

**Grounds
for
Extension.**

the Act of 1883, in the case of patents dated before January 1, 1884, the Judicial Committee will still take cognisance of the existence of foreign patents, in forming their decision whether to recommend an extension or otherwise,^(s) as indeed it will when a patent of later date than January 1, 1884, is the subject of the petition.

The Committee considers all the circumstances of the case : ^(t) and if foreigners are at liberty to use the invention free, this fact may induce the Committee not to accede to the petition, on the ground that to do so would be to unduly handicap the British public, and so the fact that there are foreign patents which the petitioner has allowed to expire is still a great obstacle in the way of a patentee desirous of obtaining an extension of a British patent.^(u) In such circumstances it requires a very strong case to be made out by the petitioner for extension, but if the invention is of rare or exceptional merit, and the inventor has been very insufficiently remunerated, notwithstanding that there are lapsed foreign patents, the Committee will recommend a prolongation, when there is no reason to suppose that the inhabitants of Great Britain and Ireland would be thereby placed at a disadvantage in competing with foreigners.^(x)

Items which may be credited to the petitioner.

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.^(y) It is better to render a separate account of items in respect of which a deduction is claimed.

Expenses in connection with experiments, legal proceedings, salaries and commissions.

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;^(z) also necessary costs of exhibiting and advertising the invention;^(a) and reasonable salaries and travelling

^(s) 46 & 47 Vict. c. 57, s. 113; Newton's Patent, (1884) L. R. 9 App. Cas. 592; 1 R. P. C. 177; Brandon's Patent, (1884) 1 R. P. C. 154.

^(t) 46 & 47 Vict., c. 57, s. 25, sub-s. 4.

^(u) Fountain Levit's Patent, (1892) 9 R. P. C. 327; Shone's Patent, (1892) 9 R. P. C. 438, 440; Semet and Solway's Patent, (1894) 12 R. P. C. 10; Pieper's Patent, (1895) 12 R. P. C. 295.

^(x) Semet and Solway's Patent,

(1894) 12 R. P. C. 10; Pieper's Patent, (1895) 12 R. P. C. 295.

^(y) Bailey's Patent, (1884) 1 R. P. C. 1.

^(z) Kay's Patent, (1839) 1 W. P. C. 572; 3 Moo. P. C. 24; Heath's Patent, (1853) 2 W. P. C. 247; 8 Moo. P. C. 217; Hill's Patent, (1863) 1 Moo. P. C. N. S. 258; 9 Jur. N. S. 1209; 9 L. T. N. S. 101; Adair's Patent, (1881) L. R. 6 App. Cas. 176; 50 L. J. P. C. 68.

^(a) Duncan and Wilson's Patent, (1884) 1 R. P. C. 257.

expenses for clerks; (b) and commissions on sales or royalties. (c) Grounds
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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. (d)

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. (e)

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, (f) and also in respect of payments for the surrender of licences. (g) 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 was not allowed to charge the item in the accounts as one of loss. (h)

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. (i) 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. (k)

Profits made as
a manufacturer
in contra-
distinction to
profits made as
a patentee.

(b) Duncan and Wilson's Patent, (1884) 1 R. P. C. 257.

(c) *Ibid.*; Poole's Patent, (1867) L. R. 1 P. C. 514; 4 Moo. P. C. N. S. 452; 36 L. J. P. C. 76.

(d) Poole's Patent, (1867) L. R. 1 P. C. 514; 4 Moo. P. C. N. S. 452; 36 L. J. P. C. 76.

(e) Hill's Patent, (1863) 1 Moo. P. C. N. S. 258, 268; 9 Jur. N. S. 1209; 9 L. T. N. S. 101.

(f) Fryer's Patent, 47 Eng. 49.

(g) Hill's Patent, (1863) 1 Moo. P. C. N. S. 258; 9 Jur. N. S. 1209; 9 L. T. N. S. 101.

(h) Wield's Patent, (1871) L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300.

(i) Bett's Patent, (1862) 1 Moo. P. C. N. S. 49; 9 Jur. N. S. 137; 7 L. T. N. S. 577; McInnes' Patent, (1868) L. R. 2 P. C. 54, 57; 5 Moo. P. C. N. S. 72; 37 L. J. P. C. 23; Hill's Patent, (1863) 1 Moo. P. C. N. S. 258; 9 Jur. N. S. 1209; 9 L. T. N. S. 101; Johnson's Patent, (1871) L. R. 4 P. C. 75; 8 Moo. P. C. 282; Saxby's Patent, (1870) L. R. 3 P. C. 292, 295; 7 Moo. P. C. N. S. 82.

(k) See Saxby's Patent, (1870) L. R. 3 P. C. 295.

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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 realised, the Committee will not recommend a prolongation or extension.^(l)

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,^(m) but the proportion must be divided according to the circumstances of each case.⁽ⁿ⁾

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 proportion 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.^(o)

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.

Personal remuneration when patentee is himself a manufacturer.

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.^(p)

Effect of rendering incomplete accounts.

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

^(l) Muntz's Patent, (1846) 2 W. P. C. 113; Newton's Patent, 51 Eng. 208; 17 Iron, 155, 171.

^(m) Duncan and Wilson's Patent, (1884) 1 R. P. C. 257, 260.

⁽ⁿ⁾ See Trotman's Patent, (1866) 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, (1863) 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, (1884) 1 R. P. C. 257.

^(o) Bailey's Patent, (1884) 1 R. P. C. 1.

^(p) 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, (1884) 1 R. P. C. 1; Carr's Patent, (1873) L. R. 4 P. C. 530; 9 Moo. P. C. N. S. 379; Perkin's Patent, (2) 47 Eng. 105; Cocking's Patent, (1885) 2 R. P. C. 151; Furness' Patent, (1885) 2 R. P. C. 175; Toy's Patent, (1893) 10 R. P. C. 89; Hazeland's Patent, (1894) 11 R. P. C. 467.

Judicial Committee may grant an adjournment in order that the accounts may be put right,^(q) but in most cases of insufficient or improper accounts the petition will be dismissed at once.^(r)

The New Grant.

THE 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 new grant of letters patent.^(s)

Crown gives effect to the recommendation of the Committee by means of a new grant,

It is not necessary for the patentee to file a fresh specification on the grant of a new patent;^(t) 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.^(u) The new grant is in the nature of a graft on the old one, and has no existence apart from it.^(x) A new grant of letters patent is subject in all cases to the conditions imposed by the Act of 1883 and subsequent statutes,^(y) and may be granted to more than one person jointly,^(z) 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.^(a)

which is subject to same conditions as the expired grant.

The Crown in granting new letters patent has the power to, and frequently does, impose conditions in the interest of the original patentee ^(b) or his representatives.^(c) The following are instances of cases in which such conditions have been imposed. In *Whitehouse's Patent* ^(d) 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*,^(e) where the

Conditions in the interest of the original patentee are frequently, on the recommendation of the Committee, imposed by the Crown on a new grant.

^(q) Perkins' Patent, (1845) 2 W. P. C. 17; Heath's Patent, (1853) 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, (1873) L. R. 5 P. C. 87.

^(r) Clark's Patent (2), (1870) L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 255; Newton's Patent (4), (1884) L. R. 9 App. Cas. 592; 1 R. P. C. 177; Adair's Patent, (1881) L. R. 6 App. Cas. 178; 50 L. J. P. C. 68.

^(s) Stoney's Patent, (1888) 5 R. P. C. 524; Cocking's Patent, 1885, 2 R. P. C. 151.

^(t) Wastenev Smith's Patent, (1885) 12 R. P. C. 14.

^(u) Russell v. Ledsam, (1843) 14 M. & W. 583; H. L. C. 687; Bovill v. Finch, (1870) L. R. 5 C. P. 523.

^(x) Bovill v. Finch, (1870) L. R. 5 P. C. 523; 39 L. J. C. P. 277.

^(y) Wastenev and Smith's Patent, (1885) 2 R. P. C. 14.

^(z) 46 & 47 Vict. c. 57, s. 4, sub-s. 2.

^(a) Southworth's Patent, (1837) 1 W. P. C. 488.

^(b) Whitehouse's Patent, (1830) 1 W. P. C. 473; reported as Russell's Patent, 2 Moo. P. C. 496.

^(c) Herbert's Patent, (1867) L. R. 1 P. C. 399.

^(d) (1838) 1 W. P. C. 473; reported as Russell's Patent, 2 Moo. P. C. 496.

^(e) (1860) 13 Moo. P. C. 310.

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original patentee had been bankrupt, the condition was imposed that he should receive an annuity during the extended period. In *Morton's Patent* (*f*) the assignee was required to secure to the original patentee one-half the future profits after recouping his own losses. In *Herbert's Patent* (*g*) 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.

Conditions are sometimes imposed for the benefit of persons other than the original patentee,

Sometimes conditions are imposed on the patentee for the benefit of other persons who have an interest in the patent, (*h*) or who might be liable in respect of infringements committed between the date of the order and the sealing of the new patent, (*i*) 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. (*k*)

or for the benefit of the public generally.

When the justice of the case requires, conditions will be imposed in favour of the Crown or the public generally.

Thus in *Petitt Smith's Patent* (*l*) the condition was imposed that the Crown should be allowed to use the invention without licence. See also *Lancaster's Patent*, (*m*) *Carpenter's Patent*, (*n*) and *Dixon v. London Small Arms Co.* (*o*) 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* (*p*) the condition was imposed that the patentee should grant licences upon terms similar to one already granted by him. In *Hardy's Patent* (*q*) 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* (*r*) the condition was imposed that certain portions of the specifications which related to parts of the invention not worked out should be disclaimed. In *Lyon's Patent*, (*s*) where the patentee had granted an exclusive licence, the condition was imposed that the petitioner should grant

(*f*) 51 Eng. 274; 17 Iron. 250.
 (*g*) (1867) L. R. 1 P. C. 399; 4 Moo. P. C. N. S. 300.
 (*h*) Normandy's Patent, (1855) 9 Moo. P. C. 452; Baxter's Patent, 13 Jur. 593.
 (*i*) Schlumberger's Patent, (1853) 9 Moo. P. C. 1.
 (*k*) Church's Patent, (1886) 3 R. P. C. 95.

(*l*) (1850) 7 Moo. P. C. 133
 (*m*) 2 Moo. P. C. N. S. 189.
 (*n*) 2 Moo. P. C. N. S. 191 n.
 (*o*) L. R. 1 App. Cas. 632.
 (*p*) (1866) L. R. 1 P. C. 308.
 (*q*) 6 Moo. P. C. 441.
 (*r*) (1853) 8 Moo. P. C. 282.
 (*s*) (1894) 11 R. P. C. 537.

licences on the same terms to all persons who should apply for them, the royalties to be limited to ten per cent. upon the selling price of each machine. **The New Grant.**

It is the practice when extension is granted in respect of two cognate patents to fix the expiry of each on the same day.^(t) Date of commencement and expiry of new grant.

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.^(u) 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.^(x)

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.^(y) Only one period of extension can be obtained.

It is not usual for the Judicial Committee to recommend a longer prolongation or extension than seven years;^(z) 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,^(a) which may in extreme cases be fourteen years, the longest period for which the Crown has power to grant a prolongation or extension.^(b) 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.^(c) Duration of new grant cannot exceed fourteen years.

If the petitioner succeed, he must forthwith leave at the

(t) Johnson's and Atkinson's Patent, (1873) L. R. 5 P. C. 87; Church's Patents, (1886) 3 R. P. C. 95.

(u) *Ledsam v. Russell*, (1847) 1 H. L. Cas. 687.

(x) Whitehouse's Patent, (1830) 1 W. P. C. 473; *Carp*. P. C. 565; 2 Moo. P. C. 496.

(y) Goucher's Patent, (1865) 2 Moo. P. C. N. S. 532.

(z) Furness' Patent, (1885) 2 R. P. C. 175. Seven years was allowed in the following somewhat recent cases: Joy's Patent, (1893) 10 R. P. C. 89; Davies' Patent, (1893) 11 R. P. C. 27; Hazeland's Patent, (1894) 11 R. P. C. 467.

(a) Moncrieff's Patent, 22 Iron, 35; Mitchell's Patent, (1847) 30 Newton, L. J. G. S. 356; Darby's Patent, (1891) 8 R. P. C. 380; Currie and Timmiss' Patent, L. R. (1898) A. C. 347.

(b) Mitchell's Patent, (1847) 30 Newton, L. J. O. S. 356; 46 & 47 Vict. c. 57, s. 25, sub-s. 5.

(c) Newton's Patent, (1861) 14 Moo. P. C. 156; Bailey's Patent, (1884) 1 R. P. C. 1; Derosne's Patent, (1844) 2 W. P. C. 1; *Carp*. P. C. 699; 4 Moo. P. C. 417; Currie and Timmiss' Patent, L. R. (1898) A. C. 347.

Costs.

Patent Office a copy of the order for prolongation or extension when obtained, that it may be entered on the register of patents.(d)

COSTS.

Costs are in the discretion of the Committee.

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

It is the practice of the Committee to award costs, on the principle that *bonâ 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 opponents may be ordered to pay costs occasioned by improper opposition,(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 where 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.(k)

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.

(d) R. R. 1890, r. 74.

(e) 46 & 47 Vict. c. 57, s. 25, sub-s. 7; as to taxation see p. 419 *ante*.

(f) *Wield's Patent*, (1871) L. R. 4 P. C. 89; 8 Moo. P. C. N. S. 300; *Westrupp and Gibbin's Patent*, (1836) 1 W. P. C. 556; *Honiball's Patent*, (1855) 9 Moo. P. C. 378; 2 W. P. C. 201; 25 L. T. 1.

(g) *Downton's Patent*, (1839) 1 W. P. C. 567.

(h) *Honiball's Patent*, (1855) 9 Moo. P. C. 394; 2 W. P. C. 201; 25 L. T. 1.

(i) *Bridson's Patent*, (1852) 7 Moo. P. C. 499; *Hornby's Patent*, (1853) 7 Moo. P. C. 503; *Milner's Patent*, (1854) 9 Moo. P. C. 39; *Mackintosh's Patent*, (1837) 1 W. P. C. 739; *Morgan Brown's Patent*, (1886) 3 R. P. C. 212.

(k) *Bridson's Patent*, (1852) 7 Moo. P. C. 449.

(l) *Newton's Patent* (2), Eng. Rep. Jan. to Mar. 1881.

(m) *Newton's Patent* (4), (1884) L. R. 9 App. Cas. 592; 52 L. T. 329; 1 R. P. C. 177.

(n) *Milner's Patent*, (1854) 9 Moo. P. C. 39; *Hill's Patent*, (1863) 1 Moo. P. C. N. S. 259; *Wield's Patent*, (1871) L. R. 4 P. C. 89.

(o) *Schlumberger's Patent*, (1853) 9 Moo. P. C. 1; *Johnson's Patent*, (1871) L. R. 4 P. C. 75, 8 Moo. P. C. N. S. 282; *Jones' Patent*, (1854) 9 Moo. P. C. 41; *Hopkinson's Patent*, (1896) 14 R. P. C. 10.

(p) *Judicial Committee Rules*, 1898, r. 6, p. 733 *post*.

CHAPTER XII.

ACTION TO RESTRAIN THREATS OF LEGAL PROCEEDINGS.

PART I.—GENERAL.

SEC. 32 of the Patents, Designs, and Trade Marks Act of 1883 enacts that:— Sec. 32 of Act of 1883,

“ 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.”

The principle embodied in this enactment seems to have been recognised by *Malins*, V.C., as early as 1871,^(a) though 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.^(b) It was subsequently held by *Jessel*, M.R., and affirmed on appeal,^(c) that no such principle at that date

creates a statutory right.

^(a) *Rollins v. Hinks*, (1872) L. R. 13 Eq. 355; *Axman v. Land*, (1874) L. R. 18 Eq. 330.

^(b) Judgment of *Jessel*, M.R., *Halsey v. Brotherhood*, (1880) L. R. 15 Ch. D. 520, 523.

^(c) *Halsey v. Brotherhood*, (1880) L. R. 15 Ch. D. 514; 19 Ch. D. 386; 49 L. J. Ch. 786; 51 L. J. Ch. 233.

General.

existed, and that a patentee was, in the absence of *mala fides*, justified in giving notice that his rights were being infringed without following up such notice by an action for the alleged infringement.

Slanderous statements made by patentee may be restrained apart from s. 32 of Act of 1883.

The Court has and 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) and damages for the slander of title may be obtained upon proof of the absence of privilege and the existence of express malice on the part of the slanderer.^(e)

Cases within either of the saving clauses of s. 32 of Act of 1883 are governed by the law in existence before the Act of 1883.

It is to be noticed that the foregoing section of the Act of 1883 does not apply to cases which are within either of the saving clauses—that is to say, to cases where the alleged manufacture, use, sale, or purchase to which the threats related are in fact an infringement of any legal rights of the person making such threats, and to cases where the threatening party with due diligence commences and prosecutes an action for the infringement of his patent.

Cases within either of the saving clauses of s. 32 of the Act of 1883 are still governed by the law as it existed prior to the Act.^(f)

Statement of such law.

The law thus referred to as applicable to such cases was, and is, 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 *bond fide* and in the belief that the articles in question were really infringements.^(g) 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 *bond fide*, and would damnify the person threatened.^(h)

Though the patentee was entitled to issue notices containing

^(d) *Loog v. Bean*, (1884) L. R. 26 Ch. D. 306; *Thomas v. Williams*, (1880) L. R. 14 Ch. D. 864; *Beddow v. Beddow* (1878) L. R. 9 Ch. D. 89; *Saxby v. Easterbrook*, (1878) L. R. 3 C. P. D. 339; *Thorley's Cattle Food Co. v. Massan*, (1877) L. R. 6 Ch. D. 582; *Riding v. Smith*, (1877) L. R. 1 Ex. D. 91.

^(e) *Ibid.*; *Montgomerie v. Peterson*, (1894) 11 R. P. C. 221, 633.

^(f) *Temler v. Stevenson*, (1897) 15 R. P. C. 24.

^(g) *Wren v. Wield*, (1869) L. R. 4 Q. B. 730; *Halsey v. Brotherhood*, (1880) L. R. 15 Ch. D. 514; L. R. 19 Ch. D. 386; *Sharp v. Brauer*, (1886) 3 R. P. C. 193; *Skinner v. Shaw*, (1893) L. R. 1 Ch. 413.

^(h) *Burnett v. Tate*, (1883) 45 L. T. N. S. 743; *Halsey v. Brotherhood*, (1880) L. R. 15 Ch. D. 514; 19 Ch. D. 390; *Sugg v. Bray*, (1885) 2 R. P. C. 224; *Dicks v. Brooks*, (1880) L. R. 15 Ch. D. 40; 49 L. J. Ch. 812.

statements that articles being sold by others were infringements of his rights, if such statements were made with reasonable and probable cause,⁽ⁱ⁾ 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.,^(k) "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."

General.

In some cases the patentee makes 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, sometimes such threats are circulated maliciously, and *mala fide*, 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*.^(l) In other words, if such a statement was made *bona fide*, though the party affected might be able to prove *damnum*, he could not at Common Law establish *injuria*, and consequently, it being merely a case of *damnum sine injuria*, he could not saddle the patentee with the commission of any tort.^(m) 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.⁽ⁿ⁾

If the plaintiff in an action to restrain the issue of threats of legal proceedings intends to rely on the old law and not on s. 32 of the Act of 1883, he should disclose his case as to

Plaintiff
intending to
rely on the old
law must dis-
close his case

⁽ⁱ⁾ Per Baggalay, L.J.; *Halsey v. Brotherhood*, (1881) L. R. 19 Ch. D. 390.

^(k) *Dicks v. Brooks*, (1880) L. R. 15 Ch. D. 22.

^(l) Per Coleridge, L.C.J., *Halsey v. Brotherhood*, (1881) L. R. 19 Ch. D. 388; *Sugg v. Bray*, (1885) 2 R. P. C.

243; see also *Skinner v. Shaw*, (1893) L. R. 1 Ch. 413.

^(m) *Commercial Development Corporation, Ltd. v. Castner-Kellner Alkali Co.*, (1897) 14 R. P. C. 939.

⁽ⁿ⁾ *Halsey v. Brotherhood*, (1880) L. R. 15 Ch. D. 518.

General. *mala fides* in his affidavits in support of his motion for an injunction.(o)

as to *mala fides*.

Law altered by 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 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.(p)

Bona fides of the patentee immaterial when s. 32 of Act of 1883 applies.

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.(q) The only defence open to the patentee, 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.(r) Thus an injunction was granted where the defendant refused to bring an action for infringement or to test the validity of his patent which was put in issue by the plaintiff.(s) The burden of proof that the patentee's statements are untrue lies, *prima facie*, on the plaintiff,(t) as it did before the Act of 1883,(u) though he may easily rebut it in a particular case, and throw on the defendant the burden of proving them to be true.(x)

Equitable assignee, or a patentee who.

A person who merely holds an agreement for an assignment of the patent upon terms does not possess legal rights of which

(o) *English and American Machinery Co. v. Gare Machine Co.*, (1894) 11 R. P. C. 631. (p) p. 441 *ante*.

(q) *Kurtz v. Spence*, (1888) 5 R. P. C. 161; *Herrburger v. Squire*, (1888) 5 R. P. C. 581; *Skinner v. Shew*, (1893) L. R. 1 Ch. 413.

(r) *Crampton v. Patents Investment Co.*, (1888) 5 R. P. C. 382; 6 R. P. C. 287; *Automatic Weighing Machine Co. v. Combined Weighing and Measuring Machine Co.*, (1889) 6 R. P. C. 120.

(s) *Willoughby v. Taylor*, (1894) 11 R. P. C. 45.

(t) *Challender v. Royle*, (1887) L. R. 36 Ch. D. 435; 4 R. P. C. 363; *Barney v. United Telephone Co., Ltd.*, (1885) 2 R. P. C. 173.

(u) *Burnett v. Tate*, (1882) 45 L. T. N. S. 743; *Anderson v. Liebig's Extract of Meat Co.*, (1881) 45 L. T. N. S. 757, 759.

(x) *Challender v. Royle*, (1887) L. R. 39 Ch. D. 435; 4 R. P. C. 363.

the acts referred to in a threat could be an infringement; (y) neither, it would appear, does a patentee who has obtained leave under s. 19 of the Act of 1883 in a pending action for infringement or a petition for revocation of the patent, for the fact of asking for leave to amend amounts to an admission that the patent is bad without amendment of the specification, and he is not, therefore, entitled to issue threatening notices till the amendment is actually made. (z) In such a case an injunction restraining the issue of the threats may be obtained upon motion in the pending proceeding. (a)

Person aggrieved.—The right of action conferred by s. 32 of the Act of 1883 is given to “any person aggrieved.” In founding the action, therefore, it is always necessary to consider whether the proposed plaintiff is really a person aggrieved. When threats are made against the customers of the person who supplies or agrees to supply the articles in respect of which the threats are made that person is a person aggrieved and may bring the action. (b) Also if the threats are made against the plaintiff’s licensee the plaintiff is a person aggrieved. (c)

It would 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, (d) because the term “patentee” as used in the Act means the person for the time being entitled to the benefit of the patent, (e) and it is doubtful whether this term would be held to include an exclusive licensee. (f) 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.

What is a Threat?—In considering the question what are threats within the meaning of s. 32 of the Act of 1883, it is well to bear clearly in mind what the evil was which the enactment of the section was intended to guard against.

Person Aggrieved.
What is a Threat?

has obtained leave to amend under s. 19 of Act of 1883, does not possess legal rights of which acts complained of in a threat could be an infringement.

Who is a person aggrieved.

The evil which s. 32 of the Act of 1883 was intended to guard against.

(y) *Kensington and Knightsbridge Electric Lighting Co. v. Lane Fox Electrical Co.*, (1891) 8 R. P. C. 277.

(z) *Fusee Vesta Co. v. Bryant and May* (2), (1887) 4 R. P. C. 191.

(a) *Ibid.*

(b) *Kensington and Knightsbridge Electric Lighting Co. v. Lane Fox Electrical Co.*, (1891) 8 R. P. C. 277; *Colley v. Hart*, (1898) L. R. 44 Ch. D.

179; 7 R. P. C. 101; *Skinner v. Shew*, (1893) L. R. 1 Ch. 413; 62 L. J. Ch. 196; 10 R. P. C. 1.

(c) *Kensington and Knightsbridge Electric Lighting Co. v. Lane Fox Electrical Co.*, (1891) 8 R. P. C. 277.

(d) p. 374 *ante*.

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

(f) *Barnett v. Barrett's Screw Stopper Bottling Co.*, (1884) 1 R. P. C. 9.

What is a Threat?

Before the section became law, a person aggrieved by the issue of threats of legal proceedings, or liability, at the instance of a person claiming to be the patentee of an invention in respect of which the threats were made, could only obtain the injunction of the Court restraining such threats and damages in respect of them, if he was able to discharge the *onus* which was upon him of proving that the threats were issued *mala fide* and without reasonable excuse. This *onus* of proof, which was upon the party aggrieved, almost nullified the remedy by injunction because of the extreme difficulty of proving that the patentee had put forward his assertion of patent rights maliciously and without just cause or excuse. The threat of a patent action is well calculated to paralyse the business of persons aggrieved, and in the words of *Bowen, L.J.*, (g) "the Legislature desires that threats of patent actions shall not hang over a man's head—that the sword of Damocles, in such a case, should either not be suspended or should fall at once, and it is with that view that the section seems to be framed." The object of the Legislature, therefore, was to prevent persons claiming to be patentees from issuing *any* kind of threat the result of which might be to paralyse a man in his trade by having an action on a patent suspended before his eyes without the opportunity of determining the suspense at once and bringing the question to a speedy and immediate issue. (h)

Effect of the words "or otherwise" as used in s. 32 of the Act of 1883.

Upon this view of the evil which the section was designed to guard against, the Court of Appeal have held that the words "or otherwise," as used in the section, are not to be construed *eiusdem generis* with "circulars" and "advertisements," but that, on the contrary, the words "circulars" and "advertisements" enlarge the meaning of the words "or otherwise" so as to include within the section all threats of whatsoever kind made in respect of any alleged manufacture, use, sale, or purchase of an invention by a person claiming to be the patentee thereof. (i)

Nature of threats which have been held to be within s. 32 of the Act of 1883.

Threats within s. 32 may, as above stated, be made by circular, advertisement, or otherwise. It has been held that a threat contained in a solicitor's letter, (k) in a private letter, (l)

(g) *Skinner v. Shew*, [1893] 1 Ch. 425.

(h) *Ibid.*

(i) *Skinner v. Shew*, [1893] 1 Ch. 413.

(k) *Duffield v. Waterloo*, (1886) 3 R. P. C. 46; L. R. 31 Ch. D. 638; *Crampton v. The Patents Investment Co.*, (1888) 5 R. P. C. 393; *The Com-*

bined Weighing and Advertising Machine Co. v. The Automatic Weighing Machine Co., (1889) 6 R. P. C. 502; *Edlin v. Pneumatic Tyre and Brooks Cycle Agency*, (1893) 10 R. P. C. 312.

(l) *Walker v. Clarke*, (1887) 4 R. P. C. 113; *Burt v. Morgan*, 4 R. P. C. 278.

and in a letter written without prejudice,^(m) or in answer to an inquiry as to whether the patentee considered a certain article an infringement of his patent,⁽ⁿ⁾ are actionable. Further, a statement made by the patentee, or on his behalf, though it does not contain any direct reference to the patent, may nevertheless amount to a threat within the section. Thus, where the defendant wrote to probable customers of the plaintiff that they must not be surprised if he, the defendant, applied for an injunction against the plaintiff to restrain him from selling the articles in question, the Court held that such statement amounted to a threat in respect of the patent, and granted an injunction in the terms of the section.^(o) 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.^(p)

What is a
Threat?

The question may arise as to how far a person who has issued threats within the meaning of s. 32 of the Act of 1883, and brought himself within the proviso by, with due diligence, commencing and prosecuting an action for infringement, is justified in continuing the threats whilst the action is pending. In this connection there is the authority of *Kekewich, J.*, in *Fenner v. Wilson*,^(q) for the proposition that, quite apart from s. 32 of the Act of 1883, a plaintiff in a pending action for infringement may, on motion in the action, be restrained from issuing advertisements warning the public that they are liable in damages for using the subject-matter of the plaintiff's patent, if such advertisements amount to statements that the pending action must succeed. The injunction is granted on the ground that the issue of such advertisements may prejudice the defendant, and so be an interference with the even course of justice;^(r) and in such a case the order ought not to contain any undertaking as to damages, since, though subject to appeal, it is not obtained on interlocutory proceedings in the true sense.^(s) The Court of Appeal, without expressing any opinion on the proposition of law above formulated, stated that

Continuation
of threats by a
person within
the proviso of
s. 32 of Act of
1883 pending
action.

^(m) *Kurtz v. Spence*, (1888) 5 R. P. C. 173.

⁽ⁿ⁾ *Skinner v. Shew*, [1893] 1 Ch. 413.

^(o) *Douglass v. Pintsch's Patent Lighting Co.*, (1896) 13 R. P. C. 673.

^(p) *Kurtz v. Spence*, (1888) 5 R. P. C. 161, 172, 173.

^(q) (1893) 10 R. P. C. 283; see also *Goulard v. Lindsay*, (1887) 4 R. P. C. 189.

^(r) *Fenner v. Wilson*, (1893) 10 R. P. C. 283; *Goulard v. Lindsay*, (1887) 4 R. P. C. 189.

^(s) *Fenner v. Wilson*, (1893) 10 R. P. C. 287.

What is a
Threat?

they could not consider the advertisements in *Fenner v. Wilson*, the particular case in question, as amounting to contempt of Court. (t)

Bonâ fide
notice by plain-
tiff to cus-
tomers of
defendant in an
infringement
action.

The plaintiff in a pending action for infringement is entitled to give *bonâ fide* notice to the defendant's customers that, by dealing in the goods supplied by the defendant, they expose themselves to the risk of actions by the plaintiff, and that in the event of the plaintiff succeeding against them in such actions they are liable to pay damages and costs and to have their goods which were so purchased destroyed by order of the Court. (u)

Question
whether threat
to be actionable
under s. 32 of
Act of 1883
must relate
only to an act
done, or
whether it may
relate to some-
thing proposed
to be done.

The question whether a threat, to be actionable under s. 32 of the Act of 1883, must be not merely a warning about something that is going to be done, but must be a threat about an act done—*i.e.*, whether it must be a threat of legal proceedings in respect of an alleged actual manufacture, use, sale, or purchase of the invention, and not in respect of a proposed manufacture, use, sale, or purchase, cannot be said to have been, as yet, definitely decided by the Courts. There are expressions in the judgments delivered by the Court of Appeal, especially in that of *Bowen*, L.J., in *Challender v. Royle*, (x) which, if read apart from the particular case, support the view that a threat in respect of a proposed manufacture, use, sale, or purchase, would not be a "threat" within the meaning of the section; but in the later case of *Johnson v. Edge*, (y) the Court of Appeal without deciding the point, which was not necessary to the decision of that case, expressed grave doubts as to whether upon the true construction of the section it does exclude intended infringements which have not actually taken place, and as to whether the language used by *Bowen*, L.J., in the judgment above referred to is to be taken to mean that, in all cases, such intended infringements are so excluded. It is submitted that the first part of the section should be construed as correlative with the proviso; and that consequently all threats of legal proceedings or liability in respect of any alleged past or future manufacture, use, sale, or purchase of an invention issued by or on behalf of a person claiming to be the patentee

(t) *Fenner v. Wilson*, (1893) 10 R. P. C. 287.

(u) *Incandescent Gas Light Co. v. Sunlight Incandescent Gas Lamp Co.*, (1897) 14 R. P. C. 180; see also *Dunlop Pneumatic Tyre Co. v. New Seddon Pneumatic Tyre and Self-closing Tube Co.*, (1897) 14 R. P. C. 332; *Näh-*

maschinen Fabrik v. Singer Manufacturing Co., (1893) 10 R. P. C. 310.

(x) (1887) L. R. 36 Ch. D. 425.

(y) (1892) 9 R. P. C. 142; see also judgment of Kekewich, J. in *Kurtz v. Spence*, (1888) 5 R. P. C. 171; and of Day, J. in *Willoughby v. Taylor*, (1894) 11 R. P. C. 52.

of such invention, are threats within the section if the person claiming to be a patentee is in a position when the threats are issued, to found an action for the infringement of his patent upon the past or future Acts referred to therein. A patentee may found an action upon a threatened infringement, even though no actual infringement has taken place.^(z) And, it is submitted, s. 32 must be interpreted as including any threat made by the patentee in respect of any alleged intended infringement when the person threatened has actually done something which the patentee is justified in construing as an expression of an intention to infringe.

**The
Proviso.**

S. 32 of the Act of 1883, according to this view of its construction, does not in any way limit the right of every patentee to issue a general warning to infringers, and to advise the public that the patent to which he is entitled, and under which he claims, is one which he intends to enforce.^(a) It must, however, be remembered that what at first sight appears to be a justifiable general warning may, in view of the peculiar circumstances of a particular case, well be construed as a threat directed against a particular individual, and so actionable under the section.^(b)

General
warning to in-
fringers issued
by a patentee.

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.^(c)

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.^(d)

Use of a thing
simpliciter as
distinguished
from use in a
particular
manner.

A threat which is not withdrawn is considered as continuing.^(e)

Threat not
withdrawn.

The Proviso.—S. 32 of the Act of 1883 provides that the remedy created by the section shall not be applicable, if the person making the threats complained of, with due

^(z) See pp. 504, 516 *post*.

^(a) *Johnson v. Edge*, (1892) 9 R. P. C. 142; *Challender v. Royle*, (1887) 2 R. 36 Ch. D. 428.

^(b) *Johnson v. Edge*, (1892) 9 R. P. C. 142, 148.

^(c) *Cropper v. Smith*, (1883) L. R. 24 Ch. D. 305, 312.

^(d) *Burt v. Morgan*, (1887) 4 R. P. C. 278.

^(e) *Driffield v. Waterloo*, (1886) L. R. 31 Ch. D. 638, 643.

**The
Proviso.**

Nature of
infringement
action which
will secure
the benefit
of the proviso.

diligence, commences and prosecutes an action for infringement of his patent.

The question naturally arises, By whom and against whom and when must such an action be commenced and prosecuted, so as to bring the case within the proviso ?

The proviso will not be satisfied unless the action for infringement is brought by the person making the threats—*e.g.*, an action brought by the equitable or legal assignee of the defendant to the threats action will not do.^(f) Also the proviso will not be satisfied unless the action for infringement is in respect of the patent to which the threats relate, but, if several patents relate to the same general subject-matter, it is not necessary that the patentee bring the action in respect of all such patents.^(g)

It is not always possible for the defendant to a threats action to bring an action for the infringement of his patent against the person aggrieved by the threats. For instance, the patentee 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 or contemplated 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.^(h) 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 ;⁽ⁱ⁾

^(f) Kensington and Knightsbridge Electric Lighting Co. v. Lane Fox Electrical Co., (1891) 8 R. P. C. 277.

^(g) Temler v. Stevenson, (1897) 15 R. P. C. 24.

^(h) See p. 445 *ante*.

⁽ⁱ⁾ Challender v. Royle, (1887) L. R. 36 Ch. D. 425 ; 4 R. P. C. 363 ; Day v. Foster, 7 R. P. C. 54.

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.(k)

The
Proviso

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.(l) Thus, in a case where the defendant had commenced an 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.(m)

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.(n)

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 before or 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.(o)

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, and it is not necessary that the action for infringement should be one in which the issue of validity can be contested.(p)

In forming a conclusion as to whether an action for infringement has been commenced with due diligence after the issue of

(k) *The Combined Weighing and Advertising Machine Co. v. The Automatic Weighing Machine Co.*, (1889) 6 R. P. C. 502; L. R. 42 Ch. D. 665; 58 L. J. Ch. 709.

(l) *Challender v. Royle*, (1887) L. R. 36 Ch. D. 425, 439; 4 R. P. C. 363.

(m) *Household v. Fairburn*, (1884) 1 R. P. C. 109; 2 R. P. C. 142.

(n) *Day v. Foster*, (1890) 7 R. P. C. 54.

(o) *Ibid.* 54, 60.

(p) *Ibid.* 54.

The Proviso.

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 defendant's right.(q)

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.(r) If delay in bringing the infringement action were caused by negotiations between the parties, it would no doubt be held that the conditions of the proviso were satisfied.(s) But where the 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 in the threat action alleging infringement by the plaintiffs, they were held not to have commenced and prosecuted an action for infringement with due diligence.(t)

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;(u) though this decision would appear to be wrong in view of the fact that subsequent cases have decided 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.(x) Moreover, 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,(y) or it was

(q) *Challender v. Royle*, (1887) L. R. 36 Ch. D. 435, 437; 4 R. C. P. 363; *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.*, (1889) 6 R. P. C. 502.

(r) *Colley v. Hart*, (1890) 7 R. P. C. 101, 106.

(s) *Edlin v. Pneumatic Tyre and Brooks Cycle Co.*, (1893) 10 R. P. C. 311.

(t) *Herrburger v. Squire*, (1888) 5 R. P. C. 581; 6 R. P. C. 194; but see *Challender v. Royle*, (1887) L. R. 36 Ch. D. 437.

(u) *Crampton v. Patents Investments Co.*, (1888) 5 R. P. C. 382, 393; but see *Colley v. Hart*, (1890) 7 R. P. C. 101.

(x) *Colley v. Hart*, (1890) 7 R. P. C. 101, 108, 110; *English and American Machinery Co. v. Gare Machinery Co.*, (1894) 11 R. P. C. 627.

(y) *Colley v. Hart*, (1890) 7 R. P. C. 101, 109, 110; *English and American Machinery Co. v. Gare Machinery Co.*, (1894) 11 R. P. C. 627.

originally in respect of several patents and was dropped in respect of some of them.^(z)

Issues.

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.^(a)

An action commenced to obtain an injunction to restrain the defendant from passing off his goods as and for the plaintiffs, and tardily after the issue of the writ in an action under s. 32 amended to an infringement action, is not commenced and prosecuted with due diligence.^(b)

PART II.—PRACTICE.

Specimens of the pleadings in an action under s. 32 of the Act of 1883 will be found in the Appendix.^(c) The action for breach of the statutory right created by s. 32 of the Act of 1883 lies against individuals, and also against a corporation.^(d)

Issues.—In any action brought under s. 32 of the Act of 1883 to restrain threats of legal proceedings, not only the issue of infringement may be raised, but also that of the validity of the patent to which the threats relate;^(e) and it is therefore open to the plaintiff 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."^(f) That is to say, 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

Issues of infringement and also validity of the patent may be raised.

^(z) *Temler v. Stevenson*, (1897) 15 R. P. C. 24.

^(a) *Anderson v. Liebig's Extract of Meat Co.*, (1881) 45 L. T. N. S. 757.

^(b) *Johnson v. Edge*, (1892) 9 R. P. C. 142.

^(c) p. 796 *post*.

^(d) *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.*, (1889) L. R. 42 Ch. D. 669; *Fusee Vesta Co. v. Bryant and May*,

(1887) 4 R. P. C. 194; *Kensington and Knightsbridge Electric Lighting Co. v. Lane Fox Electrical Co.*, (1891) 8 R. P. C. 277; L. R. (1891) 2 Ch. 579.

^(e) *Challender v. Royle*, (1887) L. R. 36 Ch. D. 425; 4 R. P. C. 363; *Kurtz v. Spence*, (1887) 4 R. P. C. 427; *Herrburger v. Squire*, (1888) 5 R. P. C. 589.

^(f) Per Charles, J. *Herrburger v. Squire*, (1888) 5 R. P. C. 589.

Particulars.

the action seeks to have it considered, because, if the patent is invalid, there is no infringement of a legal right of the patentee.(g)

Practice in pleading.

It would appear to be the more correct course for the plaintiff not to plead the invalidity of the defendant's patent in the statement of claim, but to leave the defendant to raise the issue in the defence. The plaintiff is at liberty to deny the validity in the reply, and to deliver particulars of objections therewith, and such further pleadings as may be necessary are allowed.(h) It is, however, competent to the plaintiff, if he is so minded, to raise the issue of the validity of the patent by a denial in the statement of claim.(i)

The burden of proof of the fact of infringement is on the defendant.(k)

Particulars of breaches.

Particulars.—The defendant may be ordered to furnish particulars of breaches, 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;(l) 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.(m)

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.(n)

If the plaintiff pleads non-infringement of any legal right of the defendant, and defendant, though not admitting the plea, does not allege infringement of any particular legal right, the plaintiff cannot claim particulars showing in what respect the defendant alleges the infringement of his legal rights, or in what respect he does not admit that the plaintiffs do not infringe the alleged legal rights of the defendant.(o)

Particulars of objections.

The defendant is entitled to particulars of objections before

(g) See judgment of Cotton, L.J., *Challender v. Royle*, (1887) L. R. 36 Ch. D. 435; 4 R. P. C. 363.

(h) *Dowson v. Drosophore Co.*, (1895) 12 R. P. C. 95.

(i) *Willoughby v. Taylor*, (1894) 11 R. P. C. 47.

(k) *Ungar v. Sugg*, (1889) 6 R. P. C. 337.

(l) *Wren v. Wield*, (1869) L. R. 4 Q. B. 213; *Union Electrical Power and Light Co. v. Electrical Power*

Storage Co., (1888) 5 R. P. C. 329; *Law v. Ashworth*, (1890) 7 R. P. C. 86.

(m) *Union Electrical Power and Light Co. v. The Electrical Power Storage Co.*, (1888) 5 R. P. C. 329; *Smith v. Laing*, (1890) 7 R. P. C. 148.

(n) *Ibid.* Particulars of breaches and objections are discussed more fully at pp. 512, 527 *post*.

(o) *Dowson Taylor v. Drosophore Co.*, (1894) 11 R. P. C. 653.

he delivers his defence if invalidity is pleaded in the statement of claim.(p)

Inter-
locutory
Injunction.

When the plaintiff alleges that the threats were made by the defendant's agents, he may be compelled to give particulars of the names of such agents.(q)

Interlocutory Injunction.—In cases where the defendant brings an infringement action which satisfies the conditions of the proviso of s. 32 of the Act of 1883, it is the usual course for the Court, on motion by the plaintiff for an interlocutory injunction, to make no order except that the threats action be stayed until the trial of the infringement action or further order, and that the costs of the threats action be costs in the infringement action; and the defendant usually gives an undertaking to prosecute the infringement action diligently, and disclaims any intention of issuing new threats in the meantime.(r) In the event of the defendant not prosecuting the infringement action with due diligence, the plaintiff has thus an opportunity of moving again.(s)

Usual course
where de-
fendant brings
an action for
infringement.

