with notice that the plaintiff intended to enforce it (*m*), a motion for his committal may be made.

Breach of injunction.

The continuance of an infringement after injunction is a contempt, even although the defendant thought he was not infringing (*n*).

Motions to commit when only an apology and costs are asked for, and no serious case for committal is made out, are discouraged by the Courts (*o*).

Motion to commit for.

It is not a breach of an injunction for the person against whom it has been ordered to publish advertisements asking for subscriptions towards the expense of an appeal, or documentary evidence of anticipation (*p*).

The mere making, using, or vending of the elements which afterwards enter into a patent consisting of a combination, is not prohibited by and is not an infringement of the letters patent (*q*).

If, however, there was a patent for a knife of a particular construction, and an injunction was granted restraining a defendant from selling knives made according to the patent, and he was to

(*h*) *Curtis v. Pope*, 1888, 5 P. O. R. 150.

(*i*) *Hume v. Beale*, Seton, p. 295.

(*k*) *Elsas v. Williams*, 1884, 1 Times R. 145.

(*l*) *Clayton v. Percy*, 1854, Higgins' Dig. 1044.

(*m*) *United Telephone Co. v. Dale*, 1883-84, 25 Ch. D. 778.

(*n*) *Plimpton v. Spiller*, 1876-77, 4 Ch. D. 287.

(*o*) *Plating Co. v. Farquharson*, 1881, 17 Ch. D. 49. The defendant in an action for infringement of a patent had consented to an injunction. The plaintiff

in the action, in consequence of a subsequent infringement by the defendants, the infringement not being identical with the first, moved in the action to attach the defendant for breach of the injunction. It was held by the Court of Appeal in Ireland, that this was the right form of proceeding: *Thomson v. Moore*, 1889, 6 P. O. R., at p. 445.

(*p*) *Plating Co. v. Farquharson*, *supra*.

(*q*) *Townsend v. Haworth*, 1875, per Jessel, M. R. 12 Ch. D. 831, n.; *cp. McCormick v. Gray*, 1861, 7 H. & N. 25; *Sykes v. Howarth*, 1878, 12 Ch. D. 826.

sell the component parts so that any schoolboy could put them together and construct the knife, that sale would be a breach of the injunction (r).

Determina-
tion of patent
a defence to
motion to
commit.

Upon a motion to commit a defendant for breach of an injunction, it is open to the defendant to show that the patent having been determined, there was no longer any order of the Court in existence which he could be said to have infringed (s).

Technical
breach of in-
junction,
when lawful.

A technical breach of injunction may in some cases be lawful.

For example: a master who comes on board a vessel ought not to be answerable on the ground that when he takes the command there is on board a pump which infringes a patent. He does not, owing to his qualified possession, become at once an infringer. He had no power to take a pump out of a ship, he had nothing to do with putting it there, and he was not wrong in allowing it to remain there, for he could not lawfully remove it. . . . Whatever appliances there may happen to be on board, however they came there—pumps, anchors, fire extinguishers, stolen or not stolen, pirated or not pirated—it is the master's bounden duty to use them according to the exigencies of navigation for the safety of ship, cargo, and life. To the master when out at sea (injunction or no injunction) *salus navis est suprema lex*. A master would be practically as safe in disobeying an injunction under a pressing emergency as he would be in shooting a mutineer (t).

Solicitor and
client costs.

On a motion to commit, costs as between solicitor and client may be given to a successful plaintiff (u), but not to a successful respondent (x).

In *Spencer v. The Ancoats Vale Rubber Co.* (y), where it appeared that the acts complained of had not been done vexatiously, but in the probable belief—an erroneous one—that the company were entitled to do what they did, solicitor and client costs were refused, but costs on the higher scale were given.

SECT. 13.—ACCOUNT AND DAMAGES.

(1.) Account.

There are two points in which the modern differs from the earlier practice of the Courts as to ordering an account of profits.

(r) *United Telephone Co. v. Dale*, 1883-84, per Pearson, J., 25 Ch. D. 782.

(s) *Daw v. Eley*, 1867, L. R. 3 Eq. 496.

(t) *Adair v. Young*, 1879, per James, L. J., 12 Ch. D. 20.

(u) *Plating Co. v. Farquharson*, 1879-83, 17 Ch. D. 48, 67; *Steele v. Hutchings*, 1879, W. N. 18.

(z) *Plating Co. v. Farquharson*, *ubi supra*.

(y) 1889, 6 P. O. R. 46, 68.

Differences
between
former and
modern
practice.

I. The account was formerly an adjective remedy to an injunction.

“Whenever the plaintiff,” says Mr. Hindmarch (z), “has made out a title to the interposition of the Court by injunction in his favour, . . . the Court gives him an account, in order that his remedy may be complete. But if the plaintiff fails to make out his claim to an injunction, he cannot have a decree for an account.”

Thus, where the patent alleged to be infringed expired before (a) or during (b) an action, so that an injunction could not be granted, an account of profits was generally refused.

A party would not, however, be allowed to prepare for the expiration of a patent by illegally manufacturing articles, and immediately after its expiration to deluge the market with the produce of his piracy, thus reaping the reward of his improbus labour in making it (c).

This rule was modified after Lord Cairns's Act had empowered the Court of Chancery to award damages.

Where the plaintiff's bill was filed shortly before the expiration of his patent, and made (but *aliter* if it did not make (d)) application for an interim injunction, the Court, although refusing an account of profits, would direct an inquiry as to what damages the plaintiff had sustained (e).

Any Division of the High Court may now order an account, or grant damages for infringement, whether an action is commenced before or after the expiration of the patent alleged to be infringed (f).

II. A plaintiff might formerly obtain both an account and an inquiry as to damages against the same defendant (g).

The case of *Neilson v. Betts* (h), however, most undoubtedly decided the general principle that upon a decree against a party for the infringement of a patent, the patentee is not entitled both

(z) P. 361; and *op. Bailey v. Taylor*, 1825, 1 R. & M. 73; *Smith v. L. & S. W. Rail. Co.*, 1854, Kay, 408; *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.*, 1858, 4 K. & J. 727; *Hocking v. Fraser*, 1886, 3 P. O. R. 7.

(a) *Smith v. L. & S. W. Rail. Co.*, *ubi supra*.

(b) *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.*, *ubi supra*; *contra*, however, in *Fox v. Dellestable*, 1866, 15 W. R. 149.

(c) *Crossley v. Derby Gas Co.*, 1834, 1838, per Lord Brougham, L. C., 4 L. J.

Ch. at p. 26.

(d) *Betts v. Gallais*, 1870, L. R. 10 Eq. 392, per James, V.-C.

(e) *Davenport v. Rylands*, 1865, L. R. 1 Eq. 302, per Wood, V.-C.

(f) R. S. C. 1883, Ord. XV. r. 1. *Fork v. Stowers*, 1883, W. N. 1883, 174.

(g) *Elmslie v. Boursier*, 1869, L. R. 9 Eq. 217; *op. Hills v. Evans*, 1862, 4 De G. F. & J. 288, 309; L. R. 6 H. L. 321, n. (2).

(h) 1871, L. R. 5 H. L. 1.

to an account of profits and an inquiry into damages. That principle applies generally, and without any distinction at all. It applies to every case of infringement, and therefore it must be taken to have settled conclusively that point that the patentee must, in all these cases where he has a decree, elect whether he will have an account of profits or an inquiry into damages (*i*).

“It has never been held that an account directed against a manufacturer of a patented article licenses the use of that article in the hands of all the purchasers. The patent is a continuing patent, ‘and the article may’ be followed in every man’s hand until the infringement is got rid of. So long as the article is used, there is continuing damage” (*k*).

Where, however, a patentee is in the habit of granting licences of the patented articles, and a manufacturer who has infringed the patent right pays, not by way of agreed damages (*l*), a sum equal to the ordinary royalty which the patentee demands from his licensees, he cannot recover any further sum from the manufacturer (*m*), and every article in respect of which such payment is made becomes a free instrument in the market, so far as purchasers without notice or warning from the patentee are concerned (*n*).

A patentee who takes separate proceedings against the manufacturer and the user of the patented articles cannot be compelled to accept the same royalty from a litigant as he receives from others (*o*).

An account extends to all the direct or collateral profit which the defendant has made (*p*), and to any saving he has effected (*q*) by infringing the plaintiff’s patent privilege.

It did not, however, under the Patent Law Amendment Act, 1852, and does not now, include the loss which the plaintiff sustained by reason of the infringement (*r*). The only question is,

(*i*) *De Vitre v. Betts*, 1873, L. R. 6 H. L. 321.

(*k*) *Penn v. Bibby*, 1866, per Wood, V.-C., L. R. 3 Eq. 308; *Penn v. Fernie*, *ibid*; *Penn v. Jack*, *ibid*.

(*l*) *United Telephone Co. v. Walker*, 1887, 4 P. O. R. 63, 67.

(*m*) *Penn v. Jack*, 1867, L. R. 5 Eq. 81.

(*n*) *Cropper v. Smith*, 1882, 24 Ch. D. 306, 312.

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

(*p*) *Crossley v. Derby Gaslight Co.*, 1834, 3 M. & Cr. 428.

(*q*) *Househill Co. v. Neilson*, 1843, 1 Web. P. C. 697, n. (*r*). In *Bacon v. Spottiswoode*, 1839, 1 Beav. 387, it was

held that in such a case as *Househill Co. v. Neilson*, the plaintiff must allege in his bill and prove at the trial that such a saving had been effected.

(*r*) *Ellwood v. Christy*, 1865, 18 C. B. N. S. 494; overruling *Walton v. Lavater*, 1860, per Byles, J., 8 C. B. N. S. 190. For other decisions under the Act of 1852, see *Holland v. Fox*, 1854, 3 E. & B. 977; *Vidi v. Smith*, 1854, 3 E. & B. 969. In *Ellwood v. Christy*, where the plaintiff was assignee, an account was ordered only from the date of the registration of the assignment. But see *United Horseshoe and Nail Co. v. Stewart*, 1888, 13 A. C. 401, 417.

To what profits account extends.

what advantage the infringer has derived from the use of the patent over and above what he would have got from the use of processes open to the public (s).

An order for an account is a debt provable in the infringer's liquidation.

An account will not be ordered when the evidence shows either that no profits have been made at all (t), or that the sales have been insufficient to make it worth while (u).

A plaintiff's right to an account, as well as to an injunction, may be barred by delay or acquiescence (v).

In taking an account against a defendant who has infringed a patent, it is proper to take into account for the purpose of comparison the profits made by him prior to the date of infringement. In *Siddell v. Vickers* (x), the patentee of an invention for an appliance for operating on large forgings commenced an action for infringement of his patent against Messrs. V. & Co. At the trial the judge granted an injunction, and an account of profits. The defendants appealed, and the Court of Appeal affirmed the judgment, and directed an account of all iron or steel forgings manufactured by the defendants by the use of the plaintiff's invention, and also of the profits made by the defendants by reason of such use. On the taking of the account the defendants refused to give any account of the profits made by them prior to the date at which they commenced to use the plaintiff's invention. The plaintiff took out a summons for directions as to taking the account, and that the defendants should bring in a further and better affidavit. It was held that the plaintiff was entitled to an account of the profits made by the defendants prior to the date at which they commenced their use of his invention.

(2.) Damages.

The inquiry is in the form "what damage," and not as in the case of a trade-mark "what damage, if any, the plaintiff has

Nature of inquiry.

(s) *United Horseshoe and Nail Co. v. Stewart*, 1886, 3 P. O. R. 143, per Lord Kinnear, and American case, *Mowry v. Whiteley*, cited by him *ubi supra*; and 14 Wall. N. S. 620.

(t) *Bergmann v. Macmillan*, 1881, L. R. 17 Ch. D. 427.

(u) *Sanitas Co. v. Condy* (a trade-mark case), 1887, 4 P. O. R. 533; *Watson v. Holliday*, 1882, 20 W. R. 747; 31 W. R. 536.

(v) *Crossley v. Derby Gas Light Co.*, 1834, 1 Web. P. C. 120; and see *ante*, p. 275.

(x) 1889, 6 P. O. R. 464.

sustained." There is this difference between the case of a trademark and that of a patent, as regards an inquiry into damages. In the former case, the article sold is open to the whole world to manufacture, and the only right the plaintiff seeks is that of being able to say "don't sell any goods under my mark." He may find his customers fall off in consequence of the defendant's manufacture; but it does not necessarily follow that the plaintiff can claim damages for every article manufactured by the defendant, even though it be under that mark. On the other hand, every sale without licence of a patented article must be a damage to the patentee (*y*).

In *Davenport v. Rylands* (*y*), accordingly, although the defendant had purchased in open market the article complained of, in ignorance of the process of its manufacture, and of the fact of infringement, the inquiry was ordered to extend to the sale within six years of the filing of the bill.

Where damages are granted in lieu of an injunction, the Court may assess the damages accrued after, as well as before, the issue of the writ (*z*).

When damages are to be assessed in respect of any continuing cause of action, they shall be assessed down to the time of the assessment (*a*).

The ascertainment of damages, where it is substantially a matter of calculation, may be referred to an officer of the Court (*b*). In the Chancery Division, the question of damages cannot after judgment be tried by a jury, but must be referred to a chief clerk or referee (*c*).

Under the Chancery Acts, 1852 and 1858, the question of damages was left to be decided by a jury where there was extreme difficulty in their assessment by the Court itself (*d*).

In the order for an account or for damages, there is usually, but not always, inserted a clause requiring the defendant to pay to the plaintiff the sum found due by way of profit or damages within a limited time after the filing of the certificate of the finding (*e*).

(*y*) *Davenport v. Rylands*, 1865, per Wood, V.-C., L. R. 1 Eq. 308; *United Horseshoe and Nail Co. v. Stewart*, *ubi supra*.

(*z*) *Fritz v. Hobson*, 1880, 14 Ch. D. 543, a case under Lord Cairns's Act, now repealed.

(*a*) Ord. XXXVI. r. 58.

(*b*) *Ibid.* r. 57.

(*c*) *American Braided Wire Co. v. Thomson*, 1888, 4 Times Rep. 755; cp. *Westinghouse v. Lancashire and Yorkshire Rail. Co.*, 1884, 1 P. O. R. 253.

(*d*) *Betts v. De Vitre*, 1864, 11 Jur. N. S. 9.

(*e*) *Plimpton v. Malcolmson*, 1876, Seton, 354; *Cunningham v. Gilling*, 1864, *ibid.* 355; *Betts v. Neel*, *ibid.*

Form of inquiry

Damages, how ascertained.

An inquiry as to damages will not be granted where no damage or only nominal damage has been proved (*f*).

Damages may be awarded although not specifically claimed in the pleadings (*g*).

In *Proctor v. Bayley* (*h*) the Court of Appeal, in dismissing an action for an injunction, there being no jurisdiction to grant damages without the injunction, refused to give any opinion as to whether the dismissal of the action would be prejudicial to a subsequent action at law for damages.

When a case is tried by a jury, and damages are desired, the plaintiff ought to lay his claim before the jury for assessment (*i*).

In a recent case (*k*), however, where it appeared that damages, although claimed in the pleadings, were by an oversight not asked for at the trial, Kay, J., gave special leave, on subsequent motion by the plaintiff, to vary the minutes of the decree by adding an inquiry as to damages.

Under an order of inquiry, a plaintiff is entitled to compensation for the actual loss he has sustained by the sale of the infringing articles (*l*). Measure of damages.

This definition of the measure of damages enables us at once to put aside as irrelevant, the vexation and annoyance of a lawsuit, for which a plaintiff must find relief in his costs (*m*), profit by the infringer not arising from the use of the patentee's invention, and not materially injuring the patentee's sales, and loss incurred by the plaintiff having, in consequence of the defendant's competition, reduced the price of his patented article.

The loss must be the natural and direct consequence of the defendant's acts (*n*).

The following are the chief rules which have been laid down as to the measure of damages.

Where judgment for damages has been recovered for the infringement of a patent, and the plaintiffs were not in the habit of selling, but more usually of letting out, the patented article at a rent or royalty, the measure of damages is the profit rent of the

(*f*) *Dicks v. Brooks*, 1880, L. R. 15 Ch. D. 39, per James, L. J.; *United Telephone Co. v. Sharples*, 1885, 2 P. O. R. 28; *Cole v. Saqui*, 1888, 5 P. O. R. 489, 496.

(*g*) *Betts v. Neilson*, 1868, 18 L. T. N. S. 159.

(*h*) 1889, 6 P. O. R. 538.

(*i*) *Needham v. Oxley*, 1863, 8 L. T. N. S. 604.

(*k*) *Edison and Swan Electric Light Co. v. Holland*, 1888, 5 P. O. R. at p. 483.

(*l*) *United Horseshoe and Nail Co. v. Stewart*, 1888, 13 A. C. at p. 408; *Ledgard v. Bull*, 1886, 11 A. C. 648, 654.

(*m*) *Penn v. Jack*, 1867, L. R. 5 Eq. 81.

(*n*) *United Horseshoe, &c. Co. v. Stewart*, *ubi supra*, at p. 413; followed in *American Braided Wire Co. v. Thompson & Co.*, 1890, 7 P. O. R. 47.

article during the entire period from the time when it came into the possession of the infringer until the assessment of damage, or the date of its delivery up. It is immaterial for the purposes of that assessment, whether the article has or has not been in actual use during any portion of that period. A defendant is not entitled to set-off against such damages the value of any infringing article delivered up under the judgment of the Court, nor any portion of any agreed sum for damages for infringement recovered by the plaintiff in a previous action against the manufacturer from whom the defendant had bought the article, although the period in respect of the rent payable as damages commenced at a date antecedent to the commencement of the action against the manufacturer (o).

If, however, the damages recovered by the plaintiff from the manufacturer had not been an agreed sum, but a sum representing the full rent or royalty, the defendant would have been entitled to a set-off (p).

In *Arkwright v. Nightingale* (q), Lord Loughborough said—though he was not called upon to decide the point—that he would allow an unsuccessful defendant in an action for infringement to show, by way of mitigating damages, that the verdict in a previous action had been adverse to the patent and parties had acted on the faith of it.

SECT. 14.—DELIVERY UP OF INFRINGING ARTICLES.

Besides an injunction, an account of profits or damages, a successful patentee may obtain an order that, within a time limited thereby (r), the infringing articles shall be ascertained and (a) destroyed (s), or (b) delivered up to the plaintiff (t), or (c) marked (where the patentee's invention is composite, and the various parts may be innocently used for other purposes) so as to prevent a continuation of the infringement (u).

Delivery up
of infringing
articles.

(o) *United Telephone Co. v. Walker*, 1887, 4 P. O. R. 64.

(p) *S. C.*; and see *Penn. v. Jack*, and *Penn. v. Bibby*, *ubi supra*.

(q) 1785, 1 Web. P. C. 61.

(r) *Washburn and Moes Manufacturing Co. v. Patterson*, 1884, 1 P. O. R. 191; *Otto v. Steel*, 1886, 3 P. O. R. 109, 120.

(s) *Betts v. De Vitre*, 1864, 34 L. J. Ch. 289, 291; *Emperor of Austria v.*

Day, 1861, 3 De G. F. & J. 217.

(t) *Tangye v. Stott*, 1865, 14 W. R. 386; *Young v. Fernie*, Pemberton, 236; *Washburn, &c.*, *ubi supra*, 158, 162, 191.

(u) *Needham v. Oxley*, 1863, 8 L. T. N. S. 532; *Westinghouse v. Lancashire and Yorkshire Rail. Co.*, 1884, 1 P. O. R. 253; *Plimpton v. Malcolmson*, Seton, 354; *Badiouche Anilin, &c.*, 1884, 24 Ch. D. 176.

SECT. 15.—Costs.

(1.) *General.*

Prior to 1840, a plaintiff in an action of infringement who obtained even nominal damages, was entitled to recover his full costs against the defendant, unless the judge before whom the action was tried certified under 43 Eliz. c. 6, s. 2, that no costs should be allowed.

Costs before
1840.

The statute 3 & 4 Vict. c. 24, s. 1, repealed so much of that enactment as related to costs in actions of trespass on the case (which included patent actions), and provided that if the plaintiff recovered less than 40s. damages he should not be entitled to any costs at all unless the presiding judge should, immediately after verdict, certify that "the action was really brought to try a right besides the mere right to recover damages or that the trespass or grievance in respect of which the action was brought was wilful and malicious."

Costs where
less than forty
shillings re-
covered.

A certificate could only be granted under 3 & 4 Vict. c. 24, immediately after the trial. The lapse of several months between a verdict for nominal damages (*x*) and an application for a certificate by the successful plaintiff was held to be a fatal obstacle to the exercise by the judge of his statutory discretion; and the Court even doubted whether a certificate could be granted after another cause had been called on (*y*).

Certificate
had to be ob-
tained imme-
diately after
trial.

(2.) *Certificate of Validity.*(a) *Under Act of 1835.*

The statute 5 & 6 Will. IV. c. 83, enacted that in any action at law, or any suit in equity, in respect of any alleged infringement of letters patent, the judge might certify that the validity of the patent came in question before him, and that on this certificate being given in evidence in any other suit in which the patentee obtained a verdict, the patentee should be entitled to receive treble costs, unless the judge certified to the contrary (sect. 3), *to be taxed*

Certificate of
validity under
Act of 1835.

(*x*) The damages awarded under this Act were usually nominal, the plaintiff's object being to establish his right at law before seeking pecuniary reimbursement for his losses from a suit in equity. Sometimes, however, they were exemplary. Thus, in *Lewis v. Marling*,

1829, 1 Carp. 475, the jury gave 200*l.* damages; and in *Newton v. Grand Junction Rail. Co.*, 1845, 5 Exch. 331, they were assessed at 1,000*l.* Coryton, p. 307.

(*y*) *Gillott v. Green*, 1841, 10 L. J. Ex. 124; 7 M. & W. 347.

Treble costs. *at three times the taxed costs (s).* The policy of this enactment is very clearly explained by Hindmarch.

Policy of this rule.

Improved position of a patent which has been contested.

“ Before a patentee has established his claim to a patent privilege by legal proceedings, he has no proof of his title except his patent, and that has been obtained upon his own unsupported representation. But when a patentee’s title to a patent privilege has been once fairly established in a Court of law or equity, he stands in a very different position, and he may very fairly claim to be better protected by the law than a patentee who has no verdict, judgment, or decree evidencing his title to such a privilege. It would not be fair to extend the protection to a patentee who has established his patent right in an action at law so far as to prevent any person from afterwards contesting the validity of the patent, for the defendant in an action might, through ignorance or collusion with the plaintiff, suffer him to obtain a verdict, and other persons may afterwards be able to show that the patent is void. But when the patentee has the evidence of a verdict or judgment in his favour, it is only proper that he should be so far protected that if he is again compelled to try the validity of his patent, he should be enabled to recover the full amount of his costs, if he again succeeds in establishing his title. The object of 5 & 6 Will. IV. c. 83, s. 3, was to indemnify patentees against their costs in actions which they may be compelled to bring after they have established their patent, and also to deter persons from committing vexatious infringements of such patents by the penalty of treble costs ” (a).

Penal costs.

Conditions necessary to obtain treble costs.

There were two conditions precedent to the enjoyment by a patentee of the protection of this enactment: (1) he must have obtained a verdict or decree in the subsequent action; and (2) the judge before whom the first action was tried must have granted his certificate that the validity of the patent had come in question

(c) The costs which this statute enabled a patentee to recover on a second or subsequent verdict passing for him were “ treble costs, to be taxed at three times the taxed costs.” The words in italics prevented the application of the ordinary rule as to double or treble costs, viz., that “ double or treble costs are not to be understood to mean, according to their literal import, twice or thrice the amount of single costs.” Without any such clause of interpretation, the amount of treble costs would

have been calculated in the following manner. To the sum allowed to the party for costs taxed in the ordinary way, was added one half of that sum, and also one fourth of the same sum, and these three sums being added together, formed what was technically termed treble costs, i. e., common costs, and three-fourths of the common costs, or one fourth less than twice the common costs. Hindmarch, p. 303; Webster State. p. 37, n. (c).

(a) Hindmarch, pp. 301, 302.

before him. The judge could deprive a successful plaintiff of costs if he thought fit.

The second condition was necessary because the pleadings in a cause might, upon the face of them, appear to raise almost every possible question respecting the validity of the patent; and yet the defendant might not at the trial or hearing raise any such question (*b*).

Thus in *Shocker v. Rodgers* (*c*), the pleas were "not guilty," that the invention was not new, and that the specification was not sufficient. At the trial, however, no defence was offered, and the defendant consented to a verdict for 40s. damages. Erskine, J., before whom the cause was tried, refused to give the plaintiff a certificate under 5 & 6 Will. IV. c. 83, s. 3, although the defendant's pleas had put in issue the validity of the patent. "I think," said his lordship, "that as this is a verdict by consent, and as no evidence has been adduced before me, I ought not to grant a certificate. My certificate would affect third parties, and it would be possible in a case like the present for two parties by collusion to consent to a verdict in favour of a patent; and if they could obtain a certificate under the third section of the statute to use it afterwards to the injury of a third party who was really contesting the validity of the patent."

No certificate of validity where patent not really contested.

In *Gillett v. Wilby* (*d*), however, the validity of the patent did partly come in question under a plea of want of novelty, and a certificate was granted although the defendant did not call any witnesses.

Aliter.

The privilege conferred on patentees by this statute was, however, abused. An instance is recorded by Godson, in which a successful patentee commenced no less than forty actions. Accordingly, the Act 5 & 6 Vict. c. 97, s. 1, repealed that portion of 5 & 6 Will. IV. c. 83, s. 3, which gave treble costs, and provided that the costs should be taxed in such a way as to be a "full and reasonable indemnity as to all costs, charges, and expenses incurred in and about" the action.

Abuse of rule as to treble costs.

(b) Under Act of 1852.

The right of a patentee to have full costs under 5 & 6 Will. IV. c. 83, s. 3, amended by 5 & 6 Vict. c. 97, s. 1, was dependent

Discretion of judge.

(b) *Ibid.* p. 302.

(c) 1843, 1 C. & K. 99.

(d) 1839, 9 C. & P. 334; *Newall v.*

Wilkins, 1851, 17 L. T. 20; *Stocker v. Rogers*, 1843, 1 Car. & K. 99.

on the discretion of the judge before whom the second action was tried, and who might deprive him of such costs by certifying to that effect at the trial. This discretion was liable to be exercised when the certificate of validity had been obtained by the patentee in an action tried by collusion for the purpose of obtaining it (e), or where the second action appeared to be a harsh or unnecessary proceeding, or ended in a compromise (f), or when the defendant in that action did not question the validity of the patent, but wished *bonâ fide* to try a doubtful question of infringement (g).

Collusion.

Unnecessary action.

Compromise.

Validity not questioned.

Effect of Act of 1852.

Any doubt (h) as to the meaning of the term "full costs" in 5 & 6 Vict. c. 97, s. 1, was removed by sect. 43 of the Patent Law Amendment Act, 1852, which defined it as "full costs, charges, and expenses, taxed as between attorney and client," and repeated in substance the provisions of the earlier statutes, and enacted that it should be lawful for the judge before whom an action for infringing letters patent was tried, to certify on the record that the validity of the patent came in question, and that the record with such certificate being given in evidence in any suit or action for infringing the said letters patent should entitle the plaintiff, on obtaining a decree, decretal order, or final judgment, to full costs as above defined, unless the judge should certify that he ought not to have them.

Certificate of validity.

The practice under this section was as follows:—

(1.) The provisions applied only to a patentee; and no certificate could be given to the defendant in an action for infringement (i).

This is still the law under sect. 31 of the Patents Act, 1883.

(2.) It was necessary that the certificate of validity should be given in evidence at the subsequent trial.

There is no provision to this effect in the new statute. But it seems that proper evidence of the certificate should be given.

(3.) The words "decree, decretal order, or final judgment," did not include a motion for a new trial of a subsequent action, and the costs of an unsuccessful motion of that description were given only as between party and party (k).

(e) *Davenport v. Rylands*, 1865, L. R. 1 Eq. 309.

(f) *Betts v. De Vitre*, 1864, 11 Jur. N. S. 9.

(g) *Cp. United Telephone Co. v. Patterson*, 1889, 6 P. O. R. 140.

(h) *Cp. Hindmarch*, p. 304. "It is difficult to say what construction will be put upon this statute, but there can be little doubt that it will be construed

liberally, and that a plaintiff will under these statutes be allowed the amount of his costs, taxed as between attorney and client."

(i) *Badiache Anilin, &c. v. Levinstein*, 1886, 29 Ch. D. 366, per Bowen, L. J., at p. 419.

(k) *Bovill v. Goodier*, Griffin, A. P. C. 49.

Costs of motion for new trial not included in rule.

(4.) Under sect. 43 of the Act of 1852, it was necessary that the certificate of validity should be given by "the judge before whom the trial was heard" (l).

In the case of *Cropper v. Smith* (m), the plaintiffs, in an action for the infringement of their patent, had obtained a decree from Pearson, J., at the trial. On appeal, the Court of Appeal and the House of Lords overruled this decision. The defendants applied to Pearson, J., for a certificate that they had proved their particulars of objections. Counsel differing as to the certificate to be granted, his lordship desired that the matter might be mentioned to the Court of Appeal. On its being so mentioned, the Court of Appeal communicated with Mr. Justice Pearson, who then gave a certificate as required.

(5.) Notwithstanding that the 43rd section of the Act of 1852 provided that a certificate of validity should entitle a plaintiff to full costs as between solicitor and client, unless the judge deprived him of them, it was necessary that the decree or order should contain an express direction to the taxing master that the costs be so taxed (n).

(o) *Under Act of 1883.*

Under the 31st section of the present Act, a certificate of validity may be granted by the Court (i. e., by the High Court of Justice (o) or the Court of Appeal (p)) or a judge, i. e., may be given in chambers (q). Act of 1883.

Neither the Vice-Chancellor of the County Palatine of Lancaster nor the Court of Appeal sitting on appeal from him, is within the meaning of the words "Court or a judge" in this section (r). Vice-Chancellor of Lancaster not within rule.

Sect. 31 of the present Act provides that, in an action for infringement of a patent, the Court or a judge may certify (s) 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 Provisions of Act of 1883.

(l) And see *Otto v. Linford*, 1880, 46 L. T. N. S. 35.

(m) 1885, 1 P. O. R. 61.

(n) *Lister v. Leather*, 1858, 4 K. & J. 425.

(o) Op. sect. 117, sub-s. (1).

(p) R. S. C. 1883, Ord. LVIII. r. 4; *Cole v. Saqui*, 1889, 6 P. O. R. 41.

(q) Jud. Act, 1873, s. 59.

(r) *Proctor v. Sutton Lodge Chemical Co.*, 1888, 5 P. O. R. per Day, J., at p. 185.

(s) A certificate under this section is not a judgment, decree, or order, within the meaning of the Jud. Act, 1873, s. 19, and is not therefore appealable; *Haslam Co. v. Hall*, 1888, 5 P. O. R. 144.

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.

Cases.

The decisions under this section may be very briefly summarized.

Solicitor and client costs.

In *United Telephone Co. v. Patterson* (t), an action for infringement of two patents, the plaintiffs claimed the usual injunction and damages. In his defence the defendant did not question the validity of the patents, and denied the infringement, but paid 75% into Court in the alternative. At the hearing the application for granting an injunction was not resisted by the defendant, and the enquiry as to damages was referred to Chambers. The plaintiffs having proved the certificate of validity of the patents being questioned in previous actions, under sect. 43 of Patent Act, 1852, and sect. 31 of Patent Act, 1883, the defendant applied to the judge to certify that the plaintiffs ought not to have costs as between solicitor and client, on the ground that the plaintiffs' patent had not been disputed, and their claim to relief not seriously contested by the defendant. It was held that the plaintiffs were entitled to costs of the action as between solicitor and client, those of the reference as to damages being reserved, and that the fact that the defendant had not disputed the validity of the patent, and had, by paying money into Court, so far admitted his liability, afforded no ground for granting defendant a certificate depriving plaintiffs of costs as between solicitor and client.

An action commenced before a certificate is given that the validity of a patent has come in question, is not a subsequent action so as to entitle a successful plaintiff to solicitor and client costs (u).

Uncontested action.

It is doubtful whether a certificate of validity can be granted in an uncontested action. Kay, J., refused to certify in *Peroni v. Hudson* (x), where the defendant did not appear at the trial; but in a similar case, *Haydock v. Bradbury* (y), Kekewich, J., granted

(t) 1889, 6 P. O. R. 140.

(u) *Automatic Weighing Co. v. International Hygienic Society*, 1889, 6 P. O. R. 480. *Semble*, solicitor and client costs will not be given in a subsequent action for infringement, if the only question raised in that action is infringement: *Automatic Machine Co. v. The International Hygienic Society*, *ubi supra*. Solicitor and client costs were not given

on a breach of an injunction where what was done by the defendants was not done vexatiously or improperly, but in the probable though erroneous belief that they were entitled so to do: *Spencer v. Ancoats Vale Rubber Co.*, 1889, 6 P. O. R. 46.

(x) 1884, 1 P. O. R. at p. 263.

(y) 1887, 4 P. O. R. at p. 75.

the usual certificate, notwithstanding the defendant's absence. "If a defendant," said his lordship, "by non-appearance at the trial, could deprive a successful plaintiff of the right which you are now claiming for him, he might be put to the trouble of proving it all over again."

Where a certificate of validity has been granted in a previous action, it need not be again granted. To do so would be to throw doubt on the sufficiency of the former certificate (s).

Equal doubt exists upon the point whether an action for threats is "an action for infringement of a patent" within the meaning of sect. 31. In *Kurts v. Spence* (a), Mr. Justice Kekewich held that it was not. In *Crampton v. The Patents Investment Co.* (b), Mr. Justice Field granted a certificate without prejudice to its validity if it came into operation. His lordship expressed great doubt, however, whether he had jurisdiction to grant it.

Action for threats.

This section, like sect. 43 of the Act of 1852 (c), applies only to a second action for infringement.

In *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.* (d), where the second action was in the paper for trial at the same time as the first action, it was held that a certificate given in the first action did not make the defendant in the second action, although he raised the question of the validity of the patent, liable to solicitor and client costs.

Only applies to second action.

When the validity of a patent is impeached in a second action on grounds different from the grounds of its impeachment in the first action, the costs as between solicitor and client will not be allowed. A second certificate of validity may be granted with reference to the extent to which the validity of the patent came in question in the second action (e).

Validity impeached on new grounds.

