

Perpetual Injunction.

ance with the maxim, *nemo debet bis vexari pro una et eadem causa* (s). It is to be observed that there is a distinction between the procedure on attachment and committal. In the latter, which is the appropriate remedy when a defendant has done something which the Court has ordered him not to do and therefore applies to breach of an injunction in a patent case, service of the order is not absolutely necessary, and a defendant may be committed if the Court is satisfied that the order was brought to his knowledge, although not formally served upon him. In the case of attachment, which is the appropriate remedy where a defendant has failed to do something which the Court ordered him to do, the procedure requires the service of the order by producing the original or an office copy, and leaving an accurate copy with the person served (t).

The following circumstances illustrate the necessity for accurate proof of the fact of infringement. An injunction was granted, and the defendant undertook to continue a previous undertaking not to part with infringing articles in his possession or under his control in this country, and the plaintiff on motion to commit failed to show that certain articles alleged to have been parted with, in breach of the undertaking, were, in fact, in the possession of, or under the control of, the defendant on the date on which the injunction was obtained, the Court refused an order for committal, but gave no costs, on the ground that the circumstances were suspicious and the plaintiff was justified in bringing on the motion (u).

Breach of injunction may under certain circumstances be justifiable.

There may be cases in which a breach of an injunction of the Court is not only justifiable but a positive duty. Thus, *James, L.J.*, in reference to a case in which the majority of the Court of Appeal confirmed an injunction restraining the master of a ship from using certain patented pumps, with which the ship was exclusively fitted, said: "In the absence of the owners it appears to me that the Court could not make a mandatory injunction as to the equipment of the ship. And, that being so, I cannot concur in granting an injunction

(s) See, *e.g.*, *Badische Anilin und Soda Fabrik v. Thompson* (1904), 21 R. P. C. 469.

(t) R. S. C. (1883), Ord. lxxvii. r. 1; see also *Re Holt* (1879), L. R. 11 Ch.

D. 168; *Incandescent Gas Light Co. v. Sluce* (1900), 17 R. P. C. 173.

(u) *Edison-Bell Phonograph Co. v. Smith* (1894), 11 R. P. C. 164.

to restrain the master from doing what it appears to me to be his plain duty to do. Whatever appliances there may happen to be on board, however they came there—pumps, anchors, fire extinguishers, stolen or not stolen, pirated or not pirated—it is his bounden duty to use them according to the exigencies of navigation for the safety of ship, cargo, and life. To the master when out at sea (injunction or no injunction) *salus navis est suprema lex*. And, for myself, I believe that a master would be practically as safe in disobeying an injunction under a pressing emergency as he would be in shooting a mutineer. And in my opinion, if a single life was lost through the master's neglect to use such appliances, the injunction would be no defence to an indictment for manslaughter" (x).

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It is doubtful whether, on a motion for sequestration against a company and committal against the directors for breach of a perpetual injunction, the Court has power to order an account of profits or the delivering up of the infringing articles (y).

It is a complete answer to a motion for committal for breach of a perpetual injunction restraining infringements of a patent to show that, since the injunction, the patent has expired, and that the acts complained of were done subsequently to such expiration (z), or that, since the injunction was granted, the specification has been amended and so the injunction has become inoperative (a).

Answers to a motion for committal.

When the defendant after injunction does something different to what he did before injunction, and the plaintiff wishes to restrain him on the ground that in the opinion of the plaintiff it is an infringement, the usual way to raise the question is by motion to commit (b), or in the case of a limited company sequestration against the company and attachment against the directors (c). In one such case, where it appeared that the article complained of was different

Acts done since injunction granted, which are different in nature though similar to those in respect of which the injunction was granted.

(x) *Adair v. Young* (1879), L. R. 12 Ch. D. 21; see also *Basset v. Graydon* (1897), 14 R. P. C. 701.

(y) *Spencer v. The Ancoats Vale Rubber Co.* (1889), 6 R. P. C. 67.

(z) *Daw v. Eley* (1867), L. R. 3 Eq. 497.

(a) *Dudgeon v. Thompson* (1879), L. R. 3 App. Cas. 34.

(b) *Plimpton v. Spiller* (1877), L. R.

4 Ch. D. 286; *Lancashire Explosives Co. v. Roburite Explosives Co.* (1896), 13 R. P. C. 435; *Davidson v. Sun Fan Co., Ltd.* (1906), 23 R. P. C. 493.

(c) *Hattersley v. Hodgson* (1904), 22 R. P. C. 229; *Meters, Ltd. v. Metropolitan Gas Meters, Ltd.* (1907), 24 R. P. C. 506; *Fox v. Astrachans, Ltd.* (1910), 27 R. P. C. 769.

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from that in respect of which the injunction was originally granted, the Court, being of opinion that the new article was also an infringement, but not deciding the question, did not make an order for committal, but, upon the plaintiff giving an undertaking as to damages, granted an injunction restraining the manufacture of the new article until further order, and this course was subsequently approved of by the Court of Appeal (*d*). In another case (*e*) the Court, taking the view that the alteration made by the defendants was still an infringement of the patent, made an order for sequestration against the defendant company. And in other cases (*f*) the Court dismissed the motion with costs on the ground that what the defendant did was no infringement.

Contempt of Court.

Any publication which tends to influence the result of a pending suit is reprehensible, and may involve the writer in the consequences of a contempt of Court (*g*); but if a party to the suit submits to have the matter discussed in the public papers and enters into the arena of public discussion he cannot afterwards complain that this has been done (*h*). It is not a contempt of Court to publish, after a judgment has been obtained, advertisements asking for evidence of the anticipation and publication of the subject-matter of the patent (*i*), or for subscriptions towards the expenses of an appeal (*k*). But it is a contempt for either party by advertisements to issue a representation of an *ex parte* statement of proceedings in Court for the purpose of his own profit (*l*).

Solicitor and client's costs.

Solicitor and client's costs may, on a motion to commit for breach of an injunction, be given to a successful plaintiff (*m*), but not to a successful respondent (*n*).

Where it appeared that the acts complained of had not been done vexatiously, but in the probable belief an erroneous one

(*d*) *Plimpton v. Spiller* (1876), L. R. 4 Ch. D. 286.

(*e*) *Hattersley v. Hodgson* (1904), 22 R. P. C. 229.

(*f*) *Lancashire Explosives Co. v. Roburite Explosives Co.* (1896), 13 R. P. C. 435; *Schermutz v. Pain* (1901), 18 R. P. C. 529.

(*g*) *Daw v. Eley* (1868), L. R. 7 Eq. 49; *In re Cheltenham and Swansea Railway Carriage and Wagon Works* (1869), L. R. 8 Eq. 580; *Brodribb v. Brodribb* (1886), L. R. 11 Pr. D. 66; *Butler v. Butler* (1888), L. R. 13 Pr.

D. 73.

(*h*) *Daw v. Eley* (1868), L. R. 7 Eq. 61; *British Vacuum Cleaner Co., Ltd. v. Suction Cleaners, Ltd.* (1904), 21 R. P. C. 300.

(*i*) *Plating Co. v. Farquharson* (1881), L. R. 17 Ch. D. 49.

(*k*) *Ibid.*

(*l*) *Edlin v. Pneumatic Tyre and Brook's Cycle Agency* (No. 2) (1893), 10 R. P. C. 317.

(*m*) *Plating Co. v. Farquharson* (1881), L. R. 17 Ch. D. 49.

(*n*) *Ibid.*

--that the defendants were entitled to do what they did, solicitor and client's costs were refused, but costs on the higher scale were given (*o*).

Account or
Damages—
General.

ACCOUNT OR DAMAGES.

General.—A plaintiff who succeeds in showing that his patent rights are valid and subsisting, and that they have been infringed, may be entitled, not only to an injunction restraining the defendant from continuing the infringements complained of, but also to an account of profits made by the defendant by means of his wrongful acts, or damages against him in respect of the infringements committed. In England the Court will not allow an inquiry as to damages or an account of profits to be prosecuted till the plaintiff has established his title to the patent and the fact of infringement (*p*), though this does not appear to be the invariable rule in Scotland (*q*).

Account or
damages may
be awarded to
a successful
plaintiff,

An inquiry as to damages and an account of profits are not reconcilable, for, if an account be taken of profits, the infringement is thereby condoned (*r*). A plaintiff therefore cannot have both an account and damages against the same defendant: he must choose one or the other (*s*), and this rule applies to every case of infringement (*t*).

but he cannot
have both
against the
same defen-
dant.

As regards different defendants to the same action, or to consolidated actions, the plaintiff may have an account of profits against one of such defendants and damages against the other (*u*). It has never been held that an account directed against a manufacturer of a patented article licenses the use of that article in the hands of all purchasers. The patent is a continuing patent, and there is no reason why the article should not be followed in every man's hand, until the in-

though he
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against one
defendant and
damages
against
another.

(*o*) *Spencer v. The Ancoats Vale Rubber Co.* (1889), 6 R. P. C. 46, 68.

(*p*) *De la Rue v. Dickinson* (1857), 3 K. & J. 388; *Rolls v. Isaacs* (1878), W. N. 37; *Fennessy v. Clark* (1888), L. R. 37 Ch. D. 184.

(*q*) See *Brown v. Evered* (1904), 21 R. P. C. 501.

(*r*) *Neilson v. Betts* (1871), L. R. 5 H. L. 22, per Lord Westbury.

(*s*) *Neilson v. Betts* (1871), L. R. 5 H. L. 22; *Watson v. Holliday* (1882),

30 W. R. 747; *Siddell v. Vickers* (1892), 9 R. P. C. 153, 162.

(*t*) *De Vitre v. Betts* (1873), L. R. 6 H. L. 319; *Vidi v. Smith* (1854), 3 E. & B. 969; *Holland v. Fox* (1854), 3 E. & B. 977.

(*u*) *Penn v. Bibby, Penn v. Fernie* (1866), L. R. 3 Eq. 308; 36 L. J. Ch. 277; *United Telephone Co. v. Walker* (1887), 4 R. P. C. 67; *Boyd v. Tootle Broadhurst, &c. Co.* (1894), 11 R. P. C. 175.

Account or Damages—General. fringement is got rid of. So long as the article is used, there is continuing damage (x).

When damages are preferable to an account of profits, and *vice versa*.

When the action is brought in the early days of the patent, before the patentee has established a course of dealing in the patented article, the successful plaintiff would probably prefer an account of profits, because of the difficulty he would, under such circumstances, have in showing the damage he has sustained by the wrongful acts of the defendant. On the other hand, as a rule, when the plaintiff has an established course of business in the patented article, it is more to his interest to elect to take damages in lieu of an account of profits, because of the great difficulty there always is in taking the account of profits due to the infringement of patent rights. Thus Lord *Lindley*, then *Lindley*, L.J., in *Siddell v. Vickers* (y), in stating his experience in matters of account used the following words of warning: "I do not know any form of account which is more difficult to work out, or may be more difficult to work out, than an account of profits. One sees it—and I personally have seen a good deal of it—in partnership cases, when the capital of a deceased or out-going partner has been left in the trade; an account has been directed of the profits made in respect of capital, which is something like the profits made in respect of an invention, and the difficulty of finding out how much profit is attributable to any one source is extremely great—so great that accounts in any form very seldom result in anything satisfactory to anybody. The litigation is enormous, the expense great, and the time consumed is out of all proportion to the advantage ultimately attained; so much so that in partnership cases, I confess, I never knew an account in that form worked out with satisfaction to anybody. I believe in almost every case people get tired of it, and get disgusted. Therefore, although the law is that a patentee has a right to elect which course he will take, as a matter of business he would generally be inclined to take an inquiry as to damages rather than launch upon an inquiry as to profits" (z).

(x) Per Page Wood, V.-C., *Penn v. Bibby*, *Penn v. Jack*, *Penn v. Fernie* (1866), L. R. 3 Eq. 308; 36 L. J. Ch. 277.

(y) (1892), 9 R. P. C. 162.

(z) See also *Crossley v. Derby Gas Co.* (1829), 1 W. P. C. 119; *Automatic Coal Gas Retort Co. v. Mayor, &c. of Salford* (1897), 14 R. P. C. 471.

There is a well-marked distinction between an account of profits and an inquiry as to damages, which must not be lost sight of in dealing with particular cases, and which arises from the fact that there is no necessary relationship between the two. Thus in some cases the greater the profit made by the infringer the less may be the damages sustained by the patentee, and in other cases the less the profit accruing to the infringer the greater the damage inflicted upon the patentee, *e.g.*, where the infringer undersells the patentee he may be satisfied with a very small profit with the object of ultimately getting the trade in his own hands, but the damage thereby inflicted upon the patentee may be very great (*a*).

Account or Damages—General.

Distinction between an account of profits and an inquiry as to damages.

Where a plaintiff is not desirous of taking an inquiry as to damages it is sometimes well for the parties to agree to an order for an inquiry as to what would be a proper royalty, and that such sum should be accepted in lieu of damages. Such a course may save endless expense and time as against an account of profits in the ordinary way (*b*).

Order by agreement for payment of a proper royalty is sometimes preferable to an account or damages.

An unexplained delay in bringing action may affect a plaintiff's right to an account of profits, or damages, if the circumstances are such as to establish leave and licence on the part of the plaintiff, or that the plaintiff stood by and knowingly allowed the defendant to proceed and expend money in ignorance of the fact that he had rights and meant to assert them (*c*). The effect may be to bar the plaintiff's right altogether (*d*), or limit it to damages or profits, made since the commencement of the action (*e*); for it is a principle of equity that a party who claims a right shall not lie by, and by his silence or acquiescence, induce another to go on expending his money and incurring risk, and afterwards, if profit be made, come and claim a share in that profit without having been exposed to the losses which might have been sustained (*f*).

Effect of delay in bringing the action.

(*a*) Per Chitty, J., *Howard v. Tweedale* (1896), 13 R. P. C. 214.

(*b*) *Automatic Coal Gas Retort Co. v. Mayor, &c. of Salford* (1897), 14 R. P. C. 471.

(*c*) *Proctor v. Bennis* (1887), 4 R. P. C. 330.

(*d*) *Ibid.*; and see *Crossley v. Derby Gas Co.* (1829), 1 W. P. C. 120; *Harrison v. Taylor* (1865), 11 Jur. N. S.

408; *Parrot v. Palmer* (1834), 3 M. & K. 632, 640.

(*e*) See *Sayers v. Coliyer* (1885), L. R. 28 Ch. D. 103; *Ford v. Foster* (1872), L. R. 7 Ch. App. Cas. 611, 627; *Beard v. Turner* (1866), 13 L. T. N. S. 746.

(*f*) *Crossley v. Derby Gas Co.* (1829), 1 W. P. C. 120; *Parrot v. Palmer* (1834), 3 M. & K. 640.

Account or Damages—General.

Account or damages may be awarded notwithstanding that the plaintiff is not entitled to an injunction.

An account of profits or an inquiry as to damages may now be had, notwithstanding the fact that the plaintiff is not entitled to an injunction, *e.g.*, where the action is commenced or judgment is delivered after the expiration of the patent (*g*), or there is proof of the infringement of at least one of several patents owned by the plaintiff and governing all known methods of production of a certain article but doubt as to the particular patent or patents infringed (*h*). Formerly the Court of Chancery acted upon the rule that the right to an account was ancillary to the right to an injunction, and if an injunction could not be granted, *e.g.*, if the patent had expired before (*i*), or during (*k*), the litigation, or there was no evidence of any intention on the part of the defendant to repeat the infringement (*l*), the plaintiff could not have an account (*m*), but must be left to his remedy at law, which consisted of damages (*n*), except in the case of fraud (*o*). Lord Cairns' Act empowered the Court of Chancery to award damages, and any Division of the High Court is now by that Act and the Judicature Act of 1873 and the Patents and Designs Act, 1907, entitled to award damages or grant an account of profits independently of any right on the part of the plaintiff to an injunction (*p*); but, of course, subject to the provisions of the Statute of Limitations. The Court of the County Palatine of Lancaster has now a similar jurisdiction (*q*).

Account of profits or inquiry as to damages usually goes up to the assessment.

When an account of profits or an inquiry as to damages is ordered the account or the inquiry, in the absence of provision to the contrary, extends to all infringements committed within six years before action brought (*r*) and goes up to the date of

(*g*) *British Insulated Wire Co. v. Dublin United Tramway Co.* (1899), 17 R. P. C. 14; *Kane v. J. Boyle & Co.* (1901), 18 R. P. C. 325; 21 & 22 Vict. c. 27, s. 2; 36 & 37 Vict. c. 66, s. 16.