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, and there does not appear to be any reported case in which this has been done, though no doubt, under very special circumstances, the Court might do so, if the interests of justice would not be otherwise satisfied.

Ex parte
applications.

It is usual to allow short notice of motion to be given in the ordinary way:(t) but when threats are issued by an agent in this country at the instigation of a foreigner abroad, and the agent appears, though the foreign patentee has not been served, the practice is for the Court to grant an *ex parte* injunction against the foreigner, his servants, and agents. The order indicates that the agent defendant appears, and is directed in particular against him as agent. The plaintiff should give an undertaking to accept short service of notice to dissolve the injunction.(u)

In an action to restrain threats under s. 32 the Court

Prima facie
case

(p) *Law v. Ashworth*, (1890) 7 R. P. C. 86.

(q) *Dowson Taylor v. Drosophore Co.*, (1894) 11 R. P. C. 536.

(r) *Mackie v. Salvo Laundry Co.*, (1892) 9 R. P. C. 465; *Edlin v. Pneumatic Tyre and Booth's Cycle Agency*, (1893) 10 R. P. C. 316; *English and American Machinery Co. v. Gare*

Machinery Co., (1894) 11 R. P. C. 628; *Dowson Taylor v. Drosophore*, (1895) 12 R. P. C. 95.

(s) *Ibid.*

(t) *Wilson and Co. v. Walter E. Church Engineering Co. Ltd.*, (1885) 2 R. P. C. 175.

(u) *Overton v. Burns*, (1896) 13 R. P. C. 455.

Inter-
locutory
Injunction.

of non-
infringement
or invalidity is
essential with-
out which the
Court does not
consider the
balance of con-
venience to the
parties.

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.^(x)

Cotton, L.J., commenting in the Court of Appeal on a decision^(y) 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:—^(z)

“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 granted only on a case made out entitling the plaintiff to that particular remedy.”

If the Court is satisfied, on a motion for an interlocutory injunction, that the plaintiff had made out a *prima facie* case of non-infringement, it will grant the interlocutory injunction restraining the defendant until the trial of the action from continuing to threaten any person with legal proceedings or liability in respect of the alleged manufacture, use, sale, or purchase of his invention.^(a) On the other hand, where the Court

^(x) *Challender v. Royle*, (1887) L. R. 36 Ch. D. 425; 4 R. P. C. 363; *Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.*, (1883) L. R. 25 Ch. D. 1; *Barney v. United Telephone Co.*, (1885) L. R. 28 Ch. D. 394.

^(y) *Walker v. Clarke*, (1887) 4 R. P. C. 111; *Challender v. Royle*, (1887) L. R. 36 Ch. D. 428; 4 R. P. C. 363.

^(z) *Challender v. Royle*, (1887) L. R. 36 Ch. D. 436; 4 R. P. C. 363.

^(a) *Colley v. Hart*, (1888) 6 R. 17.

is of opinion that the plaintiff, by his affidavits, fails to raise a probable case of non-infringement, and that there is a conflict of testimony on the question, an injunction will be refused.^(b) 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.^(c)

When there is a question as to whether the alleged threat is really a threat within the section which would be better decided at the trial, and the defendant denies any intention of making threats, this circumstance induces the Court to order the motion to stand to the trial, with liberty to the plaintiff to bring it on again in the interval upon two days' notice.^(d)

Where ^(e) it appeared that the defendants 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.^(f)

Another circumstance which may influence the Court to grant an interlocutory injunction is the probable incapacity of the defendant to satisfy the plaintiff's claim if ultimately defeated.^(g)

Damages.—Damages are only awarded when the plaintiff shows that he has really suffered loss owing to the defendant's conduct.^(h) Moreover, the defendant is only liable for damage directly caused by the threats. He is not liable for damage resulting from the mere rumour of legal disputes or legitimate general statements, or by threats unauthorised by him, though he may be liable in respect of a falling off in the plaintiff's general business traceable to the threats in respect of a particular article dealt in by the plaintiff.⁽ⁱ⁾

When it can be shown that the plaintiff has lost a contract

^(b) *Barney v. United Telephone Co.*, (1885) 2 R. P. C. 173.

^(c) *Colley v. Hart*, (1889) 6 R. P. C. 17.

^(d) *Douglass v. Pintsch's Patent Lighting Co.*, (1895) 13 R. P. C. 60.

^(e) *Barnett v. Barrett's Screw Stopper Bottling Co., Ltd.*, (1884) 1 R. P. C. 9.

^(f) See also *Combined Weighing and Advertising Machine Co. v. Automatic*

Weighing Machine Co., (1889) 6 R. P. C. 502.

^(g) p. 551 *post*.

^(h) *Driffield v. Waterloo*, (1886) L. R. 31 Ch. D. 638; 55 L. J. Ch. 391; 3 R. P. C. 46.

⁽ⁱ⁾ *Ungar v. Sugg*, (1891) 8 R. P. C. 385; 9 R. P. C. 113, in which the principles on which damages for threats ought to be assessed are discussed.

Damages.

Other considerations on motion for interlocutory injunction.

Damages to be recoverable must result directly from the threat.

Certificates.

in consequence of the threats the measure of damage is the loss of profit.^(k)

If the Judge is able to assess the damages at the trial it is right that he should do so instead of sending the case to an inquiry.^(l)

Can a certificate of validity be given in an action to restrain threats?

Certificate of Validity.—It is submitted that an action which is in the form of one to restrain the issue of threats under s. 32 of the Act of 1883, but in which the validity of the patent is put in issue and decided in favour of the patentee, is an “action for infringement” within the meaning of s. 31, and that the Court has, therefore, jurisdiction to give a certificate of validity under that section. The authorities, however, appear to be in conflict.^(m) It is submitted that the object of the Legislature in framing s. 31 was to protect patentees, who have once established the validity of their patent in expensive litigation, from being unduly harassed by having the same question raised against them again by the parties to different proceedings; and that the section ought not to be so construed as to limit it to cases in which the action is one for infringement in the ordinary sense, and to exclude cases in which the action, though in substance one for infringement, is not so in mere form.

Is certificate as to particulars necessary on taxation?

Certificate as to Particulars.—It does not appear to have been definitely decided whether or not in order for a successful party in an action under s. 32, in which the questions of infringement and validity of the patents were in issue, to be entitled to the costs of his particulars, it is necessary for him to obtain the Judge’s certificate under s. 29, sub-s. 6 of the Act of 1883, to the effect that such particulars delivered by him were proven or reasonable and proper.⁽ⁿ⁾ It is submitted that an action under s. 32, in which the issues of infringement and validity of the defendant’s patent are properly raised, whether or not the defendant counterclaims for damages, is in all but mere form an action for the infringement of the patent and that the term “action for infringement” as used in s. 29 should be construed as including such an action, with the result that the Court has jurisdiction to grant the certificate in a threats action and that

^(k) *Skinner v. Perry*, (1894) 11 R. P. C. 406.

^(l) *Ungar v. Sugg*, (1892) 9 R. P. C. 113; *Herrberger v. Squire*, (1887) 5 R. P. C. 596; 6 R. P. C. 194; *Kurtz v. Spence*, (1887) 5 R. P. C. 177; 57 L. J. Ch. 238.

^(m) *Kurtz v. Spence*, (1885, 1888) 5 R. P. C. 184; *Crampton v. The Patents Investment Co.*, (1888) 5 R. P. C. 404; *Herrburger v. Squire*, (1888) 5 R. P. C. 595.

⁽ⁿ⁾ *Willoughby v. Taylor*, (1894) 11 R. P. C. 45.

on taxation no costs should be allowed in respect of any particular which has not been duly certified by the Court. It is to be observed that the submission is the other way in the case of a petition for the revocation of a patent, for s. 26 of the Act of 1883 is confined expressly to the practice in cases of revocation of a patent upon petition, whereas s. 28 refers to "an action or proceeding for infringement or revocation of a patent," and s. 29 commences "In an action for infringement of a patent," and makes no reference to proceeding for revocation upon petition. Ss. 26 and 29 contain analogous directions as to the delivery of particulars and confining the evidence to them, but s. 26 does not contain the clause which is in s. 29, having reference to the certificate.(o)

Costs.
—

Costs.—The general costs of an action to restrain threats are dealt with by the Courts under their ordinary jurisdiction. Ordinary jurisdiction of the Court applies.

It is the duty of the defendant to a threat action who brings a cross-action for infringement to endeavour by arrangement to avoid causing unnecessary costs by trying the same action in two different forms.(p)

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,(q) but see above as to costs of particulars of breaches and objections.

(o) p. 399 *ante*.

(p) *Combined Weighing Machine Co. v. Automatic Weighing Machine Co.*, (1889) 6 R. P. C. 367, 502; *Colley v. Hart*, (1890) 7 R. P. C. 101, 108, 189.

(q) *Herrburger v. Squire*, (1888) 5 R. P. C. 596; *Longbottom v. Shaw*, (1888) 5 R. P. C. 502.

CHAPTER XIII.

ACTION OF INFRINGEMENT.

GENERAL.

Former spirit of interpretation of letters patent.

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.

Modern spirit of interpretation.

The Courts now recognise the principle laid down by Lord *Eldon*, L.C.,(a) that the patent may 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.

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.

Remedies for 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, together with

(a) *Cartwright v. Eamer*, (1807) cited 14 Ves. 131, 136.

(b) Chap. viii. ; p. 344 *ante*.

destruction of the infringing article. A patentee is also entitled to sue in one and the same action for the recovery of royalties from a defendant alleged to be a licensee, or in the alternative for the usual relief consequent on infringement.^(c)

General.

A secret use by the patentee 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.^(d) 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 the secret use of the invention? It is submitted that he could not do so, for the patent would be invalid because the requirements of the sixth section of the Statute of Monopolies are not satisfied, in that it cannot be said that the invention was one which falls within the class "which others at the time of making such letters patent and grants shall not use."^(e) The prior secret user would no doubt be required to establish a very strong case, for the Courts would be inclined to the conclusion that an alleged prior secret use was merely experimental and incomplete, in which case it would be no anticipation of the completed invention, the subject of the subsequent patent.^(f)

Secret use of an invention.

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.^(g)

If any person has *openly* practised an invention before the date of subsequent letters patent, he clearly cannot be prevented from continuing to do, after the patent, that which he did before it, since the patent is bad in law on the ground of lack of novelty.^(h)

Beside 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.

Sale of goods in fraud of a patentee.

^(c) *Wilson v. Union Oil Mills Co.*, (1892) 9 R. P. C. 57.

^(d) pp. 110, 120 *ante*.

^(e) p. 121 *ante*. ^(f) p. 107 *ante*.

^(g) pp. 110, 120 *ante*.

^(h) p. 111 *ante*.

General.

It does not signify in what way the offender carries out his fraudulent purpose, whether by counterfeiting a name, *(i)* word, *(k)* mark, or device *(l)* upon the spurious articles themselves, or upon the wrappers in which they may be wrapped, *(m)* or by using any other means to deceive the public into purchasing goods as the goods of the patentee when they are really not so. *(n)*

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. *(o)* And it is no answer for the defendant to say that the spurious goods are equal in quality to those made by the plaintiff. *(p)*

Further, a person selling goods in a manner which induces the purchaser to believe that he is buying the goods of another is liable to an action, notwithstanding the fact that he in a sense 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 same name as the plaintiff) made and sold similar goods to the 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. *(q)* A rule *nisi* for a new trial was refused by the Court of King's Bench. *(r)*

On the other hand, any person who becomes acquainted with the process of making 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 descriptive of the article apart from its origin, any person is entitled to describe

(i) Ransome v. Bentall, (1834) 3 L. J. N. S. 161; Singer Manufacturing Co. v. Loog, (1880) L. R. 18 Ch. D. 395, 422.

(k) 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.

(l) *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; Seixor v. Provezende, L. R. 1 Ch. App. 192.

(m) 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.

(n) See Graham, Designs and Trade Marks, pp. 87-110, and cases there collected.

(o) See *post*.

(p) Blofield v. Payne, 4 B. & A. 410.

(q) Sykes v. Sykes, 3 B. & C. 541; *cf.* Turton v. Turton, (1889) L. R. 42 Ch. D. 128.

(r) 3 L. J. N. S. 161.

it by such name, provided he does not so use the name as to lead the public to believe that they are buying goods made by such original manufacturer.^(s) Infringe-
ment.

A person is liable to be sued in one and the same action both for the infringement of a patent or in the alternative for passing off his goods as and for those of the plaintiff.^(t) Patentee may
sue in one
action in
respect of in-
fringement and
passing off.

The public are secured against the injurious effects of illegal patents by the following remedies which exist for their protection :— Security of
public against
illegal patents.

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,^(u) and so defeat the action, for there can be no infringement of an invalid patent; and, unless the patent has all the elements of validity in itself, it cannot be made the means of complaint by reason of an alleged infringement.^(v)

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.^(y)

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.^(z)

INFRINGEMENT.

A person invades the exclusive rights of a patentee and commits an infringement when, without the licence of the owner for the time being of the patent, 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 *bona fide* experiment. Definition of
infringement.

There is no infringement unless that which is protected by

^(s) *Massam v. J. W. Thorley's Cattle Food Co.*, L. R. 6 Ch. D. 574; 14 Ch. D. 748.

^(t) *Lees v. West London Cycle Works*, (1892) 9 R. P. C. 300.

^(u) But see p. 522 *post*.

^(x) *Dudgeon v. Thomson*, (1877) L. R. 3 App. Cas. 37.

^(y) p. 391 *ante*.

^(z) p. 742 *post*.

**Infringe-
ment.**

the patent—*i.e.*, that which is claimed—is taken without the leave and licence of the patentee.(a)

Thus in a recent case it was held that a claim for a process for stiffening incandescent gas mantles, which was limited upon its proper construction to the use of suitable materials which set by cooling, was not infringed by the use of other suitable materials which set by evaporation.(b)

Patentee may
fix the ambit
of his claim.

Sometimes it is open to a patentee to claim more than he actually does claim, *e.g.*, he may be in a position to claim both a process and a result, but he prefers to limit his claim to the one or the other and not to make it wide enough to include both. There are obvious dangers in making too wide a claim and there are obvious disadvantages in making it narrower than the patentee is obliged to do, having regard to the validity of the patent.(c)

It must also be remembered that what is not embraced by the claim is to be considered as disclaimed, and, consequently, open to all the world.(d)

Also, if a patentee in his specification points away from the use of a certain thing, he cannot complain of its adoption by an alleged infringer.(e)

No infringe-
ment of the
equity of a
patent.

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)

(a) See p. 467 *post*.

(b) Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co., (1897) 14 R. P. C. 757.

(c) Lancashire Explosives Co. v. Roburite Explosives Co., (1897) 14 R. P. C. 311-312.

(d) Harrison v. Anderston Foundry Co., (1876) L. R. 1 App. Cas. 581; United Telephone Co. v. Harrison, (1882) L. R. 21 Ch. D. 741; Jackson v. Wolstenholmes, (1884) 1 R. P. C. 108; Lucas v. Miller, (1885) 2 R. P. C. 159; Easterbrook v. G. W. Ry. Co.,

(1885) 2 R. P. C. 208; Ticket Punch Register Co. v. Colley's Patents, (1896) 12 R. P. C. 171.

(e) Nobel's Explosives Co. v. Anderson, (1895) 12 R. P. C. 164; Morris v. Young (1895) 12 R. P. C. 466.

(f) Dudgeon v. Thomson, (1874) 30 L. T. N. S. 244; L. R. 3 App. Cas. 34, judgment of Cairns, L.C. See also per Smith, L.J., Ticket Punch Register Co. v. Colley's Patents, (1895) 12 R. P. C. 185; Lancashire Explosives Co. v. Roburite Explosives Co., (1889) 14 R. P. C. 311, 312.

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 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)

Infringe-
ment.

Intention and
its effect.

Evidence of intention may be of some value to a jury in dealing with the question whether an infringement has taken place or not ;(p) and also the Court takes it into account when deciding whether to grant or refuse an injunction,(q) and how to deal with the cost of the action.(r)

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, nor 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.(s)

On the other hand, where the defendant was a retail dealer who unwittingly sold articles which were an infringement of

(g) *McCormick v. Gray*, (1861) 7 H. & N. 25, 39; 31 L. J. Ex. 42; *Heath v. Unwin*, 15 Sm. 552; *Stead v. Anderson*, 2 W. P. C. (1847) 156; 4 C. B. 834; *Seed v. Higgins* (1858) 5 Jur. N. S. 540; S E. & B. 771; *Young v. Rosenthal*, (1884) 1 R. P. C. 29, 39.

(h) 2 W. P. C. 227 n.

(i) *Stead v. Anderson*, (1847) 2 W. P. C. 156; 4 C. B. 834; *Newall v. Elliott*, (1864) 10 Jur. N. S. 954; *Nobel's Explosives Co. v. Jones*, (1882) L. R. 8 App. Cas. 12, 13.

(k) *United Telephone Co. v. London, &c., Telephone Co.*, (1884) 1 R. P. C. 117; L. R. 26 Ch. D. 766; *Adair v. Young*, (1879) L. R. 12 Ch. D. 13.

(l) *Heath v. Unwin*, (1854) 2 W. P. C. 228, 315; 5 H. L. C. 505; *Wright v. Hitchcock*, (1870) L. R. 5 Ex. 37; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302; *Young v. Rosenthal*, (1884) 1 R. P. C. 39.

(m) *Walton v. Lavator*, (1860) 8 C.

B. N. S. 162; *Wright v. Hitchcock*, (1870) L. R. 5 Ex. 37; *Geary v. Norton* (1846) 1 De G. & S. 9; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302.

(n) *Plimpton v. Spiller*, (1877) L. R. 4 Ch. D. 286, 288.

(o) *Upmann v. Forrester*, (1883) L. R. 24 Ch. D. 231; *Wittman v. Oppenheim*, (1884) L. R. 27 Ch. D. 260; *Wright v. Hitchcock*, (1870) L. R. 5 Ex. 37; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302; *Walton v. Lavator*, (1860) 8 C. B. N. S. 162; *Geary v. Norton*, (1846) 1 De G. & S. 9; *Young v. Morris*, (1894) 11 R. P. C. 617.

(p) *Heath v. Unwin*, (1845) 2 W. P. C. 227, n.; see above.

(q) p. 594 *post*.

(r) p. 613 *post*.

(s) *Cooper v. Whittingham*, (1880) L. R. 15 Ch. D. 501; see also *Upmann v. Forrester*, (1883) L. R. 24 Ch. D. 231.

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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.(t) 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.(u)

Act done under subsequent patent is an infringement of a prior patent for the same invention.

When there is more than one patent for the same invention, anything done under one of those of subsequent date is an infringement of that which bears the earliest date;(x) 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;(y) neither can the infringer escape liability on the plea that the later patent was unsuccessfully opposed before the Comptroller by the plaintiff in the action. The proceedings before the Comptroller are irrelevant and immaterial to the action.(z)

Necessity for a determination of the exact invention protected.

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.(a)

(t) *Betts v. Wilmott*, (1870) 18 W. R. 946; *Nunn v. D'Abuquerque*, (1865) 34 Beav. 595; see also *Jenkins v. Hope*, (1895) 13 R. P. C. 57.

(u) *Upmann v. Elkan*, (1871) L. R. 7 Ch. App. Cas. 130.

(x) *Saxby v. Hennett*, (1873) L. R. S Ex. 210.

(y) *Thomson v. Batty*, (1889) 6 R. P. C. 84, 100.

(z) *Ticket Punch Register Co. v. Colley's Patents*, (1893) 12 R. P. C. 1, 15.

(a) *Dudgeon v. Thomson*, (1877) L. R. 3 App. Cas. 34; *Minter v. Wells*, (1834) 1 W. P. C. 134; *Stevens v.*

Keating (1847) 2 W. P. C. 181; *Muntz v. Foster* (1843) 2 W. P. C. 95; *Walton v. Potter*, (1841) 1 W. P. C. 585; *Gamble v. Kurtz*, (1846) 3 C. B. 425; *Trotman v. Wood*, (1864) 16 C. B. N. S. 479; *Hayward v. Pavement Light Co.*, (1884) 1 R. P. C. 207; *Nordenfelt v. Gardner*, (1884) 1 R. P. C. 61; *Walker v. Hydrocarbon Syndicate*, (1885) 2 R. P. C. 8; *Sugg v. Bray*, (1885) 2 R. P. C. 233; *United Telephone Co. v. St. George*, (1886) 3 R. P. C. 321; *Richardson v. Castrey*, (1887) 4 R. P. C. 265; *Ellington v. Clark*, (1888) 5 R. P. C. 135, 319; *Wenham v. May*, (1887)

The use of the word "colourable" or "colourably" in reference to an infringement is highly inappropriate, and apt to lead to great confusion, as connoting the idea that a patent may be infringed though the invention is not identically or substantially copied, if it is forgotten that the real question always is, Has the property of the patentee been taken? (b) The identity of the invention may be disguised, but there is no infringement unless what the infringer does is to take identically and substantially the patentee's invention. So a patent may be infringed by a colourable imitation, though there would be no infringement in the use of a mechanical or chemical equivalent. (c)

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Objection to the use of the word "colourable" or "colourably."

The proper way to consider the question of infringement is to assume that the plaintiff's patent is valid, and to construe it in the proper way, and then to see whether the defendant has taken a substantial part of the invention claimed without any regard to what anybody else had done before. The matter should be considered just as if the plaintiff's was the only patent and the only user prior to the defendant's. (d) The question of infringement is really a mixed one of law and fact. (e) It is the duty of the Court to construe the specification and claims together, (f) and thus to ascertain what is the nature of the invention protected by the patent; and this question must be determined by the Court independently of a jury, expert, or other witness. This is a rule which is often lost sight of by counsel in examining witnesses. (g) Expert evidence may, however, be relied on to explain technical terms, to show the practical working of machinery described or drawn, to point out what is old and what is new in the specification, and to show the particulars in which an alleged invention has been used by an alleged infringer, and the real importance of any differences between the plaintiff's invention and the alleged infringement, (h) as also the relative importance of the different

Right way to consider the question of infringement.

4 R. P. C. 303; Procter v. Bennis, (1887)
4 R. P. C. 333; Ehrlich v. Ihlee, (1888)
5 R. P. C. 198, 437; Garrard v. Edge,
(1889) 6 R. P. C. 372, 563; Boyd v.
Horrocks, (1889) 6 R. P. C. 152, 528;
Automatic Weighing Machine Co. v.
Combined Weighing Machine Co.,
(1889) 6 R. P. C. 121, 367; Shaw v.
Jones, (1889) 6 R. P. C. 328; Winby
v. Manchester, &c., Steam Tramways
Co., (1889) 6 R. P. C. 359, 365; 7 R.
P. C. 30. (b) *Ibid.*

(c) Tweedale v. Howard and Bul-
lough, (1896) 13 R. P. C. 536; in con-
junction with Tweedale v. Ashworth,

(1892) 9 R. P. C. 121; also Scott v.
Hull Steam Fishing Co., (1897) 14 R.
P. C. 143; in conjunction with Scott
v. Hamling, (1897) 14 R. P. C. 123;
also p. 481 *post*.

(d) Per Lord Esher, M.R., Lyon v.
Goddard, (1893) 10 R. P. C. 341.

(e) p. 237 *ante*; Seed v. Higgins,
(1860) 8 H. L. C. 565; Curtis v. Platt,
(1866) 35 L. J. Ch. 852.

(f) p. 247 *ante*.

(g) *Ibid.* Brooks v. Steel, (1896)
14 R. P. C. 47; pp. 570, 578 *post*.

(h) *Ibid.*; Brooks v. Steel, (1896)
14 R. P. C. 47.

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parts of the invention, in order to ascertain whether the substance has been appropriated.⁽ⁱ⁾ It is the duty of the Court to construe the specification quite apart from what the defendant has done. The first canon of construction is that the specification must be construed, like all other written instruments or business documents, as if the Court had to construe it the day after it was published; and the Court is bound to construe the specification as if it had to be construed before the defendant was born, if the patent was before that time.^(k)

Importance of
ascertaining
the principle
of the inven-
tion protected.

In this connection it is always most important to consider what is the principle of the invention.^(l) 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,^(m) but is intended to mean a practical application of one or more of those first principles which is properly denominated 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.⁽ⁿ⁾ 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 from the cylinder. 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 patented article, if he could obtain an article substantially the same at a cheaper rate.^(o)

(i) *Clark v. Adie*, (1873) L. R. 10 Ch. 667; L. R. 2 App. Cas. 315; *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 302; pp. 470, 471, 570 *post*.

(k) *Nobel's Explosives Co. v. Anderson*, (1894) 11 R. P. C. 523, judgment of *Esher*, M.R.

(l) *Thomson v. Moore*, (1889) 6 R. P. C. 426, 450.

(m) p. 37 *ante*.

(n) p. 21 *ante*.

(o) *Hindmarch on Patents*, pp. 493, 494; *Thomson v. Moore*, (1889) 6 R. P. C. 426, 450.

Thus, when a principle in the above sense is invented and the infringer takes the principle and alters the details, and yet it is obvious that he has taken the idea which has been the subject-matter of the invention, and has simply altered the details so as to avoid the possibility of its being suggested that he has taken the same thing, the Court can look through the mere variation of details and see that the substance and pith of the invention has been pirated, and consequently can protect the inventor.^(p) In another class of cases, although a certain principle is common to a variety of manufactures, the subject-matter of the patent is really the particular mechanical mode by which that common principle is carried into effect,^(q) and such patents are only infringed when the particular mechanical mode which is the subject-matter of the patent is copied.

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Adoption of the principle of the invention protected, though details differ, is an infringement.

Crossley v. Beverley (r) may be given as an example of the point under discussion. In that case 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 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." (s)

In short, if the pith and marrow—*i.e.*, substance—of the

(p) *Tweedale v. Ashworth*, (1892) 9 R. P. C. 126; *Moor v. Thomson*, (1890) 7 R. P. C. 325; *Badischen Anilin und Soda Fabrik v. Levinstein*, 24 Ch. D. 170; *Sellers v. Dickinson*, (1850) 5 Ex. R. 312, 324, in which cases the infringement was quite outside the specification, but not the invention.

(q) Per *Halsbury*, L.C., *Tweedale v. Ashworth*, (1892) 9 R. P. C. 126; *Curtis v. Platt*, (1863) L. R. 3 Ch. D. 135 n.

(r) (1829) 1 W. P. C. 106.

(s) *Jupe v. Pratt*, (1837) 1 W. P. C. 146.

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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.(t)

It rarely happens that an infringer takes the identical thing described and claimed by the patentee. He usually modifies it or dresses it up with some additional matters. Nevertheless, if he has taken the substance or pith and marrow of the patentee's invention he is guilty of an actionable infringement,(u) and this notwithstanding the fact that everything done by the patentee since the date of the patent may be an improvement upon it. The question is whether the defendant has taken the substance or pith and marrow of the plaintiff's invention as claimed in his specification; and this invention may be infringed although the defendant uses it in conjunction with an improvement which is not within the ambit of the patentee's claim.(x)

Relative im-
portance of
parts is a
question to
be settled by
evidence.

The relative importance of the different parts of the patentee's combination or process is a question to be settled by evidence.(y) The fact, if such be the case, that the patentee in the specification attaches an undue importance to the use of something, handicaps him, no doubt, in a contest as to infringement, but has no further weight, and the Court is free to exercise its own judgment in weighing this fact with others when dealing with the question of infringement.(z)

(t) *Erlich v. Ihlee*, (1888) 5 R. P. C. 437; *Hayward v. Hamilton*, (1881) Griff. P. C. 115, 124; *Proctor v. Bennis*, (1887) L. R. 36 Ch. D. 740, 756; *Cannington v. Nuttall*, (1871) L. R. 5 E. & I. App. 205; 40 L. L. J. Ch. 739; *Neilson v. Harford*, (1841) 1 W. P. C. 310; *Russell v. Ledsam*, (1847) 14 M. & W. 579; *Bateman v. Gray*, (1853) Macr. P. C. 102; *Saxby v. Clunes*, 43 L. J. Ex. 228-241; *Thorn v. Worthing Skating Rink Co.*, (1877) L. R. 6 Ch. D. 415; *Plimpton v. Spiller*, (1875) L. R. 4 Ch. D. 286; *Curtis v. Platt*, (1863) L. R. 3 Ch. D. 135 n.; 35 L. J. Ch. 852; *Spencer v. Ancoats, &c., Co.*, (1889) 6 R. P. C. 46; *Thompson v. Batty*, (1889) 6 R. P. C. 84; *Thompson v. Moore*, (1889) 6 R. P. C. 428; 7 R. P. C. 325; *Wilson v. Barbour*, (1888) 5 R. P. C. 245, 675; *Nordenfelt v. Gardner*, 1 R. P. C. 61; *Automatic Weighing Machine Co.'s cases*; *Boyd v. Horrocks*, 5 R. P. C. 557; 6 R. P. C. 152; 9 R. P. C. 77; *Montgomerie v. Paterson*, 11 R. P. C. 221, 633; *Wenham*

Gas Co. v. Champion Gas Lamp Co., 8 R. P. C. 373; 9 R. P. C. 49; *Actien Gesellschaft für Cartonnagen Industrie v. Schroeder*, 13 R. P. C. 466; *Dudgeon v. Thomson*, (1877) L. R. 3 App. Cas. 34; *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 301, 559; *Proctor v. Bennis*, (1877) L. R. 36 Ch. D. 740; *Clark v. Adie*, (1873) L. R. 10 Ch. 667; 2 App. Cas. 315; *North British Rubber Co. v. Macintosh*, (1894) 11 R. P. C. 477; *North British Rubber Co. v. Gornully and Jeffery Manufacturing Co.*, (1896) 13 R. P. C. 691; 14 R. P. C. 283; 15 R. P. C. 245; *Lane v. Herold*, (1892) 9 R. P. C. 447; *English and American Machinery Co. v. Union Boot and Shoe Co.*, (1894) 11 R. P. C. 137, 367. (u) *Ibid.*

(x) *Dudgeon v. Thomson*, (1877) L. R. 3 App. Cas. 34. (y) p. 471 *post.*

(z) *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 331; judgment of Wills, J.

Though a claim to the details of a process may mention *nominatim* the use of a specific thing, it may be none the less infringed by the adoption in the process specified of a manufacturing equivalent for the specific thing mentioned, when such specific thing is not of the essence of the invention—*e.g.*, the substitution of a depositing tank for the centrifugal separating machine mentioned in the claim for the patented process for the manufacture of lanolin.^(a)

With regard to the true way in which to determine what is important and what is of subsidiary consequence in reference to the patentee's invention, the following passage from the judgment of *Wills, J.*, in the recent case of *Incandescent Gas Light and Coke Co. v. De Mare Incandescent Gas Light System*^(b) may be quoted with great advantage as dealing with some of the older cases on the subject:—

“It is contended by the defendants that what is important and what is of subsidiary consequence can only be gathered from the specification itself. I am satisfied that that neither is, nor can be, the law. Certainly *Dudgeon v. Thomson*, (1877) L. R. 3 App. Cas. 34, which is cited as an authority to that effect, says nothing of the kind. ‘Additions and subtractions,’ says Lord *Cairns*, ‘may exist, and yet the thing protected by the specification may be taken notwithstanding.’ There are no means of ascertaining whether, notwithstanding additions or subtractions, the invention has been taken except by seeing what they are worth as compared with the things which have been taken bodily from the invention. In the case of a patent for a combination, or for a series of operations, the specification very often contains no clue to the inventor's own view of the relative importance of the different elements in the combination. If he says nothing on the subject you must conclude that, as far as the specification goes, they are all presented as of equal importance, and all as essential parts of the combined whole, and yet there may be infringement notwithstanding ‘slight variations.’^(c) ‘So again,’ says *Cotton, L.J.*,^(d) ‘omissions and additions may be very material in considering whether, in fact, the machine of the defendant is an infringement of the combination which the plaintiff claims.’ Omissions and additions may even be improvements, but that fact ‘does not enable you,’ says *Bowen, L.J.*, ‘to take the substance of the plaintiff's patent.’^(e) ‘If the instrument patented,’ says Lord *Cairns*, ‘consists of

(a) *Benno Jaffé und Darmstadter Lanolin Fabrik v. Richardson*, (1893) 11 R. P. C. 93, 261.

(b) (1896) 13 R. P. C. 330.

(c) *Cotton, L.J.* in *Proctor v. Bennis*, (1887) L. R. 36 Ch. D. 740-754.

(d) *Ibid.* p. 756.

(e) *Proctor v. Bennis*, (1887) L. R. 36 Ch. D. 756.

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twelve different steps producing in the result the improved clipper, an infringer who had taken eight, nine, or ten of those steps might be held by the tribunal judging of the patent to have taken the substance, the pith and marrow of the invention, although there are one, two, three, four, five steps which might not actually have been taken.' (*f*) In such a case, as far as the specification went, the patentee would, under ordinary circumstances, treat the whole of the twelve steps as essential parts of his combination, and, so far as the specification went, there would be nothing to indicate that any one of them was not indispensable or was of less importance than the others. In *Procter v. Bennis* there was nothing to indicate that the patentee thought the parts of his combination omitted or varied by the defendant of anything but cardinal importance. How was the question suggested by *Cotton, L.J.*, whether the variations were 'slight' to be ascertained, except by evidence as to the relative importance of the variations in question as compared with the patented combination as a whole? 'There is, or may be, says *James, L.J.*, and *Mellish, L.J.*, 'an essence or substance of the invention underlying the mere accident of form: and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination.' (*g*) Drop the word 'combination,' which is perfectly immaterial as regards the principle, and every word is applicable to the present case. *Mr. Bousfield* says I am not entitled to take this as an accurate statement of the law, as the case went to the House of Lords, and no such doctrine is, as he contends, enunciated by the Law Lords. This, however, is a mistake. *Lord Cairns* expressly says: 'I am quite satisfied with the judgment of the learned Lords Justices, and I should have been content to rest the decision of this case upon that judgment, but for its importance.'" (*h*)

Substance and principle of the invention is always the important question.

In each case the substance of the invention and the principle of the machine and not the mere form are to be looked to. If what the defendant does is in principle not the same but really different there is no infringement; (*i*) and the question always is, not whether the substantial part of the process or combination said to be an infringement has been taken from the patentee's specification, but the very different one, whether

(*f*) *Clark v. Adie*, (1873) L. R. 2 App. Cas. 315-320.

(*g*) *Clark v. Adie*, (1873) L. R. 10 Ch. App. 667-675.

(*h*) (1877) L. R. 2 App. Cas. 326.

(*i*) *Morgan v. Seaward*, (1836) 1 W. P. C. 171.

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what is done or proposed to be done takes from the patentee the substance of his invention as claimed. "A process might be wholly gathered from a specification and nowhere else, and yet be no infringement if it did not take substantially the thing invented. What the thing invented is must be gathered from the specification alone, and the patentee cannot escape from the thing he has claimed as the standard, and the only standard, with which to compare the alleged infringement so as to see if it constitutes substantially the appropriation of the thing claimed." (k)

Thus a person may be entitled to take the pith and marrow in one sense of the patentee's invention; (l) what he is not entitled to do is to take its substance. The term "pith and marrow" used by Lord Cairns and many Judges since is, as *Wills, J.*, has pointed out, not so good a one to use as "substance of the invention," for it is very easy to misapply it, and it would be very likely to mislead a jury. To quote *Wills, J.*, again: "'Pith' is a great deal less than the substance of the vegetable structure of which it is part, and 'marrow' is a great deal less than the substance of the animal structure of which it is part. Metaphors are very apt to mislead, as they are seldom close enough to the things to which they are applied." (m)

Though it may be lawful to take the pith and marrow in one sense of a patented invention, it is never lawful to take its substance without licence.

The "pith and marrow" of the *Welsbach* process of gas illumination is the construction of a mantle or skeleton of materials which will incandesce when subjected to the heat of a flame, but the "substance" of the invention claimed in the *Welsbach* specification is moulding the illuminant into shape by a certain chemical process of reduction from salts, with the necessary consequence that the skeleton is homogeneous throughout. It has been held that it is no infringement of this claim to produce a mantle which will incandesce, by a process consisting in first forming a mantle of alumina and zinconia homogeneous throughout and strong, but giving little incandescence, and secondly, coating this with a thin layer of oxide of chromium, which incandesces well. In such a structure the illuminant is not (as in the *Welsbach* process) that portion of a homogeneous mantle which is exposed to the flame, but a foreign substance laid on in a thin film and quite absent from the bulk of the substance. Though this is an appropriation of the pith and

(k) Per *Wills, J.*, *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 330.

(l) *Incandescent Gas Light Co. v. Sunlight Incandescent Gas Lamp Co.*, (1896) 13 R. P. C. 345; *Lancashire*

Explosives Co. v. Roburite Explosives Co., (1897) 14 R. P. C. 303.

(m) Per *Wills, J.*, *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 332.

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marrow of the *Welsbach* invention, it is not such a taking of the substance of it as will constitute an infringement of the claim. The patentee did not and could not claim the formation of a skeleton by other means and of other substances than those pointed out in the specification, or by means substantially identical and apart from the contemporaneous formation of the illuminants, and so the Court was reluctantly compelled to hold that there was no infringement.⁽ⁿ⁾

On the other hand, it has been held that to vary by omission and alteration the non-essential details of the chemical process claimed in the *Welsbach* specification, but at the same time to produce an illuminant which is homogeneous throughout, though in a form of a fringe of threads instead of a mantle as described in the specification, is to take the substance of the *Welsbach* invention and so to commit an infringement.^(o)

Again, in an action brought for the infringement of *Bartlett's* patent for "improvements in tyres or rims for cycles and other vehicles," ^(p) *Romer, J.*, held that the essence of *Bartlett's* invention was the combination of an outside flexible tyre that can be easily removed, because it is not itself a complete tube, and of an inside complete tube capable of inflation, so that when the inside tube is inflated the flexible tyre is kept on to the grooved metal rim of the wheel by the pressure of the sides of the flexible tyre against the groove. The patentee in his specification pointed out that by thickening the sides or edges of the flexible tyre the grip could be increased; and obviously the more the grip was increased the more difficult it would be for the inside complete tube, if made elastic, to force the flexible tyre out of the narrow mouth of the grooved metal rim. The defendants took the patentee's idea and the essence or substance of his invention. All they did in substance, by way of alteration, was to increase the size of the outside flexible tyre and the thickening of its edges, and to exaggerate the dovetailing of the metal grooved rim, so as to give a greater grip, and to render it more difficult for the flexible tyre to be forced out of the mouth of the groove, and thus they were enabled to employ for the inflatable inside tube a more elastic tube than that mentioned in the body of the specification. The Judge held that the defendant's tyre might be an improvement upon the plaintiff's, but still, in substance, it was the plaintiff's and an

⁽ⁿ⁾ *Incandescent Gas Light Co. v. Sunlight Incandescent Lamp Co.*, (1896) 13 R. P. C. 333, 345.

De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 301, 559.

^(p) *North British Rubber Co. v.*

Incandescent Gas Light Co. v.

Macintosh, (1894) 11 R. P. C. 477.

infringement of the patent. Other points incidental to the structure of the different parts of the combination used by the defendants were urged as differentiating it from the plaintiff's, but unsuccessfully, in face of the finding of the Court that the essence or substance of the plaintiff's invention was present in the defendant's combination.(g)

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So also a patent for a chemical mixture or compound suitable for a beetle poison was held to be infringed by the addition of non-material ingredients to the material ingredients specified by the patentee.(r) And in a case where the defendants took what was the merit of the plaintiff's improved sewing machine—*i.e.*, using a looper in such a way and with such a variety of machinery as to present the thread at a sufficient tension to the notch of the needle, though they introduced a portion of an alleged anticipating but useless machine, which was not necessary to the plaintiff's mechanism, they were held to have infringed.(s)

An arrangement, though it be an infringement of a prior patent, may be such as would itself support a patent on the ground of novelty. The criterion of novelty and infringement in this respect are not the same. This point was stated by *Pollock, C.B.*, in *Newton v. Grand Junction Railway Co.*(t) Thus:—

Criterion of
novelty and
infringement
are not the
same.

“It was agreed that the same criterion is to be applied to the question of infringement as to that of novelty. But that is not so. In order to ascertain the novelty, you take the entire invention, and if in all its parts combined together it answer the purpose by the introduction of any new matter, by any new combination, or by a new application, it is a novelty entitled to a patent. But in considering the question of infringement, all that is to be looked at is, whether the defendant has pirated a part of that to which the patent applies; and if he has used that part for the purposes for which the patentee adapted his invention and for which he has taken out his patent, and the jury are of opinion that the difference is merely colourable, it is an infringement.”(u)

(g) See also *North British Rubber Co. v. Gormully and Jeffery Manufacturing Co.*, (1896) 13 R. P. C. 691; 14 R. P. C. 283; 15 R. P. C. 245; *Pneumatic Tyre Co. v. Tubeless Tyre*, (1897) 15 R. P. C. 74, 236; *White v. Bertrams*, (1897) 14 R. P. C. 501, 735; and as to the true construction of the claims of the Welch patent for bicycle tyres and what was and what was not held to be an infringement see the following cases: *Pneumatic Tyre Co. v. Caswell*, (1896) 13 R. P. C. 164, 375;

Pneumatic Tyre Co. v. East London Rubber Co., (1897) 14 R. P. C. 77, 573; *Pneumatic Tyre Co. v. Ixion Patent Pneumatic Tyre Co.*, (1897) 14 R. P. C. 853.

(r) *Lane v. Herold*, (1892) 9 R. P. C. 447.

(s) *English and American Machinery Co. v. Union Boot and Shoe Co.*, (1894) 11 R. P. C. 137, 367.

(t) (1846) Ex. R. 334; 20 L. J. Ex. 427 n.

(u) See p. 467 *ante*.

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ment.**

Combination
may be in-
fringed by an
unlawful
taking of its
substance.

In further pursuance of the principle under discussion, viz., that there is no infringement unless the substance of the invention claimed is pirated by the alleged infringer, the following remarks of Lord *Cairns*, L.C., and Lord *Esher*, M.R., made in reference to patents for combinations, may be usefully quoted :—

Lord *Cairns* in *Clark v. Adie*, (1877) L. R. 2 App. Cas. 320, 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 : “ One mode of infringement would be a very simple and clear one : the infringer would take the whole instrument from beginning to end, and would produce a clipper made in every respect like the clipper described in the specification. About an infringement of that kind no question could arise. The second mode would be one which might occasion more difficulty. The infringer might not take the whole of the instrument here described, but he might take a certain number of parts of the instrument 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."

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ment.

Lord *Esher*, M.R., speaking on the same question, in reference to the patent for the *Nordenfelt* gun in *Nordenfelt v. Gardner* (1884), 1 R. P. C. 61, 65, said: "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 combination, 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 the putting in of a

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ment.

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."