In *Haslam Co. v. Hall* (f), where the patent was held to be invalid, Stephen, J., granted a certificate that the validity had come in question, but refused to certify anything further.

A certificate of validity may probably be granted, although the plaintiff fail on the issue of infringement (g).

(s) *Edison Co. v. Holland*, 1889, 6 P. O. R. 287.

650; 17 C. B. N. S. 435.

(a) 1888, 5 P. O. R. at p. 184.

(e) *Otto v. Steel*, 1886, 3 P. O. R. at p. 120.

(b) 1888, *Ibid.* at p. 404.

(f) 1888, 5 P. O. R. at p. 27.

(c) *Penn v. Bibby*, 1866, L. R. 3 Eq. 308.

(g) *Automatic Weighing Machine Co. v. Knight*, 1889, 6 P. O. R. 113, 120, 125.

(d) 1889, 6 P. O. R. 120. And see *Dovill v. Hadley*, 1864, 10 L. T. N. S.

Discretion of judge in refusing full costs same as before Act of 1883.

Action vexatious.

The law as to the discretion of the judge in refusing full costs where there has been a certificate of validity, has not been altered by the Act of 1883.

Where defendants did not question the validity of the plaintiff's patent, admitted that they had used it many years ago, but explained that they had not since used, and did not intend to use it, and where the damage, if any, had been very trifling, the Court considered the action very vexatious, and deprived the plaintiff of full costs (*h*).

Full costs where validity not disputed a second time.

In *United Telephone Co. v. St. George* (*i*), where the issue of infringement had been seriously contested, costs as between solicitor and client were allowed against an unsuccessful defendant although he had not disputed the validity of the plaintiff's patent.

(3.) Certificate as to Particulars.

(a) Under Act of 1835.

Costs of separate issues.

The General Rules of Hilary Term (2 Will. IV.) provided, by sect. 74, that no costs should be allowed on taxation to a plaintiff upon any counts or issues upon which he had not succeeded; and the costs of all issues found for the defendant were to be deducted from the plaintiff's costs.

Under Act of 1835, costs on objections and counts.

The statute 5 & 6 Will. IV. c. 83, s. 6, provided that in taxing costs regard should be had to the part of the case proved and certified by the judge, and that "the costs of each part of the case should be given according as either party had succeeded or failed therein, regard being had to the notice of objections as well as the counts in the declaration, and *without regard to the general result of the trial.*"

In the case of *Losh v. Hague* (*k*), the effect of the two provisions last cited upon each other was considered. In that case, four issues were raised by the pleadings, and the defendant gave notice of seven objections to the patent. At the trial the defendant succeeded in establishing one of his objections which fell under the third issue, but the plaintiff had a verdict upon the other three issues. The issue upon which the defendant succeeded was a bar

(*h*) *Proctor v. Sutton Lodge Chemical Co.*, 1888, 5 P. O. R. 184.

(*i*) 1886, 3 P. O. R. at p. 339.
(*k*) 1859, 5 M. & W. 387.

to the whole action. In taxing costs the master allowed the defendant *the general costs* of the cause, as well as those on the third issue from which he deducted the plaintiff's costs of the three issues upon which he had succeeded. It was contended by the plaintiff that sect. 74 of the General Rules was repealed by 5 & 6 Will. IV. c. 83, s. 6, and that therefore he was entitled to three-fourths of the general costs of the cause. But the Court of Exchequer held that the statute had not the operation contended for, and that the master's ruling was right.

(b) *Under Act of 1852.*

By the Act of 1852, s. 43, it was (*inter alia*) provided that, in taxing the costs in any action, regard shall be had to the particulars delivered in such action, and the plaintiff and defendant respectively shall not be allowed any costs in respect of any particular unless certified by the judge before whom the trial was had to have been proved by such plaintiff or defendant respectively, without regard to the general costs of the cause.

Under this section it was decided that—

The certificate of the judge who tried the cause that the defendant had proved his particulars of objections, was a condition precedent to his right on taxation to any costs in respect of such particulars, even in the case of a nonsuit (*l*).

“With respect to the costs of the issues,” said Pollock, C. B., in *Honiball v. Bloomer*, the case from which the above statement is taken, “there is no doubt that where the plaintiff is non-suited, the defendant is entitled to all the costs of the issues, that is to say, of the pleadings and evidence necessary to support them. But as the particulars are the creatures of this statute, and the costs of this particular class of proceedings are declared by the legislature to be no part of the general costs of the cause, and that, in the absence of a certificate, they shall not be recoverable, they are not recoverable.”

Honiball v. Bloomer was considered in *Batley v. Kynock* (*m*), where, after the trial of issues had been fixed, the plaintiff obtained the common order at the Rolls, dismissing his own bill with costs. Among the items in the defendant's bill of costs were charges for drawing particulars of objections, and having the same settled by

(*l*) *Honiball v. Bloomer*, 1854, 24 L. J. R. 4; 2 P. O. R. 139.
Ex. 11; 10 Exch. 538; *Parnell v. Mort*, (m) 1874-75, 20 Eq. 636.
1884-85, L. R. 20 Ch. D. 325; 1 P. O.

counsel, the expenses of scientific witnesses and the price of a model, all of which the taxing master had substantially allowed. Bacon, V.-C., in confirming this decision, said: "Here the state of circumstances contemplated by the statute never did and never could arise. The case referred to at common law (*Honiball v. Bloomer*, 10 Ex. 538) has no application to the present."

Sect. 43, however, applied only to cases where there had been a trial; where there had been no trial the law stood as it did before. Thus, in *Greaves v. Eastern Counties Rail. Co.* (n), an action for the infringement of a patent, notice of trial was given and countermanded, whereupon the defendants signed judgment. It was held by the Court of Queen's Bench that the defendants were clearly entitled, under the Statute of Gloucester, to the costs of preparing, and the evidence in support of their particulars. This case is distinguishable from *Curtis v. Platt* (o). There the defendant had obtained further time to plead on the terms that the cause should be put down for trial before issue joined, and that short notice of trial should be taken. The pleas were delivered, and the plaintiff had a special jury nominated but not struck. The action was then discontinued before issue was joined or notice of trial was given. It was held that the circumstances of the case did not authorize a departure from the general rule that costs incurred before notice of trial should not be allowed.

(o) *Under the Act of 1883.*

Sect. 29, sub-sect. 6 of the Patents Act, 1883, provides that on taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant, and that 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.

This section differs in effect from the Act of 1852, s. 43, in the addition of the words "or to have been reasonable and proper."

It has already been pointed out that "Court or a judge" means a judge of the High Court, whether sitting in Court or chambers, and includes the Court of Appeal; and that it does not include the Vice-Chancellor of the County Palatine of Lancaster (p).

(n) 1869, 28 L. J. Q. B. 290; 1 E. & E. 961.

(o) 1864, 10 Jur. N. S. 823.
(p) See p. 333 and notes.

In *Griffin v. Feaver* (q), G. brought an action for infringement of a patent for improvements in metallic boxes or receptacles for holding alimentary and other substances. By his defence, the defendant alleged that the patent was invalid on a number of different grounds, including anticipation. At the trial the plaintiff's first witness, in cross-examination, was unable to distinguish the alleged invention from a previous specification, and the action was dismissed on the ground of that prior publication. The defendant was allowed the costs of all particulars of objections involved in that decision.

Costs of particulars when defendant not called on.

In *Germ Milling Co. v. Robinson* (r), the plaintiffs, in an action for infringement, failing on the ground of the invalidity of their patent being established by one of their own witnesses, judgment was given for the defendants without their being called upon to go into their defence. The defendants applied for a certificate that their particulars of objections were reasonable and proper, and the plaintiffs applied for a certificate that they had proved their particulars of breaches. It was held, that the judge must decide which of the particulars of breaches were reasonable and proper in regard to the case so far as it had gone, that a certificate would be granted in respect of those particulars only which the judge specifically mentioned; and also, that as the plaintiffs were not entitled to any costs they were not entitled to any certificate.

The Court of Appeal will give a certificate of particulars of objections, where it reverses the judgment of the Court below by which the patent was found valid (s).

Practice of Court of Appeal.

Where the Court of Appeal is able to dispose of an action on one point, viz., that there is no infringement, it will not hear the case further to decide if the objections were reasonable (t).

It still remains to consider very briefly two points of practice under the present law.

(4.) *Apportionment of Costs of Issues.*

Where issues of fact and law are raised upon a claim or counter-claim, the costs of the several issues, both in law and fact, shall,

Costs of issues.

(q) 1889, 6 P. O. R. 396; cp. *Slazenger v. Feltham*, *ibid.* 130.

(r) 1886, 3 P. O. R. 254; cp. *Rothwell v. King*, 1887, 4 P. O. R. 397; *Albion Carbon Light Co. v. Kidd*, *ib.* 539; *Longbottom v. Shaw*, 1888, 5 P. O. R. 497, and 1889, 6 P. O. R. 147; L. R. 43 Ch.

D. 46; *Oddy v. Smith*, 1888, 5 P. O. R. 503; *Cole v. Saqui*, 1888, 5 P. O. R. 489; *Boyd v. Horrocks*, 1889, 6 P. O. R. 152, 162.

(s) *Cole v. Saqui*, 1889, 6 P. O. R. 41.
(t) *Boyd v. Horrocks*, 1889, 6 P. O. R. 162; *Longbottom v. Shaw*, 1889, *ib.* 143.

General
principles,
Bowen, L. J.

unless otherwise ordered, follow the event (*n*). The general principle on which the Court acts in applying this rule to the costs occasioned by issues raised in actions of infringement, was thus stated by Bowen, L. J., in *Badische Anilin, &c. v. Levinstein* (*o*): "It seems to me that, without laying down any hard-and-fast line, or trying to fetter our discretion at a future period in any other case, we are acting on a sensible and sound principle, namely, the principle that parties ought not, even if right in the action, to add to the expenses of an action by fighting issues in which they are in the wrong. It may be very reasonable as regards their own interest, and may help them in the conduct of the action, that they should raise issues in which, in the end, they are defeated; but the defendant who does so does it in his own interest, and I think he ought to do it at his own expense."

The principle of apportionment, thus defined, has accordingly been applied not only where a plaintiff had established the validity of his patent without proving infringement (*p*), but also where a defendant, while failing on the issue of infringement, had succeeded on that of validity (*q*).

The Court has, however, refused to allow the costs of an issue which were trifling and were not materially different from the costs of the cause (*r*).

In *Sugg v. Bray* (*s*), where it appeared that if the costs were apportioned the defendant would have to pay, in respect of issues on which he had failed, at least as much as he would be entitled to receive from the general costs of the cause, the Court, to avoid a very troublesome and difficult apportionment of costs on taxation, cut the knot by giving no costs to either party.

In *Moore v. Bennett* (*t*), the Court of Appeal had held the plaintiff's patent bad on account of insufficiency in the specification, and also that there had been no infringement. The House of Lords

(*n*) R. S. C. 1883, Ord. LXV. r. 2.

(*o*) 1885, 29 Ch. D. at p. 419.

(*p*) *Simmonds v. Hitchman*, 1881, Lawson, 174; 29 Ch. D. 417, n. (4); *Needham v. Johnson*, 1884, 1 P. O. R. 49, 59; *Nordenfelt v. Gardner*, 1884, *Ibid.* 61; *Westinghouse v. Lancashire and Yorkshire Rail. Co.*, 1884, *Ibid.* 229, 253.

(*q*) *Wegmann v. Corcoran*, 1878-79, 27 W. R. 357, 362; *United Telephone Co. v. Harrison*, 1882-83, 21 Ch. D. 747; *Hocking v. Fraser*, 1886, 3 P. O. R. 7; *Edison, &c. Co. v. Woodhouse*, 1886, *Ibid.* 167; *Young v. Rosenthal*, 1884, 1 P. O. R.

29, 41; Cp. *Pooley v. Pointon*, 1885, 2 P. O. R. 167; *Lawrie v. Baker*, 1885, *Ibid.* 213; *Lawrence v. Perry*, 1885, 2 P. O. R. 179; *Lister v. Norton*, 1886, 3 P. O. R. 199, 211; *Badham v. Bird*, 1888, 5 P. O. R. 238.

(*r*) *Keys v. Chubb*, 1887, 4 P. O. R. 300, 302; Cp. *Edison, &c. Co. v. Holland*, 1888, 5 P. O. R. 483; *Blakey v. Latham*, 1889, 6 P. O. R. 38, 186, 190.

(*s*) 1885, 2 P. O. R. at p. 248, *per* North, J.

(*t*) 1884, 1 P. O. R. at p. 148.

adjudged the patent to be valid, but confirmed the decision of the Court below on the question of infringement. The appeal was therefore dismissed, but, as it had resulted in a material and important advantage to the plaintiff, without costs.

In *Boyd v. Horrocks* (u), an action in the Palatine Court for the infringement of a patent, the defendants unsuccessfully raised numerous issues, including that of infringement. Judgment was given for the plaintiff with costs, and a certificate was granted that his particulars of breaches had been proved, and were reasonable. The plaintiff's taxed costs were, by consent, paid into Court by the defendants pending an appeal to the Court of Appeal. On the hearing of the appeal, the Court, without going into any other question, decided the issue of infringement in favour of the defendants, and dismissed the action with costs. The defendants applied for repayment of the costs paid by them into Court. It was held that the plaintiff was not entitled to an apportioned part of these costs, attributable to the points other than infringement, on which he had succeeded at the trial, and that the costs must be paid out of Court without waiting for the result of an appeal to the House of Lords. Though it is right for the Court, if, after hearing the evidence it comes to the conclusion that issues were unnecessarily raised, to apportion the costs of those issues, nevertheless the Court will not apportion the costs of issues which have never been heard owing to the Court deciding that the patent is bad at the outset of the case (x).

(5.) *Costs on the Higher Scale.*

It is provided by the Supreme Court Rules that costs on the "higher scale" may be allowed, either generally in any cause or matter, or as to the costs of any particular application made, or business done, in any cause or matter, if, on special grounds arising out of the nature and importance, or the difficulty or urgency of the case, the Court or a judge shall, at the trial or hearing, or further consideration of the cause or matter, or at the hearing of any application therein, whether the cause or matter shall or shall not be brought to trial, or hearing, or to further consideration (as

Costs may be allowed on the higher scale on special grounds.

(u) 1889, 6 P. O. R. 528.

(x) *Blakey v. Latham*, 1889, 6 P. O. R. 190. In this case a motion to adduce further evidence was ultimately not heard, as the patent was held not to be good subject-matter. The Court will

not hear it either for the purpose of costs or of vindicating character. The motion, standing over at the risk of the persons who made it, was therefore dismissed with costs.

the case may be), so order; or if the taxing officer, under directions given to him for that purpose by the Court or a judge, shall think that such allowance ought to be so made upon such special grounds as aforesaid (u).

Where the action was of a complicated nature, the Court considering that special industry and learning and much time and expense had been employed in preparing it for trial, directed the taxing master to allow all or any part of the plaintiff's costs on the higher scale, if he thought fit, on the ground of the "nature" or "difficulty" of the case (x).

Costs of action for injunction not allowed on higher scale on ground that defendant submitted to an injunction (y); nor merely on the ground that important questions were raised (z).

Costs on the higher scale should be allowed in patent cases where scientific witnesses are necessarily called (a).

In considering whether the costs of a cause shall be on the higher scale, the Court will have regard to the importance of the questions in issue in the action, and also to the manner in which the case has been prepared and conducted at the trial (b).

It seems that, although a case, as presented to the Court, may not be of a special "difficulty" within the meaning of this rule, leave may be given to the taxing master to tax all or any part of the costs on the higher scale, if it appears on such taxation that the difficulty was removed by the expenditure of time, money, and learned industry (c).

Where the action was one requiring special knowledge on the part of those concerned in it, costs on the higher scale were allowed (d).

In *Automatic Weighing Co. v. Knight* (e), an appeal was dismissed with costs, and the defendants subsequently applied for costs on the higher scale. Held, that the application should be granted, but without costs, as it should have been made at the hearing of the appeal.

This rule applies to patent actions (f). In cases involving long

(u) R. S. O. Ord. LXV. r. 9.

(x) *Fraser v. Brescia Steam Tramways Co.*, 1887, 56 L. T. 771; 3 Times Rep. 687.

(y) *Hudson v. Ogerby*, 1884, W. N. 83; 82 W. R. 566.

(z) *Grafton v. Watson*, 1884, 51 L. T. 141. See also *Cardiff Steamship Co. v. Barwick*, 1885, 53 L. T. 56.

(a) *Ellington v. Clark*, 1889, 58 L. T. 818.

(b) *Davies v. Davies*, 1887, 56 L. J. Ch.

481.

(c) *Fraser v. Brescia Tramways Co.*, 1887, 56 L. T. 771.

(d) *Moseley v. Victoria Rubber Co.*, 1887, 57 L. T. 142, 148; 4 P. O. R. 241. See, too, *Farrar v. Farrar*, 59 L. T. 619.

(e) 1889, 6 P. O. R. 310, 372.

(f) *Westinghouse v. Lancashire and Yorkshire Rail. Co.*, 1884, 1 P. O. R. 108; *Easterbrook v. G. W. Rail. Co.*, 1885, 2 P. O. R. 212; *Walling v. Stevens*,

examinations, preparation of models, and the calling of expert evidence, costs on the higher scale have been allowed against the unsuccessful litigants (*g*). The fact, however, that a defendant submits to an injunction is not a "special ground" within the meaning of Ord. LXV. r. 9 (*h*).

In *Peroni v. Hudson* (*h*), where the defendant did not appear at the trial, costs on the higher scale were refused to the plaintiff.

SECT. 16.—STAY OF EXECUTION.

Under the Rules of the Supreme Court, 1883. Ord. LVIII. r. 16, proceedings will not be stayed pending an appeal, except in so far as the Court appealed from, or any judge thereof, or the Court of Appeal, may order.

No general rules can be laid down as to the circumstances under which the Court will exercise its discretion. Rules as to stay of execution.

Each case will be judged on its own merits.

The following points have, however, been decided, and it may be useful to note them.

Where judgment is given for a defendant with costs, execution will not be stayed, upon the defendant's solicitors giving their personal undertaking to repay any costs received by them, if the judgment should ultimately be reversed with costs (*i*).

An order for the delivery up of infringing machines has been suspended on the defendant undertaking that neither they nor any articles made by them should be removed out of or used in this country pending an appeal (*k*).

Where a defendant moved for a stay of proceedings pending an appeal to the House of Lords, and it appeared that, as the defendant

1888, 3 P. O. R. 43; *Otto v. Steel*, 1886, *Ibid.* 120; *Moseley v. Victoria Rubber Co.*, 1887, 4 P. O. R. 251; *Kays v. Chubb*, 1887, *Ibid.* 289; *Kurtz v. Spence*, 1888, 5 P. O. R. 161—an action under sect. 32. In *Grafton v. Watson* (51 L. T. N. S. 143) costs on appeal against an interlocutory injunction were allowed only on the lower scale, although an important question was raised.

(*g*) *Wenham v. May*, 1888, 5 P. O. R. 310; *Ellington v. Clark*, 1888, 5 P. O. R. 161. Here costs on the higher scale were allowed by the Court of Appeal, although refused by the judge in the Court below. In *Crampton v. The Patents*

Investment Co., 1888, 5 P. O. R. 404, the judge at the trial refused to allow the costs on the higher scale at that stage, but reserved the question until after taxation, and gave liberty to apply thereafter if the defendants could show that they had suffered any injustice by the costs being taxed on the lower scale.

(*h*) *Peroni v. Hudson*, 1884, 1 P. O. R. 261.

(*i*) *Easterbrook v. G. W. Rail. Co.*, 1885, 2 P. O. R. 212; *Merry v. Nickalls*, 1873, 8 Ch. 205; *Morgan v. Elgood*, 1876, 4 Ch. D. 287.

(*k*) *Washburn and Moen Manufacturing Co. v. Patterson*, 1884, 1 P. O. R. 191.

was no longer making the infringing machines, the sole object was to prevent persons from being deterred by the judgment from buying them, the motion was refused (*l*).

The operation of an injunction (*m*) and [or (*n*)] of an order for an account (*o*) has been suspended on the defendant undertaking to keep an account, and to appeal promptly, the plaintiff having liberty to apply if the appeal was not promptly prosecuted (*p*).

SECT. 17.—APPEALS.

Appeals, how brought.

The old law as to appeals in patent actions is of such moderate proportions that it can most clearly be stated in treating, as we now propose very briefly to treat, of the present practice. All appeals to the Court of Appeal are to be by way of rehearing, and are to be brought by notice of motion in a summary way (*q*).

It is not, under any circumstances, necessary for a respondent to give notice of motion for a cross appeal, unless he proposes to contend, on the hearing of the appeal, that the decision of the Court below should be varied, in which case he should give notice to any parties affected by such contention (*r*).

Bankrupt appellants.

A novel point, as to the position of bankrupt appellants, was raised and decided in *United Telephone Co. v. Bassano* (*s*). Judgment had been given restraining the defendants from the manufacture or sale of articles of a certain construction as being an infringement of the plaintiff's patent, and ordering delivery up of all instruments so constructed. The defendants appealed, but before the appeal was ready for hearing became bankrupt. It was held that the defendants, though bankrupt, had still such an interest in being relieved from the injunction as entitled them to proceed with the appeal on giving security for costs. An order was accordingly made dismissing the appeal, unless within a certain time the bankrupts gave security for costs, or the trustee in bankruptcy made himself a party to the proceedings.

(*l*) *Proctor v. Bennis*, 1887, 4 P. O. R. 363; cp. *Adair v. Young*, 1879, 11 Ch. D. 136; *Nordenfelt v. Gardner*, 1884, 1 P. O. R. 63; *Otto v. Steel*, 1886, 3 P. O. R. 109, 121.

(*m*) *Hocking v. Fraser*, 1886, 3 P. O. R. 7.

(*n*) *Woodward v. Sansum*, 1886, 3 P. O. R. 366; *Humpherson v. Syer*, 1887, 4 P. O. R. 184.

(*o*) *Kaye v. Chubb*, 1887, 4 P. O. R. 23.

(*p*) *S. C.*

(*q*) In *Siddell v. Vickers*, 1888, 5 P. O. R. 416, 436, Cotton, L. J., intimated that cases before the law officers should not be cited before the High Court or the Court of Appeal. R. S. C. 1883, Ord. LVIII r. 1. For some of the grounds of motion for a new trial, see *King v. Oliver*, 1884, 1 P. O. R. 32, 44.

(*r*) *Ibid.* r. 6.

(*s*) 1886, 31 Ch. D. 630.

Some years ago the practice was to dismiss an appeal at once where a reasonable time for giving security, allowed under Ord. LVIII. r. 15, had been exceeded without security being given. The more recent practice was to allow the appellant a further limited time within which to give security, and to order that if he did not give it within that time the appeal should be dismissed without further application to the Court. It was found, however, that the latter rule encouraged appellants to wait until an application to dismiss the appeal was made. Accordingly, in the case of *Washburn and Manufacturing Co. v. Patterson* (t), the Court of Appeal reverted to the old practice of making an immediate order for the dismissal of an appeal when security had not been found within a reasonable time and there were no extenuating circumstances. Their lordships intimated that an unexplained delay of three months would be sufficient.

“If upon the hearing of an appeal it shall appear to the Court of Appeal that a new trial ought to be had, it shall be lawful for the Court of Appeal, if it shall think fit, to order that the verdict and judgment shall be set aside and that a new trial shall be had” (u).

The Court is also invested with the widest powers of varying, in whole or in part, any judgment appealed against, and of making any order that the case may require (x).

The Court of Appeal has full discretionary power to receive further evidence upon questions of fact; but upon appeals from a judgment after trial or hearing of any cause or matter upon the merits, such further evidence, save as to matters subsequent as aforesaid, shall be admitted on special grounds only, and not without special leave of the Court (y). The term “special grounds” was judicially considered in *Hinde v. Osborne* (z). “I cannot,” said Lindley, L. J., in that case, “understand that as meaning that the Court of Appeal ought to grant leave to adduce fresh evidence simply because a man has failed at the trial and he thinks he can get more evidence which, if he had got it before, would have enabled him to succeed on the trial There must be some ground shown to satisfy the Court that there is some evidence now forthcoming which with due diligence he could not have got, and it must, moreover, in accordance with the usual

Further evidence on appeal.

(t) 1885, 29 Ch. D. 48. Cp. *Parker v. Maignen's Filtre Rapide Co.*, 5 P. O. R. 207; *Edison Telephone Co. v. India Rubber Co.*, 1881, L. R. 17 Ch. D. 137.

(u) R. S. C. 1883, Ord. LVIII. r. 5.

(x) *Ibid.* r. 4.

(y) *Ibid.* Cp. *Edison Co. v. Shippey*, 1887, 4 P. O. R. 471.

(z) 1885, 2 P. O. R. 47.

Further
evidence.

practice, be evidence—not merely swearing by affidavits, or anything of that kind, but something in the nature of the production of a lost document or something of that sort—which will not expose the parties to a mere flood of affidavits made up to meet the blots and the defects which have been disclosed upon the first trial.”

Illustrations.—(1.) The defendant in an action for infringement went to trial on a defence of non-infringement simply: he had previously pleaded want of novelty in the patent, but withdrew the plea. The plaintiff obtained an injunction, and the defendant appealed. The defendant subsequently moved for leave to adduce fresh evidence on the hearing of the appeal as to some anticipation of the plaintiff's patent, which he alleged that he had discovered since the trial. The motion was refused on the ground that it did not appear that the defendant was unable to get sufficient information to support the plea of want of novelty which he had abandoned at the trial (e).

(2.) W., a petitioner for revocation of letters patent, applied for leave to adduce further evidence of anticipation on the hearing of an appeal. It appeared that the plaintiff had been examined *de bene esse* before the trial, and that the alleged anticipation had been put to him in cross-examination. The motion was therefore refused (f).

In *Nordenfelt v. Gardner* (g), Lindley, L. J., intimated that the Court of Appeal would allow a merely formal defect of title, such as the non-production of a link in a chain of assignments, to be cured under their general powers to amend and admit further evidence (h).

In *Blakey v. Latham* (i), an appellant moved for leave to adduce further evidence on the appeal, on the ground that two of the witnesses who had given evidence at the trial as to an alleged anticipation had subsequently made statements, some on oath and others not, which tended to show that their evidence in the Court below was untrue in material respects, and on the further ground that the plaintiff had, since the trial, discovered further evidence with regard to such alleged anticipation which he could not with due

(e) *Hinde v. Osborne*, 1885, 2 P. O. R. 47.

(f) *Walker v. Hydro-Carbon Syndicate*, 1886, 3 P. O. R. 253.

(g) 1884, 1 P. O. R. at p. 73.

(h) R. S. C. 1883, Ord. LVIII. r. 4.

(i) 1889, 6 P. O. R. 186. A motion for sequestration and attachment for

breach of an injunction contained in a consent judgment in an action for infringement of a patent is an interlocutory application within rule 4 of R. S. C. 1883, Ord. LVIII., and further evidence can be admitted on appeal: *Spencer v. Ancoats Vale Rubber Co.*, 1889, 6 P. O. R. 46.

diligence have discovered before. The Court of Appeal gave liberty to the plaintiff to subpoena such witnesses with reference to the alleged anticipation, as he should name to the respondent ten days before the appeal was first in the paper for hearing, with liberty to the respondent to subpoena such witnesses as he might desire, and give the names to the plaintiff within five days before the appeal, and the Court ordered the rest of the motion to stand over until the hearing of the appeal.

In *Slasenger v. Feltham* (*k*), an action for infringement of a patent, it was held that where a judge of co-ordinate jurisdiction had decided two years before the present action that the patent was useful, novel, and good subject-matter, and had not been anticipated, the only question that could then be raised was the question of anticipation by fresh instances. Effect of previous judgment.

In *Edison Co. v. Holland* (*l*), it was held that a previous decision of the Court of Appeal on the same patent must be followed so far as it construed the patent, but that whether the claim was too wide or proper subject-matter, and whether the invention was novel and useful, were questions depending partly on fact and must be decided *de novo*.

Where a patent was held valid in a previous action, the same judge in a subsequent action would not allow the same objections of anticipation and want of subject-matter to be again raised, and refused to admit evidence on those points (*m*).

(*k*) 1889, 6 P. O. R. 130.

(*l*) 1889, 6 P. O. R. 243. Cp. *Automatic Weighing Machine Co. v. Combined*

Weighing Machine Co., *ibid.* 367.

(*m*) *S. C.* p. 120, *ubi supra*.

CHAPTER XV.

ACTION TO RESTRAIN THREATS.

SECT. 1. PRIOR TO ACT OF 1883.

SECT. 2. UNDER ACT OF 1883.

SECT. 1.—PRIOR TO ACT OF 1883.

Origin of
action to re-
strain threats.

At least as early as the year 1869 (a), it had been recognized that damages might be recovered, and an injunction granted, against a person who issued threatening notices of legal proceedings in order to deter others from purchasing alleged infringements of his patent, and the existence of this remedy had never subsequently been questioned.

Judicial opinion, however, had been divided as to one of the *facta probanda* in such proceedings.

Want of *bona fides* material.

In *Wren v. Weild* (a), it was held by the Court of Queen's Bench that an action would not lie unless the plaintiff affirmatively proved that the defendant's claim was not a *bona fide* claim in support of a right which, with or without cause, he fancied he had, but a *mala fide* and malicious attempt to injure the plaintiff by asserting a claim of right, against his own knowledge, that it was without any foundation. Want of *bona fides* or the presence of *mala fides* was therefore a material fact to be alleged and proved. This view of the law had the subsequent assent, first of Jessel, M. R., and then of the Court of Appeal, in the case of *Halsey v. Brotherhood* (b). So far the Courts were unanimous.

Patentee,
whether
bound to

In the cases of *Rollins v. Hinks* (c) and *Armann v. Lund* (d), however, Malins, V.-C., held that a patentee is not entitled to publish

(a) *Wren v. Weild*, L. R. 4 Q. B. 730, 737.

(b) 1880, 1881, L. R. 15 Ch. D. 514; 19 Ch. D. 386. Cp. *Sugg v. Bray*, an action brought before but tried under

the Patents Acts, 1883—1885, 1 P. O. R. 45; 2 P. O. R. 224.

(c) 1872, L. R. 13 Eq. 355.

(d) 1874, L. R. 18 Eq. 330.

statements of his intention to institute legal proceedings, if he has no *bond fide* intention to follow up his threats by taking such proceedings, and that the Court will in such case restrain him from making such publication. follow up threats.

In *Halsey v. Brotherhood (e)*, Jessel, M. R., rejected this statement of the law. "A man," said his lordship, "merely giving notice that his rights are being infringed, believing that they are infringed, is not to be subjected to an action for giving that notice . . . even although he does not follow up that notice by bringing an action at law for the infringement."

In the same case it was held that if the plaintiff wanted an injunction he must make out that the defendant intended to persevere in making the representations complained of, although his allegation of infringement by the plaintiff was untrue. Evidence necessary if injunction claimed.

Prior to the Act of 1883, it appears, therefore, that the law as to threatening notices may be stated thus. Two remedies—damages and an injunction—were competent to any person injuriously affected by the threat of legal proceedings. To secure the former, the plaintiff was required to prove that the statements complained of were injurious to him, untrue, and made *malâ fide*. Failure on the part of a defendant to follow up his threats by raising an action for infringement did not make him liable to an action for damages. To entitle him to an injunction the plaintiff was required to prove not only that the representations complained of were untrue, but that the defendant intended continuing to make them. Summary of law prior to 1883.

SECT. 2.—UNDER ACT OF 1883.

Sect. 32 of the Act of 1883, provides that—"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 Patents Act, 1883, s. 32.

(e) *Ubi supra.*

section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent."

Alterations
introduced by
Act of 1883.

This section has altered the earlier law in several respects, which may be briefly noted before we consider its provisions in detail.

1. The *bona fides* of the patentee threatening legal proceedings or liability is immaterial if (a) the acts of the plaintiff are not in fact an infringement of his patent right; and (b) he fails with due diligence to commence and prosecute an action for infringement.

2. The doctrine laid down in *Rollins v. Hinks* (*f*), and *Azmann v. Lund* (*g*), but dissented from in *Halsey v. Brotherhood* (*h*), that a person giving notice that his rights are being infringed is liable to an action for damages if he does not follow up that notice by bringing an action for infringement, has now received legislative sanction.

The section may be logically considered under the following heads:—

The threat of
legal proceed-
ings.

(1) *The threat of legal proceedings*, "which is the subject-matter of the action, must not be merely a warning about something which is going to be done, but must be a threat about an act done. It must be a threat of legal proceedings or liability in respect of an alleged manufacture, use, sale, or purchase of the invention." Threats do not fall within this definition if they are mere threats or warnings as to something which may be done in the future. "Everybody has still a right to issue a general warning to pirates not to pirate, and to infringers not to infringe, and to warn the public that the patent to which the patentee is entitled and under which he claims is one that he intends to enforce. . . . It does not follow that because a threat is so worded as in mere language apparently and grammatically to apply only to the future that therefore it may not be in any particular case in substance and in fact applicable to what has been done. Supposing for a moment that a manufacturer is making and issuing machines which the patentee considers to be an infringement of his patent; if with reference to that act done, or to those machines made, the patentee endeavours to guard himself against this section by merely issuing a threat in the air . . . he would not escape if the

(*f*) 1872, L. R. 13 Eq. 355.
(*g*) 1874, L. R. 18 Eq. 330.

(*h*) 1879, L. R. 15 Ch. D. 514; 19
Ch. D. 386.

true gist of what he has done is to apply that threat to a particular person and to a particular act" (i).

A threat so defined may be conveyed in a circular, an advertisement, or a private letter (j), or may be made at an interview, or in the course of a correspondence, even when conducted mainly without prejudice (k). How threat may be conveyed.

Threats made by a solicitor's letter are sufficient ground for an action (l).

Where a defendant complains not of the plaintiff's invention *simpliciter*, but that the plaintiff's invention is being so used by third parties as to infringe his patent, this is not a threat within the meaning of sect. 32 if the notice is so framed as to make this clear (m).

A threat of legal proceedings contained in a letter which has never been qualified or withdrawn, is held to be continued (n).

The point that there has not been such a threat as the section contemplates should not be raised as a "preliminary objection" at the trial (o).

(2) The remedies prescribed by the statute are competent *either* to the person threatened, *or* to any person aggrieved by the threats (p). Remedies, to whom competent.

(3) *The remedies* allowed by this section are— Remedies.

(a) An action to recover such damage, if any, as the plaintiff may have sustained by the defendant's threats; and

(b) An injunction against the continuance of such threats.

