

Models.

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

Register of Patents.

Register of Patents.

The Act of 1883(g) provides that there shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments, and of transmissions of patents, of licences under patents, and of amendments, extensions and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed.

The Register of Patents is *prima facie* evidence of any matters by the Act directed or authorised to be inserted therein. Copies of dates, licences, and any of the documents affecting the proprietorship in any letters patent, or in any licence thereunder, must be supplied to the Comptroller, in the prescribed manner, for filing in the Patent Office.(h)

It is provided that former registers of patents and of proprietors shall be deemed parts of the same book as the Register of Patents, kept under the Act of 1883.(i)

Trusts.

No notice of any trust—expressed, implied, or constructive—is to be entered on the Register of Patents, nor is any such notice receivable by the comptroller.(k)

Rights of proprietor.

Where any person becomes entitled by assignment, transmission or other operation of law, to a patent, it is the duty of the Comptroller on request, and on proof of title to his satisfaction, to cause the name of such person to be entered as proprietor of the patent in the Register of Patents; and the person for the time being entered in the Register of Patents, as proprietor of a patent, has, subject to the provisions of the Act of 1883, and to any rights appearing from such register to be vested in any

(f) 46 & 47 Vict. c. 57, s. 42.

(g) S. 23.

(h) P. R., 1890, rr. 67-69.

(i) 46 & 47 Vict. c. 57, s. 114.

(k) 46 & 47 Vict. c. 67, s. 85.

other person, power absolutely to assign, grant licences as to, or otherwise deal with the same, and to give effectual receipts for any consideration for such assignment, licence, or dealing: Provided that any equities in respect of such patent may be enforced in like manner, as in respect of any other personal property.^(l)

Where it appeared that, before the date of a patent, the grantee and another person signed a document referring to certain proposed dealings with the ownership of patents to be obtained for a process said to be the invention for which the patent was granted, the Comptroller refused to enter this document on the Register of Patents, on the ground that it was dated before the grant of the patent, and this decision was upheld on motion to the court.^(m)

Documents of earlier date than the patent.

It would appear from the judgment in *In the Matter of Parnell's Patent*,⁽ⁿ⁾ that there may be documents dated before the grant of a patent which ought to be entered on the register.

A fee of ten shillings is charged in respect of each entry made in the Register of Patents,^(o) and the procedure to be observed on the registration of patent documents, is regulated by the Patent Rules, 1890, rr. 67-69.^(p)

Fee.

The Register of Patents is at all convenient times open to the inspection of the public, subject to the provisions of the Act of 1883, and to the prescribed regulation,^(q) and any person requiring it, may obtain, on payment of the prescribed fee, a certified copy, sealed with the seal of the Patent Office, of any entry made in the Register.^(r)

Inspection of Register of Patents.

Printed or written copies or extracts, purporting to be certified by the Comptroller, and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from registers and other books kept there, are admitted in evidence in all courts in her

Evidence.

^(l) 46 & 47 Vict. c. 57, s. 87; 51 & 52 Vict. c. 50, s. 21.

^(m) *In the Matter of Parnell's Patent*, 5 P. O. R. 126.

⁽ⁿ⁾ 5 P. O. R. 128.

^(o) See list of fees, Appendix.

^(p) See Appendix.

^(q) Patent Rules, 1883, r. 75.

^(r) 46 & 47 Vict. c. 57, s. 88; 51 & 52 Vict. c. 50, s. 22.

Majesty's dominions, and in all proceedings, without further proof or production of the originals.(s)

A certificate purporting to be under the hand of the Comptroller as to any entry, matter or thing which he is authorised under the Act of 1883, or any general rules made thereunder, to make or do, is *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.(t)

Power of the Court

The Court is empowered by s. 90 of the Act of 1883, as amended by s. 23 of the Act of 1888, on the application of any person aggrieved by the omission, without sufficient cause, of the name of any person, or of any other particulars, from the Register, or of any entry made without sufficient cause in the Register, to make such order for making, expunging, or varying the entry as the Court thinks fit, or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit. And the Court has power, in any proceeding under this section, to decide any question that it may be necessary or expedient to decide for the rectification of the Register, and to direct an issue to be tried for the decision of any question of fact, and to award damages to the party aggrieved.

Any order of the Court rectifying the Register must direct that due notice of the rectification be given to the Comptroller.(u) Where an order has been made by her Majesty in Council for the extension of a patent for a further time, or for the grant of a new patent,(x) or where an order has been made by the Court for the revocation of a patent or the rectification of the Register under s. 90, or otherwise affecting the validity or proprietorship of the patent, the person in whose favour such order has been made is required forthwith to leave at the Patent Office an office copy of such order. The Register will thereupon be rectified, or the purport of such order will otherwise be duly entered in the Register, as the case may be.(y)

It is submitted that the Act of 1883(z) gives the Court power

(s) 46 & 47 Vict. c. 57, s. 89.

(t) 46 & 47 Vict. c. 57, s. 96.

(u) 46 & 47 Vict. c. 57, s. 90, s. 3.

(x) Chap. XI.

(y) P. R. 1883, r. 71.

(z) S. 90.

to expunge any entry fraudulently made on the Register, and to enter any facts relative to the ownership of a patent, but not any legal inference to be drawn from these facts. It was held that the corresponding section of the repealed Act of 1852,^(a) gave such power to the Master of the Rolls alone.^(b)

An appeal lies from any order made by the Court, or a Judge for the rectification of the Register,^(c) though formerly there was no appeal from the decision of the Master of the Rolls.

If any rectification of the Register of Patents is required in pursuance of any proceeding in a court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification must be served on the Comptroller, who is required to rectify the Register accordingly.^(d)

It is a misdemeanor for any person to make, or cause to be made, a false entry in the Register of Patents, or a writing falsely purporting to be a copy of an entry in such Register, or to produce or tender, or cause to be produced or tendered, in evidence any such writing, knowing the entry or writing to be false.^(e)

(a) S. 38.

(b) *Re Morey's Patent*, 25 Beav. 581; *Re Green's Patent*, 24 Beav. 145; *Re Horsley and Knighton's Patent*, L. R. 8 Eq. 475; *Re Berdan's Patent*, L. R. 20 Eq. 346.

(c) *Re Morgan's Patent*, 24 W. R. 245; *Re Myer's Patent*, W. N. 1882, 53, 76.

(d) 46 & 47 Vict. c. 57, s. 111 (2).

(e) 46 & 47 Vict. c. 57, s. 93.

CHAPTER VIII.

ASSIGNMENT OF LETTERS PATENT.

NATURE OF LETTERS PATENT—POWER OF ASSIGNMENT RESULT OF GRANT—ASSIGNMENT BY DEED—ASSIGNMENT BY ACT AND OPERATION OF LAW.

Rights of an author.

THE author of a literary, or musical, composition actually *creates* the work which is the produce of his mental labour. The law recognises that he has as much natural and moral right to the results created by his mental exertions, as he has to the proceeds of his manual industry, and, *independently of any grant from the Crown*, gives him an exclusive copyright in his book, or musical composition.

Rights of an inventor.

It cannot, however, be contended that an inventor has any natural, or even moral right in his invention, for he does not create in the same sense as an author does.

In the case of a book, the result of the author's skill and industry has no existence before the author commits his thoughts to paper; but in the case of an invention, in the patent law sense, all that the inventor does is to make use of natural laws, which must necessarily have been pre-existent, though perhaps undiscovered, and, by a new application of them, produce a manufacture or article of commerce, which has either not been produced before, or not been produced in the same way.

Difference between a literary composition and an invention.

The distinction between the production of a great literary composition and the discovery of a great invention, is made apparent by a contrast of a play of Shakespere—Hamlet, for instance—with a world-revolutionizing invention, such as the steam engine of Watt. Had Shakespere never written Hamlet, it is practically certain that the play would never have existed, and the literature of the world would, undoubtedly, have been

the loser; but had Watt never lived, it can scarcely be doubted that the vast superiority of the plan of condensing the steam in a steam engine in a separate vessel, instead of in the cylinder, would have been perceived and communicated to the world by some other inventor.

It is evident that an inventor merely produces a new art, consisting of a novel application of previously existing, though it may be undiscovered, physical laws to the production of a new article of commerce, or of an old article of commerce in a new manner. The law does not recognise any natural, or moral, right in the inventor to the exclusive use of the invention, and will not, except on certain conditions, attempt to guarantee him a monopoly in the profitable exercise of it.

The law only gives a right in an invention on conditions.

The conditions upon which the law will secure to an inventor an exclusive property in his invention for a limited period are, as we have seen, (a) that he shall disclose the secret of the invention, so that the public may enjoy it after the expiration of the patent; and also that he shall describe the best means known to him of performing the invention, in order that the public may enjoy it to the same extent as the patentee himself, when the term, for which the patent is granted, expires.

The inventor may perhaps be able to keep the invention a profound secret, and make considerable profit by its use; but there are very few inventions, producing valuable results, which could be worked long without the method, by which the results are arrived at, becoming matter of public knowledge, in which event the law will not prevent any member of the public from exercising the invention for his own gain, provided he has not been guilty of a breach of trust. (b) Undoubtedly the man who makes a useful discovery, or invention, and communicates it to the public is a benefactor; and it is because the law recognises this fact, as well as the desirability of encouraging the production of useful inventions for the public good, that it guarantees to the inventor, his executors, administrators, and assigns the sole privilege of making, using, exercising, and vending the invention within this realm for a definite period, by means of a

Keeping invention secret.

Reason why the law creates a right in an invention.

(a) pp. 183, 256 *ante*.

(b) *Yovatt v. Winyard*, 1 J. & W. 394.

LETTERS PATENT FOR INVENTIONS.

grant of letters patent from the Crown, on condition that the inventor discloses the best means known to him of performing the invention.

If an inventor endeavours to work the invention in secret, the law will not compel him to disclose it, but, if it does leak out, it can never afterwards form the subject of a grant of letters patent, and the inventor cannot claim any monopoly or acquire any right or property in it of any nature whatever, which the law will protect or recognise.

One inventor has no natural right to prevent another from making the same invention, and deriving profit therefrom; the law only allows, as we have seen,^(c) the grant of a monopoly in the invention for a limited period to the first and true inventor, *i.e.*, the inventor who actually *first* communicates a knowledge of it to the public.

Canham v.
Jones.

In *Canham v. Jones* ^(d) the plaintiff as the proprietor of a receipt for the preparation of a certain vegetable syrup, which had been bequeathed to him by a person named Swainson, who purchased it from the inventor, sought to restrain the defendant from selling an article under the same name as the plaintiff's. Sir Thomas Plumer, V.C., gave judgment in favour of the defendant, and used the following words "This Bill proceeds upon an erroneous notion of exclusive property, now subsisting in this medicine, which Swainson having purchased, had a right to dispose of by his will; and, as it is contended, to give the plaintiff the exclusive right of sale of. If this claim of monopoly can be maintained without any limitation of time, it is a much better right than that of a patentee; but the violation of right, with which the defendant is charged, does not fall within the cases in which the Court has restrained a fraudulent attempt by one man to invade another's property—to appropriate the benefit of a valuable interest in the nature of a goodwill, consisting in the character of his trade or production, established by individual merit; the other representing himself to be the same person, and his trade or production the same as in *Hogg v. Kirby*,^(e) combining imposition on the public with

^(c) Chap. I.

^(d) 2 Ves. & B 218.

^(e) 8 Ves. 215.

injury to the individual. This is not that sort of case. The observation is correct, that the Bill stating the defendant's medicine to be spurious, asserts it not to be the same as the plaintiff's. The defendant does not hold himself out as the representative of Swainson, setting up a right in that character to the medicine purchased by him; but merely represents that he sells not the plaintiff's medicine, but one of as good a quality. He is perfectly at liberty to do so. If any exclusive right in this medicine ever existed, it has long expired. The foundation of this Bill therefore, the exclusive right asserted by the plaintiff, failing, all the consequential relief falls with it; and the demurrer must be allowed."

If a discoverer keep his invention secret, not only does he run the risk of losing the monopoly of it by an inadvertent disclosure, but he puts himself in an evident position of disadvantage, if he should wish to dispose of it to another person, for the Court could not decree the specific performance of an agreement for the sale of a secret invention, or prevent the disclosure of it. Either it is or it is not a secret. If it is, what means has the Court of interfering, so as to enforce its own orders? If it is not, there can be no ground for interfering. (f)

Effect of keeping an invention secret.

Moreover, it would be useless for the Court to grant an injunction to restrain the publication of a secret, for there would be no means of determining whether the injunction had been violated or not. (g)

In a case (h) where the plaintiff sought to restrain the defendant from communicating the secret of preparing a certain medicine, Lord Eldon, L.C., said, in dissolving an injunction which had been obtained: "So far as the injunction goes to restrain the defendant from communicating the secret, on general principles, I do not think the Court ought to struggle to protect this sort of secret in medicine. The Court is bound, indeed, to protect them in cases of patents to the full extent of what was intended by the grant of the patent, because the

Court will not attempt to protect secret uses.

(f) *Newbury v. James*, 2 Mer. 446, judgment of Lord Eldon, L.C.

(g) *Ibid.*

(h) *Williams v. Williams*, 3 Mer. 157.

patentee is a purchaser from the public, and bound to communicate his secret to the public at the expiration of the patent. Then whether this principle can be extended to such a case as this—whether a contracting party is entitled to the protection of the Court, in the exercise of its jurisdiction, to decree the specific performance of agreements, by restraining a party to the contract from divulging the secret he has promised to keep, that is a question which would require very great consideration. But the present case is not one which calls for the determination of it. If the defendant has already disclosed the secret the injunction can be of no use. If he only threatens to disclose, it thus becomes necessary to look at his affidavit; and by that he insists that what he has to disclose is no secret at all—then how is the Court to try this question? Or what can the Court do with the case altogether?”

Monopoly has existence only by virtue of the grant of letters patent.

The monopoly created by the grant of letters patent for a limited period, is the only right or property which the law recognises an inventor as possessing in his invention; and the sole or exclusive privilege of using the invention which is vested in the patentee by the patent has existence only by virtue of the grant.

The privilege is a mere naked right vested in the patentee, and it would not be assignable unless the letters patent expressly made it so, for it contains no property within itself making it of an assignable nature.⁽ⁱ⁾

Interest of inventor in an invention for which he intends to apply for letters patent.

Notwithstanding the fact that an inventor has no property in his invention, unless and until it is made the subject of a grant of letters patent, he has such an interest in an invention for which he intends to take out a patent as to be able to make and enforce an agreement concerning it. Thus, in the case of *Smith v. Dickinson*,^(k) it appeared that the defendant had, in fraud of the plaintiff, obtained a patent for an invention which had been communicated to him by the plaintiff under an agreement, whereby the defendant undertook not to avail himself or take any advantage of such communication, under the penalty of

(i) *Duvergier v. Fellows*, 10 B. & C. 829.

(k) 3 Bos. & Pul. 630.

£1000, and the Court held that the plaintiff was entitled to maintain an action for the breach of this agreement.^(l)

According to the law as it at present stands, every patent for an invention granted by the Crown is made in the form prescribed in the first schedule to the Patents, &c., Act of 1883. Eight forms, which are modifications of the form in the schedule to the Act of 1883, to meet special circumstances, are at present in use in the Patent Office.^(m) The form in the schedule to the Act of 1883 grants to the patentee the royal licence, "full power, sole privilege, and authority, that the said patentee, by himself, his agents, or licensees, and no others, may at all times hereafter, during the continuance of the term of years herein mentioned, make, use, exercise, and vend the said invention within our United Kingdom of Great Britain and Ireland and Isle of Man." By a previous recital, the term "patentee," as used in the letters patent, is expressly defined to mean the grantee, his executors, administrators, and assignees.

Thus, the authority by which a patent right is created invests it with the quality of assignability; and there is now no limit to the number of persons to whom it may be assigned, though formerly it was made a condition that the grant should become void if the patent became vested in more than a specified number of assignees.

An assignment may be made to a body corporate, and the body corporate is entitled to be entered on the Register of Patents as the proprietor in its corporate name.⁽ⁿ⁾

Previous to the Act of 1883, a patent in the United Kingdom, in respect of an invention which had been patented abroad, was only valid for so long as the foreign patent remained in force.^(o) Since the Act of 1883 does not affect the past operation of any repealed Act,^(p) it is advisable for an assignee of a British patent of earlier date than the 1st January 1884, in respect of an invention previously patented abroad, to ascertain that the foreign patent was in force on the date of the assignment, and to keep it on foot subsequently.

^(l) See also *McDougall v. Partington*, 7 P. O. R. 216.

^(m) See Appendix.

⁽ⁿ⁾ P. R. 1890, r. 72.

^(o) 15 & 16 Vict. c. 83, s. 25.

^(p) 46 & 47 Vict. c. 57, s. 113.

Assignment
for a district.

A patentee may assign his patent for any place in a part of the United Kingdom or Isle of Man as effectually as if the patent were originally granted to extend to that place or part only.^(q)

A deed of assignment for a district should contain a covenant on the part of the assignor to pay the renewal fees within the prescribed times, and to give due notice to his co-owner of every such payment when made or permit him to pay the same, and to repay the sums so paid on demand, and until repayment to charge them, together with interest, on his share in the patent.^(r)

Assignment
may be by
deed or act
and operation
of law.

A patent right may be assigned by deed by the patentee, or by act and operation of law.

Deed neces-
sary.

Though the letters patent provide that a licence to use the invention must be under the hand and seal of the patentee, they do not specify any particular form or manner in which assignments are to be made. It is, however, necessary that the grant of letters patent shall be under seal,^(s) and it is a rule of law that things which can only be granted or created by deed are assignable only by deed.^(t)

In the words of Lord Ellenborough, C.J. ^(u): "If the licence, which is the lesser thing, must be in writing, *à fortiori*, the assignment, which is the greater thing, must also be."

No particular
form.

No particular form of words is necessary to effect an assignment of a patent right, and it has been held that where a patentee has covenanted, under his hand and seal, to assign a patent upon the happening of a certain event, the covenant, on the happening of the event, amounts to an actual assignment.^(v)

Consideration.

As the assignment of a grant of letters patent is by deed, no consideration need be stated.

Assignment in
consideration
of a royalty.

Sometimes patents are assigned in consideration of a royalty reserved to the assignor, and where such is the case, it is not, in the absence of covenants to that effect, obligatory on the part

^(q) 46 & 47 Vict. c. 57, s. 36.
^(r) See Morris' Patents Conveyancing, p. 116.
^(s) Co. Litt. 9 b, 172 a; Shep. Touch. 229-231.

^(t) 3 Co. R. 63 a, Lincoln Coll. Cas.
^(u) Power v. Walker, 3 M. & W. 9.
^(v) Cartwright v. Amatt, 2 Bos. & Pul. 43.

of the assignee to pay the duties necessary to keep the patent on foot.

Thus, in *Re Railway and Electric Appliances Company (y)* it appeared that on the sale of a patent by the patentees to the company a deed of assignment was executed by the parties, by which, after a recital that the patentees had agreed to sell the patent to the company for £250, "and for the other considerations herein appearing," the patentees assigned the patent to the company absolutely, and after covenants for title by the patentees, including a covenant for quiet enjoyment of the patent "during the time subsisting therein," the company covenanted to pay to the patentees a royalty for every article which should be manufactured or sold by the company under the patent "while subsisting," and also a proportion of the profits arising from the manufacture or sale and from licences granted for the manufacture or sale of articles to be manufactured under the patent "while subsisting." The deed contained no express covenant by the company to keep the patent on foot or to manufacture or sell articles under the patent. On the expiration of the first four years of the patent, the company duly paid the first renewal fee, but on the expiration of the fifth year, by inadvertence, omitted to pay the second renewal fee, and consequently the patent lapsed. After an ineffectual attempt to obtain a private Act of Parliament to revive the patent, the company passed resolutions for a voluntary winding up, and the patentees thereupon sent in a claim for damages for the loss, through the lapse of the patent, of the royalties reserved by the assignment, contending that a covenant to keep the patent on foot should be implied in the assignment. The Court, however, held that no such covenant could be implied; and that, even if it could, the patentees could not obtain more than nominal damages, the company being under no obligation, express or implied, to manufacture the patented articles.

The Secretary of State for War is empowered, either for or without valuable consideration, to acquire by assignment to himself, on behalf of her Majesty, all the benefit of the inven-

Secretary of
State for War.

tion and of any patent obtained or to be obtained for any improvement in instruments or munitions of war; and where any such assignment has been made to the Secretary of State for War, he may at any time before the application for a patent for the invention, or before the publication of the specification or specifications, certify to the Comptroller his opinion that, in the interests of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret; and if the Secretary of State for War so certifies, the specifications of the invention will not be published or open to public inspection at any time without the sanction of the Secretary of State for War. (z)

Equitable and legal interests of licensee.

The equitable interests of a licensee in relation to the district comprised in the licence are co-extensive with those of the grantee or assignee of the letters patent, yet his legal title is very different. Though an exclusive licensee may perhaps sue in his own name for infringements (a) he cannot apply to amend the specification or obtain an extension of the patent, and a mere licensee is not able to sue for infringements in his own name.

Assignment of different inventions include in one grant of letters patent.

Before the passing of the Act of 1883 it was not uncommon to include more than one invention in a grant of letters patent, but the practice is not so frequent now, for it is provided by that Act (b) that every patent shall be granted for one invention only, but may contain more than one claim.

It is, however, declared (b) that it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention. It is consequently possible that a patent granted under the present practice may comprise more than one invention.

If the patent comprise two or more inventions separate and distinct in their nature, valid assignments may be made of the different parts of the patent to different persons, and it is competent to the assignee of a separate and distinct portion of a

(z) See 46 & 47 Vict. c. 57, s. 44.

(a) p. 339 *post*.

(b) 46 & 47 Vict. c. 57, s. 33.

patent to sue for an infringement of that part without joining one who has an interest in another part, the damages recovered in the action accruing to the former alone.(c)

A patent may be assigned to different persons in different portions as joint tenants, or as tenants in common.(d) Assignment of portions.

When a share in a patent is assigned, it is advisable that the deed of assignment should contain covenants binding not only the parties, but all future owners, to account to each other for the profits made by them respectively, and to grant, or concur in granting, licences in a manner prescribed.(e) Covenants. A deed of assignment of a share of a patent should also contain a covenant by the assignee to perform and observe the stipulations (if any) which bind the assignor and to indemnify him from future breaches thereof; (f) and each owner should covenant to pay his proper proportion of the renewal fees, and should charge his share in the patent with the payment of any moneys which may be paid by any other owner on his behalf in this respect.(g) There should also be a provision to the effect that licences should be granted by the co-owners jointly, and that all benefits arising therefrom should be shared by such co-owners in proportion to their shares.(h) If a deed of assignment of a share of a patent provides for the sole working of the patent by one of the co-owners alone, it is well to reserve to the other co-owners the right to use the share or shares assigned on agreed conditions; for a notification of such a right can be entered in the Register of Patents, since it is a legal one.(i)

It is submitted that when a patent for a single invention is held by different persons, either as joint tenants or as tenants in common, it is competent for one of such co-owners to sue alone in respect of an infringement,(k) though the Court of Queen's Bench in *Smith v. London and North-Western Railway Co.*,(l) Rights of co-owners.

(c) *Dunnicliff v. Mallett*, 7 C. B. N. S. 209; *Walton v. Lavater*, S C. B. N. S. 162, 184.

(d) *Walton v. Lavater*, S C. B. N. S. 162; *Smith v. London and North-Western Ry. Co.*, Macr. P. C. 203.

(e) See *Morris' Patents Conveyancing*, p. 120; see form of assignment, Appendix.

(f) See *Morris' Patents Conveyancing*, p. 121.

(g) See *Morris' Patents Conveyancing*, p. 123.

(h) See *Morris' Patents Conveyancing*, p. 123.

(i) See *Morris' Patents Conveyancing*, p. 126.

(k) *Sheehan v. Great Eastern Ry. Co.*, L. R. 16 Ch. D. 59.

(l) Macr. P. C. 207.

decided in favour of the right of the survivor of two persons, to whom a patent had been assigned as tenants in common, to sue for the whole damages caused by an infringement, on the ground that, if one of the assignees had not died, the action must have been brought by both.(*m*)

Trustees.

A patent may be vested in one as trustee for another person or persons, and it is competent for trustees to sue alone in respect of infringements, but the Court or a judge may at any stage of the proceedings order the *cestuis qui trustent* to be made parties ; (*n*) also a person is entitled to bring an action in his own name when the patent is registered in the name of another, if that other is a trustee for the plaintiff.(*o*)

Action for infringement by assignee.

The assignee of a patent may maintain an action for infringement though he has acquired the right by two assignments of separate portions, and the party sued is the original grantee. Moreover, the action is maintainable, although there has been no infringement since the defendant has received notice that the entire interest in the patent has become vested in the plaintiff.(*p*)

Assignment with notice of licences.

The assignment of a patent restrains the assignor and subsequent licensees from him from working or using the invention without the leave or licence of the assignee ; (*q*) and with respect to prior licensees from the assignor the rule seems (in the absence of any express reservation in the assignment of their rights) to be that, if the assignee took the assignment with notice thereof, he takes it subject to their licences, and, therefore, cannot restrain them, but that, if he had no such notice, he is entitled to restrain them.

Assignment of improvements.

When inventors have once turned their attention to a particular class of inventions, or to some problem, the successful solution of which is felt to be a desideratum, which must bring benefit to the public, and remuneration to the discoverer, it is well known that they are very likely to go on inventing fresh methods and improvements in the same direction. It frequently happens, therefore, that a purchaser of an invention is desirous

(*m*) See also p. 21 *post* ; Bergmann v. Macmillan, L. R. 17 Ch. D. 423.

(*n*) S. C. R. Order xvi. r. 8.

(*o*) Speckhart v. Campbell, "Times," Mar. 13, 1884.

(*p*) Walton v. Lavater, S. C. B. N. S. 162.

(*q*) Hassall v. Wright, L. R. 10 Eq. 509.

of acquiring the right to an assignment of all future inventions and improvements of a like nature to the invention sold, which may be the produce of the assignor's inventive talent, for, as far as the purchaser is concerned, the utter destruction of the value, from a commercial point of view, of the original invention may be the result, if the monopoly in a better method, or an improvement in the means of achieving the desired object, is allowed to pass into the possession of anybody but himself.

To prevent this, a covenant by the vendor of a patent to assign Covenant for. to the purchaser all future patent-rights which the vendor may thereafter acquire, in whatever way, of a like nature to the patent sold, is frequently inserted in deeds of assignment; and such an agreement is not contrary to public policy.(*r*)

On the contrary, public policy is directly in favour of such an agreement, by means of which a needy and struggling inventor may obtain a present payment to put his intellectual gifts at the service of a purchaser, and thus become enabled, in comparative ease and affluence, to devote his attention to scientific research, whereas if such a contract were prohibited he would be compelled to apply himself to some menial, or mechanical, or lower calling, in order to gain a livelihood.(*s*)

The purchaser of a patent can maintain an action for breach of an agreement to assign further improvements and inventions, but specific performance will not be ordered on an interlocutory application.(*t*)

If a deed of assignment recite that the assignor is the Estoppel. inventor, he is estopped from denying the validity of the patent in any subsequent action brought by the assignee, or any person deriving title through him, in respect of any infringement; for the principle of the law of estoppel is, that where a man has entered into a solemn engagement by deed under his hand and seal as to certain facts, he shall not be permitted to deny any matter which he has so asserted.(*u*)

(*r*) *Printing and Numerical Registering Co. v. Sampson*, L. R. 19 Eq. 462.

(*s*) *Ibid.*; see judgment of Jessel, M.R., p. 465.

(*t*) *London and Leicester Hosiery Co., Limited, v. Griswold*, 3 P. O. R. 251.

(*u*) *Bowman v. Taylor*, 2 A. & E. 278, 291; per Taunton, J., *Walton v. Lavater*, 8 C. B. N. S. 162; *Dunnicliff v. Mallett*, 7 C. B. N. S. 209; *Franklin Hocking & Co. v. Franklin Hocking*, 6 P. O. R. 69, 72; see also rule in *Pickard v. Sears*, 6 A. & E. 469.

It is the usual practice for the assignor to enter into covenants that he is the true and first inventor, and that the patent is valid, so far as his acts and omissions are concerned. A covenant for title is implied if the assignor is expressed to assign as beneficial owner or trustee.(x)

There may be an estoppel by matter of recital,(y) but an estoppel must be certain, and is not to be taken from argument or inference.(z)

If the recital only amount to an assertion that the assignor is himself an assignee of the actual inventor, it appears that the assignor is not estopped from denying the validity of the patent in an action brought by the assignee on a covenant contained in articles of agreement.(a)

The grantee and assignor of letters patent is estopped in an action brought by the assignee against him for infringement, from denying that he had any title to convey.(b)

It is competent, however, for the grantee and assignor to dissent, at the hearing of an action for infringement brought against him by his assignee, from a particular construction of the specification which would have the effect of sustaining the patent as against another construction which would invalidate it.(c)

Hocking & Co.
v. Hocking.

Hocking & Co. v. Hocking (d) was a case in which the plaintiffs, as assignees, sued the defendant for the infringement of a patent of which he was the original grantee, and contended that the doctrine of estoppel prevented him from denying the validity of the patent.

The patent was for "an improved apparatus for heating water and other liquids, applicable also as a condenser, cooler, or refrigerator." The specifications were amended by disclaimer and memorandum of alteration filed by assignees of the patent, who afterwards assigned to the plaintiff company.

(x) Conveyancing Act, 1881, s. 7.

(y) *Lainson v. Tremere*, 1 A. & E. 792; *Bowman v. Taylor*, 2 A. & E. 278, 293.

(z) Co. Litt. 352 b; *Bowman v. Taylor*, 2 A. & E. 278, 294.

(a) *Hayne v. Maltby*, 3 T. R. 438; 1 W. P. C. 291; *Bowman v. Taylor*, 2 A. & E. 278.

(b) *Oldham v. Langmead*, 1 W. P. C. 291.

(c) *Hocking & Co. v. Hocking*, 4 P. O. R. 255; 4 P. O. R. 434; 6 P. O. R. 69.

(d) 4 P. O. R. 255; 4 P. O. R. 434; 6 P. O. R. 69.

The complete specification, as amended, described and claimed the construction of a condenser, cooler, or refrigerator, consisting of an arrangement of annular spaces (*i.e.*, steam-spaces), substantially as described and shown, the principle of annularity and concentricity being disclaimed. Reversibility of the steam and water spaces was also pointed out in the specification as a special feature. The plaintiffs alleged against the defendant infringement of the condensing apparatus. It appeared in evidence that the apparatus of the defendant, in its simple form, was composed of a helical steam-space between two water-spaces, all the spaces being concentric and annular, and his multiform arrangement consisted of a cluster of the simple forms inside a large cylindrical vessel, and neither of his forms admitted of reversibility.

At the trial, the defendant denied infringement, and alleged that, if the patent was so construed as to cover the alleged infringement, it would be void for want of novelty. Kekewich, J., who was the judge of first instance, held (1) that the Court would regard with extreme jealousy the defendant's claim, as being in derogation of his own grant, and would assume that the patent must have a reasonable meaning; (2) that the essence of the amended patent was the alternation of steam- and water-spaces of the particular character described and shown in the figures, combined, if convenient, but not of necessity, with concentricity; and (3) that the defendant's apparatus infringed although it contained certain minor differences and additions, and in one form only a single steam-space, while in the rest the spaces were not concentric.

The Court of Appeal (*dissentiente* Fry, L.J.), dismissed the appeal with costs, and the defendant thereupon appealed to the House of Lords. The House of Lords held that, although it approved of the principle that a grantee shall not defeat his own grant, the language of the specification must not be strained against the patentee, and that the effect of the disclaimer was to limit the patent to machines constructed substantially as described, and, therefore, the only question was whether the defendant's apparatus was so constructed. The House found as a matter of fact that the defendant's apparatus was not so con-

structed, and the decisions of the Court of Appeal and Kekewich, J., were accordingly reversed with costs, in favour of the appellant and defendant in the action.

Assignor's
right to give
evidence of
invalidity.

Though an assignor, who assigns under terms which amount to an express or implied warranty of the validity of the patent, is estopped from denying the patent in an action brought against him by the assignee, he cannot be restrained from assisting as a scientific witness or otherwise a defendant, other than himself, in an action instituted by the assignee, or from communicating to such defendant evidence tending to show the invalidity of the patent.

Thus, in an interlocutory application in *London and Leicester Hosiery Company, Limited, v. Griswold* (c) the plaintiff sought to obtain an injunction of the Court to restrain the defendant in the action, who was the original patentee and assignor of the company's patents, from assisting, as a scientific witness or otherwise, the defendants in two other actions then pending for the infringement of the company's patents. North, J., in refusing the injunction asked for, pointed out that he could not, under any circumstances, grant an injunction to restrain the defendant from obeying the subpoena to attend as a witness in Court and answering questions which might be properly put to him in the course of examination as a witness, the refusal to answer which might lead to his committal to prison for contempt.

On the same application it was also sought by the plaintiffs to restrain the defendant in the action from communicating to the defendant in other actions information in his possession, which might enable the defendants in the other actions to show that the patents assigned were not valid patents. The Court refused to grant an injunction, and the learned judge stated that, though it is well settled that a licensee of a patent is, during the continuance of the licence, estopped from disputing the existing patent, yet it is going a great deal further to say that a man, who has assigned a patent, is to be restrained from mentioning to any person, at any time, or under any circumstances, matters which might show that the patent, which was

granted by the Crown in the belief that the invention claimed was a new invention. was not, as a matter of fact, a new invention.

A bankrupt patentee, whose patent has been sold by his trustee ^{Bankrupt.} in bankruptcy, is not estopped, in an action subsequently brought against him (the patentee) for infringement, from denying the validity of the patent, either by matter of record, on the ground that the letters patent were matters of record; or by deed, by reason of the specification being under his seal; or by matters *in pais*, on the ground of the statements in his applications, there being nothing to show that the purchaser bought on the faith of those statements.(f)

In cases arising on the breach of contracts by purchasers of letters patent, it is always most important to consider whether ^{Warranty of validity.} the contract contains any express or implied warranty on the part of the assignor as to the validity of the patent, for, if there is no such warranty, the purchaser, in the absence of fraud, cannot repudiate the contract on the ground that he has subsequently discovered the patent to be void. A purchaser without a warranty from the assignor, in the absence of fraud, is bound to take the patent with all its faults, if it have any.(g)

In *Hall v. Conder*,(h) which is the leading case on this point, ^{Hall v. Conder.} the facts were, that by an agreement reciting that the plaintiff had invented a method for the prevention of boiler explosions, and had obtained a patent for the use of the same within the United Kingdom, and was desirous of taking out patents in France, Belgium, and such other places as might be found expedient, and that he had disposed of a moiety of the English patent, and had applied to the defendant to purchase the other moiety, and, to assist him in taking out the foreign patents, it was agreed that the defendants should pay to the plaintiff £2500 in such manner as should be mutually agreed on, and also a proportion of the net profits, and in consideration of such agreement on the part of the defendant, the plaintiff “agreed to make over and transfer, and did thereby accordingly make over and transfer to

(f) *Cropper v. Smith*, L. R. 26 Ch. D. 700; L. R. 10 App. Cas. 249; 1 P. O. R. 81; 2 P. O. R. 17.

(g) *Hall v. Conder*, 2 C. B. N. S. 22; *Smith v. Neale*, 2 C. B. N. S. 67.
(h) 2 C. B. N. S. 22.

the defendant one-half of the said foreign patents, when the same should be obtained, and the above-mentioned one-half of the English patent thereinbefore referred to."

The action was brought for the specific performance of this agreement, and the defendant objected that the invention was wholly worthless, and of no public utility, and was not new in England, and that the plaintiff was not the true and first inventor. The Court of Common Pleas, however, held that, in the absence of any allegation of fraud, it must be assumed that the plaintiff was an inventor, and there was no warranty, express or implied, either that he was the true and first inventor, within the meaning of the statute of James I., or that the invention was useful or new; but that the contract was for the sale of the patent such as it was, each party having equal means of ascertaining its value, and each acting on his own judgment.

Smith v.
Buckingham.

In *Smith v. Buckingham* (i) it appeared that the defendant had agreed to purchase the patent right of the plaintiff in an invention for which provisional protection had been obtained. The agreement contained a recital to the effect that the plaintiff had lately invented an improved composition or material to be used in waterproofing, or rendering woven fabrics impervious to moisture. The action was on the breach of this agreement, and the defendant pleaded that the plaintiff had not invented an improved, or any, composition or material which could be employed in rendering woven fabrics impervious to moisture, but the Court of Queen's Bench gave judgment for the plaintiff, holding that the plea did not show a total failure of consideration, and that there was no express or implied warranty, and that the defendant had got what he bargained for.

Co-patentees

Each one of a number of joint grantees of a patent is entitled to use the invention himself, without being under any obligation to obtain the consent of the others, or to account to them for any profits made by such use.(k) It is, however, doubtful whether one of such co-grantees could grant a valid licence without the consent of the rest, and without a liability to account to them for royalties received.(l)

(i) 21 L. T. N. S. 519.
(l) p. 326 *post*.

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

It is clear that one of two co-patentees cannot dispose of the rights of the other. Thus, if A. and B. are patentees, and B. wants to get rid of A., the only way in which he can do so is by getting A. to assign his rights to him; he cannot assign the whole patent to C., and then say that A. has no right to use it at all.^(m)

In *Smith v. London and North-Western Railway Company* ⁽ⁿ⁾ it was held that where a patent is assigned to two persons as tenants in common, they may maintain a joint action in respect of infringements, and the right of action survives, so that after the death of one tenant in common the survivor may sue for and recover the whole of the damages in respect of infringements committed during the lifetime of the deceased tenant in common.

It must be noticed that one ground for the decision in favour of the plaintiff Smith, who was a surviving tenant in common, being entitled to sue in respect of the infringements in question, was that, had the action been brought during the lifetime of both tenants in common, it must have been brought by them both jointly, and the case is consequently an authority for saying that one of two co-assignees cannot sue for infringement without the other being a party to the action.^(o) Moreover, it has been held that where an assignment is made of a share in profits (arising, *e.g.*, from the working of a patent by licences) the assignee is entitled to an account from the licensee, but that the account must be taken once for all in the presence of all the parties interested. Thus, if there are more than one assignee, all the assignees are necessary parties. And the assignee who asks for an account of the profits must place himself in the position of the assignor, by offering to pay to the accounting party anything which may be due to him from the assignee. Also an account of profits will not be directed, if it is clear that no profits have been made.^(p)

Assignee of a share in profits entitled to an account from licensee.

Malins, V.C., gave it as his opinion that one person interested in a patent is entitled to sue without making his co-owners

^(m) *In re Horsley and Knighton's Patent*, L. R. 8 Eq. 475.

⁽ⁿ⁾ 2 E. & B. 69; Macr. P. C. 188.

^(o) But see p. 309 *ante*.

^(p) *Bergmann v. Mcmillan*, L. R. 17 Ch. D. 423.

Damages to which co-owners are entitled.

parties to the action, either for an injunction or for an account.^(q) It must be concluded, however, from a consideration of the case ^(r) on which the learned Vice-Chancellor's opinion was mainly formed, that the damages to which the plaintiff would in such circumstances be held entitled would be not the whole profits, but only such proportion as should appear to be his, having regard to the proportion of the patent vested in the other co-owners. And on the analogy of *Bergmann v. Macmillan* ^(s) the account must be taken in the presence of all the parties interested.

Parties.

All parties interested in the patent, if they do not join as co-plaintiffs, may be, and for safety's sake should be, joined as defendants, in order that the infringing defendant may not be called on to account more than once, first to the plaintiff, and then separately to the other persons claiming an interest in the patent.^(t)

Assignment with notice of covenants.

When an assignee takes from a prior assignee, with notice, he takes subject to the prior assignee's covenants. Thus,^(u) a patentee assigned letters patent to two persons, A. and B., who covenanted with him that they, their executors, administrators, and assigns, would use their best endeavours to introduce the invention by granting licences, or working the patent, or selling it, and that the patentee should be entitled to receive £5 per cent. of all net profits, whether arising from royalties, sale, or otherwise, which should be received by A. and B., or the survivor of them, the executors, administrators of such survivor, or their or his assigns, and that an account of profits should be rendered yearly to the patentee, and his share of profits paid to him by A. and B., and the survivor of them, and the executors, administrators of such survivor, or their or his assigns, with a proviso that, after a sale had been made of the patent, the interests of the patentee in the profits should cease, and a final account be come to. A. and B. had taken the assignment with a view to forming a company to work the patent. The company

^(q) *Sheehan v. Great Eastern Ry. Co.*, L. R. 16 Ch. D. 62.

^(r) *Dent v. Turpin*, 2 J. & H. 139.

^(s) L. R. 17 Ch. D. 427.

^(t) *Westhead v. Keece*, 1 Peav. 287;

Bergmann v. Macmillan, L. R. 17 Ch. D. 423; *Van Gelder Co. v. Sowerby, Limited*, 7 P. O. R. 41.

^(u) *Werdermann v. Société Générale d'Electricité*, L. R. 19 Ch. D. 246.

was formed, and the patent made over to it. The patentee sued the company for an account of profits. The company demurred, on the ground that there was no privity between them and the plaintiff, and that the plaintiff's right, if any, was against A. and B. only. It was held, however, both by Bacon, V.C., and the Court of Appeal, that the plaintiff could sue the company for an account of profits, since the stipulations of the assignment to A. and B. amounted to a contract that the owners for the time being of the patent should account for and pay to the plaintiff a share of the profits, unless a sale within the meaning of the deed was effected, and no person taking the patent with notice of this contract could refuse to give effect to it.

An assignee is, at any time so long as he remains the person for the time being entitled to the benefit of the patent, entitled to ask for leave to apply at the Patent Office for liberty to amend the specification; he is in fact included in the meaning of the term "patentee," as used in the Act of 1883.^(x)

Assignee is entitled to apply to amend the specifications.

