

objection that the description of the invention is not distinct from the description of the manner in which it is to be performed (s). It would seem, however, that the provisional specification cannot be used to supplement deficiencies in description in the complete (t).

The drawings are also part of the specification (u), and apparently an improvement may be sufficiently claimed though it only appears from the drawings and is not referred to as an improvement in the letterpress (x), though in other cases it has been pointed out that drawings alone cannot define the limits of the monopoly claimed (y).

Claim must be confined to what is useful.

Since a valid patent can only be granted for an invention which is both new and useful it is essential that the claim should be confined not only to what is new, but also to what is useful, and if this is not so the patent is bad for insufficiency (z). Thus, if a class of material or apparatus be named, and only some members of this class be useful, the patent is bad unless the general knowledge in the trade would enable competent workmen to know which would be useful and which would not (a). The insufficiency in this case may be looked on as insufficiency in defining the invention, or in describing the manner in which it is to be performed, and is conveniently treated under the latter head.

Test for sufficiency of directions.

In deciding whether the patentee has sufficiently described the manner in which the invention is to be performed the main rule is that it is essential that such directions be given that a competent workman endowed with the trade knowledge of the date of the grant (b) should know the necessary and appropriate

*Thomas v. Welch* (1866), L. R. 1 C. P. 192; *Parkes v. Stevens* (1869), L. R. 8 Eq. 358, 5 Ch. App. 36.

(s) *Penn v. Jack* (1866), 14 L. T. 95.

(t) *MacKelcan v. Rennie* (1862), 13 C. B. (N. S.) 52.

(u) Sect. 2 (3).

(x) *Hattersley v. Hodgson*, 23 R. P. C. 193, H. L.

(y) *Gillies v. Dunbar* (1877), 4 S. V. 337, I. H.; *Macfarlane v. Price* (1818), 1 Stark. 199; *Kopp v. Rosenwald*, 20 R. P. C. 154, C. A.; *Robertson v. Purdey*, 24 R. P. C., at p. 297; *Tolson v. Speight*, 13 R. P. C., at p. 722.

(z) *Hill v. Thompson & Forman* (1817), W. P. C. 237; *United Horse-*

*nail Machinery Coy. v. Stewart*, 2 R. P. C. 132, O. H.

The fact that a patentee expresses a preference for certain methods does not prevent the specification being insufficient if other methods covered by it are old. *European Eibel Coy. v. Lloyd (Edward) & Coy., Ltd.*, 28 R. P. C. 349; or not useful, *Simpson v. Holliday* (1866), L. R. 1 H. L. 315; *Kurtz v. Spence*, 5 R. P. C. 161, 182; cf., however, *Watson Laidlaw & Coy. v. Potts Cassel & Williamson*, p. 92, n. (p).

(a) See p. 91, n. (o).

(b) *Z. Electric Lamp Coy. v. Marples*, 27 R. P. C. 737, 745, C. A.; *Incandescent Gas Lighting Coy. v. De Mare Incandescent System*, 13

materials, apparatus, and conditions for successfully carrying out the invention (c). The patentee need not include directions to matters which such a workman should have known at the date of the grant (d), but he cannot call in aid matters not known at that date (e).

The expression "workman skilled in the art" must be interpreted to some extent differently for different classes of patents, according to the class of person who will really have to apply the knowledge such workman is deemed to possess. For example, in the case of patents for the production of synthetic dyes, or for other highly technical objects, the description would probably be considered sufficient if it would enable the ordinary manager of a factory to give proper directions to the workmen, and it would not be necessary to include directions as to matters of practice with which he would be well acquainted, but which possibly inferior workmen would not know (f). On the other hand, the directions for carrying out some small improvement should be such as to enable the ordinary workman to understand them without further explanation (g).

Workman  
skilled in  
the art.

R. P. C. 301, 320; *Tiemann's Patent*, 16 R. P. C. 575.

(c) *Vidal Dye Syndicate, Ltd. v. Levinstein*, 29 R. P. C. 245, C. A.; *British Dynamite Coy. v. Krebs* (1879), 13 R. P. C. 192; *Badische Anilin und Soda Fabrik v. Levinstein*, 4 R. P. C. 449, H. L.; *Edison & Swan Coy. v. Holland*, 6 R. P. C. 243, 280, C. A.; *Lane-Fox v. Kensington Electric Lighting Coy.*, 9 R. P. C. 413, 417, C. A.; *Sirdar Rubber Coy., Ltd. v. Wallington Weston & Coy.*, 23 R. P. C. 132, C. A.; *Incandescent Gas Light Coy. v. De Mare Incandescent Gas Light System*, 13 R. P. C. 301; *Nicholls v. Kershaw*, 27 R. P. C. 237, 250; *Arkwright's Patent* (1785), W. P. C. 68. See also *Hornblower v. Boulton* (1799), 8 T. R. 95; *Gibson v. Campbell* (1841), W. P. C. 627; *Bloxam v. Elsee* (1827), 6 B. & C. 169. And cases at p. 161, n. (a).

(d) *Hopkinson v. St. James's Electric Light Coy.*, 10 R. P. C. 46, 61; *Edison Bell Phonograph Corporation v. Smith*, 11 R. P. C. 389, 403, C. A.

(e) *Lane-Fox v. Kensington Electric Lighting Coy.*, 9 R. P. C. 248, 417, C. A.; *Robertson v. Purdey*, 24 R. P. C. 273, 292. See also p. 92, n. (p).

(f) *Badische, &c. v. Levinstein, ubi supra*; *Incandescent Gas Light Coy. v. De Mare Incandescent Gas Light System*, 13 R. P. C. 301, 327; *Tiemann's Patent*, 16 R. P. C. 561, 574, 575. See also *Neilson v. Harford* (1841), W. P. C. 314; *Edison v. Holland*, 6 R. P. C. 280.

(g) *Plimpton v. Malcolmson* (1876), 3 Ch. D. 536, 568, and cases at p. 90, n. (e).

The class of workman to be considered is that who would carry out the invention, e.g. in the case of a patent for electric lamps lampmakers, not chemists. *Z. Electric Lamp Coy. v. Marples*, 27 R. P. C. 305, 737, C. A. See also *Osram Lamp Works v. Z. Electric Lamp Coy.*, 29 R. P. C. 424.

The fact that persons not skilled in the trade occasionally work at some branches of it does not make them "workmen skilled in the art" for this purpose. Thus, where the directions given in a patent for making golf balls were sufficient for a man skilled in working gutta-percha, but not for golf professionals, who, in fact, often mould or remake balls, the specification was held sufficient. *Haskell Golf Ball Coy., Ltd. v. Hutchinson*, 22 R. P. C. 478, 493.

Experiment  
should be  
unnecessary.

Generally the description is insufficient if it renders it necessary for the person who attempts to carry it out to make a series of experiments in order to see how the invention can be performed or to get any beneficial effect at all (*h*). But this rule must be reasonably interpreted in view of the particular subject-matter of the patent, and it is recognised that it may often be necessary, even if the description be sufficient, to make a certain number of trials to ascertain the best working conditions, or arrive at a successful result (*i*). This especially applies to patents, such as chemical patents, where a large number of different bodies may have to be dealt with, or where the conditions or the results sought vary largely (*k*). On the other hand, if the invention is for some small detail the description should be such that this is unnecessary (*l*), and the need for such trials should in all cases be reduced to a minimum. Further, the patentee must show that the competent workman should know what trials to make and how to perform them (*m*). Subject to this limitation the directions must be sufficient to enable the invention to be applied in all cases within the ambit of the patent, and if special directions are necessary for its due execution in particular cases these must be given (*n*).

(*h*) *Sirdar Rubber Coy., Ltd. v. Wallington Weston & Coy.*, 23 R. P. C. 132, 138, C. A. See also *R. v. Arkwright* (1785), W. P. C. 66; *R. v. Wheeler* (1819), 2 B. & Ald. 345; *Morgan v. Seward* (1837), 2 M. & W. 544; *Bailey v. Robertson* (1878), L. R. 3 A. C. 1055, H. L.; *United Horseshoe and Nail Coy. v. Stewart*, 2 R. P. C. 132, O. H.; *Pooley v. Pointon*, 2 R. P. C. 167; *Lane-Fox v. Kensington & Knightsbridge Electric Lighting Coy.*, 9 R. P. C. 221, 248, and 413, C. A.; *Hookham v. Johnson*, 14 R. P. C. 525, 563; *Kinmond v. Keay*, 20 R. P. C. 497, L. H.