Although these remedies are concurrent, it will be convenient to treat them to some extent separately. Action.

In an action for damages for threatening notices, the burden of proving that the patentee's statements are false rests on the plaintiff (q). On whom *onus probandi* rests.

In *Wren v. Weild* (r), an action brought by the plaintiffs in

(i) *Challender v. Royle*, 1887, per Bowen, L. J., 4 P. O. R. at pp. 374, 375.

(j) *Driffield, &c. Co. v. Waterloo, &c. Co.*, 1886, 31 Ch. D. 638; *Walker v. Clarke*, 1887, 4 P. O. R. 113; *Kurtz v. Spence*, 1888, 5 P. O. R. 161; *Crampton v. Patent Investment Co.*, 1888, 6 P. O. R. 393.

(k) *Kurtz v. Spence*, *ubi supra*, 172, 173.

(l) *Combined Weighing Co. v. Automatic Weighing Co.*, 1889, 6 P. O. R. 602; 42 Ch. D. 665.

(m) *Burt v. Morgan*, 1887, 4 P. O. R. 280, 281.

(n) *Driffield, &c. Co. v. Waterloo, &c. Co.*, *ubi supra*, per Bacon, V.-C., at p. 643.

(o) *Kurtz v. Spence*, 1888, *ubi supra*, per Kekewich, J., at p. 170.

(p) Cp. *Stirling, J.*, in *Burt v. Morgan*, *ubi supra*, at p. 280.

(q) *Burnett v. Tak*, 1882, 45 L. T. N. S. 743; *Anderson v. Liebig's Extract of Meat Co.*, 1881, 45 L. T. N. S. 757, 759.

(r) 1869, L. R. 4 Q. B. 213.

respect of injury caused by letters and statements of the defendant alleging that certain machines sold by them were infringements of his patent, the Court ordered the defendant to deliver particulars to the plaintiff, showing in what part or parts the said machines were an infringement of his patent, and pointing out, by reference to line and page of his specifications, what part of the inventions therein described he alleged to have been infringed. This case was decided in 1869, but it is presumed that a similar order might still be made.

Damages,
when
awarded.

Damages will be awarded only where substantial injury has been sustained.

Thus, in *Driffield, &c. Co. v. Waterloo, &c. Co.* (s), where the plaintiffs had merely been compelled by the threats complained of to look over their machinery, and to suspend certain building operations, Bacon, V.-C., held that the notion of damages was out of the question.

Threats
without
prejudice.

In *Kurtz v. Spence* (t)—a leading case under this section—where (a) the threats were conveyed in the course of a correspondence conducted mainly “without prejudice,” and with a view to the amicable adjustment of the legal rights of the parties; and (b) the plaintiffs had not yet erected plant and machinery for the manufacture of the articles alleged to infringe the defendant's patent, Kekewich, J., refused to direct a reference as to damages, and awarded the plaintiffs 40s., with costs on the higher scale.

Validity may
be questioned.

The plaintiff may now, it seems, question the validity of the defendant's patent in an action under sect. 32 (u), but the Court may order that the defendant shall have the same notice of objections, and the same right of beginning and replying, as he would have had if he had brought an action against the plaintiff to restrain the infringement of his patent (x).

Defendant
must support
patent as in
action for
infringement.

In an action for damages under this section, the question who is the true and first inventor is an issue of fact, which is not concluded by the defendant merely producing the original letters patent duly sealed. He is bound to support them as if he were plaintiff in an action for infringement (y).

(s) 1886, 3 P. O. R. at p. 48.

(t) 1888, 6 P. O. R. at p. 177.

(u) *Challender v. Royle*, 36 Ch. D. 425; disapp. of *Kurtz v. Spence*, 33 Ch. D. 579, upon this point. Cp. *Law v. Ashworth*, 1890, 7 P. O. R. 86.

(x) *Kurtz v. Spence*, 1887, 36 Ch. D.

at p. 774, per Cotton and Bowen, L.JJ., Fry, L. J., *diss.*; *Union Electrical Power and Light Co. v. Electrical Power Storage Co.*, 1888, 38 Ch. D. 325.

(y) *Kurtz v. Spence*, 1888, 6 P. O. R. at p. 177, per Kekewich, J.

In considering a motion (which should not be made *ex parte* (z)) for an interlocutory injunction under sect. 32, the Court looks to the balance of convenience and inconvenience, and in particular requires the applicant to make out at least a *prima facie* case (a) that the act complained of is not an infringement. Injunction.
Balance of convenience looked to.

The following points are also material: Is there evidence of the violation of any contract or undertaking entered into between the plaintiff and the defendant? (b). Has the defendant with "due diligence" commenced an action for infringement against the plaintiff? Material points.

The law upon this latter point may be very shortly summarised. Due diligence.

An action is commenced with due diligence if commenced (a) within a reasonable time, *e.g.*, within an interval of three months *after the threats complained of*; (b) with the *bona fide* intention of testing the validity of the patent or the fact of infringement, whichever may be in question; and (c) against the person or any of the persons to whom the threats have been made (c).

The fact that a person making threats refrains from bringing an action to assert his rights, is very material on a motion for an interlocutory injunction (d).

The proviso of sect. 32 may be satisfied although the patentee does not apply for an interlocutory injunction in his action (e).

An action for infringement to come within the proviso must be to restrain an infringement similar to that which is threatened; and the proviso is not satisfied by an action to restrain a different infringement (f).

The right of action for threats given by sect. 32 of the Act of 1883 is taken away by the commencement of an action for infringement commenced and prosecuted with due diligence (f).

The fact that the defendant in an action under sect. 32 contends

(z) *Wilson v. Walter E. Church Engineering Co.*, 1885, per Bacon, V.-C., 2 P. O. R. 175.

(a) *Colley v. Hart*, 1889, 6 P. O. R. 17; *cp. Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.*, 25 Ch. D. 9; *Barney v. United Telephone Co.* 1885, 28 Ch. D. 94, where evidence of no infringement was held to be a condition precedent to the grant of an interlocutory injunction. *Walker v. Clarke*, 1888, 4 P. O. R. 114, where this extreme view was dissented from.

(b) *Société Anonyme, &c.*, *ubi supra*;

E.

Household v. Fairburn, 1884, 1885, 1 P. O. R. 108; 2 P. O. R. 140; *Sharp v. Brauer*, 1886, 3 P. O. R. 193; *cp. also Clark v. Adie*, 1873, 21 W. R. 456, 764; *Société Anonyme, &c.*, *ubi supra*.

(c) *Challender v. Royle*, 1887, 36 Ch. D. per Cotton, L. J., at p. 437.

(d) *Colley v. Hart*, 1889, per North, J., 6 P. O. R. at p. 21.

(e) *Anderson v. Liebig's Extract of Meat Co.*, 1881, 45 L. T. N. S. 757.

(f) *Combined Weighing Co. v. Automatic Weighing Co.*, 1889, 6 P. O. R. 502, 507; 42 Ch. D. 665.

at the trial that the threatening notices were such as he had a right to issue and to continue to issue, is no evidence of an expression of intention to persist in issuing such notices in the event of its being decided that the doing of it would be actionable (*g*).

The meaning of the proviso in sect. 32 was recently considered in *Barrett v. Day*, and *Day v. Foster* (*h*). F. was exclusive licensee of D., a patentee; he was also exclusive licensee of B., a subsequent patentee. D. sued F. for a declaration that articles made under B.'s patent were an infringement of his (D.'s) patent, and for an injunction to restrain manufacture and sale under B.'s patent without paying royalties to D. and accounts of royalties for past manufacture.

Previously to the issue of the writ, D.'s solicitor had written to F.'s solicitors that B.'s patent was within D.'s patent, and that claims would be made in the action, then intended, in respect of articles made under B.'s patent. B. sued D. under sect. 32 for an injunction to restrain threats. North, J., held that D.'s action was an action for infringement within the meaning of that section, and as it had been brought with due diligence the section did not apply, and B.'s action was stayed.

Advertisement after action brought.

After an action has been commenced, a patentee may not advertise, and will, if necessary, be restrained by injunction from advertising a positive statement that the defendant has infringed. He may, however, give notice that an action has been brought, and warning other persons against the consequence of infringement (*i*).

Cross actions.

Where an action for threats is brought, and then a cross action for infringement, some arrangement should be made in order to avoid incurring unnecessary costs by trying the same action in two different forms (*k*).

(*g*) *Sugg v. Bray*, 1885, per North, J., 2 P. O. R. at p. 246.

(*h*) 1890, 7 P. O. R. 54; L. R. 43 Ch. D. 435; W. N. 1890, 36.

(*i*) *Goulard v. Lindsay*, 1887, 4 P. O.

R. per Kay, J., at p. 189; *Fusee Vesta Co. v. Bryant and May*, 1887, 4 P. O. R. 192.

(*k*) *Combined Weighing Co. v. Automatic Weighing Co.*, *ubi sup.* at p. 267.

CHAPTER XVI.

REVOCATION OF PATENTS.

SECT. 1. SCIRE FACIAS BEFORE ACT OF 1883.

SECT. 2. REVOCATION UNDER ACT OF 1883.

SECT. 1.--SCIRE FACIAS BEFORE ACT OF 1883.

BEFORE the Act of 1883 the mode of revoking and cancelling patents for inventions was by an action of *scire facias*, in which a person complaining of the illegality of a patent was authorized by the fiat of the Attorney-General to proceed in the name of the Crown to obtain the judgment of the Court of Chancery for its repeal (a). Necessity of
scire facias.

The action of *scire facias* was necessary as a protection to the Crown and the public. The proceedings to obtain a patent were substantially *ex parte*. The grant being entirely at the risk of the petitioner, the Attorney-General relied solely on his statement of facts. An opponent had no information to guide him except the title of the invention, which was purposely made as vague as possible, and was not permitted to hear the petitioner's statement in support of his claims. It was, therefore, essential that there should be some remedy for the Crown and the public against false suggestions and illegal grants.

The procedure for the repeal of letters patent for inventions was formerly the same as that for the repeal of other royal grants. And *scire facias* still lies to repeal such of these other grants as may be contrary to law, or have been obtained by false suggestion.

The proceeding for avoiding and cancelling a patent by *scire facias* was originally taken on the common law side of the Court

(a) See a full account of the practice in proceedings by *scire facias* in Hindmarch, pp. 376 *et seq.*

of Chancery, that being the Court in which the patent was made (b).

Crown grants always obtained by petition.

Crown specially protected against false petitions.

If Crown deceived, patent void.

Particulars respecting the invention were stated in petition and recited in the patent.

Remedy for the public by *scire facias*.

Queen may proceed by *scire facias* to cancel a patent.

Crown grants in general are, indeed almost always, obtained by means of representations made by, or on the behalf of the grantees, and as the sovereign is so much occupied with the affairs of the state, it would be impossible always to ascertain with certainty whether the representations of a petition for a grant by patent were true or not. The law, therefore, takes especial care to protect the Crown against false petitions and representations (c). It is accordingly laid down that it is the duty of every one obtaining a grant from the Queen, to see that she is correctly informed respecting the grant. And if it appears that the Queen has been deceived in any material particular, by a false representation or suggestion of the grantee, the patent will be wholly void (d). And when facts are recited in a patent respecting the subject-matter of the grant, it will be presumed that the statements contained in the recital were represented or suggested to the Queen by the patentee (e).

The material particulars respecting an alleged invention for which a party formerly sought to obtain a patent, were stated in the petition for the patent. The petition stated that the petitioner was the inventor or importer of the invention, and that the invention possessed the qualities of novelty, utility, &c., so as to be the proper subject of a grant by patent. The substance of the petition for the patent was always recited in the patent itself, and therefore the patent itself showed upon what representations of the patentee it had been granted; and if the patentee had represented anything which was untrue in any material particular, or had induced the Crown to make an illegal grant, the patent was entirely void.

The various objections which can be taken to a patent for an invention, by a person against whom the patentee may institute legal proceedings, have already been considered (f); and the law provided a remedy for the public by action of *scire facias*, in which similar objections might be taken, and if any valid objection was sustained, the result was that the patent was repealed or annulled, and ordered to be cancelled.

The Queen has by the common law an undoubted right to proceed by *scire facias* to repeal and cancel a patent respecting which she has been deceived, or by which her subjects are prejudiced.

(b) Hindmarch, p. 379.

(c) See 10 Co. R. 113, b.

(d) Vin. Abr. Prerog. (O. b.).

(e) 5 Co. R. 55, b.; 10 Co. R. 112, a.

(f) *Ante*, pp. 288 *et seq.*

This was laid down by the judges in the House of Lords in the case of *R. v. Butler* (g), and there are several old authorities to the same effect (h). In the *Magdalen College case* (i), it was said, that "The law has given the king a great prerogative above any of his subjects, that where by fraud or false suggestion he is deceived, that he himself in such cases shall avoid his own grant *jure regio*." And in *Legat's case* (k), it was said, that "When upon false insinuations or pretences the king makes any grant, as of any monopoly, &c., which, in truth, is to the prejudice of the king and commonwealth, the king *jure regio* shall avoid such grants, and such letters patent by judgment of law shall be cancelled" (l).

*R. v. Butler.**Magdalen College case.**Legat's case.*

The grounds on which an action of *scire facias* might formerly be instituted were "fraud, false suggestion, non-compliance on the part of the patentee with the conditions of the letters patent, failure of any of the essential requisites of novelty and utility, or abuse of the privileges granted by the letters patent" (m).

Former grounds for *scire facias*.

Fraud and false suggestion may be considered together (n).

Letters patent were granted for "certain improvements in steam engines and in machinery for propelling vessels." One of the inventions as described in the specification was not an improvement. The grant was held bad for falsity of suggestion (o).

Fraud and false suggestion. Cases.

Letters patent were taken out for a watch. The invention as disclosed by the specification was only of part of a watch. The patent was repealed (p).

The patentee of an improved machine claimed as his invention a part of it which turned out to be useless. The specification did not describe it as essential to the machine. It was held that the patent was not vitiated (q).

The distinction between the first two and the last of the cases just cited is clear. In each of the former there was a false statement, recited in the patent by way of suggestion, and forming a material part of the consideration for the grant. In the latter the false

(g) 3 Lev. 220, 221.

(h) See Staund. Prerog. 84, a.; Brook, Abr. Pat. 14, Petit. 11, and Sci. Fa.; Rol. Abr. Prerog. (S.) p. 191; 21 Ed. III. 47 B. & 10 Co. 113, b.

(i) 11 Co. R. 74, b.

(k) 10 Co. R. 109.

(l) This and the third previous paragraph are adapted from Hindmarch, pp. 377-9.

(m) Webs. Lett. Pat. p. 32.

(n) See *R. v. Mussary*, 1738, 1 Web.

P. C. 41, n. 2.

(o) *Morgan v. Seaward*, 1835-37, 2 M. & W. at p. 561.(p) Before 1795; 1 Web. P. C. 42, n.; cp. *R. v. Wheeler*, 1819, 2 B. & Ald. 349; *Hill v. Thompson*, 1818, 1 Web. P. C. 239; *Erunton v. Hawkes*, 1821, 4 B. & Ald. 551, 552, 558; *Felton v. Greaves*, 1829, 3 C. & P. 611.(q) *Lewis v. Marling*, 1829, 1 Web. P. C. 496; cp. *Morgan v. Seaward*, 1837, 1 Web. P. C. 197, per Alderson, B.

recital was not made by way of suggestion at all (r). Even if such a false recital did affect in some degree the suggestion made by the patentee to the crown, the patent will not necessarily be held void.

Utility.

Thus, in *Haworth v. Hardcastle* (s), an action for infringement, the jury found as follows: "the invention is new and useful upon the whole . . . but they also find that the machine is not useful in some cases for taking off goods." In delivering judgment upon a motion for entering a non-suit, Tindal, C. J., said: "We think we are not warranted in drawing so strict a conclusion from this finding of the jury, as to hold that they have intended to negative, or that they have thereby negatived, that the machine was useful in the generality of the cases which occur for that purpose. After stating that the machine was useful upon the whole, the expression, that in some cases it is not useful to take up the cloths, appears to us to lead rather to the inference that in the generality of cases it is found useful. And if the jury think it useful in the general, because some cases occur in which it does not answer, we think it would be much too strong a conclusion to hold the patent void. . . . We think that we should act with great hazard and precipitation if we were to hold that the plaintiff ought to be non-suited upon the ground that his machine was altogether useless for one of the purposes described in his specification."

Non-compliance with conditions of patent.

A specification described various parts of machinery, but no complete machine, and the defendant did not point out what parts were new. The patent was repealed (t).

Want of novelty and utility.

A patent was granted for "improvements in firegrates or stoves." The specification, after describing the stove, claimed as the invention the construction of stoves in such manner as that the fuel necessary to supply the fire shall be introduced from beneath, either in a perpendicular or in an oblique direction. Ellenborough, C. J., was of opinion that the evidence showed grates to have been constructed prior to the patent on a principle identical with that described in the specification; that the patentee by his claim had confined himself to that principle, and that therefore the patent could not be supported (u).

(r) See 1 Web. P. C. 42, n.; cp. *Morgan v. Seaward*, 1837, 1 Web. P. C. 197, per Alderson, B.; cp. *Travell v. Carteret*, 3 Lev. 134; *Alcock v. Cooke*, 1820, 5 Bing. 340, cited by Parko, B., in *Morgan v. Seaward*, *ubi supra*, at p. 196.

(s) 1834, 1 Web. P. C. 483.

(t) *R. v. Arkwright*, 1785, 1 Web. P. C. 64, and other authorities there cited; *R. v. Cutler*, 1816, 1 Web. P. C. 76; and Specification, *supra*, p. 83.

(u) *R. v. Cutler*, *ubi supra*.

The *defects* in the proceeding by *scire facias* were in many ways objectionable. It was cumbrous. The most superficial study of the description given by Hindmarch of the various stages in the action will satisfy any one upon this point. It was costly. The *fiat* of the Attorney-General was obtained as a matter of course by any one who could give the requisite security by bond to the chief clerk of the Petty Bag Office. No interest in the repeal was necessary. Although particulars of objection were required, and although it was provided—15 & 16 Vict. c. 83, s. 41—that no evidence should be admitted on any subject not mentioned therein, the particulars supplied were usually so vague as to give no information at all, and the patentee came into Court without any accurate knowledge of the case he had to meet. On this point the evidence taken before “the Commissioners appointed to inquire into the working of the law relating to patents for invention” is interesting and conclusive (*x*).

The action of *scire facias* was tried, in so far as issues of fact were concerned, before a jury.

The patentee, if successful in an action of *scire facias*, obtained only such costs as were covered by the petitioner's bond; the petitioner, who succeeded in setting aside a patent, got no costs at all, on account of the general rule of law which then prevailed, that the Queen received no costs in any action to which she was a party (*y*).

Sir Roundell Palmer, giving evidence before the Commissioners, said (*z*): As the inquiry is one usually more of judgment and opinion than of fact, there is always the contradiction between the witnesses ranged on each side, which is almost proverbial in questions of this description. If, then, the point to be determined is the resemblance between two machines, the difference between which cannot be observed by a common eye, or the distinction between two equivalent chemical combinations, the probability is that the last word will carry the day; and it has more than once happened that the same patent tested by an action for infringement has been held good, and has been afterwards set aside when impeached by *scire facias*, the patentee beginning his case in the action, and his opponent in the *scire facias*, and each respectively having the reply. This advantage of the first and last word in cases of this kind has

(*x*) Report of the Commissioners, &c., 1865.

(*y*) Report, &c., 1865, p. 15, Ans. 347—350.

(*z*) *Ibid.*, Appendix, p. 180, Ans. 7.

been considered of such importance that the legislature, in the Act of 1852, provided that for the benefit of a patentee at the trial of a *scire facias* to repeal letters patent, the defendant should begin, and if evidence should be adduced on the part of the prosecutor, should be entitled to reply.

SECT. 2.—REVOCATION UNDER ACT OF 1883.

The petition.

The proceeding by *scire facias* is now in form abolished, and revocation of a patent may be obtained by petition to the Court.

Every ground on which a patent might, before the Act of 1883, be repealed by *scire facias* is now a ground of revocation, and also available by way of defence to an action of infringement (*a*).

Letters patent for inventions assigned to the Secretary of State for War are not revocable (*b*).

The Court.

The "Court" means the High Court of Justice in England (*c*), the Court of Session in Scotland (*d*), and the High Court of Justice in Ireland (*e*).

Does not include Lancaster Palatine Court.

Petitions for revocation cannot be presented in the Court of the County Palatine of Lancaster, which is not a Court within the meaning of the Patents Act, 1883, except for the purpose expressly set forth in sect. 112 (*a*) (*f*).

Jurisdiction to repeal patent in England where patentee a domiciled Scotchman.

Where a petition was presented for the revocation of a patent belonging to a domiciled Scotchman who was served with the petition, but stated he did not intend to appear, the Court, on the application of the petitioner, made an order that the petition should go into the witness list, unless the patentee showed cause to the contrary, it being open to the patentee, if he appeared, to dispute the jurisdiction (*g*).

Nature of petition for revocation.

A petition for revocation is in the nature of an "action," or at any rate is a "matter," and therefore (*h*) it can be sent for trial at assizes before a judge without a jury; but such an order will not prevent the judge at the trial from acting on his own view of his jurisdiction (*i*).

(*a*) Act of 1883, s. 26, sub-ss. 1, 2, 3.
 (*b*) Sect. 44, sub-ss. (3) and (9), *infra*, pp. 498, 499.
 (*c*) *Ibid.* s. 117.
 (*d*) *Ibid.* s. 109.
 (*e*) *Ibid.* s. 111, sub-s. (1).
 (*f*) *Proctor v. Sutton Lodge Chemical*

Co., 1888, 5 P. O. R. at p. 185.
 (*g*) *Drummond's Patent*, 1889, 6 P. O. R. 576; L. R. 43 Ch. D. 80.
 (*h*) Either under R. S. C. 1883, Ord. XXXVI. r. 1; or Ord. XXX. r. 1.
 (*i*) *In re Edmonds' Patent*, W. N. 1888, p. 234; 1889, 6 P. O. R. 355.

A petition for revocation may be presented by any of the following persons (*k*):— Who may petition.

(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 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.

Proceedings in Scotland for revocation of a patent takes the form of an action of reduction at the instance of the Lord Advocate; or of a party having interest with his concurrence, which concurrence may be given on just cause shown only (*l*). Who may petition in Scotland.

It appears, therefore, that a petitioner before the Court of Session for revocation of letters patent, is required to have both an interest in the patent which he seeks to repeal and the concurrence of the Lord Advocate.

When it is desired to obtain the fiat of the Attorney-General, the following papers must be sent to the Patent Clerk, at Room No. 549, Royal Courts of Justice, London: a memorial to the Attorney-General asking for his authority, and stating all the circumstances; a statutory declaration verifying the statements in the memorial; two copies of the proposed petition and of the particulars proposed to be delivered with it; the certificate of a barrister that the petition is proper to be authorized by the Attorney-General; the 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. Fiat of Attorney-General, how obtained.

The fiat of the Attorney-General has never been, and is not now, issued as a matter of course. Fiat not issued as of course.

(*k*) Patents Act, 1883, s. 26, sub-s. (4).

(*l*) *Ibid.* s. 109, sub-s. (1).

Although it was laid down in *Butler's Case* (e), that "where a patent is granted to the prejudice of a subject the King, of right, is to permit him upon his petition to use his name for the repeal of it," it is also stated that "the subject had not a right *mero motu* to have a *scire facias*" (f), and there seems to have been no doubt that if the Attorney-General were to have accepted insufficient security, or if, after his fiat had been granted, the bail or security had failed, the Court would have ordered a stay of proceedings until further security had been given (g). In *Reg. v. Newall* (h), Sir F. Pollock, A.-G., on a petition for relief against certain suggestions in a writ of *scire facias*, which had regularly issued, decided that he would direct a *nolle prosequi* to be entered as to certain parts of the writ, if the prosecutor insisted on retaining them.

Fiat may or may not be granted *ex parte*.

Principles on which Attorney-General acts.

The Attorney-General may either give or refuse his authority *ex parte*, or direct that the patentee shall have notice and liberty to be heard before him.

The following cases show the principles on which the law officer acts in issuing or withholding his fiat:—

A. was the patentee of a process for the production of paraffin oil by the distillation of bituminous coal. B. applied for *scire facias*. B. was the owner of a coal field in Scotland, containing a certain mineral called the Torbane Hill mineral, the right to get which was leased to certain persons, who sold it to the patentee for the purposes of his manufacture. Under the terms of the said lease, B. had a pecuniary interest in the quantity of mineral raised. B. alleged that A.'s invention was not new, and that the patent, by restricting the sale of the Torbane Hill mineral, prejudicially affected his interests. At the date of the application, an action raised by B. in Scotland for the reduction of A.'s Scotch patent for the same invention was pending. Sir R. Bethell, A.-G., refused his fiat (a) because the writ of *scire*

(e) 2 Vent. 344.

(f) *Reg. v. Neilson*, 1842, 1 Web. P. C. 672; *R. v. Betts*, 1850, 19 L. J. Q. B. 531; 15 Q. B. 540. Sir Frederick Pollock in argument said: "I never knew a *scire facias* except in the case of a patent for an invention. The only case which I recollect of anything like two grants having been issued occurred not in this country, but in the colony of New South Wales. The Attorney-General of that colony had refused to permit a *scire facias* to issue for the very purpose of

trying whether land granted by a second grant had not been granted before. Upon a case which came afterwards before my learned friend the Solicitor-General and myself, it appeared that the late law officers of the Crown had advised that the Attorney-General ought to allow the *scire facias* to issue, from which I presume it was considered that the subject had not a right *mero motu* to have a *scire facias*."

(g) 1 Web. P. C. 671, 672.

(h) *Ibid.* n. (i).

facias ought not to be used for purely private ends; (b) because the convenient and proper course seemed to be to allow the Scotch action to go on, and to be guided by its issue; and (c) because the patent was eleven years old, had been the subject of several legal proceedings, and ought not, therefore, to be lightly challenged (*i*).

The H. F. Co. applied for authority as regards a patent of B. and C., who had raised an action for infringement, then pending in Scotland, against the applicants. James, A.-G., directed that notice should be given to the patentees, and on their objecting that, as they were resident in Scotland, the application should have been made to the Lord Advocate, refused authority, pending the result of the action in Scotland, but gave leave to renew the application if necessary (*k*).

V. applied for authority as regards S.'s patent. Russell, A.-G., directed notice to be given to S., and at the hearing ordered the application to stand over generally, upon S. undertaking to bring an action against the applicants within a month. Costs of the application to be, by consent, costs in the cause (*l*).

B. applied for authority as to W.'s patent. B. had been a defendant in an action by W. *v.* S., and this application was made in the interval after the judgment against B. in the Court below, and before the hearing in the Court of Appeal. Russell, A.-G., directed that W. should have notice, and on his failure to appear at the hearing granted authority (*m*).

F. applied for authority as regards G.'s patent. No other proceedings were pending. Webster, A.-G., granted his fiat without directing notice to be given to G. (*n*).

K.'s trustees applied for authority as to R.'s patent. R. had sued K. in the Palatine Court for infringement, had abandoned the action after the delivery of K.'s defence, and had made an application (then pending at the Patent Office) for leave to amend. The applicants carried on K.'s business, with which it was alleged that R.'s patent interfered. Webster, A.-G., gave unconditional authority, without directing notice to be given to R. (*o*).

A patent will not be held to have been obtained in fraud of the

Meaning of
"in fraud of"

(i) *Young's Patent*, Pract. Mech. Jour. 2nd series, vol. vi. p. 98. See also vol. vii. p. 44; and Lawson, p. 105.

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

(l) *Siddell's Patent*, Griffin, P. C. 320. In *Martin's Patent*, *ibid.*, James, A.-G., after consultation with Herschell, S.-G.,

held that, where an application for his authority had been eventually abandoned, he had no power, under sect. 38, to give costs.

(m) *Watling's Patent*, Griffin, P. C. 320.

(n) *Gaulard and Gibbs' Patent*, *ibid.*

(o) *Rothwell's Patent*, *ibid.*

the rights of another."

rights of another unless the patentee has been guilty of dishonest and culpable acts in obtaining it (*p*).

In 1885, a patent was granted to L. for improvements in the means of generating fixed gases. In 1886, A., a subject of the United States, presented a petition for revocation, on the grounds that the invention was a communication from abroad—a fact which L. had not disclosed—and that the patent had been obtained by fraud. A.'s petition contained no allegation that he was the true and first inventor. It appeared that L. had not been guilty of fraud, but had acted upon the advice of a competent patent agent in taking out the patent in his own name, and had intended to hold it for the benefit of A. It was held by Mr. Justice Stirling, that even assuming the patent to be void by reason of the non-disclosure of the fact that part of the invention was a communication from abroad, yet it was not proved to have been obtained in fraud of the petitioner's rights, and that the petition must be dismissed without prejudice to any claim which A. might make under sect. 26, sub-sect. 4 (d), as a person alleging that he was the true and first inventor of any of the inventions included in the claim of the patent (*q*).

The question still remains, said Mr. Justice Stirling in this case (*r*), Was (the patent), in the language of the statute, obtained in fraud of the petitioner's rights? The first point to be determined in answering that question is the sense of the word "fraud" as used in the statute. Here we have not to deal with a statute 300 years old, like the Statute of Monopolies, nor is there any current of decision to fix the sense in which the word therein is used, and in my judgment it would be wrong to construe the word, occurring as it does in an Act passed little more than three years ago, and in the absence of any context imperatively demanding such a construction, otherwise than in accordance with the usual construction of the English language, and consequently as involving grave moral culpability in the person obtaining the patent (*s*).

True inventor of invention

The case of *Walker v. Hydro-Carbon Syndicate, Limited* (*t*),

(*p*) *Acery's Patent*, 1887, per Stirling, J., 4 P. O. R. at p. 165.

(*q*) *Ibid.* at p. 152.

(*r*) At p. 165.

(*s*) The petition should be presented in the name of the person making the allegations which would destroy the grant, and not in that of his attorney,

and all other persons interested in the grant must be made respondents. *S. C.*, 36 Ch. D. pp. 310, 311; *Re Haddan's Patent*, 1885, 2 P. O. R. 219.

(*t*) 1885, 2 P. O. R. p. 3. An appeal was taken against the decision in this case, but subsequently abandoned. Preliminary applications—(a) that the ap-

turned on the words "true inventor of any invention included in the claim of the patentee." In this case, W., the grantee of a patent, presented a petition under sub-sect. 2 of sect. 26 of the Patents Act, 1883, for revocation of patents granted to H. and B., alleging that he was the true and first inventor of the inventions comprised in such patents. It was held, on the construction of the specifications of the three patents, and also of a patent granted in 1865 to one Wise, that eliminating from W.'s patent matters of common knowledge, the inventions claimed by H. and B. were not similar to the invention claimed by W., and that the petition must therefore be dismissed with costs. The following extract from the judgment of Bacon, V.-C., will show the *ratio decidendi* :—

included in claim of patentee.

"There was a common universal knowledge that petroleum, dangerous in itself, inapplicable in itself, could by means which had been resorted to long ago in Wise's patent, and long before that, namely, by being reduced into the form of spray, be usefully applied for the purposes for which alone petroleum is valuable, and avoiding all the danger which would attend the application of it in any other way. The three patents . . . are not for totally different purposes, but are totally different in their mode of application; and now I am to be told, after a mechanical invention has been produced for a common object, that any person who makes a better combination of machinery (not by the mere introduction of mechanical equivalents, but by the exercise of mechanical genius or talent, or whatever it may be called) could not obtain a patent for it; that he has no right to say, . . . 'Admitting yours was a good patent, and your contrivances are very ingenious and clever, I see a much better way of dealing with the basis of common knowledge, . . . and I do it better and differently from the way in which you do it.' That is the whole case."

Judgment of Bacon, V.-C.

If a petitioner can show that prior to the grant of a patent he had publicly manufactured the subject-matter by a process substantially similar to that used by the patentee, revocation will be granted (*v*).

Prior user.

A petitioner qualified to present a petition in the manner

Where *locus standi* patent

peal might stand over till the return from America of the plaintiff, who was an engineer, and wished to be present at the hearing for the purpose of instructing his counsel; and (b) that the

plaintiff should be allowed to adduce fresh evidence on appeal, were dismissed: 1886, 3 P. O. R. 253.
(u) *Haddan's Patent*, 1885, 2 P. O. R. 218.

may be impeached on all grounds.

pointed out in clauses (c), (d), and (e), above, may impeach the patent on any other ground (*x*).

F. presented a petition for revocation of a patent on the ground of having publicly manufactured and sold the invention claimed by the patentee. The petition and particulars of objections alleged other grounds of invalidity besides F.'s prior manufacture and sale. On the petition coming on for hearing the preliminary point was taken by the respondents that F. not being authorized by the Attorney-General to present the petition, could not put forward or rely on any objection to the validity of the patent, except his own prior user of the patented invention; but it was held, that when the petitioner is qualified to present the petition the patent may be attacked on any other ground (*x*).

If, however, the petitioner has no *locus standi*, if he is not one of the persons entitled under the Act to present a petition to revoke the letters patent, the Court will not go into the question whether the patent is or is not good (*y*).

Particulars of objections with petition.

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 (*z*).

Certificate as to particulars proved, &c.

In the matter of *Goulard and Gibbs' Patent* (*a*), Mr. Justice Kekewich held (*b*), that he had no power to grant a certificate as to particulars of objections delivered (*c*) by a petitioner for revocation, but gave the petitioners leave to make a renewed application for a certificate at their own risk as to costs.

Amendment of particulars.

Particulars delivered may be from time to time amended by leave of the Court (*d*).

Contrary to the rule which prevailed in the action of *scire facias* (*e*) prior to the Act of 1852, the defendant is now, as under the Act of 1852, 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 (*f*).

(*x*) *Morgan's Patent*, 1887, 5 P. O. R. 186.

(*y*) *Acery's Patent*, 1887, 36 Ch. D. at p. 323, per Cotton, L. J.

(*z*) Sect. 26, sub-sect. (5). See form of particulars of objection, *infra*, pp. 788—790; and *Haddan's Patent*, 1885, 2 P. O. R. 219.

(*a*) 1888, 5 P. O. R. 526: affirmed 1889, 6 P. O. R. 215.

(*b*) Upon a consideration of sects. 26, 28, sub-sect. (1), and 29, sub-sects. (2), (4), and (6).

(*c*) Under sect. 26, sub-sect. (5).

(*d*) Sect. 26, sub-sect. (6).