(*h*) *Saccharin Corporation, Ltd. v. Quincy* (1900), 17 R. P. C. 337; but see p. 400, *ante*.

(*i*) *Smith v. G. W. Ry. Co.* (1854), Macr. P. C. 209; S. C., Kay, 417.

(*k*) *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.* (1858), 4 K. & J. 727; but see *Fox v. Dellestable* (1866), 15 W. R. 194.

(*l*) *Proctor v. Bayley* (1889), 6 R. P. C. 538.

(*m*) *Smith v. G. W. Ry. Co.* (1854),

Macr. P. C. 203; *Price's Patent Candle Co. v. Bauwen's Patent Candle Co.* (1858), 4 K. & J. 727.

(*n*) See *Bailey v. Taylor* (1829), 1 Russ. & M. 73, 75; *Parrot v. Palmer* (1834), 3 M. & K. 632, 642.

(*o*) *Crossley v. Derby Gas Co.* (1829), 1 W. P. C. 119.

(*p*) *Elmore v. Pirrie* (1887), 57 L. T. N. S. 333; 7 Edw. 7, c. 29, s. 8; Vol. II. p. 273; *Sayers v. Collyer* (1884), L. R. 28 Ch. D. 108; *York v. Stowers, W. N.* (1883) 174.

(*q*) 53 & 54 Vict. c. 23, s. 3; 21 & 22 Vict. c. 27; 36 & 37 Vict. c. 66, s. 16.

(*r*) *Davenport v. Rylands* (1865), L. R. 1 Eq. 308.

the assessment, if the cause of action is a continuing one, as the infringement of a subsisting patent is (*s*); and articles manufactured for export must be brought into the inquiry (*t*).

Account or Damages—General.

Where a plaintiff has become possessed of the patent by assignment, the assessment is frequently only ordered from the date of the registration of the assignment (*u*).

Assessment where the plaintiff is an assignee.

But where it appeared that the plaintiffs had taken over a business and certain patents, and succeeded to the rights of their predecessors, they were held to be entitled, in estimating the damages and loss of sales consequent on the competition of the defendants, to take into account the total quantities sold by the defendants before the plaintiffs acquired such business (*x*).

An account of profits or inquiry as to damages does not include anything due to infringements committed prior to the publication of the complete specification (*y*). An inquiry as to damages does not extend to infringements committed prior to an amendment of the specification, unless the Court is satisfied that the original claim was framed in good faith and with reasonable skill and knowledge (*z*). And the Court may refuse to award any damages in respect of infringements committed after a failure to make any payment in respect of keeping the patent on foot within the prescribed time and before the enlargement thereof (*a*).

Assessment does not extend to infringements committed within certain periods.

It is to be noticed that, as regards infringements committed prior to an amendment of the specification or after failure to pay a renewal fee, the Act does not in terms impose any restriction as to an account of profits.

(*s*) R. S. C. (1883), Ord. xxxvi. r. 58. As to ascertainment of damages in King's Bench Division, see R. S. C. (1885), Ord. xxxvi. r. 57.

(*t*) Lyon v. Goddard (1894), 11 R. P. C. 113.

(*u*) Ellwood v. Christy (1865), 18 C. B. N. S. 494.

(*x*) United Horseshoe and Nail Co. v. Stewart (1888), L. R. 13 App. Cas. 401, 417.

(*y*) 7 Edw. 7, c. 29, s. 13, p. 181, ante.

(*z*) Vol. II., p. 122; 7 Edw. 7, c. 29, ss. 23 and 91. *Semble* this section would include an account of profits as well as damages. In Wenham Gas Co. v. Champion Gas

Lamp Co. (1890), 7 R. P. C. 313; Kane v. Boyle (1901), 18 R. P. C. 325; and British Shoe Machinery Co., Ltd. v. Fussell (A.) and Sons, Ltd. (1908), 25 R. P. 368, the inquiry was limited to damages in respect of infringements since the date of amendment. In Hopkinson v. St. James's Electric Lighting Co. (1893), 10 R. P. C. 43, an account of profits was allowed from the date of the patent, the patentee having stated in evidence that he had framed the original claim in good faith with reasonable skill and knowledge. For form of Order, see Brooks v. Lycett (1903), 20 R. P. C. 392.

(*a*) 7 Edw. 7, c. 29, s. 17 (3).

Account or Damages -- General.

Time within which amount found due is to be paid.

Disclosure by the defendant of number of infringing articles sold and names and addresses of his customers and also prices.

Difference in relationship of the plaintiff to the defendant on the taking of an account to that which exists between them on an inquiry as to damages.

The order for the account or inquiry, as the case may be, usually states the time within which the amount found due must be paid after it has been duly certified (*b*); but sometimes the time within which such payment is to be made is reserved for further consideration (*c*), and the costs of taking the account or instituting the inquiry are usually so reserved (*d*).

On an account of profits or an inquiry as to damages the defendant must disclose the number of the infringing articles he has made, and the names and addresses of the persons to whom and the prices at which he has sold them, in spite of the fact that he thereby exposes his customers to attack from the plaintiff, and himself to a consequent loss of trade (*e*). The very object for which the plaintiff desires the names of the defendant's customers may be to enable him to follow the infringing articles in the hands of such customers.

When in the case of a defendant company in liquidation the order is drawn up in the usual form against the company only, a motion to commit the liquidator for non-compliance, notwithstanding that he was appointed before trial, will fail (*f*).

Account.—When the plaintiff elects to take an account of profit he establishes a different relationship between himself and the defendant to that which exists between them on an inquiry as to damages. In the former case by electing to take an account of profits he condones the infringement (*g*), and adopts that which was done by the defendant (*h*), and claims for himself the profits made by the infringer from the

(*b*) *Westinghouse v. Lancashire and Yorkshire Ry. Co.* (1884), 1 R. P. C. 253; 11 W. R. 852; *Young v. Fernie, Bovill v. Crate, Needham v. Oxley, Cunningham v. Colling, Seton*, 4th ed. p. 355.

(*c*) *Hocking v. Fraser* (1886), 3 R. P. C. 7; *Betts v. Noel, Seton*, 4th ed. p. 355; *Davenport v. Rylands* (1865), L. R. 1 Eq. 302; *Pemberton*, 4th ed. p. 484.

(*d*) *United Telephone Co. v. Fleming* (1886), 3 R. P. C. 282; *United Telephone Co. v. Patterson* (1889), 6 R. P. C. 140.

(*e*) *Murray v. Clayton* (1872), L. R. 15 Eq. 115; *American Braided Wire*

Co. v. Thompson (No. 2) (1888), 5 R. P. C. 375; *United Telephone Co. v. Walker* (1887), 4 R. P. C. 66; *Leather-Cloth Co. v. Hirschfield* (1863), 1 H. & M. 295; *Adair v. Young* (1879), L. R. 11 Ch. D. 136; 12 Ch. D. 13; *Powell v. Birmingham Vinegar Brewery Co.* (1896), 14 R. P. C. 1; *Saccharin Corporation v. Chemical and Drugs Co.* (1900), 17 R. P. C. 612.

(*f*) *Saccharin Corporation v. Chemical and Drugs Co.* (1900), 17 R. P. C. 743.

(*g*) *Neilson v. Betts* (1871), L. R. 5 H. L. 22.

(*h*) *American Braided Wire Co. v. Thompson* (1890), 7 R. P. C. 158.

use of the invention; in the latter case the defendant is treated all through the inquiry as a wrongdoer. Thus, by electing to take an account it may be said that the plaintiff constitutes the defendant his agent as regards the acts whereby he, by the use of the invention, has made a profit or the reverse, and the question always is what in profit or loss was the result of the course of conduct actually pursued by the defendant, and not what might have been the profit had he pursued a different line of conduct. Consequently, the plaintiff is not entitled to an account of, and compensation for, the actual losses he may have sustained through the wrongful acts of the defendant; he is only entitled to an account and payment over to him of the actual profits, if any, derived from the defendant's use of the invention (*i*); and, if the defendant has made profit by the illegal use of the patented invention, the fact that he might have made a profit otherwise—*e.g.*, by the sale of articles not manufactured by a machine the subject-matter of the patent—is immaterial (*k*). The true test of comparison is to take the ratio of the profit derived when the invention was used to the profit which would have been derived had the defendant used that which, looking at all the circumstances of the case, he would most probably have used had he not illegally adopted the invention (*l*).

Account or
Damages—
Account.

On the taking of the account the defendant may be compelled to disclose the profits arising from his business before he commenced to manufacture the articles to which the patent refers by the application of the patented process or machine, as well as since, if such information is necessary to put the Court in a position to estimate what proportion of the total profits made by him since the commencement of the infringement is due to his wrongful acts (*m*).

Profits of
defendant's
business
before in-
fringement
as well as
since.

An inquiry as to profits made by an infringer extends to all profits, including those which accrued since the defendant became aware of the plaintiff's claim to the patent, as well as those which accrued before he became aware of such claim (*n*).

Extent of
account of
profits.

(*i*) *Ellwood v. Christy* (1865), 18 C. B. N. S. 494.

(*k*) *United Horseshoe and Nail Co. v. Stewart* (1888), L. R. 13 App. Cas. 401.

(*l*) *Siddell v. Vickers* (1892), 9 R. P. C. 152.

(*m*) *Siddell v. Vickers* (1889), 6 R. P. C. 464.

(*n*) *Davenport v. Rylands* (1865), L. R. 1 Eq. 302, 308; *United Horseshoe and Nail Co. v. Stewart* (1888), L. R. 13 App. Cas. 401.

Account or Damages—Account.

The account also extends, not merely to the profits made by the sale of the pirated article, but also to all profits incidentally derived from its use. For example, where a defendant was sued for the infringement of a patent for gas-meters, and was ordered to account for profits made by him, the account was made to include the benefit derived by way of saving effected by the use of the piratical gas-meters (*o*).

It would appear that if the plaintiff desires an account of collateral profits he must prove that such profits have been received (*p*); and an account will not be directed when it is clear that no profits whatever have been made (*q*).

Production of books and administration of interrogatories.

When an order for an account of profits is made against a defendant, he may be compelled to produce his books, and interrogatories may be administered, notwithstanding a pending appeal (*r*).

Bankruptcy of defendant.

In the bankruptcy of a defendant the amount found due on an account of profits made by the infringement of a patent can be proved, as it is a liquidated debt (*s*).

Plaintiff in the habit of supplying on royalty articles consisting of patented and non-patented parts.

Where the plaintiff is in the habit of supplying to his customers a complete instrument at a fixed royalty, and that instrument consists of patented and non-patented parts, it is proper, in estimating the amount to which he is entitled, to deduct from the royalty a sum in consideration of the non-patented portion of the infringing instrument (*t*), though no deduction is allowed in respect of the defendant's property in the patented part (*u*). Consequently, where the plaintiff elects to claim profits made by an unauthorised use of his invention it becomes material to ascertain how much of it was actually appropriated, in order to determine what proportion of the net profits realised by the infringer was attributable to the use of the plaintiff's invention (*x*).

Damages in lieu of an account of profits.

Damages.—Before Lord *Cairns'* Act there was no jurisdiction in the Court of Chancery to give damages, and the old

(*o*) *Crossley v. Derby Gaslight Co.* (1829), 1 W. P. C. 119; see also *Househill Co. v. Neilson* (1843), 1 W. P. C. 697, n.

(*p*) *Bacon v. Spottiswoode* (1839), 1 Beav. 382.

(*q*) *Bergmann v. McMillan* (1881), L. R. 17 Ch. D. 423; *Sanitas Co. v. Condy* (1887), 4 R. P. C. 530.

(*r*) *Saxby v. Easterbrook* (1872),

L. R. 7 Ex. 207.

(*s*) *Watson v. Holliday* (1882), 30 W. R. 747; 31 W. R. 636; 52 L. J. Ch. 543; Bankruptcy Act, 1883, s. 37.

(*t*) *United Telephone Co. v. Walker* (1887), 5 R. P. C. 61, 63.

(*u*) *Ibid*; see p. 526, *post*.

(*x*) *United Horseshoe and Nail Co. v. Stewart* (1888), L. R. 13 App. Cas. 412.

form of decree always gave the plaintiff an account of profits, but by Lord *Cairns'* Act jurisdiction was conferred on the Court to give damages, and in *Hills v. Evans* (*y*) Lord *Westbury* pronounced a decree giving the plaintiff both damages and profits, which course was held to be wrong in *Neilson v. Betts* (*z*) and *De Vitre v. Betts* (*a*), in which the House of Lords settled finally that the successful plaintiff in an action of infringement of a patent is entitled, at his election, to damages or an account of profits, but not to both, which is the state of the law now (*b*). This relief may be obtained in either Division of the High Court (*c*), or in the Court of the County Palatine of Lancaster (*d*).

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An innocent infringer, without reasonable means of knowledge of the existence of the patent, is exempt from liability for damages in respect of a patent granted after the 1st January, 1908, which is the date of the commencement of the Patents and Designs Act, 1907. Sect. 33 of the Act provides as follows:—

Exemption of
innocent in-
fringer from
liability for
damages.

A patentee shall not be entitled to recover any damages in respect of any infringement of a patent granted after the commencement of this Act from any defendant who proves that at the date of the infringement he was not aware, nor had reasonable means of making himself aware, of the existence of the patent, and the marking of an article with the word "patent," "patented," or any word or words expressing or implying that a patent has been obtained for the article, stamped, engraved, impressed on, or otherwise applied to the article, shall not be deemed to constitute notice of the existence of the patent unless the word or words are accompanied by the year and number of the patent:

Provided that nothing in this section shall affect any proceedings for an injunction.

All ordinary patents, in accordance with the provisions of sect. 13 of the Act, are dated and sealed as of the date of the

(*y*) (1862), 4 De G. F. & J. 288.
(*z*) (1871), L. R. 5 H. L. 1; 40 L. J.
Ch. 317.
(*a*) (1873), 6 H. L. 319; 21 W. R.
705.

(*b*) Per Lindley, L.J., *Siddell v.*
Vickers (1892), 9 R. P. C. 162.
(*c*) P. 510, *ante*.
(*d*) P. 510, *ante*.

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application. Apparently the words, "granted after the commencement of this Act," therefore, mean "being dated after the commencement of this Act," since the letters patent which contain the grant are dated as of the date of application. That is to say, for the purposes of this section, patents are deemed to have been granted upon the day as from which they are dated, and from which the period of the grant begins to run. If Parliament had meant the section to apply to patents which, though dated before, are not in fact sealed till after the commencement of the Act, it would have said so clearly.

The section effects an important alteration in the law. Hitherto, ignorance of the patent was no defence; now, ignorance, coupled with absence of reasonable means of knowledge, is a complete defence to a claim for the payment of damages. The section apparently only exempts an infringer who has no knowledge and no reasonable means of knowledge of the patent from liability to pay damages to the patentee. It does not, apparently, excuse him from liability to account for profits made by the unauthorised use of the invention, since there is no necessary relationship between damages inflicted upon the patentee and profits made by an infringer by such an unauthorised use (e). The proviso in terms states that nothing in the section shall affect any proceeding for an injunction.

Users will, no doubt, be more frequently able to bring themselves within the protection of this section than manufacturers. Frequently a manufactured article, which is sold, gives no clue to the patented machine or process by which it was produced. An illustration of this would be a patented cigarette-making machine, which produced cigarettes similar in appearance to the ordinary cigarettes on the market. The purchaser of cigarettes made by an infringing machine might well be totally ignorant of the existence of the patent, and the mere purchase of the cigarettes from a retailer, or even a wholesale dealer, might well not furnish him with reasonable means of knowledge of the existence of the patent, nor might it even suggest that there was any patent for the machine by which the cigarettes were produced, or at all. The manufacturer who used the machine might be in a different position. The machine might have some conspicuous feature of novelty, and

(e) See p. 509, *ante*.

it might well be that this, together with an inspection of the trade journals, or catalogues of well-known manufacturers, would soon convince him that the machine was the same as, or very similar to, one advertised in such literature as protected by a patent of given number and date. The manufacturer, under such circumstances, would have reasonable means of making himself aware of the existence of the patent, and would not be protected by this section.

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It would seem that the intention of Parliament, as expressed by the section, is that an alleged infringer is not to be cast in damages unless he fails to prove that he had neither actual knowledge of, nor reasonable means of knowledge of, the existence of the patent, and that it had some sort of connection with the infringing article or process, which might reasonably put him upon inquiry.