(*i*) *Edison & Swan Coy. v. Holland*, 6 R. P. C. 243, 282, C. A.; *Leonhardt v. Kallé*, 12 R. P. C. 103, 116. See also *British Dynamite Coy. v. Krebs* (1879), 13 R. P. C. 190, H. L.; *Neilson v. Harford* (1841), W. P. C. 320; *Beard v. Egerton* (1846), 8 C. B. 165.

A very wide interpretation has been given to this by the judgment of the L. H. in *Watson Laidlaw & Coy., Ltd. v. Potts Cassel and Williamson*, 27 R. P. C. 541. On appeal the H. L. were equally divided, see 28 R. P. C. 565.

(*k*) In some cases even a specification may be sufficient if it indicates a class of bodies, and experiments are necessary, although the general limits of the class are known, in the case of a few bodies to ascertain whether they come within this class. *Thermit, Ltd. v. Weldite, Ltd.*, 24 R. P. C. 441, 461, see p. 92, *n. (o)*.

(*l*) *Hinks v. Safety Lighting Coy.* (1876), 4 Ch. D. 607, 617; *Fletcher v. Arden*, 5 R. P. C. 46; *Kinmond v. Keay, supra*.

(*m*) *E.g.* patent for making puttees of material cut on a curve to fit the leg held good, although only one example was given and the shape would necessarily have to be altered for each individual case. *Fox v. Astrachans, Ltd.*, 27 R. P. C. 377, and see also cases at p. 95, *n. (z)*.

(*n*) In the case of a patent for a machine for giving an edge to knives, scissors, and other cutting instruments, the specification described the use of two circular files of steel, but said that other rollers might be used according to the delicacy of edge required. It was shown that for scissors one circular file and one

If the patentee mentions a class of bodies as coming within the ambit of his patent or as suitable for use in carrying it out and some of such bodies are not suitable, the patent is bad for insufficiency unless either there is some indication given which would lead to the workman rejecting the unsuitable bodies, or a competent workman would have the knowledge necessary to enable him to select those bodies which were suitable (o). Again, if a patent is said to be applicable for a

Limits of usefulness should be defined.

smooth roller must be employed unless the rollers were made of Turkey stone. The patent was held bad for insufficiency, there being no direction as to making the rollers for scissors. *Felton v. Greaves* (1829), 3 Car. & P. 611.

In the case of a patent for the production of dyes the patentee specified four bodies which were to be treated with sulphur. With regard to one of these bodies it was found that the directions as to heating, etc., given for bodies generally were not sufficient to enable the result to be arrived at. In the case of another it was found that only one of two alternative methods would be effective. The patent was held bad on both grounds. *Vidal Dyes Syndicate v. Levinstein*, 29 R. P. C. 245, C. A. See also *Arkwright's Patent* (1785), W. P. C. 69; *Morgan v. Seward* (1837), W. P. C. 184; *Maxim-Nordensfeldt Coy. v. Anderson*, 14 R. P. C. 371, 385; 671, C. A.; 15 R. P. C. 421, H. L.; *Tiemann's Patent*, 16 R. P. C. 575; *Kopp v. Rosenwald*, 20 R. P. C. 154, C. A.; *Carnegie v. Bell Brothers, Ltd.*, 26 R. P. C. 265; *United Horsenail Machinery Coy. v. Stewart*, 2 R. P. C. 132, O. H.; *Ellington v. Clark*, 5 R. P. C. 319, 337, C. A.; but cf. *Watson Laidlaw & Coy., Ltd. v. Potts Cassel and Williamson*, p. 92, n. (p).

(o) The following are examples of insufficient directions:—

Where a specification gave a direction to take "fossil salt" and it was objected that there was only one "fossil salt" that would do, it was held that if this were so the patent would be bad. (The patent was upheld on a new trial.) *Turner v. Winter* (1787), W. P. C. 77.

Where a patent was taken out for making belts from "hard woven" cotton canvas, and it was shown that ten qualities of this were known in the

trade, of which only three were suitable for the purposes of the invention, and no evidence was given that a workman would know which to use, the patent was held bad for insufficiency. *Gandy v. Reddaway*, 2 R. P. C. 49.

Where the specification of a patent for inserting rings into bobbins did not define the wood of which the bobbins were to be made, the Court was of opinion that the patent must be held to extend to all woods of which bobbins were ordinarily made, and that as the process would not work with hard wood bobbins, the patent was bad for want of utility. *Wilson Brothers Bobbin Coy., Ltd. v. Wilson & Coy. (Barnsley), Ltd.*, 20 R. P. C. 1 H. L.

(This decision was in form on utility, but the issues of utility and insufficiency often run together, see per Lord DAVEY, at 20 R. P. C. 14.)

Where the specification of a patent for making rollers for grinding corn said that the patentee "preferred china" for making them, and it was proved that nothing else would do, it was held that the patent was bad. *Wegman v. Corkran*, 13 Ch. D. 65, C. A.; but cf. *Brown's Patent*, 24 R. P. C. 313, C. A. See also *Crompton v. Ibbetson*, p. 96, n. (f); *Stevens v. Keating* (1847), 2 W. P. C. 175, 183; *European Eibel Coy. v. Lloyd*, 28 R. P. C. 349.

The following are examples of directions which have been held sufficient:—

Where a patentee spoke of "gun-powder or other proper combustible," this was held sufficient, the evidence being that a workman would know which he could use. *Bickford v. Skewes* (1841), W. P. C. 214.

Where a specification for improvements in wet spinning spoke of "flax and like yarns," this was held sufficient, since the process was

number of purposes or if it is said that a class of processes can be used in connection with the patent, a similar rule would apply (*p*).

applicable to any yarns usually spun wet. *Pirrie v. York Street Flax Spinning Coy.*, 11 R. P. C. 429, C. A. Ir.

Where a specification contained a direction to use reducing agents, and a number of examples were given, it was held that the patentee was not bound to give an exhaustive list, or to state which gave better and which gave worse results. *Leonhardt v. Kalle*, 12 R. P. C. 103.

Where a specification for an improved wire mattress, made so as to be under a diagonal strain, described fully one arrangement with a proper mesh, and then said that other meshes might be used, it was held that the specification was sufficient since it clearly only included meshes capable of taking a diagonal strain, and a competent workman would know which these were. *Evans v. Hoskins*, 24 R. P. C. 517, C. A.

Where the specification of a patent for a method of reducing metals and making alloys by the use of aluminium gave certain examples and then continued, "In the same manner all the metals or their alloys mentioned in the first part of the specification can be gained," and there was, in fact, no limitation of the metals given in the specification, and the process did not work with many metals, it was held that the specification clearly only dealt with metals reducible by aluminium, and that it was well known to chemists which these were, though a few experiments might have to be made with metals on the border line, and that the specification was sufficient. *Thermit, Ltd. v. Weldite, Ltd.*, *ubi supra*. See also *British Ore Concentration Syndicate v. Minerals Separation Coy.*, 26 R. P. C. 124, 140, C. A., but *cf.* same case in H. L., 27 R. P. C. 33; *British Dynamite Coy. v. Krebs* (1879), 13 R. P. C. 190, H. L.; *Gaulard and Gibbs' Patent*, 6 R. P. C. 215, 224, C. A.; *cf. contra*, *Stevens v. Keating* (1847), 2 W. P. C. 175, 183; *Ralston v. Smith* (1865), 11 H. L. C. 223; *Flour Oxidising Coy., Ltd. v. Hutchinson*, 26 R. P. C. 597.

If the directions were sufficient in the state of the art at the date of

the grant, the sufficiency is not affected by the fact that at a later date other materials came into use in the art. A patentee need not have "the spirit of prophecy." *Clegg's Patent* (1829), W. P. C. 103; *Incan-descent Gas Light Coy. v. De Mare Incandescent Gas Light System*, 13 R. P. C. 559, C. A.