It may be questioned whether a person to whom a patent has been assigned by way of mortgage, is entitled to apply at the Patent Office for leave to amend the specification, or to present a petition to the Privy Council for the prolongation of the patent, without his mortgagor being a party to the application.^(y)

Mortgagee.

It is advisable for the mortgagor of a patent to insist on the mortgagee entering into a covenant not to seek leave to amend the specifications or drawings without the written consent of the mortgagor.

An assignee, as the person for the time being entitled to the benefit of the patent, is included in the meaning of the term "patentee," as defined by the Act of 1883, and competent to petition for the prolongation of the patent; ^(z) and an extension may be granted to the assignee, if the patentee has ceased to have any connection with the working of the patent,^(a) or, if the assignee has paid a large sum for the assignment and the development of the invention.^(b)

Assignee is entitled to petition for prolongation.

(x) 46 & 47 Vict. c. 57, s. 46.
 (y) See Van Gelder Co. v. Sowerby, limited, 7 P. O. R. 41, 208.
 (z) 5 & 6 Vict. c. 83; 7 & 8 Vict. c.

69; Russell v. Ledam, 14 M. & W. 574, 588; 1 H. L. Cas. 687.
 (a) Napier's Patent, 13 Moo. P.C. 543
 (b) Bodner's Patent, 6 Moo. P.C. 468.

But is not viewed with so much favour as the original patentee.

But assignees petitioning for the extension of letters patent, are not received with so much favour as the original grantee,^(c) and the prayer of the petition is not usually granted unless it is evident that the original grantee will derive some benefit by the extension.^(d)

Conditions.

Not unfrequently conditions have been imposed for the benefit of the patentee when prolongations have been granted on the petition of assignees,^(e) and in *Borill's Patent*,^(f) where the petition was presented by the patentee and his mortgagee, the extension was granted to the patentee alone.

Registration of assignments.

By s. 87 of the Act of 1883^(g) it is enacted, that when a person becomes entitled by assignment, transmission, or other operation of law, to a patent, the Comptroller shall, on request, and on proof of title to his satisfaction, cause the name of such person to be entered in the register of patents as proprietor of the patent; and it is by the same section further provided that the person for the time being entered on the register of patents, as proprietor of a patent, shall, subject to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licences as to, or otherwise deal with the same, and to give effectual receipts for any consideration for such assignment, licence, or dealing, provided that any equities in respect of such patents may be enforced in like manner as in respect of any other personal property.

It is to the interest of assignees to register their assignments as soon as possible.^(h)

Mortgagees of patents are always entered on the register as "mortgagees," and not as "assignees." It is submitted that a mortgagee, together with his mortgagor, form the proprietor.⁽ⁱ⁾

Documents of earlier date than the letters patent.

As a rule, documents relative to the proprietorship of letters patent of earlier date than the letters patent, will not be entered

^(c) Norton's Patent, 1 Moo. P. C. N. S. 3, 9; Claridge's Patent, 7 Moo. P. C. 394; Normand's Patent, L. R. 3 P. C. 193; Chap. XI.

^(d) Norton's Patent, 1 Moo. P. C. N. S. 339; Pitman's Patent, L. R. 4 P. C. 87; Chap. XI.

^(e) Pitman's Patent, L. R. 4 P. C. 84, 87; Herbert's Patent, L. R. 1 P. C. 399; Whitehouse's Patent, 1 W. P. C.

473; Markwick's Patent, 13 Moo. P. C. 310; Russell v. Leedsam, 14 M. & W. 574; Chap. XI.

^(f) 1 Moo. P. C. N. S. 348.

^(g) See also s. 23.

^(h) See pp. 321, 322. For practice on registration see P. R. 1890, rr. 67-70.

⁽ⁱ⁾ See Van Gelder Co. v. Sowerby, Limited, 7 P. O. R. 41, 208.

on the register. It cannot, however, be laid down as a hard-and-fast rule that such documents ought not to be entered on the register, for there may be some which, as amounting to assignments, ought to be entered, whilst, on the other hand, to the entry of others very forcible objections might be raised, which would prove absolutely insuperable.^(k)

The practice to be observed where an application is made for an entry of an assignment on the register of patents is regulated by Patent Rules, 1890.^(l)

Since the Act of 1883 came into operation, there has been no decided case in which the question has been determined whether an assignee of a patent is entitled to maintain an action for infringement before the assignment has been entered on the register, but on the authority of the old cases it is submitted that he could not do so.

Action for infringement prior to registration of assignment.

In *Chollet v. Hoffman*,^(m) a case decided under the Act of 1852, which provided for the registration of assignments,⁽ⁿ⁾ it was held that an assignee could not sue until his assignment had been registered, otherwise as the statute provided that before such registry the original patentee should be deemed the sole owner, a defendant would be liable to be sued at one and the same time by the grantee and assignee of the letters patent. It would appear that the reasoning upon which this case was decided applies equally to the law as it now stands.

In *Hassall v. Wright*,^(o) which differed from *Chollet v. Hoffman* in that it was an action between assignee and assignor, whereas the latter case was between assignee and third parties, it was decided that the assignee could maintain an action against the assignor, and his licensees, who had notice of the assignment, notwithstanding the fact that the assignment had not been registered.

The question as to whether the registration of an assignment has a retrospective effect, so as to place the assignee in a position to sue for and recover damages in respect of infringement committed after the assignment, but before the registration, has not

Registration retrospective.

^(k) In the Matter of Parnell's Patent,
5 P. O. R. 126, 130.
^(l) rr. 67 to 73.
^(m) 7 E. & B. 686.

⁽ⁿ⁾ 15 & 16 Vict. c. 83, s. 35.
^(o) L. R. 10 Eq. 509; 40 L. J. N. S.
Ch. 145.

been judicially determined, but it is submitted that the registration being merely an evidence of title, relates back to the date of the assignment, and that the assignee, on having his title perfected, is entitled to maintain the action.(p)

Where the plaintiff in an infringement action derived his title to the patent under an assignment from the executors of the patentee, and it appeared that the assignment was made after probate was granted, but before it was registered, and that the deed of assignment was not registered until after the registration of the probate, it was held that the plaintiff was entitled to maintain his action.(q)

Partnership.

The assignment of a share in the profits of letters patent may constitute a partnership between the assignor and assignee, and create consequences not perhaps contemplated between them which might have been avoided by the grant of a licence at a royalty instead of an assignment.(r)

Where a partnership at will is formed for the purpose of working an invention for which a patent has been taken out by, and registered in the name of, one of the partners alone, the patent becomes an asset of the partnership and each partner acquires a right to practise the invention, which right is not taken away by the registered owners assigning the patent to third parties who have notice of the existence of the partnership; and even after the determination of the partnership each of the partners has an equal right and licence to use the invention, the dealings between them having been such as to create in the one partner an irrevocable licence, as far as the other partner, the patentee, is concerned, to use the invention.(s)

Thus a person named Kenny, who had invented an improved kind of button-hole for boots and shoes, and a machine for making it, obtained a loan from a person, Lutwyche, to enable him to meet the expense of taking out a patent for the invention; and the patent having been obtained by Kenny, in his name alone, he and Lutwyche for more than four years worked

(p) *Hassall v. Wright*, L. R. 10 Eq. 509.

(q) *Ellwood v. Christy*, 17 C. B. N. S. 754; 18 C. B. N. S. 494; 34 L. J. C. P. 130.

(r) 1 W. P. C. 417 n.

(s) *Kenny's Patent Button-holing Co. v. Somervell*, 26 W. R. 787.

the invention in partnership, together. After the partnership had existed for some years, Kenny agreed with the trustee of a projected company to assign the patent to it, and the company having been formed, the assignment was duly made and registered. At the time of the agreement and assignment respectively, the trustee and directors of the company knew that Lutwyche and Kenny had been working the invention together. Notice of the assignment was given to Lutwyche, and he was warned not to infringe the patent, but he continued to work the invention, and the company then sought to restrain him from so doing, but the Court held that by the partnership, Lutwyche had obtained a licence to work the invention; that at the time of the assignment of the patent, the company had notice of the existence of his right; and that they could not revoke the licence.^(t)

An assignment by act and operation of law takes place when a person becomes entitled to a patent right without any deed of assignment from the person to whom he succeeds, or through whom he claims. The patent is granted to the grantee, his executors, administrators, and assigns, and these words of limitation constitute it an assignable chattel interest, assignable by act and operation of law, just as any other chattel is. Act and operation of law.

On the death of a grantee or assignee of a patent, the patent vests in his executor if he has made a duly executed will, and in his administrator if he dies intestate,^(u) and such executor or administrator may sue for and recover in respect of infringements committed during the lifetime of the testator or intestate, as the case may be, if the probate of the will or grant of letters of administration has been entered in the register of patents. Death of grantee or assignee.

If a person die possessed of an invention without having made an application for a patent, the right to apply vests in his legal representative, who of course would hold the patent, if granted, subject to any trusts contained in the will of the deceased, or for the benefit of the next of kin in cases of intestacy. And the application must be made within six months of the decease of such person, and must contain a declaration by the Death of person possessed of an invention

^(t) Kenny's Patent Button-holing Co. v. Somervell, 26 W. R. 787.

^(u) Williams on Executors, 8th ed. vol. i. p. 824.

legal representative, that he believes such person to be the true and first inventor.^(x)

Trustee in
bankruptcy .

If a grantee or assignee is declared bankrupt, the patent vests in his trustee in bankruptcy,^(y) who thereupon becomes entitled, for the benefit of the creditors, to sue in respect of infringements, whether committed before the bankruptcy or not, but it is submitted that the trustee, before commencing action, must obtain an entry of his title on the register of patents.

Undischarged
bankrupt.

If a bankrupt before he obtains his certificate of discharge obtain a patent, it will vest in his trustee for the benefit of the creditors.^(z) The fruits which result from schemes which a bankrupt has in his head before he obtains his discharge do not pass to the trustee, provided such results are subsequent to his discharge; but if he avail himself of his knowledge and skill, and thereby acquires a beneficial interest, which may be the subject of assignment, that interest will pass to the trustee.^(a)

Surrender of
letters patent.

A patentee or an assignee may dispose of the patent by surrender to the Crown, the effect being to extinguish the privilege. If there is more than one patentee or assignee, all should join in a surrender of the patent; though probably a joint patentee or assignee might surrender his part of the patent.

The surrender of a patent must be made by deed, which requires enrolment, for nothing can be conveyed to the Crown except by matter of record.^(b)

^(x) 46 & 47 Vict. c. 57, s. 34; p. 6 *ante*.

^(y) *Hesse v. Stevenson*, 3 Bos. & P. 565; *Bloxam v. Else*, 6 B. & C. 169; 9 Dowl. & R. 215; Bankruptcy Act, 1883.

^(z) *Hesse v. Stevenson*, 3 Bos. & P. 565.

^(a) *Ibid.* See judgment of the Court of Common Pleas, delivered by Lord Alvanley, C.J.

^(b) *Hindmarch on Patents*, 247.

CHAPTER IX.

LICENCES.

POWER TO GRANT LICENCES—LICENCE MUST BE BY DEED—STAMPS—
COMPULSORY LICENCES — VOLUNTARY LICENCES — REVOCABLE
LICENCES — IRREVOCABLE LICENCES — GENERAL LICENCES —
LIMITED LICENCES—EXCLUSIVE LICENCES—CONSIDERATION —
ESTOPPEL—FRAUD—REGISTRATION OF LICENCES—POWER OF
LICENSEE TO SUE FOR INFRINGEMENT.

It is open to question whether a patentee could give a valid licence authorising another person to exercise the privilege granted by the Crown, which is of a personal nature, unless the power to grant such licence was expressly given by the letters patent themselves, which, as we have seen, not only grant, but actually create the monopoly.^(a)

Query whether patentee could grant licences without express authority.

The old form in which letters patent were granted gave express power to the grantee to authorise his licensees to perform the invention. Old form.

Express power of granting licences is likewise conferred on the patentee by the form prescribed by the Act of 1883,^(b) for the grant is made to the "patentee," which by a previous recital means the grantee, his executors, administrators, and assigns; and then follows a prohibition to all the Queen's subjects whomsoever, within the United Kingdom of Great Britain and Ireland, and the Isle of Man, that they do not at any time during the continuance of the term for which the patent is granted, either directly or indirectly, make use of or put in practice the invention, or any part of the same, nor in anywise imitate the same, nor cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, licence, or agreement of Present form.

^(a) p. 304.

^(b) See Appendix.

the patentee in writing under his hand and seal, on pain of incurring such penalties as may be justly inflicted on such offenders for their contempt of the Royal command, and of being answerable to the patentee, according to law, for his damages thereby occasioned. And the letters patent further contain a proviso that nothing therein contained shall prevent the granting of licences in such manner and for such considerations as they may by law be granted.

Power of co-owners to grant licences.

Each of two or more co-owners of a patent is entitled to work the invention for himself, and to assign his share, but there is some doubt whether he is entitled to grant licences.^(c)

It is doubtful whether any licence could be granted at all if authority to grant licences were not given by the granting and prohibitory clauses of the patent, and the question whether one of several co-owners is entitled to grant a licence alone depends on the words of the letters patent.^(d)

If, as in *Mathers v. Green*,^(e) the grant is made to the grantees, their executors, administrators, and assigns, that they and every of them, by themselves, their servants and agents, *and such others as they shall agree with*, and no others, may use the invention, then it is submitted that no licence could be granted without the concurrence of all the patentees.^(f)

Royalties in respect of licences granted by co-owners separately.

Each co-owner is entitled to retain whatever profit he makes by his own working of the invention, though it is open to question whether, if he grant licences, he is not liable to account to his co-owners for the royalties he receives.^(g)

Licence must be by deed.

Formerly a licence to use a patented invention need not have been made under seal,^(h) but the effect of the prohibiting clause in modern letters patent seems to make it compulsory that the licence must now be under the hand and seal of the patentee; that is to say, it must be made by deed. An agreement, though not under seal, for a licence is equivalent, however,

^(c) *Mathers v. Green*, L. R. 1 Ch. 29; see *ante*.

^(d) See Appendix, for forms of letters patent at present in use in cases of grants to joint grantees.

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

^(f) See Jessel, M.R., *Powell v. Head*, L. R. 12 Ch. D. 690.

^(g) *Dunncliff v. Mallett*, 7 C. B. N. S. 209; *Walter v. Lavater*, 8 C. B. N. S. 162; *Mathers v. Green*, L. R. 1 Ch. 29; *Hancock v. Bewley*, Johns. R. 601.

^(h) *Chanter v. Johnson*, 14 M. & W. 408; 14 L. J. Ex. 289; *Chanter v. Dewhurst*, 12 M. & W. 823; 13 L. J. Ex. 198.

to a formal deed of licence in questions affecting the rights of the parties.⁽ⁱ⁾

Where an applicant before filing his complete specification granted a licence to use the invention, and the licensees on being sued, after the grant of the patent, for the payment of royalties refused to pay, on the ground that the letters patent were obtained for an invention less than the whole invention described in the provisional specification, Chitty, J., held that, on the construction of the licence, without deciding the point so raised by way of defence, the bargain was that in the circumstances the royalties should be paid.^(k)

Licence granted before acceptance of complete specification, and validity disputed afterwards.

A licence to use a patented invention bears a ten-shilling stamp, and an *ad valorem* stamp is required in cases where a fixed sum is paid as consideration. In cases where the licensee covenants to pay a minimum royalty the Stamp Office requires an *ad valorem* duty to be paid on the gross minimum royalty, and this whether or not the licence is determinable.

Stamps.

Licences to use patented inventions may be divided into—

- (1) compulsory licences,
- (2) voluntary licences.

Previous to the Act of 1883 it was optional with the grantee of a patent whether he would grant licences authorising other persons to use the invention, but this statute (which only applies in this respect to patents granted on applications since January 1, 1884,^(l) enacts ^(m) as follows:—If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licences on reasonable terms—

Compulsory licences.

Power of Board of Trade.

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

(i) Postcard Automatic Supply Co. v. Samuel, 6 P. O. R. 560.

(k) Otto v. Singer, 7 P. O. R. 7.

(l) 46 & 47 Vict. c. 57, s. 45 (2).

(m) 46 & 47 Vict. c. 57, s. 22.

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

It is to be observed that neither the Act nor the Rules give any powers either to the Board of Trade, or the Comptroller, over the costs incurred on presenting a petition for the grant of a compulsory licence.

Appeal.

The Act does not directly provide for any appeal from the decision of the Board of Trade, and in the case of a refusal on the part of the Board to grant an application, there is absolutely no appeal; but it would appear that in the event of the Board granting the prayer of the petition the patentee may obtain a revision of the Board's decision by leaving the petitioner to move for a mandamus to enforce the order. A writ of mandamus is a prerogative writ, and not a writ of right, and it is in this sense in the discretion of the Court whether it shall be granted or not. The Court may refuse to grant the writ, not only on the merits, but upon some delay, or other matter personal to the party applying for it; in this the Court exercises a discretion which cannot be questioned. So in cases where the right, in respect of which a rule for a mandamus has been granted upon showing cause, appears to be doubtful, the Court frequently grants a mandamus in order that the right may be tried upon the return; this is also a matter of discretion.^(o) The writ may be refused on a consideration of the special circumstances of a particular case,^(p) and it was refused where it was impossible, owing to want of funds, to perform an order of the Board of Trade.^(q)

Licences may be—

- (1) revocable,
- (2) irrevocable.

Revocable
licences.

Frequently the licence contains a provision under which it

⁽ⁿ⁾ The practice on an application for the grant of a compulsory licence is governed by rules 60 to 67 inclusive of the Patent Rules, 1890; 51 & 52 Vict. c. 50, s. 25.

^(o) Per Lords Chelmsford and Hath-

erley, *R. v. Churchwardens of All Saints', Wigan*, L. R. 1 App. Cas. 620, 622.

^(p) *R. v. Garland*, L. R. 5 Q. B. 269.

^(q) *Re The British and North Somerset Ry. Co.*, L. R. 3 Q. B. D. 10.

may be revoked and terminated on the happening of certain events, such as the non-payment of royalties or a decision of a Court of law to the effect that the patent is void.

If a licence is expressed in general terms, the inference is that it is a mere licence revocable at will, but a licence coupled with an interest is not so revocable.^(r)

When, from an examination of the whole instrument, it appears clear that the intention of the parties was that the licence was to be irrevocable, neither party can, without the consent of the other, put an end to it.^(s) Irrevocable licences.

A licence, coupled with an interest, may, however, be revoked if the terms and conditions on which it was granted are broken; and a simple notice in writing is quite sufficient to revoke it, a deed not being necessary.^(t) Licence coupled with an interest.

Licences may be—

- (1) general,
- (2) limited,
- (3) exclusive.

General licences are those which include the right to use every part of the invention, and apply to the whole of the geographical area for which the patent was granted. General licences.

Limited licences may be limited in the sense that they apply only, (a) to a part of the invention, (b) to the use of the invention in a particular manner, (c) in a particular district, (d) or for a specified portion of the term for which the patent was granted. Limited licences.

Exclusive licences are those under the terms of which the patentee is prevented from making a like grant to any one other than the licensee during the continuance of the licence. Exclusive licences.

Not unfrequently patentees grant exclusive licences for the whole or some particular part of the invention, applying to the whole or some particular part of the geographical area over which the patent right extends. It is usual to insert in an exclusive licence a covenant on the part of the patentee to the

^(r) Wood v. Ledbitter, 9 Jur. 187; Ward v. Livesey, 5 P. O. R. 102, 106.

^(s) Kenny's Patent Button-holing Co. v. Somervell, 38 L. T. N. S. 870.

^(t) Ward v. Livesey, 5 P. O. R. 102.

effect that he will not grant any other licence authorising any other person to use the invention within the district to which the licence applies. It may be questioned whether such a covenant divests the patentee of all power of granting any other licence in breach of his covenant; but he would be clearly liable in damages if he were to do so.

Exclusive licence amounting to an assignment.

If an exclusive licence be made irrevocable and applicable to the whole geographical area of the patent right, it amounts to an assignment of the patent; and it would appear that since the licence is made by deed, and no particular form of words is required to effect an assignment, such an exclusive licensee would be entitled to apply to have his name entered on the register of patents as the owner for the time being.^(u)

An exclusive licence operates as an assignment of the patent in the same way as a demise by a lessee of the premises comprised in his lease for the whole of the term granted amounts to an assignment to the under lessee.^(v) For an assignment is a transfer or making over to another of the whole right of the assignor in the thing transferred,^(y) and any words which show an intention to do this in a deed are sufficient with respect to a patent-right.^(z)

Assignable licences.

A licence may be made to an individual only, or to him, his executors, administrators, and assigns, and the question whether or not a licence is assignable depends in each case upon the words by which it was granted.

Bown v. Humber.

In *Bown v. Humber*^(a) it appeared that the plaintiff, the owner of a patent for improvements in the bearings of bicycles in the year 1885 granted to a firm of bicycle manufacturers a licence to use the invention within the United Kingdom, the Channel Islands, and the Isle of Man, for the purpose of applying the invention to the wheels of bicycles, &c., manufactured for sale or use or otherwise by the licensees, or by persons employed by them, but not in any other manner, with a proviso that the licence should not be construed to permit the licensees to make or sell the patent bearings to be applied to the

^(u) See p. 296 *ante*; *Heap v. Hartley*, 6 P. O. R. 495, 500.

^(v) *Palmer v. Edwards*, 1 Doug. 187 n.; *Parmenter v. Webber*, 8 Taunt. 593; 2 B. Mo. 656; *Shep. Touch.* 266.

^(y) 2 Bl. Com.

^(z) p. 306, *ante*.

^(a) 6 P. O. R. 9.

wheels of bicycles, &c., manufactured by any other person or company, other than the licensees or by persons employed by them; and that the licence should not authorise the use of the said invention by the licensees individually or separately, but only by the licensees jointly, or such two or one of them as should continue to carry on the business, hitherto carried on by the three licensees at Beeston, or the person or persons or company from time to time carrying on such business.

In 1887 the defendants were registered as a limited company to acquire and carry on the business of the licensees and various other businesses at other places. The defendants claimed under the licence the right to manufacture the patent bearings at all places where they carried on business, and also to apply the patent bearings to all bicycles, &c., manufactured by them, whether manufactured by them at Beeston or elsewhere.

The plaintiff contended that the licence only authorised the defendants to manufacture the patent bearings at Beeston, in connection with the business of the original licensees; and, secondly, only to apply the patent bearings to bicycles, &c., manufactured by them at Beeston in connection with the said business; and the plaintiff brought the action and moved for an injunction to restrain the defendants from using the patent, otherwise than according to the plaintiff's construction of the licence, but the Court held that the defendants, as carrying on the original business of the licensees at Beeston, were entitled to start other businesses elsewhere, and to apply the patent bearings to any bicycles, &c., manufactured by them in such other businesses, and dismissed the action with costs.

The Crown has the right to use the inventions comprised in all letters patent granted before the commencement of the Act of 1883, *i.e.*, the 1st January 1884, or on any application then pending. And the Crown has the power to use any such invention without the assent of, or compensation to, the patentee.^(b) The Crown enjoys this right, not because it is exempted from the effect of the letters patent, but because the privilege thereby granted is granted against the subjects only,

Right of
Crown to use
inventions
forming sub-
ject-matter of
patents prior
to Jan. 1. 1884

(b) *Feather v. The Queen*, 6 B. & S. 257; *Dixon v. The London Small Arms Co. Limited*, L. R. 1 App. Cas. 632.

and not against the Crown.^(c) This right of the Crown may be exercised by any Government department. Contractors who supply the Government with manufactured articles are not servants of the Crown, and if such articles are manufactured according to a patented invention, without the licence of the patentee, the manufacturers are liable to be sued by the patentee for infringement.^(d) The patentee's remedy, in case he wishes to question the authority of the Crown, is not by petition of right, but by proceeding against the officers of the Crown using the patent.^(e)

Letters patent
subsequent to
Jan. 1. 1883.

With regard to all patents granted on applications dated after the 1st January 1884, it is provided by the Act of 1883 ^(f) that they shall have to all intents the like effect as against Her Majesty the Queen, her heirs and successors, as they have against a subject.

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

Consideration
for licence.

There is no restriction as to the consideration in respect of which a licence may be granted. As a licence must be granted by deed, it is not necessary that there should be any consideration at all.

The patentee generally grants licences in return for some consideration, which is usually a money payment, either of a fixed amount or a sum varying according to the extent to which the licensee uses the invention, or of a fixed royalty in respect of every single article manufactured by the licensee according to the invention, or a royalty on profits.

^(c) Per Lord Selborne, *Dixon v. The London Small Arms Co., Limited*, L. R. 1 App. Cas. 659.

^(d) *Dixon v. The London Small Arms Co., Limited*, L. R. 1 App. Cas. 632.

^(e) *Feather v. The Queen*, 6 B. & S. 257; *Walker v. Congreve*, 1 Carp. P. C. 356.

^(f) 46 & 47 Vict. c. 57, ss. 27 and 45 (2).

It is usual to insert in a licence which is granted in con- Covenants.
sideration of a periodical or other payment, a covenant on the
part of the licensor that the patent is valid so far as his acts
or omissions are concerned, and that he has power to grant the
licence, and on the part of the licensee a covenant for pay-
ment of the various sums as they become due. And if the
sums reserved vary with the extent of the licensee's user of the
invention, it is usual for him to covenant to render accounts to
the patentee, and to permit periodical inspections of premises
and machinery. *(g)*

It is usual also to insert conditions avoiding the licence
altogether, if the licensee fail to pay any of the sums and
royalties reserved by the licence, or to perform any of his
covenants. *(h)*

In the interests of a patentee it is absolutely necessary that
a licence which is made in consideration of periodical payments,
should contain covenants on the part of the licensee for pay-
ment of the sums reserved, and a proviso terminating the
licence if default is made; otherwise a defaulting licensee might
assign the licence (if assignable), *(i)* and so escape all liability
in respect of it.

A licensor is not entitled to interfere with the trade of his Disputes.
licensee pending disputes as to collateral matters; *(k)* but the
owner of both English and foreign patents, who has granted a
licence to work under one or all of the foreign patents, but not
under the English patent, will not be restrained from issuing
circulars, warning the public that the sale in England of articles
made abroad according to the patented invention is an infringe-
ment of the English patent. *(l)*

A licence to use a patented invention under a foreign patent Licence to use
invention
under foreign
patent.
stands in a very different position to the sale of an article
manufactured under either a foreign or an English patent.

The sale of an article without any restriction, whether Article sold
without re-
striction.
manufactured under a British or foreign patent, as against the
vendor, gives the purchaser the absolute right to deal with the

(g) See Appendix.

(h) See Appendix.

(i) p. 330.

(k) Clark v. Adie, 21 W. R. 456, 764.

(l) Société Anonyme des Manufac-
tures de Glaces v. Tilghman's Patent
Sand Blast Company, L. R. 25 Ch. D.
1; Betts v. Willmott, L. R. 6 Ch. 239.

article in any way he thinks fit, and of course that includes selling in any country, where there is a patent in the possession of, and owned by, the vendor.(m)

Estoppel.

A licensee, who has covenanted with the patentee to pay a royalty for the right to use a patented invention, is estopped, in virtue of recitals implying the validity of the patent, during the continuance of the licence, from denying that validity as against the licensee in any legal proceedings to which they are both parties;(n) and he is so estopped independent of estoppel by deed,(o) and even when he has used the invention under a mere verbal agreement.(p)

After the termination of the licence, the licensee may dispute the validity of the patent,(q) but he cannot sell articles as manufactured under licence from the patentee.(r)

Where, in an action for infringement, the defendant, who was the mortgagee of certain articles manufactured under a licence which the plaintiff alleged was revoked, disputed the fact of revocation, and contended that the patent was invalid, the Court held that he must elect which line of defence he would adopt.(s)

Verbal agreement.

In *Crossley v. Dixon* (t) it was held that though the agreement for a licence was only verbal, yet the defendant having used the invention, was not entitled in a subsequent action, brought for the recovery of royalties, to deny the validity of the patent.

Covenants for title and validity.

If it is the intention of the parties that it is to be open to the licensee to dispute the validity of the patent, then the licence ought to be specially framed to allow of this, by the insertion

(m) *Société Anonyme des Manufactures des Glaces v. Tilghman's Patent Sand Blast Company*, per Cotton, L.J., L. R. 25 Ch. D. 9; *Betts v. Willmott*, L. R. 6 Ch. 239; *Heap v. Hartley*, 5 P. O. R. 603; 6 P. O. R. 495.

(n) *Baird v. Neilson*, 8 Cl. & Fin. 726; *Cutler v. Bower*, 11 Q. B. 973; 17 L. J. Q. B. 217; *Hills v. Laming*, 9 Exch. 256; 23 L. J. Ex. 60; *Bowman v. Taylor*, 2 A. & E. 278; 1 W. P. C. 292; *Lawes v. Purser*, 6 E. & B. 930; 26 L. J. Q. B. 25; *Norton v. Brooks*, 7 H. & N. 499; *Smith v. Scott*, 28 L. J. C. P. 325; 6 C. B. N. S. 771; *Bessmans v. Wright*, 6 W. R. 719; *Crossley v. Dixon*, 10 H. L. 293; 32 L. J. Ch.

617; *Hall v. Conder*, 2 C. B. N. S. 22, 53; 26 L. J. C. P. 138, 288; *Trotman v. Wood*, 16 C. B. N. S. 479; *Clark v. Adie*, L. R. 2 App. Cas. 423; *Liardet v. Electric Lighting Co.*, W. N. 1883, 96; *Ashworth v. Law*, 7 P. O. R. 231.

(o) *Lawes v. Purser*, 6 E. & B. 930; *Norton v. Brooks*, 7 H. & N. 499.

(p) *Crossley v. Dixon*, 10 H. L. C. 293, 308, 310; *Clark v. Adie*, L. R. 2 App. Cas. 423.

(q) n. 336 *post*.

(r) *Postcard Automatic Supply Co. v. Samuel*, 6 P. O. R. 560.

(s) *Postcard Automatic Supply Co. v. Samuel*, 6 P. O. R. 560.

(t) 10 H. L. Cas. 293.

of covenants on the part of the licensor for title to grant the licence, and that the patent is valid.

If there are no express covenants on the part of the licensor as to his power to grant the licence, and as to the validity of the patent, the law will not import any, since the privilege created by letters patent is impressed with the nature of personality, and the law will not create a covenant respecting a personal thing.^(u)

Though previously to the commencement of an action for the recovery of royalties due under a licence, the patent has been declared void in other proceedings, the defendant, if he be the licensee of the plaintiff, under a licence containing no covenant on the part of the licensor as to his title to grant the licence and as to the validity of the patent, cannot plead that the patent is bad.^(v)

The licensee cannot in the absence of fraud recover royalties which he has paid under a licence, even though, after the termination of the licence, it should turn out that the patent is bad.^(y)

Fraud is a defence to an action for the recovery of royalties, and it is also a ground on which a licensee, who has paid royalties under a licence tainted therewith, can recover the moneys he has disbursed.^(z)

Where a person has agreed, not under seal, with the patentee to pay a certain sum of money, annually or otherwise, for the use of a patented invention, but has not actually used the invention, he is not estopped from denying the validity of the patent in an action brought against him by the patentee for recovery of royalties.^(a)

In *Hayne v. Maltby* (b) the action was brought for the breach of an agreement which recited that the plaintiffs were assignees of a patent granted to T. Taylor, and that the defendant had

Royalties when patent declared invalid.

Recovery of royalties.

Fraud.

Licensee not estopped.

Hayne v. Maltby.

(u) Com. Dig. tit. Covenant, A 4.

(v) *Grover and Baker Sewing Machine Co. v. Millard*, 8 Jur. N. S. 713.

(y) *Taylor v. Hase*, 1 B. & P. N. R. 260; 1 W. P. C. 292; *Collinge v. Bowman*, 1 W. P. C. 295.

(z) *Cutler v. Bower*, 11 Q. B. 973; 17 L. J. Q. B. 217; *Hall v. Couder*, 2

C. B. N. S. 22; 26 L. J. C. P. 138; *Lawes v. Purser*, 6 E. & B. 930; 26 L. J. Q. B. 25; *Smith v. Scott*, 28 L. J. C. P. 325; 6 C. B. N. S. 771.

(a) *Chanter v. Leese*, 1 W. P. C. 295; 8 L. J. Ex. 58; 9 L. J. Ex. 327; 4 M. & W. 295; 5 M. & W. 698.

(b) 3 T. R. 438; 1 W. P. C. 291.

applied, to the plaintiffs for permission to use the patented invention, to which they assented, on condition of his working it in the manner described in the specification. The agreement contained a covenant by the plaintiffs with the defendant, that he should have the free use and quiet enjoyment of the patent machine, in case the same should be worked only in the manner described in the specification, and also a covenant by the defendant that he would not, during the residue of the term, use any of the patent machines except the one by the articles allowed to be used by him.

Under these circumstances, the Court of King's Bench held that the defendant was not estopped from denying the validity of the patent, and gave judgment for him, on the ground that the patent was void. It is to be noticed that the agreement merely recited that the plaintiffs were assignees of the patent, not that the patent was valid.(c)

Termination of licence.

After the termination of the licence, the licensee is in just the same position as the rest of the Queen's subjects, with regard to being able to deny the validity of the patent, if the patentee brings any action against him for infringement.(d)

Goucher v. Clayton.

In *Goucher v. Clayton* (e) it appeared that the plaintiff took proceedings in 1854 against a certain firm of Clayton & Co., for infringement of his patent. The firm submitted to a judgment in the action, and took a licence for five years (afterwards extended to seven), to work under the patent. The present suit was instituted in 1864, against the same firm, but two new partners had entered the firm after the judgment at law. The defendants raised the issues of want of novelty and sufficiency of the specification. Page Wood, V.C., overruled the objection that the defendants were estopped from denying the validity of the patent, both as having been licensees, and by reason of the judgment at law, and stated that in any case he could not prevent those defendants, who were not parties to the action at law, from setting up that defence.

(c) See *Bowman v. Taylor*, 2 A. & E. 278; 1 W. P. C. 293; and remarks of Lord Cottenham, L.C., in *Neilson v. Fothergill*, 1 W. P. C. 290.

(d) *Axmann v. Lund*, L. R. 18 Eq. 330; 43 L. J. Ch. 655; *Goucher v.*

Clayton, 11 Jur. N. S. 107; 34 L. J. Ch. 239; *Dangerfield v. Jones*, 13 L. T. N. S. 142; *Neilson v. Fothergill*, 1 W. P. C. 290.

(e) 11 Jur. N. S. 107; 34 L. J. Ch. 239.

An equitable assignee of an exclusive licence is not estopped, in an action brought against him by the patentee for infringement, from disputing the validity of the patent. *(f)*

Equitable assignee of exclusive licence.

Though a licensee of a patentee is, during the continuance of the licence, estopped from disputing the patent as against the patentee, yet he is entitled in an action to show that what he has done (in respect of which patent royalties are claimed from him), does not fall within the limits of the patent, but is something extraneous to it. *(g)*

Limit of patent.

A licensee under a patent is in a situation analogous to a tenant, who, during the tenancy, cannot dispute the title of the lessee to any of the land held under the lease; but who is nevertheless at liberty to show that part of the land he actually occupies is really not comprised within the lease, but belongs to himself under some other right. *(h)*

A licensee (not a party to the action) cannot be compelled to give inspection in an action against the licensor, but if the licensor can arrange for an inspection, it is proper he should do so; and if it appear that the licensor is himself or by his licensee working the process in dispute, the usual order for inspection will be made. *(i)*

Inspection as regards a licensee.

A licensee is a competent witness for the plaintiff in an action for the infringement of a patent under which he has a licence. He has no direct pecuniary interest in supporting the patent, and it may be for his advantage that it should not be supported. *(k)*

Licensee may be witness for plaintiff in an action for infringement.

An account of profits will not be granted against a licensee at the instance of the licensor or his assignee, if there is proof that no profits have arisen, and not in any case unless all parties interested are before the Court. *(l)*

Account of profits against a licensee.

The vendee of a licensee has all the privileges of an ordinary vendee, including that of resale.

Vendee of a licensee.

(f) Pidding v. Franks, 1 Mac. & G. 56; 18 L. J. Ch. 295.

(g) Clark v. Adie, L. R. 2 App. Cas. 423; Crossley v. Dixon, 10 H. L. Cas. 293; Cropper v. Smith, L. R. 26 Ch. D. 700; Couchman v. Greener, 1 P. O. R. 197; The Useful Patents Company v. Rylands, 2 P. O. R. 255.

(h) Per Lord Blackburn, Clark v. Adie, L. R. 2 App. Cas. 435.

(i) Germ Milling Co. v. Robinson, 3 P. O. R. 11, 14.

(k) Per Lord Abinger, C.B., Derosne v. Fairie, 2 Cr. M. & R. 476; 1 W. P. C. 154.

(l) Bergman v. Macmillan, L. R. 17 Ch. D. 423.

LETTERS PATENT FOR INVENTIONS.

Thus, where the defendant in an action for the infringement of a patent for improvements in the manufacture of soap, pleaded that the alleged infringement was the resale by him of soap purchased by himself from licensees of the plaintiff, the Court of Common Pleas held this to be a good defence, and gave judgment for the defendant accordingly.^(m)

What the letters patent prohibit the public from doing without the consent, licence, or agreement of the patentee, under his hand and seal, is the making use of, or putting in practice, the invention comprised in the patent—that is, the art by the exercise of which the patentee produces the finished product.

The public are entitled to use the invention in the sense of the finished product without the licence of the patentee, if that finished product was not produced in infringement of the patent.

Use of a manufactured article only constitutes an infringement when the article used is produced by an infringement.⁽ⁿ⁾

Registration
of licences.

A notification of every licence to work under a patent must be entered in the Register of Patents, and an attested copy of every licence granted under a patent must be left at the Patent Office by the licensee, with a request that a notification thereof may be entered in the register. The licensee must cause the accuracy of such copy to be certified as the Comptroller may direct, and the original licence must at the same time be produced and left at the Patent Office, if required, for further verification.^(o)

Notice.

Registration under the Act of 1883 of an exclusive licence for a limited area is not notice to the world, so as to affect defendants buying outside and using inside the area, without notice of the licence, certain machines manufactured by the patentee outside the area.^(p)

Power of li-
censee to sue
in respect of
infringements.

It is clear that a mere licensee having a simple licence to work under a patent cannot sue alone in respect of infringements of the patent, but he must join the patentee, for, since the patentee may grant a licence to any other person, the de-

^(m) Thomas v. Hunt, 17 C. B. N. S.
183.

⁽ⁿ⁾ Chap. xiii.

^(o) 46 & 47 Vict. c. 57, s. 23; P. R.,
1890, r. 77.

^(p) Heap v. Hartley, 5 P. O. R. 603;
6 P. O. R. 495.

fendant in the action might possibly be a licensee also, and the infringement is an injury to the patentee and not to the mere licensee.(*q*)

It consequently follows that a patentee, who has merely granted simple licences, is entitled to sue alone in respect of any infringements without joining his licensees; for, since he may grant licences to whom he pleases, the injury affects him alone, and it would appear that a patentee, who has granted an exclusive licence, which does not amount to an actual assignment of the patent (*e.g.*, one which contains a power of revocation in the event of breach of covenant), may sue to restrain infringements without bringing the exclusive licensee before the Court; for the injury done to the patentee is distinct from that suffered by the exclusive licensee. The infringement affects the exclusive licensee by injuring his trade; it affects the patentee both by loss of reputation of the patent through infringements being permitted, and by loss of royalties, if royalties are paid for the licence.

As regards an exclusive licensee, he is not entitled to sue alone in respect of infringements, if the licence is not coupled with, or equivalent to an assignment, but the patentee must join as plaintiff,(*r*) or be added as a defendant.

In the case of exclusive licences it is usual to insert a covenant on the part of the patentee binding him to proceed against all persons who may infringe the patent, or to allow the licensee to do so in his name.(*s*)

The decision of Lord Hatherley, then Vice-Chancellor Wood, in *Renard v. Levinstein* (*t*) appears to be an authority for the statement that an exclusive licensee is entitled to sue alone to restrain infringements within the area of the exclusive licence. It must, however, be noticed that in that case the owners of the patent were joined as defendants, and there does not appear to be any decided case in which the licensee has been allowed to sue without the patentee being a party.(*u*)

(*q*) *Newby v. Harrison*, cited in *Renard v. Levinstein*, 2 H. & M. 628; *Derosne v. Fairie*, 1 W. P. C. 155.

(*r*) *Heap v. Hartley* 5 P. O. R. 603; 6 P. O. R. 495. See R. S. C. or 162.

(*s*) See Form in Appendix.

(*t*) 2 H. & M. 628.

(*u*) *Plimpton v. Malcolmson*, L. R. 3 Ch. D. 531; *Barnett v. Barrett's Screw Stopper Bottling Co.*, 1 P. O. R. 9; *Heap v. Hartley*, 5 P. O. R. 603.

CHAPTER X.

REVOCATION OF LETTERS PATENT.

EFFECT OF GRANT OF LETTERS PATENT—CONDITION OF LETTERS PATENT—REVOCATION OF LETTERS PATENT—WHO MAY PETITION—GRANT OF FRESH PATENT—PARTIES—GROUNDS FOR REVOCATION—PARTICULARS OF OBJECTIONS—INTERROGATORIES—HEARING OF PETITION—REGISTRATION OF ORDER.

Effect of a grant of letters patent.

LETTERS PATENT for inventions are obtained on the faith of representations made by the patentee, and where there is no opposition (*a*) they are rarely refused.