By the terms of the section the marking of an article with words implying that a patent for the article has been obtained, together with the year and number of the patent, is notice of the existence of the patent. Where a patentee so marks articles, which are upon the market to a considerable extent, it may well be that a person who becomes possessed of a similar, but unmarked article, produced without licence of the patentee, will find great difficulty in satisfying a Court that he had no reasonable means of making himself aware of the existence of the patent. A person possessed of an infringing article, marked with the number and year of the patent, would not be entitled to any benefit from the section, because he would clearly have knowledge, or the reasonable means of knowledge, of the existence of the patent, and the belief that the article was, contrary to the fact, made under licence, would not avail him.

In consequence of this section, it will probably become the common practice for patented articles, or articles produced by a patented machine or process, to be marked with the number and year of the patent.

It is not possible to lay down any general canon of what will be the result of a given case in respect of protection or no protection under the section. It will always be a question of fact, to be decided in reference to the circumstances peculiar to each individual case.

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Proof of some damage essential to an inquiry.

Before a plaintiff can be entitled to an inquiry as to damages, it is incumbent on him to show that he has in fact sustained some damage which is not merely nominal (*f*), *i.e.*, the plaintiff must show that he has sustained pecuniary loss, and, as far as the nature of the case may permit, the amount of that loss (*g*). Sometimes, however, it may be evident that the plaintiff has sustained substantial damage, though it is not possible to fix any sum as to the exact quantum. In such cases it is proper and the practice of the Courts, by guesswork, to award such a sum as from the circumstances of the case appears fair (*h*). Thus, by way of illustration, if it can be proved that the necessary consequence of an injurious act, *e.g.*, infringement of a patent, is to damage the reputation of the patented article or process, and so to interfere with its general and extended use, very substantial damages might be recovered, though it might be impossible to put a figure on the loss (*i*).

Assessment is not affected by amount accepted from non-litigants.

The rate at which the plaintiff has accepted compensation for damages from non-litigants does not govern the assessment of the amount recoverable by action from the defendant (*k*).

Measure of damages.

The measure of damages to which a successful plaintiff is entitled is the actual loss sustained by him by reason of the unlawful acts of the defendant, which loss must be the natural and direct consequence of the defendant's acts (*l*), *i.e.*, the question is by how much would the plaintiff have been better off if there had been no infringement (*m*); and the essential principle should always be borne in mind that the action is one not to punish the infringer, but to compensate the

(*f*) *Dicks v. Brooks* (1880), L. R. 15 Ch. D. 39; *United Telephone Co. v. Sharples* (1885), 2 R. P. C. 28; *Sanitas Co. v. Condy* (1887), 4 R. P. C. 530; *Cole v. Saqui* (1888), 5 R. P. C. 489, 496; *Webb Lamp Co. v. Atkinson* (1902), 19 R. P. C. 599.

(*g*) *Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre Co.* (1898), 15 R. P. C. 406; 16 R. P. C. 215.

(*h*) See *Ungar v. Sugg* (1891), 8 R. P. C. 388; 9 R. P. C. 117.

(*i*) See *Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre Co.* (1898), 15 R. P. C. 406; 16 R. P. C. 212, 215.

(*k*) *Boyd v. Tootal Broadhurst, & Co.* (1894), 11 R. P. C. 175.

(*l*) *United Telephone Co. v. Walker* (1887), 4 R. P. C. 67; *Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre Co.* (1899), 16 R. P. C. 212, 214; *Clement Talbot v. Wilson* (1909), 26 R. P. C. 467; *Martin's, Ltd. v. Metropolitan Gas Meters, Ltd.* (1910), 27 R. P. C. 721; 28 R. P. C. 157.

(*m*) *Boyd v. Tootal Broadhurst, & Co.* (1894), 11 R. P. C. 175; *Penn v. Jack* (1867), L. R. 5 Eq. 81; 37 L. J. Ch. 136; *Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre Co.* (1899), 16 R. P. C. 212, 214.

patentee (*n*), and the Court properly compensates him with a liberal hand at the expense of the wrongdoer (*o*). Thus, the whole moneys which an infringer has contracted to pay to a third party for the supply of a definite number of infringing articles (some of which have not been delivered) do not form the measure of damage sustained by the patentee, since he is only entitled to damages in respect of such articles as have actually been delivered (*p*). The plaintiff is not entitled to receive anything in respect of the annoyance and vexation he experiences from the necessity of having to establish his right in a Court of law, the award of the costs of the action being the only way the Court will attempt to recompense him in respect of such annoyance and vexation (*q*), though he may be entitled to a substantial sum in respect of damage to the reputation of his patented article or process (*r*).

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It is, therefore, clearly important to establish what is the plaintiff's usual course of dealing with the invention—*e.g.*, the price at which he usually sells the patented article, or the amount of royalties he generally accepts from licensees authorised to use the invention.

When the patentee of machinery who does not grant licences, claims damages from an infringing manufacturer who competes with him by selling the same class of goods as those made by the patented machine and in the same market, the profit made by the infringer is of no consequence. However large his gains, he is only liable in nominal damages so long as his illegal sales do not injure the trade of the patentee; and however great his loss he cannot escape from liability to make full compensation for the injury which his competition may have occasioned. Every sale of goods manufactured without licence by patented machinery is, and must be, treated as an illegal transaction in a question with the patentee; and its inherent illegality is not affected by the circumstance that the infringement consisted in using a small and, it may be, the least useful part of the invention (*s*).

Damages
when it is not
the plaintiff's
usual course
of business to
grant licences.

(*n*) See *Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre Co.* (1899), 16 R. P. C. 215.

(*o*) *Ibid.*; *British Motor Syndicate, Ltd. v. John Taylor & Son, Ltd.* (1899), 17 R. P. C. 189, 723.

(*p*) *British Insulated Wire Co. v.*

Dublin United Tramways Co. (1899), 17 R. P. C. 14.

(*q*) *United Horseshoe and Nail Co. v. Stewart* (1888), L. R. 13 App. Cas. 410, 416; 5 R. P. C. 260.

(*r*) See *supra*.

(*s*) See Lord Watson's judgment in

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If a part only of the actual article sold by the defendant is an infringement and the article sold by the defendant is of a substantially cheaper and lower grade than that usually manufactured and sold by the plaintiff under the patent, the Court ought in estimating the quantum of damage by no means to conclude that all the sales effected by the defendant would have been, but for the wrongful acts of the defendant, effected by the plaintiff at the price he charges for the higher grade article, or at all. In such circumstances the Court is obliged to arrive at and adopt the best conclusion it can, upon the facts of the case, as to what quantity of the patented articles the plaintiff has been prevented from selling in consequence of the infringing articles being put upon the market and so determine the quantum of profit which the wrongful acts of the defendant have prevented the plaintiff from realising (*t*).

In *Gavioli v. Shepherd* (*u*), where the defendant was the user and not the manufacturer of the infringing article, the Court came to the conclusion upon the facts that, if he had not bought the cheap infringing article, he would not have bought the plaintiff's more costly article, and, therefore, the plaintiff had not suffered any damage at all. In this case the order was in the form "whether any and what damages have been sustained or incurred by the plaintiff, &c.," and not in the usual form, "what damages the plaintiff has sustained" (*x*). It is submitted, nevertheless, that some damage should have been found due—if necessary by guesswork (*y*)—since every unlicensed user must be a damage to the patentee (*z*).

In *Meters, Ltd. v. Metropolitan Gas Meters, Ltd.* (*a*), it was proved that as to some of the infringing articles sold the purchasers bought solely on account of the price and not on account of the patented parts, and that if the defendants had not made the sales the plaintiffs could not have obtained the orders. Under these circumstances the Court held that the plaintiffs had failed to prove that they lost the orders in consequence of

United Horseshoe and Nail Co. v. Stewart (1888), L. R. 13 App. Cas. 413; 5 R. P. C. 267.

(*t*) Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre Co. (1899), 16 R. P. C. 209, 212, 215, 216; Dunlop Pneumatic Tyre Co. v. Gunn (1900),

17 R. P. C. 234.

(*u*) (1899), 17 R. P. C. 157.

(*x*) P. 518, *ante*.

(*y*) See p. 518, *ante*.

(*z*) See *infra*.

(*a*) (1910), 27 R. P. C. 721; 28 R. P. C. 157.

the defendants' conduct and refused to allow anything to the plaintiffs in respect of such sales. Account or
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In *Dunlop Pneumatic Tyre Co. v. Green* (b) it appeared that the defendant, who was a manufacturer of bicycles, supplied the plaintiffs' patented tyre with second grade machines, and it was proved that the plaintiffs supplied their tyre with all grades of machines. Under these circumstances the Court refused to interfere with the finding of the master, which awarded a substantial sum as the measure of damage.

And in *British United Shoe Machinery, Ltd. v. Fussell (A.) and Sons, Ltd.* (c), the Court being satisfied that the defendants were desirous of acquiring a machine of a particular character, which could only be lawfully supplied by the plaintiffs, held that, as wrongdoers, they were not entitled to the benefit of the doubt, but it was to be assumed against them that they would have bought the machine from the plaintiffs had that been the only source from which they could have been supplied. The master's order awarding only one farthing damages was varied accordingly, and the plaintiffs were given substantial damages.

In estimating the amount of damages to which a successful plaintiff is entitled, the Court recognises that every sale without licence of a patented article must be a damage to the patentee, and the inquiry is in the form, "what damage the plaintiff has sustained," not "what damage, if any." In the case of infringement of trade mark all the world are entitled to make the article, but not to brand it with the plaintiff's mark; but in the case of a patent every manufacture or sale of the article is necessarily a damage to the patentee (d). The actual profit derived by the defendant is not in all cases necessarily the measure of the plaintiff's loss, for it cannot always be ascertained with arithmetical precision what, in the ordinary course of business, would have been the amount of the plaintiff's sales and profits. When the product of the patented process or machinery or the patented article itself is a new and special article which cannot be successfully imitated without using the invention, the process of estimation is comparatively simple; but, on the other hand, it is quite

(b) (1900), 17 R. P. C. 234.

(c) (1910), 27 R. P. C. 205.

(d) See per Page Wood, V.-C.,

Davenport v. Rylands (1865), L. R. 1 Eq. 308.

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the reverse when this is not the case. An allowance is made to the plaintiff in respect of loss of sales caused by the defendant's competition, and at the same time the defendant is entitled to strike off a moderate percentage as representing sales due to increased activity in the trade produced by the rivalry of two competitors, if that is the relationship of the parties (*e*).

Reduction of
price by the
plaintiff.

If a patentee whose patent is being infringed reduces the price at which he sells the patented articles, in order to be able to undersell the infringer, although in an action for damages he may be entitled to the benefit of all sales made by the infringer as if they were made by himself, so that he will get all the profit so made by the infringer, yet he will not be entitled to recover the difference between the original and reduced price, when the reduction is not a natural and direct consequence of the infringer's acts, and is therefore too remote (*f*). But when it can be shown that the plaintiff has not reduced his price below that of the infringing defendant, and that the plaintiff's reduction has been consequent upon the defendant's, the Court, in estimating the amount of damages, will consider that the plaintiff, but for the defendant's wrongful acts, would have made all the sales effected by the defendant at the original and not at the lowered price (*g*). Thus, a plaintiff who is only able to secure an order by reducing his usual price in consequence of the defendant offering to supply an article at a lower price than the patented article as usually sold by the plaintiff, when the evidence shows that the article would otherwise have been supplied by the plaintiff at his usual price, is entitled to credit for the difference between the usual price and the actual price obtained (*h*).

To the extent that he can establish it, the plaintiff is entitled to take credit for the fact that there would be no increase of establishment charges involved in the manufacture and sale by

(*e*) *United Horseshoe and Nail Co. v. Stewart* (1888), L. R. 13 App. Cas. 401, 413, 417; *Ellwood v. Christy* (1865), 18 C. B. N. S. 494; *Penn v. Jack* (1866), L. R. 5 Eq. 81; *Alexander v. Henry* (1895), 12 R. P. C. 360.

(*f*) *United Horseshoe and Nail Co. v. Stewart* (1888), L. R. 13 App. Cas. 401; 5 R. P. C. 260.

(*g*) *American Braided Wire Co. v.*

Thompson (1890), 7 R. P. C. 47, 152; *W. N.* (1890) 68; L. R. 44 Ch. D. 274; *Alexander v. Henry* (1895), 12 R. P. C. 360; *Meters, Ld. v. Metropolitan Gas Meters, Ld.* (1910), 27 R. P. C. 721; 28 R. P. C. 157.

(*h*) *Wellman, Leaver & Head, Ld. v. Bustinghaus & Co., Ld.* (1911), 28 R. P. C. 326.

him of the extra number of articles he would have sold but for the defendant's conduct (*i*).

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A reduction, however, may be allowed to the defendant in consideration of the increase of sales by reason of the diminution of price, as also by reason of his business connection (*k*).

When it is the plaintiff's usual course of business to grant licences, the measure of damage becomes the loss of royalties sustained by him through the defendant's acts; that is to say, the profit rent and royalties for the entire period during which the infringing article was in the hands of the defendant, whether it was or was not in use during the whole of that time (*l*). Since the plaintiff deems himself fully compensated by the usual royalty charged in cases in which he has granted a licence, such sum is the proper measure of compensation where the manufacture or use has been carried on without his leave (*m*).

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when it is
the plaintiff's
usual course
of business to
grant licences**

And where the plaintiff is in the habit of granting licences he cannot claim by way of damages a manufacturing profit, or any sum beyond the ordinary royalty; moreover, he will not be entitled to recover anything from the manufacturer if he has received the full royalty from the user (*n*). And, further, it cannot always be taken for granted that the licences which it is presumed the plaintiff would have granted, had the defendant not infringed, would have been in force till the expiration of the patent; with regard to the duration of such supposed licences, the Court must make the best estimate it can, having regard to all the circumstances of the case, *e.g.*, the average duration of licences granted by the plaintiff about the time the defendant's acts were committed (*o*).

A patentee who has obtained an injunction cannot be compelled to accept from an infringer desirous of continuing the use of the invention the same royalties he accepts from other and licensed users (*p*).

(*i*) Leeds Forge Co., Ld. v. Deighton's Patent Flue Co., Ld. (1908), 25 R. P. C. 212.

(*k*) See note (*g*), above.

(*l*) United Telephone Co. v. Walker (1887), 4 R. P. C. 63; English and American Machinery Co. v. Union Boot and Shoe Machine Co. (1895), 13 R. P. C. 64; see Pneumatic Tyre Co. v. Puncture Proof Pneumatic Tyre

Co. (1898), 15 R. P. C. 405; 16 R. P. C. 212.

(*m*) See Penn v. Jack (1867), L. R. 5 Eq. 86.

(*n*) *Ibid.* 81.

(*o*) English and American Machinery Co. v. Union Boot and Shoe Machine Co. (1895), 13 R. P. C. 64.

(*p*) Penn v. Bibby (1866), L. R. 3 Eq. 310, 312; Penn v. Jack (1867), L. R. 5 Eq. 81.

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Damages may be recovered either against a manufacturer or a user, or both, until the full amount has been recovered.

Damages for infringement may be recovered against either a manufacturer or a user, or both, until the full measure of damage, which is the total loss of the profit which the plaintiff would have made had the infringing machine been supplied by him, has been recovered (*q*).

For example, if a patentee obtains an injunction and damages against an infringing manufacturer, and the manufacturer does not pay the damages, it is open to the patentee to claim from a purchaser of the manufacturer what is due to him by way of damages in respect of the purchase of infringing machines (*r*); and the acceptance by the plaintiff of *agreed* damages from an infringing manufacturer of the patent article in respect of *his* wrongful acts, does not preclude the plaintiff from following the article in the hands of a purchaser from such manufacturer and claiming damages from him, for the payment of agreed damages by the manufacturer does not necessarily make the article "free" in the hands of a purchaser (*s*); but if the damages payable by a manufacturer under an order against him are calculated upon the basis that he is to be held liable for the full loss caused to the patentee by the manufacture and sale of the infringing articles in question such articles do become "free" in the hands of purchasers from the manufacturer, who cannot be subjected to any liability in respect of them (*t*). In cases where the new provisions of sect. 33 of the Act of 1907 do not apply (*u*), a plaintiff's right to damages against a defendant user is not affected by the fact that the user had no notice of the patent (*x*); such a user cannot be heard to say that, if he had had notice of the patent, he might have bought articles other than those which infringe the patent and which would have done as well for him (*y*).