(*e*) Hindmarch, p. 412.

(*f*) Sect. 26, sub-sect. (7).

Subject to the provisions contained in the Patents Act, 1883, s. 26, the practice is governed by the ordinary practice upon a petition to the High Court. Accordingly, a petitioner on making the usual deposit will be allowed to administer interrogatories to the respondent (*g*).

Subject to sect. 26 ordinary practice on petition holds.

A petition for revocation is in every sense of the word an "action," except that it is not commenced by writ, and involves precisely the same issues as an action to try the validity of the patent. Respondents who desire it may therefore have a petition for revocation tried on *virá voce* evidence (*h*).

Petition "an action."

Revocation on the ground of prior user by the petitioner, or a person through whom he claims (*i*), is in form apparently new; though, of course, a *scire facias* would have lain for want of novelty at the instance of any person.

Fraud of opponent's right.

The person in whose favour an order for the revocation of a patent has been made, is required to leave forthwith at the Patent Office an office copy of such order (*j*).

Registration of order revoking patent.

That a specification does not end with a distinct statement of the invention claimed is not a ground of revocation (*k*).

Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor, made in accordance with the provisions of the 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 (*l*).

There is no provision in the Act of 1883 for the cancellation of a revoked patent, according to the practice which prevailed in proceedings by *scire facias*. But the order revoking the patent is entered upon the register, which is indeed sufficient.

A specification cannot be amended under the Act of 1883, s. 18, whilst a petition for revocation is pending, but the Court or a judge may, subject to such terms as are thought fit, give leave to apply at the Patent Office for liberty to amend the specification by way of disclaimer, and may direct a stay of proceedings in the meantime.

(*g*) *Haddan's Patent*, 1884-85, Griffin, P. C. 108.

(*h*) *Gaulard and Gibbs' Patent*, 1887, per North, J., 34 Ch. D. 396.

(*i*) Sect. 26, sub-s. 4, clause (c).

(*j*) P. R. 1890, r. 74.

(*k*) *Siddell v. Vickers*, 1888, per Fry, L. J., 39 Ch. D. at p. 109.

(*l*) Sect. 26, sub-s. 8.

CHAPTER XVII.

OFFENCES AND PENALTIES.

SECT. 1. PRIOR TO ACT OF 1883.

SECT. 2. UNDER ACT OF 1883.

SECT. 1.—PRIOR TO ACT OF 1883.

Remedy for
imitation
prior to 1835.

BEFORE the year 1835, the only remedy which a patentee had against any person for imitating his name or device was by a bill in Chancery for an injunction, or an action at law for the damages which he might have sustained (*a*).

Act of 1835,
s. 7.
Protection to
names and
marks of
patentees.

The statute 5 & 6 Will. IV. c. 83, provided an additional protection to patentees in such cases. By that statute (*b*) it was enacted that any person who counterfeited or imitated the *name*, or the *stamp*, *mark*, or *device* of any patentee, should for every such offence be liable to a penalty of 50*l.*, to be recovered by action of debt in any of his Majesty's Courts of Record at Westminster, or in Ireland, or in the Court of Session in Scotland (*c*), one-half to his Majesty, his heirs, and successors, and the other to any person who shall sue for the same.

Defences
under this
Act.

The defendant in an action under this section was entitled to plead *nil debet*, and to give the special matter on which he relied in evidence, without any notice of objections, the 5th section of 5 & 6 Will. 4, c. 83, being inapplicable (*d*).

There is some doubt as to the defences which were competent in an action for penalties under this statute.

(*a*) Hindmarch, p. 367.

(*b*) Sect. 7.

(*c*) No penalty under this section could be recovered in a County Palatine Court, or in any inferior Court of Record.

(*d*) The right to plead the general issue was derived from the Statute of

Monopolies, which enabled the defendant in a final action to plead not guilty, or that he owes nothing, and to give the special matter in evidence (sect. 4). Under the Reg. Gen. T. T. 1 Vict. 1838, the defendant was required to write in the margin of the plea, setting up the general issue, the words by statute.

In *Myers v. Baker* (*e*), an action for a penalty for putting on an article made according to a patent the words "K. & G. Patent Elastic," without the licence of the patentee, it was held to be no defence that "the invention was not a new manufacture."

It may be doubted, says Hindmarch (*f*), whether this protection given to a patentee against the use and imitation of his name, is intended only to apply to acts done during the continuance of his patent-term; or whether it is also to apply to the use and imitation of a patentee's name after the expiration of his privilege. The Act makes it an offence in every person to copy or imitate the name of "any other person who hath or shall have obtained letters patent," &c., and these words seem to be large enough to include the copying or imitating the name of a patentee whose patent has expired. But the preamble of the Act shows that the objects of the Legislature in altering the law touching letters patent were "*as well for the better protecting of patentees in the rights intended to be secured by such letters patent, as for the more ample benefit of the public from the same;*" and it will most probably be found that the intention was that the seventh section should only apply to acts done during the existence of a patent.

Query whether protection only during term of patent.

Proceedings under 5 & 6 Will. IV. c. 83, s. 7, came within the meaning of the statute 31 Eliz. c. 3, s. 5, and were, therefore, required to be commenced within one year after the fact committed, if the action was brought by the patentee or an informer, and within two years if the Crown sued for the penalty (*g*).

Limitation of proceedings.

The statute 5 & 6 Will. IV. c. 83, s. 7, merely gave to patentees a new and penal remedy for a kind of interference with their rights, which was already punishable both at common law and in equity.

Other remedies for fraudulent imitation.

If a person, says Hindmarch (*g*), deceitfully sells articles as of the manufacture of a patentee or of any other person, such an act is a fraud upon the patentee or other person by whom the offender pretends that the articles were manufactured. It does not signify in what manner the offender compasses his purpose—whether by counterfeiting a name, word, mark, or device upon the spurious articles themselves, or upon the envelopes in which they may be wrapped, or by using any other means so as to deceive the

(*e*) 1858, 3 H. & N. 802. In this case it was, however, held to be necessary to prove that the words "K. and G. Patent Elastic" did imitate, and were so put

on by the defendant "with a view of imitating" the mark of the patentee.

(*f*) Page 368.

(*g*) Hindmarch, p. 372.

public, and induce them to purchase goods as the goods of another, when they really are not so.

Action of
deceit.

Two remedies against such offenders were open to a patentee—an action of deceit at common law, and a suit in Chancery for an injunction to restrain the repetition of the fraud.

The form of action was trespass on the case, and the plaintiff was entitled to recover nominal damages upon proof of his cause of action, even if he could not show that he had been deprived of any particular amount of profit by means of the defendant's fraud, or the defendant's articles were as good as his own, or the defendant had not himself actually made any representation at all.

Cases.

Thus in an action on the case against a person for wrapping hones in envelopes resembling those of the plaintiff, no actual damage by means of the deceit was proved, and the jury found that the defendant's hones were not inferior to the plaintiff's; it was held, nevertheless, by the Court of King's Bench, that the plaintiff was entitled to recover nominal damages (*h*).

In the case of *Sykes v. Sykes* (*i*) it appeared that the plaintiff made and sold goods, which he was accustomed to mark with the words "Sykes' patent," and that the defendant (being of the same name as the plaintiff) made and sold to retailers goods which he also marked with the words "Sykes' patent." The declaration charged the defendant with deceitfully selling goods so marked as and for goods of the manufacture of the plaintiff. The defendant did not himself represent the goods to be of the plaintiff's manufacture, but he sold them to retailers for the express purpose of being resold as such. It was held by the Court of King's Bench, on a motion for a new trial, that the declaration had been substantially proved, and a rule *nisi* was refused.

Defects of
action of de-
ceit.

The common law action of deceit, however, was at best an imperfect remedy. The plaintiff could seldom prove the actual extent of the injury which he had sustained so as to enable a jury to award him adequate damages. Nor could he, by an action at common law, prevent the continuance of the fraudulent acts complained of.

Suit for in-
junction.

Under these circumstances, the Court of Chancery lent its extraordinary aid, and a plaintiff was enabled to bring a suit to restrain deceit by injunction (*k*).

(*h*) *Blofield v. Payne*, 1833, 4 B. & Ad. 1783, 3 Doug. 293.
410.

(*i*) 1824, 3 B. & C. 541. Cp. *Southerne v. Home*, 2 Rol. R. 26; *Singleton v. Bolton*,

(*k*) Cp. *Ransome v. Bentall*, 1834, 3 L. J. N. S. Ch. 161; *Knott v. Morgan*, 1839, 2 Keen, 213.

SECT. 2.—UNDER ACT OF 1883.

Under the Patents Act, 1883 (*l*), it is provided 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 for every offence on summary conviction to a fine not exceeding five pounds. Patents Act, 1883, s. 105.

Also that a person shall be deemed to represent that an article is patented if he sell the article with the word "patent," "patented," or any word or words expressing or implying that a patent has been obtained for the article stamped, engraved, or impressed on or otherwise applied to the article. Use of words "patent," "patented," &c.

In *Cheavin v. Walker* (*m*), it was held that the use of the word "patent" along with a representation of the royal arms, as a label on an article made under an expired patent, was a representation that the patent was still subsisting, and disentitled the plaintiff from obtaining an injunction to restrain the wrongful use of the label. A plea that the word "patent" was in fact a trade-mark was overruled. "It is impossible," said Jessel, M. R., "to allow a man who has once had the protection of a patent to obtain a further protection by using the name of the patent as a trade-mark. No man can claim a trade-mark in a falsehood. It is a falsehood to represent that the patent is still subsisting.

The false representation of an expired patent as being still subsisting, would not, however, be an offence under the present Act.

With the question of trade-names and trade-marks we are not concerned in this work (*n*).

The sale of an article as "patented," which is merely the subject of provisional protection, is an offence against the Act (*o*).

Any person who, without the authority of her Majesty, or any of the royal family, or of any government department, assumes or uses in connexion with any trade, business, calling, or profession, the royal arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable, on summary conviction, to a fine not exceeding twenty pounds (*p*). Penalty on unauthorized assumption of the royal arms.

(*l*) Sect. 105.

(*m*) 1877, 5 Ch. D. 863. Cp. *Linoleum Manufacturing Co. v. Nairn*, 1878, 7 Ch. D. 834.

(*n*) See Sebastian on Trade-marks.

(*o*) *Reg. v. Wallis*, 1886, 3 P. O. R. 1; *Reg. v. Crampton*, 1886, *ibid.* 367.

(*p*) Act of 1883, s. 106.

Falsification
of entries in
registers.

Any person who makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders, or causes to be produced or tendered, in evidence any such writing, knowing the entry or writing to be false, shall be guilty of a misdemeanor (*p*).

Summary
proceedings
in Scotland.

In Scotland, any offence under the Act of 1883 may be prosecuted in the Sheriff's Court (*q*).

Isle of Man.

The punishment for a misdemeanor in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding 100%, at the discretion of the court; and any offence committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted (*r*).

Person
improperly
describing
himself as a
patent agent.

After the 1st day of July, 1889, no person is entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act; and if any person knowingly describes himself as a patent agent in contravention of this section, he shall be liable on summary conviction to a fine not exceeding 20%. (*s*).

(*p*) Act of 1883, s. 93.
(*q*) Sect. 108.

(*r*) Sect. 112, sub-sects. 2 and 3.
(*s*) Act of 1883, s. 1.

CHAPTER XVIII.

PROLONGATION OR EXTENSION OF PATENTS (*a*).

SECT. 1. PROLONGATION BY SPECIAL ACT OF PARLIAMENT BEFORE 1835.

SECT. 2. PROLONGATION UNDER THE ACT OF 1835, AND PATENTS ACT, 1883.

SECT. 1.—PROLONGATION BY SPECIAL ACT OF PARLIAMENT BEFORE 1835.

PRIOR to 1835, the term of letters patent could not be extended, except by a special Act of Parliament. The following cases illustrate the kind of circumstances under which a statutory prolongation of a patent could be obtained (*b*).

Before 1835 no prolongation except by special Act.

A patent for an engine for making stone pipes had been granted to one John Juite, in 1734. The undertaking stood still until John Elwick purchased the patent right, and at many thousand pounds' expense improved the engine beyond what it was capable of doing when first invented. An additional term of fourteen years was granted in 1743. (16 Geo. II. c. 25 (*c*)).

Examples of special Acts.

Israel Pownoll had obtained a patent in 1712 for an engine for raising ballast, suttage, and sand, and for removing banks, shelves, and shoals in rivers and harbours, and completed the engine before his death, but afterwards his children, being young, could not work it; and the patent being expired, it was not likely to be brought

(*a*) The Author is indebted to Mr. G. P. Wheeler, Barrister-at-Law, of the Judicial Department, Privy Council, for much information in connection with this subject.

(*b*) Cf. Report, &c., 1829, p. 171; Web. Letts. Pats. p. 19; and 1 P. C. pp. 39, 40.

(*c*) This invention did not succeed.

It was revived under patents, in 1805, by Sir Geo. Wright, and again, in 1810, by a Mr. Murdock. A company was then established, and they made a large quantity of stone pipes for the water-works in Manchester and some in London, but they did not answer, and were taken up. (Report, &c., 1829, *ubi supra*.)

Special Acts. into use without a new grant. It was, therefore, renewed for fourteen years, from 1st August, 1750. (23 Geo. II. c. 33, 1749 (*d*).)

In 1768, William Cookworthy had obtained a patent for England for using Cornish moorstone and Growan clay as materials for making porcelain. It was assigned in 1774 to Richard Campion, who incurred great trouble and expense in perfecting the invention, and could not receive an adequate compensation during the remainder of the term. An additional fourteen years was therefore added to the privilege without altering it in any other respect. A new specification of the mixture and proportion of the materials was to be enrolled, and the Act was not to hinder the use of the said materials except in such mixture and proportions as were so specified. (15 Geo. III. c. 52, 1775.)

A patent for a certain composition, or cement, for England and the colonies, was granted to John Liardet, in 1773. The cement or stucco required to be applied to buildings as soon as it was made, and could not be sent to a distance. Therefore, it could come into use only by degrees, so that the inventor could not at once be recompensed. The term of the patent was extended eighteen years upon the condition that the patentee was not to be allowed to take more than a specified price for the cement. The Act was not to hinder the use of any other cement than that invented by Liardet. Every objection to the cement's not being a new invention, sufficient to invalidate the patent, was to be a bar to any action brought under the Act. The privilege was not to be transferred to more than five persons, and a new specification of the invention was to be enrolled. (16 Geo. III. c. 29, 1766 (*e*).)

David Hartley obtained a patent for England and the colonies in 1773 for his method of applying iron plates to cover the woodwork of buildings and ships, so as to prevent the action of fire; and having expended large sums in experiments to perfect the invention, and still more money being requisite without a prospect of recompense during the term of the patent, the term was prolonged thirty-one years, upon conditions similar to those mentioned in the last case, with a further provision that the invention might be applied in any buildings used in fitting out or victualling

(*d*) Cf. another Private Act, 24 Geo. II. c. 28, 1751.

(*e*) The stucco for the walls of buildings was called "Adam's Oil Cement," because Mr. Adam, the architect, be-

came interested in the patent. In 1778 it was set aside for insufficiency of the specification on a trial: *Liardet v. Johnson*, 1 Web. P. C. 52.

the King's ships of war without licence from the patentee. (17 Special Acts. Geo. III. c. 6, 1777.)

Dr. Edward Bancroft had a patent in 1775 for the use of certain vegetables, growing spontaneously in America, for dyeing, staining, printing, and painting certain valuable colours. Having been deprived of the benefit of his patent by the American war, he was allowed an extension of fourteen years upon the usual terms. (25 Geo. III. c. 38, 1785.)

James Turner had a patent in 1781 for a yellow colour for painting coaches and other works. Owing to secret piracies, from 1787 to 1789, his sale was almost taken from him. He brought one action to trial, and obtained two verdicts therein (a new trial having been granted), also an injunction, but he only gained nominal damages, and was not rewarded for his invention. The term of the patent was extended for eleven years from 24th June, 1792, upon the following conditions: Turner was not to sell the colour at more than 500 guineas per cwt. The Act was not to hinder any person from making any yellow colour which was publicly used before the date of the patent, but only such as was of Turner's invention, and as was described in his specification. Every objection which might have been made to the said yellow colour not being a new invention within the meaning of 21 Jac. I. sufficient to invalidate letters patent, should be a bar to any action brought by virtue of the Act (*f*). The privilege was not to be assigned to more than five persons. (32 Geo. III. c. 72, 1792.)

On March 29th, 1808, the House of Lords made a Standing Order, "That no Bill for the purpose (of extending the terms of letters patent) shall be read a third time in this House, unless it shall appear that the letters patent of which it is intended to extend the term by such Bill, will expire within two years from the commencement of the Session of Parliament in which the application for such Bill shall be made, and unless it shall appear that the application to Parliament for extending the term of the letters patent is made by the person, or by the representatives of the person, who himself originally discovered the invention for which such letters patent were granted by his Majesty; and that the knowledge of such invention was not acquired by such person as

Standing Order, House of Lords, 1808, as to Bills for extension.

(*f*) In a note to this Act in the Appendix to the Parliamentary Report of 1829, it is suggested that this clause was so drawn as to prevent any objections to the form of the specification, the form

being so defective that a verdict had been given against the patentee in 1787: *Turner v. Winter*, 1 Web. P. C. 77; Cf. 35 Geo. III. c. 68, 1795, also 47 Geo. III. c. 131, s. 2.

aforesaid, by purchase or otherwise, from the inventor or owner of the same, or by information that such invention was known and pursued in any foreign country.”

In 1829, Mr. Samuel Crosley applied to Parliament to extend the term of a patent for an improved gas apparatus assigned to him, but granted in 1815 to Mr. Samuel Clegg, the inventor. The Bill was withdrawn after the second reading, because it was found that the Standing Order of the House of Lords in 1808 would have prevented the Bill being read in that House: the prolongation not being for the benefit of the original inventor.

In the same year, however, an Act passed (10 Geo. IV. c. 135) extending for a term of twenty-one years a patent granted to John Stephen Langton for an improved method of seasoning timber and other wood. The patent having ten years of its term unexpired, the passing of the Bill through the House of Lords was contrary to their Standing Order of 1808 (*g*).

SECT. 2.—PROLONGATION UNDER THE ACT OF 1835 AND PATENTS ACT, 1883.

Lord
Brougham's
Act.

The frequency of such applications for statutory assistance suggested the propriety of framing some general measure providing for the extension of letters patent, and Lord Brougham's Act (5 & 6 Will. IV. c. 83, s. 3) was eventually passed. Sect. 4 of that statute declared: “That if any person who now hath or shall hereafter obtain any letters patent as aforesaid (*i.e.*, as grantee, assignee, or otherwise (*h*)), shall advertise in the *London Gazette* three times, and three times in some country paper published in the town where or near to which he carried on manufacture of anything made according to his specification, or near to or in which he resides in case he carried on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town, that he intends to apply to his Majesty in Council for a prolongation of his term of sole using and vending his invention, and shall petition his Majesty in Council to that effect, it shall be lawful for any person to enter a *careat* at the Council office; and if his Majesty shall refer the consideration of such petition to the Judicial Committee of the Privy Council, and notice shall first be

(*g*) Report, &c., 1829; Appendix p. 180.

(*h*) See sect. 1 of this Act at p. 637, Appendix.

by him given to any person or persons who shall have entered such *caveats*, the petitioner shall be heard by his counsel and witnesses to prove his case, and the persons entering *caveats* shall likewise be heard by their counsel and witnesses; whereupon, and upon hearing and inquiring of the whole matter, the Judicial Committee may report to his Majesty that a further extension of the term in the said letters patent should be granted, not exceeding seven years; and his Majesty is hereby authorized and empowered, if he shall think fit, to grant new letters patent for the said invention for a term not exceeding seven years after the expiration of the first term, any law, custom, or usage to the contrary notwithstanding: provided that no such extension shall be granted if the application by petition shall not be made and prosecuted with effect before the expiration of the term originally granted in such letters patent."

Various changes in the procedure here described have been made by subsequent legislation. The judicial committee was empowered by the statute 7 & 8 Vict. c. 69, s. 2, to recommend an extension of the original term of letters patent for a period not exceeding fourteen years where it was shown that the patentee had been unable to obtain a due remuneration for his expense and labour in perfecting his invention, and that an additional term of seven years would not suffice for his reimbursement. Again, the clause in 5 & 6 Will. IV. c. 83, s. 4, requiring a petition for extension to be not only presented, but "prosecuted with effect," before the expiration of the original term, was, owing to the circumstances in the case of *Bodmer's Patent* (i), repealed by 2 & 3 Vict. c. 67.

Amendments
of Lord
Brougham's
Act.

The facts in that case were as follows: An application was made in May, 1838, for an extension of the term of *Bodmer's Patent* for cotton spinning machinery. *Caveats* were entered in July. The case came on before the Privy Council on 17th August, when, according to the rules of practice (k), the opposing party was entitled to four weeks' notice of the hearing for the purpose of preparing evidence. Before the expiration of this month the Privy Council would have closed its sittings. The case was opened, and adjourned to the 29th of November. In the meantime the opposition was withdrawn, but the patent had also expired. It was held that the words "prosecuted with effect" meant that something must have been effected, some conclusion arrived at by the Council

*Bodmer's
Patent.*

(i) 15 Lond. Jour. Arts.

(k) J. C. R. r. 2, *infra*, p. 595.

before the expiration of the patent; and no conclusion having been arrived at, nothing effected, the law did not empower the Council to proceed with the matter further, or the Crown to grant new letters patent for an invention open to the public (*l*).

2 & 3 Vict.
c. 67.

The statute 2 & 3 Vict. c. 67, s. 2—under which Bodmer's Patent was subsequently extended (*m*)—empowered the Privy Council to report in favour of an extension, in spite of failure to prosecute with effect before the expiration of the original term, where such default arose from other causes than the neglect or default of the petitioner. The same section also provided that no extension would be granted upon petitions presented after 30th November, 1839, "unless such petition be presented six calendar months, at the least, before the expiration of such term, nor in any case unless sufficient reason shall be shown to the satisfaction of the said Judicial Committee for the omission to prosecute with effect the said application by petition before the expiration of the said term." Under the Patents Act, 1883, s. 25, letters patent may be extended for seven, or in exceptional cases for fourteen years (*n*), and the petition for extension must be presented at least six months before the expiration of the original term (*o*).

Act of 1883.

The Act of 1883, sect. 25, leaves the law and procedure relating to prolongation practically unaltered. A different term is used in this Act, viz. *extension*, instead of *prolongation*. As, however, sect. 113 saves the rights of all existing patentees, and no prolongation for patents granted under the Act of 1883 can take effect until 1898, it appears that the provisions of sect. 25 are suspended, or at any rate so far suspended as rights or privileges accrued prior to 1st January, 1884, are concerned, for some years to come, notwithstanding the repeal of the statutes regulating the law and practice of prolongation at the time when the Act of 1883 was passed (*p*). This was the opinion of the Judicial Committee in *Brandon's Patent* (*q*). It seems, therefore, clearly proper to speak of *prolongation* and not *extension* until the provisions of sect. 25 come into full force in 1898.

In *Brandon's Patent* (*q*), a petition presented on the 24th May, 1884, for the prolongation of a patent dated the 31st October, 1870, was refused by the registrar as not being presented within six months of the expiration of the patent, as provided by the Act of

(*l*) Web. Letts. Pat. p. 58, n. (*s*);
also 1 Web. P. C. 740.

(*m*) For a term of seven years. The
new patent bore date 18th July, 1840.
1 Web. P. C. 740.

(*n*) Sub-sect. 5.

(*o*) Sub-sect. 1.

(*p*) See schedule to that Act.

(*q*) 1884, 1 P. O. R. 154.

1883, s. 25. The petitioner moved before the Judicial Committee of the Privy Council that the petition might be admitted. "Their lordships," said Lord Watson, in giving the decision of the Judicial Committee, "have come to the conclusion that the petition presented the 24th May, 1884, ought to be received. It is obvious that the petition would not be competently presented if the provisions of sect. 25 applied. But their lordships are of opinion that those provisions do not apply, and that the proceeding falls within the exceptions introduced by the 113th section of the statute of 1883. The provisions of sub-sect. (a) of that section must be read distributively, and so read they declare that the enactments of the new statute shall not affect any patent granted before the commencement of the Act. And they also declare in express terms that those enactments shall not affect any right or privilege which has accrued to the patentee before or at the commencement of this Act. Now the patent which was held by the present petitioner at the passing of this Act of 1883 was an exclusive right to use a certain invention for a definite period of time, but as incidental to that right he had, by virtue of the provisions of the Act 5 & 6 Will. IV., the further privilege of leave to apply for a prolongation of his patent at any time before its expiration, upon such grounds as commended themselves to this board. That right had accrued to him. He was in a position if he had chosen to make the application when the new statute came into force; and their Lordships find it impossible, looking to the precise terms of sect. 113, to hold that that privilege, which was incident to and part of his patent right, was taken away by the provisions of the new Act, or rather they find it impossible to hold that it is not a right included in the express reservation made by sect. 113. They will therefore direct that the petition be received, and the usual procedure followed."

No new rules relating to petitions for prolongation have been made by the Privy Council, and it is understood that it is not intended to alter the existing rules made under 5 & 6 Will. IV. c. 83, so that the practice appears to remain unaltered at present.

Sect. 4 of 5 & 6 Will. IV. c. 83, requires the petitioner to "advertise in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carried on any manufacture of anything made according to his specification; or near to or in which he resides, in case he carried on no such manufacture; or published in the county

Advertisements.

where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town.”

Rule II. of the Judicial Committee Rules provides that “a party intending to apply by petition, under sect. 4 of the said Act, shall, *in the advertisements* (s) directed to be published by the said section, give notice of the day on which he intends to apply for a time to be fixed for hearing the matter of his petition (which day shall be not less than four weeks from the date of the publication of the last of the advertisements to be inserted in the *London Gazette*), and that on or before such day caveats (t) must be entered.”

Caveats.

Where the patentee resides abroad, and the invention is carried on under licenses, the advertisements should be inserted in papers circulating in places where the manufacture is actually carried on (u). “The statute,” said Lord Brougham (u), “provides for two cases, the patentee carrying on a manufactory or residing; but there would be no sense in inserting an advertisement in the *Moniteur* when the man resides in Paris; that would afford no protection to the Queen’s subjects, for whose protection the rule is intended” (u).

To entitle an equitable assignee to appear with the legal assignee of a patent, the name of such equitable assignee must appear in the advertisements with that of his co-petitioner (x). “If the statute requires anything to be done which is not done, the Crown has no power to grant a prolongation” (y).

The petition.

The petition.—The next (z) step is the presentation of a petition (a) to the Queen in Council, praying that the petitioner’s letters patent “may be extended for the further and additional term of fourteen years, or for such other term” as to her Majesty may seem fit.

Time when to be presented.

As we have already pointed out, in *Brandon’s Patent* (b), it appears that the petition need not be presented six months before the expiration of the patent. The old rule prevails, and provided

(s) Before the Judicial Committee Rules were made, it seems that notice of the intention to apply for extension, and of the day on which application would be made to fix the hearing of the petition, were not necessarily included in one advertisement. See *Erard’s Patent*, 1835, 1 Web. P. C. 559, n. (c). For a form of the present advertisement, see Appendix, p. 812.

(t) For form of caveat, see Appendix, p. 813. All persons entering a caveat,

or *creators*, are entitled to be served with the petition, and to appear at the hearing.

(u) *Derosne’s Patent*, 1844, 2 Web. P. C. 2.

(x) *In re Noble’s Patent*, 1850, 7 Moo. P. C. 191.

(y) Per Lord Brougham, *ibid.* p. 194.

(z) See sect. 25, sub-s. 1, *infra*, p. 466.

(a) See *Forms*, Appendix, pp. 816 *et seq.*

(b) 1884, 1 P. O. R. p. 154.

a petition be “*prosecuted with effect*” (c) before the expiration of the term, a petition can be presented at any time before the expiration of the patent. If, however, the petition be not “*prosecuted with effect*” before the end of the term, it appears that unless the petition has been presented six months before the end of the term, the claim to prolongation is lost (d).

The petition should not be presented too long before the expiration of the patent, otherwise it may be ordered to stand over, as the profits accruing in the meantime might materially affect the question of extension (e).

As the recommendation to the Crown for the prolongation of the term of letters patent is a matter of discretion in the Judicial Committee, it is imperative that the petition for such prolongation should state fairly and fully everything relating to the patent, and an omission to do so is *generally* (f) fatal to the application (g). Forms of petition are given in the Appendix (h).

Petition must set out all facts fully and fairly.

A petition was presented for the extension of a patent for a foreign invention, which had been patented in America prior to the date of the English patent. It appeared that the American patent had expired, was subsequently renewed, and would finally come to an end in August, 1876. These facts were not stated in the petition. Extension refused (i).

Cases.

(c) The application for renewal is “*prosecuted with effect*,” within the words of the statute, if the party applying obtains the report of the Judicial Committee before the expiration of the original patent: *Ledsam v. Russell*, 1 H. L. Ca. 687. But the Crown is not restricted as to the time within which it may not act upon such report, and renewed letters patent are not void because they are dated after the expiration of the patent.

(d) See 5 & 6 Will. IV. c. 83, s. 4; 2 & 3 Vict. c. 67, ss. 1, 2, and 7 & 8 Vict. c. 69, s. 2, under which it seems to have been the practice of the Privy Council to allow a petition to be presented at any time.

(e) See *Macintosh's Patent*, 1 Web. P. C. 739.

(f) In *Pitman's Patent*, 1871, L. R. 4 P. C. 84, the Judicial Committee stated that for the future they would invariably act upon the principle that failure to make a full disclosure of everything relating to the patent, the term of which it was desired to extend, e.g., particulars as to foreign patents, should be fatal to a patent. In *Re Hutchinson's Patent* (14 Moo. P. C. 364), material facts showing the title of

the petitioner were disclosed in evidence, which were not stated in the petition for prolongation. The hearing was postponed, and an amendment of the petition allowed. The date of this case, however, was 1861, so that it is not an exception to the rule in *Pitman's Patent*, which was laid down in 1871. But in *Reece's Patent* (Eng. Rep. January to March, 1881, XIV.), a petitioner who had, in ignorance of the Privy Council's rule, omitted in his petition to give the proper information as to his foreign patents, was allowed, on application made before the hearing, to correct the omission by adding a supplementary paper. This does not, however, contravene the decision in *Pitman's Patent*, as the petition was amended before the case came on, *vide Adair's Patent*, 1881, L. R. 6 App. Cas. 176, at p. 180.

(g) In *re Pitman's Patent*, 1871, *ubi sup.*; In *re Johnson's Patent*, 1871, L. R. 4 P. C. 83; *cp. also In re Clark's Patent*, 1870, L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 265; In *re Horsey's Patent*, 1884, 1 P. O. R. 225.

(h) At pp. 816 *et seq.*

(i) In *re Pitman's Patent*, 1871, *ubi sup.* “It is desirable that those who

A petition was presented nominally by one company, but really was for the benefit of another company, to which the shares of the former had been transferred. No statement of the fact appeared in the petition, and the real facts were only brought forward by the Attorney-General. Petition dismissed (*h*).

A limited company, who were the registered assignees of *Horsesey's Patent* (No. 3145 of 1870), presented a petition for the prolongation of the term of such patent. The company consisted mainly of seven persons, to whom a share each was given, to enable the requirements of the Joint Stock Companies Act to be literally complied with, but the only persons really interested were the patentee and a creditor of his for money borrowed. These facts were not stated in the petition. Held, that the requisite good faith had not been observed by the petitioners, and the prayer of the petition must, therefore, be refused (*i*).

One of several joint patentees carried on the manufacture of the patented article in combination with the manufacture of other articles. No allusion to that fact was made in the petition, nor was there any intimation in the accounts that any other manufacture excepting that of the patented article was so carried on. Extension refused (*j*).

Who may be petitioner.

A petition for extension may be presented by any person *who is for the time being entitled to the benefit* of the patent, the term of which it is sought to extend. Under the clause in italics, which is the definition of "patentee" given by sect. 46 of the Patents Act, 1883, the following persons may petition for extension:—

The patentee.

1. The *original patentee*, whether inventor or merely importer of the patent. The merit of an importer, however, being less than that of an inventor (*k*), the Judicial Committee regards such applications with jealousy, and will carefully consider the merit of the invention imported (*l*).

come to oppose a patent should know the precise circumstances and the possible conditions on which a renewal was granted, and therefore it does appear to their Lordships that this was eminently a case in which the suggestions of Mr. Archibald in *Re Johnson's Patent* (1871, L. R. 4 P. C. 75), approved by their Lordships, should have been followed, and that there should have been a full disclosure of all the circumstances relating to the American patent": per Sir J. W. Colville. Cp. *Adair's Patent*, 1881, L. R. 6 A. C. 176. The remuneration which a patentee has obtained from foreign patents, as

well as from his English patent, should be stated.

(*h*) *Reece's Patent*, Eng. Rep. January to March, 1881, XIV.

(*i*) *Re Horsesey's Patent*, 1884, 1 P. O. R. 225.

(*j*) *In re Yates and Kellert's Patent*, 1887, L. R. 12 App. Cas. 147.

(*k*) *Soames' Patent*, 1843, 1 Web. P. C. at p. 733; *Johnson's Patent*, 1871, L. R. 4 P. C. 75; *Pitman's Patent*, 1871, L. R. 4 P. C. 84; *Adair's Patent*, 1881, L. R. 6 A. C. 176.

(*l*) *Claridge's Patent*, 1851, 7 Moo. P. C. 394; cp. *Bell's Patent*, 1846, 2 Web. P. C. 159.

A petition was presented for the extension of the term of a patent imported from abroad. The importers had embarked a large capital upon machinery in trying to introduce it to general use, and incurred considerable loss in so doing. Extension of letters patent for six years granted (*m*). Illustrative cases.

C. imported an invention from Paris, patented it in England, and assigned it for 8,000*l.* to a joint stock company, whose trustees petitioned for an extension on the ground that the company had expended 23,000*l.* in carrying out the invention, and that the profits made had not compensated for the losses incurred. In delivering judgment, Sir John Jervis said: "Each case must be dealt with according to its own particular circumstances, and their Lordships have looked at this case as to the merits of Claridge as the inventor according to the strict meaning of that word. He introduces, not a piece of complicated machinery, or a manufacture of difficulty or science, but something in general use at Paris. . . . He does obtain a patent, and forms a joint stock company, and receives 8,000*l.* for the introduction of a well-known substance from a foreign land; so far as he is concerned, he has had adequate satisfaction for any merits he had in the introduction. We must take this case upon the basis of the original importer's merit, taking into consideration that those who now apply entered into a commercial speculation with a full knowledge of all the circumstances, and with the expectation of a profit, which, if they have not got, is no reason to entitle them to call upon us to grant this application" (*n*).