(*p*) The following are examples of insufficient directions of this nature:—

Where a specification gave a direction to perform a certain chemical operation in an autoclave, it was proved that there were two types of autoclaves in use, viz. iron and enamelled autoclaves, and that the action only took place successfully in an iron autoclave, the iron, in fact, taking part in the reaction. The distinction was not indicated in the specification (or known to the inventor) and the patent was held bad for insufficiency. *Badische v. La Société des Usines de Rhone*, 15 R. P. C. 359, C. A.

Where a specification described two processes and said that one was the more speedy and effective, and it was proved that, in fact, the other would not work at all, the patent was bad for insufficiency. *Simpson v. Holliday* (1866), L. R. 1 H. L. 315. See also *per* WESTBURY, L.C., 12 L. T., at p. 99; *Vidal Dye Syndicate v. Levinstein*, p. 91, *n.* (*n*); *cf.* also *Ellington v. Clark*, 5 R. P. C. 327, C. A.

In the following case this principle was held not to apply.

In the case of a patent for a centrifugal drier, in which the old practice had been to put a shaft in a very flat conical bearing with an angle of about 51° to 60°, the inventor in a disclaiming note said that his bearings were to have the shape of a cone approaching much more nearly to a cylinder than in the former practice. The drawings in his specification showed angles of 25° to 40°. In practice the patentee used 10°, and it was admitted by his witnesses that 5° to 25° were the useful limits (28 R. P. C. 575, but see *contra*, 27 R. P. C. 562). Held by the I.H. that the patent was good. The exact angle formed no part of the

The Courts, however, are not anxious, if a specification is fairly drawn, to find it bad for insufficiency because it does not deal with exceptional and out-of-the-way cases (*q*), or because some rare or special material, which a workman would not be likely to choose (*r*), might come within the words of the specification and will not act, or because the words do not exclude some mistake which the competent workman should not make (*s*).

Where a patent introduces a great change from the old practice of the trade, it is not proper for the patentee to leave out working directions and say that they may be supplied from the old practice, since a workman reading the patent would not in general know which parts of such practice were applicable (*t*). Fuller directions needed where there is large change in practice.

invention, and must be varied according to the special object and could be determined by experiment. On appeal to the House of Lords the House was equally divided (*Watson, Laidlaw & Coy. v. Potts, Cassel, and Williamson*, 25 R. P. C. 337; 27 R. P. C. 541, I.H.; 28 R. P. C. 565, H.L.).

(*q*) *Morgan v. Seaward* (1837), W. P. C., at p. 180.

(*r*) Thus, where a direction was given to use "carbon gas" and "carbonic gas" in making lamp filaments, and it was objected that the term would include CO and CO<sub>2</sub>, which would be useless, the patent was upheld, the Court being satisfied on the evidence that no competent man would think of using these. *Edison and Swan Coy. v. Woodhouse* (2nd action), 4 R. P. C. 99, C. A.; *Same v. Holland*, 6 R. P. C. 243, C. A. See also *Stevens v. Keating* (1847), 2 W. P. C. 175, 183; *Thermit v. Weldite, supra*; *Flour Oxidising Coy., Ltd. v. Hutchinson*, 26 R. P. C. 597, 626.

(*s*) Thus where a direction was given to use two nuts on a screw so that one might be sure of catching, the Court refused to hold the specification bad because it did not guard against the chance of a workman choosing nuts of different pitches. *Edison Bell Phonograph Corporation v. Smith*, 11 R. P. C. 389, C. A. See also *Beard v. Egerton* (1848), 8 C. B. 165; *Farbenfabriken &c. v. Bowker*, 8 R. P. C. 389; *Hopkinson v. St. James' Electric Light Coy.*, 10 R. P. C. 46, 61.

In *Z. Electric Lamp Coy. v. Marples*, 27 R. P. C. 305, 316, and 737, C. A., it was held that where a passage *might* lead a workman to adopt a certain unsuitable substitute, the fact that he would necessarily have to make a preliminary analysis which would show him his error, prevented the specification from being misleading.

(*t*) Thus where in a patent for a new form of motor tyre the inventor stated that the former idea that there must be a tight fit between every part of the tyre and rim that came into contact was wrong, and it was proved that it was necessary to have a certain portion (the base) of the tyre made convex so as to give a tight fit, and there was no direction as to this, it was held that the patent was bad for insufficiency, although it had been the former practice to make the base of the tyre in this way. *Sirdar Rubber Coy., Ltd. v. Wallington Weston & Coy.*, 23 R. P. C. 132, 140, C. A. See also *Bailey v. Robertson* (1878), 4 S. IV. pp. 559-560, approved by Lord BLACKBURN, 3 A. C. 1080; *Maxim-Nordenfeldt Coy., Ltd. v. Anderson*, 14 R. P. C. 671, 683, C. A.; *Kinmond v. Keay*, 20 R. P. C. 493.

It is also more necessary to give full instructions when the subject-matter of a patent is a dangerous substance, and a workman would therefore be afraid to make variations. *Maxim-Nordenfeldt Coy., Ltd. v. Anderson*, 671, 683, C. A.

Necessary directions.

The directions given must also include a description of how to prepare the materials necessary for carrying out the invention unless these are articles known and procurable in this country (*u*), or as to whose preparation directions are given in recognised text-books (*x*), in which case it is sufficient to state their ordinary name. Any direction which makes the obtaining or preparing of such materials unnecessarily complicated may render the patent bad (*y*).

Proportions and similar details also should be given where they are necessary for the proper working of the invention. But many patents are for general processes for mixing or employing two substances, and are in no way

(*u*) The following are examples of this :—

Where in a specification a direction was given to use "the finest and purest chemical white lead," it was proved that no white lead sold by chemists in this country would do, but there was a special quality made in Germany which had to be used. Lord LYNDHURST was of opinion that the patent was bad for insufficiency. *Sturz v. De la Rue* (1828), 5 Russ. 322.

Where a patentee directed that certain rollers should be covered with china, and it was proved that no china ordinarily made in this country would do, the patent was held bad. *Wegman v. Corkran* (1879), 13 Ch. D. 65, C. A.

Where in a specification a direction was given that certain bituminous schistus should be freed from iron, but the method was not shown, the patent was held bad since it did not appear either that the method of separating the iron was well known, or that bituminous schistus free from iron was procurable in this country except from the patentee. *Derosne v. Farie* (1835), 2 Cr. M. & R. 476.

The following are examples of cases where special directions were held to be unnecessary :—

Where a direction was given to use nitrogen gas, it was held that it was unnecessary to describe its preparation since this was well known. *Edison v. Woodhouse* (2nd action), *ubi supra*; *Edison v. Holland*, *ubi supra*.

Where a patent involved the use of transformers it was held that it

was unnecessary to describe their construction, this being well known. *Gaulard and Gibbs' Patent*, 7 R. P. C. 367, H. L.

Where a patent was taken out for making lithographic stones, BIS-TOWE, V.C., was of opinion that the patentee was not bound to give directions as to the method of using them for obtaining transfers, although special means were necessary. (This seems a doubtful decision.) *Coles v. Bayliss*, 3 R. P. C. 178. See also *Badische, &c. v. Levinstein*, 6 R. P. C. 387, H. L.; *Gill v. Coutts*, 13 R. P. C. 125, 138, I. H.

(*x*) *Z Electric Lamp Coy. v. Marples*, 27 R. P. C. 318. It should be noted that it was also found that the substance here in question was sold commercially at the date of the patent, and in the C. A. the judgment seems to have been based solely on the latter ground. See 27 R. P. C. 744.

There may be certain highly scientific branches of trade where the literature consists of patent specifications. *Vidal Dye Syndicate, Ltd. v. Levinstein*, 29 R. P. C. 260, C. A.

(*y*) Thus, where in a patent for making scidlitz powders the specifications gave recipes for making three substances to be mixed to form the final substance, but did not disclose that these three substances were respectively Rochelle salt, carbonate of soda, and tartaric acid, all of which were readily procurable upon the market, the patent was held bad. *Savory v. Price* (1823), 1 Ry. & M. I.

confined to the proportions. In such cases the proportions need not be given, or at any rate may be indicated very broadly (z).