Thus, the substitution of a weighted valve for a water valve or column in a combination forming a milking machine was held to be an infringement.^(x) Also the substitution of a pump, though contrived with great ingenuity, for a bellows in a smoke-testing and fumigating apparatus.^(y) Again, a patent for an improved carriage lamp, in which the candle tube was prevented from falling out by means of a flat sliding bolt which engaged with a knob on the tube being pushed home by the coachman's hand, or simply by shutting the door of the lamp, and kept in its place by contact with the door when shut, was infringed by a sliding bolt with spring engaging with a collar on the tube and kept in position by the shut door of the lamp.^(z)

But if the defendant's combination is really a different one to the plaintiff's there is no infringement.^(a)

Special claims
for subsidiary
parts of a com-
bination.

It has been explained ^(b) 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, depends upon whether or not the parts are claimed separately, or whether taken together they are claimed 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 separately or whether they are claimed together as a separate subordinate combination within the larger combination consisting of A, B and C.^(c)

A patent for a combination is infringed by the use of a subordinate part only, if that part is new and material and is

^(x) (1893) 10 R. P. C. 417.

^(y) Macdonald v. Fraser, (1893) 10 R. P. C. 386; 11 R. P. C. 169.

^(z) Howes v. Webber, (1895) 12 R. P. C. 465; 13 R. P. C. 39.

^(a) Automatic Diversions Syndicate v. Urry, (1897) 14 R. P. C. 365.

^(b) p. 228 *ante*.

^(c) Clark v. Adie, (1877) L. R. 2 App. Cas. 335.

the subject of a claim ; (*d*) 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, since the patentable novelty claimed is the combination of the two. (*e*)

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ment.

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. (*f*) 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?" (*g*)

When the ambit of the claim is not limited to the particular thing specified, the law will not allow a person to take an article described by the patentee 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. (*h*)

Equivalents
substituted for
specified parts.

In fact, when, having regard to the state of public knowledge, a narrow construction is not to be put upon the claim, (*i*) it is an infringement to substitute mechanical equivalents for parts of the patentee's invention and add at the same time an improvement ; (*k*) 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. (*l*)

(*d*) *Lister v. Leather*, (1857) 8 E. & B. 1004 ; *Parkes v. Stevens*, (1869) L. R. S Eq. 358, 366 ; L. R. 5 Ch. App. 36 ; *Wright v. Hitchcock*, (1870) L. R. 5 Ex. 37 ; *Foxwell v. Bostock*, (1863) 12 W. R. 723 ; *Sellers v. Dickinson*, (1850) 5 Ex. 312 ; *Newton v. Grand Junction Ry.*, (1846) 5 Exch. 331 ; *Smith v. London and North-Western Ry.*, (1853) 2 E. & B. 69 ; *Young v. Rosenthal*, (1884) 1 R. P. C. 33 ; *Clark v. Adie*, (1873) L. R. 10 Ch. App. Cas. 667 ; 3 Ch. D. 134, 143 ; 2 App. Cas. 315, 327, 335.

(*e*) *Smith v. London and North-Western Ry.*, (1853) 2 E. & B. 69, 76.

(*f*) *Ibid.*

(*g*) See per Cotton, L.J., *Proctor v. Bennis*, (1887) L. R. 36 Ch. D. 254, 740 ; 4 R. P. C. 333 ; see also *Burnett v. Tate*, (1882) 45 L. T. N. S. 143 ; *Murray v. Clayton*, L. R. 10 Ch. App. Cas. 675 n. ; *Kaye v. Chubb*, (1888) 5

R. P. C. 641 ; *Garrard v. Edge*, (1889) 6 R. P. C. 372, 563.

(*h*) *Bateman v. Gray*, (1853) Macr. P. C. 102 ; *Morgan v. Seaward*, (1837) 1 W. P. C. 171 ; *Thorn v. Worthing Skating Rink Co.*, (1876) L. R. 6 Ch. D. 415 n. ; *United Telephone Co. v. Harrison Cox-Walker*, (1882) L. R. 21 Ch. D. 720 ; *United Telephone Co. v. Bassano*, (1886) 3 R. P. C. 295 ; *United Telephone Co. v. St. George*, (1886) 3 R. P. C. 321 ; *Hancock v. Moulton*, *Johns. Pat. Man.* 5th ed. p. 254.

(*i*) p. 480 *post*.

(*k*) *Proctor v. Bennis*, (1887) 4 R. P. C. 333 ; L. R. 36 Ch. D. 740 ; *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 437, 454.

(*l*) *Proctor v. Bennis*, (1887) 4 R. P. C. 333 ; 36 Ch. D. 740, 755 ; *Needham v. Johnson*, (1884) 1 R. P. C. 49 ; *Gwynne v. Drysdale*, (1886) 3 R. P. C. 65, 67 ; *Cannington v. Nuttall*, (1871) L. R. 5 H. L. 205.

**Infringe-
ment.**Rule in *Sellers*
v. Dickinson.

It is an accepted proposition of patent law, known as the rule in *Sellers v. Dickinson*,^(m) 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.

Equivalents
not known at
the date of the
patent.

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 no infringement of the prior patent.⁽ⁿ⁾ Thus, rendering cast steel easy to weld and malleable by subsequently discovered equivalents, viz., 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^(o) to be no infringement of a prior patent for doing the same thing by means of carburet of manganese, although there was evidence to the effect that carburet of manganese was formed by exposing the mixture of carbon and oxide of manganese to a high temperature. This decision of the House of Lords was substantially to the same effect as that of Lord *Abinger*, C.B., in the Court of Exchequer, viz., that the materials or elements of carburet of manganese, as used by the defendant, being out of all proportion cheaper than the carburet of manganese itself, the use of such materials in the composition was a new discovery or invention, and not within the letters patent.^(p)

State of public
knowledge
affects the
question
whether or
not the substi-

With regard to the question of the infringement of patents by the substitution of equivalents for parts described by the patentee in the specification, it must be remembered that it is necessary first to determine the true construction of the speci-

(m) 5 Exch. 312, 326; 20 L. J. N. S. Ex 417.

(n) *Badische Anilin und Soda Fabrik v. Levinstein*, (1883) L. R. 24 Ch. D. 156, 170-173; L. R. 12 App. Cas. 710; *Heath v. Unwin*, (1855) 5 H. L. C. 545; *Automatic Weighing Machine*

Co. v. Knight, (1889) 6 R. P. C. 113, 300; *Thompson v. Moore*, (1889) 6 R. P. C. 426; 7 R. P. C. 329.

(o) *Heath v. Unwin*, (1855) 5 H. L. Cas. 505.

(p) *Heath v. Unwin*, (1855) 2 W. P. C. 217; 5 H. L. C. 505.

fication, and so ascertain what is the real invention claimed.^(q) It must also be borne in mind that the true construction of the specification is affected (*inter alia*) by the state of public knowledge at the date of the patent.^(r) The substitution of an equivalent in the place of a part mentioned in the patentee's specification may, or may not, be an infringement according as the state of public knowledge affects the true construction of the claim. Thus, when the invention relates to the production of an old result, or a machine of a known type, the patentee is protected only in respect of the particular means of performing the invention he sets forth in the specification; and under such circumstances it may be no infringement to achieve the same result by the use of well-known equivalents.^(s)

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tution of known equivalents is an infringement in a particular case, *i.e.*, public knowledge affects the true ambit of the claim.

In such a case it is necessary to give the claim the limited construction above indicated, for the rule is that the specification is to be construed so as to support the patent, if it can fairly and logically be done,^(t) and if a wider construction were put upon it under the circumstances indicated it would claim what had been done before, and so make the patent void for want of novelty.

On the other hand, when the invention consists in the production of a new result, or a machine which is of a totally new type, the patentee is not tied down strictly to the particular means of performing the invention, or the identical parts he sets forth in the specification; and under such circumstances it is an infringement to substitute known equivalents for the parts specified, and at the same time to make use of the novel principle the carrying of which into effect is the real substance of the patentee's invention.^(u)

Curtis v. Platt,^(x) which followed the prior House of Lords' decision in *Seed v. Higgins*,^(y) and the principle of which was also applied by the House of Lords in *Boyd v. Horrocks*,^(z) and in *Morris v. Young*,^(a) is usually cited as the leading authority

Curtis v. Platt and *Proctor v Bennis* as types of the two classes of cases.

^(q) pp. 237, 466 *ante*.

^(r) pp. 251, 253 *ante*.

^(s) *Curtis v. Platt*, (1866) L. R. 3 Ch. D. 135 n; *Seed v. Higgins*, (1860) H. L. C. 550; *Gosnell v. Bishop*, (1888) 5 R. P. C. 550; *Atkiebolaget Separator v. Dairy Outfit Co.*, (1897) 14 R. P. C. 473.

^(t) p. 253 *ante*.

^(u) *Clark v. Adie*, (1887) L. R. 2 App. Cas. 315; *Proctor v. Bennis*, (1887) L. R. 36 Ch. D. 740; *Boyd v. Horrocks*, (1891) 9 R. P. C. 77.

^(x) (1863) L. R. 3 Ch. D. 135 n.

^(y) (1860) 8 H. L. C. 550.

^(z) (1892) 9 R. P. C. 77.

^(a) (1895) 12 R. P. C. 455. The rule in *Curtis v. Platt* was also applied in the following cases: *Bovill v. Pimm*, (1856) 11 Exch. 718; *British Tanning Co. v. Groth*, (1891) 8 R. P. C. 113; *Jahncke v. Bell*, (1892) 9 R. P. C. 94; *Nettlefolds v. Reynolds*, (1892) 9 R. P. C. 270; *Parkinson v. Simon*, (1894) 11 R. P. C. 238, 493; *Ticket Punch Register Co. v. Colley's Patents*, (1894) 12 R. P. C. 1, 171; *Shoe Machinery Co. v. Cutlan* (2), (1896) 13 R. P. C.

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with reference to the first class of cases, and *Proctor v. Bennis*,^(b) the principle of which was approved by the House of Lords in *Moore v. Thomson*,^(c) as the leading authority with reference to the second class of cases.

Curtis v. Platt.

In *Curtis v. Platt*,^(d) where the patent was for certain improvements in spinning mules, a class of machine previously well known, and the invention consisted in a novel combination of old parts, all of which had been previously used before, though not in the same combination, for a similar purpose, Lord *Hatherley* (then Vice-Chancellor *Wood*) and Lord *Westbury*, L.C., followed the rule laid down by the House of Lords in *Seed v. Higgins*,^(e) 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 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."^(f)

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, the patentee must be held to the description which he gives of

141; *Cleaver v. Wallwork*, (1896) 13 R. P. C. 277; *Birch v. Harrap* (1896) 13 R. P. C. 615; *Scott v. Hamling*, (1897) 14 R. P. C. 123; *Scott v. Hull Steam Fishing and Ice Co.*, (1897) 14 R. P. C. 143.

^(b) (1887) L. R. 36 Ch. D. 740; 4 R. P. C. 333.

^(c) (1890) 7 R. P. C. 325. The rule in *Proctor v. Bennis* was held to

apply in *Gosnell v. Bishop*, (1887) 5 R. P. C. 41, 151; *Peckover v. Rowland*, (1893) 118, 234; *Jardine v. King, Mendham & Co.*, (1896) 13 R. P. C. 411.

^(d) (1863) L. R. 3 Ch. D. 135 n; L. R. 1 H. L. 337.

^(e) (1860) 8 H. L. Cas. 550.

^(f) Per Page Wood, V.C., *Curtis v. Platt*, (1863) L. R. 3 Ch. D. 135 n.

the particular means by which his invention is to be carried into effect, and that there can be no infringement by the substitution of parts. 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."(*g*) Or, to put it in another way, where at the date of the patent there were other known combinations of elements equivalent to the elements of the patentee's combination, and the real invention is neither more nor less than the substitution of a combination of elements for and mechanically equivalent to the elements of the mechanism previously known and used to attain the same end as the patentee's combination attains, the patentee is not in a position to take benefit from the principle of mechanical equivalents. In such circumstances there can be no infringement unless the apparatus complained of is in substance identical with the combination claimed by the patentee.*(h)* Consequently under such circumstances a claim for a particular means to effect certain purposes is not infringed where the same purposes are effected by different means;*(i)* 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;*(k)* but the claim is infringed when a variation in detail which amounts only to a colourable imitation is used.*(l)* When there is not only novelty in the machine, but also novelty in the result it produces, *Curtis v. Platt* does not apply.*(m)*

In *Proctor v. Bennis* *(n)* the patent in question related to a new combination of tappets, shafts and springs in connection with a flap or door, producing a new kind of mechanical inter-

Proctor v. Bennis.

(g) Per Cotton, L.J., *Proctor v. Bennis*, (1887) L. R. 36 Ch. D. 756, 757; see also *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 437; *Boyd v. Horrocks*, (1889) 6 R. P. C. 152, 558; *Thompson v. Moore*, (1889) 6 R. P. C. 426; *Brown v. Jackson*, (1895) 12 R. P. C. 324.

(h) *Miller v. Clyde Bridge Steel Co.*, (1891) 8 R. P. C. 198; 9 R. P. C. 470, 478; *Gosnell v. Bishop*, (1888) 5 R. P. C. 159, judgment of Bowen, L.J.

(i) *Sugg v. Bray*, (1885) 2 R. P. C. 233-9; p. 48 *ante*.

(k) *Lawrence v. Perry*, (1885) 2 R. P. C. 179, 188; *Boyd v. Horrocks*, (1889) 6 R. P. C. 152; 9 R. P. C. 77; *Automatic*

Weighing Co. v. Knight, (1889) 6 R. P. C. 113, 297.

(l) See p. 490 *post*; *Boyd v. Horrocks*, (1888-91) 5 R. P. C. 557; 6 R. P. C. 152.

(m) Per Cotton, L.J., *Proctor v. Bennis*, (1887) L. R. 36 Ch. D. 756, 757; see also *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 437; *Boyd v. Horrocks*, (1889) 6 R. P. C. 152, 558; *Thompson v. Moore*, (1889) 6 R. P. C. 426; *Brown v. Jackson*, (1895) 12 R. P. C. 324; *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 113.

(n) (1887) 4 R. P. C. 333; L. R. 36 Ch. D. 740.

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mittent radial stoker for distributing coal on the fires of furnaces. The novel feature of this machine as compared with others was that in it the result of throwing coal on to the furnace by the intermittent radial action of a flap or door was for the first time applied. There was thus not only novelty in the machine, but there was novelty in the effect and the result produced. The defendant did not copy exactly the plaintiff's machine; on the contrary, the defendant's combination looked at first sight very different to the plaintiff's. What the defendant really did was to omit certain parts from the patented combination and to substitute mechanical equivalents for other parts. Therefore, although the defendant had not got the exact combination, yet he had got the combination in substance and result by putting mere mechanical equivalents for those things which were in the plaintiff's machine and which were protected in combination by his patent as the combination which he successfully claimed to have invented.

The Court of Appeal held that, notwithstanding the substitution of the equivalents above referred to for analogous parts in the plaintiff's combination as specified, the defendant infringed because he had adopted the substance of the plaintiff's patented invention, and not the less so though he had added certain further improvements. *Cotton, L.J.*,⁽ⁿ⁾ referring to *Curtis v. Platt*,^(o) and distinguishing that case from the present, in his judgment said:—

“ The plaintiff there was a patentee or the assignee of a patent for improvements in spinning mules. A spinning mule was a well-known machine, working and acting long before the patent on which the plaintiff in that case relied was taken out, and it was necessary in such a machine that there should be an intermission of the action of certain parts, although the motive power was still acting on the machine as a whole. That result had been produced before the patent in question by, amongst other means, the patent of *Roberts* and the patent of *Lakin* and *Rhodes*, and they had done it by adopting certain mechanical means. What the patentee whose patent was relied on by the plaintiff did was to correct and improve the means which they described in their patents for the purpose of obtaining that result; and that, therefore, is a most material matter, because I find at page 857 of the 35 L. J. Ch., where the specification of the patent is set out, that what the patentee claimed was ‘ the novel construction, combination, and application of mechanism as

⁽ⁿ⁾ 4 R. P. C. 355.

^(o) (1866) L. R. 3 Ch. D. 135 n; 35 L. J. Ch. 852.

hereinbefore described, whereby one-half of the clutch or catch-box hereinbefore, and in the said specification of *Robert Lakin* and *William Henry Rhodes* described, or any mechanical equivalent therefor, is connected with and acts upon the cams or other similar parts of mechanism for effecting the changes in the action of the mule.' So that there he refers to that previous patent, and I think he also had done so with reference to the previous patent of the other patentee which I have mentioned. It was specially to introduce improvements into the mechanical means and arrangements which a previous patentee had used to obtain a well-known object in a well-known machine. Therefore, in that case, in applying those words used by the Judges we must deal with the case before them and must come to the conclusion, as I do, that what they meant was this, that where there is no novelty in the result, where neither the machine nor the result is new, there you must tie down the patentee, who claims an improvement in the machinery for producing in a known machine that result, strictly to the invention which he claims, and the mode of effecting the improvement which he says is his invention. But here the throwing coal on to the furnace by the intermittent radial action of a flap or door was new, and nothing of the kind had been done before. It is true there had been previous, though imperfect, machines for feeding furnaces automatically, but that had not been done previous to this machine by any intermittent radial action of a flap or door as was done by the plaintiff, and apparently successfully done by him. In my opinion, therefore, these opinions expressed by the Judges with reference to mere improvements in an old machine for an old purpose cannot lay down any law for a case like this, where the result of throwing coal on to the furnace by the intermittent radial action of the flap is first applied in a machine invented by the plaintiff. 'There was not only novelty in the machine, but there was novelty in the effect and in the result to be produced by that machine. In my opinion, therefore, we must come to the conclusion that here the defendant *Bennis*, and also the other defendants, do, in fact, infringe that which is claimed by the plaintiff as his combination, and that so far as that goes the appeal of *Bennis* fails."

Infringe-
ment.

The history of the litigation in connection with *Tweedale's* invention, which related to cotton and wool carding and consisted in improvements in flats and fasteners for securing the carding cloth thereon and thereto; and also *Everitt's* invention of the so-called penny-in-the-slot or coin-feed weighing apparatus, afford good illustrations of the application of the principles of *Curtis v. Platt* and *Proctor v. Bennis* respectively.

Tweedale's invention and *Everitt's* invention as illustrating the application of the doctrines of *Curtis v. Platt* and *Proctor v. Bennis* respectively.

Infringe-
ment.

History of the
litigation in
connection
with
Tweedale's
invention.

Tweedale's invention of "improvements in flats and fasteners for securing the card clothing thereon and thereto" was merely a new mechanical mode of obtaining an old result, *i.e.*, stretching evenly and fastening a carding cloth or fillet on the flat, and did not involve a question of principle. The claim, properly construed, was for the mode of achieving the result and the thing described. Consequently the rule in *Curtis v. Platt*^(p) governed the question of infringement, and the doctrine of substitution of mechanical equivalents did not apply. Though *Tweedale's* invention was useful, ingenious, and meritorious, the claim was not infringed by another means of attaining the same result, the details of which were different. The new means adopted by *Tweedale* to attain the old result were thus described by Lord *Watson*^(q) in the House of Lords: "The 'flat' consists of a straight bar of solid metal, to the surface of which there is attached a wire brush. What in ordinary language would be described as the back of the brush is of elastic material, and is technically termed its foundation. For the efficiency of the carding machine it is necessary that the surface of the brush shall be perfectly level, and shall remain so in course of working. The attainment of that result has been found in practice to depend mainly, if not wholly, upon the manner in which the foundation of the brush is fastened to the bar of metal upon which it rests. At the date of the patent there appears to have been only two known modes of attachment. The foundation was placed upon the bar, and its edges fastened to the bar either by a series of rivets about half an inch apart, or by substituting a wire thread, with stitches of that length, for the rivets. Both the methods were liable to the same defects. In attaching it to the bar the foundation was apt to become puckered, thereby causing inequalities in the surface of the brush; and in working the exposed edges of the foundation became frayed, and caused an accumulation of waste from the material carded. The patentee's invention obviated these defects by introducing a different mode of fastening the foundation of the brush to the bar. The fasteners which he employed were thin strips of metal, one for each side of the bar. One edge of each strip was moulded so as to grip firmly the outer edge of the foundation, independently of the bar; the other edge of the strip was moulded so as to fit and grip a ridge cast upon the back of the

^(p) (1886) L. R. 3 Ch. D. 135 n; 35 L. J. Ch. 852; p. 481 *ante*.

^(q) *Tweedale v. Ashworth*, (1892) 9 R. P. C. 128.

bar. After a strip was attached to each edge of the foundation the bar was inserted, producing a degree of tension which made the foundation adhere to it flatly and evenly, and then the other edges of the strips were made to grip the ridges cast on the other side of the bar, the result being that the surface of the brush was made and kept uniformly level, and that the edges of the foundation were, by the encasing metal, protected from fraying and becoming a receptacle for waste."

Infringe-
ment.

In *Tweeddale v. Ashworth*(*r*) it appeared that the alleged infringer attained the old result in the following manner: By a long strip of metal he clasped one side of the fillet to the bar, and then, by a steel comb operating like a carpet stretcher, he stretched the elastic material of the fillet to the other side, and then clamped this other side of the fillet to the bar by a long strip of metal, precisely as he had already clamped the first side of the fillet and bar together. The stretching was thus produced by external mechanical means. This different means was held by the Court of first instance, the Court of Appeal, and the House of Lords to be no infringement of the means claimed by the patentee, which necessarily involved as one of the merits of the invention the power of stretching the material of the fillet at the same time and by the same operation as completed the machine. An essential feature of the patentee's invention was the gripping the edges of the fillet independently of the bar; and, as stated in the specification, it was evident that the forms of the edges of the bar and of the bent portions of the strips might be varied, so long as it is provided that one edge of each strip secures a firm grip upon the foundation of the fillet, and the other edge secures a tight grip upon the under portion of the bar.

In a subsequent case, *Tweeddale v. Howard and Bullough*,(*s*) it appeared that the infringers there had slightly varied the form of the parts employed, but had attained the result by a "colourable imitation" of the patentee's invention, in that they obtain a sufficient grip of the fillet independently of, and before, the insertion of the bar, which grip was increased when the strip was clamped upon the bar, and the insertion of the bar effected the desired stretching. The following *résumé* of the evidence(*t*) shows the variations in form adopted by the infringers. The defendants' fastener was a continuous strip of metal bent horizontally at the top and bottom, so that it firmly fixed the foundation of the clothing to the bar. There was no

(*r*) (1890) 7 R. P. C. 426; 8 R. P. C. 49; 9 R. P. C. 121.

(*s*) (1896) 13 R. P. C. 522.
(*t*) 13 R. P. C. 532.

Infringe-
ment.

longitudinal rib, as in *Tweedale's*, under the bar, but the under side of the bar was bevelled for some distance in a slightly slanting upward direction, so as to admit of the fasteners being applied firmly. The top part of the strip had a distinct curl, by which it got a direct grip of the foundation, and the pressure applied to fix on the bar increased the curl, so that when the end of this part of the strip penetrated the foundation and was clinched, it got an adequate hold of the foundation, which was necessary for stretching purposes. The foundation was stretched by forcing in the bar. Thus the defendants attained the same end by substantially the same means, and the Court held that they had infringed, since the means used by them were only "colourable" variations of the patentee's means, and not mechanical equivalents for the parts specified by him and claimed in combination.

History of the
litigation in
connection
with *Everitt's*
invention,

Everitt's invention of the automatic weighing machine consisted essentially in a contrivance by which he set the indicating apparatus in motion by means of a penny placed in the slot. The patentee was clearly not entitled to a patent for this principle apart from the method in which it was carried out as disclosed by the specification; and especially the patentee was not entitled to protection for every mode of operating upon every conceivable indicating apparatus by means of a penny.^(u) The essential elements in *Everitt's* invention are three, viz.: (a) a weighing apparatus, (b) an indicating apparatus, and (c) a break, or want of continuity between the two, together with a contrivance by means of which the indicating apparatus, broken from the weighing apparatus, is, by a penny placed in the slot, set at work in such a way that the indicator will stop at a point fixed by the weighing apparatus itself, or by a stop upon it, and the index does not operate to show the weight on the dial till the coin is inserted.^(x)

Everitt's invention produced the first machine of its class, which operated by the utilisation of the principle above described, and therefore the rule in *Proctor v. Bennis* ^(y) applied as to the infringement of the claim by the use of mechanical equivalents.

The first reported case relating to an infringement of *Everitt's Patent* was *Automatic Weighing Machine Co. v. Knight*,^(z) and both the Judge of first instance and the Court of Appeal held

^(u) p. 39 *ante*.
^(x) *Automatic Weighing Machine Co. v. National Exhibitions Association, Ltd.*, (1891) 9 R. P. C. 44 45.

^(y) (1888) 4 R. P. C. 333; L. R. 36 Ch. D. 740.

^(z) (1889) 6 R. P. C. 297.

that no infringement had been committed, because the essential features of the patentee's apparatus were not reproduced by the substitution of equivalents, or otherwise in the alleged infringing machine. The defendant's apparatus in this case differed from the patentee's in that it had a stop which prevented the machine being set in operation till a coin was put in the slot and raised a lever, thereby allowing a handle to be moved by the person being weighed, and the machine so to be set in operation; this was in effect equivalent to putting a lock on the machine, and so, though both machines attained the same result by the operation of the coin, the defendant's by the intervention of a different principle did it in a different way to that protected by the claim of the patent.

Infringe-
ment.

Then in *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*,^(a) it was also held that there was no infringement, where in the defendant's apparatus the coin was first introduced through the slot, and so placed in position; and then, on an outside knob being pushed by the person being weighed, the coin was moved and made to operate on the lever, which, so to speak, unlocked and set the weighing apparatus in action.

These cases were followed by *Automatic Weighing Machine Co. v. National Exhibition's Association, Ltd.*,^(b) where it was held, both by the Judge of first instance and the Court of Appeal, that what the defendants had done was an infringement of *Everitt's Patent*, since the essential principle of the invention was pirated, though the defendants had most ingeniously attempted to conceal this fact by bringing about the same result by a somewhat different method. They adopted a lever instead of a wheel and axle, and they employed a different indicating apparatus, in which an electric battery was introduced; but these things were nevertheless held to be nothing but equivalents for the things pointed out by the patentee, and the defendants committed an infringement because they made use of the essential principle or substance of the patentee's machine, and gave effect to it merely in a different way by the substitution of mechanical equivalents for the parts which the patentee described.

In *Automatic Weighing Machine Co. v. International Hygienic Society*,^(c) which was decided before the last-mentioned case, but did not go to the Court of Appeal, it was held that the

^(a) (1889) 6 R. P. C. 367.

^(b) (1891) 8 R. P. C. 345; 9 R. P. C. 41.

^(c) (1889) 6 R. P. C. 475.

Infringe-
ment.

defendants had infringed by the use of an indicating mechanism in which the indicating was effected by the removal of two shutters exhibiting the figures denoting the weight on a moveable dial, which was a mere mechanical equivalent for the patentee's indicating mechanism where the indicating was effected by the movement of an index on a fixed dial, and there was a break between the weighing and indicating part of the mechanism, though the spindles in the defendant's machine were not on the same axial lines.

Again, in *Automatic Weighing Machine Co. v. Fearby*,^(d) the defendant there was held to have infringed by using an apparatus consisting of a weighing apparatus and an indicating apparatus disconnected, in which a coin put in the slot fell into position by its weight and formed a coupling between an exterior handle and a lever. The handle, when turned by the person being weighed, moved a lever, which drew down one arm and released a catch which set free the indicating mechanism and allowed it to fall down by its weight on the weighing mechanism and so indicate the weight.

"Pioneer patent" and "pioneer claim."

The terms "pioneer patent" and "pioneer claim" are sometimes not inaptly used in reference to a claim which, having regard to the state of public knowledge in relation to the art at the date of the patent, is properly construed according to the rule in *Proctor v. Bennis*.^(e)

Correct application of the doctrine of infringement by substitution is a matter of difficulty in some cases.

The doctrine of infringement by substitution is, however, much misunderstood, and is by no means easy to apply correctly in dealing with many particular cases. It is necessary to consider the step in invention which the patentee has taken, and also the alleged infringement, and to ascertain if, in substance, it is the same. A mechanical equivalent is a mechanical variation, and if the step taken by the patentee is a small one, as in *Curtis v. Platt*, then identity means taking the same or only colourably different mechanical variations. If the invention is detail, difference in detail can be successfully pleaded by the alleged infringer. If on the other hand the step taken by the patentee is a long one, as in *Proctor v. Bennis*, then all the details in an infringement may be different, and, provided there is substantial identity, mere difference in detail cannot be pleaded as an excuse. In dealing with the facts of particular cases, great difficulty often arises in reference to what, having regard to the state of

^(d) (1893) 10 R. P. C. 443.

^(e) pp. 481, 482, *ante*; see also *Proctor v. Bennis*, (1888) L. R. 36 Ch. D. 764;

Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System, Ltd., (1896) 13 R. P. C. 331.

public knowledge at the date of the patent, is the true ambit of the claim, *i.e.*, whether it is to be construed according to the rule in *Curtis v. Platt*,^(f) or according to the rule in *Proctor v. Bennis*.^(g) This difficulty may be illustrated by a consideration of two somewhat recent cases, both of which were finally disposed of by the House of Lords, *viz.*, *Boyd v. Horrocks*,^(h) and *Thomson v. Moore*.⁽ⁱ⁾ These cases may be supplemented by *Pneumatic Tyre Co. v. Tubeless Tyre*, and *Capon Heaton, Ltd.*^(k)

Infringe-
ment.

Illustrations of
the difficulty
in correctly
applying the
doctrine of
infringement
by substitu-
tion.

In *Boyd v. Horrocks* ^(l) the patentee *Boyd* claimed as his invention not only an entire machine, but also a number of subordinate inventions. The invention comprised various improvements applicable to winding and doubling machinery of the same class or type as that described in various prior specifications. Two of the subordinate claims were alleged to have been infringed by a variation of some of the details referred to by the patentee, and the Court of First Instance held that such was the fact. The Court of Appeal, however, over-ruled this finding, on the ground that the claims in question ought to be construed very narrowly so as to limit them to the specific details mentioned, otherwise, if a sufficiently wide construction were put upon them to cover what the alleged infringer had done, they would also embrace a combination which was old and render the patent void for want of novelty. The House of Lords, on the other hand, on a careful consideration of the language of the specification, came to a different conclusion. Their Lordships held that what was claimed was a definite arrangement of parts producing a definite result as a consequence of the arrangement, and was not restricted to the details of the parts employed; and, further, that as the particular arrangement in question was present in the machine used by the infringer, though the details were different, but was absent from the alleged prior anticipating machine, the claims were valid and had been infringed.

Boyd v. Horrocks.

In *Thomson v. Moore* ^(m) the facts relative to the question of infringement were as follows. The plaintiff, now Lord *Kelvin*, was the patentee of improvements in the mariner's compass. The following were the chief features of the invention: an extremely

Thomson v. Moore.

^(f) p. 481 *ante.* ^(g) p. 481 *ante.*

^(h) (1888-1891) 5 R. P. C. 557; 6 R. P. C. 152; 9 R. P. C. 77.

⁽ⁱ⁾ (1889-1890) 6 R. P. C. 426; 7 R. P. C. 325.

^(k) (1897-1898) 15 R. P. C. 74, 236; see also *Gormully and Jeffery Manu-*

facturing Co. v. North British Rubber Co., (1896) 13 R. P. C. 691; 14 R. P. C. 283; 15 R. P. C. 245.

^(l) (1888-1891) 5 R. P. C. 557; 6 R. P. C. 152; 9 R. P. C. 77.

^(m) (1889) 6 R. P. C. 626; 7 R. P. C. 325.

Infringe-
ment.

light card, consisting of a narrow rim of thin paper supported by a thin rim of aluminium on which were marked the cardinal points; the aluminium rim was attached to the central boss, which was also of aluminium, by fine silken filaments in tension; the needles, which were short and light, were arranged in a horizontal plane a little beneath the card and attached to the rim by light silken threads. By this combination three important objects were obtained, viz., (1) diminution of friction, resulting in increased sensitiveness and accuracy; (2) small magnetic moment, and consequent amenability to *Airey's* correctors; (3) long vibration period, the magnetic moment being small and a comparatively large proportion of the weight of the card being thrown to the periphery, securing steadiness in stormy weather.

The defendant constructed and sold a card resembling the plaintiff's in three features of (1) extreme lightness; (2) smallness of needles and magnetic moment; and (3) length of vibrational period and consequent steadiness in virtue of the greater part of the weight being thrown to the periphery. The construction of the defendant's card differed from the plaintiff's in that (a) the circumference consisted of an L-shaped aluminium ring instead of a thin rim; (b) the rim was connected to the boss by flat parallel strips of aluminium instead of silken threads in tension; (c) the short and light needles were arranged in vertical pairs some distance below the card, and were attached to it by aluminium wires instead of silk threads. The same combination of results attended the defendant's combination as were the consequence of the plaintiff's combination—viz., diminution of frictional error, steadiness and amenability to correctors. The defendant contended that his arrangement of the needles was specially adapted to his own patented correctors.

The case first came before the Irish Master of the Rolls and the result of his Lordship's view of the effect of the evidence as to the state of public knowledge at the date of the patent was, that the patent being for a new means of attaining a well-known object—viz., to produce a compass-card, which would be steady and true under all circumstances—it was the case of a combination of known mechanical means for effecting a known improvement in an old machine, and that the doctrine of mechanical equivalents did not apply, and further that the defendant's card not being the same in substance as the plaintiff's there was no infringement. The plaintiff thereupon appealed, and the Court of Appeal in Ireland took a different view of the

evidence and held that the essence of the plaintiff's invention being so to combine extreme lightness of card with long period of vibration and shortness of needles as to obtain a combination of results not previously obtained, viz., diminution of frictional error, steadiness, and amenability to correction, such a combination amounted to a new result, and the doctrine of mechanical equivalents applied. Further, the question was whether there was a pith and substance underlying the invention; and, if so, had the defendant taken that pith and substance? The Court held that he had done so, since his card attained the same results by substantially the same means, agreeing in essentials with the plaintiff's and differing only in non-essentials, and, consequently, he had infringed. The case ultimately went to the House of Lords, and their Lordships affirmed the decision of the Court of Appeal, and held that the plaintiff had attained a new result—a new instrument—and that the differences between his card and the defendant's were mere colourable differences introduced for the purposes of avoiding the appearance of imitation, and an infringement had been accordingly committed.

Infringe-
ment.

As regards the infringement of chemical patents, the rules which have been discussed chiefly with reference to patents for mechanical contrivances have equal force when the subject-matter of the patent is a chemical process or a chemical compound, both as regards the true way in which to fix the ambit of the claims and to determine the question of infringement by the substitution of equivalents for the parts or ingredients referred to in the specification.⁽ⁿ⁾ In many of the reported cases having reference to chemical patents the rule that there is no infringement in the substitution of an equivalent, when at the date of such patent the equivalent used was not known to be an equivalent of the process or ingredient for which it is substituted,^(o) is of the utmost importance in arriving at a true conclusion.

Chemical pa-
tents and in-
fringement by
substitution of
equivalents.

Thus, in *Nobel's Explosives Co. v. Anderson*,^(p) the Court of First Instance, the Court of Appeal and the House of Lords all decided that the claims of the specification were limited to the use of the "soluble" form of nitro-cellulose for the purpose of preparing the explosive compound referred to and that the

(n) *Heath v. Unwin*, (1855) 5 H. L. C. 505; as compared with *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System*, (1896) 13 R. P. C. 301, 332, 559, 578; see also

Fabriques de Produits Chimiques de Thaum v. Caspers, (1897) 15 R. P. C. 94.
(o) p. 480 *ante*.
(p) (1894) 11 R. P. C. 115, 519; 12 R. P. C. 164.

Infringe-
ment.

“insoluble” form was not known to be an equivalent at the date of the patent. The Lord Chancellor (*q*) pointed out that the contention that, though the patentee claimed only the combination of the “soluble” nitro-cellulose with nitro-glycerine, yet an infringement had been committed because all that had been done was that the “insoluble” form had been substituted for the “soluble,” and that one chemical equivalent had been substituted for another, had not been made out, and that there was no evidence to show that the two were known to be equivalents at the date of the patent. The evidence was the other way; and the patentee, who obviously had a competent knowledge of the subject, was careful to always stipulate for the use of the “soluble” form. (*r*)

It is no in-
fringement to
use propor-
tions of in-
gredients out-
side the limits
claimed.

Various
methods of
infringing a
patent.

When proportions of the substances used are of the essence of the invention, (*s*) there is no infringement by the use of proportions outside the limits included by the claim. (*t*)

The form (*u*) 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, *i.e.*, 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 the
construction of
a patented
article.

It is an infringement to order an article to be made according to a patented process, for he who causes an article to be made may be said to make it himself. (*x*)

(*q*) 12 R. P. C. 167.

(*r*) Other cases in which the infringement of chemical patents by the use of equivalents was considered are: *Muntz v. Foster*, (1844) 2 W. P. C. 95; *Stevens v. Keating*, (1847) 2 W. P. C. 181; *Hancock v. Moulton*, (1852) *John's Pat. Man.* 6th ed. 254.

(*s*) pp. 466, 468, 469, 472 *ante*.

(*t*) *Maxim-Nordenfelt Guns and Ammunition Co. v. Anderson*, (1897) 14 R. P. C. 371, 671.

(*u*) 46 & 47 Vict. c. 5, 1st Schedule, Form D.

(*x*) *Gibson v. Brand*, (1842) 1 W. P. C. 631.

But it is not an actionable infringement to make, use, or sell a patented invention by or at the instigation of a patentee or his duly authorised agent; (*γ*) neither is a person who gives another a licence to work under a patent which infringes the patent of a third person himself an infringer of that patent. (*z*)

Infringe-
ment.

Use of patented
invention at
the instigation
of the patentee.

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, 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. (*a*) Nor is it any infringement to manufacture or sell an article which may be used for the purpose of infringing a patent, whether in ignorance of the patent, (*b*) or even though the person manufacturing and selling it actually knows that it will be used for purposes of infringement; (*c*) 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. (*d*)

Manufacture
and sale of the
separate parts
of a patented
combination.

It has been held to be an infringement of a combination patent to restore instruments by renewing parts which were essential to the combination. (*e*)

Restoration of
a patented
instrument.

The mere making of articles for the purpose of sale or use, and not by way of *bonâ fide* experiment, (*f*) is an infringement, although no actual sale or use has taken place; (*g*) but there is no infringement unless a saleable article is produced; (*h*) though

Infringement
by manufac-
ture without
actual sale.

- (*γ*) *Kelly v. Batchelor*, (1893) 10 R. P. C. 289.
 (*z*) *Montgomerie v. Paterson*, (1894) 11 R. P. C. 221, 633.
 (*a*) See *Goucher v. Clayton*, (1865) 11 Jur. N. S. 462; *M'Cormick v. Gray*, (1861) 7 H. & N. 25.
 (*b*) *Savage v. Brindle*, (1896) 13 R. P. C. 267.
 (*c*) *Townsend v. Haworth*, (1875) 48 L. J. Ch. N. S. 770; 12 Ch. D. 831 n; *Sykes v. Howarth*, (1878) L. R. 12 Ch. D. 826; 48 L. J. Ch. 769; but see *Incandescent Gas Light Co. v. New Incandescent Gas Mantle Co.*, (1897) 15 R. P. C. 83, 84.
 (*d*) *United Telephone Co. v. Dale*, (1883) L. R. 25 Ch. D. 778.
 (*e*) *United Telephone Co. v. Neilson*, (1887) W. N. (1887) 193.
 (*f*) p. 496 *post*.
 (*g*) *Muntz v. Foster*, (1844) 2 W. P. C. 101; *Jones v. Pearce*, (1832) 1 W. P. C. 125.
 (*h*) *Higgs v. Goodwin*, (1858) E. B. & E. 529; 27 L. J. Q. B. 421.

Infringe-
ment.

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.(i)

Use by way of
bonâ fide ex-
periment is no
infringement.

It is no actionable invasion of a patentee's rights for another person to use the invention, and thereby produce the finished product by way of *bonâ fide* experiment or amusement, without 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.(k) In the words of *Jessel*, M.R.,(l) "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 advan-
tage is an in-
fringement.

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.(m) 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.(n)

Also where it appeared that certain persons purchased 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

(i) *Newall v. Elliot*, (1863) 10 Jur. N. S. 954.

(k) *Frearson v. Loe*, (1878) L. R. 9 Ch. D. 48; *Jones v. Pearce*, (1832) 1 W. P. C. 121, 125; 5 M. & G. 208; *Muntz v. Foster*, (1844) 2 W. P. C. 101; *United Telephone Co. v. Sharples*,

(1885) 2 R. P. C. 28; *Proctor v. Bayley* (1889) 6 R. P. C. 107.

(l) *Frearson v. Loe*, (1878) L. R. 9 Ch. D. 48.

(m) *United Telephone Co. v. Sharples* (1885) L. R. 29 Ch. D. 164.

(n) *Ibid.*

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.^(o)

Infringe-
ment.

The *ratio decidendi* of cases which decide that a person may be an infringer, though he has derived no pecuniary profit from his infringement, is that such profit is not a condition precedent to liability, but the condition precedent is actual or probable damage to the patentee arising from the acts complained of.

Pecuniary profit is not a condition precedent to liability.

It is an infringement to sell or use an article which was manufactured according to a patented process without the licence of the patentee;^(p) whether the article was made in this country or was imported from abroad,^(q) or whether the sale was to an English or a foreign customer for shipment abroad,^(r) 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.^(s) And if the article is manufactured abroad and sold and delivered by such manufacturer abroad to the person or his agent who imports it into this country, such foreign manufacturer aiding and abetting the importation into this country does not thereby make himself amenable to the jurisdiction of the Court, nor is he an infringer.^(t) In such a case the importer only is the infringer; but if the foreign manufacturer contracts for and, either personally or by means of an agent—*e.g.*, the post or other carrier—makes delivery in this country, he is himself the importer and an infringer.^(u)

Unlicensed sale of patented article within the area of the patent is an infringement, notwithstanding the *locus* of the manufacture.

The *ratio decidendi* of the cases to the effect that the

^(o) Proctor v. Bayley, (1889) 6 R. P. C. 106, 538.

^(p) Wright v. Hitchcock, (1870) L. R. 5 Ex. 37; Davenport v. Rylands, (1865) L. R. 1 Eq. 302.