The Crown makes the grant at the patentee's peril, and does not guarantee its validity if the representations contained in the applicant's declarations are not true, or if all the requirements of the law are not satisfied. (*b*)

The grant of a patent for an invention operates as a curtailment of the rights of the public, for it prohibits all Her Majesty's subjects, other than the patentee and his licensees, from using the invention, even if they should discover it independently for themselves. (*c*) As we have seen, the only justification for making the grant, is the consideration that the patentee is the first to give the public a knowledge of the invention, and the means of making practical use of it. (*d*)

It is evident that, if a grant of letters patent for an invention be made, which is in fact void owing to the grantee not being the true and first inventor, or on account of the alleged invention not being proper subject-matter, or in consequence of some defect as regards novelty, utility, proper specification, or any other ground which vitiates a patent, so long as the

(*a*) See p. 281 *ante*.
(*b*) p. 256 *ante*.

(*c*) p. 85 *ante*.
(*d*) *Ante*.

grant remains unrevoked the public suffers an injury, and the patentee is in the enjoyment of a monopoly to which he is not entitled.

We shall see hereafter that in the event of a patentee bringing an action against any member of the public in respect of any act alleged to be an infringement of the plaintiff's rights under the grant, it is competent to the defendant to put in issue the validity of the patent on any one or more of the grounds which in law render it void, so as to obtain the declaration of the Court on the point.^(e)

Defendant in an action for infringement may question validity of patent.

It is sometimes to the interest of a particular member of the public to obtain a revocation of a void patent, quite independently of any proceedings against him in respect of infringement; as, for instance, where an individual is using an invention, for which a subsequent patentee claims to be entitled to a patent, or where a person is desirous of using an invention included in a patent which he has good reason to believe is defective. The law has provided a means for the protection of the public to enable them to obtain the revocation of a void patent, consisting in the presentation of a petition to the Court for revocation of the patent, under s. 26 of the Act of 1883.

Member of the public interested in revocation

Formerly, if two persons had obtained patents for the same invention the Courts would not interfere between them, but left them to determine their rights by *scire facias*,^(f) for which proceeding the presentation of a petition for revocation has been substituted by the Act of 1883.^(g)

Petition for revocation instead of *scire facias*

The presentation of a petition for revocation of a patent entails expense on the part of the person presenting it, and in order that the public may not be put to the trouble or cost of resisting an unlawful patent, the Crown imposes a condition on the grantee of every letters patent for an invention. This condition is a proviso in the letters patent to the effect that, if at any time during the term for which the patent is granted, it be made to appear to the Queen, her heirs, or successors, or any six or more of her Privy Council, that the grant is

Condition of letters patent.

^(e) Chap. xiii.

^(f) *Copeland v. Webb*, 11 W. R. 134; 1 N. R. 119; *Baskett v. Cunningham*, 2 Edell, 137.

^(g) S. 26.

contrary to law, or prejudicial, or inconvenient to her Majesty's subjects in general, or that the invention is not a new invention as to the public use and exercise thereof, within the United Kingdom of Great Britain and Ireland, and the Isle of Man, or that the patentee is not the first and true inventor thereof within the realm, the letters patent shall forthwith determine and be void to all intents and purposes.(*h*)

There is no instance in modern times of the determination of a patent under this proviso, but it is probable that it was under some such proviso that Queen Elizabeth was enabled to recall patents for monopolies, which were found to be so grievous to the public during her reign.(*i*)

Revocation in a part of the United Kingdom.

The Act of 1883 defines the term "patent" as meaning letters patent for an invention(*j*) which have effect throughout the United Kingdom and the Isle of Man(*k*), and therefore, if revocation be obtained in any portion of the United Kingdom or the Isle of Man, it is applicable to the whole area for which the patent was originally granted.

Act of 1883.

The words (*l*) of the Act which establish the proceeding by petition are: "Revocation of a patent may be obtained on petition to the Court," and it is submitted that in view of the evident contemplation by the Act of proceedings in England, Scotland, and Ireland(*m*), the "Court" must be taken to mean in England, her Majesty's High Court of Justice in England (*n*); in Scotland, any Lord Ordinary of the Court of Session(*o*); and in Ireland, the High Court of Justice in Ireland.(*p*)

Revocation in England.

Scotland.

Ireland.

Court of the County Palatine of Lancaster.

Before the Chancery of Lancaster Act 1890, it was held that the Court of the County Palatine of Lancaster, not being a "Court" within the Act of 1883, was not competent to entertain a petition for revocation, but it would appear that it has jurisdiction to do so now.(*q*)

Action of reduction in Scotland.

In Scotland, proceedings for revocation of a patent are in the form of "an action of reduction at the instance of the Lord

(*h*) 46 & 47 Vict. c. 57, 1st Schedule, Form D.

(*i*) See Hindmarch on Patents, p. 432.

(*j*) S. 46.

(*k*) S. 16.

(*l*) S. 26 (2).

(*m*) See s. 26 (4) (a) (b).

(*n*) 46 & 47 Vict. c. 57, s. 117.

(*o*) 46 & 47 Vict. c. 57, s. 111.

(*p*) *Ibid.*

(*q*) 53 & 54 Vict. c. 23, s. 3; Proctor v. Sutton Lodge Chemical Co., 5 P. O. R. 184.

Advocate, or at the instance of a party having interest, with his concurrence, which concurrence may be given on just cause shown only"; and service of all writs and summonses in the action must be made according to the forms and practice existing at the commencement of the Act of 1883.(r)

In Ireland, all parties have their remedies under or in respect of a patent as if it had been granted to extend to Ireland only.(s)

No proceeding by petition or otherwise lies for revocation of a patent relating to any improvement in instruments, or munitions of war, which has been assigned to her Majesty's Principal Secretary of State for the War Department, and in respect of which such Secretary of State has, before the application for a patent, or before the publication of the specification or specifications, certified to the Comptroller his opinion that, in the interests of the public service the particulars of the invention, and of the manner in which it is to be performed should be kept secret.(t)

Improvements in instruments or munitions of war.

It is to be noticed that s. 26 sub-section 4 of the Act of 1883 authorises various persons to present a petition for the revocation of a patent; but, whereas by s. 109 the proceeding for revocation in Scotland is limited, the only persons entitled to initiate proceedings for the revocation of a patent in Scotland are the Lord Advocate and persons having an interest, with his concurrence.

Persons who are entitled to take proceedings for revocation.

The Act of 1883(u) authorises the following persons to present a petition for the revocation of a patent:

- (a) The Attorney-General in England or Ireland, or the Lord Advocate in Scotland.
- (b) Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland.
- (c) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims.

(r) 46 & 47 Vict. c. 57, s. 109.
(s) 46 & 47 Vict. c. 57, s. 110.

(t) 46 & 47 Vict. c. 57, s. 44 (9) (1)
(3).
(u) S. 26 (4).

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

If the petitioner is qualified under (c), (d), or (e), he presents his petition as of right, any other person must obtain the fiat of the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, authorising the presentation.

Fiat of the
Attorney-
General.

If there is any doubt as to whether a would-be petitioner is qualified as of right, he should take the precaution to arm himself with the fiat of the Attorney-General or the Lord Advocate, as the case requires, for the Court will at the hearing refuse to go into the question whether the patent is good or bad, if it appear that the petitioner has no *locus standi*.^(y) But any person who presents a petition under any one of the above clauses, is, if he proves his right to do so, entitled to impeach the patent on any other lawful ground.^(z)

In order to obtain the Attorney-General's fiat authorising the presentation of a petition for the revocation of a patent, it is necessary to forward the following papers to the Patent Clerk :

1. Memorial to the Attorney-General asking for his authority and stating all the circumstances.
2. Statutory declaration verifying the statements in the memorial.
3. Two copies of the proposed petition, and of the particulars proposed to be delivered with it.^(a)
4. Certificate of a barrister that the petition is proper to be authorised by the Attorney-General.
5. Certificate of a solicitor that the proposed petitioner is a proper person to be a petitioner, and that he is

^(y) *In re Avery's Patent*, L. R. 36
Ch. D. 307, 322.

^(z) *Morgan's Patent*, 5 P. O. R. 186.
^(a) For forms, see Appendix.

competent to answer the costs of all proceedings in connection with the petition if unsuccessful.

Under the old practice in *scire facias* the fiat of the Attorney-General was necessary in all cases, and was not issued as of course; (b) neither does a petitioner under the present practice obtain the fiat as a right, for the Attorney-General grants or refuses it at his discretion.

In some cases the Attorney-General decides *ex parte* whether to grant or refuse his fiat, and in others he directs notice to be given to the patentee, and that the parties be heard before him.

Thus, where no other proceeding was pending, the Attorney-General's fiat was granted without a direction to give notice to the patentees; (c) so likewise where an action for infringement of the patent had been commenced but abandoned. (d) Where an action for infringement against the applicants was pending in Scotland, and the patentees objected that, as they were resident in Scotland, the application should have been made to the Lord Advocate, the Attorney-General's fiat was refused, pending the result of the action in Scotland, but leave was given to renew the application if necessary. (e) Where the applicant was a licensee under the patent, notice was directed to be given to the patentee, (f) so also where the applicant was a defendant in an action for infringement at the instance of the patentee and the application was made during the interval after judgment in the Court of First Instance and the hearing of an appeal, (g) and where notice had been given to the patentee, the application was at the hearing ordered to stand over, on the patentee undertaking to commence an action for infringement within a month. (h)

Though the Act of 1883 gives the Attorney-General power ^{Costs.} to award the costs of proceedings before him, (i) it does not give him any authority over the costs of a petition presented

(b) 1 W. P. C. 671 n.; R. v. Prosser, 14 Beav. 306.
 (c) Gaulard and Gibbs' Patent, Griff. P. C. 320.
 (d) Rothwell's Patent, Griff. P. C. 320.
 (e) Bell and Coleman's Patent, Griff. P. C. 320; see also *In re Young's*

Patent, P. M. J. 2nd series, vol. vii. p. 44.
 (f) Martin's Patent, Griff. P. C. 320.
 (g) Watling's Patent, Griff. P. C. 320.
 (h) Siddell's Patent, Griff. P. C. 320.
 (i) S. 38.

to him praying for the grant of his fiat, when that petition is subsequently abandoned. *(k)*

Fraud and mistake.

The power of presenting a petition for the revocation of a patent conferred on "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" *(l)* relates only to cases of fraud, and will not be extended to cases of mistake notwithstanding that the consequences of the mistake may be to deprive the inventor of his patent-rights. *(m)* Thus, where a subject of the United States of America, and resident there, gave a power of attorney to an English patent agent, with instructions to obtain a patent in this country, and the agent employed a sub-agent, who took out a patent in his own name for the invention, together with some improvements of his own, without stating in the specification that it or any part of it was a communication from abroad, and made a statutory declaration that he was the first and true inventor, the Court of Appeal held that, even if the patent was void by reason of the non-disclosure in the specification of the communication from abroad, as there was no proof of any intention on the part of the patentee to deprive the inventor of his rights, the petition could not be sustained on the ground of fraud, and it was dismissed, without prejudice to any petition which the inventor might be advised to present as a person claiming to be the first and true inventor. *(n)*

Grounds for revocation.

A patent may be revoked on any ground on which previous to the Act of 1883 it could have been repealed by *scire facias*. *(o)*

A *scire facias* lay to repeal a patent in three cases according to the authority of the fourth Institute. *(p)*

1. When the King by his letters patent doth grant by several letters patent one and the self same thing to several persons, the former patentee shall have a *scire facias* to repeal the second patent.

2. When the King granteth anything that is grantable upon

(k) Martin's Patent, Griff. P. C. 320.

(l) p. 343 *ante*.

(m) *In re Avery's Patent*, L. R. 36 Ch. D. 307.

(n) *In re Avery's Patent*, L. R. 36 Ch. D. 307; 4 P. O. R. 152, 322.

(o) 46 & 47 Vict. c. 57, s. 26 (3).

(p) p. 88.

a false suggestion, the King by his prerogative *jure regio* may have a *scire facias* to repeal his own grant.

3. When the King doth grant any thing which by law he cannot grant, he, *jure regio* (for the advancement of justice and right), may have a *scire facias* to repeal his own letters patent.

It was laid down by another well-known authority (*q*) that the grounds on which a patent could be repealed by *scire facias* 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."^(r)

Parke, B., delivering the judgment of the Court of Exchequer in a case where a patent was upset on the ground of false suggestion, said: "The question is whether this patent, which suggests that certain inventions are improvements, is avoided, if there be one, which is not so. And upon the authorities we feel obliged to hold that the patent is void, upon the ground of fraud on the Crown, without entering into the question whether the utility of each and every part of the invention is essential to a patent, where such utility is not suggested in the patent itself, as the ground of the grant. That a false suggestion of the grantee avoids an ordinary grant of land or tenements from the Crown, is a maxim of the common law, and such a grant is void, not against the Crown merely, but in a suit against a third person.^(s) It is on the same principle that a patent for two or more inventions, when one is not new, is void altogether, as was held in *Hill v. Thompson* and *Brunton v. Hawkes*; for although the statute invalidates a patent for want of novelty, and consequently by force of the Statute, the patent would be void, so far as related to that which was old, yet the principle on which the patent has been held to be void altogether is, that the consideration for the grant is the novelty of all, and the consideration failing, or in

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

(*r*) See *R. v. Cutler*, Macr. P. C. 124; *R. v. Arkwright*, 1 W. P. C. 66.

(*s*) *Travell v. Casteret*, 3 Lev. 135; *Alcock v. Cooke*, 5 Bing. 340.

other words, the Crown being deceived in its grant, the patent is void, and no action maintainable upon it.”(t)

Recital.

Under the present practice, all letters patent contain a recital to the effect that the patentee has represented to the Crown that he is in possession of an invention, of which he is the true and first inventor, and that the same is not in use by any other person to the best of his knowledge and belief;(u) and a further recital to the effect that the patentee has by, and in his complete specification, particularly described the nature of his invention.(v)

Distinction between false representation and false statement.

The distinction between a false representation made by the patentee and recited in the letters patent, and a false statement, as an error in the specification, is of the greatest importance. A distinction must be drawn between an error in the specification, such as will make a suggestion in the letters patent false, and an error in a matter of direction or otherwise, such as affects the suggestion in some degree short of the preceding, as for instance, to diminish the extent of utility.(w)

Inventions with same objects.

If a patentee invents an apparatus or process for achieving a given object, he will not necessarily be entitled to obtain (on the ground that he was the first and true inventor) the revocation of a subsequent patent for achieving the same object, when the invention comprised therein is a different method of arriving at the same result, and the later patentee shows a different way of dealing with knowledge common at the date of the first patent.(y) If, however, the prior patentee has discovered a new principle and a method of carrying it out, he may be entitled to the revocation of a subsequent patent for another and analogous method of carrying out the same principle.(z)

In a case(a) where revocation of a patent for “improvements in the preparation of foods for infants and invalids” was sought, on the ground that the petitioner had for many years previous to the date of the patent been manufacturing foods

(t) Morgan v. Seaward, 2 M. & W. 544; 1 W. P. C. 196, 41.

(u) Appendix.

(v) *Ibid.*

(x) See 1 W. P. C. 42 n.

(y) Walker v. Hydrocarbon Syndicate, Ld. 2 P. O. R. 3.

(z) See Chap. II.

(a) In the Matter of Haddan's Patent, 2 P. O. R. 219.

by a process substantially similar to that of the patentee, and the evidence established the fact that the two processes were chemically the same, Kay, J., in giving judgment for the petitioner said: "This is an application to recall a patent. It is made under the Statute of 1883, which provides that a petition for revocation of a patent may be presented by, among other people, '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.' Now, the justice and common sense of that is too apparent to need much comment. A man has been carrying on a particular manufacture for some time; and that another person should come and take out a patent for that manufacture as for a new invention by that other person, and stop the manufacture that has been going on for years, would be an intolerable wrong, carried out under the apparent sanction of the Patent Law; and therefore when anything of the kind happens, the Legislature provides this simple remedy, that the person who has been carrying on this manufacture may come to the Court, and have the patent revoked."

When a petitioner succeeds on the ground that the patent was obtained in fraud of his rights, the patent of the respondent will be revoked, and a fresh patent may be granted to the petitioner,^(b) which will terminate on the expiration of the term for which the revoked patent was granted.^(c)

When a fresh patent is granted.

In all other cases when the petitioner succeeds on grounds other than that of fraud of his rights, the invention cannot be good subject-matter of a fresh patent.^(d)

When not.

Every petition for the revocation of a patent must be presented in the name of the person making the allegations in respect of which the revocation is sought; and all persons having an interest in the patent must be made respondents.^(e)

Parties.

Under the old practice it was not competent for two persons

(b) *In re Avery's Patent*, L. R. 36 Ch. D. 326.
(c) 46 & 47 Vict. c. 57, s. 26 (8).

(d) *Ibid.*
(e) *Re Avery's Patent*, L. R. 36 Ch. D. 307; 4 P. O. R. 152.

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to have a *scire facias* for the same patent, (*f*) and if the patent had been originally granted to two persons jointly it was necessary to make them both parties, notwithstanding the fact that one had, before the issue of the suit, assigned his share to the other. (*g*)

Under the present practice it is only necessary to make the persons respondents who have an interest in the patent at the time the petition for revocation is presented; and when the patent is assigned after the presentation of a petition, the name of the assignee may, on payment of a sum into Court, be substituted for that of the patentee as respondent. (*h*)

Particulars of objections.

The petitioner is required to deliver with his petition particulars of the objections on which he means to rely. (*i*) These particulars may be, from time to time, amended by leave of the Court or a judge, (*k*) and no evidence will, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars have not been delivered. (*l*)

In a case of *scire facias*, before particulars of objection were required, it was held that a suggestion in the words "the grant is prejudicial and inconvenient to our subjects in general," was too vague, and the Court refused to hear evidence on this issue. (*m*) Again after a verdict had been given for the Crown it was held to be no ground for granting a new trial that the patentee could bring further evidence, if there was no allegation of surprise, or the discovery of further evidence. (*n*)

Interrogatories.

The petitioner is entitled to administer interrogatories to the respondent as in an action for infringement of a patent. (*o*)

Certificate.

In an action for infringement it is necessary for the successful party to obtain the Judge's certificate of the reasonableness and propriety of his particulars, in order that his costs of such

(*f*) *R. v. Neilson*, 1 W. P. C. 673.

(*g*) *R. v. Betts*, 15 Q. B. 540; L. J. Q. B. 13, 53.

(*h*) *Re Haddan's Patent*, 2 P. O. R. 218.

(*i*) 46 & 47 Vict. c. 57, s. 26 (5).

(*k*) 46 & 47 Vict. c. 57, s. 26 (6).

(*l*) 46 & 47 Vict. c. 57, s. 26 (5).

(*m*) *R. v. Arkwright*, 1 W. P. C. 64 n.

(*n*) *R. v. Arkwright*, 1 W. P. C. 64,

74. For a form of particulars of objection to be delivered with a petition for the revocation of a patent, the reader is referred to *In the Matter of Haddan's Patent*, 2 P. O. R. 218; and further detailed information, relative to particulars of objections, will be found in Chapter xiii.

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

particulars may be allowed on taxation,^(p) but this does not seem necessary in the case of a petition for the revocation of a patent, and it would appear that the Court or a Judge has no power to give such a certificate.^(q)

At the hearing of a petition for revocation the *onus* is on the respondent, who therefore has the right to begin and give evidence in support of the patent, and he has the right to reply, if the petitioner tenders evidence impeaching the validity of the patent.^(r)

Hearing of
petition for
revocation.

In an action of *scire facias* the burden of proof was on the plaintiff, and in order to succeed he had to do more than establish a mere *prima facie* case.^(s)

A petition for revocation is, in every sense of the word, an action, except that it is commenced by a petition instead of a writ, and it will be tried in the way in which actions usually are tried—*i.e.*, by *virâ voce* evidence, if either of the parties desires to have it so determined.^(t)

The Court may, and on the request of either of the parties it must, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance.^(u)

Unless the Court otherwise decide, the petition is heard without a jury.^(v)

To suit the convenience of the parties to a petition for revocation and their witnesses, an order may be obtained directing the trial of the petition before a Judge without a jury at assizes.^(x)

The Act of 1883 does not provide for service of the petition out of the jurisdiction.

In the Matter of Drummond's patent ^(y) it appeared that the patentee was resident, and domiciled in Scotland. After a copy of the petition, together with the particulars of objection,

^(p) 46 & 47 Vict. c. 57, s. 29 (6).
^(q) 46 & 47 Vict. c. 57, s. 26; Gaulard and Gibbs' Patent, 5 P. O. R. 525, 537.
^(r) 46 & 47 Vict. c. 57, s. 26 (7).
^(s) R. v. Cutler, Macr. P. C. 124, 133, 134.
^(t) *In re* Gaulard and Gibbs' Patent, L. R. 34 Ch. D. 396; Walker v. Hydro-

carbon Syndicate, 2 P. O. R. 3; *In re* Haddan's Patent, 2 P. O. R. 218.
^(u) 46 & 47 Vict. c. 57, s. 28.
^(v) *Ibid.*
^(x) R. S. C. O. 36, r. 8; *In the Matter of Edmond's Patent*, 6 P. O. R. 355.
^(y) 6 P. O. R. 756.

was served upon him personally in Scotland, he wrote to the petitioner's solicitors, stating that he did not intend to appear, and objecting to the jurisdiction of the English Court. On the application of the petitioner, the Court ordered that the case should be set down for hearing, unless by a certain day, of which notice was to be given to the respondent, he should appear and show cause to the contrary; it being open to him, if he appeared, to dispute the jurisdiction.

Under the old practice, the fact of a *scire facias* pending was a ground for refusing a nonsuit on an objection to a patent in an action for infringement.^(z) Where a *scire facias* was sued out after a verdict in an infringement action, and a rule obtained to show cause why a nonsuit should not be entered, the Court refused to extend the time for this rule, until after the hearing of the *scire facias*. Tindal, C.J., pointed out that even if the *scire facias* availed, and the patent was repealed, that would not necessarily prevent the Court from giving judgment on the objections taken at the trial of the cause.^(a) So also the Court refused to deprive the plaintiff in an action for infringement of his common law right to try where a *scire facias* had been set down.^(b) As a general rule, the plaintiff had a right to have his cause go on to trial, according to the ordinary course of business, but there might be special circumstances upon which the Court might see fit to interpose.^(c)

Where, in a case in the Common Pleas, an action for the infringement of a patent had been tried, and a rule *nisi* for a new trial had been obtained and argued, and it appeared that another action was pending in that Court for another infringement of the same patent, the Court suspended judgment upon the rule for a new trial, and ordered the trial of the other action to be postponed until after the trial of the *scire facias*;^(d) and in another action in the Common Pleas, where it appeared that the defendants had sued out a *scire facias* to repeal the plaintiff's patent, and a verdict had been obtained for the Crown,

^(z) Haworth v. Hardcastle, 1 W. P. C. 485.

^(a) Haworth v. Hardcastle, 1 W. P. C. 486 n.

^(b) Muntz v. Foster, 2 W. P. C. 93 n.

^(c) *Ibid.*

^(d) Patteson v. Holland, Hindmarch Patents, p. 293.

but a rule *nisi* for a new trial was pending in the Queen's Bench and the defendant in the Common Pleas gave notice of trial *by proviso*, the Court upon the application of the plaintiff made a rule absolute for postponing the trial.(e)

In *Walker v. The Hydrocarbon Syndicate* (f) an application for the postponement of an appeal in a petition for revocation, on the ground that the petitioner could not be found at the hearing, and for leave to adduce further evidence, was refused.

The respondent may, if he thinks fit, on obtaining the leave of the Court or a judge, during a proceeding for the revocation of his patent, apply at the Patent Office for leave to amend his specification by way of disclaimer, and a postponement of the hearing may be granted to allow of this being done.(g)

Amendment of specification during proceeding for revocation.

If a petitioner succeeds in obtaining the order of the Court for the revocation of a patent he must forthwith leave at the Patent Office a copy of such order, and the purport of it will be duly entered in the Register of Patents.(h)

Registration of order for revocation.

Under the old practice, if the trial of a *scire facias* resulted in favour of the Crown, the Lord Chancellor had authority to order the patent to be restored into Chancery to be cancelled,(i) but recent legislation has not provided for the delivering up of a patent which has been revoked by a decision of the Court.

Delivery up of letters patent.

The Act of 1883 does not contain any special provision as to the costs on the hearing of a petition for revocation, but the Court acting under its general jurisdiction, awards the costs of the petition at its discretion.(k)

Costs.

(e) *Smith v. Upton*, 6 M. & G. 251.

(f) 3 P. O. R. 253.

(g) 46 & 47 Vict. c. 57, s. 19; p. 234 ante.

(h) P. R. 1890, r. 74.

(i) *R. v. Newton*, Hindmarch on

Patents, p. 427; *R. v. Eastern Archipelago Co.*, 4 De G. M. & G. 199.

(k) In the Matter of Haddan's Patent, 2 P. O. R. 218; In the Matter of Edmond's Patent, 6 P. O. R. 358.

CHAPTER XI.

PROLONGATION OR EXTENSION OF LETTERS PATENT.

PROLONGATION BY SPECIAL ACT—PROLONGATION BY PETITION—
REQUISITES OF PETITION—THE PETITIONER—ADVERTISEMENTS—
HEARING—MERIT—INSUFFICIENT REMUNERATION—ACCOUNTS—
NEW GRANT—COSTS—REGISTRATION OF ORDER.

Object of grant
of letters pa-
ent.

THE Common Law sanctions the grant of letters patent for inventions because the pecuniary reward, which a monopoly usually brings to the patentee, acts as an inducement to others possessing inventive ability to disclose their inventions for the public good.

Letters patent are never granted for a longer period than fourteen years,^(a) and it sometimes happens that this term is not sufficient to enable the patentee, by means of the profits arising from his monopoly, to recoup himself the outlay to which he has been put, and to reap the remuneration, which the law considers he is entitled to in return for communicating a valuable and perfected invention to the public.

Though an invention be beneficial, it may happen that the patentee does not reap any adequate reward during the original term, on account of his outlay in experiments, or on account of the public hesitating to perceive and adopt the discovery. The patentee may also fail to reap a proper reward because he has been compelled to carry on expensive litigation against persons who have infringed his patent, or to oppose petitions for its revocation. Again, inventors who are not affluent may nearly reach the expiry of their monopoly before they succeed in obtaining the monetary assistance, necessary to enable them to

(a) p. 292 *ante*.

develop their discoveries, so as to make any adequate profit within the residue of the term.

If from any cause whatever an inventor has not been able to reap the pecuniary benefits, to which he was entitled in respect of the disclosure of his secret, there is nothing in the spirit of the patent law, which prohibits the Sovereign, acting for and on behalf of (b) the public, from prolonging the duration of the monopoly, if there is any likelihood of the patentee making profit during the extended period.

Previous to the year 1835 the only way in which a patentee could obtain a prolongation of the period for which the patent was originally granted, was by obtaining a special Act of Parliament, and instances of such special Acts are not wanting.(c)

Lord Brougham's Act,(d) passed in the year 1835, provided "that if any person who now hath, or shall hereafter obtain any letters patent as aforesaid—*i.e.*, as grantee, assignee, or otherwise(e)—shall 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 carries 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 caveat 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 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 the caveats shall likewise be heard by their counsel and

Power of
Crown to pro-
long monopoly

Prolongation
prior to 1835.

Since 1835
Lord Brough-
am's Act.

(b) *Harmer v. Playne*, 14 Ves. 132; Bac. Abr. tit. Prerog.; Year Book 40 Edw. III. fol. 18.

(c) See 16 Geo. II. c. 25; 23 Geo. II. c. 33; 15 Geo. III. c. 52; 16 Geo. III.

c. 29; 17 Geo. III. c. 6; 25 Geo. III. c. 38; 32 Geo. III. c. 72; 10 Geo. IV. c. 135.

(d) 5 & 6 Will. IV. c. 83, s. 4.

(e) 5 & 6 Will. IV. c. 83, s. 1.

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 authorised 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 in anywise 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."

Stat. 2 & 3
Vict. c. 67.

In consequence of the hardships which patentees suffered who were unable to prosecute their petitions with effect before the expiration of the term of their patents, (*f*) so much of the above recited Act as provided that no extension of the term of letters patent should be granted, if the application by petition were not prosecuted with effect before the expiration of the term originally granted in such letters patent, was repealed by 2 & 3 Vict. c. 67.

It was provided by this latter statute (*g*) that the Judicial Committee of the Privy Council should have power wherever it appeared to them that any application for an extension of the term granted by any letters patent, the petition for which extension should have been referred to them for their consideration, had not been prosecuted with effect before the expiration of the said term from any other causes than neglect, or default of the petitioner, to entertain such application, and to report thereon as by Lord Brougham's Act, (*h*) provided, notwithstanding the term might have expired before the hearing of such application: and her Majesty was empowered, if she should think fit, on the report of the Judicial Committee recommending an extension of the term of such letters patent, to grant such extension, or to grant new letters patent for the invention or inventions specified in such original letters patent for a term not exceed-

(*f*) See *Bodmer's Patent* (1), 2 Moo. P. C. 471; 13 Newton, L. J. O. S. 175.
(*g*) S. 2.

(*h*) p. 355 *ante*.

ing seven years after the expiration of the term mentioned in the said original letters patent: Provided, that no such extension or new letters patent should be granted if a petition for the same should not have been presented as by Lord Brougham's Act directed, before the expiration of the term sought to be extended, nor in case of petitions presented after the 30th day of November 1839, unless such petition should be presented six calendar months at least before the expiration of such term, nor in any case unless sufficient reason should be shown to the satisfaction of the Judicial Committee for the omission to prosecute with effect the said application by petition before the expiration of the said term.

The fact being recognised that, for the encouragement of inventions in the useful arts, it was desirable to give the Crown power to extend the period of a patentee's monopoly beyond seven years from the expiration of the original term, in cases where it could be satisfactorily shown that the expense of the invention had been too great for the patentee to recoup himself during the term then limited by law, the Legislature in 1844 enacted as follows:

Stat. 7 & 8
Vict. c. 69.

“If any person having obtained a patent for any invention, shall, before the expiration thereof, present a petition to her Majesty in Council, setting forth that he has been unable to obtain a due remuneration for his expense and labour in perfecting such invention, and that an exclusive right of using and vending the same for the further period of seven years in addition to the term in such patent mentioned will not suffice for his reimbursement and remuneration, then, if the matter of such petition shall be by her Majesty referred to the Judicial Committee of the Privy Council, the said Committee shall proceed to consider the same after the manner and in the usual course of its proceedings touching patents, and if the said Committee shall be of opinion and shall so report to her Majesty that a further period greater than seven years' extension of the said patent term ought to be granted to the petitioner, it shall be lawful for her Majesty, if she shall so think fit, to grant an extension thereof for any term not

exceeding fourteen years, in like manner, and subject to the same rules as the extension for a term not exceeding seven years as now granted. Provided always, and be it enacted, that nothing herein contained shall prevent the said Judicial Committee from reporting that an extension for any period not exceeding seven years should be granted, or prevent her Majesty from granting an extension for such lesser term than the petitioner shall have prayed.”(i)

Stat. 15 & 16
Vict. c. 83.

By the Act of 1852(k) it was provided that any letters patent obtained in the United Kingdom in respect of any invention first invented in any foreign country, or by the subject of any foreign power or State, and in respect of which any foreign letters patent or like privilege should have been obtained, should not continue in force after the expiration of the term which should first expire or be determined of such foreign letters patent or like privileges: Provided that no letters patent granted in the United Kingdom in respect of any invention which formed the subject of any foreign expired letters patent should be valid.

It was, however, provided by the Act of 1852(k) that the provisions of Lord Brougham’s Act,(l) the Act of 1839,(m) and the Act of 1844(n) as to prolongation of letters patent should still continue in force.

Repeal and
reservation by
Act of 1883.

The Act of 1883(o) repeals the whole of the statutes hereinbefore referred to, but at the same time provides that the repeal of those enactments shall not affect their past operations, or any patent, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything done or suffered under or by any of those enactments before or at the commencement of this Act.

Practice in
cases of in-
ventions sub-
ject-matter of
foreign letters
patent.

It was the practice of the Judicial Committee, previous to the Act of 1883, not to recommend the prolongation of a patent for an invention the subject of a prior foreign patent,

(i) 7 & 8 Vict. c. 69, ss. 2 and 3.
(k) 15 & 16 Vict. c. 83, s. 25.
(l) 5 & 6 Will. IV. c. 83.

(m) 2 & 3 Vict. c. 67.
(n) 7 & 8 Vict. c. 69.
(o) 46 & 47 Vict. c. 57, s. 113.

which had expired before the hearing of the petition, on the ground that they had no authority to recommend such prolongation.^(q) In the case of a foreign inventor who held foreign patents in respect of the invention, one of which, though of later date than his English patent, had expired,^(r) or was about to expire,^(s) they refused such recommendation in the exercise of their discretion. When the inventor was an English-born subject, the practice was that his application should not be prejudiced by the fact that a foreign patent of later date than his English patent had expired.^(t)

The expiration of foreign patents does not now affect the validity of English patents granted after January 1, 1884,^(u) but it is submitted that, notwithstanding the repeal of former Acts by the Act of 1883, in the case of patents dated before January 1, 1884, the Judicial Committee will still take cognizance of the existence of foreign patents, in forming their decision whether to recommend an extension or otherwise.^(v)

The Act of 1883 provides that the repeal of the Statutes referred to shall not interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if that Act had not been passed; or take away or abridge any protection or benefit in relation to any such action.^(y)

The effect of the above reservation is to preserve to patentees whose patents were dated before January 1, 1884, all the rights vested in them by virtue of the repealed statutes. Thus, a patentee whose patent is prior to January 1, 1884, is entitled to present a petition to the Judicial Committee of the Privy Council praying for a prolongation of the term of his monopoly

^(q) *Bodmer's Patent*, 8 Moo. P. C. 282; *Anle's Patent*, 9 Moo. P. C. 43; *Blake's Patent*, L. R. 4 P. C. 535; 9 Moo. P. C. N. S. 373.

^(r) *Newton's Patent*, 15 Moo. P. C. 176; 9 Jur. N. S. 109; *Normand's Patent*, L. R. 3 P. C. 193; 6 Moo. P. C. N. S. 477.

^(s) *Normand's Patent*, L. R. 3 P. C. 193; 6 Moo. P. C. N. S. 477.

^(t) *Bett's Patent*, 1 Moo. P. C. N. S. 49; 9 Jur. N. S. 137; 7 L. T. N. S. 577.

^(u) p. 293 *ante*.

^(v) See 46 & 47 Vict. c. 57, s. 113; *Newton's Patent*, L. R. 9 App. Cas. 592; 1 P. O. R. 177; *Braudon's Patent*, 1 P. O. R. 154.

^(y) 46 & 47 Vict. c. 57, s. 113. The Act of 1883 uses the term "extension" in place of "prolongation," used in the former statutes; but as petitions are not likely to be presented under the Act of 1883 for some time to come, it is still correct to speak of "prolongation of letters patent."

at any time before the expiration of such term,^(z) though a patentee whose patent is later than that date can only present such a petition at least six months before the time limited for the expiration of his patent.^(a)

Practice.

The practice which regulates the presentation and hearing of petitions for the prolongation or extension of all patents, whether dated before or after January 1, 1884, is that which was in existence prior to the Act of 1883, and is governed by the Privy Council Rules^(b) made under Lord Brougham's Act.^(c)

Stat. 46 & 47
Vict. c. 57,
s. 25.

S. 25 of the Act of 1883 enacts as follows:—

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

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

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

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

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

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

^(z) Brandon's Patent, L. R. 9 App. Cas. 589; 1 P. O. R. 154.

^(a) 46 & 47 Vict. c. 57, s. 25, ss. 1.

^(b) See Appendix.

^(c) See 5 & 6 Will, iv. c. 83; Newton's Patent, L. R. 9 App. Cas. 592; 1 P. O. R. 177.

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

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

A petitioner seeking the grace and favour of the Crown is bound to strict truth in his statements; *(e)* and the petitioner should remember that a prolongation or extension is a matter of favour and not of right, *(f)* and that a petition will be dismissed if it fails to state everything belonging to the patent fairly and fully. *(g)* Thus the petitioner in his petition and accounts *(h)* must refer to all foreign patents granted to him in respect of the invention forming the subject-matter of the English patent, for an extension of which his application is made, and to the remuneration or loss he has derived or sustained through such foreign patents. *(i)* Prolongation has been refused on the ground that the petition was nominally presented by one, but actually in the interest and for the benefit of another company, to whom the shares in the first company had been transferred, and no statement of this fact appeared in the petition, and the Judicial Committee would not have been cognizant of it, had it not been brought forward by the Attorney-General. *(k)*

Requisites of
petition.

(d) So far, no rules have been made under this section, and it is understood that no alteration is at present contemplated in the existing rules, which were made under 5 & 6 Will. IV. c. 83.

(e) Clarke's Patent (2), L. R. 3 P. C. 421, 426; 7 Moo. P. C. N. S. 255; Johnson's Patent, L. R. 4 P. C. 75, 83; 8 Moo. P. C. N. S. 282; Hill's Patent, 1 Moo. P. C. N. S. 258; 9 Jur. N. S. 1209; 9 L. T. N. S. 101; Horsey's Patent, 1 P. O. R. 225.

(f) Adair's Patent, L. R. 6 App. Cas. 176.

(g) Pitman's Patent, L. R. 4 P. C. 84; 8 Moo. P. C. N. S. 293. Two or more patents relating to cognate

inventions, may be included in one petition: see Johnson and Atkinson's Patents, L. R. 5 P. C. 87; Clarke's Patent, L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 255; Church's Patent, 3 P. O. R. 95; Erard's Patent, 1 W. P. C. 557.

(h) p. 373 *post*.

(i) Johnson's Patent, L. R. 4 P. C. 75; 7 Moo. P. C. N. S. 255; Pitman's Patent, L. R. 4 P. C. 84; 8 Moo. P. C. N. S. 293; Adair's Patent, L. R. 6 App. Cas. 178; 50 L. J. P. C. 68; Clarke's Patent, L. R. P. C. 421.

(k) Reece's Patent, 17 Iron. 155; 51 Eng. 207.

Where it appeared from the petition that the petitioners were a company who had purchased the patent, but in fact no company, in a commercial sense, had been formed under the Companies Acts, and the persons really interested were the petitioner and a creditor; the Judicial Committee did not recommend an extension.*(l)*

And where the petition concealed the fact that the manufacture of the patented article had been, by contract, carried on by one of several joint patentees, who had carried on such manufacture in conjunction with the manufacture of other articles, and the accounts did not disclose any other manufacture than that of the patented article, the petition was dismissed.*(m)*

The petitioner cannot be too careful in framing his petition properly, as the indulgence of the Judicial Committee in granting amendments cannot be relied upon; but in some cases, where there are special circumstances, an amendment may be allowed.*(n)*

A departure from the statutory provisions on presenting a petition affects the jurisdiction of the Judicial Committee, and is consequently fatal; but an omission to observe properly the rules laid down by the Judicial Committee itself may be remedied.*(o)*

Who may petition.

The term patentee, as defined by the Act of 1883, means the person for the time being entitled to the benefit of the patent; *(p)* and it is therefore clear that prolongation or extension of the patent could be granted on the petition of the original patentee, his legal personal representative, or assignee, or, in the case of a partial assignment, the assignee or assignees conjointly with the original patentee or patentees.

The term patentee also includes the executor of a deceased assignee, *(q)* the trustees of a company, *(r)* the patentee agent of a foreign inventor, *(s)* or a mortgagee. *(t)*

(l) Horsey's Patent, 1 P. O. R. 225.

(m) Yates and Kellett's Patent, L. R. 12 App. Cas. 147.

(n) See Reece's Patent, 17 Iron. 155; 51 Eng. 207.

(o) Hutchison's Patent, 14 Moo. P. C. 364. An application for this relief takes the form of a separate petition to the Judicial Committee: see Brandon's Patent, 1 P. O. R. 154.

(p) S. 46.

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

(r) Pettit Smith's Patent, 7 Moo. P. C. 133.

(s) Newton's Patent (1), 14 Moo. P. C. 156.

(t) Southworth's Patent, 1 W. P. C. 486; but see Church's Patent, 3 P. O. R. 95.

Under Lord Brougham's Act^(u) it was doubtful whether the Crown had power to grant a prolongation in cases where there had been a complete or partial assignment of the patent right; but it was subsequently enacted that it should be lawful for her Majesty, on the report of the Judicial Committee of the Privy Council, to grant such extension as was authorised by Lord Brougham's Act either to an assignee or assignees, or to the original patentee or patentees conjointly.^(x)

Assignees do not stand the same chance of success, on an Assignees. application for extension of the patent, as original patentees,^(y) for the object of the Crown, in granting an extension, is to reward the person, who communicated the invention to the public, and unless he derives some benefit the extension will not be granted.^(z)

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 his invention into use.^(a)

On an application by assignees, the Judicial Committee always consider that by favourably listening to the application of an 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 an assignee would be materially diminished, and consequently his interest damnified. For this reason, consideration is given to the claims of the assignee who has an interest in a patent.^(b)

It thus appears that an assignee who has assisted in developing the invention, will be viewed by the Judicial Com-

^(u) 5 & 6 Will. IV. c. 83.

^(x) 7 & 8 Vict. c. 69, s. 4.

^(y) Norton's Patent, 1 Moo. P. C. N. S. 339; Normand's Patent, L. R. 3 P. C. 193; Claridge's Patent, 7 Moo. P. C. 394.

^(z) See Norton's Patent, 1 Moo. P. C.

N. S. 339; Normand's Patent, L. R. 3 P. C. 193; Bovill's Patent, 1 Moo. P. C. N. S. 348.

^(a) Per Lord Romilly, Norton's Patent, 1 Moo. P. C. N. S. 339.

^(b) See judgment of Lord Brougham, Morgan's Patent, 1 W. P. C. 738.

mittee more favourably (*c*) than one who has rendered no such assistance. (*d*)

Companies.

Companies formed for the purpose of taking over patents, and working them, stand in the same position as other assignees with regard to petitions for prolongation or extension, *i.e.*, if it can be shown that the company has expended money in developing the invention for the public benefit, and has not obtained an adequate return, the Judicial Committee will report favourably to the company, (*e*) but if the company has been formed for purposes of speculation merely, no prolongation or extension will be recommended. (*f*)

Importers.