It is not necessary for the patentee to deal with matters of scientific theory or give particulars of merely scientific interest (a), nor need the patentee of a process producing various substances give their composition or even point out which are commercially useful (b). Again, the patentee is not bound to point out the advantages secured by his invention or from which part of it they proceed (c), or to go into questions What need not be stated.

(z) *Betts v. Menzies* (1862), 10 H. L. C. 117; *Betts v. Neilson* (1871), L. R. 5 H. L. 1; *Patent Type Foundry Coy. v. Richards* (1860), 1 Johns 381; *Muntz v. Foster* (1844), 2 W. P. C. 93; *British Ore Concentration Syndicate, Ltd. v. Minerals Separation Coy.*, 26 R. P. C. 124, 139, C. A., but see same case in H. L. 27 R. P. C. 33.

For cases where it has been held that instructions were sufficient see, in addition to cases given above, *British Dynamite Coy. v. Krebs* (1879), 13 R. P. C. 190, H. L.; *Leonhardt v. Kall*, 12 R. P. C. 103; *Incandescent Gas Lighting Coy. v. De Mare Incandescent System*, 13 R. P. C. 301 & 559, C. A.; *Scotts' Patent*, 19 R. P. C. 273. See also *R. v. Wheeler* (1819), 2 B. & Ald. 345.

Further directions as to heating, etc. were considered necessary in *Turner v. Winter* (1787), W. P. C. 77. (It appears the patent was upheld on the new trial, see p. 82), as to switching off cells in *Lane-Fox v. Kensington Electric Lighting Coy.*, 9 R. P. C. 221, 248, and 413, 417, C. A.; as to timing operations and fixing a bracket in *Kinmond v. Kcay*, 20 R. P. C. 498, O. H.; as to methods for excluding light from camera in *Nicholls v. Kershaw*, 27 R. P. C. 237, 250.

Further directions as to heating and proportions, and as to meaning in a particular reaction of "reduction" were considered necessary in *Vidal Dye Syndicate, Ltd. v. Levinstein*, 29 R. P. C. 245, C. A.

For other cases see *Maxim-Nordenfeldt Coy., Ltd. v. Anderson*, 14 R. P. C. 371, 384 and 671, 683, C. A.; *Carnegie v. Bell Brothers, Ltd.*, 26

R. P. C. 265; *Weir v. Dinney*, 11 R. P. C. 657, O. H.

The omission to state that the workman must assist the machine at a certain part of the operation was held to be immaterial. *Miller & Coy. v. Clyde Bridge Steel Coy., Ltd.*, 8 R. P. C. 198, 201, O. H. See also *Dudgcon v. Thomson* (1873), 3 S. XI. 863, 872, I. H.

In *British Vacuum Cleaner Coy., Ltd. v. L. & S. W. R. Coy.*, 29 R. P. C. 309 H. L., it was held that the specification was not insufficient because no directions were given as to the vacuum at the nozzle, the directions as to the vacuum at the filter being sufficient. See also *Edison and Swan Coy. v. Holland*, 6 R. P. C. 243, 282, C. A., and p. 91, n. (o).

(a) *Leonhardt v. Kall*; 12 R. P. C. 103, 116; *Atkins and Applegarth v. Castner-Kellner Alkali Coy.*, 18 R. P. C. 281, 293; *Gill v. Coutts*, 13 R. P. C. 125, 138; *Andrews' Patent*, 24 R. P. C. 349, 372, 373, C. A., and 25 R. P. C. 477, H. L. Anonymous referred to in *Jupe v. Pratt* (1837), W. P. C. 147.

But where the patentee stated that a certain step in his process produced a certain intermediate substance, and the statement was untrue, the patent was held bad. *Monnet v. Beck*, 14 R. P. C. 846.

(b) *Badische, &c. v. Levinstein*, 6 R. P. C. 387.

(c) *Pickard v. Prescott*, 7 R. P. C. 365, O. H.; *Perry v. Société des Lunetiers*, 13 R. P. C. 664, see, however, p. 138, n. (u), and cf. *Von der Linde v. Brummerstaedt*, 26 R. P. C. 289.



as to the comparative advantages of the different methods specified (*d*).

Need of  
*bona fides*.

It is not only necessary that a patentee (*e*) should show a method that will work; he is bound to show the best method that he knows of, and to give all the information that he has so as to enable the user to obtain the full benefit, and all that had been said as to sufficiency of directions must be considered as subject to this further consideration. Any lack of *bona fides* in the preparation of the specification, either by the omission of useful information or by the introduction of unnecessary obscurities or complication as to the nature of the materials, apparatus, or method of working, is fatal to the patent (*f*).

(*d*) *Kurtz v. Spence*, 5 R. P. C. 161, 183. See also *Thomson v. Batty*, 6 R. P. C. 84, 91, but see *n. (f)*, *infra*.

(*e*) It should be noted that the patentee for this purpose means the person to whom the grant is made, and it is not an objection to the validity of a patent taken out by a person in this country on a communication from abroad, that the foreign communicator had knowledge which would have enabled him to give more perfect directions. *Plimpton v. Malcolmson* (1876), 3 Ch. D. 531, 582.

But, of course, the directions given must be sufficient to attain a useful result. *Wegman v. Corkran*, *ubi supra*. See also *Coles v. Bayliss*, 3 R. P. C. 178.

(*f*) Examples of this are as follows:—

Where a patent was granted for making steel trusses, and it was proved that the patentee in fact used tallow to facilitate the carrying out of his invention, but had not disclosed this, the patent was held bad. *Anonymous* (temp. Lord MANSFIELD), W. P. C. 175 *n*.

Where the specification of a patent for making verdigris described a process which made good verdigris, but it was proved that the patentee was in the habit of secretly putting into the copper *aqua fortis*, which dissolved the ingredients more quickly, the patent was held bad. *Wood v. Zimmer* (1815), 1 W. P. C. 44, 82 *n*.

Where the patentee had made experiments and found that only one

particular kind of cloth would do for the web of a printing machine, and then said in his specification, "the cloth may be made of any suitable material, but I prefer it should be made of (naming the particular material)" the patent was held bad. *Crompton v. Ibbotson* (1828), 6 L. J. (O. S.) 214.

In the case of Thomson's patent for a new compass card the specification described the use of silk threads for joining the ring to the box. The objection was taken that before the complete specification was lodged the patentee had applied for a second patent for the use of wires for this purpose. KEKEWICH, J., expressed the opinion that this would have been a serious objection had it been proved that the patentee thought that wires were the best, but that as it appeared he considered the use of wires a mere unimportant variant, the patent was good. *Thomson v. Batty*, 6 R. P. C. 84.

In *Lewis v. Marling* (1829), 10 B. & C. 22, it was held that a direction to use an article which afterwards turned out to be unnecessary did not invalidate a patent, and it is clearly laid down that this objection is based on want of *bona fides*. See also *Turner v. Winter* (1787), W. P. C. 80; *Huddart v. Grimshaw* (1803), 2 B. & Ald. 377; *Bovill v. Moore* (1815), Davies 361, 400; *R. v. Arkwright* (1785), W. P. C. 64; *Morgan v. Seaward* (1837), W. P. C. 182; *British Dynamite Coy. v. Krebs* (1897), 13 R. P. C. 190 H. L.; *Badische, &c. v. Levinstein*, 4 R. P. C. 449.

It is sometimes a matter of

But of course it is no objection to the sufficiency of a patent that the patentee has subsequently discovered a better method nor is the fact of his adopting other methods necessarily evidence that the method described in the specification is not the best (*g*).

Of course for this purpose, as for all others, the specification must be read as a whole, and the general directions may correct the effect of some special mistake or omission (*h*). It is now no

Specification to be read as a whole.

considerable difficulty to decide what information a patentee must give to fulfil this obligation. Although there is no decision on the subject it is probable that a patentee is only bound to give the information in his possession specially affecting the patented invention apart from other machinery or processes of the same class. For example, if a patent is taken out for a special form of lubricating machinery, and the patentee had a secret recipe for a lubricant which, in fact, was the best lubricant to use, not only with this special form of machinery, but also with other forms, he would not be bound to disclose its composition in his specification. But, on the other hand, if this special form of machinery needed a lubricant of a special character, and he knew this, and the proper lubricant to use, he would probably be held bound to describe it in his specification, though he could, if he chose, make it the subject of a separate patent.