^(q) Walton v. Lavater, (1860) 8 C. B. N. S. 162; Elmslie v. Boursier, (1869) L. R. 9 Eq. 217; Von Heyden v. Neustadt, (1880) L. R. 14 Ch. D. 230; Société Anonyme des Manufactures de Glaces v. Tilghman's Sand Blast Co., (1883) L. R. 25 Ch. D. 1; Carlsburn Sugar Refining Co. v. Sharp, (1884) 1 R. P. C. 181; United Tele-

phone Co. v. Sharples, (1885) 2 R. P. C. 31; 26 Ch. D. 164.

^(r) United Telephone Co. v. Sharples, (1885) 2 R. P. C. 28; L. R. 29 Ch. D. 164, 167; Lyon v. Goddard, (1894) 11 R. P. C. 113.

^(s) Smith v. Buchanan, 26 S. J. 347; p. 498 *post*.

^(t) Badische Anilin und Soda Fabrik v. Johnson, (1897) 14 R. P. C. 919, 405, 211.

^(u) Badische Anilin und Soda Fabrik v. Johnson, (1897) 14 R. P. C. 919.

Infringement. sale in this country of an article made abroad by a machine or process which is patented in this country is an infringement, is that the sale of the article is an indirect use of the invention within the prohibition of the patent. The selling of an article and converting it into money is about the most effectual mode that can be imagined of using the invention whereby it was produced.^(x) The object of the patent is to give the inventor the profit of his invention; and the most effectual way of defeating that object would be to permit others to derive, from a sale of an article made in infringement of the patent, the profit which it was intended to secure to the patentee.^(y)

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;^(z) 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.^(a)

Mere loan.

A mere loan of a patented article, without any intention of selling it or evading the patent, is no infringement.^(b)

Unrestricted sale of a patented article by the patentee or his licensee.

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.^(c) 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;^(d) 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.^(e)

Unrestricted

An unrestricted licence to manufacture and sell a patent

^(x) Per Keating, J., *Walton v. Lavater*, (1860) 8 C. B. N. S. 188.

^(y) Erle, C.J., *Walton v. Lavater*, (1860) 8 C. B. N. S. 185.

^(z) *Minter v. Williams*, (1835) 4 A. & E. 251.

^(a) *Oxley v. Holden*, (1860) 8 C. B. N. S. 666; 30 L. J. C. P. 68.

^(b) *United Telephone Co. v. Henry*, (1885) 2 R. P. C. 11.

^(c) Per Cotton, L.J., *Société Anonyme*

des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co., (1883) L. R. 25 Ch. D. 9; *Betts v. Wilmott*, (1870) L. R. 6 Ch. 239.

^(d) *Healy v. Hartley*, (1888) 5 R. P. C. 603.

^(e) *Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.*, (1883) L. R. 25 Ch. D. 1.

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,^(f) whether they do so inside or outside the area comprised in the licence; for a purchaser from an unrestricted licensee, whether special or general, acquires the patented article for all purposes, and can exercise every right of ownership in respect of it.^(g)

**Infringe-
ment.**

licence to
manufacture
and sell.

It is competent to a patentee to sell, or to license the sale of, a patented article with a restriction that it shall be used only in a certain way. If the purchaser has notice of any such restriction, use in any but the authorised manner will constitute an actionable infringement. Thus, in *Incandescent Gas Light Co. v. Cantelo* (*h*) it appeared that the plaintiffs' course of business was to sell only through agents, whose dealings were restricted to their respective localities. The defendant employed a friend, who resided within the district of the plaintiff's London agent, to purchase from that agent certain goods. After these were paid for by his friend, and, at the request of the latter, consigned direct to the defendant in the Isle of Wight, the defendant discovered, on unpacking them, that each box had a notice on it stating that the goods were sold upon condition that they were to be used only in a certain way. The defendant covered up the notices with his own labels, and resold the goods to his customers. His friend when buying never saw the boxes or notices. The Court held that, as there was insufficient notice, there was no infringement under the circumstances; but the learned Judge, *Wills, J.*, stated that, if a purchaser on the sale is cognisant of restrictions put upon the use of the goods, he is bound by them on the principle that "the patentee has the sole right of using and selling the articles, and he may prevent anybody from dealing with them at all. Inasmuch as he has the right to prevent people from using them, or dealing in them at all, he has the right to do the lesser thing—that is to say, to impose his own conditions. It does not matter how unreasonable or how absurd the conditions are. It does not matter what they are if he says at the time when the purchaser proposes to buy, or the person to take a licence, 'Mind, I only give you this licence on this condition,' and the purchaser is free to take it or leave it as he likes. If he takes it he must be bound by

Restrictions
may be placed
on purchaser
of a patented
article; and
breach of
restrictions
is an infringe-
ment.

(f) *Thomas v. Hunt*, (1864) 17 C. B. N. S. 183.

(g) *Smith v. Buchanan*, (1882) 26 S. J. 347.

(h) (1895) 12 R. P. C. 262.

Infringe-
ment.

Authority to construct does not necessarily imply permission to use a patented article.

Use for a purpose analogous to the purpose specified by the patentee.

Claim may be limited to use for one particular purpose.

Use for a purpose totally different to the purpose specified.

the conditions. It seems to be common sense, and not to depend upon any patent law, or any other particular law.”

Upon the same principle it does not follow that authority from the patentee to construct an article necessarily implies permission to use the article when constructed.⁽ⁱ⁾ A person may be at one and the same time both a licensee and an infringer—*e.g.*, he may be a licensee in respect of articles actually paid for, but an infringer in respect of articles not paid for.^(k)

When a patentee draws his specification and claims for his invention chiefly with reference to an application of it to a particular purpose, a person who uses the invention cannot escape the consequences of infringement if he uses it in an analogous manner though for a purpose different to that mentioned by the patentee ; provided, of course, that the patentee has not distinctly limited his claim to the use of the invention for the first purpose. Thus, where the invention consisted in the adaptation of a machine (which was not subject-matter in itself) to the manufacture of cement for decorative purposes, an analogous adaptation of the machine to the manufacture of concrete blocks for street paving was held to be an infringement.^(l) So, generally 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.^(m)

But where the patentee distinctly limits his claim it is not infringed by a user outside the limitation. Thus, where a patentee distinctly limited his claim to the use of his invention to a process for making manure by chemically treating sewage-water with hydrate of lime, the claim was not infringed by a person who used the process for purifying water only, and did not sell or use any of the precipitated manure.⁽ⁿ⁾ A claim for the use of a thing for one purpose is not infringed by the use of the thing for a totally different purpose, requiring different variations in the details of the use of the thing in question.^(o)

(i) *Basset v. Gradon*, (1897) 14 R. P. C. 701.

(k) *Tweedale v. Howard and Bulough*, (1896) 13 R. P. C. 529, 531.

(l) *Adamant Stone Paving Co. v. The Corporation of Liverpool*, (1896) 14 R. P. C. 11, 21.

(m) *Cannington v. Nuttall*, (1871) L. R. 5 E. & I. App. Cas. 205, 230.

(n) *Higgs v. Goodwin*, (1858) E. B.

& E. 529 ; 27 L. J. Q. B. 421 ; see also *Morewood v. Tupper*, (1885) 3 C. L. R. 718 ; *Lister v. Eastwood*, (1864) 9 L. T. N. S. 766.

(o) *Preston v. Black*, (1894) 11 R. P. C. 299, 574 ; *Fletcher v. Glasgow Gas Commissioners*, (1887) 4 R. P. C. 386 ; *Edison v. Holland*, (1888) 5 R. P. C. 482.

The use of an article which will amount to an infringement of a patent for its production may be either active or passive ;(*p*) 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.(*q*)

**Infringe-
ment.**

Possession may amount to an 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.(*r*)

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.(*s*)

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.(*t*)

Breach of contract is no justification for an infringement.

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

Use of a patented invention in a foreign vessel within the jurisdiction of the British Courts.

(*p*) *Caldwell v. Vauvlissenger*, (1851) 9 Hare 415 ; *Betts v. Neilson*, (1868) 3 De G. J. & S. 82.

(*q*) *Adair v. Young*, (1879) L. R. 12 Ch. D. 13 ; *Proctor v. Bayley*, (1889) 6 R. P. C. 106 ; *United Telephone Co. v. London and Globe Telephone and Maintenance Co.*, (1884) 1 R. P. C. 117 ; L. R. 26 Ch. D. 766.

(*r*) *Adair v. Young*, (1879) L. R. 12 Ch. D. 13.

(*s*) *United Telephone Co. v. London and Globe Telephone and Maintenance Co.*, (1884) 1 R. P. C. 117 ; L. R. 26 Ch. D. 766.

(*t*) *United Telephone Co. v. Tasker*, (1888) 5 R. P. C. 628.

Infringe-
ment.

an injunction.(u) Neither is the use of any other 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.(x)

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.(y)

Transshipment
of goods may
be an infringe-
ment.

Transshipment in this country of goods made according to a British patented invention may be such a use as will amount to an infringement of the British patent. Thus, in *Betts v. Neilson*,(z) which was an action brought for the 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 whilst 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*,(a) 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 had 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.(b)

(u) 46 & 47 Vict. c. 57, s. 43, sub-s. 1.

(x) *Ibid.*

(y) 46 & 47 Vict. c. 57, s. 43, sub-s. 2.

(z) (1871) L. R. 5 H. L. 1.

(a) (1870) L. R. 9 Ch. D. 351.

(b) *Caldwell v. Van Vlissingen*,
(1851) 9 Hare, 415; 21 L. J. N. S.
Ch. 97.

A person who is merely the Custom House agent of the actual importer is not responsible for infringements. Thus, in *Nobel's Explosives Co. v. Jones, Scott & Co.*(*e*) 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 (*d*) 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 of the patent, and that no action could be maintained against them for infringement.

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 ;(*e*) 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.(*f*) 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,(*g*) 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 actual date of the grant as well as in respect of infringements committed since the grant.

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 ;(*h*) and, if the

(*c*) (1882) L. R. 8 App. Cas. 5.

(*d*) As required by the Explosives Act, 1875.

(*e*) 46 & 47 Vict. c. 57, s. 13.

(*f*) *Ibid.* s. 15. (*g*) *Ibid.* s. 10.

(*h*) p. 517 *post.*

Infringe-
ment.

Custom House
agents.

Unauthorised
use of an in-
vention prior
to the sealing
of a patent.

Infringement
committed in
the interval

Proceedings before Action.

between a decision adverse to the validity of the patent and its reversal on appeal.

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.⁽ⁱ⁾ 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 upon a petition for revocation, and the adverse decision may be reversed. It is submitted that any act done by a member of the public during the interval between a decision of the 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.^(k)

Threatened infringements.

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.^(l) 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.^(m)

PROCEEDINGS BEFORE COMMENCEMENT OF ACTION.

Proper course for a patentee to pursue on discovering several infringers.

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,⁽ⁿ⁾ and, if he issues separate writs simultaneously against all the infringers, he will have to uphold the validity

⁽ⁱ⁾ p. 391 *ante*.

^(k) *Arkwright v. Nightingale*, (1785) 1 W. P. C. 60; *Deeley v. Perkes*, (1896) 13 R. P. C. 587.

^(l) *Frearson v. Loe*, (1878) L. R. 9 Ch. D. 48, 66; *Dowling v. Billington*, (1890) 7 R. P. C. 191; *Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 357; *Incandescent Gas*

Light Co. v. De Mare Incandescent Gas Light System, (1896) 13 R. P. C. 301, 559; *Incandescent Gas Light Co. v. Sunlight Incandescent Gas Lamp Co.*, (1896) 13 R. P. C. 333; p. 516 *post*.

^(m) *Gynne v. Drysdale*, (1885) 2 R. P. C. 160; 3 R. P. C. 65.

⁽ⁿ⁾ pp. 509, 510 *post*.

of his patent in several distinct proceedings, in each of which he may have to meet different objections, and further he may be guilty of the charge of oppressive litigation. On the other hand, if he singles out one 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 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.^(o) In such a state of circumstances the proper course for a patentee to pursue is that suggested by Lord *Hatherley*, then Vice-Chancellor *Page-Wood*,^(p) 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."

Proceed-
ings
before
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.^(q) 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,^(r) though, if his conduct is oppressive,

Usual course
before com-
mencing an
action for
infringement.

(o) p. 542 *post*.

(p) *Bovill v. Crate*, (1865) L. R. 1 Eq. 391; see also *North British Rubber Co. v. Gormully and Jeffery Manufacturing Co.*, (1894) 12 R. P. C. 21.

(q) *Upmann v. Elkan*, (1871) L. R. 12 Eq. 146; *Upmann v. Forester*, (1883) L. R. 24 Ch. D. 231; *Burgess v. Hills*, (1859) 26 Beav. 244, 247; *Burgess v. Hately*, (1859) 26 Beav. 249.

(r) *Losh v. Hague*, (1837) 1 W. P. C. 200; *Geary v. Norton*, (1846) 1 De G. & S. 9; *Nunn v. D'Albuquerque*, (1865) 34 Beav. 595; *Upmann v. Forester*, (1883) L. R. 24 C. D. 231; *Nicols v. Pitman*, (1884) L. R. 26 Ch. D. 374; *Wittmann v. Oppenheim*, (1884) L. R. 27 Ch. D. 260; *Fradella v. Weller*, (1831) 2 Russ. & My. 247; *Procter v. Bayley*, (1889) 6 R. P. C. 106.

Proceed-
ings
before
Action.

Patentee
though suc-
cessful in the
action may be
disentitled to
an injunction
or costs.

he may lose the costs of the action.^(s) 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 relation to the cause of action, or the proceedings are tainted with a lack of good faith.^(t)

Consequently 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.^(u)

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.^(x)

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.^(y)

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.^(z)

^(s) *Nunn v. D Albuquerque*, (1865) 34 Beav. 595; *Hudson v. Bennett*, (1866) 14 W. R. 911; *Smith v. Roberts*, (1888) 5 R. P. C. 611; p. 613 *post*.

^(t) *Edelston v. Edelston*, (1863) 1 De G. J. & S. 203; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 305.

^(u) pp. 593, 612 *post*.

^(x) *Betts v. Willmott*, (1870) 16 W.

R. 1 Eq. 305; see also *Upmann v. Elkan*, (1871) L. R. 12 Eq. 145; *Thornton v. Baker*, (1886) 3 Times Rep. 715.

^(y) *Fletcher v. Glasgow Gas Commissioners*, (1887) 4 R. P. C. 386.

^(z) *Procter v. Bayley*, (1889) 6 R. P. C. 538.

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, especially if an account is claimed instead of damages, in order that the infringing defendants may not be called upon to account twice, first to the plaintiff and then to the other defendants who claim an interest.^(a) If the patent is the separate estate of a married woman she is capable of suing alone.^(b) The owner of a distinct and severable part of a grant can sue alone.^(c) And a co-owner can do so, if the defendant does not object.^(d) A defendant who means to object should do so without delay.^(e)

All parties interested should be before the Court.

Assignees have the same rights to sue as the original patentee had,^(f) whether they are assignees by direct assignment or act and operation of law—*e.g.*, trustee in bankruptcy or his assignee ^(g)—or whether they are co-owners.^(h)

Assignee.

An assignee's title should be registered, but registration is not always a condition precedent to the right to sue.⁽ⁱ⁾

A trustee may sue alone, as also a *cestui que trust*.^(k)

Trustee and *cestui que trust*.
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.^(l)

The mere agent of a foreign patentee cannot, in his own name, maintain an action of infringement.^(m)

Agent.

It is provided by the Supreme Court Rules of 1883⁽ⁿ⁾ 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 interest of the parties actually before

Misjoinder of parties.

(a) *Westhead v. Keene*, (1838) 1 Beav. 287, 295; *Bergman v. MacMillan*, (1881) L. R. 17 Ch. D. 423; *Hindmarch on Patents*, p. 308.

(b) See *Savage v. Harris*, (1896) 13 R. P. C. 375, as to the usual order as to costs when an action brought by a married woman is unsuccessful.

(c) *Dunncliffe v. Mallet*, (1859) 7 C. B. N. S. 209; 29 L. J. C. P. 70.

(d) *Davenport v. Richards*, (1860) 3 L. T. N. S. 503.

(e) *Sheehan v. G. E. Ry. Co.*, (1880) L. R. 16 Ch. D. 59.

(f) *Boulton v. Bull*, (1795) 2 H. Bl. 464; *Electric Telegraph Co. v.*

Brett, (1851) 10 C. B. 838; *Walton v. Lavater*, (1860) 8 C. B. N. S. 162; p. 361 *ante*.

(g) *Bloxani v. Elsee*, (1827) 6 B. & C. 169.

(h) *Anderson v. Patent Oxonite Co.*, (1886) 3 R. P. C. 279.

(i) See p. 365 *ante*; also *Stewart v. Casey*, (1891) 8 R. P. C. 259.

(k) p. 365 *ante*.

(l) *Van Gelder Apsimon and Co., Ltd. v. The Sowerby Bridge Flour Society, Ltd.*, (1890) 7 R. P. C. 208.

(m) *Adams v. North British Railway Co.*, (1873) 29 L. T. N. S. 367.

(n) R. S. C. (1883) Ord. xvi. r. 11.

Parties. it, and the Court or a Judge may, at any stage 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 to effectually and completely 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.(o)

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 the trial postponed, although the fact of the transfer was known to him when he put in his statement of defence; (p) but where the defence was that the defendant had not infringed before the assignment of the patent to the plaintiff, leave, at the trial, was refused to add as co-plaintiffs the predecessors in title of the plaintiff; (q) 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.(r)

Any person who infringes or takes part in an infringement may be made a defendant.

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; (s) 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.(t)

(o) *Walcott v. Lyons*, (1884) L. R. 29 Ch. D. 584; *Van Gelder, Apsimon and Co. v. The Sowerby Bridge Flour Society, Ltd.*, (1890) 7 R. P. C. 41, 45; but see 7 R. P. C. 208.

(p) *Ruston v. Tobin*, (1878) 49 L. J. Ch. 262.

(q) *Nobel's Explosives Co. v. Jones*, (1880) 42 L. T. N. S. 754.

(r) *Briggs v. Lardeur*, (1885) 2 R. P. C. 13.

(s) *Betts v. De Vitre*, (1865) 11 Jur. N. S. 11; *Adair v. Young*, (1879) L. R.

12 Ch. D. 19; *Betts v. Neilson*, (1868) 6 N. R. 221; *Denley v. Blore*, (1851) 38 Lond. Jour. 224.

(t) *Sykes v. Howarth*, (1878) L. R. 12 Ch. D. 826; *Betts v. De Vitre*, (1873) L. R. 3 Ch. App. Cas. 429; *Gregory v. Piper*, (1829) 9 B. & C. 591; *Whatman v. Pearson*, (1868) L. R. 3 C. P. 422; *Sharrod v. London and North-Western Ry. Co.*, (1849) 4 Exch. 580, 587; *Gordon v. Rolte*, (1849) 4 Exch. 365; *Lyons v. Martin*, (1838) 8 A. & E. 512; 3 N. & P. 509.

Though one individual partner in a firm may have a right to manufacture and sell under a patent, the firm may have no such right, as, according to the circumstances, the firm may be contractors for and not mere agents of the patentee and so properly made defendants.^(u)

Parties.
Firm as distinct from a partner.

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.^(x) Of course the company could be made a defendant also.

Directors of a company.

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.^(y)

Foreigners.

The usual form in which injunctions are granted against infringers restrains the defendant, his servants, agents, or workmen from continuing the acts complained of.^(z)

Manufacturers and persons who have purchased from them may be made defendants to the same action or sued separately.

In cases where a plaintiff succeeds in obtaining a verdict against both a manufacturer and a 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.^(a)

Manufacturers and persons who have purchased from them may be sued as defendants in the same action; ^(b) though if the manufacturer or user be sued alone, the other cannot claim to be joined as a defendant against the wish of the plaintiff. It is not the case of attacking a principal through his agent or the improper selection of a member of a class.^(c) Further, if a foreign manufacturer is not also an importer, he is not liable to the jurisdiction of the Courts in this country, and is not an infringer.^(d) Thus, a foreign manufacturer who delivers goods abroad—*e.g.*, by means of the post—to a person who imports them into this country—*e.g.*, by his agent, the

Foreign manufacturer.

^(u) Howard *v.* Tweedale, (1895) 12 R. P. C. 519.

^(x) A.-G. *v.* Vestry of Bermondsey, (1883) L. R. 23 Ch. D. 60; Mathias *v.* Yates, (1882) 46 L. T. N. S. 497; Betts *v.* De Vitre, (1865) 11 Jur. N. S. 9; L. R. 3 Ch. App. Cas. 441; Spencer *v.* The Ancoats Rubber Co., (1889) 6 R. P. C. 46.

^(y) Caldwell *v.* Van Vlissingen, (1851) 21 L. J. N. S. Ch. 97; 9 Hare, 415; Vavasseur *v.* Krupp, (1870) L. R. 9 Ch. D. 351.

^(z) Seton, p. 352.

^(a) Penn *v.* Bibby, (1866) L. R. 3 Eq. 308; 36 L. J. Ch. 277; United Telephone Co. *v.* Walker, (1887) 4 R. P. C. 67.

^(b) Proctor *v.* Bennis, (1887) 4 R. P. C. 333; L. R. 36 Ch. D. 740; United Telephone Co. *v.* Walker, (1887) 4 R. P. C. 67.

^(c) Moser *v.* Marsden, (1892) 9 R. P. C. 214.

^(d) Badische Anilin und Soda Fabrik *v.* Johnson, (1897) 14 R. P. C. 919, 405, 211.

Parties. — post—is no infringer; but a foreign manufacturer who contracts for and makes delivery in this country—*e.g.*, by the post or other carrier—would be an infringer.*(e)*

Consignees of goods shipped from abroad are proper defendants.

When goods are made in infringement of an English patent, and shipped from abroad, the consignees are proper defendants in 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.*(f)*

When separate actions must be brought against separate infringers.

In other cases of separate infringements of the same patent by different persons separate actions must be brought against each individually;*(g)* 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.*(h)* 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.*(i)*

Person who has indemnified the defendant may be allowed to take part in the action.

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*(k)* 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 on any question as to the above indemnity as might arise between them and the defendants, but not further or otherwise.*(l)* 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.*(m)*

(e) *Badische Anilin und Soda Fabrik v. Johnson*, (1897) 14 R. P. C. 919, 405, 211.

(f) *The Washburn and Moca Manufacturing Co. v. The Cunard Steamship Co.*, (1889) 6 R. P. C. 398; *Massey v. Haynes*, (1888) L. R. 21 Q. B. D. 330.

(g) *Dilly v. Doig*, (1794) 2 Ves. 486.

(h) *Lister v. Wood*, Seton, 3rd ed. p. 909.

(i) *United Telephone Co. v. Sharples*, (1885) 2 R. P. C. 28.

(k) R. S. C. 1883, Ord. xvi. r. 48.

(l) *Edison v. Holland*, (1886) 3 R. P. C. 397.

(m) *Edison v. Holland*, (1889) 6 R. P. C. 243.

PLEADINGS.

The usual pleadings in an action for the infringement of a patent, after service of the writ with regard to which there is nothing special in patent actions,⁽ⁿ⁾ are a statement of claim, particulars of breaches, a statement of defence, particulars of objections, and reply. Further pleadings are not usual in actions of infringement of patent rights, but, if they are required, the practice as to them is regulated by R. S. C. Order xxiii.

Usual 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.^(o)

Trial without 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 of Chancery.^(p)

The same rules apply to the service of the writ in patent actions as in other actions.^(q)

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.^(r)

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 allegation is not contained in the form given in the Appendix to the Supreme Court Rules, 1883.^(s)

or validity,

(n) For forms of indorsement of the writ, see Appendix.

(o) R. S. C. 1883, Ord. xxxiv. r. 9.

(p) Order in *Davenport v. Jephson*, Seton, p. 346; *Bovill v. Smith*, (1867) W. N. 1867, p. 240; 46 & 47 Vict. c. 57, s. 29; pp. 512, 527 *post*.

(q) R. S. C.

(r) *Amory v. Brown*, (1869) L. R. 8 Eq. 654.

(s) R. S. C. 1883, Appendix C Form 6.

Particulars of Breaches.

or to set out the specifications.

Disclaimers should be alleged.

Sufficient case to justify the relief asked for must be stated.

It is not necessary to set out in the statement of claim either the whole or any portion of the specifications,^(t) though this was usually done in bills in Chancery under the old practice.

If any disclaimer has been entered at the Patent Office, this fact, with the date, should be alleged in the statement of claim.

The statement of claim must state a sufficient case to justify the injunction asked;^(u) and must not set out a separate and different cause of action to that endorsed on the writ.^(x)

PARTICULARS OF BREACHES.

Particulars of breaches are necessary.

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 a Judge at any subsequent time, particulars of the breaches complained of;^(y) 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.^(z) Thus, when the particulars of breaches only alleged infringement by user and not by manufacture, the Court at the trial refused to consider the question whether there had been infringement by manufacturing the articles complained of.^(a)

Amendment of particulars of breaches.

The Court or a Judge has power from time to time to grant leave to amend particulars.^(b) And further and better particulars may be ordered at the instigation of either party, even though the action has actually been put down for trial and notice of trial given.^(c) Though the Court of Appeal is not a "Court or Judge" within the meaning of sec. 29 of the Act of 1883, yet, when there is an appeal, it has, if not an inherent power, at any rate a special power, under R. S. C. 1883, Ord. 58, r. 4, to allow an amendment of the particulars of breaches or objections so as to admit further evidence.

^(t) *Kay v. Marshall*, (1836) 2 W. P. C. 39; *Westhead v. Keene*, 1 Beav. 287; S. C. R. 1883, Appendix C, Form 6.

^(u) *Curtis v. Cutts*, (1839) 8 L. J. N. S. Ch. 184.

^(x) *United Telephone Co. v. Tasker* (2), (1889) 6 R. P. C. 38.

^(y) 46 & 47 Vict. c. 57, s. 29, sub-s.

1. For forms of particulars of breaches see p. 785 *post*.

^(z) 46 & 47 Vict. c. 57, s. 29, sub-s. 4.

^(a) *Hensee v. Hardie*, (1894) 11 R. P. C. 421.

^(b) 46 & 47 Vict. c. 57, s. 29, sub-s. 5.

^(c) *Mandelberg v. Morley*, (1893) 10 R. P. C. 256.

This power is purely discretionary, and the Court of Appeal is loath to exercise it, and only does so in special cases.^(d)

Particulars of Breaches.

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.^(e)

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.^(f)

The plaintiff must take care that the particulars which he 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.^(g)

Particulars must be reasonable and proper.

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.^(h) The object of particulars is not to disclose evidence, but to tell the case to be made at the trial,⁽ⁱ⁾ and the office of particulars of breaches is to tell the defendant what the plaintiff says he has done in infringement, and it is not the office of particulars to answer an interrogatory as to the construction of the patent.^(k)

Sufficient if, 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.^(l) Again, where the particulars of breaches specified a particular article as an infringement, the Court, being of opinion that the defendant 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

^(d) *Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 530.

^(e) *Haslam v. Hall*, (1887) 4 R. P. C. 203, 207, per Wills, J.

^(f) *Russell v. Hatfield*, (1885) 2 R. P. C. 144.

^(g) 46 & 47 Vict. c. 57, s. 29 (6).

^(h) *Needham v. Oxley*, (1863) 1 H. & M. 248; *Petman v. Bull*, (1886) 3 R. P. C. 390; S. C. reported in *Ledgard*

v. Bull, L. R. 11 App. Cas. 648; *Cheetham v. Oldham* (3), (1888) 5 R. P. C. 624.

⁽ⁱ⁾ *Mandelberg v. Morley*, (1893) 10 R. P. C. 260.

^(k) *Wenham Co. v. Champion Gas Co.*, (1891) 8 R. P. C. 22; *Cassella v. Levenstein*, (1891) 8 R. P. C. 473.

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

Particulars of Breaches.

occasions on which, the infringement occurred, or to order him to point out the particular parts of the specification alleged to have been infringed.(*m*) And where the alleged infringement, which is not a complicated structure, 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.(*n*)

Must state how the patent has been infringed.

Where, however, 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.(*o*) And if the specification contain a description of a number of articles, all of which are the subject of the invention, the particulars must point out which part of the specification has been infringed.(*p*)

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.(*q*)

A user may require fuller particulars than a manufacturer.

It is to be noticed that when the alleged infringer is a user and not a manufacturer the particulars of breaches must be fuller than would be necessary if he were a manufacturer. When the alleged infringer is a manufacturer he knows what the process he uses is, but if the alleged infringer is a user or vendor only he may be dependent for his knowledge of the process used upon the statement of the actual manufacturer. The plaintiff might dispute the manufacturer's statement, and contend that some other process mentioned in the specification had been used. Hence the necessity in such a case of giving the user or vendor full notice of which of the plaintiff's processes it will at the trial be contended have in fact been used.(*r*)

Must specify which claims have been 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

(*m*) *Talbot v. La Roche*, (1854) 15 C. B. 310; see also *Moseley v. Victoria Rubber Co.*, (1886) 3 R. P. C. 351.

(*n*) *Batley v. Kynock* (2), (1874) L. R. 19 Eq. 229; *Needham v. Oxley*, (1863) 1 H. & M. 248; *Perry v. Mitchell*, (1840) 1 W. P. C. 269.

(*o*) *Talbot v. La Roche*, (1854) 15 C. B. 310; *Patent Type Founding Co. v. Richards*, (1860) 2 L. T. N. S. 359.

(*p*) *Perry v. Mitchell*, (1840) 1 W. P. C. 269; *Patent Type Founding Co. v. Richards*, (1860) 2 L. T. N. S. 359;

(*q*) *Perry v. Mitchell*, (1840) 1 W. P. C. 269.

(*r*) *Mandelberg v. Morley*, (1893) 10 R. P. C. 260.

(*s*) *Haslam v. Hall*, (1887) 4 R. P. C. 203.

the specification without direct mention of the claiming clauses.(t)

Particulars of Breaches.

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) neither can the plaintiff be compelled to put a construction on his claims or specification in the particulars of breaches;(x) 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 alleged to have been infringed.(y)

if necessary, by reference to pages and lines of the specification.

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.(z)

Specific instances and dates of some infringements must be given, but certain general words may be added.

Thus, in an action for infringement, where the particulars of breaches alleged that the defendants had infringed by importing 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.(a)

In *Walter C. Church Engineering Co. v. Wilson*,(b) the words "in particular and by way of illustration" were held

(t) *Elsey v. Butler*, (1884) 1 R. P. C. 189.

(u) *Walter C. Church Engineering Co. v. Wilson*, (1886) 3 R. P. C. 123; *Electric Telegraph Co. v. Nott*, (1847) 4 C. B. 462; *Talbot v. La Roche*, (1854) 15 C. B. 310; *Batley v. Kynock* (2), (1875) L. R. 19 Eq. 229; *Cheetham v. Oldham* (3), (1888) 5 R. P. C. 624.

(x) *Cassella v. Levinstein*, (1891) 8 R. P. C. 473.

(y) *Lamb v. Nottingham Manufacturing Co.*, cited L. R. 19 Eq. 230;

Wren v. Weild, (1869) L. R. 4 Q. B. 213; *Jones v. Lee*, 25 L. J. Ex. 241.

(z) *Murray v. Clayton*, (1872) L. R. 15 Eq. 115; *Crossley v. Tomey*, (1876) L. R. 2 Ch. D. 533; *Sykes v. Howarth*, (1878) L. R. 12 Ch. D. 826; cf. *Flower v. Lloyd*, (1876) 45 L. J. Ch. 746; 25 W. R. 17.

(a) *Tilghman's Patent Sand Blast Co., Limited v. Wright and Butler Co., Limited*, (1884) 1 R. P. C. 103; see also *Talbot v. La Roche*, (1854) 15 C. B. 310. (b) (1886) 3 R. P. C. 123.

Particulars of Breaches.

to be too wide ; but, on the other hand, in *Haslam v. Hall*,^(c) where the particulars of breaches, “*by way of example and not of limitation,*” alleged certain machines fitted by the defendants on board the “*Selembrica,*” 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 “*Selembrica,*” unless he gave further names.

Particulars of actual infringements are necessary, and evidence is limited by them, unless the action is solely based on threats to infringe.

Though a threatened infringement may be restrained,^(d) an injunction will not be granted where the action is only framed in respect of, and fails as to *specific* infringements alleged to have been committed prior to the action, and the plaintiff seeks to give evidence of acts of a different nature committed after action as infringements, unless the pleadings are, by leave of the Court on terms, amended so as to include threatened infringements ; in which case the subsequent real infringements may be evidence of intention prior to action brought to infringe, otherwise evidence of subsequent infringements will not be admitted at all.^(e)

The patentee may bring two distinct kinds of action—the one based on the fact that the defendant has infringed before action brought, and the other based on the fact that the defendant threatens and intends to infringe. These two grounds of action may be combined in one action, but they are quite distinct in themselves. In the first case the plaintiff is entitled to claim damages or an account, and an injunction to prevent similar infringements in the future. In the second case the plaintiff may claim an injunction to restrain the threatened infringement. In so far as the action is based on infringement before action brought the plaintiff is bound to give particulars of breaches, and by statute no evidence can, except by leave of the Court or a Judge, be given, at the hearing, of any breaches other than those stated in the particulars. Of course, in so far as the action is based on threats to infringe no particulars of breaches can be given, but care is always taken that the defendant shall have fair notice as to the nature and particulars of the special infringement he is alleged to be contemplating.^(f) *Shoe Machinery Co. v. Cutlan* ^(g) was on the

^(c) (1887) 4 R. P. C. 203.

^(d) p. 504 *ante*.

^(e) *The Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 342.

^(f) *Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 357.

^(g) (1895) 12 R. P. C. 342.

pleadings an action of the first class referred to above. The plaintiff was obliged to admit that the acts done before action brought were in fact not infringements, but he sought to contend that acts done after action brought were different in nature and infringements. The Judge refused on the pleadings (no amendment of which was asked for) to admit evidence of such latter Acts. These latter acts were of such a nature that they would probably have been admissible as evidence of a threat or intention to infringe prior to action brought, if an amendment of the pleadings necessary to include threatened infringement had been asked for. *Frearson v. Loe* (*h*) was a case of the second class, and an injunction was granted to restrain the threatened infringements, evidence of which was on the pleadings clearly admissible. *Dowling v. Billington*, (*i*) on the other hand, though in form an action of the first class, was treated by the Judge as one of the second class, and under the peculiar circumstances of that case evidence of infringement committed after action brought was admitted. The peculiarity of the case was that the alleged infringements committed before action brought were technically not infringements at all, since the complete specification had not then been accepted. The articles made after action brought were admitted in evidence to be the same in kind as those made before, and since the action was brought in respect of that kind of article the Judge must be taken to have admitted the evidence of infringement after action, on the principle that the defendant had on the pleadings fair notice that the plaintiff would contend at the trial that the future manufacture of such articles would be an infringement and that he claimed an injunction to restrain such future manufacture.

Defence.
—

DEFENCE.

By way of defence (*h*) 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. (*l*)

Two main defences.

It is not a valid defence to say that the defendant committed the infringement because the plaintiff failed to carry out

Breach of contract by the plaintiff

(*h*) (1878) L. R. 9 Ch. D. 48.(*i*) (1890) 7 R. P. C. 191.(*h*) For forms of defence see p. 787 *post*.(*l*) *Dudgeon v. Thomson*, (1877) L. R. 3 App. Cas. 37.

Defence. 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.^(m) Moreover, the defendant is at liberty to counterclaim for damages consequent on the breach of the agreement.⁽ⁿ⁾

is not a valid defence.

All grounds of defence should be stated.

The defendant should state in his defence the grounds on which he relies, if he disputes the validity of the patent or alleges that the acts complained of were authorised by the plaintiff, for he cannot at the trial bring forward any ground of defence which is not stated in his pleadings.^(o) He must also be careful that his pleas are not embarrassing, otherwise they may be ordered to be struck out at the instigation of the plaintiff.^(p)

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.^(q)

Particulars do not stand in the place of pleas.

Particulars of objections do not stand in the place of pleas,^(r) and they cannot go outside the pleas,^(s) though they must give more detailed information,^(t) and not be merely reiterations.^(u) 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.^(x)

Short form of defence.

It is submitted that any objection to the validity of a patent will be properly raised if the defence contains a simple denial of the validity of the patent, "on the grounds stated in the particulars of objection delivered herewith";^(y) but it is advisable that the grounds of objection should appear on the defence itself.

^(m) *United Telephone Co. v. Tasker*, (1888) 5 R. R. C. 628.

⁽ⁿ⁾ *Heald v. Incandescent Gas Light Co.*, (1893) 10 R. P. C. 165.

^(o) *Bovill v. Goodier* (2), (1866) L. R. 2 Eq. 195 ; see R. S. C., (1883) Appendix D.

^(p) R. S. C. Ord. 19, r. 27 ; *Ashworth v. Law*, (1887) 7 R. P. C. 231.

^(q) *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 531, 536.

^(r) p. 528 *post*.

^(s) *Macnamara v. Halse*, (1842) 2

W. P. C. 128 ; *Jones v. Berger*, (1843) 1 W. P. C. 544.

^(t) *Bulnois v. Mackenzie*, (1837) 1 W. P. C. 260 ; *Jones v. Berger*, (1843) 1 W. P. C. 544 ; *Walton v. Bateman*, (1842) 1 W. P. C. 616.

^(u) *Neilson v. Harford*, (1841) 1 W. P. C. 370 ; *Betts v. Walker*, (1850) L. R. 14 Q. B. 363, 368 ; *Walton v. Bateman*, (1842) 1 W. P. C. 268 n.

^(x) *Gillet v. Wilby*, (1839) 1 W. P. C. 270.

^(y) See order in *Kurtz v. Spence*, (1887) 36 Ch. D. 776.

The defendant may deny infringement and plead also that the acts complained of were done by the leave and licence of the patentee.^(z) It is further open to him to plead the invalidity of the patent on any one or more of the following grounds:—

Defence.

Grounds on which invalidity may be pleaded.

- i. The grantee was not the true and first inventor.^(a)
- ii. The alleged invention is not the proper subject-matter of a patent.^(b)
- iii. The invention is not useful.^(c)
- iv. The invention is not new.^(d)
- v. The specifications are insufficient.^(e)
- vi. There is some disconformity between the specifications.^(f)
- 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.^(g)
- 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*,^(h) i.e. :
 - a. Letters patent of earlier date than those forming the subject of the action have been granted in respect of the same invention.⁽ⁱ⁾
 - b. The letters patent were granted on a false suggestion.^(k)
 - c. The grant of the letters patent was not lawful.^(l)
 - 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.

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,^(m) or under a plea of insufficiency of the specification.⁽ⁿ⁾

Not subject-matter.

^(z) *Hensee v. Hardie*, (1874) 11 R. P. C. 421; *Guyot v. Thompson*, (1894) L. R. 3 Ch. 388; 11 R. P. C. 541.

^(a) Chap. i. ante.

^(b) Chap. ii. ante.

^(c) Chap. iv. ante.

^(d) Chap. iii. ante.

^(e) Chap. v. ante. ^(f) *Ibid.*

^(g) p. 332 ante.

^(h) 46 & 47 Vict. c. 57, s. 26.

⁽ⁱ⁾ Chap. iii. ante.

^(k) *Ibid.*

^(l) Chap. ii. ante.

^(m) *Walton v. Potter*, (1841) 1 W. P. C. 597; *Househill Co. v. Neilson*, 1 W. P. C. 677.

⁽ⁿ⁾ 21 Jac. I. c. 3, s. 6; *Househill Co. v. Neilson*, (1843) 1 W. P. C. 677; *Jupe v. Pratt*, (1837) 1 W. P. C. 151; *Walton v. Potter*, (1841) 1 W. P. C. 597.

Defence.
 ———
 Not useful.

As we have seen, (o) 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." (p) 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, (q) viz., to deny the utility in general terms, is that usually followed. (r) The defence of want of utility cannot be raised under a plea that the invention is not a new manufacture if the plaintiff objects. (s)

If the specification describes different modes of carrying out the invention, which vary in utility, though all are to some extent useful, this fact cannot be made a valid ground of defence. (t)

Not new.

The issue of novelty is quite distinct from that of true and first inventor, (u) for an invention may be a new manufacture within the Statute of Monopolies (x) 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; (y) and a plea that the invention is not the proper subject-matter of letters patent does not raise the issue of novelty. (z)

In *Walton v. Potter* (a) 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. On the other hand, in *Spilsbury v. Clough* (b) it was held that a plea that the 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. But neither of these cases are to be considered as good law on the subject, for in *Bush v. Fox* (c) the House of Lords held that a plea to the effect that an invention is not a

(o) p. 125 ante.

(p) *Morgan v. Seaward*, (1837) 1 W. P. C. 197; 21 Jac. I. c. 3, s. 6.

(q) *Seton*, 4th Ed. p. 347; *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 531, 536.

(r) *Hindmarch on Patents*, p. 275.

(s) *Walton v. Bateman*, (1842) 1 W. P. C. 623.

(t) *Miller v. Searle*, (1893) 10 R. P. C. 106.

(u) *Househill Co. v. Neilson*, (1843) 1 W. P. C. 689.

(x) 21 Jac. I. c. 3.

(y) *Spencer v. Jack*, (1862) 3 De G. J. & S. 346; 11 L. T. N. S. 242; *Househill Co. v. Neilson*, (1843) 1 W. P. C. 689.

(z) *Booth v. Kennard*, (1856) 1 H. & N. 527.

(a) (1841) 1 W. P. C. 601, 611.

(b) (1842) 1 W. P. C. 255.

(c) (1856) Macr. P. C. 179.

“new manufacture” puts in issue both the novelty of the invention and its being a manufacture; and in *Spencer v. Jack* (d) the Lords Justices, on appeal, ordered the questions of newness of invention and newness of manufacture to be tried separately. Defence.

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. (e) Insufficiency of specification.

The form of letters patent at present in use does not contain any condition (though it might do so) (f) 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, (g) it is still a ground of defence to an action for infringement under the present practice. (h)

It was formerly a ground for a *scire facias* to deceive the Crown by obtaining a patent by means of a false representation, (i) 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; (k) and the objection that there is disconformity is consequently a good defence to the validity of a patent. (l) Moreover, it may be said that the complete 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. (m) Disconformity.

The Court will at any time during the progress of an action Fresh issues

(d) (1864) 3 De G. J. & S. 346; 11 L. T. N. S. 242.

(e) *Arkwright v. Nightingale*, (1785) 1 W. P. C. 61.

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

(g) p. 394 *ante*.

(h) 46 & 47 Vict. c. 57, s. 26, sub-s. 3.

(i) *R. v. Arkwright*, (1785) 1 W. P. C. 66.

(k) *Curtis v. Platt*, (1863) Griff. L. O. C. 53.

(l) 46 & 47 Vict. c. 57, s. 26, sub-s. 3; see also p. 394 *ante*.