2. The executor (*o*) or administrator (*p*) of a deceased patentee. Executor, &c.

Where it appears on the face of a petition presented by the equitable owner of the patent of which extension is desired, that the legal personal representative of the patentee may possibly have an interest in the patent, such legal personal representative will be added as a co-petitioner.

A petition was presented for the prolongation of a patent by C., a son of the patentee, who had acquired an interest in the patent for the benefit of his mother and sisters from L., to whom it had been assigned by the trustee in liquidation of the patentee. The patentee had, up to his death, worked the patent under a verbal agreement with L., that L., when he had been paid

(*m*) *In re Berry's Patent*, 1850, 7 Moo. P. C. 187.

(*n*) *Claridge's Patent*, 1851, 7 Moo. P. C. 394.

(*o*) Cp. *In re Bodmer's Patent*, 1849, 6 Moo. P. C. 469.

(*p*) *In re Downton's Patent*, 1839, 1 Web. P. C. 565; *In re Heath's Patent*, 1853, 2 Web. P. C. 247.

500%. out of profits, would settle the patent on a member of the patentee's family. The patentee had paid 300% at the date of his death, and C. paid 200% subsequently. The patent was handed over to C., but no assignment was executed by L. The Judicial Committee intimated that the legal personal representative of the patentee ought to be a party to the petition, which was amended accordingly (r).

Assignees.

3. Assignees.

The power of the Crown to extend letters patent is not confined to *grantees*, but extends to *assignees*; and such renewed letters patent, granted to the assignee, were good by the statute 5 & 6 Will. IV. c. 83, independently of the express provision in 7 & 8 Vict. c. 69, s. 4 (s).

The following extract from the judgment of Lord Romilly, M. R., in *Norton's Patent* (t), shows very clearly the considerations which guide the Court in dealing with applications for extension on the part of assignees:—"It must always be borne in mind that the assignee of a patent does not, unless under peculiar circumstances, apply on the same favourable footing that the original inventor does. The ground that the merits of the inventor ought to be properly rewarded in dealing with an invention which has proved useful and beneficial to the public, does not exist in the case of an assignee, unless the assignee be a person who has assisted the patentee with funds to enable him to perfect and bring out his invention, and has thus enabled him to bring it into use."

Another view of the principle on which applications on the part of assignees are entertained by the Judicial Committee was given by Lord Brougham in *Morgan's Patent* (u):—"Their Lordships have always been used to consider that by taking into their view and favourably listening to the application of the assignee, they are, though not directly, yet mediately and consequentially . . . as it were, giving a benefit to the inventor; because, if the assignee is not remunerated at all, it might be said that the chance of the patentee of making an advantageous conveyance to the assignee would be materially diminished, and, consequently, his interest damnified. For this reason, consideration has been given to the claims of the assignee who has an interest in the patent."

(r) *In the matter of Willacy's Patent*, 1888, 5 P. O. R. 690.

(s) *Russell v. Ledsam*, 1845, 14 M. & W. 574; judgment affirmed in Exch. Ch. 16 M. & W. 633; and in H. of L.

1 H. L. Cas. 687.

(t) 1863, 1 Moo. P. C. N. S. 339; 11 W. R. 720.

(u) 1843, 1 Web. P. C. 737.

It will be found that all the recorded successful applications, on the part of assignees, for the extension of letters patent, can be justified by reference to one or other of the principles stated in the extracts above quoted—the benefit of the public, and the benefit of the inventor. General principle.

A joint stock company purchased a patent for a sum of money paid to the patentee, and the allotment to him of a number of paid-up shares, and spent a large amount of money in a *bonâ fide* endeavour to bring the invention, which was highly meritorious, into public use, without profitable result either to the patentee or to themselves. Extension granted (*x*). Illustrative cases.

The assignees of a patent for improvements in machinery petitioned for extension. The invention was of great commercial value, and the petitioners had embarked a large capital in bringing the patent into use, but the machinery was expensive, and heavy losses had been sustained. Extension granted (*y*).

Petitioners were a company who bought a patent and made a considerable sum of money by selling their shares at a premium on the Stock Exchange. Extension was refused, on the ground that the petitioners had taken over the invention as a speculative undertaking, and not for the purpose of benefiting the public (*z*).

A company bought a patent for the purpose of trading with it, and not for any purpose by means of which any benefit could come to the original inventor, who had not only parted with all interest in it, but had died since the assignment. Extension refused (*a*).

An assignee petitioning for the extension of the term of a patent was required to secure to the inventor an annuity (*b*), or a share of the profits (*c*).

(*x*) *Houghton's Patent*, 1871, L. R. 3 P. C. 461.

(*y*) *Berry's Patent*, 1850, 7 Moo. P. C. 187. Lord Brougham said in this case, "The patent law is framed in a way to include two species of public benefactors: the one, those who benefit by their ingenuity, industry, and science, and invention and personal capability; the other, those who benefit the public without any ingenuity or invention of their own, by the importation of the results of foreign invention. In this case certain parties have, by their adventurous spirit and by the outlay of capital, benefited the public in proportion of the value of the foreign invention in question, which, but for that adventurous spirit and outlay of capital, would not

have been available to the people of this country. That, therefore, is to be considered as a solid claim to the exercise of the *quasi* legislative power which the statute vests in this Commission."

(*z*) *Sillar's Patent*, 1882, Goodeve, P. C. 581; *ep. also Electric Telegraph Co.*, per Lord Langdale, M. R., cited in Goodeve, P. C. 554.

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

(*b*) *Whitehouse's Patent*, 1833, 1 Web. P. C. 476; *Markwick's Patent*, 1860, 13 Moo. P. C. 310; *Russell v. Ledson*, 1845, 14 M. & W. 574.

(*c*) *Hardy's Patent*, 1849, 6 Moo. P. C. 441; *Morton's Patent*, Eng. Rep. April to June, 1881, VII.

Assignees petitioned for the extension of a patent. The patentee had parted with his interest for a large sum of money. Extension granted to the assignees without conditions (*d*).

When petition
to be pre-
sented.

Under the Act of 1883, the petition for extension must be presented at the Privy Council Office at least six months before the time limited for the expiration of the patent (*e*). The right, however, to present, under Lord Brougham's Act, a petition for the prolongation of a patent at any time before the expiration of the patent, is a right or privilege accrued under those enactments, and is, therefore, saved by sect. 113 of the present Act, in the case of patents existing at its commencement (*f*). In such cases the old law still prevails, and the petition for prolongation may be presented at any time, provided that it is prosecuted with effect during the existence of the patent.

By the Rules the petition must be presented within one week from the insertion of the last of the advertisements required to be published in the *London Gazette* (*g*).

Affidavit of
advertise-
ments.

All petitions must be accompanied with affidavits of advertisements having been inserted according to the provisions of Lord Brougham's Act, sect. 4, and the 1st and 2nd of the Rules of the Judicial Committee (*h*).

There is no affidavit verifying the petition; the evidence in support of the petition is given at the hearing.

On or before the day fixed for that purpose in the advertisements (*i*), any person may enter at the Council Office a caveat (*k*) addressed to the Registrar of the Council, against the extension prayed for in the petition (*l*).

Interest of
opponent.

There is no requirement of interest in an opponent to the prolongation of letters patent, such as exist in the case of opposition to the grant of patents (*m*), or the amendment of specifications (*n*).

An alien resident abroad, who was interested in an English patent by a foreign inventor, and who had also considerable dealing in this country in respect of sales of the patented machine, and in granting licences for the use of such patent, was held, under the circumstances, to have such a *locus standi* as would entitle him to

(*d*) *Bodmer's Patent*, 1849, 6 Moo. P. C. 468; *Napier's Patent*, 1861, 13 Moo. P. C. 543.

(*e*) Patents Act, 1883, s. 25, sub-s. (1).

(*f*) *Brandon's Patent*, 1884, 1 P. O. R. 154.

(*g*) J. C. Rules, Rule III., *infra*.

(*h*) J. C. Rules, Rule IV.

(*i*) J. C. Rules, Rule II.

(*k*) See Form, Appendix, p. 813.

(*l*) Patents Act, 1883, s. 25, sub-s. (2).

(*m*) *Ibid.* s. 11, sub-ss. (1), (3).

(*n*) *Ibid.*, s. 18, sub-ss. (2), (4).

oppose the extension of an English patent which would interfere with that in which he was interested (*o*).

The caveat must be entered in the name of the opponent himself, and not in that of a patent agent (*p*). Every person entering a caveat is entitled to be served with a copy of the petition for prolongation, and no application to fix a time for hearing is allowed to be made without an affidavit of such service being produced. All parties served with petitions are required to lodge at the Council Office, within a fortnight after such service, notice of the grounds of their objections (*q*).

Grounds of objections.

Under the repealed Acts, it was unnecessary for an opponent to the prolongation of letters patent to give particulars of the objections on which he proposed to rely. It was sufficient to state generally the grounds of objection (*r*). The present Act contains no provision altering this practice, and in a recent case (*s*) successful opposers were permitted to give evidence of an instance of prior user not stated in the particulars, but their costs were disallowed.

The Attorney-General, on behalf of the Crown, is entitled to give evidence of objections to the extension of a patent irrespective of the particulars (*t*).

A party applying for the extension of letters patent must give four weeks' notice of the time appointed for the hearing to any person who has entered a caveat against such extension (*u*); and, according to the usual practice of the Judicial Committee, is required to advertise the day fixed in the *London Gazette*, and in two other newspapers named in the order (*x*).

Not less than a week before the day fixed for hearing the application, the petitioner must lodge at the Council Office six printed copies of the specification, and also four copies of the balance-sheet of expenditure and receipts relating to the patent in question (*y*).

In the event of the applicant's specification not having been printed, and if the expense of making six copies of any drawing therein contained or referred to would be considerable, the lodging of two copies only of such specification will be deemed sufficient (*z*).

(*o*) *In re Schlumberger's Patent*, 1853, 9 Moo. P. C. 1.

(*p*) *Lowce's Patent*, 1852, 8 Moo. P. C. 1.

(*q*) J. C. Rules, Rules V. and VI. For forms of objections, see Appendix, pp. 837, 838.

(*r*) *Ball's Patent*, 1879, L. R. 4 App. Cas. 171.

(*s*) *Stewart's Patent*, 1886, 3 P. O. R. 7.

(*t*) *Ball's Patent*, *ubi supra*; *Stewart's Patent*, 1886, 3 P. O. R. 7; *Church's Patent*, 1886, 3 P. O. R. 101.

(*u*) J. C. Rules, Rule II.

(*x*) Lawson, p. 444.

(*y*) It has of recent years been customary to lodge eight copies of the balance-sheets.

(*z*) J. C. Rules, Rule IX.

In *Re Bell's Patent* (a), an unintentional omission to comply with the above rule as to copies of the specification was not held to be fatal; but the Judicial Committee intimated that their leniency upon this occasion must not be used as a precedent, and their lordships may refuse to go into accounts which have not been filed within the prescribed time (b).

The hearing.

The Hearing.—Under 7 & 8 Vict. c. 69, s. 8, the Judicial Committee may appoint one of the clerks of the Privy Council to take any formal proofs required to be taken in dealing with the matter before them, and may proceed on the clerk's report as if the proofs had been taken by the Committee itself. This section was not repealed by the Patents Act, 1883. Under the 28th section of the Patents Act, 1883, the Judicial Committee may call in the aid of an assessor specially qualified (sub-sect. 2), may try the case wholly or partially with the assistance of such assessor (sub-sect. 1), and may determine his remuneration, which is to be paid in the same manner as the other expenses of the execution of the Act. (Sub-sect. 3.)

At the hearing, the petitioner and any parties opposing may appear either by themselves or by counsel.

The Attorney-General, in accordance with a rule laid down by the Judicial Committee in *Erard's Patent* (c)—the first application for extension under 5 & 6 Will. IV. c. 83—always appears to watch, on behalf of the Crown and the public, the progress of extension petitions, whether opposed or not, and is entitled to set forth his views, although no caveat has been entered (d).

In *Pettit Smith's Patent* (d), an application by the Lords of the Admiralty to enter a caveat and be heard against the petitions, such caveat not having been filed within the time required by the rules, was refused, on the ground that the Attorney-General represented the interests of the Crown as well as those of the public.

Unless parties opposing have distinct and separate interests, not more than two counsel will be heard upon either side (e).

Subject to two qualifications, viz., that the advertisements must be proved first in the case (f), and that when the accounts are *prima facie* unsatisfactory, the petition will be dealt with

(a) 1846, 2 Web. P. C. 159.

(b) *Chatwood's Patent*, 1873, L. R. 5 P. C. 88, n.; and *Johnson and Atkinson's Patent*, 1873, L. R. 5 P. C. 87.

(c) 1835, 1 Web. P. C. 557, n. (a); and see *Whitehouse's Patent*, 1838, *ibid.* p. 474.

(d) *Pettit Smith's Patent*, 1850, 7 Moo. P. C. 133.

(e) *In re Woodcroft's Patent*, 1841, 3 Moo. P. C. 172, n.

(f) *Perkin's Patent*, 1845, 2 Web. P. C. 8.

without reference to the merits (*g*), the Judicial Committee follows as closely as possible the rules of evidence in courts of law (*h*).

The Grounds of Extension.—It is thought that the law bearing upon the subject is accurately stated in the following propositions:—

Grounds of extension.

I. *As regards the extension of letters patent, the Judicial Committee consider that they represent the legislature to a certain degree, and that they are invested with somewhat similar powers of discretion to those exercised formerly by parliament (i).*

Position of Judicial Committee.

The extension of letters patent has never been granted as a matter of course (*k*).

The Judicial Committee have, as a general rule, recommended an extension of the term of letters patent on grounds similar to those adopted by the legislature, and recited in the old acts of prolongation (*l*).

But it has never been their course to put themselves precisely in the situation of the legislature, and never to grant an extension in a case where an Act of Parliament would not have been obtained (*m*). Lord Brougham's Act was passed with the view of providing a remedy easier and cheaper than a petition to parliament, and better in this respect, that it took account of cases which never would have prevailed on the legislature to make a new personal law prolonging the monopoly, but meritorious enough as regards the individual, beneficial enough as regards the public, and deficient enough in remuneration, to justify interference (*n*).

II. *In considering their decision, their lordships 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 (o).*

Nature and merits of invention, &c.

The Patents Act, 1883, sect. 25, sub-sect. (4), from which this proposition is taken, does not alter in this respect the practice of the Judicial Committee under the repealed Acts (*p*).

(*g*) *Saxby's Patent*, 1870, L. R. 3 P. C. 292; 7 Moo. P. C. N. S. 82; *In re Clark's Patent*, 1870, *ibid.* 255.

(*h*) *Erard's Patent*, 1835, 1 Web. P. C. 557, n. (*a*).

(*i*) *In re Morgan's Patent*, 1843, per Lord Brougham, 1 Web. P. C. 739; *op. Erard's Patent*, 1835, 1 Web. P. C. 557, n. (*a*); *In re Soames' Patent*, 1843, 1 Web. P. C. 733; *Perkin's Patent*, 1845, 2 Web. P. C. 18.

(*k*) *In re Jones' Patent*, 1840, 1 Web.

P. C. 579; *In re Derosne's Patent*, 1844, 2 Web. P. C. 4; *In re Honiball's Patent*, 1855, 9 Moo. P. C. 393; *Cardwell's Patent*, 1856, 10 Moo. P. C. 490.

(*l*) 1 Web. P. C. 557, n. (*a*). See also above, pp. 373 *et seq.*

(*m*) *In re Morgan's Patent*, *ubi supra*.

(*n*) *In re Soames' Patent*, *ubi supra*.

(*o*) Patents Act, 1883, s. 25, sub-s. (4).

(*p*) *Newton's Patent*, 1884, L. R. 9 App. Cas. 592.

What petitioner must prove.

Invention meritorious.

The petitioner for the prolongation of letters patent is bound to prove—(a) that the invention is meritorious; (b) that everything in the power of the parties interested has been done to bring out the invention, and to turn it to advantage; and (c) that owing to circumstances beyond his control, he has been unable to obtain an adequate remuneration (*q*).

(a) It is, of course, impossible to define strictly the degree of merit which will induce the Judicial Committee to extend the term of a patent. A few leading principles may, however, be referred to with advantage.

The ordinary merit, which would sustain a patent in the first instance, is not sufficient to justify an extension of the term (*r*).

“The law presumes some merit in a patent by the mere granting of it,” said Sir William Grove in the case of *Stoney's Patent* (*r*); “in practice very little merit will do, and I do not know that the . . . law officers of the Crown, who advise the Crown, go into merit, in the sense in which it is used in this Board, further than seeing that the invention, or alleged invention, is not an absurd one. The theory, therefore, of patents is that they are granted *ex mero motu* by the Crown, on the recommendation of the legal advisers of the Crown, upon *prima facie* novelty and *prima facie* merit. But, to induce the lords of the Privy Council to extend a patent, there must be something more than that; in other words, there must be more merit than would merely support a patent in a court of law.”

In the word “merit,” as used in this connection, two distinct ideas seem to be involved—the exercise of invention or ingenuity on the part of the patentee, and the utility of the invention to the public.

These two elements are not, however, of equal importance. A patent for an invention which was “very small in point of discovery,” but useful and of great benefit to the public, may be extended (*s*).

On the other hand, the Judicial Committee would probably refuse an extension of letters patent for a comparatively worthless or trivial invention, however ingenious (*t*). It has already been shown (*u*) that the importer of a highly meritorious invention may petition successfully for the prolongation of letters patent which he

(*q*) *Markwick's Patent*, 1860, 13 Moo. P. C. 313.

(*r*) *Stoney's Patent*, 1888, 5 P. O. R. at p. 521, per Sir William Grove; *Swaine's Patent*, 1837, 1 Web. P. C. 559.

(*s*) *Derosne's Patent*, 1844, 4 Moo. P. C. 416; *Beanland's Patent*, 1887, 4 P. O. R. at p. 491, per Lord Hobhouse.

(*t*) *Beanland's Patent*, *ubi supra*.

(*u*) See *supra*, pp. 382, 383.

has obtained for it, and that the Judicial Committee will also recognize the claims of an assignee who has incurred expense in bringing a useful patent into public use.

Upon the same principle, it is not the person who merely displays ingenuity in throwing out the idea of the possibility of doing a thing, but the person who follows out that suggestion, and after repeated experiments gives it a practical application, that is the real benefactor to the public, and possesses that description of merit which constitutes one of the grounds for extending the term of a patent (*v*).

The following considerations do not weigh against the merit of an invention :—

Circumstances which do not weigh against merit.

That only a small step was made in advance of existing knowledge—the whole history of science being a continued illustration of the slow progress by which the human mind makes its advance in discovery (*x*).

That such improvements on the original invention had been made *by the patentee* (*y*) that no person would after these ever think of using the invention as it originally stood; if such an argument were to prevail, any improvement made by the patentee upon the patent would at once take away the patentee's right to obtain an enlargement of the term (*z*).

That the patentee's invention consisted of improvements upon a former patent taken out by him in consequence of a communication from abroad—such improvements being novel and of public utility (*a*).

That the working of the invention under the original patent has been altered during the term (*b*).

The following circumstances weigh against the merit of an invention :—

Circumstances which do.

That it has not been brought into public use (*c*). The presumption arising from non-user will be considered in dealing with the duty of a patentee to employ every means of making his invention a commercial success.

(*v*) *In re Bell's Patent*, 1862, 7 L. T. N. S. 577; 1 Moo. P. C. 49, 61; cp. *Woodcroft's Patent*, 1846, per Lord Brougham, 2 Web. P. C. at p. 23.

(*x*) *Soames' Patent*, 1843, 1 Web. P. C. 735.

(*y*) *Aliter*, where the invention in its improved form was imported by persons other than the petitioner. *Woodcroft's Patent*, 1841, 1 Web. P. C. 740.

(*z*) *Galloway's Patent*, 1843, 1 Web.

P. C. at p. 727. The original invention must, however, have possessed utility. *Bell's Patent*, 1846, 2 Web. P. C. 160.

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

(*b*) *Heath's Patent*, 1853, 2 Web. P. C. 257.

(*c*) *Allan's Patent*, 1867, L. R. 1 P. C. 507; *Normand's Patent*, 1870, L. R. 3 P. C. 193.

That it would exclude the public from the use of well-known sanitary agents. This may seem a somewhat special issue to take notice of, but it has been raised in several cases, of which *Sillar's Patent* (*d*) may be taken as an instance. Here, an extension of the patent would have prevented any members of the public from using alum, clay, and charcoal in stated proportions for the purpose of deodorizing manure. The petition was dismissed. "The question," said Sir Barnes Peacock, delivering the judgment of the Judicial Committee, "is whether this patent is of such utility as to justify the renewal of the patent, excluding the public, upon this general specification, from the use of those ingredients for the purpose of deodorizing sewage, the use of two of those ingredients, viz., alum and charcoal, being well-known."

Everything done to bring invention into use.

(b) Where a patentee has *intentionally delayed* for a length of time attempting to put his invention into practice, an extension will not be recommended, unless he can show some reasonable excuse, such as want of funds, for the delay (*e*).

The fact that a patent, *in spite of the efforts of the patentee*, has not come into public and general use, raises a strong presumption against its utility (*f*). But in all cases where the utility of a patent has not been tested by actual employment, the question to be considered is whether the evidence was sufficient to rebut the presumption arising from its non-use, that the invention is one of no practical utility (*g*).

This presumption may, however, be rebutted by such evidence as the following:—

That, from the nature of the invention, it would not be likely to come into immediate use, or was only capable of being employed to a limited extent (*h*).

Illustrative cases.

An application on behalf of a patented knapsack was supported by very favourable reports from officers who had examined it. It was deposed that the fact of nine out of ten men in our infantry

(*d*) 1882, *Goodere's Patents*, 581; cp. *McDougal's Patent*, 1867, L. R. 2 P. C. 1; 5 Moo. P. C. N. S. 1; *McInnes' Patent*, 1868, L. R. 2 P. C. 54; 5 Moo. P. C. N. S. 78.

(*e*) *In re Cardwell's Patent*, 1856, 10 Moo. P. C. 488; cp. *Wright's Patent*, 1839, 1 Web. P. C. 575; *Southworth's Patent*, 1837, 1 Web. P. C. 486.

(*f*) *Wright's Patent*, 1839, 1 Web. P. C. 575; *Simister's Patent*, 1842, 4 Moo.

P. C. 164; *Bakewell's Patent*, 1862, 15 Moo. P. C. at p. 386; *Allan's Patent*, 1867, L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 443; *Herbert's Patent*, 1867, 4 Moo. P. C. N. S. 300; *Hughes' Patent*, 1879, 4 A. C. 174.

(*g*) *Hughes' Patent*, 1879, 4 App. Ca. p. 174.

(*h*) *Jones' Patent*, 1840, 1 Web. P. C. 577.

becoming flat-chested was to be attributed to the one in ordinary use. Some hundreds had been expended on it by the patentee, but hitherto without return. The committee, allowing their doubt as to its utility, arising from its not having been adopted by the Government, to be slightly founded, in the absence of evidence of its failure, recommended its extension for five years (*i*).

A patentee presented a petition for prolongation of his patent "improvements in sluices and flood-gates." He satisfied the Judicial Committee that his invention was meritorious, but was, from its nature, only capable of being employed to an occasional or limited extent. Ten years' extension granted (*j*).

That, from circumstances beyond the control of the patentee, the merits of the patent had not been appreciated (k).

(1) A patent for preserved meats was extended for five years on the grounds that the patentee had used every exertion in his power to introduce the invention, and had expended large sums in so doing, but by reason of the distrust with which the public viewed preparations of that nature, the inadequacy of the patentee's means, and his want of influence with public boards, he had been prevented from obtaining such a fair trial as would lead to the adoption by the public of his invention (*l*).

Illustrative cases.

(2) The patentee of an invention, which had never been brought into public use during the period of fourteen years, accounted for the non-user on the ground that the invention was of such a nature that it could only be carried out by a company, which he had failed to form. It was held that the explanation was not sufficient to rebut the presumption against the practical utility of the patent, and an extension of the term was refused (*m*).

(3) The patentee of a captain's bridge, constructed as a self-launching life-raft, petitioned for prolongation on the ground that, owing to illness and other circumstances beyond his control, he had not been adequately remunerated. It was proved that for nearly eight years he had been practically incapacitated for business in consequence of a railway accident. The invention had been awarded prizes at exhibitions, but had never been brought into actual use. Extension for seven years was granted (*n*).

(i) *Berrington's Patent*, 1852, cited by Coryton, p. 225.

(j) *Stoney's Patent*, 1888, 5 P. O. R. 520.

(k) *Kollman's Patent*, 1839, 1 Web. P. C. 564.

(l) *Payne's Patent*, 1854, cited in Higgins' Digest, p. 266.

(m) *Bakewell's Patent*, 1862, 13 Moo. P. C. 385.

(n) *Roper's Patent*, 1887, 4 P. O. R. 201.

(4) The introduction of a patent for the improvement of the spinning jenny was violently resisted by the trade, so that the patentee received no adequate remuneration during the term. Extension granted for seven years (*o*).

(5) Extension has been granted when a patentee or his assignee has been prevented by necessary litigation from reaping his reward during the original term (*p*). Disputes between the co-owners of a patent will not justify the failure of a petitioner for extension to bring the invention into public use (*q*). Negligence on the part of a patentee in restraining infringement is a good ground of opposition for extension (*r*).

That he has at all times been ready to give the public the benefit of his invention (s).

That the circumstances have ceased which prevented the patent from being lucrative, and that it is really coming into use (t).

Remuneration insufficient (*u*).

(c) A petitioner for the prolongation of letters patent must satisfy the Judicial Committee that, regard being had to all the circumstances of the case, he has not received a remuneration adequate to the merit of his invention, and the time and money he had properly expended in working it (*v*).

The chief difficulty which the petitioner has to overcome is to present accounts showing, in a manner which admits of no controversy, the amount of remuneration which in every point of view the invention has brought to him (*w*).

It is not for the Judicial Committee to send back the accounts for further particulars, nor to dissect the accounts for the purpose of surmising what might be their real outcome if they were differently cast; it is for the applicant to bring his accounts before the committee in a shape which will leave no doubt as to what the remuneration has been that he has received (*w*). In

(*o*) *Robert's Patent*, 1839, 1 Web. P. C. 573: *cp. Stafford's Patent*, 1838, 1 Web. P. C. 563.

(*p*) *Pettit Smith's Patent*, 1850, 7 Moo. P. C. 133; *Heath's Patent*, 1853, 2 Web. P. C. 133.

(*q*) *Patterson's Patent*, 1849, 6 Moo. P. C. 469.

(*r*) *Simister's Patent*, 1841, 1 Web. P. C. 724.

(*s*) *Stewart's Patent*, 1886, 3 P. O. R. 7, 10.

(*t*) Per Lord Brougham in *Woodcroft's Patent*, 1846, 2 Web. P. C. 29. In *Foarde's Patent*, 1855, 9 Moo. P. C. 376, it was held that the fact of an Act of Parliament having passed which would

compel the use of the petitioner's patent formed no objection to a renewal of the term, the merits of the invention and loss incurred in carrying it out being established.

(*u*) Forms of account in a recent case, which were considered satisfactory by the Judicial Committee, are given in the Appendix, pp. 821 *et seq.*

(*v*) *Bate's Patent*, 1836, 1 Web. P. C. 739; *Southwether's Patent*, 1837, 1 Web. P. C. 486; *Downton's Patent*, 1839, 1 Web. P. C. 565; *Derosne's Patent*, 1844, 2 Web. P. C. 1; *Nussey and Leachman's Patent, Itc*, 1890, 7 P. O. R. 22.

(*w*) *Saxby's Patent*, 1670, per Lord

one or two cases (*x*) the hearing of a petition has been adjourned to enable a petitioner to produce better evidence as to his profits, but this was merely an exceptional indulgence, and in all probability would not again be allowed (*y*).

The following cases illustrate the modern practice of the Judicial Committee in dealing with imperfect accounts:—

Practice as regards imperfect accounts. Foreign patents.

The accounts of a petitioner were silent in reference to receipts and expenditure in respect of foreign patents for the same invention, although the attention of the petitioner had been called to the omission in a notice of objection delivered by opponents. The Judicial Committee refused an adjournment and dismissed the petition (*z*).

The statement of the remuneration received by a petitioner was, on the face of the petition and accounts filed, unsatisfactory. Petition dismissed, without reference to the merits of the invention (*a*).

The most unreserved and clear statement of the patentee's remuneration is an indispensable condition in an application for extension (*b*). The actual expenses and receipts must be shown; it is not sufficient to show generally that there has been no profit (*c*).

Full and unreserved statement of profits.

The applicant must show what profits have been derived from any foreign patents he may have for the invention (*d*), and also from sales for exportation (*e*).

The profits derived by licensees from the working of the patent should also appear in the accounts of a petitioner for prolongation (*f*).

Licensees.

Cairns, 7 Moo. P. C. N. S. at p. 85. The balance sheet should be handed over to the solicitor for the Treasury before applications for extension are heard. *Perkin's Patent*, 1845, 2 Web. P. C. at p. 14, per Lord Campbell.

(*x*) *Perkin's Patent*, 1845, 2 Web. P. C. at p. 17; *Heath's Patent*, 1853, 2 Web. P. C. at p. 256.

(*y*) *Clark's Patent*, 1870, 7 Moo. P. C. N. S. 255.

(*z*) *Newton's Patent*, 1884, 1 P. O. R. 177.

(*a*) *Clark's Patent*, *ubi supra*; *Houghton's Patent*, 1871, 7 Moo. P. C. N. S. at p. 311, per James, L. J. The statement of accounts being *prima facie* satisfactory, the petitioners may be allowed to prove the merits of the invention before going into the accounts.

S. C., at p. 309; *Wield's Patent*, 1871, 8 Moo. P. C. N. S. 300; *Johnson's and Atkinson's Patents*, 1873, L. R. 5 P. C. 87; *Willacy's Patent*, 1888, 5 P. O. R. 590.

(*b*) *Hill's Patent*, 1863, 9 L. T. N. S. 101; 1 Moo. P. C. N. S. 258; *cp. Bett's Patent*, 1861, 1 Moo. P. C. N. S. 49.

(*c*) *Quarrill's Patent*, 1840, 1 Web. P. C. 740.

(*d*) *Johnson's Patent*, 1871, L. R. 4 P. C. 75; 3 Moo. P. C. N. S. 291, dissenting from *Poole's Patent*, 1867, 4 Moo. P. C. N. S. 452; *Adair's Patent*, 1881, L. R. 6 A. C. 178; *Newton's Patent*, 1884, 1 P. O. R. 177.

(*e*) *Hardy's Patent*, 1849, 6 Moo. P. C. 441.

(*f*) *Trotman's Patent*, 1866, L. R. 1 P. C. 118; 3 Moo. P. C. N. S. 488.

In a petition for prolongation of a patent, where the patent rights have been transferred either in whole or in part to a company, it is essential that there should be deposited not only the patentee's account of his profits, but, in order to test them, the account also of the company (*g*).

This rule was not, however, insisted upon in the case of a patent of great merit and usefulness (*h*).

A patentee ought from the first to keep a patent account distinct and separate from any other business in which he may happen to be engaged. The patentee knows perfectly well that if his invention is of public utility, and he has not been adequately remunerated, he will have a claim for an extension of the original patent. It is not, therefore, too much to expect that he should be prepared, when the necessity arises, to give the clearest evidence of everything which has been paid and received on account of the patent (*i*).

In the matter of *Willacy's Patent* (*k*) the accounts did not show that the expenditure charged had been incurred with reference to the only part of the patent which was proved to possess utility, and an extension was therefore refused.

In *Yates and Kellett's Patent* (*l*) the grantees of a patent petitioned for prolongation on the ground of inadequate remuneration. No accounts were presented till within a week of the hearing, and the accounts then filed were insufficient. The petitioners applied for an adjournment in order that they might amend the accounts. The Judicial Committee refused the application and the petition was dismissed. "The explanation," said Lord Hobhouse, "given at the bar is that the patentee who has carried on this manufacture has destroyed his books; that the materials are not forthcoming out of which a better account might be made, and that the patentee was in difficulties and started afresh. 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; and a man who is bound to show what his profits have been before he can come for the renewal of the patent, must, if he

(*g*) *Deacon's Patent*, 1887, 4 P. O. R. 119.

(*h*) *Ibid.*

(*i*) *Adair's Patent*, 1881, L. R. 6 A. C. 176; *Bell's Patent*, 1861-62, 1 Moo. P.

C. N. S. 49, per Lord Chelmsford.

(*k*) 1888, 5 P. O. R. at p. 695.

(*l*) 1887, L. R. 12 App. Cas. 147; 4 P. O. R. 150; cp. *Duncan and Wilson's Patent*, 1884, 1 P. O. R. 257.

destroys his books, destroy the very case on which he must rely for a renewal of the patent.”

A petitioner for the extension of letters patent is entitled, in the petition or accounts which he submits to the Judicial Committee, to claim certain deductions from the profits made by him as patentee.

Deductions
allowed.

The personal expenses of the patentee for the *exclusive* devotion of his time in bringing the patent into practical operation and public notice, may be deducted (*m*).

Such an allowance will not be made where the whole of the time charged for has not been devoted to the extension and furtherance of the patent (*n*).

An allowance may be claimed by a patentee, who is also a manufacturer, for his personal superintendence of the working of his invention (*o*).

But where the petitioner did not manufacture the patented articles, but only granted licences, a charge for his personal allowance and subsistence money while visiting and overlooking the works of the licensees, was disallowed (*p*). “It was no part,” said Lord Chelmsford in this case, “of the covenant with the licensees that the petitioner should superintend their operations, and if they required his assistance to instruct their workmen, they should have engaged him and paid him for his services. If they had done so, this would have constituted a fair deduction out of the profits of the licensees, and would have properly entered into the patent account.”

The expenses of taking out and defending a patent, and of experiments, may be deducted (*q*).

But although law expenses incurred by the patentee in maintaining his patent rights are allowed in deduction of his profits, yet where the patentee compromised suits and gave up costs to which he had an apparent title, a deduction on that head will not be allowed (*r*).