Damages in respect of infringements

In cases where it appears that the defendant has infringed during the interval between a former decision adverse to the

(*q*) *Penn v. Bibby* (1866), L. R. 3 Eq. 308; *Penn v. Jack* (1867), L. R. 5 Eq. 81; *United Telephone Co. v. Walker* (1887), 4 R. P. C. 63; *United Horseshoe and Nail Co. v. Stewart* (1888), L. R. 13 App. Cas. 401, 408; *American Braided Wire Co. v. Thompson* (1890), 7 R. P. C. 47, 152; *Boyd v. Tootal Broadhurst, & Co.* (1894), 11 R. P. C. 175; *British Motor Syndicate v. John Taylor & Sons* (1900), 17 R. P. C. 728.

(*r*) *Cropper v. Smith* (1883), L. R. 24 Ch. D. 305, 312; *British Motor Syndicate v. John Taylor & Sons* (1900), 17 R. P. C. 728.

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

(*t*) See *ibid.*

(*u*) See p. 515, *ante.*

(*x*) *Boyd v. Tootal Broadhurst, & Co.* (1894), 11 R. P. C. 147.

(*y*) *Ibid.*

validity of the patent and its reversal on appeal, and further, that the defendant's wrongful acts were committed on the strength of that former decision, it is submitted that the defendant would be allowed to give evidence on this point in reduction of damages (*z*).

It is open to question whether a Judge of the Chancery Division has jurisdiction to order an inquiry as to damages to be referred to a Judge and jury (*a*).

Where the plaintiff in an action for the infringement of a patent claimed the costs of a former action against the same defendant, which it was alleged was discontinued owing to false evidence on the part of the defendant, the Court held that the proper course was to strike out those paragraphs of the statement of claim which referred to the costs of the former action, and to leave the plaintiff at liberty to bring a separate action in respect of them, and intimated that such action ought to be brought in the Queen's Bench Division (*b*).

Where damages, though claimed in the pleadings, were by an oversight not asked for at the trial, special leave was given, on subsequent motion by the plaintiff, to vary the minutes of the decree by adding an inquiry as to damages (*c*).

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committed on the strength of a judgment adverse to the patent.

Reference of inquiry to a judge and jury.

Costs of a former discontinued action.

Omission to ask for damages at the trial.

DESTRUCTION OR DELIVERY TO PLAINTIFF OF INFRINGING ARTICLES.

In addition to an injunction restraining the defendant from infringing the patent in future, and an account of profits or damages at his option, a successful plaintiff in an action for infringement may under the present practice obtain an order of the Court directing an inquiry as to how many of the infringing articles are in the possession of the defendant, and ordering further that all such articles shall be destroyed in the presence of the plaintiff or delivered up to him (*d*), or

Power of the Court to order the destruction or delivery to the plaintiff of infringing articles.

(*z*) P. 389, *ante*; *Arkwright v. Nightingale* (1785), 1 W. P. C. 61.

(*a*) *American Braided Wire Co. v. Thompson* (1888), 5 R. P. C. 696.

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

(*c*) *Edison v. Holland* (1888), 5 R. P. C. 483.

(*d*) *Betts v. De Vitre* (1865), 34 L. J. Ch. 289, 291; S. C. 11 Jur. N. S. 9,

217; *Seton*, 4th ed. p. 354; *Washburn and Moen Manufacturing Co. v. Patterson* (1884), 1 R. P. C. 157, 162; *Tangye v. Stott* (1865), 14 W. R. 386; *Frearson v. Loe* (1878), L. R. 9 Ch. D. 48, 67; *Otto v. Steel* (1886), 3 R. P. C. 109, 120; *Emperor of Austria v. Day* (1861), 3 De G. F. & J. 217; *Pemberton*, 4th ed. p. 484; *Edison v. Holland* (1888), 5 R. P. C. 483.

**Destruc-
tion or
Delivery
up of
Infringing
Articles.**

that they shall be delivered up or destroyed (e). It is to be observed that the practice of the Court in granting orders for the delivering up or destruction of the defendant's goods is of modern growth and does not rest upon any statutory penalty of forfeiture for infringement. No forfeiture of goods can rest upon a grant of letters patent (f). Some authorities have thought it doubtful whether the Court has jurisdiction to make an order for the delivering up of the defendant's goods to the plaintiff, and argued that a defendant whose goods are compulsorily taken or destroyed by the plaintiff, though under an order of the Court, has a right of action under sect. 4 of the Statute of Monopolies in respect of an illegal forfeiture. It is submitted, however, that this view is erroneous, first, because sect. 4 of the Statute of Monopolies does not apply to patents granted after the date of that Statute (g); and, secondly, because the Court in ordering the delivery up to the plaintiff of the defendant's goods does not proceed on the footing that the order passes the property in the goods from the defendant to the plaintiff, but makes the order as a protection to the patentee against the goods being used by the defendant who has been found guilty of an intention to use them. As was stated by *Cotton*, L.J., in *Vavasseur v. Krupp* (h), "the property in articles which are made in violation of a patent is, notwithstanding the privilege of the patentee, in the infringer if he would otherwise have the property in them. The Court in a suit to restrain the infringement of a patent does not proceed on the footing that the defendant proved to have infringed has no property in the articles; but, assuming the property to be in him, it prevents the use of those articles, either by removing that which constitutes the infringement, or by ordering, if necessary, a destruction of the articles so as to prevent them from being used in derogation of the plaintiff's rights—not on the footing that there is no property in the defendant. The Court cannot proceed to give that relief and interfere with the articles unless it has before it the person entitled to the articles in

(e) *Badische Anilin und Soda Fabrik v. Levinstein* (1883), L. R. 24 Ch. D. 176; *Plimpton v. Malcolmson*, Seton, 4th ed. p. 354.

(f) *Waltham v. Austin*, 8 Co. Rep. 125a, 127b; 2 Inst. 47; *Horne v. Ivy*,

1 Sid. 441; 1 Vent. 47; *Hastings' Patent*, Noy, 183.

(g) See *Peck v. Hindes* (1898), 15 R. P. C. 113; 14 Times L. R. 164.

(h) (1878), L. R. 9 Ch. D. 360.

question, and has as against that person power to adjudicate that the articles are made or used in infringement of the plaintiff's rights."

Destruction or Delivery up of Infringing Articles.

In a case where the statement of claim prayed for the delivery up and destruction of all infringing articles in the power or control of the defendants, *Bacon, V.-C.*, declined to make the order at the trial, but reserved the question for consideration after an account of profits had been taken (*i*).

The order for delivery up or destruction usually fixes a time within which the infringing articles are to be delivered up or destroyed (*k*).

Form of order.

Where a defendant is found to have infringed a patent for an invention consisting of a new combination of old parts, the Court will probably grant an injunction restraining the user of the infringing machines, but refuse to order their destruction, on the ground that the parts may be separated and used for other purposes, and the order will give liberty to the plaintiff to mark the infringing machines so as to be able to follow them at any time (*l*).

When an infringing article is composite.

Under the following circumstances, an order for delivery up was refused:—The infringing machines consisted of two distinct parts, one of which was an infringement of the patent, and the other was not; the machines had been manufactured abroad and imported into this country, and the defendants dismantled them and kept the separate parts stored in a warehouse (*m*). Also where the infringing part was a portion of a complicated apparatus the defendant was not ordered to deliver up the whole machine on his undertaking to remove the infringing part (*n*).

The destruction of an infringing article may cause a loss to the defendant considerably greater than the cost of such infringing article, as, for example, where the infringing article is used in combination with other things which do not infringe, and the article cannot be detached without destroying the whole machine—*e.g.*, the filament in an *Edison* incandescent

Loss caused to defendant.

(*i*) *Hocking v. Fraser* (1886), 3 R. P. C. 7.

(*k*) *Otto v. Steel* (1886), 3 R. P. C. 120; *Washburn and Moen Manufacturing Co. v. Patterson* (1884), 1 R. P. C. 191.

(*l*) *Nexdham v. Oxley* (1878), 8

L. T. N. S. 604; 11 W. R. 852; *Saton*.

(*m*) *United Telephone Co. v. London and Globe Telephone and Maintenance Co.* (1884), L. R. 26 Ch. D. 766, 776.

(*n*) *Automatic Weighing Machine Co. v. Feasby* (1893), 10 R. P. C. 442.

Costs. : electric lamp which was held to infringe the *Cheesborough* patent, and an order for the destruction of which was obtained (*o*). This loss is part of the risk an infringer incurs when he invades a patentee's right (*p*).

Costs.

Discretion of
Court or
judge.

Subject to the Judicature Acts and the Supreme Court Rules, the costs of and incident to all proceedings in the Supreme Court are in the discretion of the Court or Judge, provided that where any action, cause, matter, or issue is tried with a jury, the costs shall follow the event, unless the Judge by whom such action, cause, matter, or issue is tried, or the Court, shall for good cause otherwise order (*q*). Consequently the costs of an action for infringement of a patent are in the discretion of the Judge of any Division of the Supreme Court in which the action is tried.

If either party desires that certain costs should be disallowed, he should apply accordingly to the Judge at the trial. The taxing master rightly allows costs which fall within the Judge's order—*e.g.*, the plaintiff's costs occasioned by the defence of a defendant against whom the action was settled before trial are payable by another defendant against whom judgment is obtained with costs for the plaintiff (*r*).

Necessity for
certificate of
particulars,
and validity.

On taxation, however, if the action has proceeded to trial, no costs will be allowed to either party in respect of any particular which the Court has not certified as being reasonable and proper (*s*). And in case the plaintiff succeeds in an action in respect of a patent, the validity of which has been certified by the Court to have been questioned in a former action for infringement, he is entitled to have his full costs, charges, and expenses, as between solicitor and client, unless the Court trying the case certifies that he ought not to have the same (*t*).

In the words of Sir George *Jessel*, M.R.: "Where a plaintiff comes to enforce a legal right, and there has been no misconduct on his part, or omission or neglect which could in-

(*o*) *Edison v. Holland* (1888), 5 R. P. C. 459, 483.

(*p*) *United Telephone Co. v. Walker* (1887), 4 R. P. C. 67.

(*q*) R. S. C. (1883), Ord. lxx. r. 1.

(*r*) *Badische Anilin und Soda Fabrik v. Hickson* (1906), 23 R. P. C. 149.

(*s*) R. S. C., Ord. liiia. r. 27.

(*t*) 7 Edw. 7. c. 29, s. 35.

duce the Court to deprive him of his costs, the Court has no discretion, and cannot take away the plaintiff's right to costs. There may be misconduct of many sorts: for instance, there may be misconduct in commencing the proceedings, or some miscarriage in the procedure, or any oppressive or vexatious mode of conducting the proceedings, or other misconduct which will induce the Court to refuse costs; but where there is nothing of the kind the rule is plain and well settled, and is as I have stated it" (*u*).

As we have seen, a plaintiff is not bound to apply to the defendant for the relief he seeks before commencing action (*x*); and ignorance on the part of the defendant is no defence to an action for infringement so far as an injunction is concerned (*y*), though it may defeat the plaintiff's claim to damages (*z*).

Although a defendant admits infringement and promises to discontinue the acts complained of and not to repeat them, the plaintiff is not bound to rely on such promises, but may obtain the injunction of the Court or such other relief as may be necessary (*a*). In such a case, if the defendant would avoid the costs of the action he must, at the time he admits the infringement, offer to pay all the costs incurred up to that period (*b*). Thus, where a defendant had merely promised not to repeat the infringement, the plaintiff was held to be entitled not only to an injunction but to his costs of the suit (*c*). Again, defendants, who merely offered to remove certain infringing portions of a machine but gave no promise not to use them again and did not offer to pay the costs of the action already incurred, were ordered to pay the costs the plaintiff was put to in order to obtain an injunction (*d*). And in an action in the Palatine Court, where infringing machines had been disused for five years previous to the commencement of the action, and had been removed from the defendants'

Costs.

Ignorance does not exempt from liability to pay costs.

When defendant admits and undertakes to discontinue infringement.

(*u*) *Cooper v. Whittingham* (1880), L. R. 15 Ch. D. 504.

(*x*) P. 391, *ante*.

(*y*) P. 516, *ante*.

(*z*) See p. 515, *ante*.

(*a*) P. 391, *ante*.

(*b*) *Burgess v. Hateley* (1859), 26 Beav. 249; *Geary v. Norton* (1846), 1 De G. & S. 9, 12; *Fradella v. Weller* (1831), 2 Russ. & M. 247; *Nunn v.*

D'Albuquerque (1865), 34 Beav. 595; *Colburn v. Simms* (1843), 2 Hare, 543; *Jenkins v. Hope* (1895), 13 R. P. C. 57.

(*c*) *Geary v. Norton* (1846), 1 De G. & S. 9.

(*d*) *United Telephone Co. v. London and Globe Telephone and Maintenance Co.* (1884), 1 R. P. C. 117.

Costs.

premises, the plaintiffs obtained their costs on proof of the infringement, which was denied, and this although there was no threat on the part of the defendants to renew the infringement (*e*). The Court of Appeal, however, held that in the absence of any evidence of an intention on the defendants' part to continue the wrongful acts an injunction ought not to have been granted, and dismissed the action, but, owing to the defendants' conduct of their case, without costs in the Court below, although they gave the defendants the costs of their successful appeal (*f*).

Where the plaintiff failed to prove infringement, though the defendant admitted a discontinued infringement before action and offered to pay what was reasonable, the plaintiff was condemned in the costs of the action (*g*).

When plaintiff's conduct is oppressive.

Oppressive conduct on the part of the plaintiff will induce the Court to deprive him of his costs, even though he succeeded in the action. Thus, where a defendant at the hearing submitted to a perpetual injunction, and it appeared that the defendant had ignorantly infringed the patent, but had before the commencement of the action offered to deliver up to the plaintiff all profits he had made by selling the infringing articles, and to sell all such articles remaining in his possession to the plaintiff at a fair valuation, but the plaintiff nevertheless continued the action, the Court gave him no costs (*h*).

When plaintiff discontinues action.

Discontinuance.—Where the plaintiff seeks leave to discontinue the action, the Court imposes such terms as to costs, or otherwise, as under the circumstances seem reasonable (*i*). Before the Act of 1907 it was frequently made a term of leave to discontinue that the plaintiff should pay the defendant's costs as if the particulars had been certified as reasonable and proper, and that the plaintiff should not bring any fresh action in respect of the infringement alleged in the pleadings (*k*). Under such circumstances the Court does not now make any such order

(*e*) *Proctor v. Bayley* (1889), 6 R. P. C. 106.

(*f*) 6 R. P. C. 538.

(*g*) *Fletcher v. Glasgow Gas Co.* (1887), 4 R. P. C. 386.

(*h*) *Nunn v. D'Albuquerque* (1865), 34 Beav. 595.

(*i*) *Boake, Roberts & Co. v. Stevenson* (1894), 12 R. P. C. 228; *Wilcox and Gibbs' Sewing Machine Co. v.*

Janes (1897), 14 R. P. C. 523; *Bethell v. Gage* (1897), 14 R. P. C. 699; *Chamberlain and Hookham, Ltd. v. Mayor, &c. of Huddersfield* (1901), 15 R. P. C. 454; *Kerr v. Crompton* (1901), 19 R. P. C. 9; *Brooks v. Lycett* (1902), 19 R. P. C. 166; *Robertson v. Purdey* (1906), 23 R. P. C. 779.

(*k*) See *ibid.*

for payment of costs of the particulars of objections as if they had been certified, but leaves the question of such costs to be dealt with by the taxing master in his discretion under R. S. C., Order 53A, r. 22 (*l*). Leave of the Court to discontinue is not necessary before delivery of defence, nor after the receipt thereof before taking any other proceeding in the action save any interlocutory application, but the plaintiff is bound to pay the defendant's costs (*m*).

**Costs—
Discon-
tinuance.**

The omission by the plaintiff to deliver a reply when due, and his permitting the defendant to give notice of trial is not "taking any other proceeding in the action" within the meaning of R. S. C., Order 26, r. 1. The delivery of an amended statement of claim with a view to continuing the litigation is taking another proceeding in the action within the meaning of the rule (*n*).

A plaintiff who discontinues is entitled to commence a fresh action against the same defendant in respect of the same cause of action, unless it be a term of an order allowing discontinuance that no such fresh action shall be brought (*o*). An application to stay the taxation of the costs in a first action till after the trial of a second action would only be acceded to under exceptional circumstances (*p*).

A defendant cannot withdraw his defence, or any part thereof, without leave upon terms as to costs and otherwise (*q*).

**Withdrawal
of defence.**

It is provided by R. S. C. 1883, Ord. 65, r. 2, that where issues of fact and law are raised upon a claim or counterclaim the costs of the several issues respectively, both in law and fact, shall, unless otherwise ordered, follow the event. This rule does not apply to an action founded on infringement of patent right only. It applies to cases in which there are distinct causes of action, *e.g.*, where action is brought in respect of an alleged infringement of patent right and a passing off (*r*).