(m) *Penn v. Bibby*, (1866) L. R. 2 Ch. App. 127, 130; but see *Derosne v. Fairie*, (1835) 1 W. P. C. 161; *Neilson v. Harford*, (1841) 1 W. P. C. 312; *Morgan v. Fuller* (1), (1866) R. R. 2 Eq. 297.

Defence. 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.⁽ⁿ⁾ Thus, in one case, the plaintiff having altered his case from that originally set up, the defendant was at the trial allowed to amend his defence by adding a plea of want of subject-matter.^(o) In another case, where the defendant at the trial asked for leave to amend his defence by adding a plea of invalidity on the ground of variance between the title and the claims, the Court refused to grant the leave, on the ground that it was asked for too late.^(p)

during the progress of the action.

Decision in a prior action.

Estoppel.—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 parties to the second action,^(q) and the evidence in the second action may be different to that in the former—*e.g.*, a prior user relied on as an anticipation may fail to defeat the patent from want of evidence in the first action, but be completely successful in view of further evidence adduced in the second action.^(r) In second actions, however, the Court usually considers itself bound by the interpretation put on the specification by a Court of equal or superior jurisdiction in the first action when the facts as to prior knowledge are the same; ^(s) though, if the specification has to be reconstructed in the light of fresh facts as to prior knowledge, the Court would most probably not consider itself so bound.^(t)

The fact that the patentee has been defeated in a prior action cannot be pleaded successfully as a bar to a subsequent action,^(u) unless the patent was declared invalid in the prior action and the parties are the same when the matter is *res judicata*,^(x) for until the patent is revoked, or lapsed by

⁽ⁿ⁾ *Holste v. Robertson*, (1876) L. R. 4 Ch. D. 9; S. C. R. 1883, Order xxviii. ; p. 591 *post*.

^(o) *Crossthwaite v. Moorwood*, (1894) 11 R. P. C. 558.

^(p) *Shrewsbury and Talbot S. T. Cab and Noiseless Tyre Co. v. Morgan*, (1896) 13 R. P. C. 75.

^(q) Taylor on Evidence, 5th ed., vol. ii. p. 1444; *Shedden v. A.-G.*, (1860) 30 L. J. N. S. Pr. & Mat. 217.

^(r) *Shaw v. Day*, (1894) 11 R. P. C. 185.

^(s) *Edison v. Holland*, (1888) 5 R. P. C. 459; 6 R. P. C. 243; *Slazenger v. Feltham*, (1889) 6 R. P. C. 130; *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.*, (1889) 6 R. P. C. 367.

^(t) p. 253 *ante*.

^(u) *Arkwright v. Nightingale*, (1785) Dar. P. C. 52.

^(x) *Horrocks v. Stubbs*, (1895) 12 R. P. C. 540; 13 R. P. C. 69; *Shoe Machinery Co. v. Cutlan* (2), (1896) 13 R. P. C. 141.

effluxion of time, a right is presumed to be in the patentee, and his remedy for an infringement of such right is by action on the patent. When the question of validity has been fought out to judgment, and a separate finding has been come to on the point, the matter is *res judicata* between the parties, and cannot be raised again in any fresh action between the same parties. It cannot be raised afresh even if the defendant is prepared with fresh objections as to validity which were not before the Court on the former occasion. When the question of validity is brought to trial it is the duty of the defendant to put his whole case before the Court, and if he does not do so it is his fault or misfortune. In other words, he cannot be permitted to bring his case as to validity piecemeal before the Court in a series of actions.^(y) He could, however, after action, petition for the revocation of the patent.^(z)

Defence.
Estoppel.

When in the prior action the question of validity has been decided against the patentee, this fact may be pleaded by the defendant in the second action, on the ground that the matter is already *res judicata* between the parties.

In one case where the patentee was defeated on the validity of the patent on several grounds, including disconformity, and he then amended the specification, but did not remove the portions which affected the question of disconformity, and then commenced a fresh action, the Court of first instance held that the subject of the action was *res judicata*, and dismissed the action. On appeal, the Court of Appeal, without deciding whether the matter was *res judicata*, held that the true interpretation of a certain agreement between the parties was that the decision on the question of disconformity should be final between them, and dismissed the action on that ground.^(a)

When, however, the portions of the specification which affected the question of validity in a prior action have been entirely removed by amendment before the commencement of a subsequent action, the decision in the former action cannot, of course, be pleaded by the defendant as an estoppel against the plaintiff in the subsequent action.^(b)

Specification amended after prior adverse decision.

A defendant who has once submitted to an injunction is estopped in a second action, or, on being attacked for a second infringement, from either directly or indirectly raising argu-

^(y) *Shoe Machinery Co. v. Cutlan* (2), (1896) 13 R. P. C. 141.

^(z) p. 401 *ante*.

^(a) *Horrocks v. Stubbs*, (1895) 12 R. P. C. 540; 13 R. P. C. 69.

^(b) *Deeley's Patent*, (1894) 11 R. P. C. 76.

Defence.
 ———
 Estoppel.

ments against the validity of the patent.(c) On the other hand, where a defendant has, prior to action brought, stated—not in litigation *inter parties*—in howsoever a definite manner, that he has infringed, this fact does not raise any sort of estoppel against him in an action brought for the infringement of the patent. The question of infringement is one which must in such circumstances be determined quite apart from the defendant's previous statements, excepting in so far as they may affect his credibility as a witness of truth or as an expert.(d)

Defendant a
 licensee.

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 license granted by deed which contains a recital implying the validity of the patent; (e) 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.(f) The incapacity of a licensee to deny the validity of a 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.(g) A revocable licence may be determined by due notice, and thus a licensee may, by proper notice given before action brought, determine the licence, and so turn himself from a licensee into a wrongdoer, and become entitled to dispute the validity of the patent in an action of infringement brought against him by his former licensor;(h) but a plea in a defence to the effect that the licence has been determined will not operate as a due notice of determination.(i)

Defendant an
 assignor.

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.(k)

(c) *Moor v. Thomson*, (1890) 7 R. P. C. 327.

(d) *Osborne v. Board*, (1896) 13 R. P. C. 748.

(e) *Bowman v. Taylor*, (1834) 2 A. & E. 278; 1 W. P. C. 292; *Cutler v. Bower*, (1848) 11 Q. B. 973; see p. 379 *ante*.

(f) *Smith v. Scott*, (1859) 6 C. B. N. S. 771; 5 Jur. N. S. 1358; *Hall v. Conder*, (1857) 2 C. B. N. S. 22.

(g) *Dangerfield v. Jones*, (1865) 13 L. T. N. S. 142; *Axman v. Lund*, (1874) L. R. 18 Eq. 330; *Crossley v. Dixon*, (1863) 10 H. L. C. 293.

(h) pp. 381, 382 *ante*.

(i) *Ibid.*

(k) *Oldham v. Longmead*, (1789) cited 3 T. R. 441; *Walton v. Lavater*, (1860) 8 C. B. N. S. 162, 187; *Heugh v. Chamberlain*, (1877) 25 W. R. 742; but see pp. 354, 355 *ante*.

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 be the original patentee and defendant in an action of infringement brought by the assignee;(l) and he is at liberty to show that the specification is not as wide as the plaintiff alleges.(m) Moreover, an assignor cannot be restrained from assisting, as a scientific witness or otherwise, the defendant in an action brought by the assignee.(n)

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.(o) But 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, is not estopped from disputing the patent in an action brought by the patentee after the termination of the partnership.(p)

In *Baird v. Neilson*(q) it appeared that *Baird* had agreed with *Neilson* to put an end to litigation and pay a royalty for the use of *Neilson's* patented invention. 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.

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.(r)

A defendant may be estopped from denying the validity

Defence.

Estoppel.

Defendant a former partner of the plaintiff.

Agreement may operate as an estoppel.

Defendant may

(l) *Hocking and Co. v. Hocking*, (1889) 6 R. P. C. 69.

(m) *Ibid.*

(n) *London and Leicester Hosiery Co., Ltd. v. Griswold*, (1886) 3 R. P. C. 250, 253.

(o) *Chambers v. Crichley*, (1864) 33 Beav. 374.

(p) *Axmann v. Lund*, (1874) L. R. 18 Eq. 330. (q) 8 C. L. & F. 726.

(r) *Crossthwaite v. Steel*, (1888) 5 R. P. C. 220.

Defence. of a patent on a motion for an interlocutory injunction, and yet not be so estopped at the trial.

Estoppel.

be estopped from denying validity of the patent on a motion for interlocutory injunction though not 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.^(s) 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.^(t)

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.^(u) 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.^(x)

Assignment by trustee in bankruptcy no estoppel against the patentee.

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.^(y)

Estoppel may operate against one only of several defendants.

When there is more than one defendant, an estoppel may affect only one of them.^(z) Thus, in a case where it appeared that one defendant had, during the existence of a partnership

^(s) *Goucher v. Clayton*, (1865) 11 Jur. N. S. 107.

^(t) *Muntz v. Grenfell*, (1842) 2 W. P. C. 88, 91.

^(u) *Dudgeon v. Thomson*, (1877) 30 L. T. N. S. 244.

^(v) *Newall v. Elliott*, (1863) 1 H. & C. 797.

^(y) *Cropper v. Smith*, (1884) L. R. 26 Ch. D. 700, 706; 10 App. Cas. 249; 1 R. P. C. 81; 2 R. P. C. 17.

^(z) *Goucher v. Clayton*, (1865) 11 Jur. N. S. 107; *Heugh v. Chamberlain*, (1877) 25 W. R. 742.

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.^(a) 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,^(b) provided he is not otherwise estopped from denying the validity of the patent.^(c)

Particulars of Objections.

PARTICULARS OF OBJECTIONS.

It is enacted by the Patents, Designs, and Trade Marks Act, 1883,^(d) 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.

Must be delivered with the defence, or by order of the Court or a Judge, at any subsequent time.

It is also by the same statute ^(e) further enacted that at the hearing of an action for infringement no evidence shall, except by leave of the Court or a Judge, be admitted in proof of any alleged objection of which particulars have not been delivered.

Evidence limited by particulars.

The Court only rarely exercises its power of admitting evidence of which particulars have not been delivered—*e.g.*, where not to do so would be to stultify the action of the Court. Thus, where the defendant pleaded that what he did was done under a patent granted to him prior to the plaintiff's patent, and then at the trial tendered evidence not included in the particulars to the effect that he himself had publicly used the very thing claimed by both patents years before the date of either, *Kay*, L.J., ordered an adjournment and granted leave to adduce the defendant's evidence of prior user within a certain time, though he was not asked to do so, and stated

Discretionary power of the Court or a Judge to admit evidence not within the particulars.

^(a) *Heugh v. Chamberlain*, (1877) 25 W. R. 742.

^(b) *Cropper v. Smith*, (1885) L. R. 10 App. Cas. 249.

^(c) *Heugh v. Chamberlain*, (1877) 25 W. R. 742; *Goucher v. Clayton*, (1865) 11 Jur. N. S. 107.

^(d) s. 29. As to the disadvantages in giving an unnecessary multiplicity of objections see *Allen v. Oates*, (1898), 15 R. P. C. 303.

^(e) s. 29, sub-s. 4.

Particulars of
Objections.

that if it were put in he would allow the plaintiff an opportunity of dealing with it, otherwise there would be judgment for the defendant without costs. (*f*)

The discretionary power of the Court to admit evidence not within the particulars is quite independent of its power to allow an amendment of the particulars for the purpose of admitting fresh evidence. (*g*)

As we have seen, particulars of objections do not stand in the place of, and cannot go beyond, the pleas raised by the defence; (*h*) 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. (*i*)

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. (*k*)

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; (*l*) as also has the Court of Appeal; (*m*) 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, (*n*) for an order for further and better particulars; otherwise, where the particulars are too general, evidence within their literal meaning may be admitted. (*o*) 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

(*f*) *Hill v. Adams*, (1893) 10 R. P. C. 102; *Solvo Laundry Supply Co. v. Mackie*, (1893) 10 R. P. C. 68; see also *Britain v. Hirsch*, (1888) 5 R. P. C. 230; *Peckover v. Rowland*, (1893) 10 R. P. C. 118.

(*g*) *Britain v. Hirsch*, (1888) 5 R. P. C. 226; p. 529 *post*.

(*h*) p. 518 *ante*.

(*i*) pp. 512-517 *ante*.

(*k*) *Bulnois v. Mackenzie*, (1837) 1 W. P. C. 260.

(*l*) s. 29 (5).

(*m*) *Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 530; *Britain v. Hirsch*, (1888) 5 R. P. C. 226; p. 512 *ante*; p. 591 *post*.

(*n*) Judicature Act, 1873, s. 39; *Fearson v. Loe*, (1878) 26 W. R. 138; R. S. C. 1883, Ord. xix. r. 7.

(*o*) *Hull v. Bollard*, (1856) 1 H. & N. 134; *Curtis v. Platt*, (1865) 35 L. J. N. S. Ch. 852, 868; *Sugg v. Silber*, (1876) L. R. 2 Q. B. D. 493.

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." (p)

Particulars of Objections.

If, however, the defendant delivers his objections fairly and honestly and does his best to give the plaintiff the information he is entitled to, it is not the province of the Court by ordering amendments to tie his hands so tight as to dictate to him in an early stage of the proceedings how exactly he is to frame his case, (q) since the object of the particulars is only to prevent surprise, to limit the scope of the inquiry and to prevent expense.

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. (r)

Time for pleading after delivery of particulars.

The party against whom an order for further and better particulars is made may be ordered to pay the costs of the application; (s) 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 by summons in chambers to have the insufficient particulars struck out. (t)

Costs of further and better particulars.

A defendant complying with an order for further and better particulars is not entitled to give *fresh* particulars without having obtained leave to amend, and if he does insert them they may be struck out by the plaintiff on summons. (u)

Fresh particulars cannot be given in compliance with an order for further and better particulars,

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 (x) upon terms, (y) to raise a fresh issue on the discovery of facts which could not with due diligence have been discovered before, (z) and he will be allowed to amend his par-

but can be given at any time by leave of the Court or a Judge.

(p) *Sugg v. Silber*, (1876) L. R. 2 Q. B. D. 495.

(q) *Nettlefolds v. Reynolds*, (1891) 8 R. P. C. 417, per Lindley, L.J.; see also *Holliday v. Hippenstall*, (1889) 6 R. P. C. 320.

(r) S. C. R. 1883, Ord. xix. r. 8; *Boyd v. Farrar*, (1888) 5 R. P. C. 33, 36.

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

(t) *Flower v. Lloyd*, (1877) 20 S. J. 860; *Higgins' Digest*, Supplement p. 78; *Aktiebolagat Separator v. Dairy Outfit Co.*, (1896) 13 R. P. C. 725.

(u) *Aktiebolagat Separator v. Dairy Outfit Co.*, (1896) 13 R. P. C. 725, 727.

(x) 46 & 47 Vict. c. 57, s. 29, sub-s. 5. (y) p. 530 *post*.

(z) *Holste v. Robertson*, (1876) L. R. 4 Ch. D. 9; *Otte v. Steel*, (1885) 2 R. P. C. 139.

Particulars of
Objections.

Particulars of objections accordingly, though he may be liable for the costs occasioned by any such amendment.(a)

The defendant may, even during the progress of the trial, obtain leave on short service of motion to amend his particulars,(b) if he can show that the fresh evidence he is desirous of adducing could not with due diligence have been discovered earlier ;(c) but if an amendment be made late, though the defendant succeed in the action and the action is dismissed, it may be so dismissed without costs.(d)

The Court will not sanction an amendment, if, on the face of it, it appears that the fresh objection cannot be sustained.(e)

Particulars on
a new trial.

Where a new trial is obtained the defendant is entitled to give particulars of objections which were not raised at the first trial.(f)

Terms usually
imposed when
leave is given
to amend par-
ticulars of
objections.

When leave to amend particulars of objections is given, the Court generally imposes terms, and the usual order, with the object of putting the plaintiff in the same position as he would have been in, if the particulars had originally been delivered in their amended form, 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 objections to be amended in the event of the plaintiff not electing to discontinue, and makes the cost of the application, and consequent on the amendment, the plaintiff's in any event.(g)

The fact that the plaintiff was aware of the existence of the fresh objection which the defendant seeks to raise will not in itself entitle the defendant to an order on any more favourable terms.(h)

When the plaintiff, at the hearing of an application by the defendant for leave to amend his particulars, elects to proceed

(a) *Renard v. Levinstein*, (1864) 13 W. R. 229 ; 11 L. T. N. S. 505 ; *Daw v. Eley*, (1865) L. R. 1 Eq. 38 ; *Blakey v. Latham*, (1889) 6 R. P. C. 29.

(b) *Ibid.*

(c) *Moss v. Malings*, (1886) L. R. 33 Ch. D. 603 ; *Edison Electric Co. v. Sheppey*, (1887) 4 R. P. C. 471 ; *Blakey v. Latham*, (1889) 6 R. P. C. 184.

(d) *Allen v. Horton*, (1893) 10 R. P. C. 412.

(e) *Holste v. Robertson*, (1876) L. R. 4 Ch. D. 9.

(f) *Bovill v. Goodier*, (1871) 36 L. J. N. S. Ch. 360.

(g) *Edison Telephone Co. v. India-*

rubber Co., (1881) L. R. 17 Ch. D. 137 ; *Baird v. Moule's Earth Closet Co.*, (1881) L. R. 17 Ch. D. 139 ; *Aveling v. Maclaren*, (1881) L. R. 17 Ch. D. 139 ; *Ehrlich v. Ihlee*, (1887) 4 R. P. C. 115, 119 ; *Parker v. Maignen's Filtre Rapide Co.*, (1888) 5 R. P. C. 207 ; *Darrar v. Purser*, (1889) 6 R. P. C. 365 ; *Solvo Laundry Supply Co. v. Mackie*, (1893) 10 R. P. C. 68 ; *Badische Anilin und Soda Fabrik v. La Société des Usines du Rhône*, (1897) 14 R. P. C. 891.

(h) *Ehrlich v. Ihlee*, (1887) 4 R. P. C. 115.

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.⁽ⁱ⁾

Particu-
lars of
Objections.

Where a defendant in compliance with an order of the Court had amended his particulars of objections, and made an application for leave to reamend 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 reamendment were reserved; ^(k) 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.^(l)

On an appeal the Court has power to receive further evidence, and to order an amendment of the particulars of objection for the purpose of admitting it,^(m) 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),⁽ⁿ⁾ and not without special leave.^(o)

Further evi-
dence on
appeal.

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,^(p) or that the defendant has been misled,^(q) though he would be allowed to cure a merely formal defect in his title.^(r)

A patent may be void on account of the disconformity of the specifications, or in consequence of the claim being defective;^(s) but, it is submitted, a defendant relying on either of these grounds cannot dispense with the necessity for delivering particulars of objections, for the Court will not undertake to decide as to the disconformity of the specifications or the validity of

Particulars of
disconformity,
or defective
claims are
necessary.

⁽ⁱ⁾ *Parker v. Maignen's Filtre Rapide Co.*, (1888) 5 R. P. C. 208.

^(k) *Penn v. Bibby*, (1866) L. R. 1 Eq. 548.

^(l) *Wilson v. Gann*, (1875) W. N. 1875, 78.

^(m) *Cropper v. Smith*, (1884) 1 R. P. C. 81; 2 R. P. C. 17; *Shoe Machinery Co. v. Cutlan*, (1895) 12 R. P. C. 530.

⁽ⁿ⁾ *Hinde v. Osborne*, (1885) 45.

^(o) R. S. C. 1883; Ord. lviii. r. 4.

^(p) *Hinde v. Osborne*, (1885) 2 R. P. C. 45; *Walker v. Hydrocarbon Syndicate*, (1886) 3 R. P. C. 253; *Blakey v. Latham*, (1889) 6 R. P. C. 184.

^(q) *American Braided Wire Co. v. Thomson*, (1888) 5 R. P. C. 113, 118.

^(r) *Nordenfelt v. Gardner*, (1884) 1 R. P. C. 61, judgment of Lindley, L.J.

^(s) *Chap. v. ante.*

- Particulars of Objections.** the claims without the evidence of witnesses,^(t) which could not be given unless particulars had been previously delivered.^(u)
 The particulars of objections must be precise and definite, and should not contain a long list of anticipations, of which only a few are relied on at the trial ;^(x) but they should give such information as will enable the plaintiff to make the necessary inquiries at any places named.^(y)
- Particulars of objections must be precise and definite.** The Act of 1835 ^(z) was the first statute which specifically 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.^(a) This object is similarly provided for by the Act of 1883.^(b)
- Object of particulars of objections.** The objection that the patentee is not the true and first inventor does not raise the question of novelty generally, but only that the patentee obtained the invention from some one else, and should only be used for this purpose,^(c) and the name of the person from whom it is alleged the patentee obtained the invention should be stated,^(d) though this was not so under the old practice prior to the Act of 1883.^(e)
- True and first inventor.** When it is objected that the invention is not subject-matter the reason should be definitely stated. When other objections fail the objection that the invention is not subject-matter can rarely be made out.^(f)
- Subject matter.** Also when an objection is directed to the issue of prior grant it must state distinctly the grounds on which it is alleged that the patentee was not the first grantee.^(g)
- Prior grant.** The Act of 1835 did not require any further detail in the defendant's particulars of objections than in the plaintiff's particulars of breaches, but the terms of the subsequent Act of 1852,^(h) which are very similar to, though not quite so general as, the words of the Act of 1883, which regulates the
- Novelty. Requisite details.**

(t) *Arnold v. Bradbury*, (1871) L. R. 6 Ch. App. 706; *Longbottom v. Shaw*, (1889) 6 R. P. C. 510.

(u) p. 527 *ante*.

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

(y) *Per Parke, B., Palmer v. Cooper*, (1853) 9 Exch. 236.

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

(a) See remarks of Tindal, C.J., *Fisher v. Dewick*, (1838) 1 W. P. C. 267; *Curtis v. Platt*, (1863) 8 L. T. N. S. 657.

(b) s. 29, sub-s. 2; *Holliday v. Heppenstall*, (1889) 6 R. P. C. 320;

Nettlefolds v. Reynolds, (1891) 8 R. P. C. 417.

(c) *Thomson v. Macdonald & Co.*, (1890) 8 R. P. C. 8; *Househill Co. v. Neilson*, (1843) 1 W. P. C. 689.

(d) *Siddell v. Vickers*, (1887) 5 R. P. C. 85.

(e) *Russell v. Ledsam*, (1843) 11 M. & W. 64.

(f) See per Esher, M.R., *Edison-Bell Phonograph Corporation v. Smith and Young*, (1894) 11 R. P. C. 398, ll. 37-52.

(g) *Rothwell v. Macintosh*, (1894) 11 R. P. C. 274.

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

present practice as regards particulars directed to the issue of want of novelty, 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."

Particulars of Objections.

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.

Particulars of objection will be too indefinite if, for instance, they allege as an anticipation a user by certain persons specified, and "*divers other persons*,"(i) or "*by other persons in London and Birmingham*,"(k) or "*at Nottingham and elsewhere*,"(l) or "*by manufacturers generally in London and the vicinity*,"(m) 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,(n) 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.(o)

Must not be too general.

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 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.(p)

General public knowledge.

(i) *Galloway v. Bleadon*, (1839) 1 W. P. C. 268 n; *Fisher v. Dewick*, (1838) 1 W. P. C. 551 n.

(k) *Flower v. Lloyd*, (1877) 20 S. J. 360.

(l) *Jones v. Berger*, (1843) 1 W. P. C. 544; *Holland v. Fox*, (1853) 1 C. L. R. 440.

(m) *Alliance Pure White Lead Syndicate v. MacIvor's Patents*, (1891) 8 R. P. C. 321; p. 534 *post*.

(n) *Fisher v. Dewick*, (1838) 1 W. P. C. 264; *Russell v. Ledlam*, (1843) 11 M. & W. 647.

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

(p) *Cole v. Squire*, (1888) 5 R. P. C. 489; *Holliday v. Heppenstall*, (1889) 6 R. P. C. 320; *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 302; *Phillips v. Ivel Cycle Co.*, (1890) 7 R. P. C. 77.

Particulars of Objections.

Prior specifications and rare books cannot be referred to under a plea of common knowledge.

Distinction between issue of common knowledge and prior publication.

Particulars directed to prior general public knowledge—*i.e.*, common knowledge—will not authorise the defendant to give in evidence prior specifications or rare books or users. Such publications must be referred to in separate particulars; and if this is not done the defendant will only be allowed to make the amendment necessary to admit the evidence on the usual terms.^(q)

Common knowledge is really a different issue to prior publication, of which definite particulars must be given. Common knowledge goes to subject-matter and prior publication to novelty; and when common knowledge is pleaded it is not necessary to give particulars of it.^(r) In framing a particular as to common knowledge care must be taken that it does not include or point to something of which a separate particular should be given, otherwise the plaintiff may be entitled to further and better particulars.^(s) Thus, when the particular given was to the effect that “the alleged invention was not the subject-matter of valid letters patent, but was the mere analogous use and application to an old and well-known sewing machine of mechanical appliances and arrangements of parts well known and in common use in machines of a similar kind, and used for similar or analogous purposes, prior to the date of the said alleged Letters Patent,” it was held not to be merely one of common knowledge, but to point to some particular mechanical appliance used in the machine as having been used previously to the date of the patent, and further and better particulars were ordered accordingly.^(t)

Objection to general plea of want of novelty.

The general plea that the invention was not new is objectionable, as it may be said to be ambiguous in so far as it may go to general public knowledge or specific prior publications or users, of which detailed particulars are necessary.^(u)

General user may be stated in general,

It may be that 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

^(q) Edison Telephone Co. v. India Rubber Co., (1881) L. R. 17 Ch. D. 137; Peckover v. Rowland, (1893) 10 R. P. C. 118; Solvo Laundry Supply Co. v. Mackie, (1893) 10 R. P. C. 68; English and American Machinery Corporation v. Union Boot and Shoe Machine Co., (1894) 11 R. P. C. 373; p. 530 *ante*.

^(r) Holliday v. Heppenstall, (1889)

6 R. P. C. 326; Boxwell v. Cochran, (1895) 12 R. P. C. 169.

^(s) Chadburn v. Mechan, (1895) 12 R. P. C. 120; Birch v. Harrap, (1895) 12 R. P. C. 431.

^(t) Birch v. Harrap, (1895) 12 R. P. C. 431.

^(u) Singer v. Rudge Cycle Co., (1894) 11 R. P. C. 585.

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.^(x) In such a case the plaintiff is entitled by means of interrogatories to obtain the names and addresses of such manufacturers, and the places and dates of user.^(y) An allegation of general public user must not, however, be in too indefinite 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.^(z) 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.^(a)

Particulars of Objections.

but not too indefinite terms.

The Court will sometimes allow general words such as "amongst others,"^(b) or "amongst other instances,"^(c) to remain in the particulars of objections, but it will take care that the plaintiff shall not be taken by surprise at the trial.^(d)

In one 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 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

^(x) *Palmer v. Wagstaff*, (1853) 8 Exch. 840; *Jones v. Berger*, (1843) 1 W. P. C. 547; *Bentley v. Keighley*, (1844) 7 M. & G. 652; 8 Scott N. R. 372.

^(y) *Alliance Pure White Lead Syndicate v. MacIvor's Patents, Ltd.*, (1891) 8 R. P. C. 321.

^(z) *Morgan v. Fuller* (2), (1866) L. R. 2 Eq. 297.

^(a) *Jones v. Berger*, (1843) 1 W. P. C. 549.

^(b) *Curtis v. Platt*, (1863) 8 L. T. N. S. 657.

^(c) *Penn v. Bibby*, (1866) L. R. 1 Eq. 548.

^(d) *Curtis v. Platt*, (1863) 8 L. T. N. S. 657 judgment of Wood, V.C.

Particulars of
Objections.

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.(e)

Requisites of a
particular
directed to
specific prior
users.

Where specific users are relied on the defendant is generally required to state the time and place of such users,(f) and to describe the thing alleged to have been used by a definite description, e.g., by use of a *Wenham* lamp will not do, as that might be by any lamp made by *Wenham*.(g)

The particulars will be sufficient if they state definitely the kind of article, the prior sale, manufacturer, or user of which it is alleged anticipates the patent, the names of the alleged prior sellers, manufacturers, or users, and the dates.(h) The particulars must, however, state the mode in which the alleged prior user anticipates the invention.(i)

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;"(k) 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."(l)

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.

In *Flower v. Lloyd* (m) 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

(e) *Pascall v. Toope*, (1890) 7 R. P. C. 125.

(f) *Holliday v. Heppenstall*, (1889) 6 R. P. C. 320; *Boyd v. Horrocks*, (1886) 3 R. P. C. 281; *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 302; *Philips v. Ivel Cycle Co.*, (1890) 7 R. P. C. 82; *Heathfield v. Greenway*, (1894) 11 R. P. C. 17; *Siemens v. Karo*, (1891) 8 R. P. C. 376.

(g) *Siemens v. Karo*, (1891) 8 R. P. C. 376; *Palmer v. Wagstaffe*, (1853) 8

Ex. 840; *Boyd v. Farrar*, (1887) 5 R. P. C. 35; *Sidebottom v. Fielden*, (1891) 8 R. P. C. 272; *Alliance Pure White Lead Syndicate v. MacIvor*, (1891) 8 R. P. C. 321.

(h) *Sidebottom v. Fielden*, (1891) 8 R. P. C. 266.

(i) *Scott v. Hull Steam Fishing and Ice Co.*, (1896) 13 R. P. C. 206.

(k) p. 532 *ante*.

(l) s. 29 (3).

(m) (1877) 46 L. J. Ch. 746; 20 S. J. 860.

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 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.

Particulars of Objections.

It was expressly held that under the Act of 1852 the plaintiff was entitled to the names and addresses (*i.e.*, the present residences) (*n*) 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; (*o*) 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. (*p*) 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*. (*q*)

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 state reasonably on what ground, in respect of want of novelty, he

Different requisites under Acts of 1852 and 1883 respectively.

(*n*) *Palmer v. Cooper*, (1853) 9 Exch. 236.

(*o*) *Birch v. Mather*, (1883) L. R. 22 Ch. D. 629.

(*p*) *Ibid.*

(*q*) *Plimpton v. Spiller*, (1877) 20 S. J. 859; see p. 536 *ante*.

Particulars of Objections.

disputes it, and he must also state the time and place of the previous publications or user alleged by him.^(r)

In *Curtis v. Platt*,^(s) 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.^(t)

Requisites of a particular directed to publication by prior specifications or printed books.

A defendant who relies on prior specifications,^(u) or printed books,^(x) must point out, by reference to pages and lines, what portions of such specifications or books he relies on; ^(y) 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.^(z) A defendant is entitled to rely on the whole of a specification if necessary, and cannot be forced to point out special parts, unless it appears that no attempt at discrimination has been made.^(a) When, however, specifications or other publications are relied on, and the whole is stated to be relied on, it is always in the discretion of the Court to see how far the

^(r) *Fowler v. Gaul*, (1886) 3 R. P. C. 247, 250; *Boyd v. Horrocks*, (1886) 3 R. P. C. 285; *Darrah v. Purse*, (1889) 6 R. P. C. 365.

^(s) (1863) 8 L. T. N. S. 657.

^(t) *Ibid.*

^(u) *Fowler v. Gaul*, (1886) 3 R. P. C. 247.

^(x) *Harris v. Rothwell*, (1886) 3 R. P. C. 243.

^(y) See *Grover and Baker Sewing Machine Co. v. Wilson*, W. N., (1870) 78; *Fisher v. Dewick*, (1838) 1 W. P. C. 264; *Plimpton v. Spiller*, *Higgins' Supplement*, p. 79.

^(z) *Harris v. Rothwell*, (1886) 3 R. P. C. 243.

^(a) *Sidebottom v. Fielden*, (1891) 8 R. P. C. 266.

defendant really does rely on the whole, and to order further particulars if it thinks fit; and each case must be considered on its own merits.(b)

Particulars of Objections.

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 he alleges as publications of any of the plaintiff's claims.(c) 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.(d). 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.(e)

If a defendant object that there is a disconformity between the specifications, he may be required to state in what the disconformity consists, or how the invention described in the complete differs from that described in the provisional specification.(f) So when it was stated that the invention described in the complete specification was different to that described in the provisional specification, and in particular the inventions described in certain pages and lines of the complete were not described in the provisional specification, the particular was held too wide, and the defendant was ordered to limit the alleged variance to the particulars given.(g)

If it be objected that the complete specification does not sufficiently describe and ascertain 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

(b) *Siemens v. Karo*, (1891) 8 R.P.C. 376.

(c) *Jones v. Berger*, (1843) 1 W. P. C. 551 n.

(d) *London and Leicester Hosiery Co. v. Higham*, Lawson on Patents, 2nd ed. p. 498; *Harris v. Rothwell*, (1886) 3 R. P. C. 243; *Fowler v. Gaul*, (1886) 3 R. P. C. 247; *Boyd v. Horrocks*, (1886) 3 R. P. C.

285; *Boyd v. Farrar*, 5 R. P. C. 33, 36.

(e) *Boyd v. Farrar*, (1888) 5 R. P. C. 33, 35.

(f) *Anglo-American Brush Electric Light Corporation v. Crompton*, (1886) L. R. 34 Ch. D. 152; *Fisher v. Dewick*, (1838) 1 W. P. C. 551 n.

(g) *Heathfield v. Greenway*, (1894) 11 R. P. C. 17.

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which the patent relates to make a machine the subject of the invention, and if the defendant is in a position to give better particulars he must state in what respect the specification is insufficient.^(h) 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.⁽ⁱ⁾

Also where the objection is that the specification is ambiguous and misleading it is necessary to state definitely in what respect it is alleged to be ambiguous and misleading.^(k) And where the allegation is that the specification does not distinguish what is new from what is old the particulars must point out in what respect it fails to do this sufficiently.^(l)

Greater detail is required under Act of 1883 than under the former practice.

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,^(m) or that it is calculated to deceive,⁽ⁿ⁾ or does not sufficiently set forth the nature of the invention,^(o) or that the invention does not produce the effect stated,^(p) which were held sufficient under the old practice, would most probably not be held so now.

Objection directed to 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.^(q) 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.

INTERLOCUTORY INJUNCTION.

Prima facie case must be established.

If the plaintiff in a patent action, as is usually the case, desires to obtain an interlocutory injunction restraining the

^(h) *Crompton v. Anglo-American Brush Corporation*, (1886) L. R. 35 Ch. D. 283; *Leaf v. Topham*, (1845) 14 M. & W. 146; *Heathfield v. Greenway*, (1894) 11 R. P. C. 17; *Heath v. Unwin*, 1 W. P. C. 551 n.

⁽ⁱ⁾ *Neilson v. Harford*, (1841) 1 W. P. C. 332.

^(k) *Farbenfabriken vorm F. Bayer v. Bowker*, (1891) 8 R. P. C. 391; *Heathfield v. Greenway*, (1894) 11 R. P. C. 17.

^(l) *Delta Metal v. Maxim-Nordenfelt Guns and Ammunition Co.*, (1891)

8 R. P. C. 170; *Thomson v. Batty*, (1888) 6 R. P. C. 88; *Fisher v. Dewick*, (1838) 1 W. P. C. 551 n; *Jones v. Berger*, (1843) 5 M. & G. 208; *Baker v. Kinnell*, (1893) 9 R. P. C. 443.

^(m) *Jones v. Berger*, (1843) 5 M. & G. 208; W. P. C. 546.

⁽ⁿ⁾ *Neilson v. Harford*, (1841) 1 W. P. C. 324 n.

^(o) *Heath v. Unwin*, (1842) 10 M. & W. 687.

^(p) *Jones v. Berger*, (1843) 1 W. P. C. 551 n.

^(q) *Hindmarch on Patents*, 438.

defendant from continuing the acts complained of, or commencing to commit threatened infringements, till the trial of the action, he ought to commence the action expeditiously on becoming aware of infringements or threats to infringe and apply to the Court, *ex parte*, or on notice, and in either case without delay.(r)

In order to obtain an interlocutory injunction it is necessary for the plaintiff, in addition to not being guilty of *laches*, to establish a *prima facie* case of validity of the patent and of the fact of infringement.

On an interlocutory application the Court avoids as far as possible expressing an opinion on the merits of the case,(s) and does not decide the question of validity unless the patent appears on the face of it so irretrievably and hopelessly bad that it could not possibly be supported.(t) The Court endeavours to keep things *in statu quo*.(u)

Acquiescence is a bar to the right to an interim injunction. Acquiescence. 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 defendant 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.(w) Acquiescence also may at the trial of the action disentitle the plaintiff to an account of profits altogether,(y) or partially by limiting the account to profits made since the commencement of the action; (z) it may also be a ground for granting damages instead of an injunction.(a)

The conduct of a plaintiff who knows of the existence of a patent of later date than his own for the same invention, but takes no steps to get it repealed, does not amount to

(r) *Bacon v. Jones*, (1839) 4 My. & Cr. 436; *Baxter v. Coombe*, (1850) 1 Ir. Ch. R. 284; *Bridson v. Benecke*, (1849) 12 Beav. 1; *Bovill v. Crate*, (1865) L. R. 1 Eq. 388; *Lister v. Norton*, (1884) 1 R. P. C. 114; *United Telephone Co. v. Equitable Telephone Co.*, (1888) 5 R. P. C. 235; *Leonhardt v. Kellé*, (1894) 11 R. P. C. 534.

(s) *Plimpton v. Malcolmson*, (1875) L. R. 20 Eq. 38.

(t) *Briggs v. Lardeux*, (1884) 1 R. P. C. 126; *Shillito v. Lannuth*, (1885) 2 R. P. C. 1; *Plimpton v. Malcolmson*,

(1875) L. R. 20 Eq. 38; *Tadman v. Owens*, (1894) 11 R. P. C. 349.

(u) *Plimpton v. Spiller*, (1877) L. R. 4 Ch. D. 288.

(w) *Neilson v. Thompson*, (1841) 1 W. P. C. 275, 285.

(y) *Crossley v. Beverly*, (1829) 1 W. P. C. 120; *Harrison v. Taylor*, (1865) 11 Jur. N. S. 408.

(z) *Ford v. Foster*, (1872) L. R. 7 Ch. App. Cas. 611, 627; *Beard v. Turner*, (1866) 13 L. T. N. S. 746.

(a) *Sayers v. Collyer*, (1885) L. R. 28 Ch. D. 103.

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locutory
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Laches.

acquiescence, unless the invention is actually put in practice under the subsequent patent.(b)

Unexplained delay is a bar to an interlocutory injunction, both when the patent has not been previously contested (c) and when it has been established in prior proceedings.(d) In case of delay the defendant may be able to plead a growth of trade which would not have arisen but for the plaintiff's *laches*, and the Court will not interfere with it pending a final decision as to the validity of the patent and the fact of infringement.(e)

Thus, a plaintiff was held to be too late who applied on December 2 for an interim injunction in respect of infringement committed on November 13 and 23.(f)

And where the plaintiff knew in December what the defendant was doing, but did not move for an injunction till the following July, he was held too late, notwithstanding that he had obtained judgments by default in several prior actions.(g) So again, a plaintiff was too late where it appeared that he had known of the defendant's conduct for eleven months before moving.(h)

Delay may
sometimes be
satisfactorily
explained.

Delay in some cases is capable of a satisfactory explanation, and then it is no longer a bar to the injunction.

Thus, where it appeared that the plaintiff had on several previous occasions established his patent, and there was a combination of persons against him interested in resisting his claims, in consequence of which 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.(i)

Again, where the plaintiffs, in February, received notice from the solicitors to a company that the company was being formed 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,

(b) *Newall v. Wilson*, (1852) 2 De G. M. & G. 282.

(c) *Bacon v. Jones*, (1839) 4 My. & Cr. 436; *Baxter v. Coombe*, (1850) 1 Ir. Ch. R. 284; *Bridson v. Benecke*, (1849) 12 Beav. 1, 3; *Bovill v. Crate*, (1865) L. R. 1 Eq. 388; *Lister v. Norton*, (1884) 1 R. P. C. 114; *United Telephone Co. v. Equitable Telephone Co.*, (1888) 5 R. P. C. 235; *Leonhardt v. Kallé*, (1894) 11 R. P. C. 534; *Dunlop Pneumatic Tyre Co. v. Pneumatic Tyre Co.*, (1897) 14 R. P. C. 263.

(d) *North British Rubber Co. v.*

Gormully and Jeffery Manufacturing Co., (1894) 12 R. P. C. 21.

(e) *North British Rubber Co. v. Gormully and Jeffery Manufacturing Co.*, (1894) 12 R. P. C. 17; p. 593 *post*.

(f) *Greer v. Bristol Tanning Co.*, (1885) 2 R. P. C. 268.

(g) *Edison-Bell Phonograph Corporation v. Hough*, (1894) 11 R. P. C. 594.

(h) *Leonhardt v. Kallé*, (1894) 11 R. P. C. 534.

(i) *Bovill v. Smith*, (1867) W. N. 240.

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.^(k) And an interim injunction was granted, when the plaintiff became aware of the infringement on March 23, but spent some time in making inquiries before giving the defendant notice to desist on May 8, and continued in correspondence with him till the bill was filed on July 7.^(l)

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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 he had knowledge some time before the commencement of the action.^(m)

Defendant
working under
a patent of his
own.

But where a defendant contended that he was working under a patent of his own, which he maintained was valid, *Cottenham*, L.C., in refusing an interim injunction, said: "It would be rash in me if I were to give an opinion, coming to a conclusion contrary to what is sworn by the most eminent scientific persons in this country. If in a question so open to doubt as this I should interfere with the defendant I should be setting up my own judgment in opposition to those who, being practically acquainted with matters of this description, have deposed that, according to all rules and principles, the subject-matter of the defendant's patent may be perfectly new and unconnected with anything claimed by the plaintiff. I may not be satisfied that these gentlemen are right, or that the plaintiffs are wrong, but I am satisfied that the case is not one so free from doubt as to justify me in interfering."⁽ⁿ⁾

Where as against the actual defendant there has been no *laches*, it cannot be contended in his favour that he is merely the agent of another person not a party to the action, who would have been able to establish a complete case of *laches* if the action had been brought against him.^(o) But where the defendant is merely the customer of another, against whom there is a pending action in which an interlocutory injunction has been refused, on an undertaking to pay money into Court

Defendant the
agent of a
person who
could establish
a case of *laches*.

^(k) *United Telephone Co. v. Equitable Telephone Association*, (1888) 5 R. P. C. 233.

^(l) *Losh v. Hague*, (1837) 1 W. P. C. 201.

^(m) *Osmund v. Hirst*, (1885) 2 R. P. C. 265, 267.

⁽ⁿ⁾ *Electric Telegraph Co. v. Nott*, (1847) 11 Jur. 157; 2 Coop. C. C. 41. See also *Morgan v. Seaward*, (1837) 1 W. P. C. 167; *Muntz v. Vivian*, (1840) 2 W. P. C. 87.