(*m*) *Carr's Patent*, 1873, L. R. 4 P. C. 539; *cp. Bate's Patent*, 1836, 1 Web. P. C. 739; *Roberts' Patent*, 1839, *ibid.* 575; *Galloway's Patent*, 1843, *ibid.* 729; *Newton's Patent*, 1861, 11 Moo. P. C. 156. A patentee residing in America, for the purpose of getting the patented article into use in England, arranged with an agent in England, and in consideration gave him a moiety of the royalties. It was held, that in estimating the profits of the patentee derived from the patent such moiety must be deducted. *Pooler's Patent*, 1867,

L. R. 1 P. C. 514; 4 Moo. P. C. N. S. 452.

(*n*) *Furness' Patent*, 1885, 2 P. O. R. at p. 177.

(*o*) *Roberts' Patent*, *ubi supra*; *Perkins' Patent*, 1845, 2 Web. P. C. 8, 17.

(*p*) *Trotman's Patent*, 1866, L. R. 1 P. C. 118.

(*q*) *Bate's Patent*, *ubi supra*; *Roberts' Patent*, *ubi supra*; *Kay's Patent*, 1839, 1 Web. P. C. 572; *Galloway's Patent*, *ubi supra*; *Hett's Patent*, 1861, 1 Moo. P. C. N. S. 49.

(*r*) *Hill's Patent*, 1863, 1 Moo. P. C. N. S. 258.

The difference between the sum for which a patentee has sold his patent, and that which he has paid in buying it again, cannot be allowed in the accounts as an item of loss, but must be regarded as a mere commercial speculation (s).

A deduction may be allowed for profits made by the patentee as manufacturer, but not due to his monopoly (t).

The distinction between the manufacturing profits which a petitioner for extension may, and those which he may not, deduct, cannot better be stated than in the following language:—

“If but for the patent there would have been no manufactory, then the net profits of the manufacturer are, in that large sense, attributable to the patent. With it the manufacturer has a monopoly. . . . The patent may be said to create his trade; at least, it developed it to an extent which would be impossible without it” (u).

“It is obvious that in different manufactures there will be different degrees of connection between the business of the applicant as a manufacturer, and his business or his position as the owner of a patent. There may be patents of some kind which have little or no connection with the business of the manufacturer, and there may be patents of a different kind, where there is an intimate connection with the business of the manufacturer, such that the possession of the patent virtually secures to the patentee his power of commanding orders as a manufacturer” (x).

It appears, therefore, that the manufacturer's profits which the Judicial Committee will take into consideration in estimating the remuneration of a patentee, are those which could not have been made but for the preference monopoly created by the patent (y).

Where, however, the profits made by the patentee as manufacturer are not the profit of the monopoly, but simply the profit which any manufacturer, employed to make the patented articles, would have derived thereby, though he had no right to the patent or the monopoly, a fair deduction will be allowed (z).

The test above stated will be applied to profits arising from the

(s) *Wield's Patent*, 1871, L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300.

(t) *Galloway's Patent*, 1843, 1 Webst. P. C. 729; *Bett's Patent*, 1862, 1 Web. P. C. N. S. 49.

(u) *Hill's Patent*, 1863, 1 Moo. P. C. N. S. 258, per Lord Chelmsford.

(x) *Saxby's Patent*, 1870, per Lord Cairns, L. R. 3 P. C. 292.

(y) *Muntz's Patent*, 1846, 2 Web. P. C. 113.

(z) *Galloway's Patent*, 1843, 1 Web. P. C. 729.

manufacture of the materials out of which the patented articles are made (a), and from the sale of the patented articles (b).

Any deductions from profits which it is intended to claim must be set forth in the petition or the accounts, and evidence in support of claims not specifically made will not be admitted (c).

It is not the practice of the Judicial Committee to decide upon the novelty or utility of a patent, although they will of course abstain in any case from prolonging a patent which is manifestly bad. The petitioner must make out a case of *prima facie* validity (d). Case of *prima facie* validity must be made out.

A petition was presented for the prolongation of a patent, on the ground that the patentee had been inadequately remunerated. The merit of the invention was proved, and the inadequacy of the remuneration was not seriously disputed, but objections were taken to the novelty of the invention and the sufficiency of the specification, and it was suggested that the patent, if prolonged, should be made subject to the compulsory licences clause of the new Patents Act, 1883. The objection was repelled, and the patent extended for five years without conditions (e). Cases.

S., being the patentee of an invention for "improvements in sugar-cane mills," petitioned for the prolongation of his patent on the ground of having sustained an actual loss in working it. M. & Co. and others opposed, and tendered evidence to show anticipation by machines made by W., and by the publication in England of the American specification of H. Extension refused (f).

A petition for prolongation stated that various legal proceedings had been taken and were still pending, but that the petitioner could not postpone his application until their decision, as the patents were nearly expired. The petition further stated that by reason of litigation and expenses incurred, the inventor had not been adequately remunerated. Extension for three years granted (g).

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

(b) *Bailey's Patent*, 1884, 1 P. O. R. 1.

(c) *Ibid.*

(d) Per Lord Cairns in *Sarby's Patent*, 1870, L. R. 3 P. C. 294; cp. *Erard's Patent*, 1835, 1 Web. P. C. 557, note (a); *Hill's Patent*, 1863, 1 Moo. P. C. N. S. 258; *Stoney's Patent*, 1888, 5 P. O. R. at p. 522; *Kay's Patent*, 1839, 1 Web. P. C. 568; *Galloway's Patent*, 1843, 1 Web. P. C. 725; *Woodcroft's Patent*, 1846, 2 Web. P. C. 30; *Pinkus's Patent* 1848, 12 Jur. 234; *Bett's Patent*, 1862, 1 Moo. P. C. N. S. 52; *McDougal's*

Patent, 1867, 5 Moo. P. C. N. S. 4; *McInnes' Patent*, 1868, 5 Moo. P. C. N. S. 76.

(e) *Cocking's Patent*, 1885, 2 P. O. R. 153. The utility of an invention is of more importance than its novelty for the purpose of a successful petition for prolongation. *Church's Patent*, 1836, 3 P. O. R. 95.

(f) *Stewart's Patent*, 1886, 3 P. O. R. 7.

(g) *Kay's Patent*, 1839, 1 Web. P. C. 568; cp. *Heath's Patent*, 1853, 2 Web. P. C. 257.

Period of extension :
generally seven years ;
but ten or even fourteen years under special circumstances.

The usual practice of the Judicial Committee has been not to recommend extensions for periods of more than seven years. But in exceptional cases, the seven years' limit has been exceeded, and ten or even fourteen years' extension have been granted. *Moncrieff's Patent* for gun carriages was extended fourteen years, and *Stoney's Patent* (h) for improvements in sluices or flood-gates was extended ten years, on the ground that from its nature it was capable only of limited and occasional use.

When an extension has been once recommended, and new letters patent granted, the power of the Judicial Committee is exhausted, and they have no jurisdiction to entertain a petition for a further prolongation of the term (i).

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

It is now (l) the practice of the Judicial Committee to prolong letters patent by ordering a new grant to be made for the extended term (m).

In order that the exact relations of the new to the original letters patent may be understood, the following points must be noticed :—

Renewed letters patent are not void, if dated after the expiration of the original term (n).

As a matter of fact, the new letters patent are ordered to be sealed by the Comptroller-General and dated the date of expiration of the original patent. The Order in Council (o) prolonging the patent usually fixes the time within which application may be made for the new letters patent.

It is not necessary that a new specification of the extended patent should be filed (p).

(h) 1888, 5 P. O. R. 518.

(i) *Goucher's Patent*, 1865, 2 Moo. P. C. N. S. 532.

(k) Patents Act, 1883, s. 25, sub-s. 5.

(l) As to extension of a patent for an invention patented abroad, see p. 422. *Bodmer's Patent*, 1853, 8 Moo. P. C. 282; *Aube's Patent*, 1854, 9 Moo. P. C. 43; *Bell's Patent*, 1861, 1 Moo. P. C. N. S. 49.

(m) *Cocking's Patent*, 1855, 2 P. O. R. at p. 152; *Stoney's Patent*, 1888, 5 P. O. R. at p. 524. For the form of new grant in *Stoney's Patent*, see Appendix, p. 839.

(n) *Russell v. Ledsam*, 1845, 14 M. & W. 574, decided under 5 & 6 Will. 4, c. 83, s. 4.

(o) Appendix, p. 838.

(p) *Wastenev Smith's Patent*, 1885, 2 P. O. R. 14.

The new patent will be subject to sects. 22 and 27 of the Patents Act, 1883, as to compulsory licences and patents binding the Crown (*q*).

In the case of *Bovill v. Finch* (*r*), separate patents had been granted to Bovill in England, Scotland, and Ireland, previous to the passing of the Patent Law Amendment Act, 1852. By that Act, and its amending Act 16 & 17 Vict. c. 115, it was provided that the letters patent granted for the prolongation of a patent should, for the future, be sealed with the Great Seal of the United Kingdom, and be of force in the whole of the United Kingdom. Letters patent were subsequently granted sealed with the Great Seal of the United Kingdom, prolonging for a term of five years from their expiration the privileges granted by the three patents above mentioned. It was held, that the effect was the same as if the three patents had been separately prolonged, and the fact of one of the original patents being void for want of novelty would not prevent the letters patent being valid as a prolongation of the other patents (*s*).

The following cases illustrate the nature of "the restrictions, conditions, and provisions" which the Judicial Committee may insert in a new grant of letters patent. There is nothing in the statute 5 & 6 Will. IV. c. 83, to fetter the discretion of the Crown in the renewal, except the length of term (*t*). Reservations in new grant.

Letters patent comprised three separate subjects. Upon an application for extension, one only of the three subjects appeared to the Judicial Committee to be deserving of a renewed grant. Prolongation was granted, under 15 & 16 Vict. c. 83, s. 40, as to that part alone (*u*). Cases. Patent with several claims.

A petition for extension was presented by an assignee. Assignees.

(a) The patentee had made nothing by his patent. The Judicial Committee required the assignee to secure an annuity or a share of the profits to the inventor or his representatives (*v*);

(*q*) *Ibid*; but see *Cocking's Patent*, *ubi supra*. Conditions allowing the Crown to use the invention patented were formerly inserted in the new grant. *Pettit Smith's Patent*, 1850, 7 Moo. P. C. 133; *Carpenter's Patent*, 1854, 2 Moo. P. C. N. S. 191 (n.); *Lancaster's Patent*, 1864, 2 Moo. P. C. N. S. 189.

(*r*) 1870, L. R. 5 C. P. 523.

(*s*) See also *In re Bovill's Patent*, 1863,

1 Moo. P. C. (N. S.) 348.

(*t*) *Ledsam v. Russell*, 1 H. L. Ca. 687.

(*u*) *Lee's Patent*, 1856, 10 Moo. P. C. 226; *ep. Bodmer's Patent*, 1853, 8 Moo. P. C. 282; *Church's Patent*, 1886, 3 P. O. R. at p. 102. See also *Metford's Patent*, 1879, 48 Engineer, 15.

(*v*) *Whitehouse's Patent*, 1838, 1 Web. P. C. at p. 476; *Russell v. Ledsam*, 1845-48, 14 M. & W. 574; *Hardy's*

(b) Valuable consideration had been given for the assignment, and the assignee had sustained considerable loss. Prolongation was granted unconditionally (*x*).

Action for infringement before patent sealed.

A patentee, having obtained an extension warrant, neglected to get the patent sealed. A subsequent petition to the Crown by a foreigner to revoke this warrant was dismissed, on condition of the payment by the patentee of the petitioner's costs, and that no action should be brought for any infringement between the date of the warrant and the subsequent petition. There was held to be jurisdiction under 3 & 4 Will. IV. c. 41 (*y*).

Licences.

A patentee, formerly in partnership with J. and W., by a deed of dissolution stipulated that J. and W. should have the exclusive right of granting, in certain cases therein provided, licenses for manufacturing the patent article. In recommending an extension of the term of the patent, the Judicial Committee imposed a condition upon the patentee to secure to J., in whom the interest in the deed of dissolution then vested, the same interest in the new letters patent in regard to the granting of licenses as was provided by the deed of dissolution; but refused to allow J. to substitute new licenses for those granted under the original letters patent, in the event of the original licensees declining to renew their licenses from him under the new grant (*z*).

Prices.

Disclaimer.

A successful petitioner for prolongation has been required (a) to grant licenses to the public upon terms similar to one already granted by him (*a*); (b) to sell the patented article at a certain fixed price (*b*); (c) to disclaim all the parts of the original patent not worked out (*c*).

In *Dixon v. London Small Arms Co.* (*d*), it was held that private contractors, not being servants or agents of the Crown, could not use a patented invention of another in manufacturing articles for the government service. This led in some cases to the insertion of a reservation in favour of the government and its contractors in some new grants by the Judicial Committee,

Patent, 1849, 6 Moo. P. C. 441; *Markwick's Patent*, 1860, 13 Moo. P. C. 310; *Herbert's Patent*, 1867, 4 Moo. P. C. N. S. 300; *Pitman's Patent*, 1871, L. R. 4 P. C. 87; *Morton's Patent*, 1881, Eng. Rep., April to June, 1881, VII.

(*x*) *Bodmer's Patent*, 1849, 6 Moo. P. C. 468. "Terms are only imposed upon the assignee where the inventors and patentees have made nothing by their invention." Per Lord Brougham, *ibid.* p. 469.

(*y*) *Schlumberger's Patent*, 1853, 9 Moo. P. C. 1.

(*z*) *Normandy's Patent*, 1855, 9 Moo. P. C. 452.

(*a*) *Mallet's Patent*, 1866, L. R. 1 P. C. 308; 4 Moo. P. C. N. S. 175.

(*b*) *Hardy's Patent*, 1849, 6 Moo. P. C. 441.

(*c*) *Bodmer's Patent*, 1853, 8 Moo. P. C. 282.

(*d*) 1875, L. R. 1 App. Ca. p. 632.

where the invention was likely to be of use in the government service (*e*).

The person in whose favour an order for the extension of a patent has been made, is required to leave forthwith at the Patent Office an office copy of such order (*f*).

Costs.—In dealing with the question of costs, the Judicial Committee act upon the principle that *bonâ fide* opposition ought rather to be encouraged than discountenanced (*g*). Costs.

The costs of successful opposition are, therefore, allowed unless the Judicial Committee is dissatisfied with the manner in which the opposition has been conducted, *e. g.*, where much expense was occasioned by the opponent's relying upon patents for inventions which bore no resemblance to the patent in question, or producing discreditable witnesses, or otherwise prolonging the inquiry (*h*).

Again, costs of opposition will in general be allowed when the petitioner abandons his application for extension (*i*).

In a doubtful case, which caused the Judicial Committee great difficulty, no costs were given to the successful petitioner (*k*).

Costs will be given to a successful petitioner, where there was no ground for opposition (*l*).

Where there are several opponents representing the same kind of opposition, one set of costs, to be apportioned between them by the Registrar of the Privy Council, will be allowed (*m*). Upon the other hand, where the objection of several opponents are quite distinct, separate costs may be awarded to each (*n*). It is very usual to grant a lump sum for costs, in which case a taxation is avoided.

(*e*) See *Napier's Patent*, 1881, L. R. 6 App. Ca. p. 174, where a reservation in favour of the government and its contractors was inserted; and see also *Hughes' Patent*, L. R. 4 App. Ca. 174, where a similar condition was inserted to that in *Pulliser's Patent*. This condition in *Pulliser's Patent* was as follows:—"Upon condition that the officers of her Majesty's government, and all persons who may from time to time contract for the supply of ordnance and projectiles for her Majesty's service in respect of work done in the execution of such contracts, shall be at liberty to use the same invention or inventions during the continuance of the new letters patent."

(*f*) Patents Rules, 1890, r. 74, *infra*.

(*g*) *Wield's Patent*, 1871, 8 Moo. P. C. N. S. at p. 304; L. R. 4 P. C. 89; *cp. Westrupp and Gibbins' Patent*, 1836, 1 Web. P. C. 556.

(*h*) *Muntz's Patent*, 1846, 2 Web. P. C. 122; *Honiball's Patent*, 1855, 9 Moo. P. C.

394.

(*i*) *Macintosh's Patent*, 1837, 1 Web. P. C. 739; *Bridson's Patent*, 1852, 7 Moo. P. C. 499; *Hornby's Patent*, 1853, 7 Moo. P. C. 503; *Milner's Patent*, 1854, 9 Moo. P. C. 39; *Morgan Brown's Patent*, 1886, 3 P. O. R. 212. When the petition is abandoned, it is not necessary that the opposers should serve the petitioners with notice of their intended application to the Court for costs of opposition. *Bridson's Patent*, *ubi supra*.

(*k*) *Church's Patent*, 1886, 3 P. O. R. p. 95.

(*l*) *Downton's Patent*, 1839, 1 Web. P. C. 567.

(*m*) *Milner's Patent*, 1854, 9 Moo. P. C. 39; *Jones' Patent*, 1854, 9 Moo. P. C. 41; *Hill's Patent*, 1863, 1 Moo. P. C. N. S. 258; *Wield's Patent*, 1871, *ubi supra*; *Johnson's Patent*, 1871, 8 Moo. P. C. N. S. 282.

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

CHAPTER XIX.

CONFIRMATION OF PATENTS.

No confirma-
tion except by
special Act
before 1835.

IT has always been the law that it is necessary for the validity of a patent that the invention should be new as well as that it should be useful, and if it can be proved that the invention had been practised publicly by any person before the letters patent are granted, the patent is invalid (*a*). The hardship which this rule of law may cause in certain cases was well explained in the evidence of one of the witnesses (*b*) before the Parliamentary Committee of 1829 (*c*). "It very often happens that a person—I will say ten years ago—invents a machine which for want of just exactly the right thing does not act; he tries it; it is a complete failure; the thing is thrown by. Some eight or ten years afterwards everybody (I will say that it is an invention for the spinning of cotton) is trying who can save an hour in the spinning of cotton; it is likely a second person may invent the same thing, or may catch at the same principle; he adopts a different mode of carrying it into effect, and being a little more clever than the other, he hits on the point the other wanted, and makes his a most valuable invention: he takes out his patent for it. Away comes the other man who ten years ago invented something that involved some few of the parts this new invention does: he says 'I made such and such wheels, and put them together for the same purpose ten years ago. I did this much of it,' and that patent is upset."

Prior to 1835, there was no power in the Crown to confirm or render valid letters patent in such a case, and the only remedy was by a special Act of Parliament.

Lord
Brougham's
Act.

With a view to relieve patentees against this hardship, the statute 5 & 6 Will. IV. c. 83, s. 2 (*d*), passed in 1835, provided that "if in any suit or action it shall be proved or specially found that any

(*a*) *In re Card's Patent*, 1848 (per Lord Campbell), 6 Moo. P. C. 212.
(*b*) Mr. Benjamin Rotch.

(*c*) Pp. 113, 114.
(*d*) See *infra*, pp. 637 *et seq.*

person who shall have obtained letters patent for any invention or supposed invention was not the first inventor thereof, or of some part thereof, by reason of some other person or persons having invented or used the same, or some part thereof, before the date of such letters patent, or if such patentee or his assignees shall discover that some other person had, unknown to such patentee, invented or used the same, or some part thereof, before the date of such letters patent, it shall and may be lawful for such patentee or his assignees to petition His Majesty in Council to confirm the said letters patent or to grant new letters patent, the matter of which petition shall be heard before the Judicial Committee of the Privy Council."

The section then goes on to state the *grounds* upon which this discretionary power may be exercised, viz., that the patentee believed himself to be the first and original inventor, and that the invention or part thereof had not been publicly and generally used before the date of the letters patent which it was sought to confirm.

Grounds for confirmation by Privy Council.

The following are the chief points of interest in connection with the confirmation of letters patent, which are not provided for in the new Act, and on which, therefore, it may be sufficient to dwell very lightly:—

(1) If the defect in the patent could be cured by disclaimer or memorandum of alteration, confirmation would not be granted (*c*). Cases.

(2) The petition for confirmation was required to admit the invalidity of the patent, and the petitioner ought not to bring an action for infringement before confirmation, the two proceedings being contradictory (*f*).

(3) The petitioner had to satisfy the Judicial Committee (a) that he believed himself to be the true and first inventor (*g*); and (b) that the invention was not publicly and generally used prior to the date of his patent (*h*).

(4) The Act was meant to apply to the case of an invention abandoned, and not in use at the time of the patent; and if those conditions were absent, the Judicial Committee would not exercise its discretion, even although the person who had publicly used the invention prior to the date of the patent consented to the confirmation (*i*).

(5) Where it appeared on a petition for confirmation that part

(*c*) *In re Westrupp and Gibbins' Patent*, 1836, 1 Web. P. C. 555.

(*f*) *In re Stead's Patent*, 1846, 2 Web. P. C. 147.

(*g*) *Ibid. In re Honiball's Patent*, 1855.

2 Web. P. C. 201; *In re Card's Patent*, 1848, 2 Web. P. C. 161.

(*h*) *Ibid.*

(*i*) *In re Lamenaude's Patent*, 1850, 2 Web. P. C. 164.

of the patentee's invention formed the subject of an expired French patent, but that it had never been used or known in England otherwise than by a description in a book published in France, a copy of which was in the British Museum, notice of the day of hearing was directed to be given to the French patentee, and on an affidavit that such notice had been sent through the Post Office, directed to Paris, confirmation was recommended (*k*).

(6) The confirmation merely obviated objections arising from prior user, or publication, leaving the patent still open to all other objections to which it might be liable (*l*).

Where, however, the prior publication was that of two prior patents which had not been publicly or generally used, Lord Lyndhurst said that he did not think the Act was intended to apply to such a case. The petitioner might have gone to the office and seen the prior specifications (*m*).

Confirmation since the Act of 1883.

This Act of 5 & 6 Will. IV. c. 83, was repealed by the Patents Act, 1883, so that there can now be no confirmation except by special Act of Parliament, at least, so far as patents granted under the Act of 1883 are concerned. But it appears that confirmation may still be applied for so far as patents obtained under the Act of 1852 are concerned.

Brandon's Patent.

The decision in *Brandon's Patent* (*n*), which has already been referred to (*o*), shows that all rights or privileges of patentees under the Act of 1852 are preserved; and confirmation and prolongation in the cases contemplated by 5 & 6 Will. IV. c. 83, are equally such rights or privileges. There have been, however, no petitions for confirmation of patents granted under the Act of 1852 presented since the Act of 1883. It is clear that any such right will absolutely cease before 1898, when no patents granted before the 1st January, 1884, will be in force.

Confirmation in cases not provided for in Act of 1835.

The statute of Will. IV. only applied to cases where the patent was void by reason of prior user or invention, and there was no provision for confirming or rendering valid a patent void for any other reason. In such cases it was therefore necessary to apply to Parliament for a special Act. Two such Acts were passed prior to the Act of 1852, and patents were declared valid where the specification had been enrolled after the six months provided by the letters patent (*p*).

(*k*) *In re Heurteloup's Patent*, 1836, 1 Web. P. C. 553.

(*l*) Hindmarch, p. 201.

(*m*) *Wells' Patent*, 1 Web. P. C. 554.

(*n*) 1 P. O. R. 1884.

(*o*) See previous chapter, pp. 378, 379.

(*p*) *Westhead's Patent*, where the specification was enrolled five days late. The

After 1852 the fees on patents were paid in two instalments, of 50% and 100%, before the end of the third and seventh years. In order to revive a patent which had been allowed to lapse owing to non-payment of the stamp duty within the prescribed time, it was necessary to apply to Parliament, and a considerable number of special Acts were obtained with this object between 1852 and 1884 (*q*).

Non-pay-
ment of
renewal.

Since the Act of 1883, sect. 17, the comptroller has power to enlarge the time for payment of the renewal fees, and in consequence it appears that very few Acts will in future be passed confirming patents void for non-payment of renewal fees. In 1887 three bills were introduced for confirming letters patent void for non-payment of renewal fees, and a Select Committee reported on the whole matter (*r*).

Select Com-
mittee, 1887.

Previous to 1887 there were three confirming Acts in 1884 (*s*), and one in 1885 (*t*); but in 1887 the Select Committee reported that, having regard to the Act of 1883, sect. 17, in future no private Act to confirm letters patent should be allowed to proceed where the excuse offered for default in payment of a renewal fee falls short of serious illness, or some other cause for which the patentee ought not to be held responsible, and which may sufficiently account for the non-payment otherwise than by neglect, inadvertence, or mistake.

Recom-
mendations
of Committee.

The Committee further held, that a person beneficially interested in a patent should be held responsible for default in registered patentee or his agents. Also, that where any bill is entertained, clauses should be inserted for the protection of persons who may have availed themselves of the subject-matter of the patent after it has been announced as void in the Official Journal (*u*).

The Committee allowed Potter's Patent Bill to proceed, being satisfied that non-payment of the renewal fees arose from serious illness of the applicant, and not from neglect, inadvertence, or mistake.

Potter's
Patent Act,
1887.

Act was passed in 1849, seven months after the forfeiture, and contained no saving clause. In *Laird's Patent* the specification was enrolled one day late, but the Act was not passed till 1851, which was seven years after the forfeiture. In this Act there was a saving clause. See Report of Select Committee H. of L. on Potter's Patent Bill, &c., in 1887, at p. 43.

December 23, 1884.

(*r*) Report of Select Committee on Potter's Patent Bill, Skrivauow's Patent Bill, and Gilbert and Sinclair's Patent Bill, House of Lords, 1887.

(*s*) Wright's Patent Act, Boulton's Patent Act, and Bradbury and Leman's Patent Act.

(*t*) Auld's Patent Act.

(*u*) The clauses suggested are set out in Potter's Patent Act, 1887, sect. 2, Appendix, p. 844.

(*q*) See Report, &c., *supra*, last note. A list of these Acts is there given. See also Official Journal of Patent Office of

CHAPTER XX.

INTERNATIONAL AND COLONIAL ARRANGEMENTS.

International recognition of rights of inventors.

Select Committee, 1872.

Circular to British colonies.

Reports on foreign patent laws.

International Convention, 1883.

For at least ten years prior to the Act of 1883, there had been a strong opinion, both in England and in other countries, in favour of an attempt to create an international patent law, or at least some international recognition of the rights of inventors (*a*).

Adopting to some extent the views expressed in 1871 by Sir H. Bessemer and Sir William Armstrong, and again in 1872 by Mr. C. W. Siemens and others, the Select Committee of 1872 recommended that there should be an assimilation in the law and practice in regard to inventions amongst the various civilized countries of the world, and that her Majesty's government be requested to inquire of foreign and colonial governments how far they are ready to concur in international arrangements in relation thereto.

A circular, dated August 31, 1872, was, in accordance with this recommendation, addressed to the Governors of the British colonies by the Earl of Kimberley, then Colonial Secretary, and the replies received thereto were in the main favourable (*b*).

At the same time (*c*), her Majesty's representatives abroad were directed by Lord Granville, Secretary of State for Foreign Affairs, to prepare succinct reports upon the patent laws of the countries to which they were severally accredited, and these reports were published and laid before Parliament in 1873 (*d*).

The International Congress at Vienna in 1873, and the Paris Congress of 1878 (*e*), carried the movement towards an international

(*a*) As early as 1851, an association called the "Association of Patentees," sought to include in their list of reforms of the patent law "International arrangements for a mutual recognition of the rights of inventors." It was suggested, among other proposals, that (1) where any person patented an invention in one country, that person or his assignees should have the sole and exclusive title to a patent for the same invention in every other country for the space of six months after the date of his original patent; and (2) patents of importation in the name of parties other than the inventor or his assignees should be abolished in every country. The latter suggestion was supported on the ground that every improvement or discovery made in one part of the civilized world is, sooner or later, made known by the public journals in every other part; and it ought

not, therefore, be permitted to any one (except the inventor or his assignees) to step in and deprive the public of what is likely to be communicated to them in due course.

The above shows that the ideas underlying the Convention are much older than is popularly supposed. The Convention considerably modified the position of importers.

(*b*) Correspondence respecting International Arrangements, May, 1874 (C. 999).

(*c*) By circular of August 14th, 1872.

(*d*) Reports of her Majesty's Secretaries of Embassy and Legation respecting the law and practice in foreign countries with regard to inventions, 1873 (C. 741).

(*e*) Organized during the Exhibition of 1878.

patent law considerably further; and on 20th March, 1883, an International Convention for the protection of industrial property was signed at Paris (*f*). The necessary ratifications were exchanged by the plenipotentiaries of the contracting parties on June 6, 1884, and the Convention came into effective operation a month later (*g*).

The original signatories were the governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia and Switzerland. Great Britain was not included. Indeed, it was necessary that statutory power should be given to the Crown, to allow the ante-dating of the patent, which might otherwise be void by reason of anticipation.

The original signatories.

By the Patents Act, 1883 (*h*), it was provided that if her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for the mutual protection of inventions (*i*), any person who has applied for protection for any invention in any such state shall be entitled to a patent for his invention in priority to other applicants, and such patent shall have the same date as the date of the application (*k*) in such foreign state.

Power for Her Majesty to make arrangements with foreign states.

The application in England must be made within seven months from the date of application in the foreign state with which the arrangement is in force.

Seven months' priority.

The patentee, moreover, will not be entitled to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification in this country (*l*).

No action for infringement till complete specification accepted.

The publication in the United Kingdom or the Isle of Man, during the seven months aforesaid, of any description of the invention, or its use therein during such period, shall not invalidate the patent which may be granted (*m*).

Publication during the seven months.

The application for the grant of a patent under these provisions

Application, how to be made.

(*f*) See the text of the Convention, pp. 600 *et seq.*

(*g*) The contracting parties agreed to interfere as little as possible with the particular laws of the different States. The first principle was to ask only from each country the same treatment for subjects of each of the other countries as was accorded to their own subjects. The Convention was in no way based upon the principle of strict reciprocity, and uniform regulations were only insisted upon where they were considered indispensable in order to obtain effective reciprocal protection. Not only was it agreed to permit each State to maintain its own law without modification, except on the above points; but countries, *e.g.*

Holland, Switzerland, and Servia, were admitted, in which all branches of industrial property were not at the time and are not now protected.

(*h*) Sect. 103.

(*i*) The section deals also with trade marks and designs, which are foreign to the present work.

(*k*) The words *date of application* were, at the instigation of Lord Herschell, substituted, by sect. 6 of the Act of 1885, for the words *date of the protection obtained*, which appear in sect. 103. Cp. *L'Oiseau and Pierrard*, per Webster, A.-G., 1887, Griffin, A. P. C. at p. 39.

(*l*) Sect. 103, sub-s. 1.

(*m*) *Ibid.* sub-s. 2.

must be made in the same manner as the ordinary application for the British patent (*k*).

Order in
Council.

These provisions are, moreover, to apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state (*l*).

Her Majesty's government acceded to the Convention (*m*), so far as Great Britain and Ireland are concerned, on the 17th March, 1884, and reserved power to subsequently accede on behalf of the Isle of Man (*n*), Channel Islands, or any of Her Majesty's possessions. The accession was accepted (*o*) on the 2nd April following. By an Order in Council (*p*) dated the 26th June, 1884, the provisions of the Patents Act, 1883, s. 103, were applied to the countries then signatories of the Convention, and the order took effect from the 7th July, 1884.

Subsequent
withdrawals
and acces-
sions.

There have been subsequent accessions to and withdrawals from the Convention (*q*).

Colonial
arrange-
ments.

Provision for
colonies and
India.

As most of the British possessions have now patent laws of their own, it was necessary to make provisions for mutual protection of inventions between the colonies and Great Britain, and accordingly the Act of 1883 (*r*) provides that where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions patented in this country, it shall be lawful for Her Majesty from time to time by Order in Council to apply the provisions of section 103 as to international arrangements, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

Effect of
Order in
Council.

An Order in Council under this Act shall, from a date to be mentioned for the purpose in the order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

(*k*) Sect. 103, sub-s. 3. This, however, is not quite the fact, as several other matters have to be considered, and special forms of procedure are prescribed by Patents Rules, 1890, rr. 24—29, see pp. 568—570.

(*l*) *Ibid.* sub-s. 4. Orders in Council have been issued applying the provisions of this section to the countries given in the table on opposite page.

(*m*) For text of Convention, see pp. 600 *et seq.*

(*n*) By this reservation on behalf of the Isle of Man, the patent granted to foreigners in countries which are signatories to the International Convention, is not co-extensive with the ordinary grant, which extended to the Isle of Man.

(*o*) See p. 619.

(*p*) See pp. 620, 621.

(*q*) Art. XVI. of the Convention provided for subsequent adhesions, Art. XVIII. for subsequent withdrawals.

(*r*) Sect. 104.

The position of Great Britain with regard to arrangements made under sect. 103 with foreign countries, and under sect. 104 with the British possessions, may be presented most conveniently in tabular form.

| STATE. | Date of Order in Council (s) under sect. 103 or sect. 104 of Act of 1883. | Date from which Order in Council takes effect. | Date of accession to International Convention. | Date from which accession takes effect. | Date of Withdrawal (t). |
|---|---|--|--|---|-------------------------|
| Belgium | 26 June, 1884.... | 7 July, 1884 | 20 Mar. 1883 | 6 July, 1884 | |
| Brazil | 26 June, 1884.... | 7 July, 1884 | 20 Mar. 1883 | 6 July, 1884 | |
| East Indian Colonies of the Netherlands.. | 17 Nov. 1888 | 17 May, 1889 | | | |
| Ecuador | 26 June, 1884.... | 7 July, 1884 | 21 Dec. 1883 | 6 July, 1884 | 26 D 1886 (u) |
| France | 26 June, 1884.... | 7 July, 1884 | 20 Mar. 1883 | 6 July, 1884 | |
| Great Britain | 26 June, 1884.... | 7 July, 1884 | 17 Mar. 1884 | 7 July, 1884 | |
| Guatemala..... | 26 June, 1884.... | 7 July, 1884 | 20 Mar. 1883 | 6 July, 1884 | |
| Italy | 26 June, 1884.... | 7 July, 1884 | 20 Mar. 1883 | 6 July, 1884 | |
| Mexico (x) | 28 May, 1889 (y) .. | 28 Dec. 1889 | | | |
| Netherlands | 26 June, 1884.... | 7 July, 1884 | 20 Mar. 1883 | 6 July, 1884 | |
| New Zealand..... | 8 Feb. 1890 (z) .. | 8 Sept. 1890 | | | |
| Norway | 9 July, 1885 | 1 July, 1885 | | | |
| Paraguay (x) | 24 Sept. 1886 | 24 Sept. 1886 .. | | | |
| Portugal | 26 June, 1884.... | 7 July, 1884 | 20 Mar. 1883 | 6 July, 1884 | |
| Queensland | 17 Sept. 1885 (z) .. | 17 Sept. 1885 .. | | | |
| Salvador | 26 June, 1884.... | 7 July, 1884 | 20 Mar. 1883 | 6 July, 1884 | 17 Aug. 1887 (a) |
| San Domingo | 27 Jan. 1885 | 27 Jan. 1885 | | | 28 May, 1889 (b) |
| Servia..... | 26 June, 1884.... | 7 July, 1884 | 20 Mar. 1883 | 6 July, 1884 | |
| Spain | 26 June, 1884.... | 7 July, 1884 | 20 Mar. 1883 | 6 July, 1884 | |
| Sweden | 9 July, 1885 | 1 July, 1885 | | | |
| Switzerland | 26 June, 1884.... | 7 July, 1884 | 20 Mar. 1883 | 6 July, 1884 | |
| Tunis | 26 June, 1884.... | 7 July, 1884 | 20 Mar. 1883 | 6 July, 1884 | |
| Turkey | | | | | |
| United States | 12 July, 1887.... | 12 July, 1887 | | | |
| Uruguay (x) (c) | 24 Sept. 1886 | 24 Sept. 1886 | | | |

(s) Published in London Gazette.