**Separate
issues.**

Strictly speaking, there is only one issue in an action of infringement, *viz.*, whether the defendant has infringed the

(*l*) See *Bibby & Bawn, Ltd. v. Duerden* (1911), 28 R. P. C. 305.

(*m*) R. S. C., Ord. xxvi. r. 1.

(*n*) *Vickers, Sons & Maxim, Ltd. v. Coventry Ordnance Works, Ltd.* (1907), 25 R. P. C. 207.

(*o*) *Haskell Golf Ball Co., Ltd. v. Hutchison* (1905), 22 R. P. C. 208; *Haskell Golf Ball Co. v. Hutchison*

(No. 2) (1905), 22 R. P. C. 477; of *Consolidated Pneumatic Tool Co., Ltd. v. Churchill & Co., Ltd.* (1905), 22 R. P. C. 209

(*p*) *Ibid.*

(*q*) *Ibid.*

(*r*) See *Haskell Golf Ball Co. v. Hutchison* (1906), 23 R. P. C. 129.

**Costs—
Apportionment.**

plaintiff's legal right (s); but it is customary to speak of the separate questions of validity and infringement on the assumption that they are distinct issues. It is in this sense that the above questions are described in the following pages as separate issues.

**Issues
abandoned at
the trial.**

The costs of issues raised by either party, but abandoned at the trial, are usually given against the party who raised them (t); though this rule does not necessarily apply where a party fights an issue till late in the trial and then gives it up on the ground that he is willing to depend upon some other issue (u).

Apportionment of costs.

Apportionment.—In considering the question of the apportionment of costs in patent cases, it will be well to divide the decisions into two classes—

- I. Those in which the validity of the patent was either not contested, or was established.
- II. Those in which the patent was declared invalid.

I. Where the plaintiff succeeds in upholding the validity of the patent, but fails to prove the fact of infringement, it appears to be the general rule that the Court will apportion the costs.

Where plaintiff upholds the patent, but fails to prove infringement.

Thus, in a case in which the plaintiff succeeded on the question of validity, and the defendant on that of infringement, *Bacon, V.-C.*, apportioned the costs, saying: "The costs of the suit, as far as relates to the futile attempt to dispute the plaintiff's right to a patent invention, must be borne by the defendant. The costs of the plaintiff's futile attempt to restrain the defendant from doing that which I think by law he is entitled to do, his patent not being an imitation or piracy of the plaintiff's, the plaintiff must pay him, and the one set of costs must be set off against the other" (x).

(s) See *Haskell Golf Ball Co. v. Hutchison* (1904), 22 R. P. C. 130.

(t) *Thompson v. The American Braided Wire Co.* (1889), 4 R. P. C. 316.

(u) *New Inverted Incandescent Gas Lamp Co., Ltd. v. Globe Light, Ltd.* (1905), 22 R. P. C. 439, 440.

(x) *Simmonds v. Hitchman* (1885),

L. R. 29 Ch. D. 417; see also *Automatic Weighing Machine Co. v. Knight* (1889), 6 R. P. C. 297; see also *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.* (1897), 14 R. P. C. 776, 777; *Foden v. Wallis & Stevens, Ltd.* (1908), 25 R. P. C. 507.

In an action brought for the infringement of two separate patents, the jury found some of the issues affecting the validity of the patents for the plaintiff and others for the defendant, and it was finally ordered "that the costs be left to abide the event of the several findings for the plaintiff and the defendant company respectively, in respect of the said two letters patent, and that the said costs be taxed on the higher scale, and that the plaintiff do recover nothing against the defendants, save and except the costs of the issues on which he has obtained judgment, and that, save as aforesaid, the defendant company do recover their costs of suit from the plaintiff" (*y*).

And in another instance the action was dismissed with costs, but the Court directed that the plaintiff should have his costs, which were incurred by reason of the defendant disputing the validity of the patent (*z*). In one case the Court of Appeal awarded the general costs to the defendant, but gave the costs of the issue of novelty, which was not decided, to neither side (*a*).

In an action in which the defendants appealed from a judgment for the plaintiff with costs, and the taxed costs were by consent paid into court pending an appeal, the Court of Appeal, without going into any other question, decided the issue of infringement in favour of the defendants, and dismissed the appeal with costs. On a subsequent application by the defendants for the repayment of the costs paid by them into Court, the Vice-Chancellor of the Palatine Court held that the plaintiff was not entitled to an apportioned part of these costs, attributable to points other than infringement, on which he had succeeded at the trial; and that the costs must be paid out of court without waiting for the result of an appeal to the House of Lords (*b*).

Where the House of Lords reversed the decision of the Court below on the issue of validity, and held that the patent was good, but upheld the finding that the defendant had

(*y*) *Westinghouse v. Lancashire and Yorkshire Ry. Co.* (1884), 1 R. P. C. 229, 254.

(*z*) *Nordenfelt v. Gardner* (1884), 1 R. P. C. 61, 75.

(*a*) *Needham v. Johnson* (1884), 1 R. P. C. 49, 59.

(*b*) *Boyd v. Horrocks* (1889), 6 R. P. C. 528.

Costs—
Apportionment.

not infringed, the appeal was dismissed, but no costs were given (c).

In an action which was dismissed, on the ground of no infringement, without going into the validity of the patent, and costs were given to the defendant, but no certificate was asked for as to the reasonableness and propriety of the particulars of objections (d), the plaintiff sought, without success, by taking out a summons to review the taxation, to set off the costs he had incurred by obtaining evidence to meet the defendant's objections (e). The plaintiff's contention was that the defendant's particulars were "improper, vexatious, or unnecessary" within the meaning of R. S. C., Ord. 65, rr. 7, 27, sub-r. 20, and that he was, therefore, entitled to the costs occasioned by them. The Court, however, held that the taxing master had rightly disallowed the defendant's costs of his particulars of objection, not because they were "improper, vexatious, or unnecessary," but simply because there had been no certificate, and it was a condition precedent, before the plaintiff could succeed, that he should show the costs of such particulars were disallowed on the ground that they were "improper, vexatious, or unnecessary."

Sometimes when the plaintiff succeeds on the issue of validity, but fails on the issue of infringement, though the plaintiff gets the chief part of the costs relative to validity, yet he does not get them all. The costs of some of the particulars of objections may be given to the defendant on the ground that such particulars were reasonable and proper and necessary for the purpose of defining the ambit of the claim (f).

The proper form of order when the plaintiff is given the costs of the issue of validity, and the defendant the general costs of the action, was discussed in *Shoe Machinery Co. v. Cutlan* (g).

(c) *Moore v. Bennett* (1884), 1 R. P. C. 129.

(d) See p. 536, *post*.

(e) *Garrard v. Edge*, W. N. (1890), pp. 43, 68.

(f) *Nobel's Explosives Co. v. Anderson* (1894), 11 R. P. C. 128.

(g) (No. 2) (1896), 13 R. P. C. 148, 398; see also *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.* (1897), 14 R. P. C. 775, 776; *White v. Hartley* (1902), 20 R. P. C. 265.

II. *There is no general rule as to the apportionment of costs where the plaintiff fails to uphold his patent, but is successful on the issue of infringement.*

Costs—
Apportionment.

The Court has a discretion in the matter which is exercised according to the circumstances of each case (*h*). It is proper for the Court, if, after hearing the evidence, it comes to the conclusion that issues were unnecessarily raised, to apportion the costs of those issues; but the Court will not apportion the costs of issues which have never been heard in consequence of a decision having been come to at the outset of the case against the validity of the patent (*i*).

Where plaintiff fails to uphold the patent, but proves infringement.

In some cases where the defendant has impeached the patent on more than one ground, but has not been successful on all, and the plaintiff has succeeded on the issue of infringement, the costs of the issues affecting the validity of the patent on which the defendant has failed have been given to the plaintiff, and the other costs of the action to the defendant (*k*).

A rule was stated by *Fry, J.*, in *Wegman v. Corcoran* (*l*), to the effect that where the plaintiff fails on the issue of validity, but succeeds on other issues, the Court gives the general costs of the action to the defendant, but as regards certain issues raised by the one side or the other, the Court apportions the costs according to the success of the parties.

This rule was approved and applied by the Court of Appeal in *Badische Anilin und Soda Fabrik v. Levinstein* (*m*). In this case *Bowen, L.J.*, said: "I am of opinion, in this case, that the plaintiffs should have the costs occasioned by the issues raised by the particulars of breaches, and that in respect of all the other costs (the costs in the action should follow the usual result, and be awarded to the successful party. It seems to me that without laying down any hard-and-fast line, or trying to fetter our discretion at a future period in any other case, we are acting on a sensible and sound principle, namely, the principle that parties ought not, even if right in

(*h*) *Kaye v. Chubb* (1887), 4 R. P. C. 289, 300, 303. 2 R. P. C. 179; *Lawrie v. Baker* (1885), 2 R. P. C. 213; *Lister v. Norton* (1886), 3 R. P. C. 199.
 (*i*) *Blakey v. Latham* (1889), 6 R. P. C. 184, 190. (*l*) (1879), 27 W. R. 357.
 (*k*) *Pooley v. Pointon* (1885), 2 R. P. C. 167; *Lawrence v. Perry* (1885), (*m*) (1885), L. R. 29 Ch. D. 366, 418, 420.

**Costs—
Certificates
as to Particulars.**

the action, to add to the expenses of an action by fighting issues in which they are in the wrong. It may be very reasonable as regards their own interest, and may help them in the conduct of the action, that they should raise issues in which in the end they are defeated; but the defendant who does so does it in his own interest, and I think he ought to do it at his own expense" (*n*).

This rule is by no means universally followed (*o*). Some Judges have, however, held that a plaintiff who has failed to substantiate his patent, but has succeeded on the issue of infringement, may be deprived of his costs of that issue, on the ground that in the opinion of the Court the issue was not sufficiently distinguished from the rest of the case (*p*); or that the costs of the issue were trifling (*q*); or on the ground that there can be no infringement of an invalid patent, and that it is consequently impossible for the plaintiff to succeed on the issue of infringement if the patent is bad (*r*). In one case where the infringement was admitted and the defendant succeeded on the ground of want of novelty he was awarded the costs of the anticipations proved and the plaintiff the costs of the issue of infringement, but no other costs (*s*).

Certificates as to Particulars.—It is provided by the Rules of the Supreme Court, Ord. 53A, r. 22, that, if the action proceeds to trial, no costs shall be allowed in respect of any issues raised in the particulars of breaches or particulars of objections and relating to the patent to the parties delivering the same, respectively, except in so far as such particulars are certified by the Court to have been proven or to have been reasonable and proper, without regard to the general costs of the case, but subject as aforesaid the costs of the issues raised by the particulars of breaches and the particulars of objections shall be in the discretion of the taxing master.

(*n*) (1885), L. R. 29 Ch. D. 419; see also *Boyd v. Horrocks* (1889), 6 R. P. C. 152, 162; *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syndicate* (1894), 11 R. P. C. 638; 12 R. P. C. 258, 303; *Haslam v. Hall* (1888), 5 R. P. C. 23; *Kane v. Guest* (1899), 16 R. P. C. 443.

(*o*) See, e.g., *Haskell Golf Ball Co. v. Hutchison* (1905), 22 R. P. C. 479; 23 R. P. C. 301.

(*p*) *Guilbert-Martin v. Kerr* (1887), 4 R. P. C. 23.

(*q*) *Kaye v. Chubb* (1887), 4 R. P. C. 289.

(*r*) *Edison v. Holland* (1888), 5 R. P. C. 483; *Blakey v. Latham* (1888), 6 R. P. C. 29; *United Telephone Co. v. Harrison* (1882), L. R. 21 Ch. D. 720.

(*s*) *Bennington v. Hill* (1891), 8 R. P. C. 327; cf. *Westley Richards v. Perkes* (1893), 10 R. P. C. 194; see also *Kane v. Guest* (1899), 16 R. P. C. 443.

Certificate of particulars is necessary on taxation.

Though upon the trial of the action some of the particulars of objections may not be certified by the Court, part of the costs relative to them may be allowed by the taxing master to the defendant as instructions for his defence and not as particulars of objections (*t*).

**Costs—
Certificates
as to Particulars.**

The above provisions do not apply to Scotland or Ireland. Sects. 94 (1) and 95 (2) of the Patents and Designs Act, 1907, expressly save the forms of process of the Courts in Scotland and Ireland respectively (*u*).

When the Court simply gives the successful party the costs of the action, it becomes the duty of the taxing master to tax the costs just as he would tax the costs of any other action except that he must not allow costs in respect of those particulars as to which no certificate has been given, and this principle must be applied to the taxation of the costs of expert evidence and proof of facts not admitted upon notice to admit (*x*).

If either party omits to ask at the trial for a certificate as to the reasonableness and propriety of his particulars, it is submitted that he may obtain it afterwards on summons in chambers (*y*), or on motion in Court (*z*); but he will be cast in the costs of such summons or motion (*a*).

Omission to ask for certificate at the trial.

In the event of the Court of Appeal reversing the decision of the Court below, the Court of Appeal has power to and will grant a certificate as to proof of, or the reasonableness and propriety of the particulars (*b*). Where the Court of Appeal reversed the decision of the Court below as to the validity of a patent, and granted a certificate as to some of the particulars of objections, *Cotton, L.J.*, said, in reference to sect. 29 of the Act of 1883, which is now represented by R. S. C., Ord. 53A, rr. 13—22: "I do not think that the Court of Appeal is the Court pointed at in that section, nor that the Judge in the Court of Appeal is the Judge pointed at; it must mean the Judge of the High Court who hears the matter originally,

Power of Court of Appeal and House of Lords to grant a certificate of particulars.

(*t*) See *Piggott & Co., Ltd. v. Corporation of Hanley* (1906), 23 R. P. C. 639.

(*u*) See *Mica Insulator Co., Ltd. v. Bruce, Peebles & Co., Ltd.* (1906), 24 R. P. C. 393.

(*x*) See *Haskell Golf Ball Co. v. Hutchison* (1906), 23 R. P. C. 129.

(*y*) Judicature Act, 1873, s. 39;

R. S. C. (1883), Ord. xlv. rr. 2, 17, 18; Ord. liv. r. 1.

(*z*) *Rowcliffe v. Morris* (1886), 3 R. P. C. 145.

(*a*) *Duckett v. Sankey* (1899), 16 R. P. C. 359.

(*b*) *Cole v. Saqui* (1889), 6 R. P. C. 41, 45; *Humpherson v. Syer* (1887), 4 R. P. C. 416.

**Costs—
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as to Particulars.**

or a Divisional Court of the High Court. But in the Court of Appeal we ought to make such order as in our opinion the Judge who heard the case ought to have made—the Judge from whom the appeal is. In this case we thought he ought to have dismissed the action, and then, of course, he ought to have considered what particulars were proven, or reasonable and proper. In our opinion we ought to do that, as he has not done it, and could not do it, having regard to the conclusion at which he arrived. That has really been done in several patent cases which have been before this branch of the Court, and, that being so, we ought in our opinion to grant a certificate stating what particulars were reasonable and proper” (*c*).

The House of Lords on the same principle has a similar jurisdiction (*d*).

Certificate as to particulars is granted in two distinct cases.

The Rules of the Supreme Court, Ord. 53A, r. 22, like sect. 29, sub-sect. 6, of the repealed Act of 1883, provide that the Court may grant the certificate as to particulars in two distinct cases—*i.e.*, (1) when the particulars have been proven, and (2) where in the opinion of the Court they are reasonable and proper. Neither party to an action of infringement can, when the action is brought to trial, be allowed the costs of his particulars on taxation except he is provided with the certificate of the Court or a Judge as to them (*e*). It is right for a party to specify numerous instances of breaches or anticipations, but if he can prove one or two—if one or two are sufficient for the case—the others should be kept in reserve, and not proved (*f*). Because it becomes unnecessary at the trial to prove some of the particulars, it is not to be inferred that the others were not reasonable and proper. It is submitted that they are reasonable and proper, and should be so certified unless they could not have been of any real assistance in any possible view of the case (*g*). The power of the Court to grant the certificate on the ground that the particulars were reasonable and proper applies as well to the particulars of breaches as to the particulars of objections (*h*). And where a

(*c*) *Cole v. Saqui* (1889), 6 R. P. C. 45.

(*d*) *Morris v. Young* (1895), 12 R. P. C. 465.