The merit of an importer (*g*) is less than that of an original inventor. (*h*) To use the language of Lord Brougham, "the patent law is framed in a way to include two species of public benefactors; the one, those who benefit the public 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 inventions. Now, the latter is a benefit to the public incontestably, and, therefore, they render themselves entitled to be put upon somewhat, if not entirely, the same footing as inventors." (*i*)

Period within which petition may be presented.

In the case of patents granted prior to January 1, 1884, the petition may be presented at any time before the expiration of the patent, provided that it is prosecuted with effect (*i.e.*, the report of the Judicial Committee is obtained), (*k*) before the expiration of the term. (*l*)

The Act of 1883 does not require the petition to be pro-

(*c*) Bodmer's Patent, 6 Moo. P. C. 468; Berry's Patent, 7 Moo. P. C. 187; Whitehouse's Patent, 1 W. P. C. 473; 2 Moo. P. C. 496; Carp. P. C. 565; Woodcroft's Patent, 2 W. P. C. 18; 10 Jur. 363; Normand's Patent, L. R. 3 P. C. 193; 6 Moo. P. C. N. S. 477; Houghton's Patent, L. R. 3 P. C. 461.
 (*d*) Sillar's Patent, G. P. C. 581; Norton's Patent, 1 Moo. P. C. N. S. 339; 9 Jur. N. S. 419; G. P. C. 553.
 (*e*) Petitt Smith's Patent, 7 Moo. P. C. 133; Houghton's Patent, L. R. 3 P. C. 461; 7 Moo. P. C. N. S. 309; Napier's Patent (1), 13 Moo. P. C. 543; Church's Patent, 3 P. O. R. 95.

(*f*) Sillar's Patent, 1 G. P. C. 581; Claridge's Patent, 7 Moo. P. C. 394; Reece's Patent, 17 Iron. 155; 51 Eng. 207; Duncan and Wilson's Patent, 1 P. O. R. 257; see also Norton's Patent, G. P. C. 554, per Romilly, M.R.

(*g*) See p. 8 *ante*.

(*h*) Soames' Patent, 1 W. P. C. 729.

(*i*) Berry's Patent, 7 Moo. P. C. 187.

(*k*) Ledsam v. Russell, 1 H. L. Cas. 687.

(*l*) Brandon's Patent, 1 P. O. R. 154.

secuted with effect before the expiration of the original term of the monopoly; and it is submitted that, if it be presented at least six months before the time limited for the expiration, (m) any patent to which the Act applies in this matter may be extended, notwithstanding that the report of the Judicial Committee is obtained, after the expiry of the original term.

Moreover, there is nothing in the patent law which renders invalid a grant of new letters patent, dated after the expiry of the original term, if such new grant is made on the representations of a report of the Judicial Committee of the Privy Council properly obtained.

A person qualified to present a petition, and desirous of doing so, (n) for the prolongation or extension of a patent, is required, under Lord Brougham's Act, to advertise in the *London Gazette* three times, and in three London papers, and three times in some country papers published in the town where, or near to which, he carries on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carries 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.

The Judicial Committee Rules (o) provide that "a party intending to apply by petition under s. 4 of the above-mentioned Act, shall, in the advertisements 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 not be 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 must be entered; and any person intending to enter a caveat shall enter the same at the Council Office, on or before such day so named in the said advertisements; and, having entered such caveat, shall be entitled to have from the petitioner a four weeks' notice of the time appointed for the hearing."

(m) 46 & 47 Vict. c. 57, s. 25 (1).

(n) No petition has as yet been presented for the extension of the term of a patent granted under the Act of 1883, nor, as is evident from the fact that the

usual duration of a patent is fourteen years, is any such petition likely to be presented before 1897.

(o) R. II.: see Appendix.

If an equitable assignee is desirous of petitioning with the legal owner, his name must appear in the advertisements.(p)

In cases where the patentee resides abroad, and the invention is carried on under licences, the advertisements should be inserted in papers circulating in places where the manufacture is actually carried on.(q)

The advertisements must be proved before the petition is heard,(r) for if anything required by the statute to be done is not done, the Crown has no power to grant a prolongation.(s)

Day for hearing.

The usual order fixing the day for hearing, requires the petitioner to advertise the date fixed in the *London Gazette*, and two other papers named in the order.(t)

If on the application to fix a day for hearing it appear that the petition has been presented some considerable time (e.g., eighteen months) before the expiry of the patent, the hearing will be postponed, on the ground that the profits made during the unexpired period may be sufficient adequately to reward the patentee, or affect the term of extension (if any) granted,(u) but it will not be necessary to serve fresh notices.(x)

Hearing.

At the hearing of the petition, the petitioner and opposing parties may appear either in person or by counsel; but where there are several opponents, not more than two counsel will be heard on either side, unless the opposing parties have distinct and separate interests.(y)

It is the usual practice on the hearing of a petition for the Judicial Committee to deal first with the question of the utility of the invention to the public,(z) and afterwards with that of adequacy of remuneration;(a) but sometimes this order is reversed—e.g., where the accounts (b) show that the remuneration has been such that it would be preposterous to grant the petition,(c) or the accounts are unsatisfactory.(d)

(p) *In re Noble's Patent*, 7 Moo. P. C. 191.

(q) *Derosne's Patent*, 2 W. P. C. 2.

(r) *Perkin's Patent*, 2 W. P. C. 8.

(s) *In re Noble's Patent*, 7 Moo. P. C. 194.

(t) See Appendix.

(u) See *Mackintosh's Patent*, 1 W. P. C. 739 n.

(y) *Woodcroft's Patent*, 3 Moo. P. C. 172 n.

(z) p. 369 *post*.

(a) p. 371 *post*.

(b) p. 373 *post*.

(c) *Crichton's Patent*, 39 Eng. 135; *Saxby's Patent*, L. R. 3 P. C. 292; 7 Moo. P. C. N. S. 82; 19 W. R. 513; *Clark's Patent* (2), L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 255.

(d) *Wield's Patent*, L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300.

In accordance with the rule laid down in *Erdril's Patent*,^(e) the Attorney-General always appears at the hearing of petitions for the extension of letters patent, whether there is opposition or not, to watch the interests of the Crown and the public, and he is entitled to be heard without having previously entered a caveat.^(f)

Attorney-General.

The Judicial Committee may, if they think fit, 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;^(g) and under the Act of 1883 they may call in the aid of an assessor specially qualified and hear the petition, wholly or partially, with his assistance, and determine the remuneration he is to receive.^(h)

Evidence.

Where a petitioner applied to have the hearing of his petition advanced, or his evidence taken on commission on account of his impending absence from England, an order was made to the effect that, if his absence proved to be imperative, his evidence might be taken before the registrar, subject to any objection which the Attorney-General might raise. In the result the evidence was so taken, and the registrar directed that it should not be published before the hearing of the petition.⁽ⁱ⁾

A patentee is never entitled to demand, *ex debito justitiæ*, a prolongation or extension of the term of his monopoly. In all cases, the Judicial Committee have an absolute discretion in recommending the Crown to promote the progress of the petition;^(k) and the only limit to this recommendation is that the period of extension shall not be more than fourteen years.^(l)

Discretion of Judicial Committee.

All the grounds upon which the Judicial Committee of the Privy Council grant extensions of patents have reference to

Grounds on which Judicial Committee recommend extension.

(e) 1 W. P. C. 557 n.; Whitehouse's Patent, 1 W. P. C. 474.

(f) Petitt Smith's Patent, 7 Moo. P. C. 133.

(g) 7 & 8 Vict. c. 69, s. 8.

(h) 46 & 47 Vict. s. 28, ss. 2 and 3.

(i) Whitworth's Patent, 48 Eng. 15.

(k) Jones' Patent, 1 W. P. C. 577; Smith and Robertson's Patent, 30 New

ton, L. J. O. S. 451; Porter's Patent, 1 Newton, L. J. N. S. 179; Morgan's Patent, 1 W. P. C. 739; Soame's Patent, 1 W. P. C. 733; Perkin's Patent, 2 W. P. C. 16; Derosne's Patent, 2 W. P. C. 4; Honiball's Patent, 9 Moo. P. C. 393; Cardwill's Patent, 10 Moo. P. C. 490.

(l) 46 & 47 Vict. c. 57, s. 25; Ledsam v. Russell, 1 H. L. Cas. 687.

the inventor himself. They are, in the first place, to reward the inventor for the peculiar ability and industry he has exercised in making the discovery; in the second place, to reward him because some great benefit of an unusual description has by him been conferred upon the public, through the invention itself; and, lastly, because the inventor has not been sufficiently remunerated by the profits derived from his strenuous exertions, to make the invention profitable. All these grounds proceed upon the supposition that the invention is new and useful.(*m*)

Moreover, the grant of an extended term must not be detrimental to the public interest.(*n*)

Petitioner
must prove—

From the above, it is clear that a petitioner, in order to induce the Judicial Committee to recommend the Crown to grant the prayer of the petition, must satisfactorily prove two things, viz. :—

- (i.) The invention is meritorious;
- (ii.) He has been insufficiently remunerated, owing to no fault of his own.

Merit.

I. Merit. The applicant must make out a *prima facie* case of validity.(*o*) For this purpose, a decision of the High Court of Justice, or the Court of the County Palatine of Lancaster, in favour of the validity of the patent, will be sufficient.(*p*)

The Judicial Committee will not recommend the extension of a patent, which, on the face of it, appears to be invalid;(q) but they will not discuss or decide the question of validity, if it appear decidedly doubtful on the ground of lack of novelty, or utility, or from any other cause.(*r*) In cases of doubt as

(*m*) Per Lord Romilly, Norton's Patent, 1 Moo. P. C. N. S. 339; 9 Jur. N. S. 419; see also Whitehouse's Patent, 2 Moo. P. C. 496; 1 W. P. C. 473; Erard's Patent, 1 W. P. C. 557; Downton's Patent, 1 W. P. C. 565; Derosne's Patent, 2 W. P. C. 1; 4 Moo. P. C. 417; Carp. P. C. 699; Woodcroft's Patent, 2 W. P. C. 18; 10 Jur. 363.

(*n*) McInnes' Patent, L. R. 2 P. C. 54; 37 L. J. P. C. 23; 5 Moo. P. C. N. S. 72.

(*o*) Erard's Patent, 1 W. P. C. 557; Kay's Patent, 1 W. P. C. 568; 3 Moo. P. C. 24.

(*p*) See Bett's Patent, 7 L. T. N. S. 577; 9 Jur. N. S. 137; 1 Moo. P. C. N. S. 49.

(*q*) Kay's Patent, 1 W. P. C. 568; 3 Moo. P. C. 24; Erard's Patent, 1 W. P. C. 557; McDougal's Patent, L. R. 2 P. C. 1; 37 L. J. P. C. 17; 5 Moo. P. C. N. S. 1.

(*r*) Hill's Patent, 9 Jur. N. S. 1209; 9 L. T. N. S. 101; 1 Moo. P. C. N. S. 258; 18 Newton, L. J. N. S. 109; Cocking's Patent, 2 P. O. R. 151; Stewart's Patent, 3 P. O. R. 7; Saxby's Patent, L. R. 3 P. C. 292; 7 Moo. P. C. N. S. 82.

to the validity of the patent, the Judicial Committee exercises its discretion.(s)

If a new grant is allowed, it is of course open to the same objections, and may be annulled in the same manner as the old one ;(t) and the Judicial Committee are not called on to discuss the question as to whether an extension, if granted, would avail the petitioner anything: that is left to the courts of law.(u)

There is an obvious distinction between the "merit of ingenuity and the merit of utility" of an invention ;(v) and unless the Judicial Committee are satisfied that the invention possesses the latter, they will not recommend an extension ;(y) but the fact of great labour and ingenuity being required to produce the invention will go far to establish a case of utility strong enough to satisfy the Committee that the public is likely to derive a benefit from the invention sufficient to warrant an extension.(z)

In order to succeed, the petitioner must show that there is in the invention merit beyond that ordinary merit which would be sufficient to sustain a patent in the first instance—that is to say, there must be something beyond that merit which would, in an action for infringement, support a patent in the face of a plea of want of utility.(a)

Further, because an invention is new, in the sense that a patent for it could be supported on the ground of novelty, it does not necessarily follow that it is sufficiently novel, having regard to prior inventions of a like character, to satisfy the Judicial Committee that the benefit conferred by it on the public is sufficient to warrant an extension.(b)

(s) Per Sir William Erle, *McInnes' Patent*, L. R. 2 P. C. 54; 37 L. J. N. S. P. C. 23; 5 Moo. P. C. N. S. 72; *Woodcroft's Patent*, 2 W. P. C. 18; 10 Jur. 363; 28 Newton, L. J. C. S. 196; *Pinker's Patent*, 12 Jur. N. S. 433; *Soames' Patent*, 1 W. P. C. 729; 23 Newton, L. J. C. S. 462.

(t) *Galloway's Patent*, 1 W. P. C. 724; 7 Jur. 453.

(u) Per Lord Brougham, *Woodcroft's Patent* 2 W. P. C. 18; 10 Jur. 363; 28 Newton, L. J. C. S. 196.

(v) *Bett's Patent*, 7 L. T. N. S. 577; 9 Jur. N. S. 137; 1 Moo. P. C. N. S. 49; *Pinker's Patent*, 12 Jur. N. S. 433.

(y) *Simister's Patent*, 1 W. P. C. 721; 7 Jur. 451; 4 Moo. P. C. 164; 21 Newton, L. J. C. S. 465; *Longmaid's Patent*, 1 Eng. 347; *Derosne's Patent*, 2 W. P. C. 1; *Carp. P. C.* 699; 4 Moo. P. C. 417; 24 Newton, L. J. C. S. 459.

(z) *Hill's Patent*, 9 L. T. N. S. 101; 9 Jur. N. S. 1209; 1 Moo. P. C. N. S. 258; 18 Newton, L. J. N. S. 109.

(a) See remarks of Grove, J., *Stoney's Patent*, 5 P. O. R. 520; see also *Saxby's Patent*, 3 P. O. R. 294; *Bett's Patent*, 1 Moo. P. C. N. S. 49; 9 Jur. N. S. 137; 7 L. T. N. S. 577.

(b) *Stuart's Patent*, 3 P. O. R. 7; *Sillar's Patent*, G. P. C. 581; *M'Dougal's*

The invention must be shown to be independently meritorious—*e.g.*, it will not do to show that it could only be useful in conjunction with some later discovery.^(c) It is, however, not an objection to the grant of a prolongation or extension that the invention is an improvement on, and is intended to be used with, some previously patented invention,^(d) or that the original invention would not be used without it,^(e) provided that there is utility in the improvement.^(f)

The extent to which the invention has been used by the public is an important consideration. If there has been an extensive use by the public, of course this fact is unfavourable to the contention of an applicant for prolongation or extension, for though it shows that the invention is useful, it also shows that the patentee has had an opportunity of making profit out of it.^(g) On the other hand, if the invention has not been extensively used by the public, the presumption is against its utility, and therefore unfavourable to the applicant.^(h) In the words of Lord Romilly, the Judicial Committee “find much more difficulty in dealing with the case of a patent where it has not been used for fourteen years, than in dealing with one where a user has taken place, because assuming that there is no utility in the invention, there is nobody whose interest it is to oppose it; but where it has been used for a considerable number of years, there are persons who always desire to get rid of the invention [patent], and from them their lordships hear all the arguments which can properly be brought against the validity of the patent.”⁽ⁱ⁾

The presumption of non-utility arising from a limited use of the invention by the public is not in every case fatal, for it

Patent, L. R. 2 P. C. 1; 37 L. J. N. S. P. C. 17; 5 Moo. P. C. N. S. 1; McInnes' Patent, L. R. 2 P. C. 54; 37 L. J. N. S. P. C. 23; 5 Moo. P. C. N. S. 72.

^(c) Bett's Patent, 1 Eng. 335

^(d) Bovill's Patent, 1 Moo. P. C. N. S. 348; Soames' Patent, 1 W. P. C. 729.

^(e) Woodcroft's Patent, 1 W. P. C. 740; 3 Moo. P. C. 171; Galloway's Patent, 1 W. P. C. 727

^(f) Bell's Patent, 2 W. P. C. 160; 10 Jur. 363.

^(g) Downton's Patent, 1 W. P. C. 565.

^(h) Allan's Patent, L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 443; Herbert's Patent, L. R. 1 P. C. 399; 4 Moo. P. C. 300; Simister's Patent, 1 W. P. C. 721; 7 Jur. 451; 4 Moo. P. C. 164.

⁽ⁱ⁾ Allan's Patent, L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 433.

is often capable of being rebutted,^(k) but strong evidence is required to do this.^(l)

The following facts have been held to be sufficient evidence to rebut the presumption of non-utility arising from a limited user by the public: there was a special trade opposition;^(m) the invention was of a special nature;⁽ⁿ⁾ the market and demand was necessarily limited;^(o) experimental difficulties;^(p) legal proceedings;^(q) and the scarcity of labour.^(r)

The applicant must show that, if a prolongation or extension be allowed, there is every likelihood of the invention being used by the public—*i.e.*, that the conditions owing to which the public use has hitherto been limited (if such be the case) have ceased to exist; otherwise the intention of the Crown that the patentee should be rewarded by the profits arising from the invention, during the further period of the monopoly could not take effect, and the Judicial Committee would not recommend the Crown to accede to the petitioner's request.^(s)

If an invention consist of several parts, and it appear that some part or parts is or are not meritorious, but that there is merit in the remaining part or parts, an extension will probably be recommended in respect of the meritorious part or parts alone.^(t)

II. Insufficient remuneration owing to no fault of the patentee. Insufficient remuneration.

In deciding whether the patentee has been sufficiently rewarded, the Judicial Committee take into consideration the

^(k) Norton's Patent, 1 Moo. P. C. N. S. 339; 9 Jur. N. S. 419; Bakewell's Patent, 15 Moo. P. C. 385; Wright's Patent, 1 W. P. C. 575; Jones' Patent, 1 W. P. C. 577; Allan's Patent, L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 433; Cocking's Patent, 2 P. O. R. 151; Berrington's Patent, cited L. R. 1 P. C. 509; 4 Moo. P. C. N. S. 445; Coryton, 225; Simister's Patent, 1 W. P. C. 721; 7 Jur. 451; Southworth's Patent, 1 W. P. C. 486; Herbert's Patent, L. R. 1 P. C. 399; 4 Moo. P. C. N. S. 300.

^(l) Allan's Patent, L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 433.

^(m) Simister's Patent, 1 W. P. C. 721; 7 Jur. 451; 4 Moo. P. C. 161.

⁽ⁿ⁾ Southworth's Patent, 1 W. P. C. 486; Jones's Patent, 1 W. P. C. 577.

^(o) Herbert's Patent, L. R. 1 P. C. 399; 4 Moo. P. C. N. S. 300.

^(p) *Ibid.*

^(q) Wright's Patent, 1 W. P. C. 575.

^(r) Napier's Patent, 13 Moo. P. C. 543.

^(s) Wooldroft's Patent, 2 W. P. C. 18; 10 Jur. 363; Bates' Patent, 1 W. P. C. 739; Foarde's Patent, 9 Moo. P. C. 376.

^(t) Bodmer's Patent, 8 Moo. P. C. 282; Lee's Patent, 10 Moo. P. C. 226; Napier's Patent, L. R. 6 App. Cas. 174; 50 L. J. P. C. 40; Church's Patent, 3 P. O. R. 95.

benefit which has resulted and is likely to result to the public, as compared with that which has accrued to the patentee.(u)

The petitioner must satisfy the Judicial Committee that he has, having regard to the particular circumstances of each case, used his best endeavours to make the invention a pecuniary success, and that no circumstances under his control have led to his insufficient remuneration,(v) but that he has at all times been willing to give the public the benefit of the invention.(y)

Thus, in the case of Roper's patent,(z) the patentee of a captain's bridge constructed as a 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 from business in consequence of a railway accident. The invention had been awarded prizes at exhibitions, but had never been brought into actual use. Under the circumstances, the Judicial Committee considered that, having regard to the meritorious nature of the invention, the difficulty of bringing it into actual use, the patentee's illness, and the fact that no opposition was offered on behalf of the Crown, the case was an exceptional one, and an extension for seven years should be granted.

If infringements of the patent have been openly committed, it will be necessary for the petitioner to show that proceedings have been taken to protect the patent, as evidence of negligence on his part to do so will induce the Judicial Committee to refuse to recommend a prolongation or extension;(a) whereas if the expense of litigation necessary to maintain the patent has prevented the petitioner from deriving adequate

(u) Newton's Patent, 14 Moo. P. C. 156; Derosne's Patent, 2 W. P. C. 4; Mallet's Patent, L. R. 1 P. C. 308; Nussey and Leachman's Patent, 7 P. O. R. 22.

(x) Southworth's Patent, 1 W. P. C. 486; Kollman's Patent, 1 W. P. C. 564; Lowe's Patent, 2 W. P. C. 158; 10 Jur. 363; Norton's Patent, 1 Moo. P. C. N. S. 339; 9 Jur. N. S. 419;

Patterson's Patent, 6 Moo. P. C. 469; 13 Jur. 593; Wiold's Patent, L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300; Cardwell's Patent, 10 Moo. P. C. 488; Bakewell's Patent, 15 Moo. P. C. 385; Stewart's Patent, 3 P. O. R. 7.

(y) Stewart's Patent, 3 P. O. R. 10.

(z) 4 P. O. R. 201.

(a) Simister's Patent, 1 W. P. C. 724; 4 Moo. P. C. 164; 7 Jur. 451.

profits from the invention, this circumstance will tell in his favour.(b)

The circumstance that the invention has not been brought into public use owing to disputes between the co-owners of a patent, will not induce the Judicial Committee to recommend a prolongation or extension.(c)

The petitioner must lodge at the Council Office, not less than Accounts. one week before the day for the hearing,(d) a statement of accounts as evidence of his contention that he has been insufficiently rewarded, having regard to the value of the invention to the public. The Judicial Committee insist that the statement shall be a full, clear, and accurate (e) balance sheet, showing the whole *profit and loss* which has been derived or sustained in respect of the invention.(f) It is the petitioner's duty to satisfy the Committee, in a manner which admits of no controversy, as to the amount of remuneration which in every point of view the invention has brought to those who have introduced, or helped to introduce, it to the public, in order that their Lordships may be able to come to a conclusion whether that remuneration may fairly be considered a sufficient reward or not.(g) To use the language of Lord Cairns, "It is not for the Committee to send back the accounts for further particulars, nor to direct the accounts for the purpose of surmising what may 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."(h)

If this requirement is not attended to carefully, the Committee will most probably refuse to grant the petitioner leave to amend the accounts,(i) and will dismiss the petition alto-

(b) Petit Smith's Patent, 7 Moo. P. C. 133; Heath's Patent, 2 W. P. C. 247; 8 Moo. P. C. 217.

(c) Patterson's Patent, 6 Moo. P. C. 469; 13 Jur. 593.

(d) Judicial Committee Rules r. ix: see Appendix.

(e) Clark's Patent, L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 255; Hill's Patent, 1 Moo. P. C. N. S. 258; 9 Jur. N. S. 1209; 9 L. T. N. S. 101.

(f) Judicial Committee Rules, r. ix.: see Appendix.

(g) Saxby's Patent, L. R. 3 P. C. 292; 7 Moo. P. C. N. S. 82; Clark's Patent, L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 255; Weild's Patent, L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300.

(h) Saxby's Patent, L. R. 3 P. C. 292; 7 Moo. P. C. 82.

(i) Newton's Patent, (4) L. R.; 9 App. Cas. 592; 1 P. O. R. 177; 52 L. T. 329; Yates and Kellett's Patents, 4 P. O. R. 150.

gether; (*k*) and the petitioner will not be excused on the ground that he has kept no such accounts, or has destroyed his books. (*l*).

It is most material for the Judicial Committee to know in what ratio the profits have increased or diminished from year to year, therefore it is advisable for the petitioner to strike a balance at the end of each year's accounts. (*m*)

Profits made
by patentee as
such.

It is to be noticed that the Act of 1883 directs that the Judicial Committee, in considering their decision on the question of adequacy of remuneration, "shall have regard to the profits made by the patentee as such." (*n*) These words specify one particular class of profits as absolutely necessary; but there is nothing in the section of the Act to suggest that the Committee shall not consider the profits in relation to the patent arising from other sources, consequently the accounts must disclose all profits arising from the working of foreign patents, as was the practice before the Act of 1883. (*o*) The profits, if any, arising from the sale of articles made under the patent expressly for exportation abroad must also be disclosed. (*p*)

Committee re-
gard all the
circumstances
of the case.

The Committee are required to have regard to all the circumstances of the case. (*q*)

The question always is, What has been the total remuneration derived from the patent, or which could have been derived from the patent? Consequently, when the patent has become vested in an assignee, *e.g.*, a company, the committee require a disclosure, not only of the assignee's profits, but also of all the profits derived by his predecessors in title, (*r*) and also, when licences have been granted, a disclosure of not only the royalties received by the patentee, but also, where possible, some evidence as to the profits made by the licensees. (*s*)

(*k*) Adair's Patent, L. R. 6 App. Cas. 176; 50 L. J. P. C. 68; Saxby's Patent, L. R. 3 P. C. 292; 7 Moo. P. C. N. S. 82; Bett's Patent 1 Moo. P. C. N. S. 49; 9 Jur. N. S. 137; 7 L. T. N. S. 577.

(*l*) Yates and Kellett's Patent, L. R. 12 App. Cas. 149.

(*m*) Perkin's Patent, 2W. P. C. 16, 17.

(*n*) S. 25 (4).

(*o*) Newton's Patent, L. R. 9 App.

Cas. 592; Johnson's Patent, L. R. 4 P. C. 82; Adair's Patent, L. R. 6 App. Cas. 178.

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

(*q*) 46 & 47 Vict. c. 57, s. 25, ss. 4.

(*r*) Deacon's Patent, 4 P. O. R. 119.

(*s*) Trotman's Patent, L. R. 1 P. C.

123; 3 Moo. P. C. N. S. 488; Saxby's Patent, L. R. 3 P. C. 298; 7 Moo. P. C. N. S. 82; Hill's Patent, 1 Moo. P. C. N. S. 258, 268; 9 L. T. N. S. 101.

The petitioner is entitled to place on the credit side of the account various items and expenses, but if he desires to contend that such sums are not to be considered as profits, such claim must appear on the petition or in the accounts, otherwise he will not be allowed to offer any evidence in respect of it. (t) It is better to render a separate account of items in respect of which a deduction is claimed.

Allowances
credited to po-
titioner.

The petitioner is entitled to credit himself with the expenses incurred in making preliminary experiments, in obtaining the grant of the patent, and in legal proceedings necessary to defend it; (u) also necessary costs of exhibiting and advertising the invention; (x) and reasonable salaries and travelling expenses for clerks; (y) and commissions on sales or royalties. (z)

A deduction has been allowed in the case of a foreign patentee, resident abroad, who has obtained an English patent and has employed an agent in England to introduce the invention here. (a)

When the petitioner has compromised actions at law in relation to the patent, and foregone any claim to costs, it is improper for him to deduct the expenses of such proceedings in an unexplained lump sum. (b)

Deductions have been refused in respect of an item for the purchase of land for the purpose of working *in situ* a manufacture according to a patented process, (c) and also in respect of payments for the surrender of licences. (d) When a patentee, under the impression that the invention was one of small value, sold it for a trifling sum, and, after it had proved of considerable value, repurchased it at an increased price, he

(t) Bailey's Patent, 1 P. O. R. 1.
(u) Kay's Patent, 1 W. P. C. 572;
3 Moo. P. C. 24; Heath's Patent, 2 W.
P. C. 247; 8 Moo. P. C. 217; Hill's
Patent, 1 Moo. P. C. N. S. 258; 9 Jur.
N. S. 1209; 9 L. T. N. S. 101; Adair's
Patent, L. R. 6 App. Cas. 176; 50 L. J.
P. C. 68.
(x) Duncan and Wilson's Patent, 1
P. O. R. 257.
(y) Duncan and Wilson's Patent, 1
P. O. R. 257.
(z) *Ibid.* Poole's Patent, L. R. 1

P. C. 514; 4 Moo. P. C. N. S. 452;
36 L. J. P. C. 76.
(a) Poole's Patent, L. R. 1 P. C. 514;
4 Moo. P. C. N. S. 452; 36 L. J. P. C.
76.
(b) Hill's Patent, 1 Moo. P. C. N. S.
258, 268; 9 Jur. N. S. 1209; 9 L. T. N. S.
101.
(c) Fryer's Patent, 47 Eng. 49.
(d) Hill's Patent, 1 Moo. P. C. N. S.
258; 9 Jur. N. S. 1209; 9 L. T. N. S.
101.

was not allowed to charge the item in the accounts as one of loss. *(e)*.

Patente manu-
facturer.

When the patentee is also the manufacturer of the patented article, the profits which he makes as manufacturer, although they may not be in strict point of view profits of the patent, must undoubtedly be taken into consideration. *(f)* It is obvious that in different manufactures there will be different degrees of connection between the business of the applicant as manufacturer, and his business, or his position, as the owner of a patent. There are patents which have little or no connection with the business of the manufacturer, and there are others of a different kind, where there is such an intimate connection with the business of the manufacturer that the possession of the patent virtually secures to the patentee his power of commanding orders as a manufacturer. *(g)*

When it is not possible to sever the heads of a patentee's profits, as a manufacturer, and as a patentee, but it is apparent that a substantial sum has been realized, the Committee will not recommend a prolongation or extension. *(h)*

There is no specific rule as to the proper ratio to fix as the proportion of the total profits to be allowed as manufacturer's profits when the patentee is also the manufacturer, *(i)* but the proportion must be divided according to the circumstances of each case. *(k)*

Where it appeared that a considerable sum had been received from sales of the patented article, the Committee refused to look on the difference between the actual cost of the articles and the price at which they were sold as mere profits made by the patentee as salesman, but concluded that a considerable pro-

(e) Wickl's Patent, L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300.

(f) Bett's Patent, 1 Moo. P. C. N. S. 49; 9 Jur. N. S. 137; 7 L. T. N. S. 577; McInnes' Patent, L. R. 2 P. C. 54, 57; 5 Moo. P. C. N. S. 72; 37 L. J. P. C. 23; Hill's Patent, 1 Moo. P. C. N. S. 258; 9 Jur. N. S. 1209; 9 L. T. N. S. 101; Johnson's Patent, L. R. 4 P. C. 75; 8 Moo. P. C. 282; Saxby's Patent, L. R. 3 P. C. 292, 295; 7 Moo. P. C. N. S. 82.

(g) See Saxby's Patent L. R. 3 P. C. 295

(h) Muntz's Patent, 2 W. P. C. 113; Newton's Patent, 51 Eng. 208; 17 Iron, 155, 171.

(i) Duncan and Wilson's Patent, 1 P. O. R. 257, 260.

(k) See Trotman's Patent, L. R. 1 P. C. 118; 3 Moo. P. C. N. S. 488. Two-thirds has been held to be too large a proportion in Hill's Patent, 1 Moo. P. C. N. S. 258; 9 Jur. N. S. 1209; 9 L. T. N. S. 101; and also in Duncan and Wilson's Patent, 1 P. O. R. 257.

portion of this was profit which the patentee had received, because, having the patent, he was able to sell the articles, and refused to recommend an extension accordingly.(*l*)

Where the patentee is himself a manufacturer it is better for him to keep the accounts of his manufacturing business separate from those relating exclusively to the patent, so as to present them in this form to the Judicial Committee.

Where a patentee is a manufacturer and himself superintends the conduct of the business of making the patented article, he is often entitled to a reduction in respect of his personal services, but the amount varies with the special circumstances of each case.(*m*)

The effect of rendering incomplete accounts, or accounts in an improper form, is not always fatal, but the petitioner must not rely on the indulgence of the Committee, and he cannot be too particular in the matter of accounts. Under special circumstances, when it appears that the accounts are wrong through a *bonâ fide* mistake on the part of the patentee, the Judicial Committee may grant an adjournment in order that the accounts may be put right,(*n*) but in most cases of insufficient or improper accounts the petition will be dismissed at once.(*o*)

Opposers are not entitled to production and inspection of the petitioner's accounts till the hearing,(*p*) but they are allowed copies of them, at their own expense, when they are filed.(*q*)

It is to be observed that any person may enter a *caveat* or warning to the Sovereign not to accede to the prayer of the petition. Interest in the patent is not essential, as in the case of opposition to the grant,(*r*) the amendment of a specifi-

(*l*) Bailey's Patent, 1 P. O. R. 1.

(*m*) As much as £600 per annum has been allowed in the case of the chairman of a company formed to work the patent: Child's Patent, 56 Eng. 435; but as a rule £400 per annum, or less, is considered sufficient; Bailey's Patent, 1 P. O. R. 1; Carr's Patent, L. R. 4 P. C. 530; 9 Moo. P. C. N. S. 379; Perkins' Patent, (2) 47 Eng. 105; Cocking's Patent, 2 P. O. R. 151; Furness' Patent, 2 P. O. R. 175.

(*n*) Perkins' Patent, 2 W. P. C. 17; Heath's Patent, 2 W. P. C. 256;

8 Moo. P. C. 217; Henry's Patent, 38 Eng. 343, 352; Chatwood's Patent, 37 Eng. 285; Johnson and Atkinson's Patent, L. R. 5 P. C. 87.

(*o*) Clark's Patent, (2) L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 255; Newton's Patent, (4) L. R. 9 App. Cas. 592; 1 P. O. R. 177; Adair's Patent, L. R. 6 App. Cas. 178; 50 L. J. P. C. 68.

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

(*q*) Judicial Committee Rules, r. vii.

(*r*) p. 273 *ante*.

Effect of rendering incomplete accounts.

Discovery.

Opposition.

cation,(s) or the revocation of a patent.(t) A person who has entered a *caveat* is entitled to receive four weeks' notice from the petitioner of the day fixed for the hearing,(u) and to be served with a copy of the petition.(x) He is also entitled to notice of any special application by the petitioner (y) and, at his own expense, copies of all papers lodged in reference to the petition.(z)

An opponent must, within a fortnight of being served with the petition, lodge at the Council Office a notice of the grounds of his objections to the granting of the prayer of the petitioner,(a) which will be sufficient if it state the ground of the objections, though particulars are not given.(b)

New grant.

It is the practice for the Crown in cases where the Judicial Committee recommend a prolongation or extension of the term of a patent to give effect to the report of the Committee by a grant of new letters patent.(c)

It is not necessary for the patentee to file a fresh specification on the grant of a new patent;(d) and the validity of the new patent may be questioned in the same way and on the same grounds as that of the old one:(e) the new grant is in the nature of a graft on the old one, and has no existence apart from it.(f)

Conditions

A new grant of letters patent is subject in all cases to the conditions imposed by the Act of 1883 and subsequent statutes,(g) and may be granted to more than one person jointly,(h) but, it is submitted, a new grant cannot be made to a person or persons who has, or have not, or one of whom has not a legal interest in the old letters patent.(i) The Crown in granting new letters patent has the power to, and frequently does, impose conditions in the interest of the original

(s) p. 239 *ante*.
 (t) p. 343 *ante*.
 (u) Judicial Committee Rules, r. ii. :
 see Appendix.
 (x) *Ibid*.
 (y) Hutchison's Patent, 14 Moo. P. C.
 364.
 (z) Judicial Committee Rules, r. vii.
 (a) Judicial Committee Rules, r. vi.
 (b) Ball's Patent, L. R. 4 App. Cas.
 171; 48 L. J. P. C. 24.
 (c) Stoney's Patent, 5 P. O. R. 524;
 Cocking's Patent, 2 P. O. R. 151.

(d) Wasteney Smith's Patent, 2 P.O.R.
 14.
 (e) See Russell v. Ledlam, 14 M. & W.
 583; H. L. C. 687; Bovill v. Finch,
 L. R. 5 C. P. 523.
 (f) Bovill v. Finch, L. R. 5 P. C. 523;
 39 L. J. C. P. 277.
 (g) Wasteney and Smith's Patent, 2
 P. O. R. 14.
 (h) 46 & 47 Vict. c. 57, s. 4, ss. 2.
 (i) Southworth's Patent, 1 W. P. C.
 488.

patentee(*k*) or his representatives(*l*). The following are instances of cases in which such conditions have been imposed. In *Whitehouse's Patent*(*m*) extension was granted to an assignee on condition that he secured to the patentee and inventor, during the term, an annuity of £500, in addition to £300 already secured to him. In *Markwick's Patent*(*n*) where the original patentee had been bankrupt, the condition was imposed that he should receive an annuity during the extended period. In *Morton's Patent*(*o*) the assignee was required to secure to the original patentee one-half the future profits after recouping his own losses. In *Herbert's Patent*(*p*) an extension was granted to assignees on condition that they secured upon trust to the widow and representatives of the inventor one-half of the profits.

Sometimes conditions are imposed on the patentee for the benefit of other persons who have an interest in the patent(*q*) or who might be liable in respect of infringements committed between the date of the order and the sealing of the new patent(*r*) or to the effect that a patentee mortgagor should give to his mortgagee a like security over the new patent as he had over the old(*s*).

When the justice of the case requires, conditions will be imposed in favour of the Crown or the public(*t*).

(*k*) *Whitehouse's Patent*, 1 W. P. C. 473; reported as *Russell's Patent*, 2 Moo. P. C. 496.

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

(*m*) 1 W. P. C. 473; reported as *Russell's Patent*, 2 Moo. P. C. 496.

(*n*) 13 Moo. P. C. 310.

(*o*) 51 Eng. 274; 17 Iron. 250.

(*p*) L. R. 1 P. C. 399; 4 Moo. P. C. N. S. 300.

(*q*) *Normandy's Patent*, 9 Moo. P. C. 452; *Baxter's Patent*, 13 Jur. 593.

(*r*) *Schlumberger's Patent*, 9 Moo. P. C. 1.

(*s*) *Church's Patent*, 3 P. O. R. 95.

(*t*) In *Pettit Smith's Patent* (7 Moo. P. C. 133) the condition was imposed that the Crown should be allowed to use the invention without licence. See also *Lancaster's Patent*, 2 Moo. P. C. N. S. 189; *Carpenter's Patent*, 2 Moo. P. C. N. S. 191 n.; *Dixon v. London Small Arms Co.*, L. R. 1 App. Cas. 632. These cases were all prior to the Act of 1883. Such conditions are not now insisted upon in favour of the Crown, as they are provided for by s. 27 of the Act of 1883, which applies to all new grants of letters patent.

In *Mallet's Patent* (L. R. 1 P. C. 308) the condition was imposed that the patentee should grant licences upon terms similar to one already granted by him. In *Hardy's Patent* (6 Moo. P. C. 441) it was made a condition of the new grant that the patentee should sell the patented article (iron axletrees) at a moderate fixed sum. Such conditions are, however, not imposed now, reliance being placed on s. 22 of the Act of 1883.

In *Bodner's Patent* (8 Moo. P. C. 282) the condition was imposed that certain portions of the specification which related to parts of the invention not worked out should be disclaimed.

It is the practice when extension is granted in respect of two cognate patents to fix the expiry of each on the same day.^(v)

Security.

The Crown can only grant a prolongation or extension of letters patent on the report of the Judicial Committee of the Privy Council. It is the invariable practice for the Crown to act on such report, but it must be remembered that the Crown is not bound so to act.^(x) The Judicial Committee before recommending a prolongation or extension requires security to be given that the conditions (if any) on which the new grant is recommended will be performed.^(y)

Date.

The new grant may be made after the expiration of the original term, if all the statutory conditions have been complied with, but it is always dated as on the day on which the original term expires.

The Crown has no authority to grant more than one period of prolongation or extension of letters patent.^(z)

Term.

It is not usual for the Judicial Committee to recommend a longer prolongation or extension than seven years;^(a) but in cases where it can be shown that the invention possesses such rare and exceptional merit that the patentee would not be likely to obtain an adequate reward in seven years, a longer period will be recommended,^(b) which may in extreme cases be fourteen years, the longest period for which the Crown has power to grant a prolongation or extension.^(c) The Judicial Committee, in recommending a prolongation or extension, always consider the merit of the invention from the point of view of the public as well as the remuneration which the patentee has received, and adjusts the period accordingly.^(d)

Costs.

The costs of all parties of, and incident to, proceedings before the Judicial Committee are in its discretion.^(e)

^(v) Johnson's and Atkinson's Patent, L. R. 5 P. C. 87; Church's Patents, 3 P. O. R. 95.

^(x) See *Ledsam v. Russell*, 1 H. L. Cas. 687.

^(y) Whitehouse's Patent, 1 W. P. C. 473; Carp. P. C. 565; 2 Moo. P. C. 496.

^(z) Goucher's Patent, 2 Moo. P. C. N. S. 532.

^(a) Furness' Patent, 2 P. O. R. 175.

^(b) Moncrieff's Patent, 22 Iron. 35; Mitchell's Patent, 30 Newton, L. J. C. S. 356.

^(c) Mitchell's Patent, 30 Newton, L. J. C. S. 356; 46 & 47 Vict. c. 57, s. 25, ss. 5.

^(d) Newton's Patent, 14 Moo. P. C. 156; Bailey's Patent, 1 P. O. R. 1; Derosne's Patent, 2 W. P. C. 1; Carp. P. C. 699; 4 Moo. P. C. 417.

^(e) 46 & 47 Vict. c. 57, s. 25, ss. 7.