(t) Under Art. XVIII. of the International Convention, the provisions of the Convention remain in force as regards any country terminating its cohesion till the expiry of one year from the date of such notice.

(u) See Order in Council, 16 April, 1886. Notice of withdrawal was given on Dec. 26, 1885.

(x) Mexico, Paraguay, and Uruguay, are not signatories to the Convention, but have, by separate treaty with Great Britain, given to British inventors, and obtained for their own countrymen, the benefits of sect. 103.

(y) Reciting a treaty between Great Britain and Mexico, ratified 11 Feb. 1889.

(z) Order in Council made under the provisions of sect. 104 of the Act of 1883.

(a) See Order in Council, 24 Sept. 1886.

(b) See Order in Council, 28 May, 1889.

(c) Victoria and Tasmania have embodied in their respective laws international provisions analogous to those of the Patents Act, 1883, but no

Order in Council has yet been issued under sect. 104 applying the provisions of sect. 103 to those countries. The case of Natal is somewhat curious. By an enactment of the Governor in Council, dated Nov. 5, 1884, sect. 38 of Law No. 4 of 1870, which declares that letters patent granted in the United Kingdom shall not extend to Natal, was repealed, and it was decreed that from and after the date of the promulgation in that colony of the Order in Council referred to in sect. 104 of the Patents Act, 1883, all letters patent granted in the United Kingdom should be deemed and taken to be granted under the provisions of Law No. 4 of 1870, and dealt with accordingly. This law, which was limited to patents, was to come into operation from and after the date of the promulgation in the Natal Government Gazette of the Order in Council referred to in sect. 104 of the Act of 1883. The effect of this provision would be to extend every British patent to Natal, but no Order in Council under sect. 104 has yet been made. Cp. Trans. I. P. A. Vol. VI., pp. 130, 131. A. M. Clark on the International Convention.

Conferences under International Convention.

The International Convention provided for conferences being held successively in one of the contracting states, by delegates of the said states, with a view to improvements upon the system of the union (*d*).

The first meeting took place at Rome in April and May, 1886 (*e*), and the second at Madrid in April, 1890.

Rules for application under sects. 103 and 104.

Rules prescribing the formalities to be observed in applications for patents made under the International and Colonial Arrangements were issued by the Board of Trade and duly laid before Parliament on the 11th May, 1888; were published four days later, and came into force on 1st June, 1888. They are now Rules 24—29 of the Patents Rules, 1890.

General scope of International Convention.

The provisions of the International Convention, so far as relates to patents, may be shortly summarised as follows:—

Priority.

1. An applicant for a patent in any one of the contracting states can obtain protection in any of the other contracting states by application there within a period of six, or in the case of countries beyond the seas of seven, months from the date of his first application. The subsequent application is antedated to the date of the first application; and is, consequently, not defeated, as otherwise it would have been, by prior publication or user in the protected interval (*f*).

Importation.

2. Formerly, a patentee could not introduce into some of the States of the Union articles manufactured according to his patent in this or other countries without forfeiture of his rights. Free importation of such articles without the penalty of forfeiture is now allowed, but the patentee remains bound to “work” his patent in conformity with the laws of the country into which he introduces the patented articles (*g*).

Exhibitions.

3. Temporary protection is accorded by each of the contracting states to patented articles exhibited at official or officially recognised international exhibitions (*h*).

(*d*) Art. XIV.

(*e*) The British delegates on this occasion were the Comptroller-General (Mr. H. Reader Lack) and Mr. J. H. G. Bergne, of the Foreign Office, assisted by Mr. C. Belk, the Master Cutler of Sheffield, and Mr. H. Hughes, secretary of the Sheffield Chamber of Commerce.

The following addition to the Convention, in so far as it relates to patents, was agreed upon. To Art. V., “Each country shall decide the meaning of the word *exploiter* for itself.”

The number of applications under the provisions of the International Convention amounted to 26 in 1887, and to 71 in 1888.

(*f*) Art. IV.

(*g*) Art. V.

(*h*) Art. XI. The Act of 1886 gave Her Majesty power, by Order in Council, to declare the provisions of Act, 1883, s. 39, applicable to foreign exhibitions. For the Order in Council in case of Paris Exhibition 1889, see p. 845.

4. An International Office in connection with, and under Art. XIII. of the Convention, has been established at Berne, Switzerland. Its expenses are defrayed by the governments of all the contracting states, its functions are determined by agreement between them, and it publishes a monthly periodical entitled *La Propriété Industrielle* (i). International Office.

The legal effect of arrangements made for the Colonies and India by Order in Council, under sect. 104, is clear, because the Order in Council may vary or add to the provisions of sect. 103; and the Order in Council is to be read with the Act as if it were contained in it. The Order in Council and sect. 103 will, therefore, be read together, and construed in the same manner as any other statutory enactment. Legal effect of Orders in Council under s. 104.

But it is a matter of no little difficulty to determine the precise relation which the International Convention bears to the laws of the contracting states. The position of the Convention will probably vary, in different countries, according to the legal effect given to treaty arrangements (k). General relation of Convention to laws of contracting states.

An application in the United Kingdom for a patent for any invention, in respect of which a foreign application (l) has been made, must contain a declaration that such foreign application has been made, and must specify all the foreign states or British possessions in which foreign applications have been made, and the date or dates thereof respectively. Practice under sect. 103, the Convention, and the Patents Rules.

(i) The yearly subscription (including postage) for all countries within the postal union is 5 francs 60 cents., payable to MM. Jent & Reinert, Imprimeurs, Berne.

(k) It is to be observed, that one of the chief difficulties, under sect. 103, is the vagueness of the word *any* in the clause beginning: "If her Majesty is pleased to make *any* arrangement with the government or governments of any foreign state, &c." But it is provided, that the section shall only apply to those foreign states with respect to which her Majesty shall from time to time, by Order in Council, declare them to be applicable. Most of the Orders in Council which have been made simply apply sect. 103 to the countries with which arrangements have been made. So that so far as the treaties are concerned, it would appear that they need not be looked at, except, perhaps, to see if the provisions of the Order in Council are all contained in the treaty. All that needs attention is the sect. 103, and

to see how far the Order in Council applies its provisions. If the Order in Council applying sect. 103 to the countries under the International Convention was properly made, it would seem that her Majesty may, by Order in Council, apply some only of the provisions of sect. 103. For in this Order in Council there is a reservation of the Isle of Man. As to the general position of treaties and Orders in Council made under statutory authority, and applying the provisions thereof, see *Reg. v. Wilson*, 1877, L. R. 3 Q. B. D. p. 42, and *Parlement Belge*, 1880, 5 P. D. 197.

(l) "The term 'foreign application' means an application by any person for protection of his invention in a foreign state or British possession, to which by any Order of her Majesty in Council for the time being in force, the provisions of sect. 103 of the Patents Act, 1883, have been declared applicable." P. R. 1890, r. 24.

The application must be made within seven months from the date of the first foreign application, and must be signed by the person or persons by whom such first foreign application was made.

If such person or any of such persons be dead, the application must be signed by the legal personal representative of such dead person, as well as by the other applicants, if any (*m*).

Application
on Form A2.

The application in the United Kingdom must be made in the Form A2 in the second schedule to the Patents Rules, 1890 (*n*), and in addition to the specification, provisional or complete, left with such application, as in the case of an ordinary application, must be accompanied by—

(1) A copy or copies of the specification and drawings, or documents corresponding thereto, filed or deposited by the applicant in the Patent Office of the foreign state or British possession, in respect of the first foreign application, duly certified by the official chief or head of the Patent Office of such foreign state or British possession as aforesaid, or otherwise verified to the satisfaction of the comptroller;

(2) A statutory declaration as to the identity of the invention in respect of which the application is made, with the invention in respect of which the said first foreign application was made, and if the specification or document corresponding to it be in a foreign language, a translation must be annexed and verified by the statutory declaration (*o*).

Variance in
English and
foreign speci-
fications.

Minor matters of departure in a foreigner's English specification from his foreign specification are unimportant, if the law officer is enabled by the translation to judge of the substantial identity of the inventions described therein (*p*).

Entry by
comptroller
of dates.

On receipt of the application, together with the prescribed specification, and the other document or documents accompanying the same, and with such other proof, if any, as the comptroller may require of or relating to such foreign application, or of the official date thereof, the comptroller makes an entry of the applications in both countries, and of the official dates of such applications respectively (*q*).

Further pro-
ceedings same

All further proceedings in connection with the application are

(*m*) P. R. 1890, r. 25.

(*n*) *Infra*, p. 739.

(*o*) P. R. 1890, r. 26.

(*p*) *L'Oiseau and Pierrard*, 1887, per

Webster, A.-G., Griffin, A. P. C. at p. 37; *Mains' Patent*, 1890, 7 P. O. R. 13.

(*q*) P. R. 1890, r. 27.

taken within the times and in the manner prescribed by the Acts or Rules for ordinary applications (*r*). as in other cases.

The patent, when granted, is entered on the Register of Patents, as dated of the date on which the first foreign application was made, and the payment of the renewal fees, and the expiration of the patent, are reckoned from the date of the first foreign application (*s*). Renewal fees.

There have been several recent decisions under sect. 103, to which it is necessary to allude. Decisions under sect. 103.

L' Oiseau and Pierrard (t).—On 8th October, 1886, L. and P., two foreigners, left at the Patent Office an application in common form, with a provisional specification, for letters patent for “automatic apparatus for subjecting the person to the action of electric currents.” A complete specification was deposited on 29th January, 1887, and this was accepted on the 28th March following. On 28th May, 1887, notice of opposition to the grant of a patent to L. and P. was given by E., on the ground that the invention had been patented on an application by him of prior date. E.’s application bore date 20th August, 1886, and his complete specification had been left on 3rd March, 1887, and had been accepted on the 27th of the following May. Position of applicant where previous foreign patent not disclosed.

The applicants then called attention to a patent granted to them in France for the same invention, on 18th August, 1886, and contended that, under sect. 103 and the Convention, their patent would be dated 18th August, 1886, and would therefore be prior to E.’s. No notice had been given by L. and P. at the Patent Office of the existence of this French patent; the English specification contained claims not described in the French specification, and the applicants asked leave to strike out from the former the claim applicable to so much as was not described in the latter. Webster, A.-G., allowed the excision to be made, declined to treat the hearing as an application for an amendment which would justify him in imposing any terms, and, as there was nothing to show that L. and P.’s omission to refer to the foreign application was due to bad faith, directed their patent to be sealed as of the 18th August, 1886 (*u*).

(*r*) P. R. 1890, r. 28.

(*s*) *Ibid.* r. 29.

(*t*) 1887, Griffin, A. P. C. 36.

(*u*) “I think,” added the A.-G., “(and I wish to reserve this point) that if it were shown that the Patent Office had been misled, and the opponents had been misled by any positive misrepre-

sentation, or if there were anything which would amount to want of good faith, I should like to consider on another occasion whether an applicant who claims the benefit of sect. 103 is entitled to receive it. But once given that there has been a *bona fide* application within the period prescribed by

In a subsequent case (*x*), however, it was held that the applicants in *L'Oiseau and Pierrard* had no right under sect. 103 to oppose the grant of letters patent to E., under sect. 11 of the Act of 1883.

Retrospective effect of Orders in Council applying sect. 103.

In *Main's Patent* (*y*), Main, who was an American, had applied for a patent on the 18th April, 1887, in the United States. On the 12th July, 1887, an Order in Council applied the provisions of sect. 103 to the United States as from the 12th July, 1887. On the 18th November, 1887, Main applied for the British patent. The application was not made under the rules relating to applications under the International Convention. The grant of the patent was opposed on the ground that the invention had been patented on an application of prior date, the 8th June, 1887. The similarity of the inventions was not denied, but the applicant for the patent claimed to ante-date his application to the 18th April, 1887, under the provisions of sect. 103. It was held, that notwithstanding the fact that the provisions of sect. 103 did not apply at the time of the United States application, that the applicant was so entitled to ante-date his application. It was also objected that the application ought to have been made as an application under the International and Colonial Arrangement Rules; but *L'Oiseau and Pierrard's Case* (*z*) was followed, and the patent ordered to be sealed as of the 18th April, 1887.

Importer has no rights under sect. 103.

A person to whom an invention has been communicated from abroad, cannot claim any rights under sect. 103. The rights under that section are personal rights, and were intended to encourage people who had invented to come to this country and make known their inventions (*a*).

A patent under the International Convention can only be granted to the person (*b*) who has made the foreign application (*c*).

statute, and no conduct which would amount to a breach of good faith, or a breach which would prevent a man from being entitled to claim his rights, I am afraid that the words of the statute are so distinct that I have no alternative in the matter." See, however, the positive requirements of rr. 25 and 26, P. R. 1890.

(*x*) *Re Everitt*, 1888, per Webster, A.-G., Griffin, A. P. C. at p. 29.

(*y*) 1890, 7 P. O. R. p. 13.

(*z*) *Supra*.

(*a*) *Re Shallenberger*, 1889, per Webster, A.-G., 6 P. O. R. at p. 550.

(*b*) *Seemle*, a corporation can apply under sect. 103. *Re Carez*, 1889, per Webster, A.-G., 6 P. O. R. 552. *Re Shallenberger supra*.

(*c*) *S. C.*, *ubi supra*. Cp. also *Re Van*

de Poele.

American "renewed applications."—In *Re Van de Poele*, 1890, 7 P. O. R. 69, a most important point has recently been decided.

An American inventor applied for a patent in the United States, abandoned the application, and subsequently lodged a fresh application in respect of the same invention. Upon the latter occasion he was permitted by the Patent Office as a matter of convenience to make use of the documents filed with his first application, but the application itself was no longer operative in America after its abandonment. Webster, A.-G., held that the second application was "the first foreign application" under the circumstances.

CHAPTER XXI.

FEATURES OF FOREIGN AND COLONIAL PATENT LAWS.

We have already considered, in the preceding chapter, the existing international and colonial arrangements for the protection of inventors. Scope of chapter.

We propose in this chapter to give an account of some of the general features of foreign and colonial patent law (*a*).

For the full text of the enactments relating to foreign and colonial patent rights, Carpmael's "Patent Laws of the World," with its successive supplements, should be consulted. The law and practice in regard to foreign and colonial patents are constantly changing. Fresh supplements are brought out from time to time as the more important alterations occur. Carpmael's "Patent Laws of the World."

In the Appendix will be found a synopsis of the principal provisions of patent laws of various countries (*b*).

Subject-matter.—In regard to the subject-matter of a valid patent, the laws of most foreign countries are very much the same. Subject-matter of foreign and colonial patents.

The general rules are that:—

No patent will be granted for an invention which is contrary to law or morals;

Mere abstract principles are not patentable;

Pharmaceutical preparations are not good subject-matter (*c*), Principles. Pharmaceutical preparations.

(*a*) Patents for the protection of inventions and discoveries are granted in the following countries, colonies, and possessions:—

The Argentine Republic, each of the eight Australian colonies—viz., Victoria, New South Wales, South Australia, Western Australia, Queensland, New Zealand, Tasmania, and Fiji—Austria-Hungary, Bahama Islands, Barbadoes, Bechuanaland, Belgium, Bolivia, Borneo (British North), Brazil, British Guiana, British Honduras, Canada, Cape of Good Hope, Ceylon, Chili, Colombia, Congo, Costa Rica, Denmark, Ecuador, Finland, France, Germany, Gibraltar, Guatemala, Hawaiian Kingdom, Hong

Kong, India, Italy, Jamaica, Japan, Leeward Islands, Liberia, Luxembourg, Malta (Ordinance XIII. 1889), Mauritius, Mexico, Natal, Newfoundland, Nicaragua, Norway, Orange Free State, Peru, Portugal, Russia, St. Helena, Salvador, Sierra Leone, South African Republic, Spain, Straits Settlements, Sweden, Switzerland, Trinidad, Tunis, Turkey, United States, Uruguay, Venezuela, Windward Islands.

(*b*) Pages 862 *et seq.*

(*c*) So called "patent medicines" in England are quite distinct from letters patent for inventions. Medicine stamps appropriated to a particular medicine can be obtained from the Secretary,

and an application for a patent must be limited to a single principal object ;

Foods.
Processes.
War.

Prepared foods are frequently not subject-matter of a patent, and sometimes also chemical products. In Switzerland processes, and in Russia inventions relating to purposes of war or national defence, are not patentable.

Novelty.

Novelty is a necessary incident of every valid patent, although considerable variation is exhibited in the extent to which anticipation is considered sufficient to avoid a grant. Even in those countries where no preliminary examination upon this point is held, *e.g.*, France and Spain, want of novelty in the subject-matter of an invention is still a ground of revocation.

Improvements—additions.

Patents of improvements—Certificates of addition.—In France the patentee has one year during which he has priority of all other persons in patenting improvements in his invention, and will be granted a “certificate of addition” for any improvement which he may so make. After the end of the first year he may likewise obtain certificates of addition for improvements, but the patentee has no priority over other persons, and any one else making any improvement may obtain a “patent of improvement.” Certificates of addition expire with the original patent, of which they indeed are considered to form part. No annual taxes are payable on certificates of addition. Very similar provisions exist in several other countries, such as Belgium, Germany, Spain, Italy, Argentine.

Who may be patentee.

Who may apply.—Patents are granted generally to the true and first inventor of any patentable invention, whether he be a citizen or an alien, or to his legal representative or assignee, or to his duly authorized agent. In Germany the first applicant is entitled to the patent.

Declarations.

Declarations.—In the United States, Canada and Queensland, an oath or declaration that he believes himself to be the true and first inventor is required from every applicant who applies for a patent on that ground.

In France and most of the continental countries, upon the other hand, no oath or declaration is required, but the applicant is assumed to be the true and first inventor till the contrary be proved.

Stamps and Taxes, Inland Revenue, Somerset House, W.C., to whom all communications with respect to their preparation or supply should be addressed. The use of appropriated medicine stamps does not have the effect of

letters patent; but such stamps are only supplied to the person for whose use and at whose cost the plate from which they are printed was prepared, or to his authorized agent.

In Germany, whoever first applies for a patent is entitled to the grant. But the claim of a petitioner will not be allowed if the essential contents of his application have without permission been taken from the descriptions, drawings, models, implements, or contrivances of another person, or from a method of manufacture used by the latter, if such person raises opposition on that account.

Official examination.—A preliminary examination is held in all foreign countries, and in the principal British colonies, into the formal sufficiency of applications and other documents relating to letters patent.

Official examination.
As to formal sufficiency of application, &c.

In some countries, such as the United States, Germany, Sweden, Norway and Russia, there is a strict preliminary examination, at the instance of the Patent Office, into the novelty of every invention for which protection is demanded.

Official examination as to novelty, &c.

In other countries, such as France, Austria-Hungary, and Spain, there is no official examination as to novelty, but the patent expressly purports to be granted "without guarantee of the government."

As to novelty of invention.

Date of grant.—In France, Luxemburg, Belgium, Sweden, Norway, and some other countries, and most of the British colonies, a patent dates from the day of filing the application.

Date of patent.

Day of application.

In the United States, Denmark, Russia, Spain, Austria-Hungary, and many other countries, a patent dates from the day of issue.

Day of issue.

In Germany, however, the term of a patent commences with the day following the day of application.

Duration of grant.—The duration of foreign and colonial patents varies to a considerable extent in different countries, the average duration being about fourteen years.

Duration of patent.

The term of a patent in the United States of America is seventeen years. When the invention, however, has been previously patented abroad, the term of the American patent is so limited as to expire with the foreign patent, or if there be more than one, with that which has the shortest term. In no case does an American patent for such an invention remain in force for more than seventeen years. This rule has been very rigorously enforced in the United States in the past. Thus a British patent was held to expire in fourteen years from its commencement, even if the term is prolonged by the Judicial Committee. In recent decisions, however, it has been held that where a patentee, possessed of a foreign patent of prior date to the United States patent granted for a short time, has the option of extending the same as a matter of

United States.

Falling of patents with expiry of previous foreign patent.

right, then the United States patent does not expire so long as such foreign patent is maintained in force. For instance, an Italian patent granted for one year can be prolonged from year to year as a matter of right to fifteen years, and if so prolonged the United States patent would not expire until the end of the fifteen years. On the other hand, it is presumed that a United States patent would lapse if a prior foreign patent for the same invention were allowed to lapse through non-payment of tax. For instance, although the British patent is granted for fourteen years, and it were allowed to lapse at the expiration of the fourth year, through non-payment of tax, the United States patent of subsequent date would also lapse (*d*).

In nearly every country, except Great Britain, Sweden, Norway and Germany, similar provisions exist.

Duration dependent on merit of invention,

In some countries, *e.g.*, the Argentine Republic, the duration of a patent grant depends upon the merit of the invention and the wish of the inventor.

or character thereof.

In Spain, the duration of a patent depends on the character of the invention protected by it. If the subject-matter is entirely new and original, the term is twenty years. If the invention has not yet been publicly worked in Spain, or patented abroad for more than two years, the patent is granted for ten years. If an invention, though neither original nor entirely new, has not yet been worked in Spain, a patent for five years will be granted to the person who first introduces the manufacture into the Spanish dominions.

Extent of grant.

Extent of grant.—As a general rule, a foreign patent extends, or may readily be extended, to all the territories comprised within, and all the colonies and possessions of, the State which grants it (*e*). Thus, on the establishment of the dual system in Austria-Hungary, it was decided by special agreement between the Ministers of Austria and Hungary, that the Imperial Decree of August 15th, 1852, which contained the Austrian law and practice in regard to inventions,

(*d*) There was a similar provision in the United Kingdom under the Patent Law Amendment Act, 1852, s. 25.

(*e*) Before the Patent Law Amendment Act, 1852, a patent could be granted in England to include her Majesty's colonies and plantations abroad upon payment of an additional fee. An additional clause was then inserted in the patent granting the privileges, "also in our Islands of Jersey, Guernsey, Alderney, Sark and Man, and in all our colonies and plantations abroad." But after the passing of that

Act it was not usual to grant patents with this clause. All the patents, however, extended to the Channel Islands and Isle of Man. Under the Act of 1883, a patent is to issue for the United Kingdom and Isle of Man only. But as the prerogative of the Crown is expressly saved by that Act, the sovereign could apparently legally still extend the grant as before. In some of the colonies, however, special statutes exist, where her Majesty may, by her assent thereto, have waived her prerogative rights.

should remain in force throughout the whole Empire. In accordance with this agreement, the respective Ministers of Commerce submit for mutual approval the inventions for which they intend granting patents, and subsequently to such approval each ministry issues patents, bearing identical dates, for its respective division of the Empire. Thus an inventor desirous of securing an exclusive right to his invention in Austria-Hungary, must provide himself with two patents. These are, however, granted on a single application addressed at the choice of the applicant to either the Austrian or the Hungarian Ministry of Commerce, and on one payment of the fees (*f*). An Austria-Hungarian patent extends also to Bosnia and Herzegovina (*g*).

In like manner, French and Spanish patents extend to the colonies of those countries respectively.

Payments.—In the United States, and in several of our colonies, Taxes. when a patent has once been granted, no further payment is required to entitle the patentee to the enjoyment of his privilege during the full term prescribed in the grant.

As a rule, however, the duration of a patent is made subject to the payment of certain taxes.

Compulsory licenses.—In India, in the chief British colonies, in Germany, and the Argentine Republic, compulsory licenses may be granted as in England. Compulsory licenses.

The patent laws of every foreign country of importance, with the exception of the United States and of most British colonies, require patented inventions to be “worked” within a prescribed period after the date of the grant, upon pain of forfeiture of the patent right. In such countries patentees are also required, under the same penalty not to discontinue the use of their inventions within the territories of such countries for more than a specified period. Compulsory working, &c.

The compulsory working clauses in foreign and colonial patent laws are not enforced with uniform strictness. In France, for instance, they appear to be directed chiefly against voluntary and calculated inactivity on the part of a patentee, and it seems to be sufficient if the essential parts of an invention are worked within the prescribed time.

Importation of patented articles.—In Canada, after the first year, France, Turkey, and Venezuela, a patentee who has imported articles Importation of patented articles.

(*f*) Parliamentary Report, 1873, C. 741, p. 3. (*g*) Law of December 20th, 1879, s. 9.

manufactured abroad, and similar to those which are protected by his patent, forfeits all his rights (*h*).

In France, however, the Minister of Agriculture, Commerce, and Public Works, may authorize the introduction (1) of models of machines; and (2) of articles made abroad intended for public exhibitions, or for trials made with the consent of the government.

Marking.

Marking of patented articles.—In many countries, as in England, there is no obligation to mark patented articles as such. In most countries it is an offence, however, to mark articles as patented which have not been protected.

In France the patentee need not mark his articles as patented, but if he does he must add the words "*Sans garantie du Gouvernement*," or its equivalent, the letters "S. G. D. G."

In Germany, also, there is no obligation to mark the words "Deutsches Reichs Patent," or the letters "D. R. P.," which, however, it is recommended to the patentee to put on the patented articles.

In the United States all articles must be marked as patented with the date of the patent, but if the nature of the articles render this inconvenient, the wrapper, package or label, must be so marked. There is no penalty, however, for non-compliance with this provision, except that in an action for infringement the patentee must prove knowledge in the infringer that the article was patented.

Assignments and licences of patents.

Assignments, &c.—Assignments and licences of patents are recognised by all foreign and colonial laws. As a general rule no assignment is valid as regards third parties till it has been registered at the proper office, for which purpose it must be prepared in accordance with the requirements of each country.

Extension of term.

Extension of term.—Generally the maximum term of a foreign patent can only be extended by a special law. This is the case in the United States, France, Austria-Hungary, and other countries. A Spanish patent cannot, it seems, be prolonged.

In some of the British colonies, *e.g.*, Western Australia and New Zealand, similar provisions to those of our own law exists for obtaining the extension of the term of a patent.

Infringements.

Infringements.—In general, every interference with the rights of a patentee, either by the manufacture of the products or by

(*h*) But see Article V. of the International Convention, p. 606.

using the means forming the subject of his patent, constitutes an infringement.

In the United States the infringer of patent rights is liable to civil proceedings alone. These proceedings are similar to our own.

In most foreign countries, however, infringement is an offence punishable by fine, and in case of its repetition by imprisonment, as well as a wrong to be redressed by damages.

Provisions for the seizure and confiscation of the infringing articles are also found in most foreign laws.

Revocation of grant.—Most countries provide for the revocation of the grant of patent privileges if the provisions of the patent law are not complied with. Revocation.

Part II.

THE PATENTS ACTS, 1883 to 1888, CONSOLIDATED (*a*) AND ANNOTATED.

BEING,

46 & 47 VICT. c. 57.—An Act to amend and consolidate Act of 1883.
the Law relating to Patents for Inventions, Regis-
tration of Designs, and of Trade Marks.

[25th August, 1883.]

48 & 49 VICT. c. 63.—An Act to amend the Patents, Designs, and Act of 1885.
Trade Marks Act, 1883 (*b*).

[14th August, 1885.]

49 & 50 VICT. c. 37.—An Act to remove certain doubts respecting Act of 1886.
the construction of the Patents, Designs, and Trade Marks
Act, 1883, so far as respects the drawings by which specifica-
tions are required to be accompanied, and as respects exhibi-
tions (*c*).

[25th June, 1886.]

51 & 52 VICT. c. 50.—An Act to amend the Patents, Designs, and Act of 1888.
Trade Marks Act, 1883 (*d*).

[24th December, 1888.]

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:

(*a*) The form in which these Acts have been drawn renders consolidation a simple matter, without departing from the text of the Acts. The general text of the Act of 1883 is adhered to. The repealed parts are printed in italics, and the ad-

ditions in heavier type. The amending Act and section are quoted in the margin.

(*b*) For text at length, see Appendix, p. 725.

(*c*) *Ibid.*, p. 727.

(*d*) *Ibid.*, p. 728.

PART I.

PRELIMINARY.

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

Short title.

The principal Act of 1883, and the Amending Acts of 1885, 1886, and 1888, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888 (e).

The short titles of the amending Acts are respectively—

The Patents, Designs, and Trade Marks (Amendment) Act, 1885.

The Patents Act, 1886.

The Patents, Designs, and Trade Marks Act, 1888.

As we are concerned with patents only here, these Acts are frequently cited as the Act of 1883, Act of 1885, &c., or sometimes as the Patents Act, 1883, the Patents Act, 1885, &c.

Division of Act into parts.

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

Part I.—PRELIMINARY.

II.—PATENTS.

III.—DESIGNS.

IV.—TRADE MARKS.

V.—GENERAL.

In this work we are not concerned with Parts III. and IV., or with some sections of Part V. These portions of the Act are therefore omitted in this part of the work, though for completeness the whole of the Acts are given in the Appendix. Occasions may arise where a consideration of sections relating to trade marks or designs may be of use in considering the sections relating to patents.

Commencement of Act.

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.

Act 1888, s. 28.

The Act of 1888 shall, except so far as is thereby otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine.

There is no special provision as to time of commencement of the Acts of 1885 and 1886, so that they commence from the dates of those Acts, the 14th August, 1885, and the 25th June, 1886, respectively.

(e) Act of 1888, s. 29.

PART II.
PATENTS.

APPLICATION FOR ¹ AND GRANT OF PATENT.²

4. (1.) Any person,³ whether a British subject or not,⁴ **Sect. 4.**
may make an application for a patent.

(2.) Two or more persons may make a joint application⁵ for a patent, and a patent may be granted to them jointly.⁶

Persons
entitled to
apply for
patent.

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.⁷

Act 1885,
s. 5.
Power to
grant patents
to several
persons
jointly.

1 *Application for patent :*

For rules as to applications, Patents Rules, 1890, p. 565.

Outline procedure on applications, Chap. VI. p. 69.

Rival applicants, sect. 7, sub-sect. 5, pp. 438—440.

Application of true inventor where patent revoked on ground of fraud, sect. 26, sub-sect. 8, p. 475.

Application in fraud of first inventor, sect. 35, p. 491.

Deceased inventors, sect. 34, p. 491.

Correction of clerical errors in application, sect. 91, p. 509.

Amendment of application, sect. 7, p. 439 ; sect. 91 (a), p. 509 ;
Patents Rules, 1890, p. 566.

General form of application, Patents Rules, 1890, Form A,
p. 737.

Form of application by importer, Patents Rules, 1890, Form A1,
p. 738.

Applications sent by post, sect. 97, sub-sect. 1, p. 511.

Applications under International and Colonial Arrangements,
Chap. XX. p. 408 ; sect. 103, p. 516 ; and Patents Rules, 1890,
p. 568.

Form of application under Patents Rules, 1890, Form A2,
p. 739.

2 *Grant of patent :*

Grant and its effect, Chap. X, p. 190.

Effect of grant on Crown, sect. 27, p. 478.

Opposition to grant, sect. 11, p. 444 ; Chap. IX, p. 167 ; Patents
Rules, 1890, p. 573.

Date of grant, sect. 13, p. 451.

Sect. 4.

Extent, sect. 16, p. 454.

Term, sect. 17, p. 454.

One invention only, sect. 33, p. 490.

Assignment of grant, sect. 36, p. 492, and Chapter XI. p. 195.

Variations in form of grant, under this Act, pp. 530—536.

Coverture.
 Infancy.
 Lunacy.

3 *Any person*.—It may be laid down as a general proposition that there is now no limitation arising from incapacity—such as coverture, infancy (*f*), or lunacy (*g*)—upon the right to apply for a patent, so long as all proceedings are taken in due form, there is no inquiry at the Patent Office as to age, sanity, or coverture.

Corporation.

A body corporate, which is expressly (s. 117, sub-s. 1) included in the definition of "person," may be a patentee. But only as a joint patentee, as a corporation cannot apparently be an inventor; but, *semble*, a body corporate may be an applicant under sect. 103 (*h*).

Importers.

As to communications from abroad, and the position of importers, see note to s. 5, sub-s. (2).

Persons
 possibly
 incapacitated.
 Sovereign.
 Clergymen.
 Alien enemy.

The only persons as to whose capacity there still appears to be some doubt are the Sovereign, who cannot make a grant to herself (*i*); a beneficed clergyman, under the provisions of 1 & 2 Vict. c. 106, ss. 28—30 (*k*); and perhaps an alien enemy. This last point was raised in *Bloxam v. Elsee* (*l*), but not decided,—the patent being held invalid upon another ground. It has been doubted, says Webster (*m*), referring to this case, whether letters patent, taken out on a secret trust to be held for the benefit of a real inventor, who was an alien enemy, were void or not. To hold that such a trust could not exist would appear contrary to the spirit and policy of the patent law, in recognising communications from foreigners as good subject-matters for letters patent; but no action could be maintained by such alien, or by the trustee on his behalf, on any contract, on the ground that the resulting moneys might be employed against the country (*n*).

Query, whether alien enemy can be patentee.

(*f*) See s. 99, and *Cheavin v. Walker*, 1877, per Bacon V.-C., L. R. 5 Ch. D. 858.

(*g*) See s. 99.

(*h*) *Re Carez*, 1889, per Webster, A.-G., 6 P. O. R. 552.

(*i*) Hindmarch, p. 34. But see sect. 44, sub-s. 1, below, at p. 497, where it is provided that certain inventions may be assigned to the Secretary of State for War on behalf of her Majesty.