^(o) *Pneumatic Tyre Co. v. Warri-
low*, (1896) 13 R. P. C. 284.

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locutory
Injunction.

Ex parte appli-
cation for an
interlocutory
injunction.

Usual course
on *ex parte*
applications.

Validity of the
patent is an
important
question
on motion for
interlocutory
injunction.

and keep an account, most probably the injunction will not be granted and the motion will be dismissed with costs on the ground that it ought not to have been made at all. (*p*)

The rule laid down by Lord *Eldon*, L.C., in *Hill v. Thompson*, (*q*) is 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.

It is submitted that in the case of a plaintiff having a derivative title the above rule will be satisfied if he swears that in his belief the original patentee was the first and true inventor.

Not only must a patentee applying for an *ex parte* injunction comply with the above-mentioned rule, but he must in all other respects 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. (*r*)

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. (*s*)

The question of the validity of the patent, though not decided on an interlocutory application, is, and ought to be, an important consideration with the Court when determining whether or not to grant an interim injunction. (*t*)

(*p*) *Pneumatic Tyre Co. v. Goodman*, (1896) 13 R. P. C. 723.

(*q*) *Hill v. Thompson*, (1817) 1 W. P. C. 231; see also *Sturtz v. De la Rue*, (1828) 5 Russ. 322, 329; *Gardner v. Broadbent*, (1856) 2 Jur. N. S. 1041; *Whitton v. Jennings*, (1860) 1 Dr. & Sm. 110; *Mayer v. Spence*, (1860) 1 J. & H. 87.

(*r*) *Dalglish v. Jarvie*, (1850) 2 Mac. & G. 231; *Curtis v. Cutts*, (1839) 3 Jur. 34.

(*s*) *Daniell's Chancery Practice*, 6th ed. p. 1611; *Moser v. Jones*, (1893) 10 R. P. C. 368.

(*t*) *Jackson v. Needle*, (1884) 1 R. P. C. 174, 177.

The rule was laid down and acted upon previously to the Act of 1883, that an interim injunction will be refused where the patent is recent and its validity has not been established,^(u) and this rule is still acted upon notwithstanding the investigation and protection afforded to the public by ss. 10 and 11 of the Act of 1883.^(x)

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Where the patent is recent and has not been questioned an injunction is refused.

An important factor is the strength of the presumption in favour of the validity of the patent. A presumption in favour of the validity of the patent may arise from long enjoyment, a prior action resulting in a declaration of validity, or other circumstances. Where there has been long enjoyment under a patent the presumption in favour of its validity is based on the consideration that it was in the power of anybody to have obtained the repeal of the patent by *scire facias* before 1884 and on petition for revocation since that date, yet no one has done so.^(y)

Presumption in favour of validity arises from long uninterrupted enjoyment.

Where it is established to the satisfaction of the Court that the plaintiff has been in long, active,^(z) and uninterrupted^(a) enjoyment of the patent, an interim injunction will be granted, notwithstanding that the validity of the patent may be doubtful; for if a party gets his patent and puts his invention in execution, and has proceeded to a sale, that may be called possession under it, however doubtful it may be whether the patent can be sustained; and possession under colour of title is ground enough to enjoin and to continue the injunction till it is proved that it is only colour and not real title;^(b) provided that the enjoyment has been sufficiently long, and the patent is not on the face of it so irretrievably and hopelessly bad that it is clear it cannot be supported.^(c)

Thus, where a patentee had been in possession of his exclusive privilege for several years, and a defect in the specification was suggested, the Court refused to allow the privilege to be disturbed until the question of title had been decided;^(d) and

^(u) *Jackson v. Needle*, (1884) 1 R. P. C. 174, 177; *Lister v. Norton*, (1884) 1 R. P. C. 114; *Caldwall v. Van Vlis-sengen*, (1851) 9 Hare 424.

^(x) *Farbenfabriken vorm F. Bayer v. Bowker*, (1891) 8 R. P. C. 397, 399; *Jackson v. Needle*, (1884) 1 R. P. C. 177.

^(y) *Davenport v. Jepson*, (1862) 4 De G. F. & J. 440; *Caldwell v. Van Vlis-sengen*, (1851) Hare 415, 424; *Electric Telegraph Co. v. Nott*, (1847) 2 Coop. Ch. Cas. 41; 46 & 47 Vict. c. 57, s. 26.

^(z) See above.

^(a) *Ibid.*

^(b) See judgment of Eldon, L.C., *Universities of Oxford and Cambridge v. Richardson*, (1806) 6 Ves. 706; *Dudgeon v. Thomson*, (1877) 30 L. T. N. S. 244; *Betts v. Menzies*, (1857) 3 Jur. N. S. 357, 358; *Gardner v. Broadbent*, (1856) 2 Jur. N. S. 1041.

^(c) p. 546 *post*; *Briggs v. Lardeur*, (1884) 1 R. P. C. 126; *Shillito v. Lar-muth*, (1884) 2 R. P. C. 1.

^(d) *Muntz v. Foster*, (1843) 2 W. P. C. 93, 95.

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an injunction has been granted in the face of a prior specification, which seemed to be fatal.(e)

It is not necessary for the plaintiff, on motion for an interim injunction, to state that the patent has never been disputed, nor is the mere assertion that the patent is invalid sufficient to determine the Court to withhold the injunction.(f)

The Court will, in the words of *Jessel*, M.R., "grant an injunction before the hearing, where the patent is an old one, and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the Court to say that, as against himself, there is no reason to doubt the validity of the patent."(g)

If the plaintiff relies on long enjoyment as entitling him to a presumption in favour of the validity of his patent on an application for an interim injunction, it is incumbent on him to show that he has actually used the invention. Thus, an injunction was refused where the plaintiff was only able to produce evidence of actual user at a recent period, notwithstanding that the patent was ten years old.(h)

It is also incumbent on the plaintiff to show that his enjoyment of the monopoly has been an uninterrupted one;(i) and it has been held that where the invention is of such a nature that it cannot be exercised without the licence of a prior patentee, the plaintiff's undisturbed enjoyment only commences from the expiration of the prior patent, and where this amounts to only one year the injunction must be refused.(k)

Length of un-
interrupted
active enjoy-
ment sufficient
to raise a pre-
sumption in
favour of
validity.

In regard to the length of uninterrupted and active enjoyment of the monopoly claimed under a patent which will establish a monopoly in favour of the validity of the patent, and also entitle a plaintiff to an interim injunction,

(e) *Losh v. Hague*, (1837) 1 W. P. C. 201.

(f) *Read v. Andrew*, (1885) 2 R.P.C. 119, 122.

(g) *Dudgeon v. Thomson*, (1877) 30 L. T. N. S. 244; S. C. 23 W. R. 464; see also *Hill v. Thompson*, (1817) 3 Mer. 622; S. C. 1 W. P. C. 229, 231; *Universities of Oxford and Cambridge v. Richardson*, (1806) 6 Ves. 689, 707; *Stevens v. Keating*, (1847) 2 W. P. C. 177; *Hamar v. Plane*, (1809) 14 Ves. 130; *Bickford v. Skewes*, (1837) 1 W. P. C. 211, 213; *Electric Telegraph Co.*

v. Nott, (1847) 2 Coop. Ch. Cas. 41; *Wilson v. Tindal*, (1841) 1 W. P. C. 730; *Renard v. Levinstein*, (1864) 10 L. T. N. S. 94; *Davenport v. Jepson*, (1862) 4 De G. F. & J. 440.

(h) *Plimpton v. Malcolmson*, (1875) L. R. 20 Eq. 38.

(i) *Collard v. Allison*, (1839) 4 My. & Cr. 487; *Curtis v. Cutts*, (1839) 8 L. J. N. S. Ch. 184; 2 Coop. C. C. 60; *Hill v. Thompson*, (1817) 3 Mer. 622.

(k) *Hugh v. Magill*, (1877) W. N. 62.

thirteen, (l) twelve, (m) eleven, (n) ten, (o) nine, (p) eight, (q) seven, (r) and six (s) years have, on different occasions, been held to be sufficient.

Three years were held sufficient under circumstances from which it appeared that, previously to the grant of the patent, many inventors had been endeavouring to obtain the result achieved by the patentee, who had since the grant sold, at considerable profits, numerous articles manufactured according to the invention without his monopoly being previously questioned; (t) though where the plaintiff's patent was three years old, but the works enabling him to carry on operations under it were not completed till one year before Bill filed, the injunction was refused. (u)

Where a patent was only two years old at the commencement of an action an interim injunction was obtained, but afterwards it was dissolved by the Lords Justices on appeal, *Knight Bruce*, L.J., saying, in reference to the recent date of the letters patent: "There cannot have been any considerable length of enjoyment under them, and the defendant, in such a case, at least is entitled, I apprehend, to the benefit of any reasonable doubt and reasonable difficulty which he can show to exist as to the sufficiency and validity of the specification." (x) And in a more recent case two years' uninterrupted enjoyment was held insufficient to warrant the granting of an interlocutory injunction. (y)

Again, where a patent was a recent one and the only question as to its validity was one founded on an objection to the sufficiency of the specification, and it was proved that a competent workman, with no other assistance than the specification, could work the invention, an interlocutory injunction was refused. (z)

Where the validity of the patent has been established on A patent which

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(l) *Hamar v. Plane*, (1809) 14 Ves. 130; *Read v. Andrew*, (1885) 2 R. P. C. 119; *Stevens v. Keating*, (1847) 2 W. P. C. 176.

(m) *Neilson v. Thompson*, (1841) 1 W. P. C. 279.

(n) *Wilson v. Tindal*, (1841) 1 W. P. C. 730.

(o) *Shillito v. Larmuth*, (1884) 1 R. P. C. 1.

(p) *Davenport v. Richard*, (1865) 3 L. T. N. S. 503; *Howes v. Webber*, (1894) 11 R. P. C. 586.

(q) *Betts v. Menzies*, (1857) 3 Jur. N. S. 357; L. R. 3 Eq. 312.

(r) *Stevens v. Keating*, (1847) 2 W. P. C. 176; *Osmond v. Hirst*, (1885) 2 R. P. C. 265.

(s) *Rothwell v. King*, (1886) 3 R. P. C. 379; *Bickford v. Skewes*, (1837) 1 W. P. C. 211, 213; *Renard v. Levinstein*, (1864) 10 L. T. N. S. 94.

(t) *Wheatstone v. Wilde*, (1861) Griff. P. C. 247.

(u) *Hill v. Thompson*, (1817) 1 W. P. C. 232; 3 Mer. 622; see also *Plimpton v. Malcolmson*, (1875) L. R. 20 Eq. 37.

(x) *Renard v. Levinstein*, (1864) 10 L. T. N. S. 177.

(y) *British Tanning Co. v. Groth*, (1889) 7 R. P. C. 1.

(z) *Coles v. Baylis*, (1886) 3 R. P. C. 178.

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has been established is regarded as valid in an interlocutory application.

previous occasions, though it is open to the defendant at the trial to dispute it, the Court will, on an interlocutory application, regard its validity as sufficiently established by the previous proceedings to warrant the grant of an interim injunction, (a) if the infringement is clear, (b) or there is a *prima facie* case of infringement, (c) and this notwithstanding that the defendant disputes the validity of the patent on a ground not raised in any of the previous proceedings. (d)

Where the plaintiff has established the validity of the patent but there is an appeal pending to the Court of Appeal or House of Lords, the Court considers the validity as established on the hearing of a subsequent motion for an interlocutory injunction; and the injunction may be obtained notwithstanding that the defendant offers to pay royalties pending the appeal. (e)

If it could be established to the satisfaction of the Court that the judgment in favour of the patent in a prior action was wrongly obtained, this fact would no doubt induce the Court to depart from the usual course of treating the question of validity as established; (f) though it has been held that a certificate of validity given in a prior action in which judgment was obtained by default or consent is ground for treating the validity as established on subsequent motion for interlocutory injunction. (g)

The fact that a plaintiff has succeeded in obtaining an interdict of a Scotch Court restraining a prior infringement in Scotland is sufficient *prima facie* evidence of the validity of the patent to justify the grant of an interim injunction against a subsequent infringement in England. (h)

Where a patent had been the subject of an arbitration at the request of parties to a former action, and the arbitrator had given his award in favour of its validity, the Court, in a subsequent action of infringement against the same defendant, considered the patent sufficiently established by the arbitrator's award, and granted an interlocutory injunction. (i)

(a) *Dudgeon v. Thomson*, (1877) 30 L. T. N. S. 244; *Davenport v. Jepson*, (1862) 4 De G. F. & J. 440; *Davenport v. Goldberg*, (1865) 2 H. & M. 282; *Newall v. Wilson*, (1852) 2 De G. M. & G. 282; *Bovill v. Smith*, (1867) W.N. p. 240; *Bovill v. Goodier*, (1866) L. R. 2 Eq. 200.

(b) *Hayward v. The Pavement Light Co.*, (1884) 1 R. P. C. 207.

(c) *Thorn v. Worthing Skating Rink Co.*, (1876) L. R. 6 Ch. D. 415 n.

(d) *Newall v. Wilson*, (1852) 2 De G. M. & G. 282; 19 L. T. 161.

(e) *Moser v. Sewell*, (1893) 10 R. P. C. 365; *Moser v. Jones*, (1893) 10 R. P. C. 368.

(f) *Pneumatic Tyre Co. v. Marwood*, (1896) 13 R. P. C. 347.

(g) *Edison-Bell Phonograph Corporation v. Bernstein*, (1897) 14 R. P. C. 153.

(h) *Dudgeon v. Thomson*, (1877) 30 L. T. N. S. 244; *Stevens v. Keating*, (1847) 19 L. J. N. S. Ex. 57; 2 W. P. C. 176, 177.

(i) *Lister v. Eastwood*, 26 L. T. 4.

An interim injunction may be granted in a subsequent action, where it is shown by the plaintiff that he has established his patent on a former occasion, though against a different defendant; but the subsequent defendant will at the trial be in no way bound by the previous decision, and may contest the patent anew on the same or different evidence, and he cannot be compelled to do so by presenting a petition for its revocation.^(k) It is submitted that in such a case the Court will consider itself bound as to the interpretation of the specification by the construction put upon it by a Court of equal or superior jurisdiction.^(l)

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An interlocutory injunction is granted when the Court is satisfied that what the defendant has done, or threatens to do, is a mere invasion of the plaintiff's right,^(m) or where the infringement is clear and the patent has been established in former proceedings and there is no *laches*.⁽ⁿ⁾ Also when the sole question between the parties is the validity of the patent,^(o) and there is a strong presumption or case in its favour;^(p) but it is usually refused if there is a real doubt as to the infringement.^(q) Thus, where there was only evidence of possession and not of user, and the defendant had before action offered to give an undertaking not to use during the continuance of the patent, the injunction was refused, and the defendant undertaking not to use till the trial of the action or further order, the motion was dismissed with costs.^(r)

Interlocutory injunctions are usually refused where there is a real doubt as to infringement.

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.^(s) Thus, if there is a *bona fide* doubt as to infringement and the trade of the defendants is a new one likely to lead to the sale of a large number of

Degree of the doubt as to infringement is an important factor.

^(k) *Bovill v. Goodier* (2), (1866) L. R. 2 Eq. 195; *Russell v. Barnsley*, (1834) 1 W. P. C. 472; 2 Coop. Ch. Cas. 58; but see *Davenport v. Goldberg*, (1865) 2 H. & M. 286.

^(l) *Edison v. Holland*, (1889) 6 R. P. C. 243, 249, 276; *Slazenger v. Feltham*, (1889) 6 R. P. C. 130; p. 579 *post*.

^(m) *Thorn v. Worthing Skating Rink Co.*, (1876) L. R. 6 Ch. D. 415 n.

⁽ⁿ⁾ *Pneumatic Tyre Co. v. Warrilow*, (1896) 13 R. P. C. 288.

^(o) *Neilson v. Thompson*, (1841) 1 W. P. C. 277; *Stevens v. Keating*, (1847) 2 W. P. C. 179; *Electric Tele-*

graph Co. v. Nott, (1847) 11 Jur. 157.

^(p) p. 544 *ante*.

^(q) *Neilson v. Thompson*, (1841) 1 W. P. C. 277; *Stevens v. Keating*, (1847) 2 W. P. C. 179; *Electric Telegraph Co. v. Nott*, (1847) 11 Jur. 157; *Wood v. Cockerill*, (1889) 2 Coop. C. C. 58; *Plimpton v. Malcolmson*, (1875) L. R. 20 Eq. 38.

^(r) *Lyon v. Mayor and Corporation of Newcastle-upon-Tyne*, (1894) 11 R. P. C. 218.

^(s) *Bridson v. McAlpine*, (1846) 8 Beav. 230; *Thompson v. Hughes*, (1890) 7 R. P. C. 71.

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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; (t) and where there is evidence of long enjoyment, and consequently *prima facie* evidence of title which ought to be respected, (u) the Court will not consider the injury to the defendant, but will protect the plaintiff from the possible consequences of the market being flooded with articles manufactured in infringement of his patent, supposing him to be able to sustain it. (v) If it appears that an interim injunction would seriously prejudice the defendant, and not benefit the plaintiff, it will be refused. (y)

To obtain an injunction on an interlocutory application it is sufficient to show one clear instance of infringement, (z) or to make out a *prima facie* case; (a) and the Court of Appeal is slow to interfere with the discretion of a Judge of First Instance who is satisfied as to the existence of a *prima facie* case. (b)

Affidavits
made from
information
and belief.

Affidavits made from information and belief should show the source of such information and belief, otherwise they will not have much weight with the Court, and will not be of much material help to the plaintiff in making out the necessary *prima facie* case of infringement. (c)

Interlocutory
injunctions are
granted where
infringement
is established
and there is a
presumption
in favour of
validity.

Where the infringement is made out, and there is a presumption in favour of the validity of the patent arising, *e.g.*, from long previous enjoyment, or from the circumstance of the patent having been supported in previous litigation, (d) or if the defendant is estopped from denying the validity of the patent (e) an interim injunction will be granted. Where the defendant admitted that he had exhibited machines which to some extent were or had been infringements of the plaintiff's patent, the

(t) *Plimpton v. Spiller*, (1877) L. R. 4 Ch. D. 286, 292; but see *North British Rubber Co. v. Gormully and Jeffery Manufacturing Co.*, (1894) 12 R. P. C. 17, where the defendant pleaded laches *plus* growth of his trade.

(u) *Stevens v. Keating*, (1847) 2 W. P. C. 177; p. 545 *ante*.

(v) *Davenport v. Jepson*, (1862) 4 De G. F. & J. 448; *Hamar v. Plane*, (1809) 14 Ves. 130; *Stevens v. Keating*, (1847) 2 W. P. C. 177.

(y) *Neilson v. Thompson*, (1868) 1 W. P. C. 275, 286; *Morgan v. Seaward*, (1837) 1 W. P. C. 167; *Thomson v. Hughes*, (1890) 7 R. P. C. 71.

(z) *United Telephone Co. v. Sharples*, (1885) L. R. 29 Ch. D. 164, 169.

(a) *Briggs v. Lardeur*, (1884) 1 R. P. C. 128; *Shillito v. Larmuth*, (1885) 2 R. P. C. 1, 3; *Anderson v. Patent Oxonite Co., Ltd.*, (1886) 3 R. P. C. 279.

(b) *Baker v. White*, (1884) 1 Times R. 64.

(c) *Saccharin Corporation v. The Chemical Dye and Drugs Co.*, (1898) 15 R. P. C. 53.

(d) *Dudgeon v. Thomson*, (1877) 30 L. T. N. S. 244; *Bovill v. Goodier*, (1865) 35 L. J. Ch. 174; 35 Beav. 427; *Bovill v. Smith*, (1867) W. N. 240; *Davenport v. Goldberg*, (1865) 2 H. & M. 282; *Davenport v. Jepson*, (1862) 4 De G. F. & J. 448; *Newall v. Wilson*, (1852) 2 De G. M. & G. 282.

(e) p. 522 *ante*.

Court granted an injunction in general terms, but left open the question as to the particular machines. (*f*)

Although the Court has the power to grant an interlocutory injunction *simpliciter*, (*g*) it is the invariable practice not to do so, but to bind the plaintiff in an undertaking to indemnify the defendant, if it should ultimately turn out that the patent is bad and that the injunction ought, therefore, not to have been granted; (*h*) and the undertaking is equally required where the patent has been established on former occasions, as where there has been no previous contest. (*i*)

Unexplained and unreasonable delay in making an application to enforce the undertaking to be answerable in damages induces the Court to refuse the application; (*k*) but the undertaking is not put an end to by the discontinuance, (*l*) or dismissal, (*m*) of the action.

The undertaking can be enforced when the injunction has been wrongly granted owing to a mistake of law by the Judge; (*n*) and it may be entered into by, (*o*) and enforced against, a married woman. (*p*)

Inability on the part of the defendant to satisfy the plaintiff's claim for damages in the event of defeat is a consideration which induces the Court to grant an interlocutory injunction. (*q*) And if the defendant does not appear the injunction may be granted on affidavit as to validity, on the ground that the defendant not appearing the plaintiff may not be able to get an account. (*r*)

Where there is an independent case, on any ground, against an interlocutory injunction being granted, the Court considers

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Indemnity on behalf of the defendant is required from the plaintiff when an interlocutory injunction is granted.

Inability on the part of the defendant to satisfy the plaintiff's claim.

The motion is usually ordered

(*f*) *Edison-Bell Phonograph Corporation v. London Phonograph Co.*, (1894) 11 R. P. C. 193.

(*g*) *Bacon v. Jones*, (1839) 4 M. & C. 436; *Wilson v. Tindal*, (1841) 1 W. P. C. 730; *Bickford v. Skewes*, (1837) 1 W. P. C. 214; *Tuck v. Silver, John*. 218.

(*h*) *Chappell v. Davidson*, (1856) 8 D. M. & G. 1; *Tuck v. Silver, John*. 218; *Wakefield v. Duke of Buccleuch*, (1865) 11 Jur. N. S. 523; *Graham v. Campbell*, (1877) L. R. 7 Ch. D. 490; *Muntz v. Grenfell*, (1842) 2 W. P. C. 91; 2 Coop. Ch. Cas. 59; *Moser v. Sewell*, (1893) 10 R. P. C. 366; *Moser v. Jones*, (1893) 10 R. P. C. 368.

(*i*) *United Telephone Co. v. Taskar*, (1888) 5 R. P. C. 628, 633; *Bovill v. Smith*, (1867) W. N. 240.

(*k*) *Ex parte Hall*, (1883) L. R. 23 Ch. D. 644.

(*l*) *Newcomen v. Coulson*, (1877) L. R. 7 Ch. D. 764.

(*m*) *Newby v. Harrison*, (1861) 3 De G. F. & J. 287; *Graham v. Campbell*, (1877) L. R. 7 Ch. D. 490.

(*n*) *Griffith v. Blake*, (1884) L. R. 27 Ch. D. 474; *Rothwell v. King*, (1887) 4 R. P. C. 76.

(*o*) *Re Prynne*, (1885) W. N., p. 144.

(*p*) *Hunt v. Hunt*, (1884) 54 L. J. Ch. 289.

(*q*) *Kensington and Knightsbridge Electric Lighting Co. v. Lane Fox Electrical Co.*, (1891) 8 R. P. C. 277; *Plimpton v. Spiller*, (1876) L. R. 4 Ch. D. 291; *Newall v. Wilson*, (1852) 2 G. M. G. 282.

(*r*) *Clarke v. Nichols*, (1895) 12 R. P. C. 310.

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locutory
Injunction.

to stand over
till the trial if
there is an
independent
case against
an interlocu-
tory injunction
being granted.

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.^(s)

And in some circumstances—*e.g.*, where the patentee has agreed with the defendant not to oppose any company formed for the purpose of purchasing his invention—the Court will order the motion to stand to the trial notwithstanding that the defendant refuses to give an undertaking to keep an account.^(t)

When an inter-
locutory in-
junction is
refused the
defendant is
usually ordered
to keep an
account.

When an interim injunction is refused, either on the ground that the infringement is doubtful, or on the ground of delay,^(u) the usual course is to order the defendant to keep an account.^(x)

This order for an account may be made in different forms, as the circumstances of the case may require.^(y)

In *Neilson v. Thompson*, the account was for the past as well as from the commencement of the infringement.^(z) But in *Vidi v. Smith* ^(a) the Court held that a retrospective account should not be granted till final judgment. This is the most general form in which the order is made; ^(b) though in *Plimpton v. Malcolmson*,^(c) and *Russell v. Cowly*,^(d) the account was of "all moneys received or to be received" by the sale of the patented articles, and in *Beardsell v. Schwann* ^(e) the account was of the articles only.^(f) In *Pneumatic Tyre Co. v. Friswell* ^(g) the defendant refusing to keep an account for fear of admitting the validity of the patent, the order was prefaced with the words "the defendant not admitting the validity, but on the other hand contending that the patent is invalid."

^(s) Per Chitty, J., *Lister v. Norton*, (1884) 1 R. P. C. 116.

^(t) *British Tanning Co. v. Groth*, (1889) 7 R. P. C. 1.

^(u) *Bovill v. Crate*, (1865) L. R. 1 Eq. 388; *Neilson v. Thompson*, (1841) 1 W. P. C. 286; *Lister v. Norton*, (1884) 1 R. P. C. 114.

^(x) *Ibid.*; *Bacon v. Jones*, (1839) 4 My. & Cr. 436; *Jackson v. Needle*, (1884) 1 R. P. C. 176; *Hill v. Thompson*, (1817) 1 W. P. C. 232; 3 Mer. 662; *Morgan v. Seaward*, (1837) 1 W. P. C. 169.

^(y) For common form of order see Seton, 4th ed. p. 344.

^(z) 1 W. P. C. 286.

^(a) 3 E. & B. 969.

^(b) *Plimpton v. Spiller*, (1877) L. R. 4 Ch. D. 286.

^(c) Seton, 4th ed. p. 344.

^(d) 1 W. P. C. 458.

^(e) Seton, 3rd ed. p. 910.

^(f) *Hill v. Thompson*, (1817) 3 Mer. 626; *Jackson v. Needle*, (1884) 1 R. P. C. 176.

^(g) (1895) 13 R. P. C. 15.

An interim injunction is not often granted when the defendant voluntarily offers to keep an account and the Court is satisfied that he will be sufficiently able to satisfy any claim the plaintiff may ultimately succeed in establishing against him.^(h) Discovery.

If the plaintiff does not prosecute the action with due diligence after obtaining an interim injunction, the defendant may apply to have the injunction dissolved.⁽ⁱ⁾ Action not prosecuted with due diligence.

In the event of the defendant paying money into Court and the plaintiff being successful in the action the proper course is for the Court to order the money to remain in Court to abide the result of the inquiry as to damages, or the taking of the amount and to be paid out to the plaintiff, or so much thereof as the plaintiff shall show he is entitled to.^(k) Order as to payment of money out of Court.

DISCOVERY AND INSPECTION.

Discovery.—Notwithstanding that in patent actions particulars must be delivered by both the plaintiff and the defendant,^(l) either party may, by leave of the Court or a Judge, deliver interrogatories in writing for the examination of the opposite parties, or any one or more of such parties, provided that interrogatories which do not relate to any matters in question in the action shall be deemed irrelevant, notwithstanding that they might be admissible on the oral cross-examination of a witness.^(m) Interrogatories

Interrogatories must be limited to facts, and an interrogating party is entitled only to such answers as will enable him to establish his case, and he is not entitled to administer interrogatories which inquire into the opposite parties' evidence,⁽ⁿ⁾ nor is he entitled to answers to irrelevant questions^(o)—*e.g.*, as to certain unsuccessful proceedings abroad for the infringement of a foreign patent in the possession of the must be limited to facts enabling the interrogating party to prove his case.

^(h) *Gardner v. Broadbent*, (1856) 2 Jur. N. S. 1041; *Copeland v. Webb*, (1862) 11 W. R. 134; *Jackson v. Needle*, (1884) 1 R. P. C. 174; *Lister v. Norton*, (1884) 1 R. P. C. 114.

⁽ⁱ⁾ *Stevens v. Keating*, (1847) 2 W. P. C. 175.

^(k) *North British Rubber Co. v. Gormully and Jeffery Manufacturing Co.*, (1894) 12 R. P. C. 17.

^(l) 46 & 47 Vict. c. 57, s. 29.

^(m) R. S. C. 1883, Ord. xxxi. r. 1; *Birch v. Mather*, (1883) L. R. 22 Ch.

D. 629; *Haddan's Patent*, (1884) 54 L. J. N. S. Ch. 126; *Finnigan v. James*, (1874) L. R. 19 Eq. 72; *Crossby v. Tomey*, (1875) L. R. 2 Ch. D. 533; *Saunders v. Jones*, (1877), L. R. 7 Ch. D. 449.

⁽ⁿ⁾ *Delta Metal Co. v. Maxim-Nordenfelt Guns and Ammunition Co.*, (1891) 8 R. P. C. 169.

^(o) *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 37; *Hoffmann v. Postill*, (1869) L. R. 4 Ch. App. Cas. 673; R. S. C. 1883, Ord. xxxi. r. 6.

Discovery. plaintiff;(p) but in one case the plaintiff was ordered to answer as to the terms of a compromise in another action as being material.(q) Consequently, if the particulars of breaches are sufficient, the plaintiff will not be compelled to answer further questions as to the alleged infringements.(r)

Thus the owner of letters patent for mechanical musical instruments brought an action for alleged infringement against the defendants, and delivered particulars of breaches, in which he complained generally of the infringement of the first claiming clause of the specification, and "in particular and by way of illustration" of a specific article held by the defendants. The defendants delivered particulars of objections which alleged (*inter alia*) that the alleged invention was not the subject of a patent, but the new application of old machinery to an analogous purpose; that, as disclosed by the specification, it did not make any useful addition to the existing stock of public knowledge; and that the specification did not sufficiently distinguish the new from the old. The defendants also delivered interrogatories which in effect asked the plaintiff to admit the truth of the above-mentioned objections, or to state how he made them out not to be true. The plaintiff having declined to answer these interrogatories, the defendant took out a summons to compel him to do so. The summons was adjourned into Court, and the plaintiff, then consenting to answer the interrogatories as to subject-matter, and to amend the particulars of breaches by omitting the words "by way of illustration," it was held that no further answer should be ordered.(s)

The Court will not compel a party to discover facts beyond what is necessary to enable his opponent to prove his case.(t) Thus, where the only plea raised by the defence was that the plaintiff was not the true and first inventor, the defendant was allowed to refuse to answer interrogatories as to the accuracy of the specification, the novelty of the process, and the fact of the infringement.(u)

Fishing interrogatories are not allowed.

Fishing interrogatories, which merely help one party to get at the other's evidence and see what he can make of it, are not allowed: *e.g.*, a plaintiff is not allowed to ask a defendant to

(p) *Hoffmann v. Postill*, (1869) L. R. 4 Ch. App. Cas. 673, 679.

(q) *Betts v. Neilson*, W. N. 1866, p. 170.

(r) *Hoffmann v. Postill*, (1869) L. R. 4 Ch. App. Cas. 673, 679.

(s) *Ehrlich v. Ihlee*, (1887) 5 R. P. C. 37.

(t) *Bidder v. Bridges*, (1885) L. R. 29 Ch. D. 29, 34.

(u) *Young v. White*, (1853) 17 Beav. 532.

state the names of the persons to whom he alleges he sold articles similar to the plaintiff's before the date of the patent; (x) though he may be required to state whether alleged anticipating machines mentioned in his objections are in existence, and the names and addresses of alleged prior users. (y)

Discovery.

It has been stated that interrogatories for the examination of a plaintiff are on a different footing from those for the examination of a defendant in this respect, that a plaintiff is not entitled to discovery of the defendant's case, but a defendant may ask any questions tending to destroy the plaintiff's claim. (z) This statement must, however, be taken as having been made in the first instance in reference to a particular case, and must not be taken as establishing the proposition that the defendant has a larger right of discovery than a plaintiff. No such proposition can be upheld in the face of the authorities which, on the contrary, establish that the rights of both plaintiff and defendant are equal in respect of discovery, *i.e.*, either party is entitled to a discovery of such material facts from the other as will enable him to make out *his case*, and not to a discovery of facts which relate exclusively to the manner in which the case of the other party is to be established, or to the evidence which relates exclusively to that case. (a)

Plaintiff and defendant have an equal right to discovery.

Where discovery is a matter of indifference to the party against whom it is sought, the Court does not weigh carefully the question of materiality or immateriality; still, where the nature of the discovery required is such that the giving of it may be prejudicial to such party, the Court takes into consideration the special circumstances of the case; on the one hand it takes care that the party desiring discovery obtains all which can be of use to him, on the other it protects the opposite party against undue inquisition into his affairs. (b)

Discovery which is a matter of indifference to the party against whom it is sought,

And when a defendant's answer to an interrogatory cannot help the plaintiff to obtain a decree, but will only be of use to

or cannot help the interrogating party.

(x) *Daw v. Eley*, (1865) 2 H. & M. 725.

(y) *Birch v. Mather*, (1883) L. R. 22 Ch. D. 629.

(z) *Hoffmann v. Postill*, (1869) L. R. 4 Ch. App. 673; *Lowndes v. Davies*, (1834) 6 Sim. 468; *Commissioners of Sewers v. Glasse*, (1873) L. R. 15 Eq. 302.

(a) *Bray on Discovery*, pp. 467 and 468; *Bovill v. Smith*, (1866) L. R. 2 Eq. 459; *Daw v. Eley*, (1865) 2 H. &

M. 725; *Bidder v. Bridges*, (1885) L. R. 29 Ch. D. 34, judgment of Kay, J.

(b) *Moore v. Craven*, (1874) L. R. 7 Ch. App. 94, 96; *Simpson v. Charlesworth*, (1866) W. N. p. 255; *Daw v. Eley*, (1865) 2 H. & M. 725; *Rolls v. Isaacs*, (1878) W. N. 37; *Crossley v. Stewart*, (1863) 1 N. R. 426; S. C. 7 L. T. N. S. 848; *Craver v. Pinto Leite*, (1871) 7 Ch. App. 90, 97; *Orr v. Diaper*, (1876) L. R. 4 Ch. D. 92.

Discovery. him if he obtains a decree, the Court has a discretion whether to oblige the defendant to answer before trial, and will not do so when compelling such discovery would be oppressive.^(c) Thus, if the defendant denies infringement, but admits the possession of the infringing articles, he will not be compelled to answer interrogatories which seek an account of all such articles in his possession, as well as discovery as to the purchase or hire of them, and an account of sales and profits.^(d)

Where a party interrogates as to facts tending to enable him to prove a particular issue, the party giving discovery will not be excused from answering fully on the ground that such answers cannot be of use to the party seeking it, if he fails to prove some other issue.^(e)

The limitation as to answering interrogatories applies only to those relating to matters which depend on the part (or it may be the whole) of the case which will become immaterial if the case be not established, or are of such a nature that the party seeking the discovery is not entitled to it till his case is established by the judgment of the Court^(f)—*e.g.*, where infringement is admitted and discovery is sought of the sales and profits made by trafficking in the infringing articles.^(g) It does not protect a defendant who denies the plaintiff's title *in toto*, or alleges that the patent is invalid, from answering fully all interrogatories which are material.^(h)

Rule that "he who answers at all must answer fully."

Subject to the above limitations, the old fixed and rigid rule that "he who answers at all must answer fully," guides the Court in deciding whether any particular answers given are sufficient, or whether any particular interrogatories are allowable or not.⁽ⁱ⁾

Cost of interrogatories must be secured.

In the event of the Court or a Judge granting leave to any party to administer interrogatories to any other party or parties the costs must in the first instance be secured by the party seeking such discovery in the manner prescribed by the Supreme Court Rules, 1883.^(k)

^(c) Parker *v.* Wells, (1880) L. R. 18 Ch. D. 477; Swabey *v.* Sutton, (1863) 1 H. & M. 514; Fennessy *v.* Clark, (1888) L. R. 37 Ch. D. 184; Lister *v.* Norton, (1885) 2 R. P. C. 68; Bray on Discovery, p. 553.

^(d) De la Rue *v.* Dickinson, (1857) 3 K. & J. 388; Rolls *v.* Isaacs, (1878) W. N. p. 37; Fennessy *v.* Clark, (1888) L. R. 37 Ch. D. 184.

^(e) Foxwell *v.* Webster, (1863) 2 Drew and Sm. 250.

^(f) De La Rue *v.* Dickinson, (1857)

3 K. & J. 391; Parker *v.* Wells, (1880) L. R. 18 Ch. D. 477; Lister *v.* Norton, (1885) 2 R. P. C. 68.

^(g) *Ibid.*

^(h) Swinborne *v.* Nelson, (1852) 16 Beav. 416; Foxwell *v.* Webster, (1863) 3 N. R. 103; 9 Jur. N. S. 1189.

⁽ⁱ⁾ Swinborne *v.* Nelson, (1852) 16 Beav. 416; Elmer *v.* Creasy, (1873) L. R. 9 Ch. App. 69; Saull *v.* Browne, (1874) L. R. 9 Ch. App. 364; Lister *v.* Norton, (1885) 2 R. P. C. 68.

^(k) Ord. xxxi. rr. 25, 26, 27.

As in the case of inspection,^(l) so, when discovery is sought, if the party from whom it is sought objects to it or any part thereof, the Court or a Judge may, if satisfied that the right to the discovery sought depends on the determination of any issue or dispute in the cause, or that for any other reason it is desirable that any issue or question in dispute in the cause should be determined before deciding upon the right to the discovery, order that such issue or question be determined first, and reserve the question as to discovery.^(m)

Discovery.
Objection on the ground that the right to discovery depends on the prior decision of an issue.

The Court under this rule will not in the exercise of its unfettered discretion allow a defendant to postpone answering questions as to facts which go to establish infringement till after the issue of validity is determined.⁽ⁿ⁾

Thus, where the plaintiff framed interrogatories on statements contained in the specification of his patent and asked the defendant step by step if he ever used the processes therein described, and the defendant after answering some of the interrogatories refused to answer others on the ground that the discovery sought depended on the determination of the question at issue—viz., the validity of the patent—and that the matters inquired into were not material at that stage of the action and were a trade secret, the Court held the defendant had shown no sufficient reason for his refusal to answer and made an order for further and better answers.^(o)

As in the case of inspection^(p) so with regard to discovery, the fact that the particular discovery sought would lead to the disclosure of the trade secrets of the opposite party will not deter the Court from granting it, if it is necessary in the interests of justice to enable the applicant to establish his case.

Trade secrets and discovery.

In such cases the Court endeavours, where possible, to protect the party compelled to disclose trade secrets, and will not order discovery beyond what is necessary to prove the case of the party seeking it.

Thus, where a defendant denied having infringed a patent for “improvements in preparing colouring matters for dyeing and colouring,” although he was compelled to answer interrogatories as to whether he used certain ingredients mentioned in the specification, whether he added anything else, and whether the

(l) p. 564 *post*.

(m) R. S. C. 1883, Ord. xxxi. r. 20.

(n) Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson, (1893) 10 R. P. C. 136; Ashworth v. Roberts, (1890) L. R. 45 Ch. D. 623; 7 R. P. C.

451; Rawes v. Chance, (1890) 7 R. P. C. 275.

(o) Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson, (1893) 10 R. P. C. 136.

(p) p. 565 *post*.

Discovery. additions made any difference in the process, yet he was not obliged to disclose the nature and quantities of the additions.(q)

At the hearing of another case against the same defendant, evidence as to the defendant's secret process was taken *in camera*, and the Judge ordered the shorthand notes and all the printed copies thereof to be sealed up and impounded in Court until there should be an appeal, in which case the parties were to be at liberty to apply for the delivery out of Court of as many copies as they should want, or until, either by lapse of time or otherwise, it should be determined that there was to be no appeal, in which case any application might be made to the Court for the disposal of them as the parties should think fit.(r)

There is, however, no hardship on the defendant in requiring him to state whether he has done what the specification says is to be done. If he answer No, but he has done something slightly different which might possibly be construed as an infringement, but which is a trade secret, the Court has ample power to protect the undue disclosure of such secret.(s)

Communications between a patentee and his patent agent.

Communications between a patentee and his patent-agent relative to the preparation of the specification are not privileged, and he may be required to refer to them in answering interrogatories as documents in his possession. Thus, where the defendant interrogated the plaintiff as to documents in his possession relating to the preparation of the specification and the plaintiff refused to answer, stating as a reason for his refusal that the documents were confidential communications between himself and his solicitor (who was also his patent-agent) and counsel, the Court decided that the answer was insufficient, as not distinguishing communications between the plaintiff and his solicitor, and communications between him and his patent-agent, the former class of communications alone being privileged.(t)

And where an action was commenced in respect of the infringement of two patents for similar inventions, but discontinued as to one of such inventions, the plaintiff was nevertheless required to answer interrogatories as to communications relative to that patent between himself and his patent-agent, on the

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

(r) Badische Anilin und Soda Fabrik v. Levinstein, (1883) L. R. 24 Ch. D. 176.

(s) Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson, (1893) 10 R. P. C. 139.

(t) Mosley v. Victoria Rubber Co., (1886) 3 R. P. C. 351.

ground that such answer might be material to the validity of **Discovery**, the patent for the other cognate invention.^(u)

Neither a plaintiff ^(x) nor a defendant ^(y) can be compelled to put a construction on the specification in answer to interrogatories. Construction of documents.

When a defendant, in answer to an interrogatory asking whether or not he was making articles identical with those manufactured by the plaintiff under the patent, and requiring him to state in what respects his articles differed from the plaintiff's, stated that he had for many years before the date of the patent applied to the articles in question the same treatment as was described in the specification, and that he now made articles which, save so far as his own method or process, adopted before the patent, was similar to that described in the specification of the plaintiff's patent, differed from the articles there described, but that it was impossible, without ocular demonstration, to show in what they differed, he was held to have given a sufficient answer.^(z) When complete answer cannot be given without an ocular demonstration.

When a defendant alleges prior user generally in a certain district he may be compelled to give the names and addresses of the manufacturers and the places and dates of user.^(a) Names and addresses of alleged prior users.

Where infringement has been alleged, anything showing, or tending to show, the fact of infringement may be required to be set out in answer to interrogatories.^(b) Thus, where a plaintiff had been successful in actions against infringers and brought a subsequent action against another infringer, the defendant was compelled to answer whether the process used was the same as that used by one of the prior infringers;^(c) and where the defendants denied infringement they were compelled to state, in answer to interrogatories, where they first manufactured, and to whom by name they first sold any, and what quantity, of the articles alleged by the plaintiff to be infringements, and by what process they were manufactured.^(d) Disclosure of processes used by an alleged infringer.