It is the practice of the Committee to award costs, on the principle that *bona fide* oppositions are rather to be encouraged than discouraged, that the Crown may be put in possession of all that can be alleged against the continuance of the patent.(f)

Costs of opponents will be refused, however, if the Committee are satisfied that there was no sufficient ground of opposition, and such opponents may be ordered to pay the extra costs occasioned thereby;(g) and the opponent's costs will be refused, if the Committee are of opinion that the opposition has been improperly conducted.(h)

In cases when the petition is abandoned, and there is opposition, the petitioner pays the opponent's costs.(i) It is not necessary for the opponent to serve the petitioner with notice of an intended application for costs.(j)

Sometimes one set of costs is given to each opponent,(l) and sometimes one set is given between all the opponents.(m)

In cases where there are more than one opponent it is not uncommon for the Committee to award a lump sum to be divided among the opponents, either with,(n) or without,(o) the option of taxation in the usual way by the Registrar of the Committee.(p)

The Attorney-General, who represents the Crown on the hearing of petitions, does not ask for, nor is he ordered to pay, any costs.

If the petitioner succeed, he must forthwith leave at the Registration. Patent Office a copy of the order for prolongation or extension when obtained, that it may be entered on the register of patents.(q)

(f) *Wield's Patent*, L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300; *Westrupp and Gibbin's Patent*, 1 W. P. C. 556; *Honiball's Patent*, 9 Moo. P. C. 378; 2 W. P. C. 201; 25 L. T. 1.

(g) *Downton's Patent*, 1 W. P. C. 567.

(h) *Honiball's Patent*, 9 Moo. P. C. 394; 2 W. P. C. 201; 25 L. T. 1.

(i) *Bridson's Patent*, 7 Moo. P. C. 499; *Hornby's Patent*, 7 Moo. P. C. 503; *Milner's Patent*, 9 Moo. P. C. 39; *Macintosh's Patent*, 1 W. P. C. 739; *Morgan Brown's Patent*, 3 P. O. R. 212.

(k) *Bridson's Patent*, 7 Moo. P. C. 449.

(l) *Newton's Patent (2)*, L. R. 6 App. Cas. 174; 50 L. T. P. C. 40.

(m) *Newton's Patent (4)*, L. R. 9 App. Cas. 592; 52 L. T. 329; 1 P. O. R. 177.

(n) *Milner's Patent*, 9 Moo. P. C. 39; *Hill's Patent*, 1 Moo. P. C. N. S. 259; *Wield's Patent*, L. R. 4 P. C. 89.

(o) *Schlumberger's Patent*, 9 Moo. P. C. 1; *Johnson's Patent*, L. R. 4, P. C. 75; 8 Moo. P. C. N. S. 282; *Jones' Patent*, 9 Moo. P. C. 41.

(p) *Judicial Committee Rules*, r. viii.

(q) P. R. 190, r. 874.

CHAPTER XII.

ACTION TO RESTRAIN THREATS OF LEGAL PROCEEDINGS.

SECTION 32 OF ACT 1883—THREATS WITHIN THE SECTION—THREATS NOT WITHIN THE SECTION—LAW PRIOR TO ACT OF 1883—HOW THREATS MAY BE MADE—DECLARATION OF INVALIDITY—INTERLOCUTORY INJUNCTION—ACTION FOR INFRINGEMENT WITHIN MEANING OF SECTION 32—DUE DILIGENCE—PERSONS HAVING LIMITED INTEREST—PARTICULARS—COSTS.

S. 32 of Act of 1883.

SECT. 32 of the Patents, Designs, and Trade Marks Act of 1883 enacts 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 section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent."

Only applies to threats made since Jan. 1, 1884.

The above section only applies to threats made since the Act came into operation—*i.e.*, threats made since the 1st January 1884.(a)

Recognition of principle.

The principle embodied in this enactment seems to have been recognised by Malins, V.C.; as early as 1871,(b) though

(a) *Sugg v. Bray*, 2 P. O. R. 223, 247.

(b) *Rollins v. Hinks*, L. R. 13 Eq. 355; *Axman v. Land*, L. R. 18 Eq. 330.

the conclusion at which the learned Judge arrived—viz., that at that date the Court would restrain a patentee from issuing circulars threatening legal proceedings against alleged infringers unless he would undertake to commence proceedings to assert the validity of the patent—appears to have been based on the erroneous assumption that there is no presumption at law in favour of the validity of a patent which has not been declared void.(c)

The Court always had power, by injunction, to restrain any person from making slanderous statements calculated to injure the business of another person, whether the statements complained of are oral or written.(d)

It is to be noticed that the foregoing section of the Act of 1883 does not apply to cases which are within the proviso— that is to say, to cases where the threatening party with due diligence commences and prosecutes an action for the infringement of his patent.

Cases within the proviso of s. 32 of the Act of 1883 are still governed by the law as it existed prior to the Act.

At the date of the commencement of the Act of 1883 the law as regards threats of legal proceedings in respect of alleged infringements, was that a patentee was not liable for issuing circulars or other threats warning persons against using articles which he alleged were infringements of his patent, provided that he issued such notices *bona fide*, and in the belief that the articles in question were really infringements.(e) Moreover, a patentee was not liable to be restrained by injunction from continuing to issue notices that the articles complained of were infringements, unless such statements were proved to be untrue, so that the further issue of them would not be *bona fide*.(f)

The patentee was entitled to issue notices containing statements that articles being sold by others were infringements of

(c) Judgment of Jessel, M.R., *Halsey v. Brotherhood*, L. R. 15 Ch. D. 520, 523.

(d) *Loog v. Bean*, L. R. 26 Ch. D. 306; *Thomas v. Williams*, L. R. 14 Ch. D. 864; *Beddow v. Beddow*, L. R. 9 Ch. D. 89; *Saxbrook v. Easterbrook*, L. R. 3 C. P. D. 339; *Thorley's Cattle Food Co. v. Massan*, L. R. 6 Ch. D. 582; *Riding v. Smith*, L. R. 1 Ex. D. 91.

(e) *Wren v. Wield*, L. R. 4 Q. B. 730; *Halsey v. Brotherhood*, L. R. 15 Ch. D. 514; L. R. 19 Ch. D. 386; *Sharp v. Brauer*, 3 P. O. R. 193.

(f) *Burnett v. Tate*, 45 L. T. N. S. 743; *Halsey v. Brotherhood*, L. R. 15 Ch. D. 514; 19 Ch. D. 390; *Sugg v. Bray*, 2 P. O. R. 224.

his rights; if such statements were made with reasonable and probable cause; (*h*) though an action would lie if the statements were not simply allegations of infringements, but went on to allege, as matters of fact, assertions which were not true. A question of infringement is one of law, and, in the words of Bramwell, L.J., (*i*) "A man is not bound to be correct in his statement of the law, but he is bound to be correct in his statement of facts."

Reasons for threats.

A patentee may make threats against persons making, using, selling, or purchasing articles which he considers to be infringements of his patent rights, as a means of protecting his own property; on the other hand, such threats may be circulated maliciously, and *mala fides*, with the intention of injuring the trade of the person against whom they are made.

Before the Act of 1883, it was held that if a statement as to infringement was made by the patentee in defence of his own property, although it injured and was untrue, it was a privileged statement; it was a statement that the defendant had a right to make; unless, besides its untruth, and besides its injury, express malice was proved—that is to say, want of *bona fides* and the presence of *mala fides*. (*k*) It was also held that there was no obligation on the part of a person, who had issued notices stating that the acts of another were an infringement of his patent rights, to follow up such statements with an action for infringement against the person mentioned, for he might desist, and render such action unnecessary, or he might not be worth suing at all. (*l*)

Effect of s. 32 of Act of 1883.

The Act of 1883 has completely altered the law with regard to cases within s. 32, in favour of the public, for it provides that if a person claiming to be a patentee, 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, and does not with due diligence commence and prosecute an action for

(*h*) Per Baggallay, L.J., *Halsey v. Brotherhood*, L. R. 19 Ch. D. 390.

(*i*) *Dicks v. Brooks*, L. R. 15 Ch. D. 22.

(*k*) Per Coleridge, L.C.J., *Halsey v.*

Brotherhood, L. R. 19 Ch. D. 388; *Sugg v. Bray*, 2 P. O. R. 243.

(*l*) *Halsey v. Brotherhood*, L. R. 15 Ch. D. 518.

the infringement of his patent, he is liable to be sued by the person or persons who are aggrieved by such threats, and an injunction restraining the continuance thereof may be obtained, and damages awarded against him, if it turns out that the alleged manufacture, use, sale, or purchase was not, in fact, an infringement of any of his legal rights.

If the case is within s. 32, and a person aggrieved brings an action against the patentee to restrain the issue of threats of legal proceedings, or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, the question of the *bona fides* of the patentee does not affect the case one way or the other.^(m) The only defence open to him, if he has not at the date of the action with due diligence commenced and prosecuted an action for infringement of his patent, is to show that the allegations contained in the threatening notices were, in fact, true.⁽ⁿ⁾

In such an action, the burden of proof that the patentee's statements are untrue lies, *prima facie*, on the plaintiff,^(o) as it did before the Act of 1883,^(p) though he may easily rebut it in a particular case, and throw on the defendant the burden of proving them to be true.^(q)

Threats within s. 32 may be made by circular, advertisement, or otherwise. It has been held that a threat contained in a solicitor's letter,^(r) in a private letter,^(s) and in a letter written without prejudice,^(t) are actionable. It is submitted that the Court has power under this section to restrain oral statements which contain threats of legal proceedings against, or liability on the part of, persons aggrieved by allegations made by the patentee to the effect that they have infringed his patent.^(u)

Burden of proof.

How threats may be made.

^(m) Kurtz v. Spence, 5 P. O. R. 161; Herrburger v. Squire, 5 P. O. R. 581.

⁽ⁿ⁾ Crampton v. Patents Investment Co., 5 P. O. R. 382; 6 P. O. R. 287; Automatic Weighing Machine Co. v. Combined Weighing and Measuring Machine Co., 6 P. O. R. 120.

^(o) Challender v. Royle, L. R. 36 Ch. D. 435; 4 P. O. R. 363; Barney v. United Telephone Co., Ltd., 2 P. O. R. 173.

^(p) Burnett v. Tate, 45 L. T. N. S. 743; Anderson v. Liebig's Extract of Meat Co., 45 L. T. N. S. 757, 759.

^(q) Challender v. Royle, L. R. 36 Ch. D. 435; 4 P. O. R. 363.

^(r) Duffield v. Waterloo, 3 P. O. R. 46; L. R. 31 Ch. D. 638; Crampton v. The Patents Investment Co., 5 P. O. R. 393; The Combined Weighing and Advertising Machine Co. v. The Automatic Weighing Machine Co., 6 P. O. R. 502.

^(s) Walker v. Clarke, 4 P. O. R. 113; Burt v. Morgan, 4 P. O. R. 278.

^(t) Kurtz v. Spence, 5 P. O. R. 173.

^(u) Kurtz v. Spence, 5 P. O. R. 161, 172, 173.

Threat not
withdrawn.

A threat which is not withdrawn is considered as continuing.(x)

Issues.

In an action brought under s. 32 of the Act of 1833, not only the issue of infringement may be raised, but also that of the validity of the patent to which the threats relate;(y) and it is therefore open to the plaintiff in such an action to prove, in either of two ways, that he has not infringed any legal right of the defendant. Either he may say, "The patent is valid, but I have not infringed it;" or he may say, "The patent is invalid, and, therefore, I have not infringed any legal right of the person making the threats."(z)

In order to act on the above-mentioned section, the Court must be satisfied, at the hearing of the action, that the articles in respect of which the threats were made are not "an infringement of any legal rights of the person making such threats." The question, therefore, whether the patent of the person making the threats is a valid patent must come into consideration, if the plaintiff in the action seeks to have it considered, because, if the patent is invalid, there is no infringement of a legal right of the patentee.(a)

Nature of
threats.

A threat, to be actionable under the Act of 1833, must be not merely a warning about something that is going to be done, but must be a threat about an act done. It must be a threat of legal proceedings in respect of an alleged manufacture, use, sale, or purchase of the invention, and not in respect of a proposed manufacture, use, sale, or purchase.(b)

General warn-
ing.

Everybody has a right to issue a general warning to infringers, and to advise the public that the patent to which the patentee is entitled, and under which he claims, is one which he intends to enforce.(c)

It does not follow that because a threat is so worded as grammatically to apply only to the future, it may

(x) *Driffield v. Waterloo*, L. R. 31 Ch. D. 638, 643.

(y) *Challender v. Royle*, L. R. 36 Ch. D. 425; 4 P. O. R. 363; *Kurtz v. Spence*, 4 P. O. R. 427; *Herrburger v. Squire*, 5 P. O. R. 589.

(z) Per Charles, J., *Herrburger v. Squire*, 5 P. O. R. 589.

(a) See judgment of Cotton, L.J., *Challender v. Royle*, L. R. 36 Ch. D. 435; 4 P. O. R. 363.

(b) *Challender v. Royle*, L. R. 36 Ch. D. 435, judgment of Bowen, L.J.

(c) *Ibid.*

not in any particular case be in substance and in fact applicable to what has been done.^(d) A threat which is actionable need not necessarily, it is submitted, apply only to what is past, but there must be something actually existing—something done—before the threat will be actionable; and it cannot be contended that threats with respect to future acts are altogether excluded from the meaning of s. 32 of the Act of 1883.^(e)

If the use *simpliciter* of a certain apparatus does not amount to an infringement of the patent, but the use of that apparatus in a particular manner does amount to such an infringement, the patentee cannot escape liability for issuing threats to the users of such apparatus, unless he makes it perfectly clear that what he complains of is not the use *simpliciter*, but the use in the particular manner specified.^(f) Kind of uses complained of.

In the event of a patentee obtaining an injunction and damages against a manufacturer, he is entitled to warn purchasers from the manufacturer not to pay the purchase-money to him, and that, if the manufacturer fails to pay the damages, he (the plaintiff) will claim from the purchasers.^(g)

Charles, J., in a case where an action was brought to restrain threats, and the validity of the patent was contested and decided in the plaintiff's favour, seemed to be of opinion that the Court in actions to restrain threats cannot give a declaration that the patent is void.^(h) Declaration of invalidity.

An injunction to restrain threats of legal proceedings or liability in respect of alleged infringement of a patent will not, as a rule, be given on an *ex parte* application. Thus, where the plaintiffs were the proprietors of a patent for improvements in cylinders and valves of steam-engines, and the defendants alleged that the engines made under the plaintiffs' patent were infringements of patents vested in the defendants, in respect of which they had commenced an action for infringe- *Ex parte* application.

^(d) *Challender v. Royle*, L. R. 36 Ch. D. 435, judgment of Bowen, L.J.

^(e) *Kurtz v. Spence*, 5 P. O. R. 171.

^(f) *Burt v. Morgan*, 4 P. O. R. 278.

^(g) *Cropper v. Smith*, L. R. 24 Ch. D. 305, 312.

^(h) *Herrburger v. Squire*, 5 P. O. R. 595.

ment against the plaintiffs, Bacon, V.C., refused to grant an *ex parte* injunction to restrain threats, but allowed notice of motion to be given in the ordinary way.⁽ⁱ⁾

Interlocutory
injunction.

In an action to restrain threats made under s. 32, the Court will not grant an interlocutory injunction unless it is satisfied that the plaintiff has made out a *prima facie* case to the effect, either that he has not infringed the defendant's patent, or that the patent is void; and, unless there is such a *prima facie* case, the Court does not take into consideration the balance of convenience to the parties.^(k)

Balance of con-
venience.

Cotton, L.J., commenting in the Court of Appeal on a decision ^(l) to the effect that the Court has power to grant an interlocutory injunction in a threat action, though it is not proved that the plaintiff has not infringed the defendant's patent, and also on the question whether an interlocutory injunction should be granted depends upon the balance of convenience to the parties, said: ^(m) "It is very true that in all cases of interlocutory injunction the Court does consider, and ought to consider, the balance of convenience and inconvenience in granting or refusing the injunction. But there is another very material question to be considered: Has the plaintiff made out a *prima facie* case? That is to say, if the evidence remains as it is, is it probable that at the hearing of the action he will get a decree in his favour? Therefore, although I quite agree that the Court ought not, on an interlocutory injunction, to attempt finally to decide the question whether the Act complained of is an infringement, or (if the question of the validity of the patent is raised) whether the patent is a valid one or not, yet in my opinion it ought to be satisfied that on one or both of those two points the plaintiff in the action has made out a *prima facie* case, and unless the Court is so satisfied it would be wrong to grant an injunction, merely on the ground that it cannot do the defendant any harm. Injunctions ought to be

⁽ⁱ⁾ *Wilson & Co. v. Walter E. Church Engineering Co., Ltd.*, 2 P. O. R. 175.

^(k) *Challender v. Royle*, L. R. 36 Ch. D. 425; 4 P. O. R. 363; *Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co., L.*

R. 25 Ch. D. 1; *Barney v. United Telephone Co.*, L. R. 28 Ch. D. 394.

^(l) *Walker v. Clarke*, 4 P. O. R. 111; *Challender v. Royle*, L. R. 36 Ch. D. 428; 4 P. O. R. 363.

^(m) *Challender v. Royle*, L. R. 36 Ch. D. 436; 4 P. O. R. 363.

granted only on a case made out entitling the plaintiff to that particular remedy."

In *Colley v. Hart*,⁽ⁿ⁾ the Court being satisfied, on a motion for an interlocutory injunction, that the plaintiff had made out a *prima facie* case of non-infringement, granted an injunction restraining the defendant from continuing to threaten any person with legal proceedings or liability in respect of the alleged manufacture, use, sale, or purchase of his invention.

On the other hand, where the Court was of opinion that the plaintiffs, by their affidavits, had failed to raise a probable case of non-infringement, and that there was a conflict of testimony on the question, an injunction was refused.^(o)

The Court, in deciding whether the defendant has made out a *prima facie* case of infringement, takes into consideration the fact whether or not he has commenced an action for infringement, and, if he has not done so, this fact is evidence against him.^(p)

Evidence of *prima facie* case.

Where in an action ^(r) to restrain the issue of a threatening circular it appeared that the plaintiffs were only exclusive licensees for a limited area of the patent referred to, and that the patentee had commenced an action for infringement against the plaintiff, in which the defendants were to be made co-plaintiffs, the Court ordered the motion for an injunction restraining the further issue of the circular to stand over till after the hearing of the infringement action.^(s)

Postponement of action.

We have seen that the proviso in s. 32 provides that the section shall not apply if the person making the threats complained of with due diligence commences and prosecutes an action for infringement of his patent. The question naturally arises, against whom must such an action be commenced and prosecuted, so as to bring the case within the proviso?

Action for infringement which brings the case within the proviso of s. 32 of the Act of 1883.

It is not always possible for the defendant in a threat action to bring an action for the infringement of his patent against the person aggrieved by the threats. For instance, the patentee

⁽ⁿ⁾ 6 P. O. R. 17.

^(o) *Barney v. United Telephone Co.*,
2 P. O. R. 173.

^(p) *Colley v. Hart*, 6 P. O. R. 17.

^(r) *Barnett v. Barrett's Screw Stopper Bottling Co., Ltd.*, 1 P. O. R. 9.

^(s) See also *Combined Weighing and Advertising Machine Co. v. Automatic Weighing Machine Co.*, 6 P. O. R. 502.

of a rival machine would necessarily be a person aggrieved if threats were made against him; but if such person does not manufacture and sell, but only licenses the manufacture and sale of such rival machine, there would be no means of bringing an action for infringement against him.

It would appear that what the words of the proviso point at, is a case where some act has been done which can be tested whether or not it is an infringement. The words "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," clearly point to an act done which has been alleged to be, but as a matter of fact is not, an infringement of the patent of the person issuing the threat, and the mere fact that, where the owner of a rival patent is the aggrieved person, it is in many cases impossible that an action for infringement should be brought against him, precludes the notion that the action mentioned in the proviso must be confined to an action against the aggrieved party.^(t) On the contrary, the proper view seems to be that the proviso will be satisfied, if an action for infringement of the patent be honestly brought and diligently prosecuted against any person to whom the threats complained of are applicable;^(u) but an action commenced against a third party in respect of infringements totally different to those alleged against the plaintiff to the threat action, is not an action for infringement within the meaning of s. 32.^(v)

If the action for infringement be brought, not against the party aggrieved, but against a third party, and, if that action be not prosecuted with due diligence, or, if it be collusive, then, no doubt, the person claiming an injunction to restrain threats would be entitled to contend that the case was within the section, and that such an infringement action did not bring it within the proviso.^(w)

Thus, in a case where the defendant had commenced an

^(t) *Challender v. Royle*, L. R. 36 Ch. D. 425, 439; 4 P. O. R. 363; *Day v. Foster*, 7 P. O. R. 54, 59.

^(u) *Ibid.*

^(v) *The Combined Weighing and*

Advertising Machine Co. v. The Automatic Weighing Machine Co., 6 P. O. R. 502.

^(w) See *Challender v. Royle*, L. R. 36 Ch. D. 425, 439; 4 P. O. R. 363.

action for infringement against the plaintiff, and undertook to prosecute it with due diligence, the Court refused an injunction to restrain the issue of a threatening circular, which, however, was granted subsequently, on the ground that the defendants were not, as a matter of fact, prosecuting their infringement action diligently.(y)

An action against licensees for royalties in respect of articles which the defendant alleges were manufactured under another patent and not under the licence is an action for infringement within the meaning of s. 32 of the Act of 1883.(z)

In considering the question whether an action for infringement has been commenced and prosecuted with due diligence, so as to bring the case within the proviso of s. 32, it must be noticed that the section is silent on the point whether it is necessary that the action for infringement must be commenced after the action for threats. It has been held that, if a threatened action for infringement be commenced and prosecuted with due diligence, there is no ground upon which an action under s. 32 can be commenced at all.(a)

Moreover, an action for infringement commenced before the issue of the threats complained of, is sufficient to bring the case within the proviso of s. 32, if the alleged infringements are the same as those forming the subject of the threats.(b)

In forming a conclusion as to whether an action for infringement has been commenced with due diligence after the issue of threats, account must be taken of the time that has elapsed since the threats complained of were first issued and the infringement action was commenced, and not of the time since the defendant first became aware that the plaintiff was doing the acts which are alleged in the threatening notices to be an infringement of the plaintiff's right.(c)

There is no rule as to the length of time within which a patentee must bring an infringement action in order to escape liability in respect of threatened proceedings.(d) Where the

(y) *Household v. Fairburn*, 1 P. O. R. 109; 2 P. O. R. 142.

(z) *Day v. Foster*, 7 P. O. R. 54.

(a) *Day v. Foster*, 7 P. O. R. 54, 60.

(b) *Day v. Foster*, 7 P. O. R. 54.

(c) *Challender v. Royle*, L. R. 36 Ch.

D. 435; 437; 4 P. O. R. 363; *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.*, 6 P. O. R. 502.

(d) *Colley v. Hart*, 7 P. O. R. 101, 106.

defendants in a threat action did not commence an action for infringement till over two months after the threats complained of were issued, and then only issued writs against two persons, not the plaintiffs in the threat action, and subsequently entered a counter-claim alleging infringement by the plaintiffs, they were held not to have commenced and prosecuted an action for infringement with due diligence.(*e*)

It has been held that an action commenced and subsequently discontinued by consent, is not an action prosecuted with due diligence, so as to entitle a defendant in a threat action to exemption from liability; (*f*) though it would appear that an action which is abandoned because the defendant gives in, and desists from the infringement, or because the plaintiff is advised that the action must fail, is an action for infringement prosecuted with due diligence.(*g*)

It cannot be contended that an action for infringement to come within the meaning of the proviso of s. 32 of the Act of 1883 must be prosecuted down to a successful result; on the contrary, the action may be within the proviso though it is discontinued, or judgment is against the plaintiff.(*h*)

The fact that a patentee, who has commenced an action for infringement against a person subsequently claiming an injunction restraining the continuance of threats, has not applied for an interlocutory injunction, is not evidence that he has not prosecuted his action with due diligence.(*i*)

Costs incurred by trying action in two forms.

It is the duty of the defendant to a threat action who brings a cross-action for infringement, to endeavour to avoid causing unnecessary costs by trying the same action in two different forms.(*k*)

Licenses and persons having limited in-

S. 32 of the Act of 1883 gives a right of action to any person or persons aggrieved by the threats of "any person claiming to be the patentee of the invention," and it would,

(*e*) *Herrburger v. Squire*, 5 P. O. R. 581; 6 P. O. R. 194; but see *Challender v. Royle*, L. R. 36 Ch. D. 437.

(*f*) *Crompton v. Patents Investments Co.*, 5 P. O. R. 381, 393; but see *Colley v. Hart*, 7 P. O. R. 101.

(*g*) *Colley v. Hart*, 7 P. O. R. 101, 108, 110.

(*h*) *Colley v. Hart*, 7 P. O. R. 101, 109, 110.

(*i*) *Anderson v. Liebig's Extract of Meat Co.*, 45 L. T. N. S. 757.

(*k*) *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.*, 6 P. O. R. 502; *Colley v. Hart*, 7 P. O. R. 101, 108, 109.

therefore, appear doubtful whether the section applies in the case of threats made by a licensee or other person having only a limited interest in the patent.

It must be remembered that a mere licensee cannot sue alone for an infringement of the patent, and it is doubtful whether an exclusive licensee can do so *(l)* because the term "patentee" as used in the Act means the person for the time being entitled to the benefit of the patent, *(m)* and it is doubtful whether this term would be held to include an exclusive licensee. *(n)*

If an exclusive licensee cannot justify an action for the infringement of the patent, he cannot avail himself of the proviso, and it is submitted, therefore, in such case the section could not be held to apply.

When a plaintiff in an action for infringement applies for the leave of the Court or a judge to amend his specification, he thereby admits that the patent is void so long as the specification is unamended; and he is not entitled to issue threatening notices until the amendment is actually made. *(o)*

The plaintiff in a pending action for infringement is not entitled to issue threatening circulars stating as a positive fact that the defendant has infringed the patent, and that the action has been commenced in consequence; but he may warn others against using the defendant's machines. *(p)*

In an action to restrain the issue of threatening notices the defendant may be ordered to furnish particulars, pointing out how the acts complained of are infringements of his patent, and pointing out, by reference to pages and lines of the specification, which parts of the invention therein described he alleges have been infringed; *(q)* and the plaintiff, if he denies the validity of the defendant's patent, may be required to deliver to the defendant particulars of his objections. *(r)*

(l) p.p. 338, 339, *ante*.

(m) 46 & 47 Vict. c. 57, s. 46.

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

(o) *Fusee Vesta Co. v. Bryant & May*, 4 P. O. R. 191.

(p) *Goulard v. Lindsay*, 4 P. O. R. 189.

(q) *Wren v. Wield*, L. R. 4 Q. B.

213; *Union Electrical Power and Light Co. v. Electrical Power Storage Co.*, 5 P. O. R. 329; *Law v. Ashworth*, 7 P. O. R. 86.

(r) *Union Electrical Power and Light Co. v. The Electrical Power Storage Co.*, 5 P. O. R. 329; *Smith v. Laing*, 7 P. O. R. 148.

Effect of application for leave to amend specifications.

Positive statement of infringement.

Particulars.

The defendant is entitled to the particulars before he delivers his defence.(s)

If the defendant is the owner of more than one patent, it is proper that he should deliver particulars of the patents on which he relies to support the threats before the plaintiff delivers his particulars, which may be confined to the patents mentioned in the defendant's list.(t)

Costs.

The costs of an action to restrain threats are dealt with by the Courts under their ordinary jurisdiction.

Where the plaintiff obtains judgment with costs the Master will, on taxation, tax in favour of the defendant any issues upon which he has been wholly successful.(u)

(s) *Law v. Ashworth*, 7 P. O. R. 86.
 (t) *Ibid.* Particulars of breaches and objections are discussed more fully in Chap. xiii.

(u) *Herrburger v. Squire*, 5 P. O. R. 596; *Longbottom v. Shaw*, 5 P. O. R. 502.

CHAPTER XIII.

ACTION OF INFRINGEMENT.

GENERAL — INFRINGEMENTS — PROCEEDINGS BEFORE COMMENCEMENT OF ACTION—PARTIES—PLEADINGS—STATEMENT OF CLAIM—PARTICULARS OF BREACHES—DEFENCE—PARTICULARS OF OBJECTIONS—TRIAL—NEW TRIAL—APPEAL—INTERLOCUTORY INJUNCTIONS—PERPETUAL INJUNCTIONS—EVIDENCE—INSPECTION AND DISCOVERY—ACCOUNT OR DAMAGES—DESTRUCTION OR DELIVERY OF INFRINGING ARTICLES—COSTS.

General.

It was not for two hundred years after the Statute of Monopolies became law that the popular prejudices against patent privileges disappeared, and judges began to determine questions arising between patentees and the public in a fair and impartial spirit. Formerly the Courts were only too ready to seize on any slight defects to declare a patent null and void. They were, no doubt, actuated by the deep-seated prejudice which was extremely general in the public mind, and which was the direct outcome of the monstrous oppression practised by means of patent grants before the statute of James I.

Manner in which letters patent were formerly interpreted.

The Courts now recognise the principle laid down by Lord Eldon, L.C.,^(a) that the patent is to be considered as a bargain between the public (represented by the Crown) and the patentee, and the specification therefore must be construed on the same principle of good faith as that which regulates all other contracts. Consequently, all questions which arise between patentees and the public are determined between the parties without any bias or strained construction put upon the law or patent in favour of either.

Manner in which they are now interpreted.

(a) *Cartwright v. Eamer*, cited 14 Ves. 131, 136.

LETTERS PATENT FOR INVENTIONS.

The privilege conferred by letters patent for an invention, which is created by the law, *(b)* would be of no practical use to the grantee, if he did not possess legal remedies against persons found to have invaded it.

Remedy of patentee in respect of infringement.

It is open to a patentee whose exclusive privilege is being invaded to bring an action for infringement against the offending party, and so vindicate his right by a proceeding in which, if he succeeds, he can obtain not only an injunction of the Court restraining a continuance of the wrongful acts, but also an account of profits made by the infringer, or damages against him, and the costs of the litigation.

Secret user.

A secret use of an invention before the date of letters patent will not, at any rate if there has been no profit derived therefrom, invalidate the patent subsequently obtained. *(c)*

Effect of injunction.

The question suggests itself, Can a patentee who has obtained letters patent for an invention, by an injunction of the Court, prevent another man from continuing what before the date of the patent had been a secret use of the invention?

It is submitted that he could do so, for during the continuance of the patent the patentee and his nominees have the sole right to use the invention. To stop the man who was previously, but secretly, using the invention from continuing to do so, would not be against the spirit of the patent law, which is designed in the interest of the public to encourage the publication of new and useful inventions to be ultimately enjoyed by the public in general. The man who uses an invention and keeps the method of performing it a secret, really inflicts a hardship on the public, for, if he never discloses it, the public may have no further advantage of it beyond that which the secret user chooses to give. It is open to the secret user, if he be the true and first inventor, to obtain a patent and enjoy the exclusive privilege of using the invention during the term for which it is granted. The law grants protection to the man who first discloses an invention, provided it was not communicated to him by another person within this realm, in which case he would not be the true and first inventor.

If any person has *openly* practised an invention before the

(b) Chap. viii. p. 304 *ante.* *(c)* p. 110 *ante.*

date of subsequent letters patent, he cannot be prevented from continuing to do after the patent that which he did before it, and the patent will be bad in law on the ground of lack of novelty.(d)

Besides the remedy of an action for infringement, patentees are entitled, in common with other persons, to bring an action against any one who sells goods manufactured by himself or another in such a manner as to induce the purchasing public to believe that such goods are manufactured by the patentee or his nominees, when, in fact, they have not been so manufactured. It does not signify in what way the offender carries out his fraudulent purpose, whether by counterfeiting a name,(e) word,(f) mark, or device(g) upon the spurious articles themselves, or upon the wrappers in which they may be wrapped,(h) or by using any other means to deceive the public into purchasing goods as the goods of a particular individual when they are really not so.(i)

Other remedies.

A plaintiff who succeeds in showing that the defendant has sold goods in a manner calculated to make the public believe that they were, contrary to the actual fact, purchasing the manufacture of the plaintiff, is entitled to an injunction against the defendant, and also to an account or damages.(k) And it is no answer for the defendant to say that the spurious goods are equal in quality to those made by the plaintiff.(l)

Sale of goods in a manner calculated to deceive.

If a person sells goods in a manner which induces the purchaser to believe that he is buying the goods of another, he is liable to an action, notwithstanding the fact that he makes no actual misrepresentation.

Thus, in a case where it appeared that the plaintiff made and sold goods which he was accustomed to mark with the words "Sykes' patent," and the defendant (who was of the

(d) See Chap. III.

(e) *Ransome v. Bentall*, 3 L. J. N. S. 161; *Singer Manufacturing Co. v. Loog*, L. R. 18 Ch. D. 395, 422.

(f) *Knott v. Morgan*, 2 Keen 213; *Wotherspoon v. Currie*, L. R. 5 E. & I. App. 508; *Ford v. Foster*, L. R. 7 Ch. App. 611; *Siegert v. Findlater*, L. R. 7 Ch. D. 801.

(g) *In re Worthington*, L. R. 14 Ch. D. 8; *Orr Ewing v. Johnson*, L. R. 13 Ch. D. 434; L. R. 7 App. Cas. 219;

Seixo v. Provezende, L. R. 1 Ch. App. 192.

(h) *Blofield v. Payne*, 4 B. & A. 410; *Blackwell v. Crabb*, 36 L. J. Ch. 504; *Upmann v. Elkan*, L. R. 12 Eq. 140; L. R. 7 Ch. App. 130.

(i) See *Graham, Designs and Trade Marks*, pp. 87-110, and cases there collected.

(k) See *post*.

(l) *Blofield v. Payne*, 4 B. & A. 410.

same name as the plaintiff) made and sold goods to retailers which he also marked with the words "Sykes' patent," and the patent right had expired, the defendant was restrained by the injunction of the Court, on the ground that he was selling his goods as and for those manufactured by the plaintiff; and this notwithstanding the fact that he did not himself represent his goods to be of the plaintiff's manufacture.^(m) A rule *nisi* for a new trial was refused by the Court of King's Bench.⁽ⁿ⁾

Right of discoverer of a secret process.

Any person who becomes acquainted with the process of manufacturing an article which is merely a secret, and not the subject of a patent, is entitled to manufacture it; and if the name of the first manufacturer has become attached to the article, any person manufacturing it is entitled to describe it by such name, provided he does not use it in such a manner as to lead the public to believe that they are buying goods made by such original manufacturer.^(o)

Offence under 46 & 47 Vict. c. 57, s. 105.

By the Act of 1883,^(p) it is made an offence, punishable on summary conviction, by a fine not exceeding five pounds for every offence, for any person to represent that any article sold by him is a patented article, when no patent has been granted for the same; and a person is deemed to represent that an article is patented, if he sells the article with the word "patent," "patented," or any other word expressing or implying that a patent has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to the article.

It is not an offence under the above mentioned Act to represent an article as patented, when the patent has expired.^(q)

Security of the public against the injurious effects of illegal patents.

The public are secured against the injurious effects of illegal patents by the following remedies which exist for their protection:—

First: Any member of the public against whom proceedings are taken by the patentee, is entitled to show that the patent in question is void,^(r) and so defeat the action, for there can be no infringement of an invalid patent; and, unless the patent

^(m) *Sykes v. Sykes*, 3 B. & C. 541.

⁽ⁿ⁾ 3 L. J. N. S. 161.

^(o) *Massam v. J. W. Thorley's Cattle Food Co.*, L. R. 6 Ch. D. 574; 14 Ch. D. 748.

^(p) S. 105.

^(q) See *Cheavin v. Walker*, L. R. 5 Ch. D. 863; *Marshall v. Ross*, L. R. 8 Eq. 651; *Linoleum Co. v. Nairn*, L. R. 7 Ch. D. 834.

^(r) But see p. 434 *post*.

has all the elements of validity in itself, it cannot be made the means of complaint by reason of an alleged infringement.(s)

Secondly: Any person entitled as of right so to do, or authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, may obtain the revocation of an illegal patent on petition to the Court.(t)

Thirdly: Every patent contains a proviso to the effect that it shall forthwith determine and be void to all intents and purposes, if at any time during the term for which it is granted it be made to appear to the Queen, her heirs, or successors, or any six or more of her Privy Council, that the grant is contrary to law, or prejudicial or inconvenient to the subjects in general, or that the invention is not a new invention as to the public use and exercise thereof within the United Kingdom of Great Britain and Ireland, or the Isle of Man, or that the patentee is not the first and true inventor thereof.(u)

Infringements.

A person invades the exclusive rights of a patentee and commits an infringement, when, he directly, or indirectly, uses the art or invention which is the subject of the patent, and applies it in any way for his own profit or benefit, otherwise than for the purpose of a *bond fide* experiment. Definition of infringement.

Any act done on board a British vessel on the high seas, will not amount to an infringement of a British patent of which the Court will take cognizance.(x)

The use of an invention for the purpose of the navigation of a foreign vessel within the jurisdiction of her Majesty's Courts, in the United Kingdom or Isle of Man, or the use of an invention on a foreign vessel within that jurisdiction, if the State to which the foreign vessel belongs shows similar indulgence to British vessels, is not deemed an infringement of any British patent obtained for such invention, unless it is used for the manufacture or preparation of something intended to be sold in, or exported from, the United Kingdom or Isle of Man.(y) Use of patented inventions on foreign vessels.

(s) *Dudgeon v. Thomson*, L. R. 3 App. Cas. 37.
(t) Chap. x.

(u) p. 341 *ante*.
(x) *Newall v. Elliott*, 4 N. R. 429.
(y) 46 & 47 Vict. c. 57, s. 43.

An act done in infringement of a British patent on board a foreign vessel in British waters will be restrained by the injunction of the Court, if the provisions set out in the preceding paragraph are not applicable to the case.(z)

Use of patented invention by way of *bona fide* experiment.

It is no invasion of a patentee's rights for another person to use the invention, and thereby produce the finished product by way of *bona fide* experiment or amusement, and not with the intention of selling or making use of the thing so made for the purpose for which the patent was granted, but with the view merely of improving upon the invention the subject of the patent, or with the view of seeing whether an improvement can be made.(a) In the words of Jessel, M.R.,(b) "patent rights were never granted to prevent persons of ingenuity exercising their talents in a fair way. But, if there be neither using nor vending of the invention for profit, the mere making for the purpose of experiment, and not for a fraudulent purpose, ought not to be considered within the meaning of the prohibition, and, if it were, it is certainly not the subject for an injunction."

Use for instruction of pupils.

Use of a pirated article for the purpose of making experiments for the instruction of pupils, is use for advantage, and an infringement of the patent under which the article was manufactured.(c) Thus, where an English electrician purchased and imported from a foreign manufacturer apparatus made according to an English patent, and maintained that he had only purchased the apparatus for examination and experiment by himself and his pupils, as certain royalty paid instruments in his possession were too expensive to be taken to pieces, and further insisted that he had never sold, and had never otherwise used the apparatus, the Court held that such use was an infringement, and granted an injunction restraining the continuance of it.(d)

Payment after trial.

Also where it appeared that certain persons purchased

(z) *Caldwell v. Van Vlissingen*, 9 Hare, 415.

(a) *Frearson v. Loe*, L. R. 9 Ch. D. 48; *Jones v. Pearce*, 1 W. P. C. 121, 125; 5 M. & G. 208; *Muntz v. Foster*, 2 W. P. C. 101. *United Telephone Co.*

v. Sharples, 2 P. O. R. 28; *Proctor v. Bayley*, 6 P. O. R. 107.

(b) *Frearson v. Loe*, L. R. 9 Ch. D. 48.

(c) *United Telephone Co. v. Sharples*, L. R. 29 Ch. D. 164.

(d) *Ibid.*

infringing machines upon the understanding that they were not to be paid for unless they proved successful, and the machines in question were used by the defendants in their works for several months, the Vice-Chancellor of the Court of the County Palatine of Lancaster held that such use was not experimental; but the Court of Appeal dissolved the injunction, on the ground, however, that supposing the infringement was proved, as the defendants were merely users and not manufacturers, and the only infringement was put an end to some considerable time ago and there was no evidence of any intention on their part to continue in the wrongful act, an injunction ought not to have been granted.(*e*)

Formerly there used to be an idea that it was possible to infringe upon the equity of a statute. If it were not possible to show that the words of the statute had been infringed, it was contended that the equity had been invaded; and, similarly, by a confusion of ideas a notion was prevalent that there might be an infringement of the equity of a patent. There is, however, no sound principle of this kind in the patent law; that which is protected is that which is specified, and that which is held to be an infringement must be an infringement of that which is specified, though it may not be the less an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist, and yet the thing protected may be taken notwithstanding.(*f*)

It is not material to consider the intention of a person who commits an infringement of a patent; (*g*) evidence of intention may be material for the consideration of the jury, but if the invention be in point of fact adopted or imitated, whether in ignorance or with intention, an infringement is committed.(*h*) An infringer is liable for what he does, not for what he intends; (*i*) and there may be an indirect infringement, as

(*e*) *Proctor v. Bayley*, 6 P. O. R. 106, 538.

(*f*) See *Dudgeon v. Thomson*, 30 L. T. N. S. 244; L. R. 3 App. Cas. 34, judgment of Cairns, L.C.

(*g*) *McCormick v. Gray*, 7 H. & N. 25, 39; 31 L. J. Ex. 42; *Heath v. Unwin*, 15 Sm. 552; *Stead v. Anderson*, 2 W. P. C. 156; 4 C. B. 834; *Seed v.*

Higgins, 5 Jur. N. S. 540; S. E. & B. 771; *Young v. Rosenthal*, 1 P. O. R. 29, 39.

(*h*) 2 W. P. C. 227 n.

(*i*) *Stead v. Anderson*, 2 W. P. C. 156; 4 C. B. 834; *Newall v. Elliott*, 10 Jur. N. S. 954; *Nobel's Explosives Co. v. Jones*, L. R. 8 App. Cas. 12, 13.

well as a direct one, though the intention of the party be perfectly innocent,^(k) and even though he may not know of the existence of the patent itself,^(l) or that the thing he was dealing with was an infringement.^(m) Neither is it a sufficient answer to a motion to commit for breach of an injunction to say that the defendant did not intend to infringe,⁽ⁿ⁾ nor is ignorance a valid defence.^(o)

Effect of intention on costs.