(*g*) *Hardmuth v. Baker*, 21 R. P. C. 504, 511. But see *R. v. Arkwright* (1785), W. P. C. 64.

Statements made by the patentee are available as evidence against him on this point (*R. v. Arkwright, ubi supra*). The fact that he is in the habit of supplementing the descriptions given in the specification by private directions to users may throw doubts on his *bona fides*. *Pooley v. Pointon*, 2 R. P. C. 167. See also *Bailey v. Robertson* (1878), 4 S. IV. 545.

(*h*) Examples of this are:—

Where the specification spoke of the inner edges of the runners of a skate losing their angularity and being reversed so as to get a new edge, this was held to be a sufficient direction that they were to be placed obliquely. *Plimpton v. Malcolmson* (1876), 3 Ch. D. 531, 581.

Where the specification of a patent for an improved apparatus for disinfecting by means of steam stated that

the steam for the outer chamber was to be taken from a high-pressure boiler, and the door of the chamber in which it was to be used was made especially strong, this was held a sufficient indication that the steam in the inner chamber was to be kept dry by means of high pressure steam in the outer chamber. *Lyon v. Goddard*, 11 R. P. C. 354, H. L.; but *cf. Tolson v. Speight*, 13 R. P. C., at p. 722.

Where the specification of a patent for making candy said "the compound is boiled or cooked commonly at a temperature of about 212° F. till the mass assumes that particular condition known in the art as 'hard tack,'" and it was proved to be necessary to heat to 230°–250° F. to arrive at this condition, the direction was held to be sufficient, since the practical man did not rely on the thermometer, but heated his substance till it arrived at the required state. *Kane v. Boyle*, 18 R. P. C. 325.

Where the specification of a patent for impregnating canvas belts with rubber contained no direction as to limiting the degree of heat employed, and it was proved that a high temperature would be detrimental, it was held that the fact that the drawing showed the belt being carried past a screen in front of an open fire sufficiently indicated that only a moderate degree of heat should be used. *Dick v. Tullis*, 13 R. P. C. 149.

Where in a patent for wireless transmitters and receivers the patentee made it clear that he was seeking "tuning," a direction that the coupling of the transformers should be "loose," was read into the patent, since a skilled man would know that this was necessary for tuning. *Marconi v. British Radio-Telegraph Coy.*, 28 R. P. C. 181. See also *Leonhardt v. Kallé*, 12 R. P. C. 103; *Thermit, Ltd. v. Weldite, Ltd.*, 24 R. P. C. 441; *Evans v. Hoskins*, 24 R. P. C. 517, C. A. See *contra Turner v. Winter, ubi supra*; *R. v. Metcalfe* (1817),

objection to a specification that the description of how to carry out the invention necessitates a reference to drawings (*i*) or to other specifications mentioned therein (*k*). The question as to whether it is sufficient if important features are only indicated in the drawings and are not referred to in the body of the specification must be regarded as a question of fact in each case (*l*).

False suggestions.

Another objection to a patent may be conveniently considered under the head of insufficiency, although theoretically it has a different origin. This is that the patent is void if it contains false suggestions which may be presumed to have induced the grant (*m*). This doctrine was formerly very widely applied so as to cover nearly every objection which could be raised to a patent, it being said that the grant was obtained on the suggestion that the patent was new and useful, and that the patentee was the first and true inventor, and that if any of these facts were untrue the patent would have been obtained by means of a false suggestion. The modern practice is rather to treat lack of novelty or utility, etc., as preventing a patent from coming within the exception contained in the Statute of Monopolies. But there are certain cases in which the question of false suggestion still arises, as, for example, where a patentee claims some advantage from his invention which is not realised, or points out alleged defects of old methods which in fact did not exist (*n*).

Effect of errors.

In many cases the question has been considered of how far a specification is vitiated by containing statements in the nature of mistakes which should not mislead a competent workman. Generally speaking, the Courts in modern times would not hold a specification to be bad for anything which obviously was a clerical error or a misuse of words which any competent workman would see to be such, and know how to correct, at any rate in a part which was not the essence of the

W. P. C. 141*n* (really a decision on disconformity).

So, too, it is no objection that foreign terms or measurements are used if the general meaning is clear. *Bloxam v. Elsee* (1823), 11 C. & P. 558.

(*i*) See p. 89, *nn.* (*c*), (*d*), (*e*), and *Lyon v. Goddard*, *ubi supra*. A contrary rule was laid down in some old cases, as in *Ex parte Fox* (1812), W. P. C. 431*n*. See also *Bovill v. Moore* (1815), *Davies*, at p. 369; *Bloxam v. Elsee* (1825), 1 C. & P. 558; *Gaulard and Gibbs' Patent*, 6 R. P. C. 215, 224, C. A.

(*k*) *Harmer v. Playne* (1809), 11

East. 101; *Lister v. Leather* (1858), 8 E. & B. 1004.

(*l*) See cases at p. 89, *nn.* (*d*) and (*e*).

(*m*) The onus of proving the falsity rests with the defendant. *Flour Oxidising Coy., Ltd. v. Hutchinson*, 26 R. P. C. 597, 633.

(*n*) *Owen's Patent*, 17 R. P. C. 68, 637. See also *Easterbrook v. Great Western Railway Coy.*, 2 R. P. C. 201. (The decision was in form on non-utility.) *Turner v. Winter* (1787), W. P. C. 77. This objection was also pleaded in *Hardmuth v. Baker*, 21 R. P. C. 507, but was not discussed.

invention (o). Thus, if the terms used are proper ones, as addressed to the ordinary workman, the patent is not held bad because these terms are scientifically incorrect (p), nor is the patent affected because of mistaken theories if the process works (q). In the same way errors in the drawing, if the drawings are merely by way of example, would not be held to vitiate a patent, if the competent workman would see at once what the error was and how to correct it. In fact the Courts hold that such statements would not in fact mislead and therefore do not vitiate the specification, but this only applies to errors discoverable without trouble or experiment (r). So also

(o) *Simpson v. Holliday* (1866), L. R. 1 H. L. 315, where it is pointed out that this must be limited to errors apparent on the face of the specification, and not needing experiment to demonstrate them, and does not extend to material false suggestions as to processes being practicable which are in fact useless. The error must be obvious to the competent workman, not merely to the expert, *Knight v. Argylls, Ltd.*, 29 R. P. C. 610. See also *Morgan v. Seaward* (1837), W. P. C. 176; *Beard v. Egerton* (1846), 9 L. J. (C. P.) 36; *Farbenfabriken v. Bowker*, 8 R. P. C. 389, 396; *Miller (H.) & Coy. v. Scarle Baker & Coy.*, 10 R. P. C. 106, 111; *Montgomery v. Paterson*, 11 R. P. C. 232; *Kane v. Boyle*, 18 R. P. C. 325, 366; *British United Shoe Machinery Coy., Ltd. v. Fussell*, 25 R. P. C. 368, 385; *Z. Electric Lamp Coy. v. Marples*, 27 R. P. C. 737, C. A.; and judgments of Lords ROBSON and SHAW in *British Vacuum Cleaner Coy., Ltd. v. L. & S. W. Rly. Coy.*, 29 R. P. C. 303, H. L. See also cases in p. 97, n. (h). A contrary rule was laid down though not acted upon in *Neilson v. Harford* (1841), W. P. C. 371. See also *Hinks v. Safety Lighting Coy.* (1876), 4 Ch. D. 607.

(p) Thus where a specification spoke of using liquid hydrocarbons, and gave examples including beeswax, and it was objected that a hydrocarbon properly meant a body only containing hydrogen and carbon, and would not include beeswax, it was held that the term was clearly not used in its strict scientific sense and that no one would be misled. *Edison and Swan Coy. v. Woodhouse* (2nd action), 4 R. P. C. 99, C. A.; *Jame v. Holland*, 6 R. P. C. 243, C. A.