(*e*) See *Middleton v. Bradley* (1895), 12 R. P. C. 390.

(*f*) See *Cole v. Saqui* (1889), 5 R. P. C. 496.

(*g*) See *Clay v. Allcock & Co., Ltd.* (1906), 23 R. P. C. 387.

(*h*) See *Kane v. Guest* (1899), 16 R. P. C. 443.

defendant admits infringement and the validity of the patent is established the Court will certify the particulars of breaches (*i*).

The question arises whether, when the action is actually brought to a trial, but the case of the plaintiff breaks down on account of the patent being clearly proved to be void, or on an admission of one of the plaintiff's witnesses (*k*), or on the evidence offered by the defendant, or because the plaintiff offers no evidence (*l*), and the defendant is consequently not afforded an opportunity of proving his particulars, the Court can give a certificate that such particulars were reasonable and proper, and so enable him to obtain the costs of them (*m*). The rule is that the Court will only certify with regard to such of the particulars as the materials before the Court at the time the certificate is asked for enable it to say have either been proven or are reasonable and proper (*n*), and where the Court disposes of the action on one point it will not hear the case further for the purpose of deciding whether the other particulars should be certified or not (*o*), nor will it act in a subsequent case upon a decision as to similar particulars certified by the Court in a prior case between different parties (*p*).

The working of this rule in practice is well illustrated by the course pursued by the Court under the various circumstances hereafter detailed. Where the plaintiff's particulars alleged four distinct breaches, but no evidence was given as to one of them, and the plaintiff obtained the costs of the action, the certificate was confined to the particulars which had been proved (*q*). Where the plaintiffs failed in their action on the ground of the invalidity of the patent being

**Costs—
Certificates
as to Particulars.**

Certificate when action is not tried out on all the issues raised.

Rule that Court will only certify such particulars as the materials before the Court enable it to say are reasonable and proper.

(*i*) *British Motor Traction Co. v. Sherrin* (1901), 18 R. P. C. 275.

(*k*) *The Germ Milling Co. v. Robinson* (1886), 3 R. P. C. 254.

(*l*) *American Steel and Wire Co. v. W. T. Glover & Co., Ltd.* (1902), 19 R. P. C. 111; *Acetylene Illuminating Co. v. United Alkali Co.*, [1902] 1 Ch. 494.

(*m*) *Longbottom v. Shaw* (1888), 5 R. P. C. 497; (1889), 6 R. P. C. 143.

(*n*) *Mandleberg v. Morley* (1895), 12 R. P. C. 35, and cases there referred to; *Middleton v. Bradley* (1895), 12 R. P. C. 390; *Wilcox and Gibbs' Sewing Machine Co. v. Janes* (1897), 14 R. P. C. 524; *Bethell v. Gage* (1897),

14 R. P. C. 699; *New Inverted Incandescent Gas Lamp Co., Ltd. v. General Incandescent Co., Ltd.* (1905), 22 R. P. C. 614; *Cooper Patent Anchor Rail Co., Ltd. v. British Electric Equipment Co., Ltd.* (1906), 23 R. P. C. 606; but see p. 541, *post*.

(*o*) *Boyd v. Horrocks* (1889), 6 R. P. C. 162; *Longbottom v. Shaw* (1889), 6 R. P. C. 143; *Mandleberg v. Morley* (1895), 12 R. P. C. 35.

(*p*) *New Inverted Incandescent Gas Lamp Co., Ltd. v. General Incandescent Co., Ltd.* (1905), 22 R. P. C. 614.

(*q*) *Cole v. Saqui* (1888), 5 R. P. C. 489, 497.

**Costs—
Certificates
as to Particulars.**

established by one of their own witnesses, judgment was given for the defendants without their being called upon to go into their defence, and the Judge held that he must decide which of the particulars of objection were reasonable and proper in regard to the case so far as it had gone, and a certificate was granted to the defendant in respect of those particulars only which the Judge specifically mentioned. It was also held that the plaintiffs not being entitled to any costs, they were not entitled to any certificate in respect of their particulars of breaches (*r*). And where at the trial the plaintiff's case broke down on account of his first witness in cross-examination being unable to distinguish the alleged invention from a previous specification, and the action was accordingly dismissed, the defendant was allowed a certificate which was limited to the particulars involved in the decision of the Court (*s*). In a case where the plaintiff's first witness admitted in cross-examination that what the patentee and also the defendant actually did was not the alleged invention claimed and the case broke down accordingly, the witness was, by permission of the Judge, recalled and asked a further general question with reference to all the particulars of objections, and, upon his answer, the Judge certified as to all the particulars (*t*). Where the action was dismissed with costs, because the plaintiff did not offer any evidence, the Judge refused to certify as to the particulars of objections (*u*). And similarly, where at the trial the plaintiffs abandoned their case as to several patents sued on, but proceeded on one patent, the Court refused to certify as to the particulars relative exclusively to the abandoned patents (*x*). Where a case broke down on account of the impossibility of supporting the first claim of the patent, and the action was dismissed without the defendants being called on, *Kay, J.*, refused to give a certificate with regard to the particulars of objections, but gave

(*r*) *The Germ Milling Co. v. Robinson* (1886), 3 R. P. C. 254.

(*s*) *Griffin v. Feaver* (1889), 6 R. P. C. 396; see also *Albo-Carbon Light Co. v. Kidd* (1887), 4 R. P. C. 535; *Oddy v. Smith* (1888), 5 R. P. C. 503; *Slazenger v. Feltham* (1889), 6 R. P. C. 130; *Boyd v. Horrocks* (1889), 6 R. P. C. 152, 162; *Siddal and Hilton, Ltd. v. Wood* (1904), 21 R. P. C. 232.

(*t*) *Pegamoid, Ltd. v. British Leather-*

Cloth Manufacturing Co., Ltd. (1901), 18 R. P. C. 317. See also *Cooper Patent Anchor Rail Joint Co., Ltd. v. London County Council* (1906), 23 R. P. C. 296.

(*u*) *American Steel and Wire Co. v. W. T. Glover & Co., Ltd.* (1902), 19 R. P. C. 112.

(*x*) *Acetylene Illuminating Co. v. United Alkali Co.*, [1902] 1 Ch. 494.

costs on the higher scale and liberty to apply with regard to the costs of the particulars of objections (*y*). On the other hand, in another case, where the same learned Judge at the end of the plaintiff's case intimated that he would not call on the counsel for the defendant, and gave judgment in his favour, he not only refused a certificate in regard to the particulars of objections, but also refused to give liberty to apply (*z*). On taxation of the costs in the latter case the taxing master allowed the costs relating to or governed by the defendant's particulars, including the costs of the witnesses; but the Judge, on summons, varied the master's order by disallowing those costs, on the ground that the words of the Act of 1883 (*a*) are precise, and that as no certificate had been granted at the trial they could not be allowed (*b*). *Kay, J.*, in giving his decision, said: "There might well be a case where the matter was decided against the plaintiff without calling upon the defendant's counsel, and yet the Court, relying upon the evidence obtained by the defendant by cross-examining the witnesses, might think it right to look at the particulars of objections, and allow the costs of such particulars as were in fact made out by the cross-examination. I can quite understand that case occurring, and therefore I do not say that there might not be, in such a case as this, or in a similar case like that which I have just described, propriety in the Court looking into the particulars of objections, and saying whether they were reasonable or not, having regard to the specification" (*c*). Since these remarks were uttered there have been cases (*d*) in which the Court, being satisfied on the materials before it, has granted the certificate as to particulars of objections, though judgment was obtained before the defendant had an opportunity of giving any evidence.

Costs—
Certificates
as to Particulars.

Under the provisions of sect. 29 of the repealed Act of

(*y*) *Rowcliffe v. The Longford Wire, Iron, and Steel Co.* (1887), 4 R. P. C. 281, 288.

(*z*) *Longbottom v. Shaw* (1888), 5 R. P. C. 497, 502.

(*a*) Now incorporated in R. S. C., Ord. liiiA, r. 22.

(*b*) *Longbottom v. Shaw* (1889), 6 R. P. C. 510; *Garrard v. Edge* (1889), 6 R. P. C. 372, 563; (1890), 7 R. P. C. 139; but see *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas*

Light Co. (1897), 14 R. P. C. 776.

(*c*) (1889), 6 R. P. C. 513.

(*d*) *Heyes v. Hallmark* (1891), 9 R. P. C. 25; *Lees v. West London Cycle Stores* (1892), 9 R. P. C. 300; *Singer v. Rudge Cycle Co.* (1894), 11 R. P. C. 463, 585; *Mandleberg v. Morley* (1895), 12 R. P. C. 35; 64 L. J. Ch. 245; *Pegamoid, Ld. v. British Leather-Cloth Co., Ld.* (1901), 18 R. P. C. 317.

Costs—
Certificates
as to Par-
ticulars.

1883 a certificate that the plaintiff's particulars of breaches were reasonable and proper was given in several cases where judgment was entered for the plaintiff in default of appearance by the defendant (*e*). And a certificate as to particulars of objections was given in the Palatine Court where the defendant moved to dismiss the action for want of prosecution, and there was affidavit evidence sufficient to satisfy the Court that the particulars were reasonable (*f*). When the defendant did not appear or does not defend, the Courts inclined to act on the assumption that the defendant's conduct amounted to an admission that as against him the plaintiff's statements must be taken to be correct, and the particulars, or such of them as can be dealt with on this assumption, are reasonable and proper (*e*). In future, under any of the above states of facts, where the circumstances are such that the action does not proceed to trial, the Court, in view of R. S. C., Ord. 53A, r. 22, will not certify as to the particulars. Thus, in a recent case where the action proceeded to trial, and the defendant did not appear, the Court refused a certificate (*g*).

Where the defendant counterclaims for the revocation of the patent and the counterclaim is merely a repetition of the defence to the action, which cannot be proceeded with in the absence of evidence in the action, and the plaintiff submits to judgment when the action comes on for trial, since the action does not proceed to trial, and the case, consequently, falls within R. S. C., Ord. 53A, r. 22, both action and counterclaim will be dismissed with costs and a set-off (*h*).

Particulars
not proved
under a
specific ob-
jection but
necessary to
determina-
tion of
another issue.

There is the authority of the Court of Appeal for the statement that notwithstanding that the party giving particulars has not an opportunity of proving, or fails to prove the specific objection under which the detailed particulars may be ranged, it is the practice of the Court, owing to the difficulty of doing justice as regards costs in any other way, to certify such particulars as are material to the decision of

(*e*) *Pneumatic Tyre Co. v. J. Parr & Co.*, W. N. (1896) 88; *Pneumatic Tyre Co. v. Chisholm* (1896), 13 R. P. C. 488; *Brooks v. Hall* (1903), 21 R. P. C. 29; *Saccharin Corporation, Ltd. v. Skidmore* (1903), 21 R. P. C. 31; *Saccharin Corporation, Ltd. v. Hay* (1905), 22 R. P. C. 212.

(*f*) *Bates v. Horsfall* (1905), 22 R. P. C. 519.

(*g*) *May v. Yuill & Co.* (1910), 27 R. P. C. 525.

(*h*) *Babcock and Wilcox, Ltd. v. Water Tube Boiler and Engineering Co.* (1910), 27 R. P. C. 626.

some other issue in the action (*i*). Thus the certificate has been given as to some of the defendant's objections, though the patent was not held invalid on the special grounds alleged, because such particulars were necessary for the purpose in one case of defining the ambit of the plaintiff's claim (*k*), and in another case, for the purpose of deciding the issue of disconformity between the specifications (*l*). And a certificate has been given where the issue of invalidity was abandoned by the defendant late in the trial and he was successful on the issue of non-infringement (*m*). So also, according to the practice of the Scottish Courts, though a plea may ultimately be unsuccessful, it does not follow that expenses connected with it are to be wholly disallowed, and the evidence in support of such plea is not without influence on the result (*n*).

**Costs—
Certificates
as to Par-
ticulars.**

When the action is brought in respect of the infringement of several patents, and succeeds as to some but fails as to others, the Court will certify as to the particulars on which either party has succeeded, but will refuse to certify as to the particulars on which he failed (*o*).

Action in
respect of
several
patents.

Certificate of Validity.—It is provided by sect. 35 of the Act of 1907, which is a re-enactment of the provisions of sect. 31 of the Act of 1883, that "in an action for infringement of a patent the Court may certify that the validity of the patent came in question; and if the Court so certifies, then, in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall, unless the Court trying the action otherwise directs, have his full costs, charges, and expenses, as between solicitor and client" (*p*).

Effect of
certificate of
validity given
in a prior
action.

The certificate may be given notwithstanding the fact that the patent has expired at the date of the judgment (*q*).

(*i*) See *Castner-Kellner Alkali Co., Ltd. v. Commercial Development Co., Ltd.*, [1899] 1 Ch. 803; 16 R. P. C. 275.

(*k*) *Jardine v. King, Mendham & Co.* (1896), 13 R. P. C. 428; *Nobel's Explosives Co. v. Anderson* (1894), 11 R. P. C. 128; see also *Osmonds v. Balmoral Cycle Co.* (1898), 15 R. P. C. 522.

(*l*) *Castner-Kellner Alkali Co., Ltd. v. Commercial Development Co., Ltd.*, [1899] 1 Ch. 803; 16 R. P. C. 275.

(*m*) *New Inverted Incandescent Gas Lamp Co., Ltd. v. Globe Light Co., Ltd.* (1905), 22 R. P. C. 431.

(*n*) *Kelvin v. Whyte, Thomson & Co.* (1909), 26 R. P. C. 734.

(*o*) *Brooks v. Lamplugh* (1897), 15 R. P. C. 33.

(*p*) For forms of certificate, see *Seton*, 4th ed. p. 1661; *Pemberton*, 4th ed. p. 482.

(*q*) *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.* (1897), 14 R. P. C. 776.

Costs—
Certificate
of Validity.

Petition for
revocation.

In a second action a certificate obtained in a former action is not treated as applicable, if the specification has been amended in the interval between the two actions (*r*).

Under the Act of 1852, which authorised the Court to certify that the validity of the patent had been questioned, and provided that in a subsequent (*s*) suit or action touching such patent a plaintiff armed with the certificate of the Court given in a previous action might recover treble costs, if he was successful, it was enacted that such certificate might be given in evidence in any proceeding by *scire facias* to repeal the patent (*t*). It is to be observed, however, that there is no corresponding provision made by the Act of 1907 with regard to the certificate in reference to a petition for revocation of the patent, which is the modern substitute for the proceeding by *scire facias* (*u*).

Power of
Court of
Appeal and
House of
Lords and
Court of the
County
Palatine of
Lancaster to
grant a cer-
tificate of
validity.

The Court of Appeal, if it reverses a decision of the Court below against the patent, has power to grant a certificate that the validity has come in question, though it is not a "Court" within the meaning of the section. It is the duty of the Court of Appeal to make such order as the Judge who heard the case ought to have made, and, in the event of the Court of Appeal reversing the decision below on the question of validity, a certificate may be granted, on the ground that the finding should have been the other way (*x*). The House of Lords also for the same reason has a similar jurisdiction (*y*).

Should the Court of Appeal or House of Lords not grant the certificate, application for one may be made to the Judge of the Court below who tried the case (*z*). In a case under the old Acts the Court of Appeal refused a certificate, but gave the appellant leave to apply to the Judge below (*a*).

The Court of the County Palatine of Lancaster is not a Court within the meaning of the Act of 1907 (*b*), but it is submitted that the Chancery of Lancaster Act, 1890 (*c*), gives

(*r*) *Brooks (J. B.) & Co., Ltd. v. Rendall, Underwood & Co., Ltd.* (1907), 24 R. P. C. 27.

(*s*) *Bovill v. Hadley* (1861), 17 C. B. N. S. 435.

(*t*) 15 & 16 Vict. c. 83, s. 43.

(*u*) P. 289, *ante*.

(*x*) R. S. C. (1883), Ord. lviii. r. 4; *Cole v. Saqui* (1889), 6 R. P. C. 45;

Humpherson v. Syer (1887), 4 R. P. C. 416.

(*y*) *Morris v. Young* (1895), 12 R. P. C. 465.

(*z*) *Cropper v. Smith*, 2 R. P. C. 61.

(*a*) *Otto v. Linford* (1881), 46 L. T. N. S. 35.

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

(*c*) 53 & 54 Vict. c. 23, s. 3.

power to the Vice-Chancellor, or the Court of Appeal on appeal from his judgment, to grant a certificate entitling the plaintiff to solicitor and client's costs if successful in a subsequent action.

Costs—
Certificate
of Validity.