Jessel, M.R., in a case of infringement of copyright, laid it down that where a plaintiff comes to enforce a legal right, and there has been no misconduct on his part, no omission or neglect which would induce the Court to deprive him of his costs, the Court has no discretion, and cannot take away the plaintiff's right to costs.^(p)

On the other hand, where the defendant was a retail dealer who unwittingly sold articles which were an infringement of the plaintiff's patent, James, V.C., held that he was not liable for the costs of an action to restrain the infringement, if he at once gave full information as to the persons from whom he obtained the articles complained of, and promised not to retail any more.^(q) And, adopting the same principle, Lord Hatherley, in a trade-mark case, held that forwarding agents and warehousemen who had received boxes of cigars bearing forged brands, but were unaware of the forgery, and gave all information in their power immediately on being informed thereof, were not liable to the costs of an action brought to restrain the sale of such cigars.^(r)

Acts done under subsequent patents for same invention as prior patent.

When there is more than one patent for the same invention, anything done under one of those of subsequent date is an

^(k) *United Telephone Co. v. London, &c., Telephone Co.*, L. R. 26 Ch. D. 766
Adair v. Young, L. R. 12 Ch. D. 13.

^(l) *Heath v. Unwin*, 2 W. P. C. 228, 315; *Wright v. Hitchcock*, L. R. 5 Ex. 37; *Davenport v. Rylands*, L. R. 1 Eq. 302; *Young v. Rosenthal*, 1 P. O. R. 39.

^(m) *Walton v. Lavater*, S. C. B. N. S. 162; *Wright v. Hitchcock*, L. R. 5 Ex. 37; *Geary v. Norton*, 1 De G. & S. 9; *Davenport v. Rylands*, L. R. 1 Eq. 302.

⁽ⁿ⁾ *Plimpton v. Spiller*, L. R. 4 Ch. D. 286, 288.

^(o) *Upmann v. Forrester*, L. R. 24 Ch. D. 231; *Whitman v. Oppenheim*, L. R. 27 Ch. D. 260; *Wright v. Hitchcock*, L. R. 5 Ex. 37; *Davenport v. Rylands*, L. R. 1 Eq. 302; *Walton v. Lavater*, S. C. B. N. S. 162; *Geary v. Norton*, 1 De G. & S. 9.

^(p) *Cooper v. Whittingham*, L. R. 15 Ch. D. 501; see also *Upmann v. Forrester*, L. R. 24 Ch. D. 231.

^(q) *Betts v. Wilmott*, 18 W. R. 946; *Num v. D'Abuquerque*, 34 Beav. 595.

^(r) *Upmann v. Elkan*, L. R. 7 Ch. App. Cas. 130.

infringement of that which bears the earliest date; (s) and if an invention is shown to be new and useful, the fact that it is much more useful with a subsequent improvement affords no ground for infringing the original invention by using it with the subsequent improvement. (t)

In determining whether an act complained of is really an infringement of a patent or not, it is always most important to ascertain from the specifications what is the exact invention protected. If this invention is taken by the defendant, an infringement is committed, and it will not save the defendant from the consequences that, though he has taken the invention he has dressed it up colourably, added something to it, or taken something away from it, provided that of the whole it can be said that the machine or process is either the plaintiff's or differs from it only colourably. (u)

Importance of ascertaining the exact invention comprised in the patent.

The use of the word "colourable," "colourably," in reference to an infringement is highly inappropriate, and apt to lead to great confusion, if it is forgotten that the real question always is, Has the property of the patentee been taken? (v)

Use of the word "colourable."

When determining whether any particular act is an infringement of a patent or not, it is always most important to consider what is the principle of the invention. (y) The reader must observe that the word principle, when thus used, is not intended to signify any of those first principles or laws of nature which cannot be the subject of a valid patent, (z) but it is intended to mean a practical application of one or more of those first principles which is properly denominated

Principle of invention.

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

(t) *Thomson v. Batty*, 6 P. O. R. 84, 100.

(u) *Dudgeon v. Thomson*, L. R. 3 App. Cas. 34; *Minter v. Wells*, 1 W. P. C. 134; *Stevens v. Keating*, 2 W. P. C. 181; *Muntz v. Foster*, 2 W. P. C. 95; *Walton v. Potter*, 1 W. P. C. 585; *Gamble v. Kurtz*, 3 C. B. 425; *Trotman v. Wood*, 16 C. B. N. S. 479; *Hayward v. Pavement Light Co.*, 1 P. O. R. 207; *Nordenfelt v. Gardner*, 1 P. O. R. 61; *Walker v. Hydrocarbon Syndicate*, 2 P. O. R. 8; *Sugg v. Bray*, 2 P. O. R. 233; *United Telephone Co. v. St. George*, 3 P. O. R. 321; *Richardson*

v. Castny, 4 P. O. R. 265; *Ellington v. Clark*, 5 P. O. R. 135, 319; *Werham v. May*, 4 P. O. R. 303; *Ehrlich v. Ihlee*, 5 P. O. R. 198, 437; *Garrard v. Edge*, 6 P. O. R. 372, 563; *Boyd v. Horrocks*, 6 P. O. R. 152, 528; *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, 6 P. O. R. 121, 367; *Shaw v. Jones*, 6 P. O. R. 328; *Wulby v. Manchester, &c., Steam Tramways Co.*, 6 P. O. R. 359, 365; 7 P. O. R. 30.

(v) *Ibid.*

(y) *Thomson v. Moore*, 6 P. O. R. 426 450.

(z) p. 35 *ante*.

an art by means of which articles of commerce may be manufactured; and an art of this description is that which must necessarily be the subject of every valid patent.(a) Thus, in the case of *Watt's* steam-engine, Watt invented the art of making a steam-engine with a condenser separate from the cylinder, and in common parlance it is said that the principle of that invention is the construction of a steam-engine so that the steam shall be condensed in a vessel separate to the cylinder. And whenever it can be shown that any act done without the sanction of the patentee comes, in this sense of the word, within the principle of the invention, the act is an infringement of the patent, for it necessarily implies that the art invented by the patentee has been used contrary to the prohibition in the grant. The law intends a patent to reward the patentee for his invention by means of the profit to be derived from the exercise of the sole privilege granted by the patent; and if other parties could evade the patent privilege by making some mechanical variation from the mode of applying the invention, or the articles to be produced by means of it, as described in the specification, the object of the patent would be frustrated, for no one would pay the patentee a profit for the patent article, if he could obtain an article substantially the same at a cheaper rate.(b)

Infringement by adopting the principle of an invention.

It is an infringement to adopt a mode of accomplishing an object similar in principle to the patentee's mode,(c) or to imitate the patentee's invention.(d)

Thus, in the case of *Crossley v. Beverley*,(e) it appeared that the patentee had obtained a patent for an improved gas apparatus, and the infringement complained of was a close imitation of the patented machine, the principles applied in the plaintiff's machine and in the defendant's being the same. The plaintiff accordingly obtained a verdict.

Baron Alderson, in a subsequent case, commenting on *Crossley v. Beverley*, said: "There never was a more instructive

(a) p. 24 *ante*.

(b) See Hindmarch on Patents, pp. 493, 494; *Thomson v. Moore*, 6 P. O. R. 426, 450.

(c) *Russell v. Cowley*, 1 W. P. C. 450.

(d) *Crossley v. Beverley*, 1 W. P. C. 106; *Jupe v. Pratt*, 1 W. P. C. 146.

(e) 1 W. P. C. 106.

case than that: I remember very well the argument put by the Lord Chief Baron, who led the case for the plaintiff, and succeeded. There never were two things to the eye more different than the plaintiff's invention and what the defendant had done in contravention of his patent right. The plaintiff's invention was different in form—different in construction; it agreed with it only in one thing, and that was, by moving in the water a certain point was made to open, either before or after, so as to shut up another, and the gas was made to pass through this opening; passing through it, it was made to revolve. The scientific men, all of them, said the moment a practical scientific man has got that principle in his head, he can multiply without end the forms in which that principle can be made to operate.”(f)

If the pith and marrow of the patentee's invention be taken, an infringement is committed, and such a taking is none the less actionable because the infringer has added something to the invention which constitutes an improvement.(g)

It is an infringement to take two out of three parts of a patented combination with a colourable variation of the third;(h) and when an object the same as that patented is attained by the same process, introduced for the same purpose, there is an infringement.(i)

It has been explained(k) that in the case of a patent for a combination of several parts a claim may be made to the combination as a whole, and also to any one or more of the several parts separately, or in combination as a minor invention. The question whether the use of one or more of the component parts of a combination is an infringement or not,

(f) *Jupe v. Pratt*, 1 W. P. C. 146.
 (g) *Erlieh v. Ihlec*, 5 P. O. R. 437;
Hayward v. Hamilton, Grifl. P. C. 115,
 124; *Proctor v. Bennis*, L. R. 36 Ch. D.
 740, 756; *Cunnington v. Nuttall*, L. R.
 5 E. & I. App. 205; 40 L. J. Ch. 739;
Neilson v. Harford, 1 W. P. C. 310;
Russell v. Ledsam, 14 M. & W. 579;
Bateman v. Gray, Macr. P. C. 102;
Saxby v. Clunes, Ex. 228-43, L. J.
 241; *Thorn v. Worthing Skating Rink*
Co., L. R. 6 Ch. D. 415; *Plimpton v.*
Spiller, L. R. 4 Ch. D. 286; *Curtis v.*
Platt, L. R. 3 Ch. D. 135 n.; 35 L. J.

Ch. 852; *Spencer v. Ancoats, &c., Co.*,
 6 P. O. R. 46; *Thompson v. Batty*, 6
 P. O. R. 84; *Thompson v. Moore*, 6
 P. O. R. 428; *Wilson v. Barbour*, 5
 P. O. R. 245, 675.

(h) *Murray v. Clayton*, L. R. 7 Ch.
 App. Cas. 570, 585; *Kaye v. Chubb*, 5
 P. O. R. 641.

(i) Per Lord Hatherley, *Cunnington*
v. Nuttall, L. R. 5 E. & I. App. Cas.
 205; 40 L. J. Ch. 739; see also *Badische*
Anilin und Soda Fabrik v. Levinstein,
 L. R. 24 Ch. D. 175.

(k) p. 207 ante.

Infringement
of a combina-
tion

by use of com-
ponent parts.

depends upon whether or not the parts are claimed separately or taken as a subsidiary combination. It is not possible to say in the abstract whether the use of two parts, A and B of a combination consisting of A, B, and C, is or is not using part of the invention; nor can it be decided in the abstract whether or not the specification shows that A or B is claimed sufficiently as a part of a combination consisting of A, B and C. (l)

New and useful subordinate parts.

A patent for a combination is infringed by the use of a subordinate part only, if that part is new and material; (m) though, if the patent is for a combination of two or more old inventions, the use of only one of them will not be an infringement. (n)

Thus, if a man invents a machine consisting of three parts, of which one is a very useful invention, and the other two are found to be of less practical use, it is not free for a person to adopt the useful part, and contrive some other mode of carrying out the less useful parts. (o) The question always is, "Has the combination in substance been taken? Has the defendant, though not exactly taking the whole combination which has been patented, taken by slight variation or by mechanical equivalent the substance of it, so as to produce the same result by practically the same means?" (p)

Equivalents.

The law will not allow a person to take one article that has been patented and give a substitute in its place, for the purpose of effecting the same end, by the use of equivalents, using the skill and knowledge which he may possess to evade the patent. (q)

(l) *Clark v. Adie*, L. R. 2 App. Cas. 335.

(m) *Lister v. Leather*, 8 E. & B. 1004; *Parkes v. Stevens*, L. R. 8 Eq. 358, 366; L. R. 5 Ch. App. 36; *Wright v. Hitchcock*, L. R. 5 Ex. 37; *Foxwell v. Bostock*, 12 W. R. 723; *Sellers v. Dick*, 5 Ex. 312; *Newton v. Grand Junction Ry.*, 5 Exch. 331; *Smith v. London and North-Western Ry.*, 2 E. & B. 69; *Young v. Rosenthal*, 1 P. O. R. 33; *Clark v. Adie*, L. R. 10 Ch. App. Cas. 667; 3 Ch. D. 134, 143; 2 App. Cas. 315, 327, 335.

(n) *Smith v. London and North-Western Ry.*, 2 E. & B. 69, 76.

(o) *Ibid.*

(p) Per Cotton, L.J., *Proctor v. Bennis*, L. R. 36 Ch. D. 254, 740; see also *Burnett v. Tate*, 45 L. T. N. S. 143; *Murray v. Clayton*, L. R. 10 Ch. App. Cas. 675 n.; *Gerrard v. Edge*, 6 P. O. R. 372, 563.

(q) *Bateman v. Gray*, Macr. P. C. 102; *Morgan v. Seaward*, 1 W. P. C. 171; *Thorn v. Worthing Skating Rink Co.*, L. R. 6 Ch. D. 415 n.; *United Telephone Co. v. Harrison Cox-Walker*, L. R. 21 Ch. D. 720; *United Telephone Co. v. Bassano*, 3 P. O. R. 295; *United Telephone Co. v. St. George*, 3 P. O. R. 321; *Hancock v. Moulton*, Johns. Pat. Man. 5th ed. p. 254.

It is an infringement to substitute mechanical equivalents for the patentee's invention and add at the same time an improvement,^(r) or to omit some part or parts of a patented combination and add anything, whilst at the same time using the substance and essence of it.^(s) In order, however, that the substitution of an equivalent for any part of an invention for which letters patent have been granted, may constitute an infringement, the equivalent must, at the date of the patent, be known to be an equivalent. To produce the result arrived at by the prior patentee by the use of an equivalent means, which required subsequent invention to demonstrate that it was an equivalent, may be perfectly good subject-matter for a subsequent grant of letters patent, and consequently no infringement of the prior patent.^(t)

Thus, rendering cast steel easy to weld and malleable by the addition of coal tar and black oxide of manganese to a crucible containing bars of common blistered steel, broken into fragments, or mixtures of cast and malleable iron, or malleable iron and carbonaceous matter, and heated to the proper heat for melting the materials, was held by the House of Lords ^(u) to be no infringement of a prior patent for doing the same thing by means of carbonate of manganese, although there was evidence to the effect that carbonate of manganese was formed by exposing a mixture of carbon and oxide of manganese to a high temperature. Lord Abinger, C.B., in the Court of Exchequer, ruled that the materials or elements of carbonate of manganese, as used by the defendant, being out of all proportion cheaper than the carbonate of manganese itself, the use of such materials in the composition was a new discovery or invention, and not within the letters patent; and that there was not sufficient evidence of the formation of carbonate of manganese during the process adopted by the defendant, that

^(r) Ehrlich v. Hlee, 5 P. O. R. 437, 454.

^(s) Proctor v. Bennis, 36 Ch. D. 740, 755; Needham v. Johnson, 1 P. O. R. 49; Gwynne v. Drysdale, 3 P. O. R. 65, 67.

^(t) Badische Anilin und Soda Fabrik v. Levinstein, L. R. 24 Ch. D. 156,

170-173; Heath v. Unwin, 5 H. L. C. 545; Plimpton v. Spiller, L. R. 6 Ch. D. 424; Automatic Weighing Machine Co. v. Knight, 6 P. O. R. 113; Thompson v. Moore, 6 P. O. R. 426; Talbot v. Laroche, 15 C. B. 31.

^(u) Heath v. Unwin, 5 H. L. Cas. 505.

is, of the use of carbonate of manganese in the manufacture of steel within the meaning of the specification. (x)

Rule in *Sellers v. Dickinson*.

It is an accepted proposition of patent law, known as the rule in *Sellers v. Dickinson*, (y) that if a portion of a patented new arrangement of machinery is in itself new and useful, and a person, for the purpose of producing the same effect as it produces, uses that portion of the arrangement, and substitutes another mechanical equivalent, for the other matters combined with it, he thereby commits an infringement of the patent.

Invention of means of producing a known result.

When an invention relates to the production of an old and known result, the patentee is protected only in respect of the particular means of performing the invention he sets forth in the specification; (z) and under such circumstances it may be no infringement to achieve the same result by the use of well-known equivalents. (a)

Curtis v. Platt.

In *Curtis v. Platt*, (b) Lord Hatherley (then Vice Chancellor Wood), and Lord Westbury on appeal, followed the rule laid down by the House of Lords in *Seed v. Higgins*, (c) which applies to patents for achieving known results, viz., that if you find a specific mechanical improvement claimed, then you must hold the person strictly to that particular mechanical device which he has claimed for effecting the object he had in view; and if he says it is to be done in one precise and particular way, to that precise and particular way he must be held, and those who have *bonâ fide* employed a different system and a different way must not be held to have infringed. "Where the thing is wholly novel and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machines for effecting the same object, to see whether or not they are merely colourable contrivances for evading that which has been done before. When the object itself is one which is not new, but the means only are new, one is not

(x) *Heath v. Unwin*, 2 W. P.C. 217 ; 5 H. L. C. 505.

(y) 5 Exch. 312, 326 ; 20 L. J. N. S. Ex. 417.

(z) p. 48 *ante*.

(a) *Gosnell v. Bishop*, 5 P. O. R. 151, 156.

(b) L. R. 3 Ch. D. 135 n.

(c) 8 H. L. Cas. 550.

inclined to say that a person, who invents a particular means of doing something that has been known to all the world long before, has the right to extend very largely the interpretation of those means which he has adopted for carrying it into effect." (*d*)

It has wrongly been alleged that *Curtis v. Platt* laid down the principle that when an invention is claimed for improvements in machinery consisting only in combination, there the patentee must be held to the description which he gives of the particular means by which his invention is to be carried into effect, and that the doctrine of mechanical equivalents cannot apply. What *Curtis v. Platt* really lays down is, "that where there is no novelty in the result, and where the machine is not a new one, but the claim is only for improvements in a known machine for producing a known result, the patentee must be tied down strictly to the invention which he claims and the mode which he points out of effecting the improvement." (*e*) Consequently this case does not apply when there is not only novelty in the machine, but novelty in the result it produces; (*f*) neither is a claim for a particular means to effect certain purposes infringed where the same purposes are effected by different means; (*g*) nor is a combination to effect certain results infringed by a combination of similar parts operating in a different manner, though the results effected are the same. (*h*)

Lord Cairns, speaking in the House of Lords on the different possible modes of infringing a patent for a horse-clipper which consisted of a combination of several parts, said: (*i*) "One mode of infringement would be a very simple and clear one, the infringer would take the whole instrument from beginning to end, and would produce a clipper made in every respect like the clipper described in the specification. About an

Modes of
infringing
patents for
combinations.
Per Cairns,
L.C.

(*d*) Per Page Wood, V.C., *Curtis v. Platt*, L. R. 3 Ch. D. 135 n.

(*e*) Per Cotton, L.J., *Proctor v. Ben- nis*, L. R. 36 Ch. D. 756, 757; see also *Ehrlich v. Ihlee*, 5 P. O. R. 437; *Boyd v. Horrocks*, 6 P. O. R. 152, 558; *Thompson v. Moore*, 6 P. O. R. 426.

(*f*) *Ibid.* *Automatic Weighing Ma- chine Co. v. Knight*, 6 P. O. R. 113.

(*g*) *Sugg v. Bray*, 2 P. O. R. 233-9; p. 48 *ante*.

(*h*) *Lawrence v. Perry*, 2 P. O. R. 179, 188; *Boyd v. Horrocks*, 6 P. O. R. 152; *Automatic Weighing Co. v. Knight*, 6 P. O. R. 113, 297.

(*i*) *Clark v. Adie*, L. R. 2 App. Cas. 320.

infringement of that kind no question could arise. The second mode would be one which might occasion more difficulty. The infringer might not take the whole of the instrument here described, but he might take a certain number of parts of the instrument here described; he might make an instrument which in many respects might resemble the patent instrument, but would not resemble it in all its parts. And then the question would be, either for a judge or for any tribunal which was judging of the facts of the case, whether that which was done by the alleged infringer amounted to a colourable departure from the instrument patented, and whether in what he had done he had not really taken and adopted the substance of the instrument patented. But there is a third way in which it is possible to conceive an infringement of a patent of the kind to which I have referred. Inside the whole invention there may be that which itself is a minor invention, and which does not extend to the whole, but forms only a subordinate part or integer of the whole. Now, again, that subordinate integer may be a step, or a number of steps in the whole, which is or are perfectly new, or the subordinate integer may not consist of new steps, but may consist of a certain number of steps so arranged as to form a novel combination within the meaning which is attached by the patent law to the term "combination." Suppose that in a patent you have a patentee claiming protection for an invention consisting of parts which I will designate as A, B, C, and D; he may at the same time claim that as to one of those parts, D, it is itself a new thing, and that as to another of those parts, C, it is itself a combination of things which were possibly old in themselves, but which, put together and used as he puts together and uses them, produce a result so new that he is entitled to protection for it as a new invention. In a patent of that kind the monopoly would or might be held to be granted, not only to the whole and complete thing described, but to those subordinate integers entering into the whole which I have described. But then, the invention must be described in that way; it must be made plain to ordinary apprehension upon the ordinary rules of construction, that the

patentee has had in his mind, and has intended to claim protection for those subordinate integers; and, moreover, he is, as was said by the Lords Justices, at the peril of justifying those subordinate integers as themselves matters which ought properly to form the subject of a patent of invention."

Esher, M.R., speaking on the same questions, but on a different occasion, said:^(k) "That seems to me to claim the feeding apparatus as a combination, and to claim the combination, and the combination alone. If that be so, how can such a combination be infringed? The machine which is challenged may have that combination actually without any variance at all. If so, it is obvious that the challenged machine is an infringement. Or it may have that combination with some alteration. The alteration of a combination, as it seems to me, may be by addition, or subtraction, or substitution of parts. Any one of these alters the combination. If the alteration, whether it be by addition, or subtraction, or substitution be merely colourable, then the two machines are substantially the same; although not mathematically exactly the same, they are substantially the same, and in any case, notwithstanding such colourable alteration, there may be an infringement. An alteration by addition may be an improvement, but then that will leave the whole of the original combination, and add something to it. If such an alteration of the combination be made, it seems to me that no good patent can be made with regard to the new machine, except by claiming the invention as an improvement, and by showing distinctly what the addition is, so as to show what the improvement is. An alteration by subtraction, if it were more than a colourable subtraction, would, as it seems to me, alter the combination. It would not be a combination of the same things; it would be a combination of different things, and, if the combination were altered by a material subtraction, I should think that it was a new combination. But an alteration by substitution, that is by substitution of one of the material elements of the original combination, must to my mind, be a new combination. The second com-

Per Esher,
M.R.

(k) Nordenfelt v. Gardner, 1 P. O. R. 61, 65.

LETTERS PATENT FOR INVENTIONS.

ination, then, is a combination of different things from the first. There is a taking away of one of the elements, and a material element of the old combination, and a putting in of a new material element which is different from any of the elements of the former. Somebody tried to express these things by A, B, and C; but if the original combination is of A, B, and C, and you take away C, and make a combination of A, B, and D, it seems to me as clear as possible that the new combination is a different combination from the old."

Different ways
of infringing a
patent privi-
lege.

The form (l) now used, of all letters patent for inventions, grants to the patentee full power, sole privilege, and authority by himself, his agents, or licensees to make, use, exercise, and vend the invention, and then forbids the rest of the public, during the continuance of the patent, either directly or indirectly, to make use of, or put in practice the invention, or any part of the same, or in any wise to imitate the same, or make, or cause to be made, any addition thereto, or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent or agreement of the patentee in writing under his hand and seal. Consequently, there are several ways in which a patent privilege may be infringed: by manufacturing, or making articles for use or sale, by means of the art which is the subject of the patent; or by using, exercising, or putting the art in practice to the prejudice of the patentee in any other way; by making for use or sale, or vending articles made in pursuance of the invention; or by counterfeiting, or imitating the invention in any other way.

Ordering an
article to be
made accord-
ing to a
patented pro-
cess.

It is also an infringement to order an article to be made according to a patented process, for if he who causes an article to be made, may be said to make it himself.(m)

No proof of
sale.

What the public is by the patent prohibited from doing is to exercise the art which is the subject of the grant. In the case of making an article without proof of sale, the fact that the defendant has not sold the article manufactured according to the patent, and therefore not derived pecuniary profit, does not prove that he has not exercised the art,

(l) 46 & 47 Vict. c. 5, 1st Schedule, Form D.
(m) Gibson v. Brand, 1 W. P. C. 631.

though it does show that the plaintiff has not suffered any substantial loss, and it is, therefore, an argument in mitigation of damages.

When the patent is for a combination of various parts, each of which is in itself old, the manufacture and sale in this country of those parts is no infringement, nor is the exportation of them with the intention of putting them together abroad, for the single parts do not make the patented combination, and the making of them is in itself lawful.⁽ⁿ⁾ Nor is it any infringement to manufacture, or sell an article which may be used for the purpose of infringing a patent, even though the person manufacturing and selling it actually knows that it will be used for purposes of infringement;^(o) though it appears that an injunction restraining the sale of a complete machine would be violated by the sale of all the component parts in such a way that they could be easily put together by any one.^(p)

Manufacture and sale of parts of a combination.

Manufacturing articles which may be used for purposes of infringement.

It has been held to be an infringement of a combination patent to restore instruments by renewing parts which were essential to the combination.^(q)

Restoring articles the subject of a combination patent.

The mere making of articles for the purpose of sale or use, and not by way of *bona fide* experiment,^(r) is an infringement, although no actual sale or use has taken place;^(s) but there is no infringement unless a saleable article is produced,^(t) though the thing constructed may infringe without being separately prepared and saleable, as in the case of fitting a ship for the reception and laying of a telegraph cable.^(u)

No infringement unless saleable article is produced.

It is an infringement to sell or use an article which was manufactured according to a patented process without the licence of the patentee,^(v) whether the article was made in this

Infringement by sale of article manufactured without the licence of the patentee.

⁽ⁿ⁾ See *Gloucher v. Clayton*, 11 Jur. N. S. 107, 462; 34 L. J. Ch. 239; *McCormick v. Gray*, 7 H. & N. 25.

^(o) *Townsend v. Haworth*, 48 L. J. Ch. N. S. 770; 12 Ch. D. 831 n.; *Sykes v. Howarth*, L. R. 12 Ch. D. 826; 48 L. J. Ch. 769.

^(p) *United Telephone Co. v. Dale*, L. R. 25 Ch. D. 778.

^(q) *United Telephone Co. v. Neilson*, W. N. 1887, 193.

^(r) p. 400 *ante*.

^(s) *Muntz v. Foster*, 2 W. P. C. 101; *Jones v. Pearce*, 1 W. P. C. 125.

^(t) *Higgs v. Goodwin*, E. B. & E. 529; 27 L. J. Q. B. 421.

^(u) *Newall v. Elliot*, 10 Jur. N. S. 954.

^(v) *Wright v. Hitchcock*, L. R. 5 Ex. 37; *Davenport v. Rylands*, L. R. 1 Eq. 302.

country or was imported from abroad, (y) or whether the sale was to an English or a foreign customer (z) makes no difference; but, if the article was in the first instance manufactured or sold by a licensee of the patentee, it is no infringement for the purchaser to resell it, either within or outside the area comprised by the licence. (a)

Exposure for sale.

It has been held that the mere exposure for sale of an article made according to a patent, without actual proof of sale, is not an infringement; (b) though, on the other hand, it was held by a Court of First Instance that where a defendant had manufactured articles, and his traveller had offered them for sale, though he had not actually sold any, there had been such a use as to amount to an infringement. (c)

A mere loan of a patented article, without any intention of selling it or evading the patent, is no infringement. (d)

Purchase of a patented article without restrictions,

Any person who purchases an article made under a British or a foreign patent, whether in this country or abroad, which is sold without any restrictions on the buyer, acquires an absolute right to resell it or otherwise deal with it as he pleases, and he is at liberty to sell it in any country where there is a patent in the possession of, and owned by, the vendor. (e) Also a purchaser of a patented article, without notice of an exclusive licence for a limited area, is not affected by the licence, and cannot be restrained from using the machine within the area; (f) but a licence to manufacture an article under a foreign patent in a foreign country does not imply permission to sell or use the article in this country in violation of an English patent. (g)

or notice of a licence.

(y) *Walton v. Lavater*, 8 C. B. N. S. 162; *Elmslie v. Boursier*, L. R. 9 Eq. 217; *Von Heyden v. Neustadt*, L. R. 14 Ch. D. 230; *Société Anonyme des Manufactures de Glaces v. Tilghman's Sand Blast Co.*, L. R. 25 Ch. D. 1; *Carlsburn Sugar Refining Co. v. Sharp*, 1 P. O. R. 181; *United Telephone Co. v. Sharples*, 2 P. O. R. 31; 26 Ch. D. 164.

(z) *United Telephone Co. v. Sharples*, L. R. 29 Ch. D. 164, 167.

(a) *Smith v. Buchanan*, 26 S. J. 347; p. 333 *ante*.

(b) *Minter v. Williams*, 4 A. & E. 251.

(c) *Oxley v. Holden*, 8 C. B. N. S. 666; 30 L. J. C. P. 68; p. 412 *ante*.

(d) *United Telephone Co. v. Henry*, 2 P. O. R. 11.

(e) *Per Cotton, L.J., Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.*, L. R. 25 Ch. D. 9; *Betts v. Wilmott*, L. R. 6 Ch. 239.

(f) *Heap v. Hartley*, 5 P. O. R. 603.

(g) *Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.*, L. R. 25 Ch. D. 1.

A licence to manufacture a patent article is an authority to the vendees of the licensee to vend it without the consent of the patentee, and their doing so is no infringement,^(h) whether they do so inside or outside the area comprised in the licence; for a purchaser from a licensee, whether special or general, acquires the patented article for all purposes, and can exercise every right of ownership in respect of it.⁽ⁱ⁾

Effect of licence.

The use of a patented process for a purpose different to that for which the patentee uses it may constitute an infringement,^(l) and to adopt a combination of machinery which originally was directed to one purpose to make it minister to another and additional purpose, is an infringement of the patent which first introduced that combination, provided there is no invention involved in the adaptation.^(l)

Use of patented process or machine for purpose different to that for which the patentee uses it.

The use of an article which will amount to an infringement of a patent for its production may be either active or passive; ^(m) and the mere possession of an article made in infringement of a patent, if there is an evident intention to use it, is sufficient to entitle the patentee to an injunction.⁽ⁿ⁾

Use may be active or passive.

Possession of an article made by infringement.

Thus, an injunction was granted to restrain the master of a ship from using an invention for pumps, although he denied having used any pumps which were an infringement of the patent, and did not suggest that the owners ought to be parties. It was shown in evidence that the ship was fitted up exclusively with pumps which were an infringement of the patent, but had been so fitted up before the defendant, who was not a part owner, had command of her, and that he had nothing to do with putting them on board, and they had never been worked in British waters. The majority of the Court of Appeal held that the defendant, being in command of a ship exclusively fitted with pumps which were an infringement of the patent, was intending to use the invention.^(o)

^(h) *Thomas v. Hunt*, 17 C. B. N. S. 183.

⁽ⁱ⁾ *Smith v. Buchanan*, 26 S. J. 347.

^(k) *Cannington v. Nuttall*, L. R. 5 E. & I. App. Cas. 205.

^(l) *Ibid.* p. 230.

^(m) *Caldwell v. Vanvlissenger*, 9 Hare, 415; *Betts v. Neilson*, 3 De G. J. & S. 82.

⁽ⁿ⁾ *Adair v. Young*, L. R. 12 Ch. D. 13; *Proctor v. Bayley*, 6 P. O. R. 106; *United Telephone Co. v. London and Globe Telephone and Maintenance Co.*, L. R. 26 Ch. D. 766.

^(o) *Adair v. Young*, L. R. 12 Ch. D. 13.

And where certain defendants, a telephone company, contracted with an American agent for the purchase of a number of telephones, and were supplied accordingly with instruments containing *Blake* transmitters, the subject of both English and American patents, which they kept unused in a warehouse, the Court held that they had infringed the English patent, notwithstanding that they had dismantled the telephones by taking out the *Blake* transmitters, and kept the different parts stored separately.(p)

Failure to carry out an agreement.

It is no answer to the charge of infringement for the defendant to say that he committed the acts complained of because the plaintiff failed to carry out an agreement whereby the plaintiff undertook to supply him with articles made according to the patent.(q)

Use of invention in foreign vessel.

The use of an invention for the purpose of the navigation of a foreign vessel within the jurisdiction of any of her Majesty's Courts in the United Kingdom or the Isle of Man, is no infringement in respect of which the patentee can obtain an injunction.(r) Neither is the use of an invention in a foreign vessel within the jurisdiction of the same Courts, provided it is not used therein for, or in connection with, the manufacture or preparation of anything intended to be sold in, or exported from, the United Kingdom or the Isle of Man.(s)

The above provisions do not extend to vessels of any foreign State of which the laws authorise subjects of such foreign States, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign State, or in the waters within the jurisdiction of its Court, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign State.(t)

Infringement by transshipment of articles made abroad.

In *Betts v. Neilson*,(u) which was an action brought for the

(p) *United Telephone Co. v. London and Globe Telephone and Maintenance Co.*, L. R. 26 Ch. D. 766.

(q) *United Telephone Co. v. Tasker*, 5 P. O. R. 628.

(r) 46 & 47 Vict. c. 57, s. 43, ss. 1.

(s) *Ibid.*

(t) 46 & 47 Vict. c. 57, s. 43, ss. 2.

(u) L. R. 5 E. & I. App. 1.

infringement of an *English* patent for the manufacture of a combined metal to be (amongst other purposes) applied as capsules to put on bottles, the House of Lords held that the defendant, who resided in *Scotland*, and purchased capsules, made according to the patent from a foreign manufacturer, and *in Scotland* put them on beer bottles, which he sent to *England* for *transshipment and exportation*, was by the user of the capsules, while the beer remained in England, guilty of an infringement of the patent, and this notwithstanding that there was no evidence to show that the beer was sold in England for consumption there.

But in *Varasseur v. Krupp*,^(x) where it appeared that certain shells made in Germany for the Mikado of Japan, according to an *English* patent, were brought to this country to be placed on board a ship belonging to the Mikado, it was held that the Court could not interfere to prevent him removing the shells. The ground of this decision was that the Court has no jurisdiction to interfere with the property of a foreign Sovereign; otherwise foreigners are subject to the laws of the country in which they happen to be, and if a foreigner in England infringes an English patent, he may be restrained by the injunction of the Court.^(y)

In *Nobel's Explosives Co. v. Jones, Scott, & Co.*^(z) it appeared that the plaintiffs were the owners of an English patent for an invention for rendering nitro-glycerine less dangerous, and that certain foreigners imported into England an article compounded of nitro-glycerine and other substances, which they had manufactured abroad according to the patent, and the respondents, acting as Custom House agents for the importers, passed the article through the Custom House, and obtained permission ^(a) to land and store it in magazines belonging to the importers. The House of Lords held, affirming the decision of the Court of Appeal, that the respondents being only Custom House agents for the importers, and not themselves the importers, and having neither possession of, nor control over the goods, their acts did not amount to an exercise or use

^(x) L. R. 9 Ch. D. 351.

^(y) *Caldwell v. Van Vliссengen*, 9 Hare, 415; 21 L. J. N. S. Ch. 97.

^(z) L. R. 5 App. Cas. 5.

^(a) As required by the Explosives Act, 1875.

of the patent, and that no action could be maintained against them for infringement.

Infringements
prior to grant
of letters pa-
tent.

Every patent is dated and sealed as of the day of the application, but no proceedings can be taken in respect of an infringement committed before the publication of the complete specification ;(b) and after the acceptance of a complete specification until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, an applicant has the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification, but he is not entitled to institute any proceedings for infringement unless and until a patent has been granted to him.(c) Consequently, until the patent is actually granted, no proceedings in respect of infringements can be taken at all, nor even then in respect of any committed before the publication of the complete specification,(d) but in an action brought subsequently to the grant of the patent relief may be obtained in respect of infringements committed during the interval between the publication of the complete specification and the date of the grant as well as in respect of infringements committed since the grant.

Infringements
pending ap-
peal.

If a patentee brings an action for infringement against any member of the public, it is open to the defendant to give evidence showing that the patent is invalid; (e) and, if the Court be of opinion that such is the case, a declaration of invalidity will be the result ; also it is open to any member of the public, either of right or on obtaining the sanction of the Attorney-General in England or Ireland, or the Lord Advocate in Scotland, to obtain a declaration of invalidity on presentation of a petition to the Court.(f) The patentee has the right to appeal to the Court of Appeal and the House of Lords from the decision of the Court of First Instance declaring the patent void either in an action for infringement or petition for revocation, and, if the decision be reversed, the patent will not be revoked. It is submitted that any act done by a member

(b) 46 & 47 Vict. c. 57, s. 13.
(c) 46 & 47 Vict. c. 57, s. 15.
(d) 46 & 47 Vict. c. 57, s. 10.

(e) p. 341 *ante*.
(f) p. 343 *ante*.

of the public during the interval between a decision of a Court of First Instance adverse to the patent and its reversal on appeal which would be an infringement had the patent not been declared void, is in fact an infringement which entitles the patentee to damages or an account, because the decision of the Court of Appeal or House of Lords, as the case may be, gives validity to the patent *ab initio*; but it is further submitted that if the defendant could show that what he did was done in reliance on the former decision the plaintiff would only be entitled to nominal damages. (g)

A patentee can sustain an action in respect of a threatened infringement of his patent, even though no actual infringement has taken place, for if a person threatens to do an act amounting to an infringement it is sufficient to found an action for an injunction. (h) The mere offer, however, to supply an article for the production of which there is an existent patent, which does not lay claim to the production of every kind of such article, in the absence of evidence of positive infringement, is not sufficient to support an application for an injunction. (i)

Threatened infringements.

Proceedings before Commencement of Action.

When a patentee becomes aware of the fact that several persons are infringing his patent he is in a somewhat awkward position, for he cannot join all the infringers as defendants in one action, (j) and, if he issues separate writs simultaneously against all the infringers, he will have to uphold the validity of his patent in several distinct proceedings, in each of which he may have to meet different objections, and he may be guilty of the charge of oppressive litigation. On the contrary, if he singles out an infringer and establishes his patent against him first, as regards the others they are not bound by the decision in the first action, and may raise the question of validity anew, and the conduct of the plaintiff may be construed by the Court to amount to laches, and so disentitle him to interlocutory

Patentees' position on discovering several infringers.

(g) See *Arkwright v. Nightingale*, 1 W. P. C. 60.

(h) *Freason v. Lee*, L. R. 9 Ch. D. 48. 66; *Dowling v. Billington*, 7 P. O. R. 191.

(j) *Gynne v. Drysdale*, 2 P. O. R. 160; S. C. on appeal, 3 P. O. R. 65.

(i) pp. 424, 554 *post*.

injunctions against the other infringers, to which, having previously established the validity of the patent, he would have been entitled had he commenced action against them earlier.^(k) In such a state of circumstances the proper course for a patentee to pursue is that suggested by Lord Hatherley, then Vice-Chancellor Wood,^(l) viz., after getting information of case after case of infringement to select that which he thinks the best, in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction. At the same time, he should write to all the others who are *in simili casu*, and say to them: "Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise I shall proceed against you by way of interlocutory injunction, and if you will not object on the ground of delay, I do not mean to file bills against all of you at once. Am I to understand that you make no objection of that kind? If you do not object I shall file a bill against only one of you."

His proper course.

Proceedings before commencement of action.

It is usual and proper for a patentee, before commencing proceedings in respect of an infringement of the patent, to apply to the alleged infringer, warning him not to continue the acts complained of, and asking him voluntarily to afford the relief which, in the event of the patentee bringing an action and succeeding, he would claim from the Court, though he is by no means bound to do so, and is entitled to commence his action without making any such demand.^(m) Neither is he bound to rely on the infringer's promise not to repeat the wrongful act, but he is entitled to the injunction of the Court in aid of his legal rights,⁽ⁿ⁾ though, if his conduct is oppressive, he may lose the costs of the action.^(o) The Court does not, as a rule, take notice of negotiations between the parties preliminary to the issue of the writ, unless they amount to an accord and satisfaction, or release and binding agreement in

(k) p. 456 *post*.

(l) *Bovill v. Crato*, L. R. 1 Eq. 391.

(m) *Upmann v. Elkan*, L. R. 12 Eq. 146; *Upmann v. Forester*, L. R. 24 Ch. D. 231; *Burgess v. Hills*, 26 Beav. 244, 247; *Burgess v. Hatley*, 26 Beav. 249.

(n) *Losh v. Hague*, 1 W. P. C. 200; *Geary v. Norton*, 1 De G. & S. 9; *Nunn v. D'Albuquerque*, 34 Beav. 595; *Upmann*

v. Forester, L. R. 24 C. D. 231; *Nicholls v. Pitman*, L. R. 26 Ch. D. 374; *Wittmann v. Oppenheim*, L. R. 27 Ch. D. 260; *Fradella v. Weller*, 2 Russ. & My. 247; *Procter v. Bayley*, 6 P. O. R. 106.

(o) *Nunn v. D'Albuquerque*, 34 Beav. 595; *Hudson v. Bennett*, 14 W. R. 911; *Smith v. Roberts*, 5 P. O. R. 611; p. 421 *ante*.

relation to the cause of action, or the proceedings are tainted with a lack of good faith.(p)

Though a patentee has an undoubted right of action against an infringer who infringes, whether in ignorance of the patent or not, it does not follow, as a matter of course, that he will in all cases succeed in obtaining an injunction or costs of the action. Patentee though successful in the action does not always obtain an injunction.

Thus, where a defendant unknowingly sold a few articles in infringement of a patent, but gave the plaintiff full information as to where he had obtained the articles complained of, and promised not to sell any more, a Bill for an injunction was dismissed, and he was left to his remedy in damages.(q)

In another case, where it appeared that the plaintiff had obtained possession of certain instruments admitted to be made in infringement of his patent, but that the defendant had never intended to sell them, and relied on an undertaking for their return, the action was dismissed with costs, but an order was refused for the return of the instruments to the defendant.