Where a direction was given to mix mohair and silk "when in the raw state," and it was objected that they could not be mixed in the raw state as understood by an importer, i.e. before the silk was boiled, it was held that as the specification was addressed to spinners who would understand what stage was meant it was sufficient. *Lister v. Norton*, 3 R. P. C. 199.

Where a specification held to be addressed to lamp makers spoke of "phospham," the objection that chemically pure phospham would not act was overruled, since what was commercially sold as phospham would. *Z. Electric Lamp Coy. v. Marples*, 27 R. P. C. 737, C. A. See also *Simpson v. Holliday* (1865), 12 L. T. 101; *R. v. Metcalfe* (1817), 2 St. 249; *Minter v. Mower* (1835), W. P. C. 141; *Beard v. Egerton* (1846), 8 C. B. 165; *Haskell Golf Ball Coy., Ltd. v. Hutchinson*, 22 R. P. C. 478, 492. Case quoted in argument in *Jupe v. Pratt*, W. P. C. 147; *Flour Oxidising Coy. v. Hutchinson*, 26 R. P. C. 597, 626, 627, and cases at p. 97, n. (h).

(q) *Andrews' Patent*, 24 R. P. C. 349, 372, and 25 R. P. C. 477, C. A.; *Z. Electric Lamp Coy. v. Marples*, 27 R. P. C. 737, C. A.; *Vidal Dyes Syndicate v. Levinstein, Ltd.*, 29 R. P. C. at p. 268, C. A.; *Otto v. Steel*, 3 R. P. C. 109. But cf. *contra* *European Eibel Coy. v. Lloyd*, 28 R. P. C. 349.

This applies with special force where the theories put forward were generally accepted at the date of the patent. *Andrew's Patent, ubi supra*; *Z. Electric Lamp Coy. v. Marples, ubi supra*, at p. 745.

(r) See n. (o), *supra*.

somewhat loose statements as to the advantages of the invention are passed over if not substantially misleading (s). But where a definite statement is made that the invention can be performed in one of several ways and this in fact is not true, the patentee cannot be heard to say that no one would have tried the unsuccessful ways (t).

Sufficiency of description is question of fact.

The question of sufficiency—at any rate the sufficiency of the description of how the invention is to be performed—is essentially one for the jury, though directions may be given as to the meaning of the specification (u). Evidence is received not only as to the meaning of terms, but also as to whether the description is sufficient for the competent workman to carry out the invention. In particular evidence is frequently offered of the invention having in fact been carried out from the description in the specification (x).

Connection of sufficiency with other issues.

Since the question before the Court is whether the invention described in the specification is new and useful, it may happen that a decision does not depend solely on novelty, utility, or sufficiency, but the Court may say that the specification does not describe a new and useful invention, and that therefore the patent is bad for one of these reasons, without saying which. For example, a patentee may endeavour to supplement his description by saying that such and such matters were old and well known, and the Court may say that if this were so there would be no invention. So also in certain instances in which a patent has been held bad on the ground of want of novelty or lack of utility the decision might equally well have been given on the ground of insufficiency or *vice versa* (y).

(s) *Dudgeon v. Thomson* (1873), 3 S. XI. 863; *Kane v. Boyle*, 18 R. P. C. 325, 332; *Flour Oxidising Coy., Ltd. v. Hutchinson*, 26 R. P. C. 590, 629.

In this case it was also held that if the patentee correctly stated the results of his invention a mis-statement as to the purposes to which the product could be applied would not affect validity (p. 629), but cf. *Turner v. Winter* (1787), W. P. C. 77.

(t) *Simpson v. Holliday* (1866), L. R. 1 H. L. 315; *Vidal Dyes Syndicate v. Levinstein*, 29 R. P. C. 245, 269, C. A.

(u) *Neilson v. Harford* (1841), W. P. C. 295; *R. v. Arkwright* (1785), W. P. C. 64; *Bovill v. Keyworth* (1857), 7 E. & B. 725. But CAIRNS, L. C., stated that the question of whether the nature of the invention

is sufficiently described is for the Court, who may be assisted, but are not bound, by scientific evidence; *Bovill v. Smith* (1868), Griffin, N. C., 49, H. L. As to such evidence, see p. 188.

(x) *Dudgeon v. Thomson* (1873), 3 S. XI. 863; *Astley v. Taylor* (1871), 1 Shaw's App. Cas. 54; *Bovill v. Keyworth* (1857), 7 E. & B. 725; *Lowe v. Penn* (1846), 7 L. T. (o. s.) 203; *Shaw v. Jones*, 6 R. P. C. 328; *R. v. Arkwright, ubi supra*.

(y) See per LORD DAVEY, in *Wilson v. Wilson & Coy. (Barnsley), Ltd.*, 20 R. P. C. 1, 14. See also *R. v. Wheeler* (1819), 2 B. & Ald. 345; *Pooley v. Pointon*, 2 R. P. C. 167; *Atkins and Applegarth v. Castner Kellner Alkali Coy.*, 18 R. P. C. 295; *Von der Linde v. Brummerstaedt*, 26 R. P. C. 289.

## CHAPTER VII

## DISCONFORMITY

THE present Act contains provisions which, while they lessen the likelihood of the objection of disconformity being successful, not only leave it possible for all the difficulties that could formerly have arisen still to arise, but also create new problems (a). Provisions of present Act.

The exact origin of the modern objection of disconformity is somewhat hard to trace, in fact it probably had several different roots. In the earliest times a patent was granted for what was little more than the title of the invention (b), and the nature of the invention would have had to be established by evidence. It would therefore be open to the defendant by the plea of *non concessit* to show that what he had done was not an infringement of the monopoly really granted (c). Later it became the practice to make it a condition of the grant that the inventor should within a certain time file a specification fully describing the invention (cc). It was then held that besides the Origin of objection.

(a) Sect. 42 and p. 103. Another factor tending to diminish the probability of disconformity is the very careful comparison now made by the Patent Office between the provisional and the complete specifications.

(b) *E.g.* Gilbert's Patent given in GORDON ON MONOPOLIES, p. 249.

(c) *Cf.* *Hancock v. Noyes* (1854), 23 L. J. (EX.) 110, though this case was of a much later date.

(cc) For cases where disconformity between the title and specification was discussed see *inter alia*, *Cochrane (Lord) v. Smethurst* (1816), 1 St. 205, as to which see *Cook v. Pearce*, *infra*; *R. v. Wheeler* (1819), 2 B. & Ald. 345; *Sturz v. De la Rue* (1828), 5 Russ. 322; *Clegg's Patent* (1829), W. P. C. 103; *Croll v. Edge* (1847), 19 L. J. (C.P.) 261; *Patent Bottle Envelope Coy. v. Seymour*

(1858), 28 L. J. (C.P.) 22; *Oxley v. Holden* (1860), 30 L. J. (C. P.) 68; *Cook v. Pearce* (1844), 12 L. J. (Q.B.) 189; *Pirrie v. York Street Flax Spinning Coy.*, 10 R. P. C. 45, Ir.

It should be noted that the objection that the specification and patent did not agree was in old days frequently taken where the specification was narrower than the patent on the ground that the Crown had been deceived into granting the patent by the representation that the inventor had a larger invention than he really had. See *Cochrane (Lord) v. Smethurst* (1816), 1 St. 205; *Jessop's Case* (before 1795), Davies 182.

It was also held by ABBOT, C.J., that even if the patent and specification agreed the patent was bad if the inventor had not made the

plea of *non concessit* the defendant could also plead that the invention described in the specification was not the invention for which the patent was granted or that the inventor had not particularly described his invention according to the condition (d)—*i.e.* that there was disconformity between the title and the specification.

Later still a fuller description had to be filed before the patent was granted, namely, the provisional specification (e). This was taken as really explaining the title, and the complete specification was compared with it as it might have been with a title (f).

The Act of 1883 abolished this conditional grant, but imposed on the inventor the duty of filing a full description and definition of the invention before the patent could be sealed (g), and the grant now recites that this has been done (h). It would, however, obviously be wrong to let an inventor describe in his complete specification a further invention than that on which he applied for the patent, and so antedate such later invention. The Courts have therefore held that the objection still applies, and any other decision would have made a change in the law necessary, but it is somewhat difficult to say on what ground this decision rests (i). It has been suggested

invention at the date when he applied. (*Bloxam v. Elsee* (1827), 6 B. & C. 169). This doctrine would seem to have received its death blow, in fact if not in form, from the decision of the Ex. Ch. in *Cook v. Pearce* (1844), 12 L. J. (Q. B.) 189, and would now seem to be obsolete. See *per* Lord BLACKBURN in *Bailey v. Robertson* (1878), 3 A. C. 1055. Under the modern system of granting patents this objection has really no place.