^(u) *Mosley v. Victoria Rubber Co.*, (1886) 3 R. P. C. 351.

^(x) *Wenham Co. v. Champion Gas Co.* (1890) 8 R. P. C. 22.

^(y) *Delta Metal Co. v. Maxim-Nordenfelt Guns and Ammunition Co.*, (1891) 8 R. P. C. 169.

^(z) *Crossley v. Tomey*, (1876) L. R. 2 Ch. D. 533; see also *Smith v. G. W. Ry. Co.*, (1854) Macr. P. C. 227; 6 E. & B. 405.

^(a) *Alliance Pure White Lead Syndicate v. MacIvor's Patents*, (1891) 8 R. P. C. 321.

^(b) *De la Rue v. Dickinson*, (1857) 3 K. & J. 391; *Lister v. Norton*, (1885) 2 R. P. C. 68, 69; *Rennard v. Levinstein*, (1864) 10 L. T. N. S. 94; *Benno Jaffé und Darmstaedter Lanolin Fabrik v. Richardson*, (1893) 10 R. P. C. 136; *Ashworth v. Roberts*, (1890) L. R. 45 Ch. D. 623; 7 R. P. C. 451; *Raves v. Chance*, (1890) 7 R. P. C. 275.

^(c) *Bovill v. Smith*, (1866) L. R. 2 Eq. 459, 461.

^(d) *Swinborne v. Nelson*, (1853) 16 Beav. 416.

Discovery.

Names and
addresses
of defendant's
customers.

Where infringement is admitted, the plaintiff is entitled to an answer to interrogatories asking for the names and addresses of the persons to whom the defendant's machines have been sold ;(e) and where the defendant had, in answer to interrogatories, set forth the names and addresses of persons resident in England from whom he had received royalties for the use of machines which the plaintiff alleged were made in infringement of his patent, such defendant was ordered to give the names and addresses of persons resident abroad from whom royalties had been received by him in respect of machines made in England, on the ground that the answer might lead to the discovery of important facts relative to the infringement.(f)

A defendant will not be excused from giving the names and addresses of his customers on the ground that by so doing he may thereby expose them to actions for infringements.(g)

Production of
documents.

The same rules apply to the production of documents in patent cases as in other cases.

Where a defendant company sought to withhold from production certain letters which had passed between the officers of the company, and between them and other persons, together with reports relative to infringement and the validity of the plaintiff's claim, it was held that such documents were not privileged, and their production was ordered.(h)

Where it appeared that certain plaintiffs, before they became owners of the patent in respect of which they were suing, had, in various proceedings, either disputed, or made preparations for disputing, its validity, and the defendants applied for inspection of the documents relating to such proceedings, it was held that they were entitled to have inspection of all except such as the plaintiff should state on oath to come within such terms as counsel should agree on, *i.e.*, to have come into existence merely to be communicated to the solicitor for the purpose of litigation, actual or intended, and either as materials for briefs or for his advice or consideration.(i)

Documents not

Where it appears probable from a document produced by the

(e) Tetley v. Easton, (1856) 18 C. B. 643.

(f) Crossley v. Stewart, (1863) 1 N. R. 426; see also Davenport v. Rylands, (1865) L. R. 1 Eq. 302, 308; Leather Cloth Co. v. Hirschfield, (1866) L. R. 1 Eq. 299.

(g) Tetley v. Easton, (1856) 18 C. B. 643; How v. McKernan, (1862) 30 Beav. 547; Bovill v. Cowan, (1867) W. N. p. 115.

(h) Westinghouse v. Midland Ry. Co., (1883) 48 L. T. N. S. 98, 462.

(i) Haslam v. Hall, (1887) 5 R. P. C. 1; see also Southwark and Vauxhall Water Co. v. Quick, (1878) L. R. 3 Q. B. D. 315, 320; Anderson v. Bank of British Columbia, (1875) L. R. 2 Ch. D. 644.

plaintiff or defendant that he has in his possession relevant documents besides those which are scheduled to his original affidavit, the proper course is to apply for an order calling on him to make a further and better affidavit, and in particular to state whether he has not in his possession documents, which, from that which has been said by him on affidavit or from the documents he has produced, in all probability are in his possession.^(k) Thus, a plaintiff who in his affidavit of documents referred to certain affidavits made in a previous action against different defendants, but omitted to schedule them, was ordered to make a further and better affidavit with particular reference to the affidavits filed in the previous action.^(l)

Discovery
disclosed in
original
affidavit.

It is established that where an affidavit of documents has been made the opposite party cannot require a further affidavit to be made, if that affidavit is technically sufficient, unless he shows, either upon affidavit or from documents which are produced, or from the pleadings, or admissions in the pleadings of the party giving discovery, or from the very nature of the case (and as regards the nature of the case there must be very strong evidence to induce the Court to act), that there are, probably, in the possession of the party giving discovery documents other than those he has scheduled in his affidavit. There can be no cross-examination on an affidavit of documents which has been filed; but though the party requiring discovery cannot take any of those courses either as to cross-examination or without such evidence above referred to, on further affidavit he may, with the leave of the Court, interrogate the party who has made an affidavit as to documents with reference to certain specific documents which he has reason to suppose are in the possession of the party giving discovery, and which have not been disclosed.^(m)

Further
affidavit of
documents.

The Court may require an affidavit to the effect that the application is not for vexation, or for the purpose of delay, but that it is made honestly for the purpose of obtaining discovery; but it is doubtful whether an affidavit as to the existence and nature of documents supposed to be in the possession of the party giving discovery and not included in the schedule to his original affidavit of documents is admissible.⁽ⁿ⁾

^(k) Per Cotton, L.J., *Brown v. Sansom*, (1888) 5 R. P. C. 515; *Jones v. Monte Video Gas Co.*, (1880) L. R. 5 Q. B. D. 556.

^(l) *Brown v. Sansom*, (1888) 5 R. P. C. 510.

^(m) Judgment of Cotton, L.J., *Edison*

v. Holland, (1888) 5 R. P. C. 216; see also *Hall v. Truman*, (1885) L. R. 29 Ch. D. 307; *Rawes v. Chance*, (1890) 7 R. P. C. 275.

⁽ⁿ⁾ *Edison v. Holland*, (1888) 5 R. P. C. 216.

Inspection. After one party has made a sufficient affidavit of documents the other party to the action will not be allowed to administer to him a general roving interrogatory as to documents in his possession, the effect of which would be to compel him to make a further affidavit. There are cases in which, after a sufficient affidavit as to documents, the Court will allow a party to deliver an interrogatory as to some specific document or documents, but whether this shall be allowed is a matter within the discretion of the Judge in each particular case, and though this decision can be appealed from, the Court of Appeal will not readily reverse it.^(o)

Interrogatories as to documents not disclosed.

Limited order for discovery of documents.

If an application is made at chambers for the usual order for discovery of documents, and a limited order only is asked for and obtained, no further order can subsequently be made if the Judge has certified that he did not require argument in Court.^(p)

Inspection is not a matter of right.

Inspection.—It sometimes happens that the plaintiff could not establish the infringement complained of without an inspection of the process or machinery which the defendant is actually using; or the defendant could not prove his innocence by showing that the patent is invalid or that he does not infringe, without a like inspection against the plaintiff. In such cases the Court has power to make an order for either party to be at liberty to inspect the other's process or machinery; but neither party can claim inspection as a matter of right;^(q) and the Court will not allow it to be oppressive or to be carried beyond what is necessary in the interests of justice,^(r) the object of inspection being to enable the Court to have the case properly tried, and to assist the Court in forming a right conclusion.^(s)

Object of inspection.

Thus, where a defendant was charged with infringing a patent for a sewing machine, and objected to an order for the inspection by the plaintiff of all sewing machines on his premises, on the ground that such order would be oppressive, he was allowed to verify on affidavit all the different kinds of sewing machines

^(o) *Hall v. Truman*, (1885) L. R. 29 Ch. D. 307.

^(p) *Thomson v. Hughes*, (1890) 7 R. P. C. 187.

^(q) 46 & 47 Vict. c. 57, s. 30.

^(r) *Bovill v. Moore*, (1815) Dav. P. C. 361; 2 Coop. Ch. Ca. 56; *Russell v. Cowley*, (1833) 1 W. P. C. 458; *Piggott v. Anglo-American Telegraph Co.*, (1868) 19 L. T. N. S. 46.

^(s) *The Patent Type Founding Co.*

v. Walter, (1860) Johns, 727; *Bovill v. Moore*, (1815) 2 Coop. Ch. Ca. 56; *Russell v. Cowley*, (1833) 1 W. P. C. 459; *Davenport v. Jepson*, (1862) 1 N. R. 308; *Pemberton*, 4th ed. 484; *Russell v. Crichton*, (1837) 15 Decisions of Court of Session, 1st Series, 1270; *Germ Milling Co. v. Robinson*, (1886) 3 R. P. C. 11; *Cheetham v. Oldham*, (1888) 5 R. P. C. 622.

which he had sold or exposed for sale since the date of the Inspection. plaintiff's patent, and the order for inspection was confined to one of each class.^(t) The defendant cannot be compelled to make an affidavit verifying the machines or processes he uses, if he has offered inspection.^(u)

Before the Court makes an order for inspection it will require to be satisfied that the inspection sought is necessary to the case of the party seeking it.^(v) Evidence necessary to obtain an order for inspection.

Thus, an application for an order for inspection by the plaintiff was refused where he omitted to state on affidavit that it was necessary to his case, and the defendant swore that he made several kinds of the article complained of, and that some of them did not resemble those described in the plaintiff's specification, and that in his belief the inspection was not required for the purposes of the action, but to gain information of his improvements.^(y) Again, when the Court was of opinion that the defendant's acts, as alleged by the plaintiff, could not possibly amount to an infringement, an order for inspection was refused.^(z) And an order for inspection was refused where the plaintiff alleged that certain apparatus used by the defendant was an infringement, and the defendant on the other hand denied infringement and gave a description of the apparatus used by him, which showed it to be different to the plaintiff's. The order was refused notwithstanding the allegation that the plaintiff had failed to make the apparatus, as described by the defendant, work at all.^(a)

In an action for infringement the plaintiff cannot, as a rule, be compelled to produce, or allow inspection of the patented machine or process at the instance of the defendant for the purpose of preparing the defence, since the specification should give sufficient information of what the invention is and the mode of performing it.^(b) Inspection for the purpose of preparing pleadings.

When, however, the defendant alleges that he has in his possession apparatus which is an anticipation of the plaintiff's claim, and which was formerly used, an order for the production

^(t) *Singer Manufacturing Co. v. Wilson*, (1865) 5 N. R. 505; 12 L. T. N. S. 140.

^(u) *Drake v. Muntz's Metal Co.*, (1886) 3 R. P. C. 43.

^(v) *Piggott v. Anglo-American Telegraph Co.*, (1868) 19 L. T. N. S. 46; *Batley v. Kynock*, (1874) L. R. 19 Eq. 90; *Cheetham v. Oldham*, (1888) 5 R. P. C. 617; *Shaw v. Bank of England*, (1852) 22 L. J. N. S. Ex. 26; *Meadows*

v. Kirkman, (1860) 29 L. J. N. S. Ex. 205.

^(y) *Batley v. Kynock*, (1874) L. R. 19 Eq. 91.

^(z) *Piggott v. Anglo-American Telegraph Co.*, (1868) 19 L. T. N. S. 46.

^(a) *Sidebottom v. Fielden*, (1891) 8 R. P. C. 266.

^(b) *Crofts v. Peach*, (1836) 1 W. P. C. 268.

Inspection. and inspection of such apparatus may be obtained at the instigation of the plaintiff.(c) But where certain defendants alleged that the patent was anticipated by the sale of articles made according to the alleged invention by various persons named in the particulars, and the plaintiff applied for an order for the production before trial of the articles to be proved by the specified persons, the Court refused the application, on the ground that there was no precedent for such an order, and that on principle it ought not to be made.(d)

Plaintiff's affidavit on application for an order for inspection.

An affidavit made by the plaintiff on an application for an order for inspection should state that he has reason to believe that the process or machine used by the defendant is an infringement of his patent ; (e) it should also show the grounds of such belief,(f) and in what the invention of the plaintiff consists.(g) If the plaintiff makes out a *prima facie* case of infringement, and that inspection is necessary to enable him to prove it at the trial, an order will follow almost as matter of course,(h) but inspection will be limited to those machines and processes in respect of which a *prima facie* case of infringement is made out.(i)

Power of the Court to enforce an order for inspection.

The Court is not dependent on its power to compel inspection by treating as a contempt a refusal to comply with an order. The order of the Court may authorise any person, for the purpose of inspection, to enter upon or into any land or building that may be necessary.(k)

An order for inspection may be made at any time during the progress of an action, and may be obtained on summons or on motion.(l)

Delay no bar.

Delay in asking for an order for inspection is no bar.(m)

Postponement of the question of inspection.

If the party from whom inspection is sought objects, the Court or a Judge may, if satisfied that the right to inspection depends on the determination of any issue or question in dispute in the cause, or that for any other reason it is desirable that any issue or question in dispute in the cause should be determined

(c) *Sidebottom v. Fielden*, (1891) 8 R. P. C. 266.

(d) *Garrard v. Edge*, (1889) 6 R. P. C. 372.

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

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

(g) *Meadows v. Kirkman*, (1860) 29 L. J. N. S. Ex. 205.

(h) *Singer Manufacturing Co. v. Wilson*, (1865) 13 W. R. 560; 5 N. R. 505; *Batley v. Kynneck*, (1874) L. R.

19 Eq. 90; *Piggott v. Anglo-American Telegraph Co.*, (1868) 19 L. T. N. S. 46; *Cheetham v. Oldham*, (1888) 5 R. P. C. 617.

(i) *Cheetham v. Oldham*, (1888) 5 R. P. C. 617.

(k) R. S. C. 1883, Ord. 1. r. 3.

(l) *Judic. Act, 1873, s. 39*; R. S. C. 1883, Ord. liv. r. 12; Ord. lv. r. 15; *Frearson v. Loe*, (1878) 26 W. R. 138.

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

before deciding upon the right to the inspection, order that such **Inspection.** issue or question be determined first and reserve the question as to the inspection.⁽ⁿ⁾

The order for inspection generally makes it a condition that **Conditions.** reasonable notice be given to the parties against whom it is made,^(o) and, if the inspection relates to machinery, that the machines be put to work^(p) in the presence of persons named,^(q) and further specifies the number of inspections that are to be allowed.^(r)

A licensee not a party to the action cannot be compelled to give inspection in an action against his licensor, though the order be made.^(s)

Inspection against licensee not a party to the action.

It is sometimes objected that an inspection if granted would lead to the disclosure of trade secrets, and damage the trade of the party against whom it is sought, but such an objection will not deter the Court from making an order if it appears to be necessary in the interests of justice,^(t) though the Court will endeavour to prevent an undue advantage being taken of secrets disclosed during an inspection.^(u)

Trade secrets.

In *Flower v. Lloyd*,^(x) where inspection was resisted on the ground of disclosure of trade secrets, an arrangement was come to in the Court of Appeal whereby the defendant's works should be inspected by scientific men to be agreed upon, but not by the plaintiff.

In *Cheetham v. Oldham*,^(y) the plaintiff, a rival manufacturer of the defendant, was himself allowed to take part in the inspection.

In *Plating Co. v. Farquharson*,^(z) the Court made an order

(n) R. S. C. (1883) Ord. xxxi. r. 20.

(o) *Drake v. Muntz's Metal Co.*, (1886) 3 R. P. C. 43; *Germ Milling Co. v. Robinson*, (1886) 3 R. P. C. 11; *Flower v. Lloyd*, Seton, 4th ed. p. 351; *Russell v. Cowley*, (1833) 1 W. P. C. 458; *Davenport v. Jepson*, (1862) 1 N. R. 173; *Pemberton*, 4th ed. 484, p. 236; *Drake v. Muntz's Metal Co.*, (1886) 3 R. P. C. 43.

(p) Seton, 4th ed. p. 351; *Beardsel, v. Schwann*, Seton, 3rd ed. p. 910; *Davenport v. Jepson*, (1862) *Pemberton*, p. 484; *Germ Milling Co. v. Robinson*, (1886) 3 R. P. C. 11; *Bovill v. Moore*, (1815) 2 Coop. C. C. 56; *Russell v. Cowley*, (1833) 1 W. P. C. 458.

(q) *Russell v. Cowley*, (1833) 1 W. P. C. 458; *Drake v. Muntz's Metal Co.*, (1886) 3 R. P. C. 43.

(r) *Heathfield v. Braby*, Seton, 4th

ed. p. 1661; *Germ Milling Co. v. Robinson*, (1885) 3 R. P. C. 11.

(s) *Germ Milling Co. v. Robinson*, (1886) 3 R. P. C. 11, 14.

(t) *Renard v. Levinstein*, (1864) 10 L. T. N. S. 94; *Piggott v. Anglo-American Telegraph Co.*, (1868) 19 L. T. N. S. 46; *Smith v. G. W. Ry. Co.*, (1854) *Macr. P. C.* 223; *Russell v. Crichton*, 15 Dec. of Court of Session, 1st Series, 1270; *Cheetham v. Oldham*, (1888) 5 R. P. C. 617; *Rylands v. Ashley's Patent (Machine Made) Bottle Co.*, (1890) 7 R. P. C. 175.

(u) *Russell v. Crichton*, (1837) 15 Decisions of Court of Session, 1st Series 1270; *Flower v. Lloyd*, Seton, 4th ed. p. 351; *Plating Co. v. Farquharson*, *Lawson, Patents, Designs, and Trade Marks Acts*, 2nd ed. 500.

(x) (1876) W. N. 169.

(y) (1888) 5 R. P. C. 617.

(z) (1881) *Griff. P. C.* 187.

Inspection. authorising inspection by a scientific expert, but bound him not to disclose his report on the facts or opinion obtained or arrived at by him, without the leave of the Court or a Judge, and, at the trial, the expert was not allowed to be called as a witness or cross-examined.

Where the defendant desired an inspection of machines not belonging to, but in the power of the plaintiff, and the Court thought that such inspection would be beneficial in the interests of justice, an order was made that the plaintiff should *bonâ fide* endeavour to procure the inspection desired, and report the result to the Court. *(a)*

Where an independent inspector is appointed, he is usually required to "report to the Court upon the facts, and his opinion founded upon them." *(b)*

Samples. Besides granting inspection, the Court or a Judge has the power, which is frequently exercised, to authorise samples to be taken, or any observation to be made, or experiment to be tried, which may be necessary or expedient for the purpose of obtaining full information or evidence. *(c)*

Inspection of books. It was held that the inspection authorised by the Act of 1852 *(d)* referred to an inspection of the instrument or machinery manufactured or used by the parties, with a view to evidence of infringement, and not to an inspection of books; *(e)* and probably the same meaning must be attached to the word as used in s. 30 of the Act of 1883, and an inspection of books would not be allowed on affidavit merely showing the possibility of discovering matters advantageous to the case of the party seeking it. *(f)*

Inspection when the action is founded solely on a threat to infringe. An injunction may be obtained restraining a threatened infringement; *(g)* and in a case where it appeared that the defendant had entered into a contract to make certain paddle-wheels, which the plaintiffs alleged were a violation of their patent, an order was obtained from the Court authorising the plaintiffs and their witnesses to be at liberty to inspect at all seasonable times, giving reasonable notice, the paddle-wheels or

(a) Rylands v. Ashley's Patent (Machine Made) Bottle Co., (1890) 7 R. P. C. 175.

(b) The Plating Co. v. Farquharson, (1881) Lawson, Patents, Designs, and Trade Marks Acts, 2nd ed. p. 500; see 500; see also Hill v. Touts, *ibid.* 499.

(c) (1883) R. S. C. Ord. l. r. 3; Russell v. Cowley, (1833) 1 W. P. C. 459; The Patent Type Founding Co. v. Walter, (1860) Johns, 727; The

Plating Co. v. Farquharson, (1881) Griff. P. C. 187; The Germ Milling Co. v. Robinson, (1886) 3 R. P. C. 14; Cheetham v. Oldham, (1888) 5 R. P. C. 621.

(d) s. 42.

(e) Vidi v. Smith, (1854) 3 E. & B. 969.

(f) Smith v. G. W. Ry. Co., (1854) Macr. P. C. 223.

(g) p. 504 *ante*.

machinery relating to paddle-wheels made, or to be made, pursuant to the said contract.^(h) Evidence.

EVIDENCE.

If the defendant puts in a defence and does not appear at the trial, the plaintiff is not entitled to judgment without proof of his case: he must prove the grant and show that the specification is good on the face of it and also prove the infringement.⁽ⁱ⁾ Evidence when defendant does not appear at the trial.

By the Patent Act of 1852,^(k) the evidence of both the plaintiff and the defendant was strictly confined to the particulars which had been given, and, therefore, if at the trial either party wished to give evidence not within them, the proper course was to apply at once for leave to amend, on the ground that fresh evidence had come to light since they were delivered.^(l) Evidence not within the particulars.

The Act of 1883 has somewhat enlarged the opportunities open to litigants of giving evidence at the trial by enacting that at the hearing no evidence shall, *except by the leave of the Court or a Judge*, be admitted in proof of any alleged infringement or objection of which particulars have not been delivered;^(m) but it is not safe to rely on the Court granting the necessary leave, and consequently, if a party desire to go outside his particulars on the ground that the evidence was discovered since they were delivered, he should still apply for leave to amend, which will, however, not be granted unless he makes out a sufficient case,⁽ⁿ⁾ and then only upon the usual terms. But the Court—*i.e.*, both the Court of First Instance and the Court of Appeal—has undoubted discretion under the Act of 1883 to admit evidence not within the particulars without requiring an amendment of the particulars.^(o)

When particulars have been delivered, and not objected to, such evidence may be given under them as their words are sufficiently wide to include;^(p) and, however general they may be, if the evidence tendered is within their literal meaning, it will be admitted.^(q) Particulars not objected to are construed widely.

^(h) *Morgan v. Seaward*, (1835) 1 W. P. C. 169.

⁽ⁱ⁾ *Peroni v. Hudson*, (1884) 1 R. P. C. 261.

^(k) s. 41.

^(l) *Daw v. Eley*, (1861) L. R. 1 Eq. 38.

^(m) s. 29 (4).

⁽ⁿ⁾ *Moss v. Malings*, (1886) L. R. 33 Ch. D. 603; *Renard v. Levinstein*, (1864) 13 W. R. 229; 11 L. T. N. S. 505.

^(o) *Britain v. Hirsch*, (1888) 5 F. P. C. 226; see also p. 527 *ante*.

^(p) *Neilson v. Harford*, (1841) 1 W. P. C. 332, 370.

^(q) *Hull v. Bollard*, (1856) 1 H. & N. 134; *Curtis v. Platt*, (1866) 35 L. J. N. S. Ch. 852, 868; *Sugg v. Silber*, (1877) L. R. 2 Q. B. D. 495; *Sykes v. Howarth*, (1879) L. R. 12 Ch. D. 826; 48 L. J. N. S. Ch. 769; see also *Adair v. Young*, (1879) W. N. p. 8.

Evidence. Thus evidence of user in Cheshire was admitted under an objection which alleged that the invention had been publicly used in "corn mills";^(r) and where the particulars alleged infringement by manufacture and sale at divers times between specified dates and also two specified instances of sale, evidence of a third sale was allowed, the defendant having, by his interrogatories, admitted such a sale.^(s) When, however, an order for amendment of the particulars of objection had not been complied with, evidence of an anticipating specification not given under the order was not admitted.^(t)

Patentee who has assigned his interest is a competent witness.

A patentee who has assigned the whole of his interest is a competent witness for the assignee in any action he may bring for the infringement of the patent.^(u) If the patentee has covenanted with the assignee in respect of the validity of the patent, he may have an interest in the event of a subsequent action in which the question of validity is raised, but his evidence would not be excluded, although his interest would be a matter to be taken into consideration as affecting his credit.^(v)

Licensee may be a witness for the plaintiff.

A licensee is also a competent witness for the plaintiff in a patent action,^(y) though he may be an interested one.^(z)

If the licensee is empowered to use the invention in consideration of a periodical payment or a payment in proportion to the extent of his user, he cannot have an interest in supporting the patent (unless the payments are merely nominal or not a full consideration for the privilege granted), but he may be interested in its destruction. If the licensee has paid a gross sum for an irrevocable licence, or has obtained it for any other consideration, he may have an interest in supporting the patent, for if the invention be thrown open to the public he cannot obtain any benefit from the licence.

but not when the action is brought for his own benefit.

If, however, the action be brought for the benefit of the licensee who has an exclusive licence for some particular district, he would not be a competent witness for the plaintiff, because he would be a person "in whose immediate and individual behalf" the action was brought.^(a)

Necessity for

In patent actions the testimony of experts frequently forms

^(r) *Hull v. Bollard*, (1856) 1 H. & N. 134.

^(s) *Sykes v. Howarth*, (1879) L. R. 12 Ch. D. 826; 4 L. J. N. S. Ch. 769.

^(t) *Lister v. Leather*, (1858) 3 Jur. N. S. 811.

^(u) *Bloxam v. Elsee*, (1825) 1 C. & P. 563.

^(v) 6 & 7 Vict. c. 85, s. 1.

^(y) *Ibid.*

^(z) *Ibid.*

^(a) *Ibid.*

the chief part of the evidence submitted to the Court both in importance and in volume. The following remarks of the late Lord *Bowen* illustrate the great importance of the evidence of scientific men of repute in cases, such as Patent actions, where it is the duty of the Court to inform itself as to the state of scientific knowledge at the date of the patent bearing upon the subject-matter of the dispute between the parties.

Evidence.
 ———
 and the value
 of the evidence
 of experts.

“ If we are to act in the present instance, one must fall back upon the opinions of experts, and I wish emphatically to state my view, that in a matter like the present, so far from thinking the opinions of experts unsatisfactory, it is to the opinion of experts that I myself should turn with the utmost confidence and faith. Courts of law and courts of justice are not fit places for the exercise of the inductive logic of science. Life is short; it is impossible to place endless time at the disposal of litigants; and the laws of evidence are based upon this very impossibility of prolonging inquiries to endless length. There is hardly a scientific theory in the world which, if we were to examine into it in law courts, might not take year after year of the whole time of a tribunal. Supposing, for a moment, one had brought in question the circular theory of storms, and were to propose before a tribunal like this to examine it, not by reference to the opinions of the most experienced persons who have made it a subject of study and investigation, but to inquire ourselves into all the special circumstances of storms, with which witnesses could favour us who had crossed the Atlantic or the Eastern seas, in order to form our opinion, assisted, no doubt, by scientific men, as to the circular theory of storms, with all the qualifications which might be adopted, and with all the definitions in which it might be embodied. Take another instance of a law which is very far from likely to be accepted by science, but most probably would be rejected as pure theory, and as utterly beyond reason. I believe there are many persons in India who endeavour to connect the existence of famine raging over tracts of country with spots on the sun. Supposing that theory were brought up in an English court of law, we should be bound to embark on an endless inquiry into all the instances in which spots on the sun had been found to be coincident with famines in India. The truth is, when you are dealing with scientific theories, it is hopeless for courts of law to do more than to take the evidence of scientific men, subject, no doubt, to cross-examination, which may or may not condescend to particular instances, which may be brought home to them to show, if it exists, the uncertainty of the grounds upon which their opinions are founded. The result of the admission of this evidence,

Evidence.

assuming it, as I do, to be admissible, has been, in my judgment, to show that the endeavour to utilise such evidence launches us upon an inquiry fit only for the leisure of learned and scientific men, but for which the jury system and the judicial system are probably inadequate." (b)

Expert evidence is admissible to explain technical terms, to show the practical working of machinery described or drawn, to point out what is old and what is new in the specification, to show the particulars in which an alleged invention has been used by an alleged infringer or the real importance of any differences between the plaintiff's invention and the alleged infringement, and what are and what are not mechanical or chemical equivalents. But the nature of the invention for which a patent is granted must be ascertained from the specification, and has to be determined by the Judge and not by a jury, nor by any expert or other witness, which is familiar law, although often disregarded by counsel when examining witnesses. (c)

The Court always scrutinises very carefully—even with suspicion—expert evidence and experiments prepared expressly for the purposes of either party at the trial. (d)

Proof of the
grant of the
patent,

If the grant of the patent be denied, it must be proved by the production of the letters patent themselves or a copy thereof certified by the Comptroller and sealed with the seal of the Patent Office, (e) and no further proof is necessary.

The letters patent are only proof of the *purport* of the grant which they contain, the effect or operation of the grant being quite a different question. Although letters patent purport to grant a sole privilege to the patentee, it may be that the patent is for some reason illegal or void, and, if so, the patent is of no force, and the grant it purports to make has no operation, and consequently it is strictly correct to say that the Queen did not make such a grant as the plaintiff alleges, for a void grant is the same as no grant at all. (f) The letters patent merely prove the purport of the grant, and upon any dispute respecting the invention the specification must be read and considered as incorporated with the patent. (g)

(b) *Fleet v. The Managers of the Metropolitan Asylums District* (1886); *Cunningham's "Life of Lord Bowen,"* p. 162.

(c) See *Brooks v. Steel*, (1896) 14 R. P. C. 73; *Ticket Punch Register Co. v. Colley's Patents*, (1895) 12 R. P. C. 186.

(d) *Betts v. Neilson*, (1868) L. R. 3 Ch. 433; *Young v. Fernie*, (1864) 4

Giff. 609; Plimpton v. Malcolmson, (1876) L. R. 3 Ch. D. 576; *Crampton v. Patents Investment Co.*, (1888) 5 R. P. C. 382, 404.

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

(f) *Hindmarch*, p. 440.

(g) *Hornblower v. Boulton*, (1799) S. T. R. 102; *Dav. P. C. 221; Crossley v. Beverley*, (1829) 9 B. & C. 63.

It is incumbent on the plaintiff to prove what the invention really is for which the patent was granted. The proper way to do this is to put in the specification, and neither the patentee nor any other witness can be called to prove what the real invention is, the question being one which can only be answered from a critical examination of the specification,^(h) which must, however, be interpreted by the light of public knowledge at the date of the grant, external evidence of which is, therefore, admissible for the purpose of deciding between two possible constructions of a claim.⁽ⁱ⁾ Evidence of the patentee cannot be tendered to show what effect was intended by the specification.^(k)

Evidence.
and the scope
of the inven-
tion claimed.

If the defendant raises the issue that the patentee was not the true and first inventor, the *onus* of proof rests with him, but it is usual for the plaintiff to tender *prima facie* evidence to the effect that the patentee was the first person who actually communicated the invention to the public.^(l) This is usually done by calling the patentee himself, who claims to be the inventor; but when the patent was obtained on a communication from abroad, it is not necessary to call the foreign inventor.^(m)

Issue of true
and first
inventor.

The decision of the issue raised by a plea that the alleged invention could not form the subject-matter of a valid patent rests more with a judge than a jury. The plaintiff must give the specification in evidence, in order that the judge may see what the alleged invention really is; and if there are terms of art involved, the jury, or judge acting as a jury, must determine the meaning to be applied to them in the construction of the specification, which is the duty of the Court alone.⁽ⁿ⁾ It should also be remembered that the ingenuity of any alleged invention—*i.e.*, whether there has been a sufficient expenditure of the inventive faculty to support the patent on the ground of subject-matter—is to be judged in the light of the state of public knowledge at the time it was made.^(o) If the issues of subject-matter, novelty, and utility, or sufficiency of specification, have been decided on a previous occasion by a Court of co-ordinate or superior jurisdiction, the Court as a matter of convenience considers itself bound by the finding of the

Issue of
subject-matter.

(h) *Badische Anilin und Soda Fabrik v. Levinstein*, (1887) L. R. 12 App. Cas. 717; *Hinks v. Patent Safety Lighting Co.*, (1876) L. R. 4 Ch. D. 618; *Brooks v. Steel*, (1896) 14 R. P. C. 73; p. 467 *ante*.

(i) p. 251 *ante*.

(k) *Kaye v. Chubb*, (1887) 4 R. P. C. 289, 298.

(l) pp. 15, 17 *ante*.

(m) *Nettlefolds v. Reynolds*, (1892) 9 R. P. C. 270; *Badische Anilin und Soda Fabrik v. Levinstein*.

(n) p. 237 *ante*. (o) p. 33 *ante*.

Evidence. Court on the former occasion, so far as the same evidence is concerned, and will refuse to admit such evidence again.(p) Of course, if different evidence is adduced on any of these points, and there is no estoppel on the ground of the matter being *res judicata* between the parties, or from any other cause, the Court receives and gives effect to such fresh evidence.(q)

The plea of want of novelty does not put in issue the fact of the invention being a manufacture within the meaning of the Statutes of Monopolies for which a patent could be granted ;(r) *i.e.*, it does not raise the issue of subject-matter.

When novelty is in issue plaintiff must give *prima facie* evidence,

If the novelty of the invention be denied, the plaintiff must give *prima facie* evidence that the invention had not been communicated to the public before the date of the patent.(s) In order to do this the plaintiff must call witnesses whose avocations were likely to have made them acquainted with the subject-matter of the alleged invention if it had been published prior to the date of the patent, and who are able to testify that it was unknown to them. It is clear that only indirect evidence of novelty can be given, since it is impossible to examine every member of the public ; but if the plaintiff calls witnesses who for some time before the date of the patent were well acquainted with the particular branch of trade or manufacture to which the invention relates, and who can swear that they were ignorant of it until after the date of the patent, this will be sufficient *prima facie* evidence, and the *onus* of proving the negative will then be on the defendant.(t)

If the invention consist of several parts claimed separately,(u) or if several inventions have been comprised in the same patent,(v) it is incumbent on the plaintiff to give *prima facie* proof of the novelty of all the parts, or all the inventions, as the case may be.(y)

after which the onus is on the defendant.

After the plaintiff has made a *prima facie* case in respect of novelty, the *onus* is on the defendant of showing that the invention was public property at the date of the patent, and,

(p) *Slazenger v. Feltham*, (1889) 6 R. P. C. 130.

(q) p. 522 *ante*.

(r) p. 20 *ante*.

(s) *Turner v. Winter*, (1787) Dav. P. C. 153; *Manton v. Manton*, (1815) Dav. P. C. 348; *Bovill v. Moore*, (1815) Dav. P. C. 399; *Galloway v. Bleaden*, (1839) 1 W. P. C. 525; *Cornish v. Keene*, (1835) 1 W. P. C. 509.

(t) *Cornish v. Keene*, (1835) 1 W. P. C. 509; *Manton v. Manton*, (1815)

Dav. P. C. 350, 353; *Galloway v. Bleaden*, (1839) 1 W. P. C. 526; *Amory v. Brown*, (1869) L. R. 1 Eq. 663; *Harris v. Rothwell*, (1887) L. R. 35 Ch. D. 416, 427.

(u) *Manton v. Manton*, (1815) Dav. P. C. 340, 341; *Gibson v. Brand*, (1841) 4 M. & G. 179; *Gillett v. Wilby*, (1839) 9 Car & P. 334; *Losh v. Hague*, (1837) 1 W. P. C. 208.

(v) *Brunton v. Hawkes*, (1820) 4 B. and Ald. 541; p. 294 *ante*.

(y) Chap. iii.

consequently not new as to the public knowledge and use of it,^(z) but the evidence of one witness may be quite sufficient to do this ;^(a) though, if an alleged prior use made a long time ago is relied on, the uncorroborated evidence of persons interested in defeating the patent ought not to carry the alleged prior use further than an experimental use.^(b)

Evidence.

When a published document is alleged as an anticipation, evidence should be called to explain it, if necessary.^(c) But if the anticipation relied on is an English complete specification filed in the Patent Office no proof is required of further publication or its contents having been seen by the public,^(d) for the second of two patents for the same invention must be bad in law.^(e)

Documents as evidence of publication.

Where the want of novelty appears distinctly from a written document, it is for the Court, and not the jury, to determine the identity of the two supposed inventions,^(f) aided as to the meaning of technical expressions by the finding of the jury, or the Judge acting as a jury.^(g) But when a skilled workman, with the knowledge common to the trade at the date of the trial, produces in evidence a successful result, which he says he arrived at by following only the directions of an old and unused paper anticipation, the Court weighs very carefully indeed such evidence before accepting it.^(h)

Upon the issue of novelty the plaintiff is entitled to call evidence in reply for the purpose of rebutting that given by the defendant, on whom lies the *onus* of proving his case,⁽ⁱ⁾ and such rebutting evidence is usually called at the close of the defendant's case.^(k) Thus, at the hearing of an action where evidence had been admitted on behalf of the defendants

Rebutting evidence may be given by the plaintiff on the issue of want of novelty.

(z) *Penn v. Jack*, (1866) L. R. 2 Eq. 314; *Minter v. Wells*, (1834) 1 W. P. C. 129; *Peroni v. Hudson*, (1884) 1 R. P. C. 261.

(a) *Badham v. Bird*, (1888) 5 R. P. C. 238.

(b) *Dick v. Tullis*, (1896) 13 R. P. C. 149; *Pneumatic Tyre Co. v. Marwood*, (1897) 14 R. P. C. 240; p. 106 *ante*.

(c) *Hocking v. Fraser*, (1886) 3 R. P. C. 63; *Bovill v. Smith*, (1868) Griff. L. O. C. 52; *Betts v. Menzies*, (1862) 10 H. L. Cas. 117; pp. 107-110 *ante*.

(d) *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 551, 557; *Harris v. Rothwell*, (1887) L. R. 35 Ch. D. 416, 428.

(e) Chap. ii.

(f) *Bush v. Fox*, (1856) 5 H. L. Cas. 707; *Booth v. Kennard*, (1857) 2 H. & N. 84; *Hills v. London Gas Light Co.*, (1860) 5 H. & N. 312; *Betts v. Menzies*, (1862) 10 H. L. Cas. 134; *Harwood v. Great Northern Ry. Co.*, (1865) 11 H. L. Cas. 654; *Simpson v. Holliday*, (1866) L. R. 1 H. L. 315.

(g) *Betts v. Menzies*, (1862) 10 H. L. Cas. 134; *Harwood v. Great Northern Ry. Co.*, (1865) 11 H. L. C. 654; *Simpson v. Holliday*, (1866) L. R. 1 H. L. 320.

(h) *Defries v. Sharwood*, (1897) 13 R. P. C. 313; *Plimpton v. Malcolmson*; p. 575 *post*.

(i) p. 572 *ante*.

(k) *Penn v. Jack*, (1866) L. R. 2 Eq. 314; *Westley Richards and Co. v. Perkes*, (1893) 10 R. P. C. 187.

Evidence. which was not included under the particulars, the case was ordered to stand over, to allow of the plaintiff having an opportunity of rebutting such evidence, the defendants being allowed to amend their particulars.^(l)

Recalling witnesses.

A plaintiff, however, who has tendered evidence of novelty, and has had his attention called to a particular alleged anticipating document, cannot for the purpose of explaining its contents recall a witness in reply, who when he gave his evidence was acquainted with the document.^(m) A plaintiff has been allowed, after the conclusion of all evidence, but before judgment, which had been reserved, to give fresh evidence on a point relevant to the issue, which had not been "threshed out."⁽ⁿ⁾

A defendant cannot recall the plaintiff's witnesses, after the conclusion of the cross-examination, in order to put to them fresh instances of publication, unless it can be shown that such instances only came to the defendant's knowledge since the cross-examination, and could not, with due diligence, have been discovered earlier;^(o) and he will not be allowed to give further evidence in answer to that given by the plaintiff in reply, if his evidence has been summed up.^(p)

Notice to admit documents.

If the defendant relies upon publication in a prior document, he should give the plaintiff notice to admit that the document was published prior to the date of the patent. If the publication of any document is not admitted, it must be proved by calling the librarian of the public library at which the book or document was before the date of the patent.^(q)

Where an affidavit of documents had been required by the plaintiff, he was not allowed to recall one of the defendant's witnesses for the purpose of cross-examining him as to the contents of a report the defendant had received from a patent agent, which report was not produced, and was only referred to at a late stage of the trial.^(r)

Models as evidence.

Models are similar to documentary evidence, and the Court will draw its own conclusions from them.^(s) If a witness goes too far in his statements or admissions as to the effect of an

^(l) *Blakey v. Latham*, (1889) 6 R. P. C. 29, 36.

^(m) *Tetley v. Easton*, (1852) Mac. P. C. 61.

⁽ⁿ⁾ *Boyd v. Horrocks*, (1888) 5 R. P. C. 557.

^(o) *Moss v. Malings*, (1886) 3 R. P. C. 373.

^(p) *Penn v. Jack*, (1866) L. R. 2 Eq.

24.

^(q) R. S. C. (1883) Ord. xxxii. r. 4.

^(r) *Sugg v. Bray*, (1884) 54 L. J. N. S. Ch. 132.

^(s) *Seed v. Higgins*, (1860) 8 H. L. Cas. 565; *Westinghouse v. L. & Y. Ry. Co.*, (1884) 1 R. P. C. 245; *Bovill v. Smith*, (1868) Griff. L. O. C. 52; *Winby v. Manchester, &c., Steam Tramways Co.*, (1891) 8 R. P. C. 63.

alleged anticipation, and proved or admitted models are before the Court, the Court may be guided by the actual models themselves, notwithstanding the statements or admissions of the witness.^(t) Evidence.

When the difference between the patented article and an alleged disused prior anticipation is something apparently slight, but really important, the Court ought not to accept the evidence of a man who puts forward a perfected model as representing his idea of the alleged anticipation, when it appears that before making the model he saw the form patented, and made it with that knowledge evidently in his mind. Thus, *Jessel, M.R.*, in the *Plimpton* skate case,^(u) said, "I will not accept the evidence of any man who says that the drawing in the Patent Office is represented by a model if he has seen the real *Plimpton* skate."

It is, of course, a most improper thing for a party to make any alteration in the working power of a model once put in evidence, whether by cleaning or otherwise, unless it be done by permission of the Court, and upon notice to, and, if desired, in the presence of the other party, or his advisers.^(v)

If the plea of want of utility is raised as an objection to the patent, the plaintiff must give *prima facie* evidence to prove that the invention was useful to the public at the date of the grant.^(y) It is important to do this, since the evidence of utility raises a presumption in favour of novelty and ingenuity.^(z) Proof of utility.

If the defendant sets up a *prima facie* case that the invention was not useful, the burden is then on the plaintiff to prove that it was useful.^(a)

The fact that the defendant has attempted to infringe is itself evidence of utility.^(b)

The degree of utility is quite immaterial under this issue; it is quite sufficient if the plaintiff can show that the invention was of *any* utility to the public.^(c)

(t) *Seed v. Higgins*, (1860) 8 H. L. C. 565; *Moore v. Bennett*, (1884) 1 R. P. C. 137.

(u) *Plimpton v. Malcolmson*, (1876) L. R. 3 Ch. D. 531.