And in a case tried in Scotland, where the facts were that the defendant admitted infringement before the action, but had discontinued and offered to pay damages in respect of such infringement, and the action was brought in respect of a different article, which was not an infringement, the Court refused an interdict, and, notwithstanding the previous admitted infringement, condemned the plaintiff in the costs of the action.(r)

And when it appeared that there had been only one infringement, which had been discontinued, the Court of Appeal held that in the absence of any evidence of the defendant's intention to continue the unlawful act an injunction should be refused.(s)

Parties.

All persons interested in a patent should be made parties to an action for infringement, either as co-plaintiffs or, if they refuse to join, as defendants, in order that the infringing Proper parties.

(p) *Edleston v. Edleston*, 1 De G. J. & S. 203; *Davenport v. Rylands*, L. R. 1 Eq. 305.

(q) *Betts v. Willmott*, 16 W. R. 1 Eq. 305; see also *Ulmann v. Elkan*, L. R.

12 Eq. 145; *Thomson v. Baker*, 3 Times Rep. 715.

(r) *Fletcher v. Glasgow Gas Commissioners*, 4 P. O. R. 386.

(s) *Procter v. Bayley*, 6 P. O. R. 538.

defendants may not be called upon to account twice, first to the plaintiff and then to the other defendants who claim an interest.^(t)

Mortgagor.

The mortgagor of a patent is entitled to sue in respect of an infringement in his own name without joining the mortgagee as plaintiff, and the mortgagee does not possess such an interest in the patent as to make it necessary that he should be joined as a defendant.^(u)

The mere agent of a foreign patentee cannot, in his own name, maintain an action of infringement.^(v)

Misjoinder or nonjoinder of parties.

It is provided by the Supreme Court Rules, of 1883,^(y) that no cause or matter shall be defeated by reason of the misjoinder or nonjoinder of parties, and the Court may in every cause or matter deal with the matter in controversy so far as regards the rights and interests of the parties actually before it, and the Court or a judge may, at any step of the proceedings, either upon or without the application of either party, and on such terms as may appear to the Court or a judge to be just, order that the names of any parties improperly joined, whether as plaintiffs or as defendants be struck out, and that the names of any parties, whether plaintiffs or defendants, who ought to have been joined, or whose presence before the Court may be necessary in order to enable the Court effectually and completely to adjudicate upon and settle all the questions involved in the cause or matter be added.

The above rule does not authorise the amendment of the pleadings by allowing a plaintiff who has no right to sue to amend by joining as co-plaintiff a person who has a right to sue.^(z)

Transfer of plaintiff's rights during the progress of an action.

In a case where it appeared that the plaintiff's rights had during the progress of the trial been transferred to a company, leave was given to add the company as plaintiffs, but the right was reserved to the defendant, if he thought fit, to have

^(t) *Westhead v. Keene*, 1 Beav. 287, 295; *Bergman v. MacMillan*, L. R. 17 Ch. D. 423; *Hindmarch on Patents*, p. 308.

^(u) *Van Gelder Apsimon & Co., Limited, v. The Sowerby Bridge Flour Society, Limited*, 7 P. O. R. 208.

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

^(y) S. C. R. 1883, Ord. xvi. r. 11.

^(z) *Walcott v. Lyons*, L. R. 29 Ch. D. 584; *Van Gelder Apsimon & Co. v. The Sowerby Bridge Flour Society, Limited*, 7 P. O. R. 41, 45; but see 7 P. O. R. 208.

the trial postponed, although the fact of the transfer was known to him when he put in his statement of defence ;(b) but where the defence was that the defendant had not infringed before the assignment of the patent to the plaintiffs, leave, at the trial, was refused to add as co-plaintiffs the predecessors in title of the plaintiff,(c) as likewise was an order for leave to add as defendants the assignees of the defendants where it appeared that the assignment had been made pending the action.(d)

Any person who infringes or takes part in the infringement of a patent may be made a defendant to an action, and held responsible for his acts, whether he be a principal or an agent ; and it is no justification for a servant to say that his master ordered him to commit the infringement ;(e) nor can the master avoid liability for the acts of his workmen and servants by saying that he gave them directions not to violate the patent, for the principal is always responsible for the acts of his agent which are not done in excess of his authority.(f)

The directors of a company may be made personally liable, both in damages and costs of the action, for infringements carried out under their direction by the workmen employed by the company.(g) Of course the company could be made a defendant also.

Foreigners resident in Great Britain or the Isle of Man are responsible for any infringement of a British patent, just as they are for the infraction of any British law, and they may be made defendants to infringement actions.(h)

The usual form in which injunctions are granted against infringers restrains the defendant, his servants, agents, or workmen from continuing the acts complained of.(i)

(b) *Ruston v. Tobin*, 49 L. J. Ch. 262.
(c) *Nobel's Explosives Co. v. Jones*, 42 L. T. N. S. 754.

(d) *Briggs v. Lardner*, 2 P. O. R. 13
(e) *Betts v. De Vitre*, 11 Jur. N. S. 11 ; *Adair v. Young*, L. R. 12 Ch. D. 19 ; *Betts v. Neilson*, 6 N. R. 221 ; *Denley v. Blore*, 38 Lond. Jour. 224.

(f) See *Sykes v. Howarth*, L. R. 12 Ch. D. 826 ; *Betts v. De Vitre*, L. R. 3 Ch. App. Cas. 429 ; *Gregory v. Piper*, 9 B. & C. 591 ; *Whatman v. Pearson*, L. R. 3 C. P. 422 ; *Sharrod v. London and North-Western Ry. Co.*, 4 Exch. 580,

587 ; *Gordon v. Rolt*, 4 Exch. 365 ; *Lyons v. Martin*, 8 A. & E. 512 ; 3 N. & P. 509.

(g) *A.-G. v. Vestry of Bermondsey*, L. R. 23 Ch. D. 60 ; *Mathias v. Yates*, 46 L. T. N. S. 497 ; *Betts v. De Vitre*, Jur. N. S. 9 ; L. R. 3 Ch. App. Cas. 441 ; *Spencer v. The Ancoats Rubber Co.*, 6 P. O. R. 46.

(h) *Caldwell v. Van Vlissingen*, 21 L. J. N. S. Ch. 97 ; 9 Hare, 415 ; *Vavasseur v. Krupp*, L. R. 9 Ch. D. 351.

(i) Seton, p. 352.

Manufacturers
and users.

In cases where a plaintiff succeeds in obtaining a verdict against both the manufacturer and the person who uses an article made in infringement of his patent, he is entitled not only to an account against the former, but also to damages against the latter. (*k*)

Infringements
of the same
patent by
different
persons.

Infringements
of several pa-
tents by one
person.

Manufacturers, and persons who have purchased from him, may be sued as defendants in the same action; (*l*) but in other cases of separate infringements of the same patent by different persons separate actions must be brought against each individually; (*m*) though where one person has infringed several patents belonging to the plaintiff he may be sued in respect of all the infringements in one action. (*n*) A plaintiff who brings several actions against the same defendant in respect of infringements of several patents will probably be allowed only the costs to which he would have been entitled had he included all the infringements in one action. (*o*)

Defendant in-
demnified by
third party.

In an action for infringement against a person to whom an indemnity had been given by the manufacturers, and where such person gave notice under the third party procedure (*p*) claiming indemnity, and the manufacturers put in an appearance, it was held that the proper order to be made was that, on the manufacturers admitting their liability to indemnify the defendants, they should be at liberty to appear at the trial and take such part therein as the judge should direct, and that they should be bound by the decision of the Court in the action in any question as to the above indemnity as might arise between them and the defendants, but not further or otherwise. (*q*)

The Court of Appeal held that no injunction could be granted against such manufacturers brought in under the third party rules, as they were not made defendants, and leave to amend was refused, but they were ordered to pay the costs of the action. (*r*)

(*k*) *Penn v. Bibby*, L. R. 3 Eq. 308; 36 L. J. Ch. 277; *United Telephone Co. v. Walker*, 4 P. O. R. 67.

(*l*) *Proctor v. Dennis*, L. R. 36 Ch. D. 740; *United Telephone Co. v. Walker*, 4 P. O. R. 67.

(*m*) *Dilly v. Doig*, 2 Ves. 486.

(*n*) *Lister v. Wood*, Seton, 3rd ed. p. 909

(*o*) *United Telephone Co. v. Sharples*, 2 P. O. R. 28.

(*p*) S. C. R. 1883, Ord. xvi. r. 48.

(*q*) *Edison v. Holland*, 3 P. O. R. 397.

(*r*) *Edison v. Holland*, 6 P. O. R. 243.

When goods are made in infringement of an English patent, and shipped from abroad, the consignees are proper defendants to an action, and where they were resident out of the jurisdiction of the Court leave was given to serve the writ out of the jurisdiction.^(s)

Consignees of goods shipped from abroad.

Pleadings.

The usual pleadings in an action for the infringement of a patent, after service of the writ,^(t) are a statement of claim, particulars of breaches, a statement of defence, particulars of objections, and reply.

Pleadings.

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

Trial without formal pleadings.

If the parties to a patent action adopt this course, it is submitted, they will not be exempted from the necessity of delivering particulars of breaches and particulars of objections, but these will be required, as was the case where issues were directed under the old practice by the Court by Chancery.^(v)

Statement of Claim.

In the statement of claim the patentee should allege the grant of the patent, and if his title is a derivative one it should be clearly stated.

Allegation of grant and title.

It is not necessary to allege that the invention was new at the date of the patent, since the allegation of the grant and the production of the letters patent themselves throws on the defendant the *onus* of disputing the novelty.^(w)

Not necessary to allege novelty,

It is common to state in the statement of claim that the letters patent are, and since the grant thereof always have been, valid and subsisting, but this is not necessary, and the

or validity,

^(s) *The Washburn and Moen Manufacturing Co. v. The Cunard Steamship Co.*, 6 P. O. R. 398; *Massey v. Haynes*, L. R. 21 Q. B. D. 330.

^(t) For forms of indorsement of the writ, see Appendix.

^(u) S. C. R. 1883, Ord. xxxiv. r. 9.

^(v) *Order in Davenport v. Jephson*, Seton, p. 346; *Bovill v. Smith*, W. N. 1867, p. 240; 46 & 47 Vict. c. 57, s. 29; p. 437 *post*.

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

allegation is not contained in the form given in the Appendix to the Supreme Court Rules, 1883.(a)

or to set out the specifications.

It is not necessary to set out in the statement of claim either the whole or any portion of the specifications,(b) though this was usually done in Bills in Chancery under the old practice.

Disclaimers should be alleged.

If any disclaimer has been entered at the Patent Office, this fact, with the date, should be alleged in the statement of claim.

Sufficient case to justify relief asked must be stated.

The statement of claim must state a sufficient case to justify the injunction asked ; (c) and must not set out a separate and different cause of action to that endorsed on the writ.(d)

Particulars of Breaches.

Allegation of infringement.

The allegation of infringement in the statement of claim need only be in general terms, for it is specially enacted that the plaintiff must deliver with his statement of claim, or by order of the Court or the judge at any subsequent time, particulars of the breaches complained of ; (e) and at the hearing no evidence can, except by the leave of the Court or a judge, be admitted in proof of any alleged infringement of which particulars have not been given ; (f) but the Court or a judge has power from time to time to grant leave to amend particulars.(g)

Amendment.

Any party desiring an amendment of the particulars of breaches or objections in an action for infringement must satisfy the Court that he is really placed in a difficulty by the particulars as they stand.(h)

Where, on a motion for further and better particulars, it appeared that the plaintiff had stated that he was unable to give further particulars till he had obtained discovery from the defendant, the motion was ordered to stand over till after the defendant had given discovery.(i)

Particulars of breaches must be reasonable and proper.

The plaintiff must take care that the particulars which he

(a) S. C. R. 1883, Appendix C., Form 6.

(b) *Kay v. Marshall*, 2 W. P. C. 39 ; *Westhead v. Keene*, 1 Beav. 287 ; S. C. R. 1883, Appendix C., Form 6.

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

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

(e) 46 & 47 Vict. c. 57, s. 29, ss. 1. For forms of particulars of breaches see Appendix.

(f) 46 & 47 Vict. c. 57, s. 29, ss. 4.

(g) 46 & 47 Vict. c. 57, s. 29, ss. 5.

(h) *Haslam v. Hall*, 4 P. O. R. 203, 207, per Wills, J.

(i) *Russell v. Hatfield*, 2 P. O. R. 141.

furnishes are reasonable and proper ones, otherwise he will fail to obtain the certificate of the Court or a judge, which is necessary to entitle him to the costs of such particulars on taxation. (*k*)

Particulars of breaches are sufficient if, taken together with the pleadings, they give the defendant fair notice of the case to be made against him. (*l*)

Sufficient if, taken with the pleadings, they give the defendant notice of the case to be made against him.

Thus, where the pleadings stated that the defendant's machine included a certain new and important combination which was the plaintiff's invention, and the particulars of breaches simply pointed to certain specified machines, and stated in general terms that these infringed the patent, they were held to be sufficient, in spite of the contention that the plaintiffs ought to specify precisely in what respect the defendant's machines were an infringement. (*m*) Again, where the particulars of breaches specified a particular article as an infringement, the Court, being of opinion that the defendants must know whether and in what respect he had infringed, refused to compel the plaintiff to specify the persons with respect to whom, and the occasions on which, the infringement occurred, or to order him to point out the particular parts of the specification alleged to have been infringed. (*n*) And where the alleged infringement is an exhibit in the case, it has been held not to be necessary that the particulars of breaches should point out the precise portion of the specification alleged to have been infringed. (*o*)

Where a specification describes two processes wholly distinct from each other, and the defendant's process is capable of being an infringement of the one, but not of the other, particulars of breaches in general terms would not be sufficient. (*p*) And if the specification contain a description of a number of articles, all of which are the subject of the invention, the particulars

Must state how plaintiff's invention has been infringed.

(*k*) 46 & 47 Vict. c. 57, s. 29 (6).

(*l*) *Needham v. Oxley*, 1 H. & M. 248; *Petman v. Bull*, 3 P. O. R. 390; S.C. reported in *Ledgard v. Bull*, L. R. 11 App. Cas. 648; *Cheetham v. Oldham* (No. 3), 5 P. O. R. 624.

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

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

See also *Moseley v. Victoria Rubber Co.*, 3 P. O. R. 351.

(*o*) *Batty v. Kynock* (No. 2), L. R. 19 Eq. 229; *Needham v. Oxley*, 1 H. & M. 248; *Perry v. Mitchell*, 1 W. P. C. 269.

(*p*) *Talbot v. La Roche*, 15 C. B. 310; *Patent Type Founding Co. v. Richards*, 2 L. T. N. S. 359.

must point out which part of the specification has been infringed.(*q*)

Thus, where the specification contained a description of thirteen different sorts of pens, the plaintiff was ordered to point out specifically which particular pens shown in the drawing he alleged to have been infringed.(*r*)

Must specify claims infringed.

The defendant is entitled to a statement in the particulars of breaches as to which one or more of several claims in the specification he is charged with having infringed ;(*s*) but it is sufficient if the particulars refer to pages and lines of the specification without direct mention of the claiming clauses.(*t*)

Pages and lines.

Provided the particulars of breaches give the defendant a fair idea of the case to be made against him, they will be sufficient if they refer to specific claims, and specify certain machines of the defendant as infringements of those claims and it is not necessary that they should state by reference to pages and lines what portion of the specification has been infringed ;(*u*) though if the invention is a complicated one, or the defendant has any other sufficient grounds for requiring the information in the preparation of his defence, the plaintiff may be compelled to furnish particulars of pages and lines of the specification.(*v*)

Specific instances of infringements and dates.

The particulars of breaches must not merely refer in general terms to acts of the defendant, but must specify definite instances of infringements committed by him, and give at any rate the date of some of the various occasions when the infringements took place, and the names and addresses of the persons (if any) concerned as buyers, &c.(*x*)

Thus, in an action for infringement where the particulars of breaches alleged that the defendants had infringed by importing

(*q*) *Perry v. Mitchell*, 1 W. P. C. 269; *Patent Type Founding Co. v. Richards*, 2 L. T. N. S. 359.

(*r*) *Perry v. Mitchell*, 1 W. P. C. 269.

(*s*) *Haslam v. Hall*, 4 P. O. R. 203.

(*t*) *Elsey v. Butler*, 1 P. O. R. 189.

(*u*) *Walter C. Church Engineering Co. v. Wilson*, 3 P. O. R. 123; *Electric Telegraph Co. v. Nott*, 4 C. B. 462; *Talbot v. La Roche*, 15 C. B. 310; *Batley v. Kynock* (No. 2), L. R. 19 Eq. 229;

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

(*v*) *Lamb v. Nottingham Manufacturing Co.*, cited L. R. 19 Eq. 230; *Wren v. Weild*, L. R. 4 Q. B. 213; *Jones v. Lee*, 25 L. J. Ex. 241.

(*x*) *Murray v. Clayton*, L. R. 15 Eq. 115; *Crossley v. Timney*, L. R. 2 Ch. D. 533; *Sykes v. Howarth*, L. R. 12 Ch. D. 826; *cf. Fowler v. Lloyd*, 45 L. J. Ch. 746; 25 W. R. 17.

into this country, selling, exposing for sale, and otherwise dealing with glass globes, shades, and moons, having their surfaces wholly or in part roughened in a particular way, the judge expressed an opinion that the plaintiffs ought to give two or three specific instances of globes which they alleged to be infringements, but ought to be at liberty to add general words so as not to be confined to such instances at the trial, and his Lordship accordingly made an order for further and better particulars.(y)

In *Walter C. Church Engineering Co. v. Wilson*,(z) the words "in particular and by way of illustration" were held to be too wide, but, on the other hand, in *Haslam v. Hall*,(a) where the particulars of breaches "*by way of example and not of limitation*," alleged certain machines fitted by the defendants on board the "*Selembria*," and "*all machines made by the defendants similar to them*," to be infringements of the plaintiff's patent, the words in italics were allowed to remain, but the plaintiff was confined, so far as concerned machines fitted to ships, to the "*Selembria*," unless he gave further names.

Defence.

In the defence(b) it is open to the defendant to defeat an action for infringement of a patent by proving either that he has not committed any infringement, supposing the patent to be a valid one, or that the patent is, in fact, non-existent, or void, and that the acts complained of are consequently no violation of any right vested in the plaintiff.(c)

The fact that a patent has been questioned and upheld in a former action, does not estop a person questioning it again in a subsequent action, when the parties to the second action are not the same as the parties to the first; and though the plaintiff in both actions is the same, the Court trying the second action is not bound by the decision in the former in favour of the plaintiff, for its operation is not *mutual* as between the

(y) *Tilghman's Patent Sand Blast Co. Limited, v. Wright & Butler Co., Limited*, 1 P. O. R. 103; see also *Talbot v. La Roche*, 15 C. B. 310.

(z) 3 P. O. R. 123.

(a) 4 P. O. R. 203.

(b) For forms of defence see Appendix.

(c) See *Dudgeon v. Thomson*, L. R. 3 App. Cas. 37.

parties to the second action.(*d*) In such a case, however, the Court is bound by the interpretation put on the specification by a Court of equal or superior jurisdiction in the first action.(*e*)

No defence that plaintiff failed to carry out an agreement for supply of patented article.

It is not a valid defence to say that the defendant committed the infringement because the plaintiff failed to carry out an agreement whereby he undertook to supply the defendant with a certain number of the patented machines ; but, in such a case, the injunction of the Court restraining further infringements will only be granted on the terms that the plaintiff undertakes to supply the defendant with a certain limited number of machines in the place of those which the injunction would prevent him from using.(*f*)

Defences should state grounds on which the validity of the patent is disputed.

The defendant should state in his defence the grounds on which he relies if he disputes the validity of the patent, for he cannot at the trial bring forward any ground of defence which is not stated in his pleadings.(*g*)

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

Nature of particulars of objections.

Particulars of objections do not stand in the place of pleas,(*i*) and they cannot go outside the pleas,(*k*) though they must give more detailed information,(*l*) and not be merely reiterations.(*m*) The Court has refused to allow a defendant to contend that the patent was illegal when it appeared that he had only given notice of an objection to that effect, and not specially pleaded it.(*n*)

Sufficient denial of validity.

It is submitted that any objection to the validity of a patent will be properly raised if the defence contains a simple

(*d*) Taylor on Evidence, 5th ed., vol. ii. p. 1444; Sheldon v. A.-G., 30 L. J. N. S. Pr. & Mat. 217.

(*e*) Edison v. Holland, 5 P. O. R. 459; 6 P. O. R. 243; Slazenger v. Feltham, 6 P. O. R. 130; Automatic Weighing Machine Co. v. Combined Weighing Machine Co., 6 P. O. R. 367.

(*f*) United Telephone Co. v. Tasker, 5 P. O. R. 628.

(*g*) Bovill v. Goodier (No. 2), L. R. 2 Eq. 195; see S. C. R. 1883, Appendix D.

(*h*) Plimpton v. Malcolmson, L. R. 3 Ch. D. 531, 536.

(*i*) 438 *post*.

(*k*) Macnamara v. Halse, 2 W. P. C. 128; Jones v. Berger, 1 W. P. C. 544.

(*l*) Bulhois v. Mackenzie, 1 W. P. C. 260; Jones v. Berger, 1 W. P. C. 544; Walton v. Bateman, 1 W. P. C. 616.

(*m*) Neilson v. Harford, 1 W. P. C. 370; Betts v. Walker, L. R. 14 Q. B. 363, 368; Walton v. Bateman, 1 W. P. C. 268 n.

(*n*) Gillet v. Wilby, 1 W. P. C. 270.

denial of the validity of the patent, "on the grounds stated in the particulars of objection delivered herewith;"^(o) but it is advisable that the grounds of objection should appear on the defence itself.

It is open to a defendant in an action of infringement to plead the invalidity of the patent on any one or more of the following grounds:—

Grounds on which invalidity may be pleaded.

- i. The grantee was not the true and first inventor.^(p)
- ii. The alleged invention is not the proper subject matter of a patent.^(q)
- iii. The invention is not useful.^(r)
- iv. The invention is not new.^(s)
- v. The specifications are insufficient.^(t)
- vi. There is some disconformity between the specifications.^(u)
- vii. The letters patent have lapsed previously to the committal of the acts complained of, in consequence of the non-payment of fees, or the period of their duration having expired.^(v)
- viii. Any ground on which the patent might, at the commencement of the Patents, Designs, and Trade Marks Act, 1883, have been repealed by *scire facias*.^(w)
 - a. Letters patent of earlier date than those forming the subject of the action have been granted in respect of the same invention.^(x)
 - b. The letters patent were granted on a false suggestion.^(y)
 - c. The grant of the letters patent was not lawful.^(z)
 - d. Non-compliance on the part of the patentee with the conditions of the letters patent.
 - e. Failure of the essential requisites of novelty or utility.
 - f. Abuse of the privileges granted by the letters patent.

^(o) See order in *Kurtz v. Spence*, 36 Ch. D. 776.

^(p) Chap. II. *ante*.

^(q) p. 4 *ante*.

^(r) Chap. IV. *ante*.

^(s) Chap. III. *ante*.

^(t) Chap. V. *ante*. ^(u) *Ibid*.

^(v) *Ibid.*; p. 448 *post*.

^(w) 46 & 47 Vict. c. 57, s. 26.

^(x) Chap. III. *ante*.

^(y) *Ibid*.

^(z) Chap. II. *ante*.

Not subject-matter.

The objection that the invention is not the proper subject matter of a patent cannot be taken under a plea that the invention is not new,^(b) or under a plea of insufficiency of the specification.^(c)

Not useful.

As we have seen,^(d) the requirement of utility does not arise from any express words in the Statute of Monopolies, but is an inference to be drawn from the common law and the enactment that the monopoly granted must not be "mischievous to the State, or to the hurt of trade, or generally inconvenient."^(e) Though it may be thought that the proper form of plea is to plead the statute, and not merely the want of utility, the practice at common law, which was adopted by the Court of Chancery,^(f) viz., to deny the utility in general terms, is that usually followed.^(g) The defence of want of utility cannot be raised under a plea that the invention is not a new manufacture if the plaintiff objects.^(h)

Not new.

The issue of novelty is quite distinct from that of true and first inventor,⁽ⁱ⁾ for an invention may be a new manufacture within the Statute of Monopolies ^(k) but the patentee may not be the true and first inventor, in which case the patent would be void. The defendant is consequently entitled to have the question of newness of manufacture tried apart from that of newness of invention; ^(l) and a plea that the invention is not the proper subject-matter of letters patent does not raise the issue of novelty.^(m)

In *Walton v. Potter* ⁽ⁿ⁾ it was pleaded that the invention was not a "new manufacture," and the Court held that this plea admitted the invention to be a "manufacture" within the meaning of the statute, and only put in issue the novelty. But in *Spilsbury v. Clough* ^(o) it was held that a plea that the

^(b) *Walton v. Potter*, 1 W. P. C. 597; *Househill Co. v. Neilson*, 1 W. P. C. 677.

^(c) 21 Jac. I. c. 3, s. 6; *Househill Co. v. Neilson*, 1 W. P. C. 677; *Jupe v. Pratt*, 1 W. P. C. 151; *Walton v. Potter*, 1 W. P. C. 597.

^(d) p. 125 *ante*.

^(e) *Morgan v. Seaward*, 1 W. P. C. 197; 21 Jac. I. c. 3, s. 6.

^(f) *Seton*, 4th Ed. p. 347; *Plimpton v. Malcolmson*, L. R. 3 Ch. D. 531, 536.

^(g) *Hindmarch on Patents*, p. 275.

^(h) *Walton v. Bateman*, 1 W. P. C. 623.

⁽ⁱ⁾ *Househill Co. v. Neilson*, 1 W. P. C. 689.

^(k) 21 Jac. I. c. 3.

^(l) *Spencer v. Jack*, 3 De G. J. & S. 346; 11 L. T. N. S. 242; *Househill Co. v. Neilson*, 1 W. P. C. 689.

^(m) *Booth v. Kennard*, 1 H. & N. 527.

⁽ⁿ⁾ 1 W. P. C. 601, 611.

^(o) 1 W. P. C. 255.

invention was not "a new manufacture" was bad, as it left it doubtful whether the objection was that the invention was not new, or that it was not a manufacture within the statute. And in *Bush v. Fox*,^(p) the House of Lords held that a plea to the effect that an invention is not a new manufacture, puts in issue both the novelty of the invention and its being a manufacture. In *Spencer v. Jack* ^(q) the Lord Justices, on Appeal, ordered the questions of newness of invention and newness of manufacture to be tried separately.

Under the practice prior to the Act of 1883, insufficiency of the specification was one of the most frequent objections raised in patent actions. The reason of this was that formerly the letters patent contained a condition requiring the patentee within a stated period to file a specification ascertaining the nature of the invention, and in what manner the same was to be performed under pain of forfeiting the grant altogether.^(r)

Specifications
insufficient.

The form of letters patent at present in use does not contain any condition (though it might do so)^(s) avoiding the grant, if the specification, which is filed previously to the grant, is insufficient. As, however, insufficiency of the specification was a ground on which the repeal of a patent might at the commencement of the Act of 1883 have been obtained by *scire facias*, as being a failure to comply with one of the conditions of the grant,^(t) it is still a ground of defence to an action for infringement under the present practice.^(u)

It was formerly a ground of *scire facias* to deceive the Crown by obtaining a patent by means of a false representation,^(v) and, it is submitted, the Crown is deceived if there is a material difference between the provisional and complete specification; the patent must in such a case have been obtained in respect of an invention which was not foreshadowed in the provisional specification;^(x) and the objection that there is disconformity is consequently a good defence to the validity of a patent.^(y) Moreover, it may be said that the complete

^(p) Macr. P. C. 179.

^(q) 3 De G. J. & S. 346; 11 L. T. N. S. 242.

^(r) See *Arkwright v. Nightingale*, 1 W. P. C. 61.

^(s) See 46 & 47 Vict. c. 57, s. 33.

^(t) p. 347, *ante*.

^(u) 46 & 47 Vict. c. 57, s. 26, ss. 3.

^(v) *R. v. Arkwright*, 1 W. P. C. 66.

^(x) *Curtis v. Platt*, Griff. L. O. C. 53.

^(y) 46 & 47 Vict. c. 57, s. 26, ss. 3.

specification does not particularly describe and ascertain the nature of the invention, if it departs from the terms of the title or of the provisional specification, in which the nature of the invention must be described. It would consequently appear that evidence of a defect in the title and disconformity between the specification, may be tendered under a plea of insufficiency.^(z)

Fresh issues during progress of the action.

The Court will at any time during the progress of an action for infringement allow the defendant to raise a fresh issue on the discovery of facts which could not with due diligence have been discovered before.^(a)

Estoppel.

The defendant in an action for infringement may in consequence of his relationship to the plaintiff be estopped from denying the validity of the patent, *e.g.*, where he is a licensee under a licence granted by deed which contains a recital implying the validity of the patent,^(b) for, the contract being by deed, the failure of the consideration is immaterial, and it is not competent to a defendant by plea to deny the effect of a deed which he has executed.^(c) The incapacity of a licensee to deny the validity of the patent against the licensor, terminates with the termination of the licence, and he is then in exactly the same position as any other member of the public against whom an action of infringement may be brought.^(d)

Persons, other than licensees, may in consequence of their past conduct be estopped from denying the validity of the patent as against the plaintiff. Thus, a patentee who has assigned his patent is estopped from denying its validity in an action for infringement brought by the assignee.^(e)

Although it is a sound principle of law that a grantor cannot derogate from his grant, yet the language of a specification must not be strained against an assignor who happens to

^(z) *Penn v. Bilby*, L. R. 2 Ch. App. 127, 130; but see *Derosne v. Fairie*, 1 W. P. C. 161; *Neilson v. Harford*, 1 W. P. C. 312; *Morgan v. Fuller*, (1) R. R. 2 Ec. 297.

^(a) *Holste v. Robertson*, L. R. 4 Ch. D. 9; S. C. R. 1883, Order xxviii.; p. 439 *post*.

^(b) *Bowman v. Taylor*, 2 A. & E. 278; 1 W. P. C. 292; *Cutler v. Bower*, 11 Q. B. 973; see p. 334 *ante*.

^(c) *Smith v. Scott*, 6 C. B. N. S. 771; 5 Jur. N. S. 1358; *Hall v. Conder*, 2 C. B. N. S. 22.

^(d) *Dangerfield v. Jones*, 13 L. T. N. S. 142; *Axman v. Lund*, L. R. 18 Eq. 330; *Crossley v. Dixon*, 10 H. L. C. 293.

^(e) *Oldham v. Longmead*, cited 3 T. R. 441; *Walton v. Lavater*, 8 C. B. N. S. 162, 187; *Hough v. Chamblain*, 25 W. R. 742; but see 312, 337 *ante*.

be the original patentee and defendant in an action of infringement brought by the assignee ; (f) and he is at liberty to show that the specification is not as wide as the plaintiff alleges.(g) Moreover, an assignor cannot be restrained from assisting, as a scientific witness or otherwise, the defendant in an action brought by the assignee.(h)

A patentee who has worked the patent in partnership with his co-patentee, but has dissolved partnership and assigned the whole of his interest in the patent to his former partner, is estopped from denying the validity of the patent in an action of infringement at the instance of such former co-patentee.(i)

In *Baird v. Neilson* (k) it appeared that Baird had agreed with Neilson to put an end to litigation and pay a royalty for the use of Neilson's patent. Subsequently, Neilson brought an action against Baird for specific performance of the agreement, and Baird, in a cross action, sought to deny that what he was doing was an infringement, but the House of Lords held that the very object of the agreement was to put an end to the question of the particular thing done by Baird being an infringement, and that he was therefore estopped from setting up the defence.

A defendant who has consented to an injunction is, in a subsequent action for breach of the injunction, estopped from denying the validity of the patent.(l)

Where on an action being brought to enforce an agreement the defendants gave an undertaking to the patentee not to sell certain grates, having a patent canopy, without marking them in an agreed manner, it was held, on a motion to commit them for breach of the agreement, which motion was by consent turned into a motion for an injunction, that they were estopped from denying the validity of the plaintiff's patent.(m)

A defendant may be estopped from denying the validity

Defendant may
be estopped
from denying
validity on

(f) *Hocking and Co. v. Hocking*,
6 P. O. R. 69.

(g) *Ibid.*

(h) *London and Leicester Hosiery Co.
Limited v. Griswold*, 3 P. O. R. 250, 253.

(i) *Chambers v. Crichley*, 33 Beav.
374.

(k) 8 C. L. and F. 726.

(l) *Thomson v. Moore*, 6 P. O. R.

441.

(m) *Crossthwaite v. Steel*, 5 P. O. R.
220.

motion for an interlocutory injunction, but not at the trial.

of a patent on a motion for an interlocutory injunction, and yet not be so estopped at the trial.

Thus, where in a previous action judgment and costs had been given against the defendants, Lord Hatherley, then Vice-Chancellor Wood, on the hearing of a suit against the same defendants, for the infringement of the same patent, held that, if the plaintiffs had made an interlocutory application they would have been entitled to an injunction till the hearing, but the question being as to a perpetual injunction, the right of the defendants to deny the validity of the patent was not barred.⁽ⁿ⁾ And again, where it appeared that the patentee had formerly worked the patent in partnership with the defendants under an agreement reciting the patent, and during the partnership the defendants had joined the patentee as co-plaintiff in suits against various infringers, the same judge held that the partnership having been determined, and the defendants having commenced working the invention without the leave of the patentee, the latter was entitled to an interlocutory injunction against them before establishing the patent at law.^(o)

Where it appeared that in a previous action tried in Scotland, and decided in favour of the plaintiff, the defendant had omitted to dispute the validity of the patent, he was not allowed to set up this defence on a motion for an interlocutory injunction in England.^(p) But in an action for the infringement of a patent which had been declared valid in a previous arbitration between the plaintiff and defendant, the Court held that the defendant was not estopped from disputing it at the trial.^(q)

Persons not estopped.

A bankrupt patentee is not estopped from denying the validity of the patent against a purchaser from his trustee in bankruptcy, if there is nothing to show that the purchaser has bought on the faith of any representation made by the patentee.^(r)

⁽ⁿ⁾ *Goucher v. Clayton*, 11 Jur. N. S. 107.

^(o) *Muntz v. Grenfell*, 2 W. P. C. 88, 91.

^(p) *Dudgeon v. Thomson*, 30 L. T. N. S. 244.

^(q) *Newall v. Elliott*, 1 H. and C. 797.

^(r) *Cropper v. Smith*, L. R. 26 Ch. D. 700, 706; 10 App. Cas. 249.

Nor is a person who has worked a patent in partnership with the patentee, and during the partnership asserted its validity against various infringers, but refrained from taking legal proceedings, estopped from disputing the patent in an action brought by the patentee after the termination of the partnership.(s)

Where there are more than one defendant, an estoppel may affect only one of them.(t) Thus, in a case where it appeared that one defendant had, during the existence of a partnership between the plaintiff and the defendant, by his acts barred his right to dispute the validity of the patent against the plaintiff, the other defendant, who was not affected by the acts of his co-partner, was not estopped in an action brought subsequent to the termination of the partnership, from disputing the patent.(u) But where two defendants, disputing in the same interest, sever their defence, and one delivers particulars disputing the validity of the patent, but the other omits to do so, the latter is entitled to the benefit of such particulars, if proved,(v) provided he is not otherwise estopped from denying the validity of the patent.(x)

Particulars of Objections.

It is enacted by the Patents, Designs, and Trade Marks Act, 1883,(y) that the defendant in an action for infringement 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. And if he disputes the validity of the patent, the particulars must state on what grounds he disputes it, and if one of those grounds is want of novelty, they must state the time and place of the previous publication or user alleged by him.

It is also by the same statute (z) further enacted, that at the hearing of an action for infringement, no evidence shall

Must be delivered with statement of defence, or by order of the Court or a judge, at any subsequent time.

Evidence limited.

(s) Axmann v. Lund, L. R. 18 Eq. 330.

(t) Goucher v. Clayton, 11 Jur. N. S. 107; Hugh v. Chamberlain, 25 W. R. 742.

(u) Hugh v. Chamberlain, 25 W. R. 742.

(v) Cropper v. Smith, L. R. 10 App. Cas. 249.

(x) Hugh v. Chamberlain, 25 W. R. 742; Goucher v. Clayton, 11 Jur. N. S. 107.

(y) S. 29.

(z) S. 29.

except by leave of the Court or a judge, be admitted in proof of any alleged objection of which particulars have not been delivered.

Particulars of objections cannot go beyond the pleas.

As we have seen, particulars of objections do not stand in the place of, and cannot go beyond, the pleas raised by the defence; (a) and it is to be noticed that the Act of 1883 requires far more detail in the particulars of objections than in the particulars of breaches complained of by the plaintiff. (b)

Amendment of particulars of objections.

It was decided that the notice of objections required by 5 & 6 Will. IV., c. 83, s. 5, to be delivered by a defendant in an action for infringement were not conclusive at his peril, but the Court or a judge, under their general jurisdiction, as well as under the statute, might order a further and fuller notice. (c)

Under the Act of 1883, the Court or a judge has power to order the amendment from time to time of the plaintiff's or defendant's particulars; (d) and if they are insufficient or too general, the opposite party, if he means to object to them, should at once apply, by summons at chambers or a motion in Court, (e) for an order for further and better particulars, otherwise, where the particulars are too general, evidence within their literal meaning may be admitted. (f) In the words of Mellish, L.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. It is perfectly obvious that if . . . wherever the Court would order further particulars because the objection had not been particularly specified, it would also hold that the party was precluded from raising it at the trial, nobody would be foolish enough to apply to a judge for further particulars." (g)

(a) p. 430 *ante*.

(b) pp. 442, 447 *ante*.

(c) *Bulnois v. Mackenzie*, 1 W. P. C. 260.

(d) S. 29 (5).

(e) Judicature Act, 1873 s. 39; *Fearson v. Lee*, 26 W. R. 138; S. C. R. 1883, Ord. xix. r. 7.

(f) *Hull v. Bollard*, 1 H. and N. 134; *Curtis v. Platt*, 35 L. J. N. S. Ch. 852, 868; *Sugg v. Silber*, L. R. 2 Q. B. D. 493.

(g) *Sugg v. Silber*, L. R. 2 Q. B. D. 495.

The party at whose instance particulars are delivered under a judge's order has, unless the order otherwise provides, the same length of time for pleading after the delivery of the particulars that he had at the return of the summons; and an order for particulars does not, unless the order otherwise provides, operate as a stay of proceedings, or give any extension of time.^(h)

Time for pleading after delivery of particulars of objections.

The party against whom an order for further and better particulars is made may be ordered to pay the costs of the application;⁽ⁱ⁾ and if the party against whom the order is made does not comply with it, the proper course is for the other side to apply to have the insufficient particulars struck out.^(k)

Costs.

Noncompliance.

It is competent for the defendant at any time during the progress of an infringement action, with the leave of the Court or a judge,^(l) to raise a fresh issue on the discovery of facts which could not with due diligence have been discovered before,^(m) and to amend his particulars of objections accordingly, though he may be liable for the costs occasioned by any such amendment.⁽ⁿ⁾

Fresh issues.

The defendant may, even during the progress of the trial, obtain leave on short service of motion to amend his particulars,^(o) if he can show that the fresh evidence he is desirous of adducing could not with due diligence have been discovered earlier.^(p)

The Court will not sanction an amendment, if, on the face of it, it appears that the fresh objection cannot be sustained.^(q)

Where a new trial is obtained the defendant is entitled to give particulars of objections which were not raised at the first trial.^(r)

Objections on new trial.

^(h) S. C. R. 1883, Ord. xix. r. 8; *Boyd v. Farrar*, 5 P. O. R. 33, 36.

⁽ⁱ⁾ *Grover & Baker Sewing Machine Co. v. Wilson*, W. N. 1870, p. 78; *Penn v. Bilby*, L. R. 1 Eq. 548.

^(k) *Flower v. Lloyd*, 20 S. J. 860; *Higgins' Digest*, Supplement p. 78.

^(l) 46 & 47 Vict. c. 57, s. 29, ss. 5.

^(m) *Holste v. Robertson*, L. R. 4 Ch. D. 9; *Otto v. Steel*, 2 P. O. R. 139.

⁽ⁿ⁾ *Renard v. Levinstein*, 13 W. R.

229; 11 L. T. N. S. 505; *Daw v. Eley*, L. R. 1 Eq. 38; *Blakey v. Latham*, 6 P. O. R. 29.

^(o) *Ibid.*

^(p) *Moss v. Malings*, L. R. 33 Ch. D. 603; *Edison Electric Co. v. Sheppey*, 4 P. O. R. 471; *Blakey v. Latham*, 6 P. O. R. 184.

^(q) *Holste v. Robertson*, L. R. 4 Ch. D. 9.

^(r) *Bovill v. Goodier*, 36 L. J. N. S. Ch. 360.

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Usual order.

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The usual order, which is made on an application by the defendant for leave to amend his particulars, gives the plaintiff time within which to elect whether he will discontinue the action, and orders the defendant, in the event of discontinuance, to pay all costs incurred by the plaintiff since delivery of the original particulars of objections, and only allows the objection to be amended in the event of the plaintiff not electing to discontinue, and makes the costs of the application, and consequent on the amendment, the plaintiff's in any event.(s)

The fact that the plaintiff was aware of the existence of the fresh objection which the defendant seeks to raise will not entitle the defendant to an order on any more favourable terms.(t)

Provision as to costs.