(d) *Hancock v. Noyes, ubi supra*; *Croll v. Edge, ubi supra*.

Another form of plea was that the specification was larger than the patent. *Patent Bottle Envelope Coy. v. Seymour, ubi supra*. On this point *cf.* reasoning of Ex. Ch. in *Ralston v. Smith* (1862), 35 L. J. (C. P.) 49.

(e) This was introduced by the 1852 Act (15 & 16 Vict. c. 83), ss. 6 and 8.

Under this Act provision was made for the grant of patents either before or after the complete specification had been filed. In the former case the above condition was inserted in

the patent, in the latter a condition that if the Letters Patent did not particularly describe the invention the patent should be void (see Patent Act, 1852 (15 & 16 Vict. c. 83, s. 9 and schedule). No distinction seems to have been made between these two classes of patents on the question of disconformity.

(f) It was held by the Scotch Courts in *Dudgeon v. Thomson* (1873), 3 S. XI. 863, that if the claim was within either the title or the provisional specification there was no disconformity, but this decision has not been followed.

(g) 1883 Act (46 & 47 Vict. c. 57), s. 5 (4); 1907 Act, s. 2 (2).

(h) See form, Appendix, *post*.

(i) There have been a number of patents granted since 1883 held bad for disconformity, including one in the H. L. See *Castner-Kellner Alkali Coy. v. Commercial Development Coy.*, 17 R. P. C. 593, H. L. There was no argument before the House of Lords as to disconformity being no longer an objection.

that since the Act of 1883 preserved all former grounds of attack on a patent, disconformity was included (*k*), but as the objection of disconformity was based on the non-fulfilment of a condition which is no longer imposed this is hardly a satisfactory reason. It may be that the true ground is that if the inventor claims a different invention to that for which he sought protection, he has not "particularly described the nature of his invention" (*l*), or that by attempting to extend the ambit of the patent which the Crown intended to grant for the invention contained in the original application he has invalidated his patent, or again that such extension being outside the real grant is a mere nullity (*m*).

The present Act provides that any of the old objections can be raised against a patent (*n*), but that no patent, whether granted before or after the date of the Act (*o*), shall be held invalid on the ground of disconformity if the disconforming matter was in fact new when the complete specification was put in, and the applicant was the first and true inventor thereof (*p*).

Exception introduced by new Act.

In considering the subject of disconformity it must be remembered that the Patent Laws contemplate that the applicant will develop his invention during the period of provisional protection, and indeed this is the main object of such protection. The provisional specification may quite properly be filed when the inventor has no clear idea of the limits of his invention, and if it discloses the nature of the invention may and should be in such general terms as will give him full liberty in defining these limits after further experiment. It is

Fair development permissible.

(*k*) See *inter alia*, *Nuttall v. Hargreaves*, 8 R. P. C. 450, 454, and case there quoted (O. A.).

(*l*) *Ibidem*.

(*m*) There are certainly dicta that suggest that the disconforming part is mere surplusage and does not affect the remainder of the patent. See *per* Lord BLACKBURN in *Bailey v. Robertson* (1878), 3 A. C. 1055; and *Lucas v. Miller*, 2 R. P. C. 159. In considering this view it must be remembered that this objection differs from those based on the Statute of Monopolies, since the latter attack the power of the Crown to make the grant at all, and therefore necessarily attack the grant as a whole. The Courts, however, have always treated this plea as going

to validity, though in most cases in which patents have been held bad for invalidity the result of the action would have been the same if the other view had been taken, since the claim held bad was that alleged to be infringed.

In *Osmonds, Ltd. v. The Balmoral Cycle Coy., Ltd.*, 15 R. P. C. 505, C. A., however, the patent was held invalid for disconformity in a claim not alleged to be infringed, as also was the case in *United Telephone Coy. v. Harrison* (1883), 21 Ch. D. 731.

(*n*) Sect. 25 (2).

(*o*) Sect. 98 (2).

(*p*) Sect. 42, as to pleading, see p. 174.



not only his right but his duty to endeavour to develop his invention during this period, and also to prune away what is useless or old, and it is further his duty to include in his complete specification such matters appertaining to his invention as he may have so discovered, and which will be useful to the public in connection therewith (*q*). The mere presence, therefore, of matter in the complete specification which does not occur in the provisional does not even make out a *prima facie* case of disconformity or put the patentee on the defensive, but the burden still lies on the objector of making out that these additions constitute a different invention to the invention (if any) described in the provisional (*r*).

The difference must be one of substance.

In arriving at a decision as to disconformity the first step is to construe the complete specification, of course taking into account the state of general knowledge, so as to determine what is the invention claimed, and then to see if that invention is fairly fore-shadowed in the provisional specification (*s*). But this is only the first step. Of course, if the specifications pass this test there can be no question of disconformity, but it will often happen that there are elements in the claims not appearing in the Provisional. It is then necessary to consider, quite apart from the wording of the specification, what the real invention was, in order to determine whether these additional elements are merely a limitation of this invention, or whether they in fact constitute the novelty of the patented invention (*t*). Thus, to take a concrete case, if the provisional specification of a chemical patent says that the inventor has discovered that by combining two bodies A and B you get a third body C, and the complete claims the process of combining A and B in a particular solvent D in order to get C, the question of

(*q*) See *per* Lord MACNAGHTEN in *Pneumatic Tyre Coy. v. Leicester Pneumatic Tyre Coy.*, 16 R. P. C. at p. 541; *Newall v. Elliott* (1858), 27 L. J. (C. P.) 337. See also p. 96, *n.* (*f*).

(*r*) *Per* Lord MACNAGHTEN in *Pneumatic Tyre Coy. v. Leicester Pneumatic Tyre Coy.*, *ubi supra*, and *per* Lord DAVEY, *ibid.*, at p. 545; *Moseley v. Victoria Rubber Coy.*, 4 R. P. C. 241; *Miller v. Scarle Baker and Coy.*, 10 R. P. C. 111; *Kelvin v. Whyte Thomson and Coy.*, 25 R. P. C. 177, 190, O. H. *Per* Lord BLACKBURN in *Bailey v. Robertson* (1878), 3 A. C. 1055; *Clegg's Patent* (1829), W. P. C.

103; *Birmingham Pneumatic Tyre Syndicate, Ltd. v. Reliance Tyre Coy.*, 19 R. P. C. 298, 315.

(*s*) *Siddle v. Vickers*, 5 R. P. C. 98.

(*t*) See *per* VAUGHAN WILLIAMS, L.J., in *Andrew's Patent*, 24 R. P. C. at p. 368; *Nuttall v. Hargreaves*, 8 R. P. C. 450, C. A.; *Brookes v. Lamplugh*, 15 R. P. C. 33, 50, C. A., and *Ralston v. Smith* (1862), 35 L. J. (C. P.) 49; but see *contra Cassel Gold Extracting Coy. v. Cyanide Gold Recovery Syndicate*, 12 R. P. C. 232, C. A.; *Geipel's Patent*, 21 R. P. C. 379, 389, C. A.

disconformity would turn on whether it was new to combine A and B by any method to get C. If it was, then this is the invention made, and the limitation to what the inventor has found is the best, or perhaps the only method, does not constitute disconformity. But if it was old to combine A and B to produce C by other methods, then the true invention is the use of the solvent D for this purpose, and as this is not foreshadowed in the provisional there is disconformity.