If a certificate that the validity of the patent was called in question is not asked for at the trial, it may probably be obtained by subsequent summons in chambers (*d*), or on motion in Court (*e*).

Omission to ask for certificate of validity at the trial.

If a certificate be granted there is no appeal, as it is not a judgment or order against which an appeal lies (*f*).

It seems that the grant of a certificate is discretionary in the Court or Judge (*g*).

In a case in which the result of the judgment was that the patent was invalid as regarded one claim, but that if the specification could be amended by omitting that claim the patent would be valid as to the remainder, *Stephen, J.*, granted a certificate that the validity had come in question, but made no reference to the finding on the point, and his Lordship stated that he could not refuse to certify the fact of the validity having been questioned (*h*). It must be observed that in the case last referred to the decision of *Stephen, J.*, was to the effect that the patent was valid to a certain extent, and the case is no authority for the proposition that the certificate should be given when the Court merely decides that the patent is bad and gives no decision as to what would be the result of an amendment of the specification, or pronounces no decision upon validity or invalidity at all. In such a case it would appear clear that the certificate should be refused (*i*).

It was held under the Act of 1835 that no certificate ought to be given when no evidence on the question of validity was offered, and judgment was entered for the plaintiff by consent (*l*); but where the defendant offered evidence against the

Certificate when no evidence on issue of validity is offered.

(*d*) Judicature Act, 1873, s. 39; R. S. C. (1883), Ords. liv. and lv.

(*e*) *Rowcliffe v. Morris* (1886), 3 R. P. C. 145.

(*f*) *Haslam v. Hall* (1888), L. R. 20 Q. B. D. 491; (1888), 5 R. P. C. 144; *Cropper v. Smith* (1885), 2 R. P. C. 63.

(*g*) 7 Edw. 7, c. 29, s. 35.

(*h*) *Haslam v. Hall* (1888), 5 R. P. C. 28; *Automatic Weighing Machine Co. v. Knight* (1889), 6 R. P. C. 113, 120;

Badische Anilin und Soda Fabrik v. La Société des Usines du Rhône (1897), 14 R. P. C. 892.

(*i*) See *Acetylene Illuminating Co., Ltd. v. United Alkali Co., Ltd.* (1902), 19 R. P. C. 234; *New Inverted Incandescent Gas Lamp Co., Ltd. v. Cope and Timmins, Ltd.* (1905), 23 R. P. C. 116.

(*k*) *Stocker v. Rodgers* (1843), 1 Car. & K. 99.

Costs—
Certificate
of Validity.

novelty of the invention, which failed, and was prevented from offering further evidence affecting the validity of the patent on other grounds, it was held that a certificate ought to be given (*l*).

And under the Act of 1883, where a defendant by his pleadings denied the validity of the patent, but did not appear at the trial, *Kay, J.*, holding that sect. 31 of the Act of 1883 only applied when the patent was established in a case contested in Court, refused to grant a certificate (*m*); and *Buckley, J.*, under similar circumstances, adopted the same course (*n*), though on a subsequent occasion, where the defendant appeared by counsel at the trial but took no part in it, he granted the certificate (*o*), and under like conditions *Farwell, J.*, permitted the plaintiff to give evidence shortly as to the validity of the patent, and then granted the certificate (*p*). *Kekewich, J.*, in the absence of authority to the contrary, granted the certificate (*q*), and pointed out that if a defendant, by non-appearance at the trial, could deprive a successful plaintiff of the right to a certificate as to the validity of the patent, the plaintiff might be put to the trouble of proving it all over again. And *Day, Farwell, Channell, and Buckley, JJ.*, and the Irish Master of the Rolls, in more recent cases, followed the course adopted by *Kekewich, J.* (*r*). But *Eve, J.* (*s*), refused to give a certificate on the ground that the practice might open the door to a collusive action. Where a case was settled by a compromise between the parties, *Collins, J.*, granted the certificate on the ground that the validity had undoubtedly been brought in question, though the parties had arranged between themselves how it was to be decided (*t*), and *Cozens-Hardy, J.*, granted the certificate where

(*l*) *Gillett v. Wilby* (1839), 1 W. P. C. 270.

(*m*) *Peroni v. Hudson* (1884), 1 R. P. C. 261, 263; *Stocker v. Rodgers* (1843), 1 Car. & K. 99.

(*n*) *Webb Lamp Co. v. Atkinson* (1902), 19 R. P. C. 599.

(*o*) *Consolidated Pneumatic Tool Co. v. Churchill & Co.* (1905), 22 R. P. C. 367.

(*p*) *Chadburn's (Ship) Telegraph Co. v. Robinson* (1905), 22 R. P. C. 468.

(*q*) *Haydock v. Bradbury* (1887), 4 R. P. C. 74.

(*r*) *Edison-Bell Phonograph Cor-*

poration v. Edison Phonograph Co. (1893), 11 R. P. C. 33; *Acetylene Illuminating Co. v. Midland Acetylene (Parent) Syndicate* (1900), 17 R. P. C. 534; *Welsbach Incandescent Gas Light Co. v. Krumm* (1901), 18 R. P. C. 211; *Welsbach Incandescent Gas Light Co. v. John McGrady & Co.* (1901), 18 R. P. C. 513; *Brooks v. Lycett (E.), Ltd.* (1904), 20 R. P. C. 392.

(*s*) *Gale v. O'Neill and Brown* (1910), 27 R. P. C. 10.

(*t*) *Delta Metal Co. v. Maxim-Nordenfelt Guns and Ammunition Co.* (1891), 8 R. P. C. 247.

the issue of validity was raised on the pleadings, but no evidence on that issue was offered at the trial (*u*). *Byrne, J.*, on the other hand, refused the certificate where the issue was raised and denied on the pleadings, but judgment for an injunction was given by consent, it being part of the settlement that a licence was to be granted to the defendant (*x*). In a recent action for interdict in Scotland, which was settled after proof was allowed but before any proof was taken, the Judge, being of opinion that there was no suggestion of collusion, granted the certificate (*y*).

It is not necessary that the plaintiff should be completely successful in the action to obtain a certificate of validity. The certificate has been given in many cases where the plaintiff, though successful on the issue of validity, has failed on that of infringement (*z*).

There does not appear to be any case in which a certificate of validity has been given where the defendant has admitted the validity of the patent upon a certain specific construction of the specification, found by the Court to be the true construction, which excludes the alleged infringement from the claim; and in such a case it is submitted that no certificate would be given (*a*). If, however, the defendant should, besides admitting validity, subject to a proviso as to construction, alternatively plead invalidity upon another construction, and succeed with reference to the special construction without arguing his case upon the other construction, it is submitted the Court might grant the certificate, though the case of validity was not contested in Court (*b*).

Where a certificate of validity has been granted in a previous action, it will not usually be granted again at the conclusion of a subsequent action (*c*). And if it is desired to claim solicitor

Costs—
Certificate
of Validity.

Certificate of validity may be given though plaintiff fails on the issue of infringement.

Certificate where defendant admits validity on certain construction of the specification.

Certificate of validity should be pleaded in a subsequent action.

(*u*) *Leeds Forge Co. v. Deighton's Patent Flue and Tube Co.* (1901), 18 R. P. C. 233.

(*x*) *Cloughton v. Foster* (1903), 21 R. P. C. 17.

(*y*) *Robertson v. Standard Piston Ring and Engineering Co., Ltd.* (1910), 27 R. P. C. 266.

(*z*) *Tweedale v. Ashworth* (1890), 7 R. P. C. 426; 8 R. P. C. 49; 9 R. P. C. 121; *Sunlight Incandescent Gas Lamp Co. v. Incandescent Gas Light Co.* (1897), 14 R. P. C. 776; *Morrison*

v. Asplen (1904), 21 R. P. C. 557.

(*a*) *Morris v. Young* (1895), 12 R. P. C. 464, 465.

(*b*) *Haydock v. Bradbury* (1887), 4 R. P. C. 74; *Edison-Bell Phonograph Corporation v. Edison Phonograph Co.* (1893), 11 R. P. C. 33; *Delta Metal Co. v. Maxim-Nordenfelt Guns and Ammunition Co.* (1891), 8 R. P. C. 247; *Morris v. Young* (1895), 12 R. P. C. 465.

(*c*) *Edison v. Holland* (1888), 6 R. P. C. 285.

**Costs—
Certificate
of Validity.**

Meaning of
"subsequent
action."

Solicitor and
client costs
are not
always given
though a cer-
tificate of
validity has
been obtained
in a prior
action.

and client's costs, the certificate ought, strictly speaking, to be pleaded in the subsequent action, though they may be given if the writ and statement of claim ask for them (*d*).

An action commenced but not determined at the time a certificate in another action is obtained is not a subsequent action for infringement within the meaning of sect. 35 of the Act of 1907, and the plaintiff cannot claim solicitor and client's costs on the production of the certificate and record of the first determined action (*e*).

Under the Act of 1852 the order on a motion for a new trial of an action subsequent to one in which a certificate of validity had been obtained was held not to be a "decree, decretal order or final judgment," and the plaintiff was not entitled to full costs (*f*). It is submitted that such an order, or an order on motion to commit for breach of an injunction, would not be a "final order or judgment" within sect. 35 of the Act of 1907, and, therefore, under the present practice the plaintiff could not on the strength of a certificate of validity claim solicitor and client's costs, if successful in resisting a motion for a new trial, or obtaining an order for committal for breach of an injunction (*g*).

It is to be noticed that the Act of 1907 provides that a plaintiff possessed of a certificate that the validity of his patent has been questioned is, in a subsequent action on obtaining a final order or judgment, to have his costs as between solicitor and client, *unless the Court trying the action otherwise directs*. Therefore, it is left to the discretion of the Court to deprive a successful plaintiff in a subsequent action of his full costs, if it is of opinion that he ought not to have them. The object of the enactment was to prevent patentees being put under the necessity of bringing repeated actions to determine their rights after the patent has been once established. There are many circumstances under which it might be improper that a plaintiff succeeding in a subsequent action should have solicitor and

(*d*) *Pneumatic Tyre Co. v. Chisholm* (1896), 13 R. P. C. 488.

(*e*) See *Automatic Weighing Machine Co. v. Combined Weighing Machine Co.* (1889), 6 R. P. C. 120; *Automatic Weighing Machine Co. v. International Hygienic Society* (1889), 6 R. P. C. 480; *Saccharin Corporation v. Anglo-Continental Chemical Works* (1909),

17 R. P. C. 320; [1901] 1 Ch. 417; *Penn v. Bibby* (1866), L. R. 3 Eq. 308; *Bovill v. Hadley* (1864), 17 C. B. N. S. 435.

(*f*) *Bovill v. Goodier* (1866), Griff. L. O. C. 49.

(*g*) See *Spencer v. The Ancoats Vale Rubber Co.* (1889), 6 R. P. C. 46, 48.

client costs, notably if it is proved that the first action was collusive (*h*) or vexatious (*i*), or the defendant is otherwise able to discharge the burden which is on him of showing cause why he should not pay solicitor and client costs (*k*).

Costs—
Certificate
of Validity.

The intention seems to be to protect patentees from being harassed by having to support their patents again after they have been contested and declared valid, and not to affect the question of the costs of the issue of infringement where the evidence before the Court is totally distinct from that which was presented in the former action, or there are other substantially new questions to be decided with reference to the patent or the specification.

For instance, where a certificate as to validity had been obtained, *Pearson, J.*, in a subsequent action, refused to give full solicitor and client costs on the ground that the patent was attacked on grounds which were not raised in the prior proceedings, but he granted the plaintiff a fresh certificate of validity, specifying to what extent the patent had been questioned (*l*). But *Romer, J.*, gave solicitor and client costs where in the subsequent action the patent was unsuccessfully contested on a point of ambiguity of specification which was not raised on the former occasion (*m*); and *Byrne, J.*, gave solicitor and client costs in a subsequent action on the express ground that the defendant had contested the ambit of the patent (*n*).

In a case under the Act of 1852, where the validity of the patent was subsequently contested on different grounds, Lord *Hatherley*, then Vice-Chancellor *Page Wood*, refused to give solicitor and client costs, on the ground that the former action was not conclusive as to the validity of the patent, for, after the plaintiff had obtained the judgment of the House of Lords in his favour, the Court of Queen's Bench

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

(*i*) *Proctor v. Sutton Lodge Chemical Works* (1888), 5 R. P. C. 184.

(*k*) *United Telephone Co. v. Patterson* (1889), 6 R. P. C. 142; *United Telephone Co. v. St. George* (1886), 3 R. P. C. 339; *Anti-Vibration Incandescent Lighting Co., Ltd. v. Wholesale Incandescent Fittings Co., Ltd.* (1906), 23 R. P. C. 399.

(*l*) *Otto v. Steel* (1886), 3 R. P. C. 109, 120.

(*m*) *Automatic Weighing Machine Co. v. Fearby* (1893), 10 R. P. C. 447; see also *Dunlop Pneumatic Tyre Co. v. New Ixion Tyre and Cycle Co.* (1898), 15 R. P. C. 389; 16 R. P. C. 16.

(*n*) *Dunlop Tyre Co. v. Wilson* (1900), 17 R. P. C. 336.

**Costs—
Certificate
of Validity.
Public
Authority.**

Solicitor and
client costs
when defen-
dant does not
dispute
validity.

directed a new trial, which, however, did not take place, in consequence of a compromise between the parties (*o*).

The fact that a defendant does not deny the validity of the patent, but only disputes the question of infringement, will not necessarily induce the Court to deprive a plaintiff who holds a certificate of validity of full solicitor and client costs (*p*); but, on the other hand, the plaintiff, though armed with a certificate that the validity of his patent was questioned in a prior action, will not be awarded full solicitor and client costs in a subsequent action where the only question raised is one of infringement, and the necessity for the subsequent action arises, in the opinion of the Court, from the lax manner in which the patentee's specification was drawn (*q*), or the specification being clear, the defendant has a plausible case on non-infringement (*r*); or there are other special reasons which induce the Court, in the exercise of its discretion, not to allow solicitor and client costs (*s*).

Public Authority.—A public authority party to an action of infringement, if successful, is, under the provisions of the Public Authorities Protection Act, 1893, entitled to solicitor and client costs, if the provisions of that Act apply (*t*). The provisions of the Act extend not only to a public body acting as principals in the execution of an Act of Parliament or

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

(*p*) *The United Telephone Co. v. Patterson* (1889), 6 R. P. C. 140; *Davenport v. Rylands* (1865), L. R. 1 Eq. 302, 308; *Pneumatic Tyre Co. v. West London Rubber and Tyre Co.* (1898), 15 R. P. C. 129; *Fabriques de Produits Chimiques de Thann et de Mulhouse v. Lafitte* (1899), 16 R. P. C. 61; *Welsbach Incandescent Gas Light Co. v. Daylight Incandescent Mantle Co.* (1899), 16 R. P. C. 354; *Saccharin Corporation v. Dawson* (1902), 19 R. P. C. 172.

(*q*) *Automatic Weighing Machine Co. v. International Hygienic Society* (1889), 6 R. P. C. 480; *Automatic Weighing Machine Co. v. National Exhibitions Association* (1891), 8 R. P. C. 352.

(*r*) *Saccharin Corporation v. Dawson* (1902), 19 R. P. C. 172.

(*s*) See *Welsbach Incandescent Gas*

Light Co. v. Daylight Incandescent Mantle Co. (1899), 16 R. P. C. 354. In this case the point that the subsequent action was necessitated by the lax manner in which the patentees' specification was drawn was not urged upon the Court. The defendant appealed upon the whole case, and the appeal was allowed with costs in the Court of Appeal and below, 17 R. P. C. 141; *British Vacuum Co., Ltd. v. Exton Hotels Co., Ltd.* (1906), 25 R. P. C. 630.

(*t*) See *Chamberlain and Hookham, Ltd. v. Mayor, &c. of Bradford* (1900), 17 R. P. C. 762; *Chamberlain and Hookham, Ltd. v. Mayor, &c. of Huddersfield* (1901), 18 R. P. C. 456; *Harrop v. Mayor of Ossett*, [1898] 1 Ch. 525; *North Metropolitan Tramways Co. v. London County Council*, [1898] 2 Ch. 145; *British Thomson-Houston Co. v. Mayor of Manchester* (1903), 20 R. P. C. 471.

public duty or authority, but also to the individual subordinates carrying out their mandates (*u*).

Party and Party Costs.—It is of great importance to litigants who are unsuccessful that they should not be oppressed by having to pay an excessive amount of costs; and it is a rule that the costs chargeable under a taxation, as between party and party, are only those necessary to enable the adverse party to conduct the litigation; any charges merely for conducting litigation more conveniently may be called luxuries, and must be paid by the party incurring them (*x*).