(v) *Winby v. Manchester, &c., Steam Tramways Co.* (2), (1891) 8 R. P. C. 63.

(y) Chap. iv., *R. v. Arkwright*. (1785) Dav. P. C. 135; *Manton v. Parker*, (1815) Dav. P. C. 327; *Manton v. Manton*, (1815) Dav. P. C. 333; *Bovill v. Moore*, (1815) Dav. P. C. 399; *Minter v. Wells*, (1834) 1 W. P. C. 129; *Hill v. Thompson*, (1817) 2 W. P. C. 237; *Crane v. Price*, (1842) 1 W. P. C.

411; *Russell v. Cowley*, (1835) 1 W. P. C. 467; *Brunton v. Hawkes*, (1820) 4 B. & Ald. 541; *Derosne v. Fairie*, (1835) 5 Tyr. 393; 2 Cr. M. & R. 476.

(z) *Lyon v. Goddard*, (1893) 10 R. P. C. 121, 334, 343; 11 R. P. C. 354.

(a) *Ehrlich v. Hilee*, (1888) 5 R. P. C. 449.

(b) *Lucas v. Miller*, (1885) 2 R. P. C. 160; *Reynolds v. Amos*, (1886) 3 R. P. C. 215; *United Horseshoe and Nail Co. v. Stewart*, (1888) L. R. 13 App. Cas. 407; *Badische Anilin und Soda Fabrik v. Levinstein*, (1887) L. R. 12 App. Cas. 712. (c) p. 146 *ante*.

Evidence.

The question of utility must be determined with reference to the date of the patent. If it can be shown that it was then of some utility to the public, it is no objection that owing to more recent improvements it has since become useless;(d) and, if the patentee has obtained a subsequent patent for an improvement on a prior invention, it is not to be inferred that the prior invention was therefore useless.(e)

Each essential part of the invention must be shown to be useful;(f) for, if a material part is useless, the patent is void.(g)

It is not necessary that the utility of every part of an invention should be proved by actual trial; evidence of skilled persons to the effect that if tried it would answer may be sufficient.(h) Thus, in *Neilson v. Harford*(i) a question arose as to the utility of a certain vessel which according to the specification formed a material part of the invention. There was no evidence of any person having actually tried the vessel of the shape in question, but there was the evidence of scientific witnesses to the effect that it would answer, and the Judge who tried the case told the jury that if they were satisfied with that evidence it was quite sufficient to establish utility.

If the plaintiff proves that the invention as a whole is useful, he is not bound to prove that each part of it possesses an equal amount of utility.(k)

Effect of user
on the issue of
utility.

The fact that an invention has not come into general use raises a strong presumption against its utility;(l) but it is not to be assumed from such evidence that the invention was not sufficiently useful to support a patent. The reason why an invention has not come into general use may be that immediately after the discovery an improvement upon it may have been produced, which, for commercial reasons, prevented the general adoption of the former invention.(m)

It is to be observed that a large sale of a patented article

(d) p. 143 *ante*.

(e) *Otto v. Linford*, (1881) 46 L. T. N. S. 39; *Edison v. Holland*, (1889) 6 R. P. C. 277; *Thompson v. Batty*, (1889) 6 R. P. C. 100; p. 67 *ante*.

(f) p. 146.

(g) *Hill v. Thompson*, (1818) 8 Taunt. 375; *United Horseshoe and Nail Co. v. Stewart*, (1885) 2 R. P. C. 122, 132.

(h) pp. 144, 210 *ante*.

(i) (1841) 1 W. P. C. 295.

(k) p. 144, 149, 210 *ante*; *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 203.

(l) *Morgan v. Seaward*, (1837) 1

W. P. C. 185; *Simister's Patent*, (1842) 1 W. P. C. 723; *Morgan v. Windover*, (1888) 5 R. P. C. 303; *Re Bakewell's Patent*, (1862) 15 Moo. P. C. 386; *Re Allan's Patent*, (1867) L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 443.

(m) *Badische Anilin und Soda Fabrik v. Levinstein*, (1887) L. R. 12 App. Cas. 710, 712; *United Telephone Co. v. Bassano*, (1886) 3 R. P. C. 313; *Kurtz v. Spence*, (1888) 5 R. P. C. 182; *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 450; *Edison v. Holland*, (1888) 5 R. P. C. 283.

does not necessarily prove that it possesses the kind of utility which the patent law requires to support a patent—*i.e.*, that it is useful for the purpose in view,⁽ⁿ⁾ or that it is novel.^(o) The reason why the article has a large sale may be that it is well advertised, or got up in a manner likely to attract the purchasing public.^(p) On the other hand, the fact that thousands of a patented article have been sold, and, in consequence of their superiority, others of a similar nature have become a drug in the market, may afford evidence of the utility of the patent.^(q)

Evidence.

The burden of giving some evidence of the sufficiency of the specification is upon the plaintiff, as was held by *Bullen, J.*, in a case in which his Lordship is reported to have said: "I do not agree with the counsel who have argued against this rule in saying that it was not necessary for the plaintiff to give any evidence to show what the invention was, and that the proof that the specification was improper lay on the defendant; for I hold that a plaintiff must give some evidence to show what his invention was, unless the other side admits that it has been tried and succeeds. But wherever the patentee brings an action on his patent, if the novelty or effect of the invention be disputed, he must show in what his invention consists, and that he produced the effect proposed by the patent in the manner specified. Slight evidence of this on his part is sufficient, and it is incumbent on the defendant to falsify the specification."^(r)

Proof of sufficiency of the specification.

A plea of the insufficiency of the specification puts the plaintiff to the necessity of giving evidence to the effect that the specification does particularly describe and ascertain the nature of the invention, and in what manner it is to be performed.

For the purpose of proving the sufficiency of the specification it is enough for the plaintiff to call workmen of ordinary intelligence engaged in the trade to which the invention relates who are able to state that they can or have actually performed the invention with no other aid than the specification.^(s)

Under an issue of insufficiency of the specification the plaintiff must prove that it sufficiently describes and ascertains every part of the invention; that it is intelligible to persons of ordinary

(n) pp. 143, 144 *ante*.

(o) pp. 27, 95 *ante*.

(p) *Cole v. Saqui*, (1888) 5 R. P. C. 489; 6 R. P. C. 41.

(q) *Ehrlich v. Ihlee*, (1888) 5 R. P. C. 437, 449; *American Braided Wire Co. v. Thompson*, (1888) 5 R. P. C. 113.

(r) *Turner v. Winter*, (1787) Dav. P. C. 153; 1 T. R. 606.

(s) *Cornish v. Keene*, (1835) 1 W. P. C. 503; *Shaw v. Jones*, (1889) 6 R. P. C. 335; *Edison v. Holland*, (1889) 6 R. P. C. 243.

Evidence. skill engaged in the trade to which the invention relates; and that the invention is capable of producing the effects specified.^(t) If there are any technical terms or terms of art used in the specification which require explanation to make the description intelligible, evidence must be given of their meaning, but the plaintiff is not allowed to correct or explain any error or misdescription unless they be such that they could not possibly mislead.^(u)

If the defendant can prove that there is anything material stated in the specification which is false^(v) or calculated to mislead or puzzle a person who might attempt to follow its directions, the patent will be void.^(y)

Proof of infringement.

The construction of the specification is for the Court, aided by such facts as are admissible, to explain written documents. The evidence of scientific witnesses is only admissible as proof of facts. Their opinion as to whether there has been an infringement or not, though sometimes received in order to save time and trouble, is, strictly speaking, inadmissible, and if objected to ought to be rejected.^(z)

When expert evidence is called for the purpose of explanation, and the first witness explains all that requires explanation, and is not broken down in cross-examination, there is no need to call further expert witnesses on the same points, and it is not admissible to do so.^(a)

In order to substantiate the allegation of infringement, the plaintiff must prove that the defendant has used the art which forms the subject-matter of the patent, or that he has violated the patent privilege in the manner alleged in the statement of claim. And in order to make out his case it is not necessary that the plaintiff should prove that the defendant has used the whole of the art or invention comprised in the patent; it is sufficient to show that he has used any essential part of it.^(b)

The same rule applies to the infringement of all patents, whether they are "pioneer" or "master patents" or not—*i.e.*, in order to make out infringement it must be established to the

^(t) p. 144 *ante*. ^(u) p. 255 *ante*.
^(v) *Bickford v. Skewes*, (1841) 1 Q. B. 938; *Lewis v. Marling*, (1829) 10 B. & C. 22.

^(y) pp. 178, 183, 191 *ante*.
^(z) *Seed v. Higgins*, (1860) 8 H. L. C. 565; *Bovill v. Smith*, (1868) Griff. L. O. C. 52; *Westinghouse v. Lancashire and Yorkshire Ry. Co.*, (1884) 1 R. P. C. 245.

^(a) *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 116.

^(b) *Cornish v. Keene*, (1835) 1 W. P. C. 501; *Morgan v. Seaward*, (1836) 1 W. P. C. 170; *Jones v. Pearce*, (1832) 1 W. P. C. 124; *Crane v. Price*, (1842) 4 M. & G. 580; *Hill v. Thompson*, (1817) 8 Taunt. 375; 3 Mer. 622; 1 W. P. C. 232; pp. 466-473 *ante*.

satisfaction of the Court that the alleged infringer, dealing with what he is doing as a matter of substance, is taking the invention claimed by the patent, not the invention which the patentee might have claimed if he had been well advised or bolder, but that which he has in fact and substance claimed on a fair construction of the specification.^(c)

It is sometimes stated that the Court is bound by the construction put upon the specification by a Court of equal or superior jurisdiction in prior proceedings, but this statement is only partially true. When it is a matter of pure construction of the document itself, and the construction is not dependent upon a consideration of the external facts as to prior knowledge, the Court, as a matter of convenience to itself, follows the construction adopted by a Court of equal jurisdiction;^(d) but whether the claim is too wide is a question of fact which must be decided *de novo* in the light of any fresh evidence as to the state of public knowledge which may be adduced in any subsequent action.^(e)

The fact that the defendant has himself obtained a patent for what he is doing, is in itself no evidence of infringement, and the defendant is not placed thereby in any different position to any other member of the public. The question is what he has in fact done.^(f)

It must be proved strictly that the alleged infringing article was not made by the plaintiff, or any agent or licensee of the plaintiff.^(g) Where the plaintiff omits to give this necessary evidence and merely proves the sale of the article by the defendant, an opportunity may be given him of perfecting the evidence, if he is able to do so, after his case is closed.^(h) Care must, therefore, be taken, in collecting evidence of infringement, that the article relied on as proof of infringement was not made by the alleged infringer under such circumstances that he can contend that what he did was as agent of the plaintiff and therefore no infringement. Thus when a patentee for the purpose of getting evidence of infringement sent an agent to a manufacturer and ordered an article to be made in a particular way which was within the patent, and then, after obtaining it, moved for an interim injunction, the Court dismissed the motion

Evidence.

Effect of prior construction of the specification by a Court of equal jurisdiction.

Defendant himself a patentee.

Evidence must be given to the effect that the alleged infringement was not committed by an agent or under the licence of the patentee.

(c) Per Romer, J., *Nobel's Explosives Co. v. Anderson*, (1894) 11 R. P. C. 128.

(d) *Edison v. Holland*, (1889) 6 R. P. C. 276; *Automatic Weighing Machine Co. v. Knight*, (1889) 6 R. P. C. 367.

(e) *Ibid.*

(f) *Tweeddale v. Ashworth*, (1890) 7 R. P. C. 431.

(g) *Betts v. Willmott*, (1871) L. R. 6 Ch. 239; 25 L. T. N. S. 181.

(h) *Farbentabriken vorm F. Bayer v. Bowker*, (1891) 8 R. P. C. 389.

Evidence. with costs on the ground that the defendant, having worked to the detailed orders of the plaintiff's agent, was not liable as an infringer.⁽ⁱ⁾

When it is sufficient for the plaintiff to make out a *prima facie* case of infringement.

There are many cases in which it is impossible to ascertain what it is the defendant has done. Under such circumstances the proper course is for the plaintiff to make out a *prima facie* case, and if the plaintiff makes out a *prima facie* case which the defendant does not venture to answer, the Court will conclude that the alleged wrongful acts have been done in the manner which the plaintiff or his witnesses believe.^(k) The defendant may, however, give evidence to show that what he has done does not amount to a user of the art protected by the patent. Thus he may prove that the articles complained of are substantially different to those described in the specification, or that they were manufactured according to a process different to that claimed by the patentee, and this will be a complete answer to the charge of infringement.^(l)

If the patent is for a process only and does not include the manufactured article, the *onus* is on the plaintiff to show that the article alleged to have been manufactured in infringement has, in fact, been so made.^(m) And similarly, if the patent is for the manufacture of any particular machine, the sale of an article made by the machine might be no proof of infringement.

If the plaintiff proves that the defendant has without authority⁽ⁿ⁾ sold a patented article he makes out a *prima facie* case of infringement, and throws the *onus* on the defendant of showing either that he was a licensee of the plaintiff, or that he bought the article from a person who was authorised by the plaintiff to manufacture and sell it.^(o)

Evidence that a defendant gave an order in England, which order was executed in England, for the manufacture by a patented process of articles which were afterwards received by him, is quite sufficient to satisfy an allegation that he made those articles; for he that causes and procures things to be made may well be said to have made them himself.^(p)

⁽ⁱ⁾ Kelly v. Batchelor, (1893) 10 R. P. C. 289.

^(k) Huddart v. Grimshaw, (1803) Dav. P. C. 265; Hall v. Jarvis, (1822) 1 W. P. C. 100; Badische Anilin und Soda Fabrik v. Dawson, (1889) 6 R. P. C. 387, 396; Edison v. Woodhouse, judgment of Butt, J., (1886) 3 R. P. C. 167.

^(l) Morgan v. Seaward, (1837) 1 W. P. C. 171; Walton v. Potter, (1841) 1 W. P. C. 585, 589.

^(m) Palmer v. Wagstaffe, (1853) 8 Exch. R. 840; 22 L. J. N. S. Ex. 295; 9 Exch. R. 449; 23 L. J. N. S. Ex. 217.

⁽ⁿ⁾ Betts v. Willmott, (1870) L. R. 6 Ch. 239.

^(o) Badische Anilin und Soda Fabrik v. Dawson, (1889) 6 R. P. C. 387, 396; Gibson v. Brand, (1841) 1 W. P. C. 630.

^(p) Gibson v. Brand, (1841) 1 W. P. C. 631.

And in the absence of evidence to the effect that articles complained of may have been manufactured by a process different to that comprised in the patent, (q) the following facts are *prima facie* evidence of infringement: similarity of structure in the patented article and the things produced by the defendant where a trade secret is alleged and there has been no inspection by the plaintiff; (r) the offering for sale of an article in the state produced by the application of a patented machine where it is proved that the defendant had one such machine in his possession. (s)

Trial.

Under some circumstances, however, the *onus* is on the plaintiff of proving not merely the sale of the patented article, but further that it was not manufactured by himself or under his authority, *e.g.*, where a patentee has manufactories both in England and abroad. (t)

When a plaintiff must prove that an alleged infringing article was not made under his authority.

Where the defence was that the alleged infringement was an exercise by the defendant of a secret process he was allowed to refuse to answer questions on cross-examination which might disclose his process, and, at his election, evidence was taken *in camera* of what the alleged secret process really was, and the shorthand notes of such evidence were ordered to be impounded in Court until there should be an appeal, or until further order. (u)

Defence that an alleged infringement is a secret process.

The Patents Act, 1883, contains special provisions with regard to the giving in evidence of, and the effect as evidence of, the seal of the Patent Office, (x) the Register of Patents, (y) Patent Office copies and certificates of specifications, disclaimers, and other documents or extracts from them, (z) and orders and certificates made by the Board of Trade. (a)

Special provisions of the Act of 1883.

TRIAL.

Action for infringements of patents may be brought in either division of the High Court of Justice, or in the Court of the County Palatine of Lancaster. The County Courts have no jurisdiction to

Jurisdiction of the Courts.

(q) *The Cartsburn Sugar Refining Co. v. Sharp*, (1884) 1 R. P. C. 181, 186.

(r) *Huddart v. Grimshaw*, (1803) 1 W. P. C. 91; *Davenport v. Richard*, (1860) 3 L. T. N. S. 503.

(s) *Hall v. Jarvis*, (1822) 1 W. P. C. 100.

(t) *Betts v. Willmott*, (1870) L. R. 6 Ch. App. Cas. 239; *Société Anonyme*,

&c. *v. Tilghman's, &c., Co.*, (1883) L. R. 25 Ch. D. 1.

(u) *Badische Anilin und Soda Fabrik v. Levinstein*, (1883) L. R. 24 Ch. D. 156, 170.

(x) s. 12, sub-ss. 2 and 3.

(y) s. 23, sub-s. 2.

(z) ss. 89 and 96.

(a) s. 102, sub-ss. 2 and 3; also Act of 1888, s. 25.

Trial.

entertain an action in which the validity of the patent is in question, because a patent is a franchise and under s. 56 of the County Courts Act, 1888, a County Court has no cognisance of any action in which the title to any franchise is in question. Moreover a special jurisdiction was given to the High Court by ss. 28, 29, and 117, of the Patents Act, 1883, and it cannot be contended that the later County Courts Act 1888 gave to County Courts an open jurisdiction in such actions.(b)

It is submitted that an action to recover royalties amounting to not more than fifty pounds could be brought in a County Court, notwithstanding the fact that the ambit of the claim may be disputed by a licensee.(c)

Arbitration.

The provisions of the Arbitration Act 1889 apply to patent actions equally as to other actions.

Trial is usually by the Court alone.

Infringement actions are tried without a jury unless the Court directs otherwise.(d)

Patent actions are in rare cases tried by jury.

As a rule, patent actions do not require the intervention of a jury, and can be more satisfactorily disposed of by a Judge alone.(e) In the words of Lord *Selborne*, L.C.,(f) "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, 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."

e.g., where there is

An allegation of fraud may induce the Court to accede to a request for a jury. Thus in a case where the plaintiff opened

(b) *R. v. Judge of County Court of Halifax*, (1891) 8 R. P. C. 338.

(c) *Cutlan v. Dawson*, (1896) 13 R. P. C. 710; 14 R. P. C. 249.

(d) 46 & 47 Vict. c. 57, s. 28.

(e) *Bovill v. Hitchcock*, (1868) L.

R. 3 Ch. 417; *Young v. Fernie*, (1863) 1 De G. J. & S. 353; *Downes v. Hughes and Co.*, (1880) 69 L. T. 150; *Sugg v. Silber*, (1874) L. R. 1 Q. B. D. 362.

(f) *Patent Marine Inventions Co. v. Chadburn*, L. R. 16 Eq. 447.

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.^(g) Trial.
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an allegation of fraud.

Juries are rarely asked for now in patent cases, and it is submitted that only where there is an allegation of fraud would a jury be allowed.^(h)

Trial by jury cannot be had before a Judge of the Chancery Division of the High Court of Justice.⁽ⁱ⁾ 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 Court has power to, and on the request of either party it must, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance.^(k) Trial with the
aid of an
assessor.

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.^(l)

Before the repeal of Lord Cairns' Act ^(m) and Sir John Rolt's Act,⁽ⁿ⁾ 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,^(o) the jurisdiction which they established is not abolished,^(p) but is exercised by both divisions of the High Court of Justice,^(q) though it is not usual to try the issues of validity and infringement on different occasions. Trial of issues
separately.

The Court has the power to order any issue of fact in a patent action to be tried before an official referee,^(r) and to order a trial without a jury of any cause, matter, or issue requiring any prolonged examination of documents or accounts,

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

^(h) Since the Act of 1883 there are only four patent actions reported as having been tried with a jury—viz., *Young v. Rosenthal*, (1884) 1 R. P. C. 29; *Westinghouse v. Lancashire and Yorkshire Ry. Co.*, (1884) 1 R. P. C. 229; *Edge v. Harrison*, (1891) 8 R. P. C. 74; *Westley v. Tolley*, (1894) 11 R. P. C. 602.

⁽ⁱ⁾ *Warner v. Murdoch*, (1877) L. R. 4 Ch. D. 750.

^(k) 46 & 47 Vict. c. 57, s. 28.

^(l) 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.

^(m) 21 & 22 Vict. c. 27.

⁽ⁿ⁾ 25 & 26 Vict. c. 42.

^(o) 46 & 47 Vict. c. 49.

^(p) *Sayers v. Collyer*, (1884) L. R. 28 Ch. D. 103, 108.

^(q) 46 & 47 Vict. c. 57, s. 117.

^(r) 36 & 37 Vict. c. 66, s. 57; *Saxby v. Gloucester Waggon Co.*, W. N. 1880, p. 28.

Trial.
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or any scientific or local examination which cannot, in the opinion of the Court or a Judge, be tried with a jury,^(s) 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.^(t)

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;^(u) but issues will not be directed unless the Court is satisfied that there is a real question to try,^(x) and most probably not at all, if the motion is opposed by the plaintiff,^(y) or is made after the disclosure of the plaintiff's evidence.^(z)

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 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.^(a)

And, subject to the provisions of the first seven rules of Order XXXVI. of R. S. C. 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.^(b)

The Court of Appeal will not readily interfere with a decision of the Court below as to the mode of trial.^(c)

(s) R. S. C. 1883, Ord. xxxvi. r. 5.

(t) R. S. C. 1883, Ord. xxxvi. r. 7 a.

(u) R. S. C. 1883, Ord. xxxiii. r. 1; see Seeton on Decrees, 4th ed. p. 347, for the form of issues.

(x) *Davenport v. Phillipps*, (1865) 5 N. R. 485.

(y) *Henderson v. The Runcorn Soap and Alkali Co.*, W. N. 1868, p. 250; 19 L. T. N. S. 377.

(z) *Roskell v. Whitworth*, (1870) L. R. 5 Ch. App. Cas. 459.

(a) R. S. C. 1883, Ord. xxxiv. r. 2.

(b) R. S. C. 1883, Ord. xxxvi. r. 8.

(c) *Bovill v. Hitchcock*, (1868) L. R. 3 Ch. App. Cas. 417; *Brooke v. Wigg*, (1878) L. R. 8 Ch. D. 510, 517; *Williams v. Guest*, (1875) L. R. 10 Ch. App. Cas. 467; *Ruston v. Tobin*, (1878) L. R. 10 Ch. D. 558; *Hunt v. Chambers*, (1882) L. R. 20 Ch. D. 365; *Wharton v. Boffin*, W. N. 1883, p. 96; *Saxby v. Gloucester Waggon Co.*, W. N. 1880, p. 28.

It is generally highly inconvenient to try the issues in a patent action separately or before different tribunals,^(d) but sometimes great expense may be saved to the litigants by adopting this course.^(e) 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.^(f)

Trial.
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 Advantages of
 separate trial
 of issues.

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; ^(g) 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.^(h) 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 specification, 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.⁽ⁱ⁾ 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 at once his evidence of such prior use, and the action was dismissed.^(k)

It is enacted by s. 56 of the Judicature Act of 1873 that, 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.

Reference to a
 referee.

This power was exercised by *Pearson, J.*, in *Badische Anilin*

^(d) *Young v. Fernie*, (1863) 1 De G. J. & S. 353.

^(e) *Kurtz v. Spence*, (1888) 5 R. P. C. 170; *Muirhead v. Commercial Cable Co.*, (1894) 11 R. P. C. 323.

^(f) *United Telephone Co. v. Motershead*, (1886) 3 R. P. C. 213.

^(g) *The Republic of Bolivia v. The*

National Bolivian Navigation Co., (1876) 24 W. R. 361.

^(h) *Richardson v. Castrey*, (1887) 4 R. P. C. 265.

⁽ⁱ⁾ *Bovill v. Goodier*, (1866) L. R. 2 Eq. 195.

^(k) *Badham v. Bird*, (1888) 5 R. P. C. 238.

Trial.

und Soda Fabrik v. Levinstein,^(l) 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*,^(m) where it was ordered that a special referee should make experiments to test the capability of a certain machine to cut brushes; by *Kay, J.*, in *Edison v. Holland*,⁽ⁿ⁾ 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; and by *Romer, J.*, in *North British Rubber Co. v. Macintosh*^(o) where a reference to an independent expert was ordered on points on which the evidence was directly in conflict. The expert is in such a case usually furnished by the direction of the Court with printed shorthand notes, has access to all the exhibits, and is to be at liberty to make such experiments as he may think desirable. Counsel are at liberty to make observations on the expert's report and the expert then reads the observations and advises the Court.

In certain cases a sufficiently qualified expert could only be found amongst a class of persons who would be likely to have a bias against the patent—*e.g.*, rival manufacturers—and these circumstances induce the Court to forego the assistance of an independent expert in such cases.^(p)

Trial at
assizes.

Any party to any cause or matter involving the trial of a question or issue of fact, or partly of fact and partly of law, may, with the leave of the Judge or Judges to 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.^(q)

The rules^(r) also empower the Court to send an action for trial at assizes with the object of getting an early trial whenever on an application before trial for an injunction or other order it appears that the matter in controversy is one which can be most conveniently dealt with by an early trial without first going into the whole merits on affidavit or other evidence for the purpose of the application.

To whatever division of the High Court an action may be

^(l) (1883) L. R. 24 Ch. D. 156.

^(m) (1884) 1 R. P. C. 129, 133.

⁽ⁿ⁾ (1888) 5 R. P. C. 459, 479.

^(o) (1894) 11 R. P. C. 477.

^(p) *Badische Anilin und Soda Fabrik v. La Société des Usines du Rhône*, (1897) 14 R. P. C. 891.

^(q) 36 & 37 Vict. c. 66, s. 29. The

following actions were tried at assizes: *Miller v. Searle*, (1893) 10 R. P. C. 106; *Legge v. Wakelan*, (1893) 10 R. P. C. 379; *Allen v. Duckett*, (1893) 10 R. P. C. 397; *Allen v. Horton*, (1893) 10 R. P. C. 412; *Westley v. Tolley*, (1894) 11 R. P. C. 602.

^(r) S. C. R. (1883) Ord. l. r. 1a.

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.(s)

Trial.
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Actions set down for trial in the Chancery Division may, upon the application of the plaintiff, even without the consent of the defendant, by order of the Court be advanced out of their turn for hearing if a proper reason be shown—*e.g.*, that delay would cause the loss of the object of the action.(t)

Acceleration
of trial.

Where a plaintiff patentee of a chemical dye applied for the acceleration of the trial on the ground that new dyes were being continuously introduced and the trade in the patented dye could not be relied upon for long, and the defendant was offering the alleged infringing goods at reduced prices to the consequent detriment of the plaintiff's trade, the Court refused to expedite the trial for the reason that, if the plaintiff's case was well founded, he could get compensation in damages, and there was no ground, therefore, for giving him priority over other suitors.(u)

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.(x) 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.(y)

Motion for
judgment on
determination
of a separate
issue.

(s) *Fairbairn v. Household*, (1885) 2 R. P. C. 195.

(t) S. C. R., (1883) Ord. 36, r. 16 n.

(u) *Farbenfabriken vorm. F. Bayer & Co. v. Bowker*, (1890) 8 R. P. C. 136.

(x) R. S. C. (1883) Ord. xl. r. 7.

(y) R. S. C. (1833) Ord. xl. r. 8; *Fernie v. Young*, (1866) L. R. 1 H. L. 63; *Macdougall v. General Sewage and Manure Co.*, (1875) W. N. 64; *Tangye v. Stott*, (1865) 14 W. R. 386.

Trial.

Motion for judgment on an admission 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 make such order, or give such judgment, as the Court or Judge may think fit.^(z) 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.^(a)

Judgment when a defendant does not appear.

If the defendant do not appear, the plaintiff may on motion obtain judgment and the usual certificates upon formal proof of his title and the fact of infringement.^(b) In one case where judgment went by default the Court refused to hear counsel on behalf of the defendant in another pending action on the same patent in which an order had been made that the first action should be treated as a test case and the judgment should bind the parties to the second action.^(c) The defendant to the second action could no doubt under such circumstances get the order set aside upon proper motion to the Court.

When there are two defendants—*e.g.*, the manufacturer and a user, and one—*e.g.*, the user—puts in no defence and refuses to submit to judgment, the Court will not give leave to the plaintiff to set down the action on motion for judgment against such defendant, because the other defendant may be able to prove the patent void, in which case the first defendant would be entitled to the benefit of the decision.^(d)

Judgment by consent.

If judgment is obtained by consent against a defendant, such defendant may withdraw his consent before the judgment has been entered, but he will not, except under very special circumstances, be allowed to do so, when he has stated that he will not require evidence to be filed in support of the plaintiff's application, and then seeks to allege a mistake of fact with regard to infringement.^(e)

Certificates

At the conclusion of the trial counsel on behalf of the

^(z) R. S. C. (1883) Ord. xxxii. r. 6.

^(a) United Telephone Co. v. Donohoe, (1886) L. R. 31 Ch. D. 399.

^(b) Pneumatic Tyre Co. v. Chisholm, (1896) 13 R. P. C. 488; Edison United Phonograph Co. v. Young, (1894) 11 R. P. C. 489. Surprise may be a ground for a new trial: Incandescent

Gas Light Co. v. New Incandescent Mantle Co., (1897) 15 R. P. C. 81.

^(c) Edison United Phonograph Co. v. Young, (1894) 11 R. P. C. 489.

^(d) Actien Gesellschaft für Carton-nagen Industrie v. Remus, (1895) 12 R. P. C. 94.

^(e) Pneumatic Tyre Co. v. Cash Cycle Co., (1897) 14 R. P. C. 177, 326.

successful party should not omit to ask the Judge to certify that the validity of the patent came in question if the plaintiff succeeds and also that the particulars were reasonable and proper. These certificates are most important on taxation. *(f)*

Consolidation of Actions.

should be asked for at the conclusion of the trial.

Documents and evidence not actually produced and given at the trial should not be inserted in the minutes of judgment. *(g)*

CONSOLIDATION OF ACTIONS.

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; *(h)* 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. *(i)*

Actions may be consolidated,

Actions can only be consolidated at the instance of the defendants, *(k)* 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. *(l)*

but only at the instance of the defendants.

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. *(m)*

Several actions by different plaintiffs against the same defendant.

It was held at Common Law that a consolidation could be made as soon as the defendants had appeared, and before declaration; *(n)* 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. *(o)*

Time when a consolidation order can be made.

(f) pp. 617-621 *post*.

(g) *Shoe Machinery Co. v. Cutlan* (2), (1896) 13 R. P. C. 395.

(h) *Foxwell v. Webster*, (1863) 4 De G. J. & S. 77; *Edison-Bell Phonograph Corporation v. Smith*, (1894), 11 R. P. C. 148, 389.

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

(k) *Lush's Practice*, 3rd ed. 965;

Amos v. Chadwick, (1876) L. R. 4 Ch. D. 869.

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

(m) *Amos v. Chadwick*, (1876) L. R. 4 Ch. D. 869; *Bennett v. Lord Bury*, (1880) L. R. 5 C. P. D. 339.

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

(o) *Thomas v. Winter*, (1867) 17 L. T. N. S. 148.

NEW TRIAL.

Procedure to
obtain a 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 accordingly, the proper procedure is, if the action was tried with a jury, to apply by motion to the Court of Appeal; and, if the action was tried without a jury, the procedure is by appeal to the Court of Appeal.(p)

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.(q)

APPEAL.

Procedure.

All appeals to the Court of Appeal must be by way of rehearing,(r) 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.(s)

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.(t)

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.(u)

(p) R. S. C. (1883) Ord. xxxix. r. 1; *Hunt v. City of London Real Property Co.*, (1877) L. R. 3 Q. B. D. 19; *Edison v. Shippey*, (1887) 4 R. P. C. 473.

(q) *Flower v. Lloyd*, (1877) L. R. 6 Ch. D. 297.

(r) As to the effect of a finding of fact by the Judge of First Instance on the Court of Appeal see *Haggemacher v. Watson*, (1897) 14 R. P. C.

634, judgment of Esher, M.R.; see also p. 592 *post*.

(s) R. S. C. (1883) Ord. lviii. r. 1. As to service of notice of motion, and time within which appeals are allowed, see R. S. C. (1883) Ord. lviii. r. 2-19.

(t) R. S. C. (1883) Ord. lviii. rr. 6 and 7.

(u) R. S. C. (1883) Ord. lviii. r. 5.

Power of
Court of
Appeal to
order a new
trial.

An appellant may be ordered to give security for the costs of the appeal;^(x) and if such security is not given within a reasonable time, an order will, in the absence of extenuating circumstances, be made for the immediate dismissal of the appeal.^(y)

Appeal.
Security for costs of appeal.

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.^(z)

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,^(a) but on giving security for costs in such a case he is entitled to proceed with the appeal.^(b)

The appellant a bankrupt.

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.^(c)

The Court of Appeal has power to admit evidence not given in the Court below, and may allow an amendment of the particulars for this purpose,^(d) or in its discretion admit the fresh evidence, though it is not within the particulars originally delivered, without ordering an amendment of such particulars.^(e)

Fresh evidence on appeal.

If the defendant's witnesses at the trial give evidence of anticipations not within the particulars, and the plaintiff chooses not to ask for an adjournment to consider them, the Court of Appeal will not allow such evidence to be adduced by the plaintiff with regard to them.^(f) And if the defendant in the Court below does not call evidence, but elects to rest his case on the admissions of the plaintiff's witnesses, the Court of Appeal will refuse to allow him to call fresh evidence for the purpose of making out a case, which, in the opinion of the Court of Appeal differing from the Judge below, was not substantiated by such admissions.^(g)

If a party in the Court below abandons an issue, the Court of Appeal will not allow it to be raised on appeal. Thus, where the plaintiff's witnesses admitted in the Court below that, if an alleged anticipation was in fact made prior to the

Issues abandoned below.

(x) R. S. C. (1883) Ord. lviii. r. 15.

(y) Washburn and Moen Manufacturing Co. v. Patterson, (1885) L. R. 29 Ch. D. 48.

(z) Garrard v. Edge, (1890) 7 R. P. C. 139.

(a) United Telephone Co. v. Bassano, (1886) L. R. 31 Ch. D. 630.

(b) *Ibid.*

(c) Walker v. Hydrocarbon Syndicate, 3 R. P. C. 253.

(d) pp. 512, 528 *ante*.

(e) pp. 527, 528 *ante*.

(f) Barcroft v. Smith, (1897) 14 R. P. C. 172.

(g) Lancashire Explosives Co. v. Roburite Explosives Co., (1895) 12 R. P. C. 470, 480.

Appeal.

patent as stated, it was a complete anticipation, and the plaintiff fought the case solely on the contention that the alleged anticipating machine was in fact not made, and at the same time charged the defendant with fraudulently altering it as originally constructed, the Court of Appeal refused to allow the appellant plaintiff to raise the question that though the alleged anticipation in question was made as stated yet it was no anticipation in fact, and dismissed the appeal with costs.^(h)

Particulars of objection when appeal is in respect of infringement only.

Notwithstanding that the only question on appeal is the issue of infringement, the Appellate Court will consider the particulars of objection for the purpose of ascertaining the state of public knowledge at the date of the patent whereby to properly construe the ambit of the patentee's claim.⁽ⁱ⁾

Decisions on facts as well as law may be reversed on appeal.

There is no presumption that the Court of Appeal or the House of Lords ought not to interfere with what the Judge of First Instance has done with regard to matters of fact; but, on the contrary, the Appellate Court, in which both fact and law are open to review, is bound to pronounce such judgment as, in their view, ought to have been pronounced by the lower Court; and it is not competent to the Appellate Court to say that they would have pronounced a different judgment, if they had been Judges of First Instance, but because the Judge has pronounced a certain judgment they will adhere to his decision.^(k)

Decision of several points when one is sufficient.

In *Parkinson v. Simon*,^(l) the Court of Appeal stated a rule to the effect that when two distinct points have been argued in the Court below, and the Court of Appeal is obliged to dismiss the appeal on a consideration of one point alone, yet to render further litigation between the parties more unlikely the Court will give a decision on the other point also. In the same case, however, the House of Lords^(m) dismissed the appeal on the same ground as the Court of Appeal, but declined to express any opinion on the second point, and did not call upon the respondent's counsel to argue it. And during the argument their Lordships stated that the practice of giving decisions (which only amount to *dicta*) on issues not necessary to decide on appeal is not to be recommended, and will not be adopted by their Lordships' House.

^(h) *Westly, Richards and Co. v. Perkes*, (1893) 10 R. P. C. 181, 382.

⁽ⁱ⁾ *Morris v. Young*, (1895) 12 R. P. C. 455.

^(k) *Rickmann v. Thierry*, (1897) 14 R. P. C. 105; but see *Haggenmacher*

v. Watson, (1897) 14 R. P. C. 634, judgment of Esher, M.R.

^(l) (1895) 11 R. P. C. 493; *Deeley's Patent*, (1896) 12 R. P. C. 192, 197.

^(m) 12 R. P. C. 403.

A decision of the Court of First Instance may be reversed by the Court of Appeal, notwithstanding the absence of a respondent who does not appear at the hearing in the Appellate Court.⁽ⁿ⁾ Perpetual Injunction.

PERPETUAL INJUNCTION.

If at the trial of an action the plaintiff succeeds in conclusively^(o) proving that the defendant has infringed, and the validity of the patent is established, one of the remedies to which he is usually entitled is a perpetual injunction restraining the defendant from repeating the acts complained of during the continuance of the monopoly. And where the defendant is desirous and willing to consent to a perpetual injunction without bringing the action to a trial, it may be obtained, by the consent of both parties, on the hearing of the motion,^(p) or by summons in chambers.^(q) A defendant is entitled to withdraw his consent to a perpetual injunction if it was given under mistake or surprise.^(r) Successful plaintiff is usually entitled to a perpetual injunction.
Injunction by consent.

The Court does not invariably grant an injunction on proof of an invasion of the plaintiff's rights under the patent. An injunction does not in such circumstances follow as matter of course, but is in the discretion of the Court.^(s) Injunction is not a matter of course.

Acquiescence on the part of the plaintiff may induce the Court to refuse an injunction and merely grant damages, or an account of profits.^(t) Acquiescence.

Though *laches* may disentitle a plaintiff to an interlocutory injunction,^(u) yet delay to enforce a legal right does not prevent a person from bringing an action, provided it does not cause a statutory bar;^(x) and, consequently, delay or acquiescence, which would prevent the plaintiff from succeeding on an interlocutory application, may be no bar to his right to a perpetual injunction at the trial,^(y) and to damages or an account.^(z) *Laches.*

⁽ⁿ⁾ *Pneumatic Tyre Co. v. Casswell*, (1896) 13 R. P. C. 375.

^(o) *Hill v. Evans*, (1862) 4 De G. F. & J. 288.

^(p) *Morrell v. Pearson*, (1849) 12 Beav. 284.

^(q) 46 & 47 Vict. c. 57, s. 30; *Judic. Act*, (1873) s. 39; *Freason v. Loe*, (1877) 26 W. R. 138.

^(r) *Elsas v. Williams*, (1884) 1 Times Rep. 144.

^(s) *Betts v. De Vitre*, (1864) 11 Jur. N. S. 9; *Geary v. Norten*, 1 De G. & S. 4; *Proctor v. Bayley*, (1889) 6 R. P. C. 538; *Lyon v. Goddard*, (1893) 10 R. P. C. 135; *Jenkins v. Hope*,

(1895) 13 R. P. C. 57; *Scott v. Hull Steam Fishing and Ice Co.*, (1897) 14 R. P. C. 143.

^(t) *Sayers v. Collyer*, (1885) L. R. 28 Ch. D. 103. ^(u) p. 506 *ante*.

^(x) *Three Towers Banking Co. v. Maddever*, (1884) L. R. 27 Ch. D. 523; *Wood v. Lambert*, (1886) 3 R. P. C. 84.

^(y) *Fullwood v. Fullwood*, (1878) L. R. 9 Ch. D. 176; *Johnson v. Wyatt*, (1863) 2 De G. J. & S. 18, 25; *Proctor v. Bennis*, (1887) L. R. 36 Ch. D. 740; *Bacon v. Spottiswoode*, (1839) 1 Beav. 382.

^(z) *Bovill v. Crate*, (1865) L. R. 1 Eq. 388.

Perpetual Injunction.

Expiry of the patent before conclusion of the action.

Generally speaking, the Court will not grant an injunction if the patent has expired before the commencement or during the course of an action; (a) but where it appeared that the patent would expire in a few days, and that the defendant had piratically manufactured a large stock of the patented article ready to throw on the market as soon as the monopoly was at an end, *Lyndhurst, L.C.*, granted an injunction to restrain the sale of such articles both before and after the term limited by the grant of the patent. (b)

Absence of evidence of an intention to continue infringements.

Also, if the defendant has committed only one act of infringement and there is no evidence of an intention on his part to infringe again, the Court does not usually grant the plaintiff an injunction. Thus, where it was proved that the defendant was guilty of only one act of user, and the Judge was satisfied that the defendant had no intention of infringing again, the Court did not grant an injunction, but awarded a small sum by way of damages and gave the plaintiff liberty to apply for an injunction in case of necessity thereafter. (c) And where the defendant refused to submit to an injunction, but after writ issued and before statement of claim delivered offered to account for the profits made by the sale of infringing articles, to deliver up all such in his possession, to give a perpetual undertaking not to infringe, and to pay costs of the action, the Court held that the plaintiff was entitled to have his legal right recognised, but considering the smallness of the matter the defendant's undertaking not to manufacture or sell was sufficient and no injunction was granted, and the Court made certain provisions as to the costs of the action. (d)

Where, after the plaintiff had obtained an interlocutory injunction, the defendant removed the alleged infringing parts from a machine, the plaintiff, at the trial, was awarded a perpetual injunction together with an account of profits and costs, on the ground that the defendant, had, in fact, infringed, and had not submitted on the hearing of the interlocutory motion to the relief which the plaintiff asked for. (e)

Certain in-

When an injunction is granted, if in the interests of justice

(a) *Betts v. Gallais*, (1870) L. R. 10 Eq. 392; *Davenport v. Rylands*, (1865) L. R. 1 Eq. 302; 35 L. J. Ch. 204; *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.*, (1858) 4 K. & J. 727; *Smith v. L. & S. W. Ry. Co.*, (1854) Macr. P. C. 209; 23 L. J. Ch. 562.

(b) *Crossley v. Beverley*, (1829) 3

Car. & P. 513; 1 Russ. & M. 166 n; 1 W. P. C. 106.

(c) *Scott v. Hull Steam Fishing and Ice Co.*, (1897) 14 R. P. C. 143.

(d) *Jenkins v. Hope*, (1895) 13 R. P. C. 57.

(e) *Edison-Bell Phonograph Corporation v. London Phonograph Co.*, (1894) 11 R. P. C. 471.