(*k*) *Hall v. Franklin*, 1838, 3 M. & W. 259. It may be doubtful whether the exercise of a patent privilege by a beneficed clergyman would not be a

trading within the meaning of the statute, and therefore prohibited by that Act. And if that be so, it may be questionable whether the grant of a patent privilege to such a clergyman would not be void, because the Queen's intent, namely, that the patentee should derive a profit from the exercise of the privilege, cannot take effect: Hindmarch, p. 35.

(*l*) 1825-27, 6 B. & C. at p. 178; 9 D. & R. 224.

(*m*) Letters Patent for Inventions, p. 23.

(*n*) See foot-note, p. 23, *ibid.* Also 1 Web. P. O. p. 418 (note).

A member of an official commission or committee cannot take out a patent for the subject-matter of their official investigation, or for the results of such investigation, embodied in an official report to the public authorities (o). Such a report belongs absolutely to the State. "The consideration for every patent is the communication of useful information to the public. What consideration is there when the information is already the property of the State?" (p).

Sect. 4.

Member of official commission, when disqualified.

Probably no official in the Patent Office would be allowed to apply for or hold any interest in a patent.

Official in Patent Office.

4 *Whether a British subject or not.*—An alien *amoy* (a) resident in this country, or (b) resident abroad, may obtain a patent (q).

Aliens.

The dictum of Lord Cairns, C., however, in *Re Wirth's Patent* (r); that a patent might be granted to an alien *resident abroad for an invention communicated to him* by another alien, also resident abroad, is no longer an accurate statement of the law, as Form A1, Patents Rules, 1890 (s), contemplates a resident applicant only in such cases.

5 *Joint application.*—For form of application, see Patents Rules, 1890, Form A, or Form A1, pp. 737, 738.

Joint applicants.

This part of the sub-section is declaratory of the existing law.

6 *Joint grantees.*—As to joint grantees, see Chap. X., pp. 192 *et seq.*; form of grant, pp. 533, 534.

Joint grantees.

Where a patent for inventions is granted to two or more persons in the usual form, each one may use the invention without the consent of the others, and without being liable to account to them for the profits made by such use (t).

The power of one of several co-grantees of letters patent to grant a valid licence without the consent of the others probably depends upon the authority conferred by the granting and prohibitory clauses. Where the grant is, as in *Mathers v. Green* (t), to A., B., and C., their executors, administrators, and assigns, "that they, by themselves and *such others as they may agree with*, and no others, may use the invention," then, unless the effect of these words is modified by the prohibitory clause, it would seem that none of the co-grantees could grant a licence without the concurrence of all the others. In *Mathers v. Green* (u) Lord Romilly held that one of several co-grantees

Powers of co-grantees.

(o) *Patterson v. Gas Light and Coke Co.*, 1876-77, L. E. 2 Ch. D. 833; L. R. 3 A. C. 239.

(p) *S. C.*, L. R. 2 Ch. D., per James, L. J., at p. 833.

(q) *Beard v. Egerton*, 1846, 3 O. B. 97; *Chappell v. Purday*, 1845, 14 M. & W. 318.

(r) 1879, 12 Ch. D. at p. 304.

(s) *Infra*, p. 738.

(t) *Mathers v. Green*, 1865-66, L. R. 1 Ch. 29, per Lord Cranworth, L. C., reversing the decision of Lord Romilly, M. R. Cp. also *Powell v. Head*, 1879, L. R. 12 Ch. D., per Jessel, M. R., at p. 650. See also p. 193, note (t).

(u) 34 Beav. 170.

Sect. 4. would be bound to account to the others for royalties received from a licensee. This point was not judicially reviewed on the appeal.

7 Patents are now frequently granted to joint applicants where some only are inventors as here provided. In this way a capitalist or other person who has assisted the inventor obtains an interest in, and control over, the invention from the date of application.

Application
and specifi-
cation.

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 form¹ 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.²

Declaration.

(2.) An application must contain a declaration³ 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,⁴ and for which he or they desires or desire to obtain a patent; and must be accompanied⁵ by either a provisional or complete specification.

Specification.

Act 1885,
s. 2.

5 & 6 Will. 4,
c. 62.

The declaration may be either a statutory declaration, under the Statutory Declarations Act, 1835,⁶ or not, as may be from time to time prescribed.

(3.) A provisional specification must describe the nature of the invention,⁷ and be accompanied by drawings, if required.⁸

(4.) A complete specification, whether left on application or subsequently,⁹ must particularly describe and ascertain the nature of the invention, and in what manner it is to be performed,¹⁰ and must be accompanied by drawings, if required.⁸

Act 1886,
s. 2.

The same
drawings may
accompany
both specifi-
cations.

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.

(5.) A specification, whether provisional or complete, must commence with the title,¹¹ and in the case of a complete specification must end with a distinct statement¹² of the invention claimed.¹³

1 *Such other form.*—See Patents Rules, 1890, r. 5, &c., p. 560, and Forms A, A1, A2, *ib.* pp. 537 *et seq.*

The application must be signed by applicant. Patents Rules, 1890, r. 8, p. 561.

2 *Prescribed manner.*—See Patents Rules, 1890, *infra*, pp. 562 *et seq.* Applications by post, sect. 97, sub-sect. (1), p. 511.

Proof of delivery through post, sect. 97, sub-sect. (2), p. 511.

3 *A declaration.*—For form of declaration, see Patents Rules, 1890, r. 6 (3), and note thereto, p. 561; also Forms *infra*, pp. 537—539.

By 47 & 48 Vict. c. 62, s. 9, a statutory declaration in connection with an application for a patent was exempted from the stamp duty of 2s. 6d., chargeable on statutory declarations under the Stamp Act, 1870.

For declaration by representative of deceased inventor, sect. 34, p. 491.

For declaration on behalf of infant, lunatic, &c., sect. 99, p. 512.

4 *True and first inventor.*—The definition of invention under the present Act is the same as it was under the Statute of Monopolies. See sect. 46, *infra*, p. 501.

The best general interpretation of the words “true and first inventor,” is that given by Lord Lyndhurst, C., in *The Househill Co. v. Neilson* (y):—

Meaning of “true and first inventor.”

“If the invention is in use at the time the grant is granted the man cannot have a patent, although he is the original inventor: if it is not in use he cannot obtain a patent if he is not the original inventor. He is not called the inventor who has in his closet invented it but who does not communicate it (z); the first person who discloses that invention to the public is considered as the inventor. The party must be *an* inventor: you need not say *the* inventor, because another may have invented and concealed it; but in addition to his being an inventor others must not use the invention at the time of the patent.” The cases which illustrate this point turn chiefly on confidential and experimental user, which are considered above (a).

An inventor who first communicates invention to public.

By the common law (b), affirmed by the Statute of Monopolies,

First importer.

(y) 1843, 1 Web. P. C. 719.

(z) Cp. *Dollond's Patent*, 1776, 1 Web. P. C. 43.

(a) Pages 223 *et seq.*

(b) *Hasting's Patent*, 1567, 1 Web. P. C. 6; *Matthey's Patent*, Eliz., 1 Web. P. C. 6; *Humphrey's Patent*, 1 Web. P. C. 7; *Darcy v. Allin*, 1602, 1 Web. P. C. 6.

Sect. 5.

Importers.

and a series of judicial decisions (c), a patent might be granted to the first importer into this realm of a foreign invention. The words "within the realm" were not, however, reproduced in sect. 5, sub-s. (2), of the Patents, &c. Act, 1883; and as the form of application originally prescribed by the Act (d), drew no distinction between an original and a communicated invention, it seemed as if the right of the first importer of an invention from abroad to obtain a patent in respect of it had implicitly been taken away, and that a person taking out a patent, and making a declaration as required by this sub-section, that he was a true and first inventor, when in truth he was only the importer of a communicated invention, made a false suggestion, which, according to the dictum of Wood, V.-C., in *Milligan v. Marsh* (e), would avoid the grant. The Patents Rules of 1883, however, gave a form specially applicable to communications from abroad. There is also the definition of an invention given in the present Act (f), which defines an invention to be any manner of new manufacture, the subject-matter, and grant of privilege within the meaning of sect. 6 of Statute of Monopolies. Many applications are now made by agents as importers, under Form A1.

Another difficulty, however, remains.

The Patents Rules, 1890, r. 6, provide that "an application for a patent containing the declaration mentioned in sub-section 2 of section 5 of the principal Act shall be made either in the Form A or in the Form A1 set forth in the second schedule hereto, as the case may be." Form A contains a declaration that the applicant is "the true and first inventor" of the subject-matter in respect of which a patent is claimed. Form A1 deals with communicated inventions. Suppose that a person in possession of a communicated invention uses Form A instead of Form A1, is the patent which he obtains liable to be avoided as containing a false suggestion? In the recent case *Re Avery's Patent* (g); Stirling, J., appears to have considered that such a patent would be valid; but the point has not been expressly decided.

Re Avery's Patent.

Rule as to communications not

A communication made in England by one British subject to another British subject cannot be patented by the receiver of the communi-

(c) *Edgeberry v. Stephens*, 1 Web. P. C. 35; *Walton v. Bateman*, 1842, 1 Web. P. C. 615; *Beard v. Egerton*, 1846, 3 C. B. 97; *Nickels v. Ross*, 1849, 8 C. B. 679; *In re Lame-naude's Patent*, 1850, 2 Web. P. C. 169; *Steedman v. Marsh*, 1856, 2 Jur. N. S. 391; *Marsden v. Saville St. &c. Co.*, 1878, per Jessel, M. R., 3 Ex. D. 203, 205.

(d) Form A, *infra*, p. 737.

(e) 1856, 2 Jur. N. S. 1083. Cp. also, *Renard v. Levinstein*, 1864-65, 10 L. T. N. S. 177; *Plimpton v. Malcolmson*, 1876, L. R. 3 Ch. D. at p. 555, per Jessel, M. R. Scotland is "within the realm" in the sense of the 6th section of the Statute of Monopolies.

(f) Sect. 46.

(g) 1887, 4 P. O. R. 163; 36 Ch. D. 307, 318, 324.

cation, so as to make the receiver the true and first inventor within the meaning of the patent laws (*h*).

As to fraud of importer, see *Edmund's Patent*, 1886, Griffin, P. C. 281, and p. 179.

5 *Must be accompanied by, &c.* :—

For origin and development of specification, see Chap. VIII. sect. 1, p. 83.

Forms of specifications, Appendix, p. 759.

As to relative advantages and disadvantages of leaving complete specification in first instance, see Chap. VI. p. 71.

Publication of specifications, sect. 13, p. 451.

Indexes of, sect. 40, p. 495; sect. 101, sub-sect. (1), p. 513.

6 *Statutory Declarations Act*, 1835.—5 & 6 Will. IV. c. 62. See this statute in Appendix, *infra*, p. 636.

Sect. 11 of this statute was repealed by sect. 113 of the Act of 1883. See pp. 522, 556.

Before the Statutory Declarations Act, 1835 (5 & 6 Will. IV. c. 62), s. 11, the application (then a *petition*) for letters patent was verified by an *affidavit* sworn before a master, or a master extraordinary, in Chancery. "The solemn declaration," introduced by the Statutory Declarations Act, was quite distinct from the *petition* (*i*), but afterwards formed part of the application (*k*).

There is now no *statutory* declaration in an application for a patent. It is a simple declaration. But see Patents Rules, 1890, rr. 24—29, as to applications under International and Colonial Arrangements.

7 *A provisional specification, &c.* :—

As to essentials of provisional, see Chap. VIII. sect. 3, p. 95.

Reference to examiner, sect. 6, p. 436.

Amendment of sect. 7, sub-sect. (1), p. 438. Chap. VIII. sect. 5, p. 145.

Comparison of, with complete, sect. 9, sub-sect. (1), p. 441.

Variance between provisional and complete, sect. 11, sub-sect. (1), p. 444.

Chap. VIII. sect. 4, sub-sect. (1), p. 97.

8 *Drawings*.—For the rules as to drawings, and for the existing regulations as to size, paper, quality of ink, scale, &c., see Patents Rules, 1890, rr. 30—33, pp. 571, 572.

The words *if required* are new, the use of drawings having formerly

Sect. 5.

applicable to communications in this country.

Fraud of importer.

(*h*) *Marsden v. Saville St. &c. Co.*, 1878, per Jessel, M. R., 3 Ex. D. 204. 1852, Appendix p. 665.
 (*k*) See *infra*, p. 666. Cp. also, Patents Rules, 1890, r. 6, p. 560.

Sect. 5. been permissive, not compulsory (*l*), and mean if required by the Comptroller-General.

A specification may consist simply of a drawing, and a description of it, provided that the invention is distinctly described and claimed (*m*).

Subject to this proviso, drawings are taken to be part of the specification (*n*).

9 *Whether left on application or subsequently.*—See Chap. VI. pp. 70 *et seq.*

10 *Complete specification* :—

Reference to examiner, sect. 9, p. 441.

Time for leaving, sects. 8, 9, pp. 440, 441.

Acceptance of, sect. 9, sub-sect. 4, p. 442.

Comparison with provisional, sect. 9, sub-sect. 1, p. 441.

Protection under, sect. 15, p. 453.

Amendment of, sect. 18, p. 455; and Chap. VIII. sect. 5, p. 434.

Transmission of copies of, sect. 100, p. 512.

Board of Trade may require duplicates of, sect. 101, sub-sect. 1 (c), p. 513.

Forms of, Patents Rules, 1890, p. 740; and Forms, p. 759.

This sub-section is declaratory of the common law.

Nature of complete specification.

While an exhaustive definition of the words “must particularly describe and ascertain” falls beyond the scope of this note, it may be possible to indicate with general accuracy the *tests of sufficiency* which the Courts have from time to time applied in the construction of specifications:

They are—Does the specification contain a full and *bonâ fide* disclosure of all material facts and details within the knowledge of the patentee at the time of specifying? (*o*).

And—Is the description of the invention sufficiently accurate to enable a careful and competent workman to make the invention with-

(*l*) *Boulton v. Bull*, 1795, 2 H. Bl. 481; per Buller, J.; *Ex parte Fox*, 1812, 1 Web. P. C. 431, per Lord Eldon; *Bloxam v. Elsee*, 1825, 1 C. & P. 564, per Abbott, C. J.

(*m*) *Brunton v. Hawkes*, 1820, 1 Carp. P. C. 410 per Abbott, C. J.; *Foxwell v. Bostock*, 1864, 10 L. T. N. S. 146, per Lord Westbury, L. C.; *Poupard v. Fardell*, 1869, 18 W. R. 129, per Malins, V.-C., overruling *Ex parte Fox*. *Provided that, &c.*—*Macfarlane v. Price*, 1816, 1 Web. P. C. 74; *Fairbairn v. Household*, 1886, 3 P. O. R. 266. See also *supra*, p. 107.

(*n*) *Williams v. Brodie*, cited in *R. v. Arkwright*, 1785, 1 Web. P. C. 71; *Hastings v. Brown*, 1853, 1 E. & B.

454; *Morgan v. Seaward*, 1836, 1 Web. P. C. 173; *Morton v. Middleton*, 1863, 1 Cr. & S. 3rd Ser. 722-24; *Daw v. Eley*, 1867, L. R. 3 Eq. 500, n.; 14 W. R. 126.

(*o*) *Full and bonâ fide*—*Cartwright v. Eamer*, 1800, cited 14 Ves. 131, 136, per Lord Eldon; *R. v. Arkwright*, 1785, 1 Web. P. C. 66, per Buller, J.; *Bovill v. Moore*, 1815-16, Dav. P. C. 361, per Gibbs, C. J.; *Sturtz v. De la Rue*, 1828, 5 Rus. 324, per Lord Lyndhurst, L. C.; *Coles v. Baylis*, 1886, 3 P. O. R. 180, per Bacon, V.-C.

Within the knowledge of the patentee at the time of specifying—*Crossley v. Beverley*, 1829, 9 B. & C. 64, per Bayley, J.

out any further aid than that which his practical knowledge and the specification afford him? (*p*).

Sect. 5.

For a fuller discussion of this subject, see Chap. VIII. sect. 4 (2), p. 118.

11 *The title.*—As to the title generally, its nature, variance between title and specification, and amendment of, see Chap. VIII. sect. 2, p. 89.

Report of examiner upon title, sect. 7; sub-sect. 1, p. 438.

Comptroller may refuse application where title insufficient, *ibid.* p. 438.

The title must express correctly and concisely the subject-matter of the invention; and ought to be neither too narrow to include the whole invention, nor so wide that it includes more than the patentee has invented.

Nature of title.

The introduction of the provisional specification, and the power to require amendments, now conferred upon the comptroller-general, have made the old cases as to variance between the title and the specification of less importance; but a summary of the law will be found above, at p. 91, to which the reader is referred.

Variance between title and specification.

12 *A distinct statement.*—“Distinct” means independently of and apart from the mere description of the nature of the invention, and of the way in which it is to be carried into effect (*q*).

Meaning of “distinct statement.”

13 *The claim.*—The important subject of claims is fully dealt with in Chap. VIII. sect. 4 (4), p. 97.

“The object of a claim is, to restrict and cut down what might be suggested as the claim made by the previous part of the description, so as to show what it does consist of, and to prevent the patent from being defeated in consequence of words being used which might lead to the inference that something which was not intended to be claimed was claimed, and then the patent being defeated by there being included in the previous part of the specification that which was not new but old” (*r*).

The claim.

“It is not the function of a provisional specification to claim anything. The claim is, in point of fact, a disclaimer: it shows what parts, and what parts only, of the whole invention you mean to protect by your patent” (*s*).

Object of claim.

(*p*) Cp. *Cartwright v. Eamer*, *ubi supra*; *Bloxam v. Elsee*, 1825-27, 1 C. & P. 558, per Abbott, C. J.; *Plimpton v. Malcomson*, 1875, L. R. 3 Ch. D. 568, per Jessel, M. R.; *Bray v. Gardner*, 1887, 4 P. O. R. 406, per Kekewich, J.; *Edison v. Wood-*

house, 1887, 4 P. O. R. 92, 107, 108.

(*q*) *Siddell v. Vickers*, 1888, 5 P. O. R. 428.

(*r*) *Jackson v. Wolstenholmes*, 1884, 1 P. O. R. 108, per Cotton, L. J.

(*s*) *Lucas v. Miller*, 1885, 2 P. O. R. 159, per Kay, J.

Sect. 5.

“The office of the claim is to protect the patentee from the danger of being supposed to make claims beyond those which he elects to make, and it must therefore limit his patent rights to what it fairly embraces” (t).

Sect. 5,
sub-s. 5, direc-
tory merely.

A further question arises as to the effect of nonconformity to the directions in sect. 5, sub-s. (5).

This matter is dealt with by Cotton, L. J., in *Siddell v. Vickers* (u): “There is nothing in the Act which says that if the complete specification does not contain that ‘distinct statement’ the patent shall be bad. There are things in sect. 5 the neglect of which it can hardly be said will make the patent bad. It may be the neglect to comply with some of these requisites will make the patent bad, not because there is any enactment to that effect, but because, according to law, the specification must so describe the invention that it can be known what it is, and that the public can know how that invention is to be carried into operation.” His lordship then points out that any objection on that ground would now require to be taken under sect. 26, sub-s. (3), (x), and adds, “But, in my opinion, what is here required is apparent on the face of the specification, and whether the Act is complied with or not, it must be considered as a mere direction—a matter to be attended to by the comptroller or law officer when the matter comes before him; and if they are satisfied, unless independently of this provision the specification is so indefinite as to make the patent bad, the mere fact that there is not a compliance with this, or a proper compliance with other provisions here, will not of itself, because sect. 5 is not obeyed, make the patent bad, though it may be that the law officer might require it to be altered” (y).

Reference of
application to
examiner.

6. The comptroller¹ shall refer every application to an examiner,² who shall ascertain and report³ to the comptroller whether the nature of the invention has been fairly described,⁴ and the application, specification, and drawings (if any) have been prepared in the prescribed manner,⁵ and the title⁶ sufficiently indicates the subject-matter of the invention.

1 *The comptroller* :—

This is the first mention of the comptroller in the Act.

(t) *Easterbrook v. Great Western Rail. Co.*, 1885, 2 P. O. R. 208, per Wills, J.

(u) 1888, 5 P. O. R. at p. 428.

(x) See p. 474.

(y) Cp. Fry, L. J., *S. C.*, at p. 433.

2 *The examiners.*—As to examiners generally, see Chap. V. sect. 3, Sect. 6.
p. 60.

Appointment of, sect. 83, sub-s. (1), p. 503.

Reference of specifications to, sect. 9, sub-s. (1), p. 441.

Reports by, sects. 7—9, sub-s. 2, pp. 439—441.

3 *Reports of examiners.*—These reports are private, and are only liable to production under sect. 9, sub-s. (5), p. 442.

The examiner has to report on the following points:—

Is the nature of the invention fairly described?

Have the application and specification, or specifications and drawings, if any, been prepared in the prescribed manner?

Does the title sufficiently indicate the subject-matter of the invention?

Is more than one invention claimed?

And where there is a provisional specification left in the first instance, the examiner has to report on the second reference to him with the complete specification, whether the complete describes substantially the same invention as the provisional specification.

4 *Fairly described.*—See note *supra*, sect. 5, sub-s. (4).

5 *Prescribed manner.*—Cp. Patents Rules, 1890, pp. 737 *et seq.*

6 *The title.*—See note *supra*, sect. 5, sub-s. (5). The provisional specification “must describe the nature of the invention.” It is now sufficient for the title to indicate its subject-matter.

As to what may be subject-matter of invention, see Chap. IV. p. 16.

[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.*

Power for
comptroller to
refuse applica-
tion or
require
amendment.
Repealed.
Act 1888,
s. 2.

(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.*

Sect. 7.

(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.]*

**Act 1888,
s. 2.**

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

“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,¹ the comptroller may refuse to accept the application,² or require that the application, specification, or drawings be amended before he proceeds with the application;³ 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.

Appeal to law
officer.

“(2.) Where the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer.⁴

Hearing by
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.

Notice of
acceptance.

“(4.) The comptroller shall, when an application has been accepted, give notice⁵ thereof to the applicant.

Rival
applications.

“(5.) If, after an application for a patent has been made, but before the patent thereon has been sealed,⁶ another application for a patent is made, accompanied by a specification bearing the same or 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.”⁷

¹ See note to sect. 6, *supra*.

2 Here the words "the comptroller may refuse to accept the application," and the last clause of the sub-section, are new. Sect. 7.

3 *The comptroller may require that the application, &c., be amended.*
—See Forms of Letters by Comptroller, *infra*, p. 750.

The grounds on which the comptroller may require amendment are—that the nature of the invention is not fairly described; that the application, specification, &c., have not been prepared in the prescribed manner; or that the title does not sufficiently indicate the subject-matter of the invention. Grounds on which comptroller may require amendment.

He has no authority to refuse an application, or to require amendment, because the subject-matter is not useful, or not novel, or impracticable.

There has not been, as yet, any judicial construction of the words "if the examiner reports that *the nature of the invention is not fairly described*;" and the precise scope of the examiner's preliminary duty is therefore uncertain. Scope of examiner's preliminary duty.

But it seems improbable that the Legislature intended anything more than that the examiner should ascertain and report whether the specification *on the face of it* fairly describes the invention. The most absurd invention would be passed by an examiner, provided that the inventor's meaning were intelligible. The decision of Sir Richard Webster, A.-G., in *Brown's Patent (p)*, lends colour to this view of the character of the examiner's duty.

As to voluntary amendment by the patentee, see notes to sect. 18, p. 455.

4 *The law officer.*—This is the first mention of the law officer in the Act.

As to definition of law officer, sect. 117, sub-sect. (1), p. 525.

Appeals to, against refusal of comptroller-general to accept complete specification, sect. 9, sub-sects. (2, 3), p. 441.

Appeals to, on opposition, sect. 11, sub-sects. (2, 3), pp. 444, 445.

Appeals in regard to amendments of specifications, sect. 18, sub-sects. (3—7), p. 456.

Costs in proceeding before, sect. 38, pp. 492, 493.

Power to examine witnesses on oath, *ibid.*

Power to make rules, *ibid.*

Power to summon expert, *ibid.*

The appeal to the law officer is new.

See "Rules regulating the Practice and Procedure on Appeals to the Law Officers," and notes thereon, *infra*, Appendix, p. 589.

5. *Notice of acceptance.*—See form of such notice, *infra*, p. 758.

Sect. 7.

The application is accompanied by a provisional or a complete specification (Patents Rules, 1890, r. 21, p. 567).

The acceptance is to be advertised in the Official Journal of the Patent Office, *ibid.*

6 Sealing.—As to sealing, see sects. 12, 13, pp. 449—451.

Seal of Patent Office, see sect. 84, p. 503.

7 Rival applications.—This sub-section amends the corresponding sub-section in the Act of 1883, in the following particulars:—(1) the report of the examiner, with regard to conflicting and pending applications, is dispensed with; (2) the comptroller's power to decline to proceed with the second application is discretionary.

Time for leaving complete specification.

8. (1.) If the applicant does not leave a complete specification with his application,¹ he may leave it at any subsequent time within nine months² from the date of application.³

Act 1885, s. 3. Extension of time.

A complete specification may be left within such extended time,⁴ not exceeding one month after the said nine months, as the comptroller may on payment of the prescribed fee allow.⁵

Abandonment of application.

(2.) Unless a complete specification is left within that time the application shall be deemed to be abandoned.⁶

1 Complete specification with application.—As to leaving complete specification in first instance, see sect. 5, sub-sect. (2), and Chap. VI. p. 71.

2 Nine months.—Month here means calendar month: 13 & 14 Vict. c. 21, s. 4.

3 From the date of application.—The *day* of the date is excluded (*q*). As to other "excluded days," see sect. 98, pp. 511, 512.

4 Extension of time.—The extension of time for one month is readily granted by the comptroller, the general reason being experiments not completed, or desire to apply for and obtain foreign patents.

5 Prescribed fee.—The fee is 2*l.*, see p. 588, Fee, No. 39.

6 Abandonment of application.—Under the Act of 1852, it was held that the abandonment of a provisional specification did not amount to

(*q*) Cp. *Russell v. Ledsam*, 1845, 14 M. & W. 574, per Parke, B.; *Williams v. Nash*, 1859, 5 Jur. N. S. 696.

a publication of it, so as to invalidate a patent upon a subsequent application for the same invention.

Sect. 8.

On the 10th April, 1858, A. obtained provisional protection for three heads of invention, one of which was comprised in a provisional specification of the 17th March previous, which latter he thereupon abandoned, and completed his patent before the provisional specification of the 17th March had been made public by the Patent Office, under the 29th section of the Patent Law Amendment Act, 1852 (15 & 16 Vict. c. 83). It was held that there had been no such publication as would invalidate the patent (*r*).

Cases under Act of 1852.

In *Lister v. Norton*, under substantially the same circumstances as before, it was held that the abandonment of the first provisional specification would not avoid the patent, even if actual user during the currency of the first provisional specification can be shown (*s*).

This case opens an important question as to how long an inventor can obtain protection by filing provisionals in succession. He appears to be protected from acts of user, and under the Act of 1885, s. 4, the specifications accompanying an abandoned application are never exposed to public inspection.

9. (1.) Where a complete specification is left after a provisional specification,¹ the comptroller shall refer both specifications to an examiner² for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner,³ and whether the invention particularly described in the complete specification is substantially the same⁴ as that which is described in the provisional specification.⁵

Comparison of provisional and complete specification.

(2.) If the examiner reports⁶ that the conditions hereinbefore contained have not been complied with, the comptroller may refuse⁷ to accept the complete specification unless and until the same shall have been amended to his satisfaction;⁸ but any such refusal shall be subject to appeal to the law officer.⁹

(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.

(*r*) *Oxley v. Holden*, 1860, 8 C. B. N. S. p. 708, per Erle, C. J.

(*s*) *Lister v. Norton*, 1886, 3 P. O. R. 200.

Sect. 9.

(4.) Unless a complete specification is accepted¹⁰ within twelve months from the date of application,¹¹ then (save in the case of an appeal¹² having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void.¹³

Act 1885,
s. 3.

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.¹⁴

Repealed.
Act 1888,
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.¹⁵

1 *Complete left after provisional.*—Cp. sect. 5, sub-s. 2, and Chap. VI. p. 71.

2 *Examiner.*—See note to sect. 6; also Chap. V. sect. 3, p. 60.

3 *Whether the complete specification has been prepared in the prescribed manner.*—Cp. Patents Rules, 1890, rr. 30—33, p. 570.

Effect of
variance
under present
Act.

4 *Substantially the same.*—From the language of Cotton, L. J., in *Siddell v. Vickers (t)*, quoted under sect. 5, sub-s. (5), it appears that variance between the complete and the provisional specifications derives no new significance from this Act, and is fatal, if at all, in virtue of the previous law.

The general effect of the cases, bearing upon the point of variance, may be stated in this way. There is no variance if the difference between the two specifications is merely in a matter of detail, or if the complete specification is the legitimate development of, and contains nothing that is not foreshadowed in, the provisional (*u*).

(*t*) 1888, 5 P. O. R. 428.

(*u*) *Lucas v. Miller*, 1885, 2 P. O. R. 155; *Horrocks v. Stubbs*, 1886, 3 P. O. R. 233, 236; *Watling v. Stevens*, 1886, 3 P. O. R. 37, 41, 147, 152; *Moseley v. Victoria Rubber Co.*, 1887, 4 P. O. R. 241, 248; *Anglo-American*

Brush v. Crompton, 1887, 4 P. O. R. 27; and 1888, 5 P. O. R. 398; *Hutchison v. Patullo*, 1887-8, 4 P. O. R. 332; and 5 P. O. R. 351; *Woodward v. Sansum*, 1887, 4 P. O. R. 178; *Siddell v. Vickers*, 1888, 5 P. O. R. 81, 98.

On the whole subject of variance between the specifications, see Chap. VIII. p. 97.

Sect. 9.

5 The language of the statute seems a little at fault here ; it should run "As the invention, the general nature of which is described," &c.

6 *Examiner's report.*—See note to sect. 6.

7 *Refusal of comptroller.*—See Letters from Comptroller, pp. 752, 753.

8 *Unless and until the same shall have been amended.*—There must be no variance between the amended complete specification and the provisional (*x*).

9 *Appeal to law officer* :—

For rules regulating such appeals, see *infra*, p. 589.

See also note to sect. 7, sub-s. 2.

10 *Acceptance of complete specification.*—The Act does not make the acceptance of a complete specification conclusive as to its sufficiency ; and insufficiency of the specification is a ground for the revocation of a patent now as before the Act of 1883 (*y*). Acceptance of complete specification not conclusive of sufficiency.

11 *Date of application.*—The day of the date is excluded, see note to sect. 8, sub-s. 2.

12 *Notice of appeal.*—Form T., *infra*, p. 749.

13 *Application void.*—As to abandonment of application and its effect, see note to sect. 8, sub-s. 2.

A list of abandoned applications is published weekly in the "Illustrated Official Journal."

14 *Comptroller may allow.*—See Letters from Comptroller, *infra*, p. 756.

Fee, No. 40, p. 588.

15 *Reports of examiners.*—These reports are put into the *file* when the patent is sealed and the grant entered on the register. But they are not open to public inspection.

As to *inspection* generally, see Chap. XIV. p. 305.

Unless the Court . . . shall certify.—No such order appears to have been made.

(*x*) *Goulard and Gibbs' Patent*, 1888, 5 P. O. R. at p. 532.

(*y*) Cp. *infra*, sect. 26, sub-s. (3), and *Goulard and Gibbs' Patent*, *supra*, where a patent was revoked

on this ground. See a summary of the conflicting opinions on this point in *Morris's Patents Conveyancing*, pp. 20-21, and p. 21, n. (*p*).

Sect. 10.

Advertisement on acceptance of complete specification.

10. On the acceptance of the complete specification the comptroller shall advertise the acceptance;¹ and the application and specification or specifications with the drawings (if any) shall be open to public inspection.²

1 *Advertisements of acceptance* of complete specifications appear weekly in the "Illustrated Official Journal," see Patents Rules, 1890, r. 21, p. 567.

2 *Inspection.*—Until the specifications are printed only the duplicate copies can be seen at the Patent Office.

It takes usually about three weeks after acceptance of complete specification before the printed specifications are published.

Cp. Patents Rules 1890, r. 22, p. 567.

Opposition to grant of patent.

11. (1.) Any person¹ may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice² at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him,³ or from a person of whom he is the legal representative,⁴ or on the ground that the invention has been patented in this country on an application of prior date⁵ [*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.⁶

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,⁷ 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,⁸ but subject to appeal to the law officer.⁹

Sect. 11.

(3.) The law officer shall, if required, hear the applicant¹⁰ and any person so giving notice and being, in the opinion of the law officer, entitled to be heard in opposition to the grant,¹² 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,¹² who shall be paid such remuneration as the law officer, with the consent of the Treasury,¹³ shall appoint.

Under the present Act there may be opposition (1) to the grant of a patent, sect. 11, sub-s. (1), and Chap. IX., p. 167; (2) to the amendment of a specification, sect. 18, sub-s. (2), and Chap. VIII., p. 145; and (3) to the extension of the term of a patent, sect. 25, sub-s. (2), and Chap. XVIII., p. 386. Opposition under Act of 1883.

The law relating to each of these subjects is fully discussed in the several chapters above referred to.

For the history of oppositions to the grant of letters patent before and under the Act of 1852, see p. 650, n. (b).

We shall only mention here these cases which bear upon the construction of the words of the section.

1 *Any person.*—As to procedure on oppositions generally, see Patents Rules, 1890, r. 34, p. 573; and Law Officers' Rules, *infra*, p. 589.

2 *Notice of opposition.*—Form D., p. 741.

Opposition to the grant of a patent, or to the amendment of a specification, can be offered by such persons only as in the law officer's opinion are "entitled to be heard" upon the subject: see sect. 11, sub-s. (3), and sect. 18, sub-s. (4); it would seem, therefore, that the twelfth section of the Patent Law Amendment Act, 1852, limiting opposition to the grant of a patent to persons "having an interest in opposing the grant of letters patent," is still substantially in force. The limitation upon opposition to the amendment of a specification is new. Cp. 5 & 6 Will. IV. c. 83, s. 1, p. 637. Who entitled to oppose.

See consideration of cases, at p. 175.

There is no restriction imposed by sect. 25, sub-s. (2) upon the persons who may enter a caveat against the extension of letters patent.

3 *The applicant having obtained the invention from him.*—Invention here means the *entire* invention. Grounds of opposition.

Where *part* of an invention only was communicated by the opponent Applicant having ob-