Experts' Fees.—When scientific evidence is necessary, proper fees to experts will be allowed (*y*); but only the fees of experts which relate to qualifying to give evidence in the particular case and to attendance in Court for the purpose of giving evidence should be allowed. Fees which relate to experiments performed to educate an expert apart from the special case should be disallowed (*z*). The expenses of experts who are not called as witnesses, but merely advise and assist counsel, whether in the Court of first instance or in the Court of Appeal, are "unusual expenses," and are not allowed on a party and party taxation unless a special order of the Court is obtained, which should be applied for at the hearing (*a*).

Drawings and Models.—An allowance may also be made in respect of the preparation of drawings or models when they are required (*b*); but the Court will not order such drawings and models to be given up to the party ordered to pay the costs of them (*c*). If the drawings and models are not really necessary, no allowance will be made in respect of them on taxation—*e.g.*, where drawings were only used for the purpose of being affixed to the margin of copies of evidence supplied to counsel, the costs of their preparation were disallowed, although the opposite party had asked for and been supplied with copies of them (*d*).

Costs—
Party and
Party
Costs.
Experts'
Fees.
Drawings
and Models.

Party and
party costs.

Scientific
evidence and
experts' fees.

Drawings and
models.

(*u*) *Bostock v. Ramsey* Urban District Council, [1900] 1 Q. B. 357.

(*x*) *Smith v. Buller* (1874), L. R. 19 Eq. 475.

(*y*) *Ibid.* 473; *Batley v. Kynock* (1875), L. R. 20 Eq. 632; *Musgrave v. Hicks* (1886), 3 R. P. C. 49.

(*z*) *Leonardt v. Kallé* (1895), 12 R. P. C. 306.

(*a*) *Consolidated Pneumatic Tool Co.*

v. Ingersoll Sergeant Drill Co. (1908), 25 R. P. C. 574.

(*b*) *Batley v. Kynock* (1875), L. R. 20 Eq. 632; *Musgrave v. Hicks* (1886), 3 R. P. C. 49; *Horrocks v. Stubbs* (1886), 3 R. P. C. 221.

(*c*) *Horrocks v. Stubbs* (1886), 3 R. P. C. 241.

(*d*) *Smith v. Buller* (1875), L. R. 19 Eq. 473.

Costs—
Three
Counsel
Shorthand
Notes.
Inquiry
as to
Damages.

Three
counsel.

Shorthand
notes.

Inquiry as to
damages.

Three Counsel.—The costs of three counsel may sometimes be allowed (*e*); but this should only be done when the case is one of multifarious issues and matters on which different minds might be properly employed, as it were dividing the labour among counsel; they should not be allowed in cases, though of great difficulty, where it is necessary for each counsel to get up the whole case (*f*).

Shorthand Notes.—A Judge has no power in the absence of arrangement to order shorthand notes of the evidence to be taken (*g*). Where shorthand notes are taken it is the usual and proper course for the parties to agree beforehand that the costs of them shall be costs in the cause, or to make some other mutual arrangement as to them. When this is not done the Court will sometimes give the costs of the shorthand notes as part of the costs in the action, and the necessary application should be made at the trial (*h*). But such an order is only made in exceptional cases (*i*).

The costs of a shorthand note of a judgment appealed from will generally be allowed by the Court of Appeal (*l*).

Inquiry as to Damages.—Where a plaintiff succeeds in obtaining an inquiry as to damages or an account of profits,

(*e*) *Incandescent Gas Light Co. v. Sunlight Incandescent Gas Light Co.* (1896), 13 R. P. C. 347; *Monnet v. Beck* (1897), 14 R. P. C. 850; *Pneumatic Tyre Co. v. Ixion Patent Pneumatic Tyre Co.* (1897), 14 R. P. C. 875; *Badische Anilin und Soda Fabrik v. La Société Chimique des Usines du Rhône* (1897), 14 R. P. C. 892; *Palmer Tyre, Ld. v. Pneumatic Tyre Co.* (1899), 16 R. P. C. 496; *Bradford Dyers' Association v. Bury* (1901), 19 R. P. C. 127; *Patent Exploitation, Ld. v. American Novelty and Manufacturing Co., Ld.* (1903), 20 R. P. C. 704; *Haskell Golf Ball Co. v. Hutchinson* (1905), 22 R. P. C. 478; 23 R. P. C. 301; *Farbenfabriken vormals Friedrich Bayer v. Chemische Fabrik von Heyden* (1905), 22 R. P. C. 501; *Marconi v. British Radio Telegraph and Telephone Co., Ld.* (1911), 28 R. P. C. 181.

(*f*) *Leonardt v. Kallé* (1895), 12 R. P. C. 306.

(*g*) *Hilleary v. Taylor* (1887), L. R. 36 Ch. D. 262; *Nobel's Explosives Co. v. Anderson* (1894), 11 R. P. C.

129. As to the relationship between judges' notes and shorthand notes, see *Gammons v. Singer Manufacturing Co.* (1904), 22 R. P. C. 129.

(*h*) *Earl De La Warr v. Miles* (1881), L. R. 19 Ch. D. 80; *Bowen v. Centaur Cycle Co.* (1891), 8 R. P. C. 113; *Incandescent Gas Light Co. v. De Mare Incandescent Gas Light System* (1896), 13 R. P. C. 333; *Incandescent Gas Light Co. v. Sunlight Gas Lamp Co.* (1896), 13 R. P. C. 346; *Monnet v. Beck* (1897), 14 R. P. C. 850; *Pneumatic Tyre Co. v. Ixion Patent Pneumatic Tyre Co.* (1897), 14 R. P. C. 875; *Castner-Kellner Alkali Co. v. Commercial Development Corporation* (1899), 16 R. P. C. 275; *Palmer Tyre Co., Ld. v. Pneumatic Tyre Co., Ld.* (1899), 16 R. P. C. 496.

(*i*) *Ibid.*; *Kelly v. Baylcs* (1879), L. R. 13 Ch. D. 693.

(*l*) *Collyer v. Isaacs* (1882), 45 L. T. N. S. 567; 30 W. R. 71; *London and South-Western Ry. Co. v. Groom* (1881), L. R. 20 Ch. D. 589; *Woodward v. Sansom* (1887), 4 R. P. C. 178.

and also obtains the general costs of the action, the Court, as a rule, will not give the costs of the inquiry as well as general costs of the action, but will reserve them, in order that the Judge before whom the inquiry is directed may have full control over the costs, and see that they are not unreasonably exaggerated (*l*).

Costs—
Costs on
Higher
Scale.

It is the duty of the officer of the Court before whom an inquiry as to damages or an account of profits is heard to take notes of the evidence, and if shorthand notes are taken no costs of them will in the absence of agreement between the parties be allowed (*m*).

Costs on Higher Scale.—It is provided (*n*) that costs on the higher scale may be allowed either generally in any cause or matter, or as to the costs of any particular application made or business done, in any cause or matter, if on special grounds arising out of the nature and importance or the difficulty or urgency of the case, the Court or a Judge shall, at the trial or hearing, or further consideration of the cause or matter, or at the hearing of any application therein, whether the cause or matter shall or shall not be brought to trial or hearing, or to further consideration (as the case may be), so order; or if the taxing officer, under directions given him for that purpose by the Court or a Judge, shall think that such allowance ought to be so made upon such special grounds as aforesaid.

Costs on the
higher scale.

Costs on the higher scale may be given by the Court of Appeal, although refused by the Court below; but the Court of Appeal does not usually allow them, there being no special reason for doing so (*o*).

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

(*l*) *Stark v. Midland Ry. Co.* (1881), L. R. 16 Ch. D. 81; *United Telephone Co. v. Fleming* (No. 2) (1886), 3 R. P. C. 282; *Moss v. Malings* (1886), 3 R. P. C. 379; *United Telephone Co. v. Faulkner* (1886), 3 R. P. C. 282 *n.*; *Cole v. Saqui* (1888), 5 R. P. C. 497; *Needham v. Oxley*, Seton, 4th ed. p. 353.

(*m*) *Ungar v. Sugg* (1892), 9 R. P. C. 113.

(*n*) S. C. R. (1883), Ord. lxx. r. 9.

(*o*) *Automatic Weighing Machine Co. v. Knight* (1889), 6 R. P. C. 310.

(*p*) *Fraser v. Province of Brescia Steam Tramways Co.* (1887), 56 L. T. N. S. 771; 3 Times R. 587.

Costs—
Costs on
Higher
Scale.

costs on the higher scale have been allowed in many patent cases, on the ground that the case of the successful party being of exceptional difficulty has involved a protracted examination of witnesses, the calling of expert evidence, or the preparation of drawings and models (*q*), whether the patent has been previously supported or not; though costs on the higher scale have been refused where complications of the case were due to the unfortunate wording of both an original and an amended specification (*r*), and in many other cases. It is more general for the Court to give costs on the higher scale in chemical cases than it is in purely mechanical or electrical cases (*s*).

Where costs on the higher scale have been asked for, on the ground that the defendant submitted to an injunction (*t*), or that important questions were raised (*u*), or that the defendant did not appear at the trial (*x*), they have been refused; and it would appear that the fact that the damages claimed amount to a large sum is not sufficient reason for directing the costs to be taxed on the higher scale (*y*).

Where an application is made at the trial for costs on the higher scale which is refused, the question may be reserved till after the taxation, and liberty given to apply, so that the successful party may have an opportunity of showing that he has suffered an injustice, if such be the fact, by the taxation having been made on the lower scale (*z*).

(*q*) *Westinghouse v. L. & Y. Ry. Co.* (1884), 1 R. P. C. 103; *Easterbrook v. G. W. Ry. Co.* (1885), 2 R. P. C. 212; *Watling v. Stevens* (1886), 3 R. P. C. 43; *Otto v. Steel* (1886), 3 R. P. C. 120; *Wenham v. May* (1887), 4 R. P. C. 310; *Kaye v. Chubb* (1887), 4 R. P. C. 289; *Ellington v. Clark* (1888), 5 R. P. C. 528; *Edison v. Holland* (1888), 5 R. P. C. 459; *Blakey v. Latham* (1889), 6 R. P. C. 29; *Automatic Weighing Machine Co. v. International Hygienic Society* (1889), 6 R. P. C. 475; *Tweedale v. Ashworth* (1890), 7 R. P. C. 426; *Farbenfabriken vorm. F. Bayer & Co. v. Bowker* (1891), 8 R. P. C. 389; *Hopkinson v. St. James's and Pall Mall Electric Light Co.* (1892), 10 R. P. C. 46; *Edison-Bell Phonograph Co. v. Smith* (1894), 11 R. P. C. 161; *Hookham v. Johnson* (1897), 14 R. P. C. 525; *Haskell*

Golf Ball Co. v. Hutchison (1905), 22 R. P. C. 478; but see *Leonardt v. Kallé* (1895), 12 R. P. C. 120.

(*r*) *Wenham Gas Co. v. Champion Gas Lamp Co.* (1890), 7 R. P. C. 313.

(*s*) See *Marconi v. British Radio Telegraph and Telephone Co., Ltd.* (1911), 28 R. P. C. 220.

(*t*) *Hudson v. Osgerby* (1884), 32 W. R. 566.

(*u*) *Grafton v. Watson* (1884), 51 L. T. N. S. 141; *Cardiff Steamship Co. v. Barwick* (1885), 53 L. T. N. S. 56.

(*x*) *Peroni v. Hudson* (1884), 1 R. P. C. 261.

(*y*) *Spettigue's Trusts* (1884), 32 W. R. 385; *The Horace* (1884), L. R. 9 P. D. 86.

(*z*) *Crampton v. The Patents Investments Co.* (1888), 5 R. P. C. 282, 404.

Stay Pending Appeal.

STAY PENDING APPEAL.

If the party who has been unsuccessful in a patent action intends to enter notice of appeal he may sometimes succeed in obtaining an order from the Court staying the proceedings on the judgment till the hearing and determination of the appeal (*a*): but a stay is by no means the general rule (*b*).

Stay is not usual.

The application must in the first instance be made to the Court below and not to the Appellate Court (*c*); but if the Court below refuse to make an order staying proceedings, an application may be made to the Appellate Court, and an application of this nature is not properly an appeal motion, and need not be brought within twenty-one days after the refusal of the Court below (*d*).

Application for a stay.

Sometimes, pending an appeal, the Court in its discretion will grant a stay of an injunction on the undertaking of the defendant to keep an account (*e*); or will grant a stay for a time sufficient to allow of the defendant giving notice of appeal and making an application to the Court of Appeal to stay the injunction or to advance the appeal and stay the injunction till the hearing (*f*). Where there is a special reason (*g*) the Court, in view of an appeal, orders the taxation of costs, and, if the appeal is not heard before the completion of the taxation, the money to be paid over on the personal undertaking of the solicitor to return it in the event of the appeal succeeding (*h*); but though this is frequently done it is not the usual order (*i*), and the refusal of a solicitor to give an undertaking, in the absence of an order, is not a

Circumstances which induce the Court to grant a stay.

(*a*) *Adair v. Young* (1879), L. R. 11 Ch. D. 136; *Woodward v. Sansom* (1886), 3 R. P. C. 366; *Humpherson v. Syer* (1887), 4 R. P. C. 189; *Proctor v. Bennis* (1887), 4 R. P. C. 363; *Otto v. Steel* (1886), 3 R. P. C. 121.

(*b*) *Edge v. Johnson* (1892), 9 R. P. C. 142; *Lancashire Explosives Co. v. Roburite Explosives Co.* (1895), 12 R. P. C. 483.

(*c*) *Otto v. Lindford* (1880), L. R. 18 Ch. D. 394; *Cropper v. Smith* (1883), L. R. 24 Ch. D. 305.

(*d*) *Cropper v. Smith* (1883), L. R. 24 Ch. D. 305.

(*e*) *Hocking v. Fraser* (1886), 3 R.

P. C. 7; *North British Rubber Co. v. Gormully, Jeffery & Co.* (1896), 13 R. P. C. 691; 14 R. P. C. 283.

(*f*) *Leeds Forge Co. v. Deighton's Patent Flue and Tube Co.* (1901), 18 R. P. C. 240.

(*g*) *Pneumatic Tyre Co. v. East London Rubber Co.* (1897), 14 R. P. C. 590.

(*h*) *Ticket Punch Register Co. v. Colley's Patents* (1895), 12 R. P. C. 10.

(*i*) Per Lindley, L.J., *Badische Anilin und Soda Fabrik v. Johnson* (1897), 14 R. P. C. 418.

Stay Pending Appeal.

Costs of application for a stay.

special circumstance entitling the unsuccessful party to a stay (*k*). Neither is it usual to stay an inquiry as to damages or the taking of an account pending an appeal (*l*), though frequently a stay is granted in respect of an order for the delivery up or destruction of the defendant's goods (*m*).

Usually the costs of an application for an order to stay proceedings have to be borne by the party making it in any event (*n*); but sometimes they are made costs in the appeal (*o*). Where the plaintiffs obtained a judgment granting a perpetual injunction restraining infringement and an account of profits, and the defendant entered an appeal, and moved for an order staying proceedings under the order for an account, the Court thought that, under the circumstances, the proper course was to advance the appeal, but as the plaintiff thereby obtained a benefit the costs of the application should be costs in the appeal (*p*).

(*k*) *Att.-Gen. v. Emerson* (1889), L. R. 24 Q. B. D. 56; *John Vasey, Ld. v. Walker, Mitchell & Co.* (1899), 16 R. P. C. 606; *British Vacuum Cleaner Co., Ld. v. London & South Western Ry. Co.* (1911), 28 R. P. C. 108.

(*l*) *Chadburn v. Mehan* (1895), 12 R. P. C. 135; *Evans & Taunton, Ld. v. Hoskin & Sewell, Ld.* (1901), 21 R. P. C. 682; *Hyam v. Terry* (1880), 29 W. R. 32.

(*m*) *English and American Machinery Co. v. Union Boot and Shoe Machine Co.* (1894), 11 R. P. C. 142; *Howes v. Webber* (1895), 12 R. P. C. 470.

(*n*) *Cooper v. Cooper* (1875), L. R. 2 Ch. D. 493; *Merry v. Nickalls* (1873), L. R. 8 Ch. App. Cas. 205.

(*o*) *Adair v. Young* (1879), 11 Ch. D. 6.

(*p*) *Adair v. Young* (1879), L. R. 11 Ch. D. 136.

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