When the plaintiff on an application by the defendant for leave to amend his particulars elects at the hearing to proceed with the action, the order merely provides that the costs of the application, and all costs occasioned by the amendment, and costs unnecessarily caused to the plaintiff by reason of the amendment being made, shall be the plaintiff's in any event.(u)

Where a defendant in compliance with an order of the Court had amended his particulars of objections, and made an application for leave to re-amend them by inserting further specified instances of alleged prior use which had come to his knowledge, he was ordered to pay the costs of the application, and the costs arising out of, and consequent on, the re-amendment were reserved ; (v) and where a cause was in the paper for hearing, the defendant was, after giving notice to the plaintiff, allowed to give evidence, by affidavit, of prior user discovered after the cause was in the paper, but the terms imposed insured to the plaintiff an opportunity of filing affidavits in answer, and the costs of, and consequent on, the application were reserved.(x)

Further evidence on appeal.

On an appeal the Court has power to receive further evi-

(s) *Edison Telephone Co. v. India Rubber Co.*, L. R. 17 Ch. D. 137; *Baird v. Moule's Earth Closet Co.*, L. R. 17 Ch. D. 139; *Aveling v. Maclaren*, L. R. 17 Ch. D. 139; *Ehrlich v. Ihlee*, 4 P. O. R. 115, 119; *Parker v. Maignen's*

Filtre Rapide Co., 5 P. O. R. 207; *Darrar v. Purser*, 6 P. O. R. 365.

(t) *Ehrlich v. Ihlee*, 4 P. O. R. 115.

(u) *Parker v. Maignen's Filtre Rapide Co.*, 5 P. O. R. 208.

(v) *Penn v. Bibby*, L. R. 1 Eq. 548.

(x) *Wilson v. Gann*, W. N. 1875, 78.

dence, but if the appeal is from a judgment after trial, this evidence, except as to matters subsequent to the judgment, can be admitted only on special grounds (*e.g.*, the party desiring to tender it has found a lost document), (*y*) and not without special leave. (*z*)

An appellant will not be allowed to give further evidence on appeal, unless, it can be shown that he could not have tendered the evidence at the hearing in the Court below, (*a*) or that the defendant has been misled, (*b*), though he would be allowed to cure a merely formal defect in his title. (*c*)

A patent may be void on account of the disconformity of the specifications, or in consequence of the claim being defective; (*d*) Disconformity of the specifications. but, it is submitted, a defendant relying on either of these grounds cannot dispense with the necessity of delivering particulars of objections, for the Court will not undertake to decide as to the disconformity of the specifications or the validity of the claims without the evidence of witnesses, (*e*) which could not be given unless particulars had been previously delivered. (*f*)

The particulars of objections must be precise and definite, Requisites of particulars of objections. and should not contain a long list of anticipations of which only a few are relied on at the trial; (*g*) but they should give such information as will enable the plaintiff to make the necessary inquiries at any places named. (*h*)

The Act of 1835 (*i*) was the first statute which specifically Object of the particulars of objections. required the delivery of particulars of objections by the defendant to the plaintiff, and this was done, not to limit the defence, but to prevent the patent from being upset by any unexpected turn of the evidence, and to lessen the expense. (*k*) This object is similarly provided for by the Act of 1883. (*l*) The Act of 1835 did not require any further detail in the

(*y*) *Hinde v. Osborne*, 2 P. O. R. 45.

(*z*) S. C. R. 1883; Ord. LVIII. r. 4.

(*a*) *Hinde v. Osborne*, 2 P. O. R. 45; *Walker v. Hydrocarbon Syndicate*, 3 P. O. R. 253; *Blakey v. Latham*, 6 P. O. R. 184.

(*b*) *American Braided Wire Co. v. Thomson*, 5 P. O. R. 113, 118.

(*c*) *Nordenfelt v. Gardner*, 1 P. O. R. 61, judgment of Lindley, L.J.

(*d*) Chap. v.

(*e*) *Arnold v. Bradbury*, L. R. 6 Ch.

App. 706; *Longbottom v. Shaw*, 6 P. O. R. 510.

(*f*) p. 437 *ante*.

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

(*h*) Per Parke, B., *Palmer v. Cooper*, 9 Exch. 236.

(*i*) 5 & 6 Will. IV. c. 83, s. 5.

(*k*) See remarks of Tindal, C.J., *Fisher v. Dewick*, 1 W. P. C. 267; *Curtis v. Platt*, 8 L. T. N. S. 657.

(*l*) S. 29, ss. 2.

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Detail required
in particulars
of objections
under Acts of
1835 and 1852.

defendant's particulars of objections than in the plaintiff's particulars of breaches, but the terms of the subsequent Act of 1852,^(m) which are very similar to, though not quite so general as, the words of the Act of 1883, which regulates the present practice, required that the particulars of objection 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."

Since the Act of 1883 requires greater detail in the particulars of objections than did the Acts of 1835 and 1852, it follows that words which were held to be too general under the latter Acts will be too general under the Act of 1883, which regulates the present practice in patent actions.

Words which
are too general.

Particulars of objection will be too general if, for instance, they allege as an anticipation a user by certain persons specified, and "*divers other persons*,"⁽ⁿ⁾ or "*by other persons* in London and Birmingham,"^(o) or "*at Nottingham and elsewhere*,"^(p) and in such cases the words in italics may be ordered to be struck out. The particulars of objection must state whether the whole of the invention is alleged to have been anticipated, or whether a portion only is old,^(q) and if the invention deals with complicated machinery or with several distinct machines, the particulars must state which particular machines or which portion of the invention has been anticipated.^(r)

General public
knowledge.

The defendant in an action for infringement frequently relies on the invalidity of the patent on the ground that the subject-matter of the alleged invention was matter of general public knowledge before the date of the patentee's application. A defendant who relies on general public knowledge as an objection must be careful not to refer to specific specifications, or other publications, as merely showing the state of general public knowledge, otherwise he may incur the costs of amending his particulars by striking out all such references. It is neither necessary nor proper for him to state in his particulars

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

⁽ⁿ⁾ Galloway v. Bleadon, 1 W. P. C. 268 n; Fisher v. Dewick, 1 W. P. C. 551 n.

^(o) Fowler v. Lloyd, 20 S. J. 860.

^(p) Jones v. Berger, 1 W. P. C. 544; Holland v. Fox, 1 C. L. R. 440.

^(q) Fisher v. Dewick, 1 W. P. C. 264; Russell v. Ledsom, 11 M. & W. 647.

^(r) Boyd v. Farrar, 5 P. O. R. 33.

of objections the books or publications which contain that knowledge, but such general public knowledge should be proved by ordinary evidence, with a reference to well-known books, if necessary.^(s) And if the defendant relies on and states a general user in general terms—*e.g.*, the invention was previously to the patent in question used by persons engaged in the trade to which it refers, “*generally in London and the vicinity thereof*,” he is perfectly justified in so doing, and does not inflict any hardship on the plaintiff, for proof by one person is not sufficient to prove a general user, and the plaintiff in such a case cannot complain of generality of statement, for the more general it is the more the defendant must prove under it.^(t) An allegation of general public user must not, however, be in too wide terms. Thus, in a case in which the defendant’s particulars of objections alleged previous user of the invention by “*carriage-builders generally throughout Great Britain*,” and also by “*various carriage-builders in or near London, Liverpool, Manchester, and Southampton, and various other of the principal towns of Great Britain*,” they were held to be insufficient.^(u) On the other hand, an application which alleged the general user of an invention by a particular class of persons consisting of lace makers at Nottingham, has been held to be sufficient.^(x)

The Court will sometimes allow general words such as “amongst others,”^(y) or “amongst other instances,”^(z) to remain in the particulars of objections, but it will take care that the plaintiff shall not be taken by surprise at the trial.^(a)

In a recent case the defendants by their particulars of objections alleged that the method described by the plaintiff in his specification had been in ordinary and common use for forty years prior to the date of the patent. In further answers to interrogatories they gave a description of the particular

General words which are allowable.

Application for adjournment.

^(s) *Cole v. Squire*, 5 P. O. R. 489; *Holliday v. Heppenstall*, 6 P. O. R. 320; *Automatic Weighing Machine Co. v. Knight*, 6 P. O. R. 302; *Phillips v. Ivel Cycle Co.*, 7 P. O. R. 77.

^(t) *Palmer v. Wagstaff*, 8 Exch. 840; *Jones v. Berger*, 1 W. P. C. 547; *Bentley v. Keighley*, 7 M. & G. 652; 8 Scott N. R. 372.

^(u) *Morgan v. Fuller*, (2) L. R. 2 Eq. 297.

^(x) *Jones v. Berger*, 1 W. P. C. 549.

^(y) *Curtis v. Platt*, 8 L. T. N. S. 657.

^(z) *Penn v. Bibby*, L. R. 1 Eq. 548.

^(a) *Curtis v. Platt*, 8 L. T. N. S. 657, judgment of Wood, V.C.

method they relied on to support their plea of general user. At the trial, evidence was given of another method which had been used at a large number of places, and which appeared to be a complete anticipation of the plaintiff's invention. The plaintiff objected that no particulars had been given of this, and asked that the case might stand over. Kay, J., held that the action must stand over, but at the plaintiff's risk as to costs, and that the defendants (whose witnesses had given many instances of this user) should be allowed to give particulars of further instances. The judge refused an application to the effect that the plaintiff might have a certain time, after the delivery of the fresh particulars, to elect whether he would discontinue the action on paying costs up to the first delivery of particulars, but to get the subsequent costs.^(b)

Time and place of prior publication relied on.

We have seen that the Act of 1852 required the particulars of objections, if prior user was relied on, to state "the place or places at or in which, and in what manner, the invention was alleged to have been used or published prior to the date of the letters patent;"^(c) whereas the words of the Act of 1883 are to the effect that if one of the grounds on which the defendant disputes the validity of the patent is want of novelty, he "must state the time and place of the previous publication or user alleged by him."^(d)

Cases under Act of 1852.

In consequence of the similarity between the wording of these two statutes, the cases decided under the former are important, as bearing on the construction which will probably be placed on the latter enactment as occasion requires.

Flower v. Lloyd.

In *Flower v. Lloyd*^(e) the Court of Appeal held that the particulars of objections could not be required to go beyond the words of the Act, and varied the order of the Court below, which 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 invention had been publicly practised in *England* before the date of the patent, by requiring the defendants to state "the place or places at or in which, and in what manner" the invention was known or publicly

^(b) *Pascall v. Toope*, 7 P. O. R. 125.
^(c) p. 442 *ante*.

^(d) S. 29 (3).
^(e) 46 L. J. Ch. 746; 20 S. J. 860.

practised in *England* before the date of the patent. In pursuance of this order, the defendants delivered particulars alleging prior user by three persons, whose names and addresses were given, and by other persons in *Birmingham* and *London* respectively. On summons for better particulars, the judge held them to be insufficient, and ordered the defendants to give the names and addresses of the other persons in *Birmingham* and *London* by whom the patented process had been previously used, and pointed out that if they could not give further information the words in italics were useless, and ought to be struck out.

It was expressly held that under the Act of 1852 the plaintiff was entitled to the names and addresses (*i.e.*, the present residences) (*f*) of the persons by whom prior user was alleged to have been made, as well as the places where the prior user had taken place; (*g*) and, further, that where the plaintiff or the defendant, as the case might be, made out a proper case, the Court had jurisdiction to order interrogatories to be answered, notwithstanding the provision in the Act for the delivery of particulars. (*h*) And where the defendants objected that there was a prior American patent which had been surrendered; that the invention had been published in certain journals of specified dates, and in sketches and drawings in the Patent Office Library; and also alleged prior user, it was held that better particulars ought to be given, specifying the date, name of patentee, and time of surrender of the alleged American patent, and the pages of the journals, also identifying the drawings, and the order as to prior user ought to be in the terms of *Flower v. Lloyd*. (*i*)

It is to be observed that the Act of 1852 required the *place* and *manner*, &c., of prior publication to be stated in the particulars of objection, whereas the Act of 1883 requires a statement of the *time* and *place* of such prior publication. And it has been held that if a defendant under the latter Act disputes the patent on the ground of want of novelty, he must

(*f*) *Palmer v. Cooper*, 9 Exch. 236.

(*g*) *Birch v. Mather*, L. R. 22 Ch. D. 629.

(*h*) *Ibid.*

(*i*) *Plimpton v. Spiller*, 20 S. J. 859.

Decisions
under Act of
1852.

Difference be-
tween Act of
1852 and Act
of 1883.

state reasonably on what ground, in respect of want of novelty, he disputes it, and he must also state the time and place of the previous publication or user alleged by him.^(k)

Curtis v. Platt.

In *Curtis v. Platt*,^(l) the particulars of objection, which were furnished under an order requiring a statement of "the place where, and the earliest date at which," certain alleged anticipating machines had been made, stated a list of thirteen persons and firms, and that, in all the cases, the user had been at the earliest from 1825 downwards; and, in answer to the contention that they ought to state in each instance the place at which the first machine had been made and the date of making, Lord Hatherley, then Vice-Chancellor Wood, ordered an amendment, on the ground that as regarded the date of user and the place of user of the machines, the defendants were bound to give the plaintiff all the information they themselves possessed.

The defendants in this case were also ordered to amend an objection alleging prior publication in books, &c. with a mere general reference by stating the particular work or document and the volume of that work in which the alleged prior publication was to be found.^(m)

Reference to pages and lines of prior specifications and books relied on.

A defendant who relies on prior specifications,⁽ⁿ⁾ or printed books,^(o) must point out, by reference to pages and lines, what portions of such specifications or books he relies on; ^(p) and where particulars of objection stated, with regard to a certain alleged anticipating specification, "the parts relied upon are the whole specification but more particularly" certain specified portions, an order was obtained requiring their amendment by striking out the words denoting reliance on the whole specification, but the defendant was held to be at liberty to specify other pages and lines beyond those already referred to.^(q)

Statement of disconformity relied on.

If a defendant object that there is a disconformity between the specifications, he may be required to state in what the

^(k) *Fowler v. Gaul*, 3 P. O. R. 247, 250; *Boyd v. Horrocks*, 3 P. O. R. 285; *Darrah v. Purse*, 6 P. O. R. 365.

^(l) 8 L. T. N. S. 657.

^(m) *Ibid.*

⁽ⁿ⁾ *Fowler v. Gaul*, 3 P. O. R. 247.

^(o) *Harris v. Rothwell*, 3 P. O. R. 243.

^(p) See *Grover & Baker Sewing Machine Co. v. Wilson*, W. N. 1870, 78; *Fisher v. Dewick*, 1 W. P. C. 264; *Plimpton v. Spiller*, Higgins' Supplement, p. 79.

^(q) *Harris v. Rothwell*, 3 P. O. R. 243.

disconformity consists, or how the invention described in the complete differs from that described in the provisional specification.^(r) And if it be objected that the complete specification does not sufficiently describe the invention and in what manner the same is to be performed, it is not sufficient for the particulars to state merely that the directions given are not sufficient to enable a workman skilled in the manufacture to which the patent relates to make a machine the subject of the invention, if the defendant is in a position to give better particulars.^(s) But in a case under the Act of 1834 it was held that, if the plaintiff was content to accept as notice an objection that the specification was insufficient, any objection showing insufficiency at the trial might be taken.^(t)

Objection that the specification is insufficient.

The effect of the Act of 1883 and the recent cases is to require far greater detail in the particulars of objections than was formerly necessary, and particulars simply alleging that the specification does not describe the most beneficial method of practising the invention known to the patentee,^(u) or does not sufficiently describe the nature of the invention or the manner in which it is to be performed,^(v) or does not sufficiently distinguish between what is new and what is old,^(w) or that it is calculated to deceive,^(y) or does not sufficiently set forth the nature of the invention,^(z) or that the invention does not produce the effect stated,^(a) which were held sufficient under the old practice, would most probably not be held so now.

Detail required by Act of 1883.

A defendant may be required to state in the particulars of objection, by means of a reference to the claiming clauses of the plaintiff's specification, what portion or portions of the invention or inventions, as the case may be, he alleges have been anticipated and published, and he may be compelled to refer to pages and lines of any anticipating documents which

Reference to claims.

^(r) *Anglo-American Brush Electric Light Corporation v. Crompton*, L. R. 34 Ch. D. 152; *Fisher v. Dewick*, 1 W. P. C. 551, n.

^(s) *Crompton v. Anglo-American Brush Corporation*, L. R. 35 Ch. D. 283; *Leaf v. Topham*, 14 M. & W. 146.

^(t) *Neilson v. Harford*, 1 W. P. C. 332.

^(u) *Jones v. Berger*, 5 M. & G. 208; W. P. C. 546.

^(v) *Heath v. Unwin*, 1 W. P. C. 551 n.

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

^(y) *Neilson v. Harford*, 1 W. P. C. 324 n.

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

^(a) *Heath v. Unwin*, 1 W. P. C. 551 n.

he alleges as publications of any of the plaintiff's claims.(b) Where a specified machine is relied on, it is not necessary to state which of the plaintiff's claims it infringes, as he must be taken to understand his own patent well enough to be able, when he sees the machine, to judge how far it is or is not an anticipation of his invention.(c) And objections which referred to certain specified machines as anticipations of particular claims in the specification were held sufficient, notwithstanding the fact that the owner of some of the machines refused to allow the plaintiff to inspect them, and the defendants were not sure whether some of the others were in existence.(d)

Objection that patent is void on account of non-payment of fees.

Under the practice prior to the Act of 1883, a defendant could, at the trial, take the objection that the patent was improperly stamped, without having raised it in the particulars.(c) It is, however, submitted that, if a defendant now desires to take the analogous objection that the patent is void for non-payment of duties, the particulars must refer to the fact.

Trial.

Jury.

Infringement actions are tried without a jury unless the Court directs otherwise.(f)

As a rule, patent actions do not require the intervention of a jury, and can be more satisfactorily disposed of by a judge alone.(g)

In the words of Lord Selborne, L.C.,(h) "It is to be observed that such cases almost always involve questions of law and fact, not only mixed, but mixed in such a way as to render the extrication of them extremely difficult; secondly, that very often much must depend upon the construction of documents, as to which a jury must take their direction entirely from the judge; thirdly, that much of the evidence in such cases is argumentative and relative to matters of opinion,

(b) *Heath v. Unwin*, 1 W. P. C. 551 n.

(c) *London and Leicester Hosiery Co. v. Higham*, *Lawson on Patents*, 2nd ed., p. 498; *Harris v. Rothwell*, 3 P. O. R. 243; *Fowler v. Gaul*, 3 P. O. R. 247; *Boyd v. Horrocks*, 3 P. O. R. 285; *Boyd v. Farrar*, 5 P. O. R. 33, 36.

(d) *Boyd v. Farrar*, 5 P. O. R. 33, 35.

(e) *Hindmarsh on Patents*, 438, App. Cas.

(f) 46 & 47 Vict. c. 57, s. 28.

(g) *Bovill v. Hitchcock*, L. R. 3 Ch. 417; *Young v. Fernie*, 1 De G. J. & S. 353; *Downes v. Hughes & Co.*, 69 L. T. 150; *Sugg v. Silber*, L. R. 1 Q. B. D. 362.

(h) *Patent Marine Inventions Co. v. Chadburn*, L. R. 16 Eq. 447.

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 a jury. It very rarely happens, if it ever does, that in such cases the practical work is not done by the judge. It very rarely happens, if it ever does, when a 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."

It was held in a case where an application for trial by jury was refused, that if there were a really doubtful question at issue the Court would not decide it for itself.⁽ⁱ⁾ And in a case where the plaintiff opened fraud, but the defendant's counsel protested that this was not raised by the pleadings and asked for a jury, a trial by jury was allowed and the cause was directed to stand over for that purpose.^(k)

Trial by jury cannot be had before a judge of the Chancery Division of the High Court of Justice.^(l) Actions commenced in the Chancery Division must be set down in the general list, if they are to be tried by a jury, to be tried by one of the judges of the Common Law Division.

The judge before whom a case requiring scientific investigation comes for trial, is empowered to send the issues of fact to be tried by an official referee; ^(m) and the Court of Appeal will not interfere with the discretion of a judge of first instance in this matter.⁽ⁿ⁾

The Court has power to, and on the request of either party Assessor. it must, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance.^(o)

In cases where an assessor is called in, the remuneration to be paid to him is determined by the Court, and paid in the same manner as the other expenses of the execution of the Act of 1883.^(p)

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

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

(l) *Warner v. Murdoch*, L. R. 4 Ch. D.

750.

(m) *Judic. Act*, 1873, s. 57.

(n) *Saxby v. Gloucester Waggon Co.*, W. N. 1880, p. 28.

(o) 46 & 47 Vict. c. 57, s. 28.

(p) 46 & 47 Vict. c. 57, s. 28 (3). As to the effect of an assessor's opinion on the judgment of the Court, see *The Beryl*, L. R. 9 P. D. 137, 141.

Trial of issues. Before the repeal of Lord Cairns' Act(*q*) and Sir John Rolt's Act,^(r) the practice had arisen in the Court of Chancery of directing in patent suits the trial of issues relative to the validity of the patent and to the fact of infringement, and, though those Acts are now repealed,^(s) the jurisdiction which they established is not abolished,^(t) but is exercised by both divisions of the High Court of Justice.^(u)

The Court has the power to order any issue of fact in a patent action to be tried before an official referee,^(x) and to order a trial without a jury of any cause, matter, or issue requiring any prolonged examination of documents or accounts, or any scientific or local examination which cannot, in the opinion of the Court or a judge, be tried with a jury,^(y) or at any time to order any cause, matter, or issue to be tried by a judge with a jury, or by a judge sitting with assessors, or by an official referee or a special referee with or without assessors.^(z)

If it appear to the Court or a judge that the issues of fact in dispute in a patent action are not sufficiently defined, the parties may be directed to prepare issues, and, if the parties differ, such issues will be settled by the Court or a judge;^(a) but issues will not be directed unless the Court is satisfied that there is a real question to try,^(b) and most probably not at all, if the motion is opposed by the plaintiff,^(c) or is made after the disclosure of the plaintiff's evidence.^(d)

Questions of law.

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

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

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

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

(*t*) *Sayers v. Collyer*, L. R. 28 Ch. D. 103, 108.

(*u*) 46 & 47 Vict. c. 57, s. 117.

(*x*) 36 & 37 Vict. c. 66, s. 57; *Saxby v. Gloucester Waggon Co.*, W. N. 1880, p. 28.

(*y*) S. C. R. 1883, Ord. xxxvi. r. 5.

(*z*) S. C. R. 1883, Ord. xxxvi. r. 7 u.

(*a*) S. C. R. 1883, Ord. xxxiii. r. 1; see *Seton on Decrees*, 4th ed. p. 347, for the form of issues.

(*b*) *Davenport v. Phillipps*, 5 N. R. 485.

(*c*) *Henderson v. The Runcorn Soap and Alkali Co.*, W. N. 1868, p. 250; 19 L. T. N. S. 377.

(*d*) *Koskell v. Whitworth*, L. R. 5 Ch. 459.

law to be raised for the opinion of the Court, either by special case or in such other manner as the Court or a judge may deem expedient, and all such further proceedings as the decision of such question of law may render unnecessary may thereupon be stayed.(e)

And, subject to the provisions of the first seven rules of Order xxxvi. of S. C. R. 1883, 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.(f)

Trial of questions of fact by different modes.

The Court of Appeal will not readily interfere with a decision of the Court below as to the mode of trial.(g)

It is generally highly inconvenient to try the issues in a patent action separately or before different tribunals,(h) but sometimes great expense may be saved to the litigants by adopting this course.(i) An order for the trial of the issue of infringement by itself, will not be granted, unless the validity of the patent is not only admitted, but admitted in unqualified terms.(k)

The following are instances in which special issues may be directed to be tried separately: Where it is alleged that the specification is ambiguous or vague, the question of sufficiency of the specification may be determined separately and without evidence; (l) or where several users are alleged as anticipations of a patent, all the evidence on one alleged user may be taken before going into the others.(m) Where, at the trial of an action on a patent which had been repeatedly established, and the judge was of opinion that the sufficiency of the specifica-

Instances of trial of special issues.

(e) S. C. R. 1883, Ord. xxxiv. r. 2.

(f) S. C. R. 1883, Ord. xxxvi. r. 8.

(g) *Bovill v. Hitchcock*, L. R. 3 Ch. App. Cas. 417; *Brooke v. Wigg*, L. R. 8 Ch. D. 510, 517; *Williams v. Guest*, L. R. 10 Ch. App. Cas. 467; *Ruston v. Tobin*, L. R. 10 Ch. D. 538; *Wharton v. Boffin*, W. N. 1883, p. 96; *Saxby v. Gloucester Waggon Co.*, W. N. 1880, p. 28.

(h) *Young v. Fernie*, 1 De G. J. & S. 353.

(i) See *Kurtz v. Spence*, 5 P. O. R. 170.

(k) *United Telephone Co. v. Mottershead*, 3 P. O. R. 213.

(l) *The Republic of Bolivia v. The National Bolivian Navigation Co.*, 24 W. R. 361.

(m) *Richardson v. Castrey*, 4 P. O. R. 265.

tion, the utility of the invention, and the fact of infringement had all been proved, he granted an injunction, but ordered an issue as to the novelty of the invention to be tried before a jury.(n) And where the plaintiff admitted that, if the defendant could prove the prior use of a certain article, the patent would be void, the defendant was allowed to call evidence of such prior use, and the action was dismissed accordingly.(o)

Motion for judgment where issues have been tried or questions of fact determined.

Where issues have been ordered to be tried, or questions of fact to be determined in any manner, the plaintiff may set down a motion for judgment as soon as such issues or questions have been determined. If he does not set down such a motion, and give notice thereof to the other parties within *ten days* after the right so to do has arisen, then, after the expiration of such ten days, any defendant may set down a motion for judgment, and give notice thereof to the other parties.(p) And where issues have been ordered to be tried, or questions of fact to be determined in any manner, and some only of such issues or questions of fact have been tried or determined, any party who considers that the result of such trial or determination renders the trial or determination of the others of them unnecessary, or renders it desirable that the trial or determination thereof should be postponed, may apply to the Court or a judge for leave to set down a motion for judgment without waiting for such trial or determination. And the Court or a judge may, if satisfied of the expediency thereof, give such leave upon such terms, if any, as shall appear just, and may give any directions which may appear desirable as to postponing the trial of the other issues of fact.(q)

Motion for judgment on admissions of fact.

Any party may at any stage of a cause or matter where admissions of fact have been made, either on the pleadings or otherwise, apply to the Court or a judge for such judgment or order as upon such admissions he may be entitled to, without waiting for the determination of any other question between the parties; and the Court or a judge may upon such application

(n) *Bovill v. Goodier*, L. R. 2 Eq. 195.

(o) *Badham v. Bird*, 5 P. O. R. 238.

(p) S. C. R. 1883, Ord. xl. r. 7.

(q) S. C. R. 1833, Ord. xl. r. 8;

Fernie v. Young, L. R. 1 E. & I. App. Cas. 63; *Mac lougall v. General Sewage and Manure Co.*, W. N. 1875, 64; *Tangye v. Stott*, 14 W. R. 386.

make such order, or give such judgment, as the Court or judge may think fit.^(r) If a plaintiff moves for judgment under this power on admissions in the pleadings, he is bound by statements made in the defence, and thus where a defendant admitted ten, but denied any further infringements, an inquiry as to damages was limited to the ten admitted infringements.^(s)

It is enacted by s. 56 of the Judicature Act of 1873 that, Reference to official or special referee. subject to any Rules of Court, and to such right as existed at the date of the Act to have particular cases submitted to the verdict of a jury, any question arising in any cause or matter (other than a criminal proceeding by the Crown) before the High Court of Justice or before the Court of Appeal, may be referred by the Court or by any Divisional Court or judge before whom such cause or matter may be pending for inquiry and report to any official or special referee, and the report of any such referee may be adopted wholly or partially by the Court, and may (if so adopted) be enforced as a judgment by the Court.

This power was exercised by Pearson, J., in *Badische Anilin und Soda Fabrik v. Levinstein*,^(t) who directed certain experiments to be made by a special referee for the purpose of advising the Court; by the Court of Appeal in *Moore v. Bennett*,^(u) where it was ordered that a special referee should make experiments to test the capability of a certain machine to cut brushes; and by Kay, J., in *Edison v. Holland*^(v), where it was ordered that certain of the plaintiff's and defendant's witnesses should make experiments in the presence of a special referee, with a view of ascertaining the sufficiency of the complete specification.

Any party to any cause or matter involving the trial of a question or issue of fact, or partly of fact, and partly of law, Trial at assizes. may, with the leave of the judge or judges to whom, or to whose division, the cause or matter is assigned, require the question or issue to be tried and determined at the assizes, or at sittings to be held in Middlesex or London.^(x)

^(r) S. C. R. 1883, Ord. xxxii. r. 6.

^(s) *United Telephone Co. v. Donohoe*,
L. R. 31 Ch. D. 399.

^(t) L. R. 24 Ch. D. 156.

^(u) 1 P. O. R. 129, 133.

^(v) 5 P. O. R. 459, 479.

^(x) 36 & 37 Vict. c. 66, s. 29.

LETTERS PATENT FOR INVENTIONS.

To whatever division of the High Court an action may be attached, if it has been ordered to be tried at the assizes, the judge has no power, except the interests of justice so require, to remit it for trial in London.(y)

Consolidation of Actions.

Actions may be consolidated

When a patentee brings several actions on the same patent against different defendants, they may be consolidated, so that the validity of the patent and any other issues common to all the actions, may be tried once for all in one action; (z) and actions pending in the same division are now to be consolidated in the manner in use before the commencement of the Judicature Act, 1873, in the superior Courts of Common Law.(a)

only at the instance of the defendants.

Actions can only be consolidated at the instance of the defendants; (b) and at common law a plaintiff could not be bound without his consent by the result of one action, but could after an adverse verdict proceed with any of the others.(c)

Several actions by different plaintiffs against the same defendant.

Where several actions are brought by different plaintiffs against the same defendants the Court will, on the application of the plaintiffs, make an order enlarging the time for taking the next step in several of the actions, and staying proceedings therein, till after one has been tried as a test action.(d)

Time when a consolidation order can be made.

It was held at common law that a consolidation could be made as soon as the defendants had appeared, and before declaration; (e) and where the defendants to several actions, by a consolidation order, consented to be bound by the result of one action, and the defendant in that action, which was decided against him, neglected to appeal, it was held that a defendant to one of the other actions had no equity to be allowed to carry the case to a superior Court.(f)

New Trial.

Procedure to obtain new trial.

If, after the trial of a patent action, either party considers that he is entitled to a new trial, and desires to obtain one

(y) Fairburn v. Household, 2 P. O. R. 195.

(z) Foxwell v. Webster, 4 De G. J. & S. 77.

(a) S. C. R. 1883, Ord. XLIX. r. 8.

(b) Lush's Practice, 3rd ed. 965; Amos v. Chadwick, L. R. 4 Ch. D. 869.

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

(d) Amos v. Chadwick, L. R. 4 Ch. D. 869; Bennett v. Lord Bury, L. R. 5 C. P. D. 339.

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

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

accordingly, the proper procedure is, if the action was tried with a jury, to apply by motion to a Divisional Court of the Queen's Bench Division; and, if the action was tried without a jury, the procedure is by appeal to the Court of Appeal.(g)

Where, after the reversal by the Court of Appeal of a judgment obtained by fraud, the respondents sought a rehearing of the appeal with fresh evidence, it was held that the Court had no jurisdiction to rehear the appeal, but that the proper course was an original action, analogous to a suit under the old practice to set aside a decree as obtained by fraud.(h)

Appeal.

All appeals to the Court of Appeal must be by way of rehear- Procedure. ing, and must be brought by notice of motion in a summary way, and no petition, case, or other formal proceeding, other than such notice of motion is necessary. The appellant may, by the notice of motion, appeal from the whole or any part of any judgment or order, and the notice of motion must state whether the whole or part only of such judgment or order is complained of, and in the latter case must specify such part.(i)

It is not, under any circumstances, necessary for a respondent to give notice of motion by way of cross-appeal, but if a respondent intends, upon the hearing of the appeal, to contend that the decision of the Court below should be varied, he must, within eight days, or such time as may be specified by special order, give notice of such intention to any parties who may be affected by such contention.(k)

If, upon the hearing of an appeal, it appears to the Court of Appeal that a new trial ought to be had, the Court of Appeal has power, if it thinks fit, to order that the verdict and judgment shall be set aside, and that a new trial shall be had.(l)

An appellant may be ordered to give security for the cost of the appeal; (m) and if such security is not given within a reason-

Power of Court of Appeal to order new trial.

Security for costs of appeal.

(g) L. C. R. 1883, Ord. xxxix. r. 1; *Hunt v. City of London Real Property Co.*, L. B. 3 Q. B. D. 19; *Edison v. Shippey*, 4 P. O. R. 473.

(h) *Flower v. Lloyd*, L. R. 6 Ch. D 297.

(i) S. C. R. 1883, Ord. LVIII. r. 1. As

to service of notice of motion, and time within which appeals are allowed, see S. C. R. 1883, Ord. LVIII. r. 2-19.

(k) S. C. R. 1883, Ord. LVIII. rr. 6 and 7.

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

(m) S. C. R. 1883, Ord. LVIII. r. 15.

able time, an order will, in the absence of extenuating circumstances, be made for the immediate dismissal of the appeal.(n)

If a respondent contends that the appellant ought to be ordered to give security for costs, he must apply to the appellant before moving the Court for such order, otherwise he will be liable to the costs of the application.(o)

When defendant becomes bankrupt.

If a defendant becomes bankrupt, after setting down an appeal, the appeal cannot be proceeded with unless he give security for costs, or the trustee in bankruptcy is made a party to the proceedings,(p) but on giving security for costs in such a case, he is entitled to proceed with the appeal.(q)

Insufficient ground for postponing an appeal.

It has been held not to be sufficient ground for postponing an appeal that the plaintiff was abroad, but desired to attend and instruct his counsel.(r)

Interlocutory Injunctions.

Procedure.

If the plaintiff in a patent action desires to obtain an interlocutory injunction, as is usually the case, restraining the defendant from continuing the acts complained of till the trial of the action, he should apply to the Court, *ex parte*, or on notice, and in either case without delay.(s)

Laches.

Thus, a plaintiff was held to be too late who applied on December 2nd for an interim injunction in respect of infringement committed on the 13th and 23rd November.(t)

On the other hand, where it appeared that the plaintiff had on several previous occasions established his patent, and that there was a combination of persons against him, interested in resisting his claims, and that he waited till he had established his patent again against one of the members of this combination before proceeding against the other members, his conduct was held to be no bar to an interlocutory injunction.(u)

Again, where the plaintiffs, in February, received notice from the solicitors to a company that the company was being formed

(n) Washburn and Moen Manufacturing Co. v. Patterson, L. R. 29 Ch. D. 48.

(o) Garrard v. Edge, 7 P. O. R. 139.

(p) United Telephone Co. v. Bassano, L. R. 31 Ch. D. 630.

(q) United Telephone Co. v. Bassano, L. R. 31 Ch. D. 630.

(r) Walker v. Hydrocarbon Syndicate, 3 P. O. R. 253.

(s) Bacon v. Jones, 4 My. & Cr. 436; Baxter v. Coombe, 1 Ir. Ch. R. 284; Bridson v. Benecke, 12 Beav. 1, 3.

(t) Greer v. Bristol Tanning Co., 2 P. O. R. 268.

(u) Bovill v. Smith, W. N. 1867, 240.

for the purpose of manufacturing an article which might possibly be an infringement of the plaintiff's patent, and inspection was offered, the Court held that they were not too late in applying, in March, for an interlocutory injunction, the delay being sufficiently explained, on the ground that they had been advised not to apply for it till the company had raised a substantial capital, and had actually commenced to manufacture the infringing article.^(v) And an interim injunction was granted, when the plaintiff became aware of the infringement on the 23rd March, but spent some time in making inquiries before giving the defendant notice to desist on the 8th May, and continued in correspondence with him till the bill was filed on the 7th July.^(x)

A plaintiff is not to be held guilty of laches disentitling him to an interim injunction, merely on the ground that the infringement was committed under the supposed protection of a patent, of the existence of which the plaintiff had knowledge some time before the commencement of the action.^(y)

If, however, a plaintiff acquiesce in the infringement of the defendant, no injunction will be granted on a subsequent interlocutory application. Thus, an interim injunction was dissolved by Cottenham, L.C., where it appeared that the plaintiff, about two years before he applied to the Court, was aware that the defendants were at considerable expense in preparing and erecting apparatus for the purpose of using the patented invention, and never interfered to stop them, but permitted them to go on in the expectation that they would pay the royalties required.^(z) Acquiescence may also disentitle the plaintiff to an account of profits altogether,^(a) or partially by limiting the account to profits made since the commencement of the action; ^(b) it may also be a ground for granting damages instead of an injunction.^(c)

The conduct of a plaintiff who knows of the existence of a

^(v) United Telephone Co. v. Equitable Telephone Association, 5 P. O. R. 233.

^(x) Losh v. Hague, 1 W. P. C. 201.

^(y) Osmond v. Hirst, 2 P. O. R. 265, 267.

^(z) Neilson v. Thompson, 1 W. P. C. 275, 285.

^(a) Crossley v. Beverly, 1 W. P. C.

120; Harrison v. Taylor, 11 Jur. N. S. 408.

^(b) Ford v. Foster, L. R. 7 Ch. App. Cas. 611, 627; Beard v. Turner, 13 L. T. N. S. 746.

^(c) Sayers v. Collyer, L. R. 28 Ch. D. 103.

patent of later date than his own for the same invention, but takes no steps to get it repealed, does not amount to acquiescence, unless the invention is actually put in practice under the subsequent patent.(d)

Procedure where there is an independent case against an interlocutory injunction being granted.

Where there is an independent case, on any ground, against an interlocutory injunction being granted, the Court considers it better to order the motion to stand over till the trial, if the defendant asks for it, because, although when the case on the motion is the same as the case at the trial, it is better merely to make the costs in the motion costs in the action; yet, where there is an independent case against a motion, so that the defendant may say: "If you succeed at the trial, yet you must have failed on the motion by reason of this delay, and therefore you have exposed me in any view to unnecessary expense," it is better, then, to order the motion to stand to the trial, without prejudice to any question.(e)

When defendant is estopped.

If the defendant is from any reason or other estopped from denying the validity of the patent as against the plaintiff,(f) and the fact of infringement is clear, an interlocutory injunction will be granted.

Ex parte application.

Eldon, L.C., laid down the rule that when an injunction is applied for *ex parte*, on the ground of violation of the rights to an invention secured by patent, it is incumbent on the party making the application to swear, at the time of making it, as to his belief that he is the original inventor; for although when he obtained his patent he might very honestly have sworn as to his belief of such being the fact, yet circumstances may have subsequently intervened, or information been communicated, sufficient to convince him that it was not his own original invention, and that he was under a mistake when he made his previous declaration to that effect.(g)

It is submitted that in the case of a plaintiff having a derivative title, the above rule will be satisfied if he swears that,

(d) *Newall v. Wilson*, 2 De G. M. & G. 282.

(e) See remarks of Chitty, J., *Lister v. Norton*, 1 P. O. R. 116.

(f) See p. 434 *ante*.

(g) *Hill v. Thompson*, 1 W. P.

231; see also *Sturtz v. De la Rue*, 5 Russ. 322, 329; *Gardner v. Broadbent*, 2 Jur. N. S. 1041; *Whitton v. Jennings*, 1 Dr. & Sm. 110; *Mayer v. Spence*, 1 J. & H. 87.

in his belief, the original patentee was the first and true invention.

A person applying *ex parte* for an injunction must exercise perfect good faith, and put the Court in possession of all the facts within his knowledge bearing on the question whether an injunction ought under the circumstances to be granted or not.^(h)

The Court does not commonly grant injunctions on *ex parte* applications, but the usual course is to make an order extending over a specified day, liberty being given to the applicant to serve short notice of motion for the day before that on which the order expires, and the applicant is required to give an undertaking to abide by the order of the Court as to any damages the defendant may be put to by reason of the interim order, such other terms being imposed upon him as the case may require.⁽ⁱ⁾

An interlocutory injunction is granted when the sole question between the parties is the validity of the patent,^(k) and there is a strong presumption or case in its favour,^(l) but it will most probably be refused if there is a real doubt as to the infringement.^(m) In cases where there is a question as to the infringement, it depends on the degree of doubt whether or not an injunction will be granted, and the Court will consider the degree of convenience or inconvenience to the parties caused by granting or refusing the injunction.⁽ⁿ⁾ Thus, if the trade of the defendants is a new one, and likely to lead to the sale of a large number of the alleged infringing articles, it is more convenient, and less likely to produce irreparable damage, to stop him by injunction from selling, than it would be to allow him to sell and merely keep an account, thus forcing the plaintiff to commence a multitude of actions against the purchasers;^(o) and where there is evidence of long enjoyment, and consequently *prima facie* evidence of title which ought to be respected,^(p) the

^(h) *Dalglish v. Jarvie*, 2 Mac. & G. 231; *Curtis v. Cutts*, 3 Jur. 34.

⁽ⁱ⁾ *Daniell's Chancery Practice*, 6th ed. p. 1611.

^(k) *Neilson v. Thompson*, 1 W. P. C. 277; *Stevens v. Keating*, 2 W. P. C. 179; *Electric Telegraph Co. v. Nott*, 11 Jur. 157.

^(l) See p. 461 *post*.

^(m) *Neilson v. Thompson*, 1 W. P. C. 277; *Stevens v. Keating*, 2 W. P. C.

179; *Electric Telegraph Co. v. Nott*, 11 Jur. 157; *Wood v. Cockerill*, 2 Coop. C. C. 58; *Plimpton v. Malcolmson*, L. R. 20 Eq. 38.

⁽ⁿ⁾ *Bridson v. McAlpine*, 8 Beav. 230; *Thompson v. Hughes*, 7 P. O. R. 71.

^(o) *Plimpton v. Spiller*, L. R. 4 Ch. D. 286, 292.

^(p) *Stevens v. Keating*, 2 W. P. C. 177, p. 461 *post*.

Grant and refusal of interlocutory injunctions.