If, therefore, the claims contain elements or definitions not foreshadowed in the provisional, it is necessary to see whether these elements constitute the invention claimed. If they do there is disconformity whether the new matter limits the invention, as, for example, by substituting a particular device for a general element in the provisional, where all that is new is the choice or invention of this particular device (*u*), or extends it as by including other mechanical equivalents for those described in the provisional, where the real invention lies in the choice of the mechanical equivalents used (*x*). But where the invention does not lie in these details and the provisional specification has described a substantially new process or apparatus, the choice of the best form, or the variation of equivalents, or the improvement of a part, would not constitute disconformity (*y*). In the case where disconformity is alleged by reason of the introduction of new details in the claim, a test which may sometimes be of use is to see whether the claim is a mere limitation of a wider claim which could have been made and which would have been good from the point of view of novelty

What is disconformity.

(*u*) *Gillies v. Dunbar* (1877), 4 S. V. 337, I. H.; *Cera Light Coy. v. Doby*, 11 R. P. C. 10, I. H.; *King Brown and Coy. v. Anglo-American Brush Coy.*, 7 R. P. C. 436, I. H.; *Nuttall v. Hargreaves*, 8 R. P. C. 450, C. A.; cf. also judgment of Ex. Ch. in *Ralston v. Smith* (1865), 11 C. B. (N. S.) at p. 117, and of VAUGHAN-WILLIAMS, L.J., in *Ward Brothers v. Hill*, 20 R. P. C. 198, C. A.

(*x*) *Brookes v. Lamplugh*, 15 R. P. C. 33, C. A.; *Castner-Kellner Alkali Coy. v. Commercial Development Corporation*, 17 R. P. C. 593, H. L.

(*y*) *Sutcliffe v. Abbot*, 29 R. P. C. at p. 58; *Walling v. Stevens*, 3 R. P. C. 147, C. A.; *Woodward v. Sansum*, 4 R. P. C. 166, C. A.; *Ward Brothers v. Hill*, 20 R. P. C. 189, C. A.; *Cranspton v. Patents Investment Coy.*, 6 R. P. C.

287. As to this case see *n. (z)*, *infra*. *Birmingham Pneumatic Tyre Syndicate, Ltd. v. Reliance Tyre Coy.*, 19 R. P. C. 298; *Carter v. Leyson*, 19 R. P. C. 473, C. A.; *Chadburn v. Mechan*, 12 R. P. C. 120; *Cassel Gold Extracting Coy. v. Cyanide Gold Recovery Syndicate*, 12 R. P. C. 232, C. A. As to this case see *n. (z)*, *infra*. *Castner-Kellner Alkali Coy. v. Commercial Development Corporation*, 17 R. P. C. 593, H. L.; *Geipel's Patents*, 21 R. P. C. 379, C. A.; *Gaulard & Gibb's Patent*, 7 R. P. C. 367, H. L.; *Gadd v. Mayor of Manchester*, 9 R. P. C. 516, C. A.; *Moseley v. Victoria Rubber Coy.*, 4 R. P. C. 241; *Morgan v. Windover*, 4 R. P. C. 446; *Newall v. Elliott* (1858), 27 L. J. (O. P.) 337; *Pneumatic Tyre Coy., Ltd. v. Leicester Pneumatic Tyre Coy.*, 16 R. P. C. 531, H. L.

(though not necessarily from that of utility) and which is foreshadowed in the provisional. If so it is apprehended that the claim is in general good (z).

In some cases the provisional clearly shows a particular feature as the essence of the invention, and then devices which do not embody this feature necessarily disconform (a).

In modern times the Courts have rightly been liberal to the patentee on the question of disconformity (b), and have looked at the substance rather than the form of the description, treating the question of the identity of the inventions as one rather of fact than of construction (c). Even a slight suggestion in the provisional is often sufficient (d), and elements there mentioned separately may be claimed in combination (e), and probably in some cases the converse would apply (f). So, too, there is an unwillingness to punish an inventor for having

(z) It should be noted that in the following two cases the Courts have held claims bad for disconformity where the claim, if the disconforming part had been omitted, would still have been good: *Osmond v. Balmoral Cycle Coy.*, 15 R. P. C. 505; *Kinmond v. Keay*, 20 R. P. C. 497, I. H.

It seems difficult, however, to reconcile these decisions with others of equal or greater weight which lay down the general rule that the introduction of an integer, properly or improperly, into a claim, so as to restrict the monopoly covered by the claim, does not invalidate it if the claim would have been good without such restriction: cf. *British Dynamite Coy. v. Krebs* (1879), 13 R. P. C. 130, H. L.; *British United Shoe Machinery v. Fussell*, 25 R. P. C. 631, C. A., and other cases in n. See also *Newall v. Elliot* (1858), 27 L. J. (C. P.) 337; *Lucas v. Miller*, 2 R. P. C. 155.

In the last case it was said that this rule would apply even if the invention would have been unworkable without the additional part. On the other hand in some cases the Courts have stated rules for judging as to disconformity which seem too favourable to the patentee, and held there was no disconformity where the statement in the provisional contained no hint of the special feature which was held to constitute the invention. E.g. *Cassel Gold Extracting Coy. v. Cyanide*

*Gold Recovery Syndicate*, 12 R. P. C. at p. 257, C. A.; *Crampton v. Patents Investment Coy.*, 6 R. P. C. 287, C. A.

(a) *United Telephone Coy. v. Harrison* (1883), 21 Ch. D. 731; *Tubeless Pneumatic Tyre Coy. v. Trench Coy.*, 16 R. P. C. 291; *Savage v. Brindle*, 17 R. P. C. 228; *Hutchinson v. Pattulo*, 5 R. P. C. 351, I. H.; *Brookes v. Lamplugh*, 15 R. P. C. 33, 50, C. A.

(b) See *Gadd v. Mayor of Manchester*, 9 R. P. C., per LINDLEY, L.J., at p. 527.

(c) *Geipel's Patent*, 21 R. P. C. 379. In *Pneumatic Tyre Coy., Ltd. v. Leicester Pneumatic Tyre Coy.*, 16 R. P. C. at p. 55, SMITH, L.J., was of opinion that the question was one of law, so that a decision bound Courts of equal jurisdiction in the absence of fresh evidence.

Probably the question of whether the provisional foreshadows what is in the complete is one of construction, while the question as to whether the differences are of the essence of the invention is one of fact.

(d) See per Lord BLACKBURN in *Bailey v. Robertson* (1878), 3 A. C. 1055. See also *Andrews' Patent*, 24 R. P. C. 349, C. A.

(e) *Dudgeon v. Thomson* (1873), 3 S. XI. 863, I. H.; *Patent Bottle Envelope Coy. v. Seymour* (1858), 28 L. J. (C. P.) 22.

(f) See, however, *Bailey v. Robertson*, *supra*.

condescended to unnecessary details in his provisional if there is invention apart from such details (*g*).

It is no objection to a patent that matters in the provisional have been omitted or disclaimed in the complete (*h*), or that new matters have been introduced by way of description or explanation only (*i*). If, however, these limitations or new matters are incorporated in the claims by description or otherwise the above rules would apply (*h*).

New and complicated questions as to disconformity will probably arise from the power given by the present Act of filing one complete specification on two or more provisional specifications for cognate inventions. In such case the novelty of any matter claimed has to be tested as at the date when the provisional relating to the matters claimed therein was filed (*l*). As there is no provision for, or practice of, earmarking the claims as referring to the matters contained in a certain provisional, questions will undoubtedly arise as to the earliest provisional to which a claim can be referred, and even as to whether the filing of the later provisionals was not merely an unnecessary precaution, and the inventions described in such provisionals merely fair developments of the original invention (*m*).

Case of several provisionals.

(*g*) *Pneumatic Tyre Coy., Ltd. v. Ixion Tyre Coy.*, 14 R. P. C. at p. 869; *Woodward v. Sansum*, 4 R. P. C. 166, C. A.; *Geipel's Patent*, 21 R. P. C. 379, C. A.

(*h*) *Aktiebolaget Separator v. Dairy Outfit Coy.*, 15 R. P. C. 336; *Andrews' Patent*, 24 R. P. C. 349, C. A.; *Nickels v. Haslam* (1844), 13 L. J. (C. P.) 146; *Thomas v. Welch* (1866), 35 L. J. (C. P.) 200; *Penn v. Bibby* (1866), 2 Ch. App. 127. See also *British Motor Syndicate, Ltd. v. Universal Motor Carriage Coy.*, 16 R. P. C. 113, 132.

(*i*) *Oxley v. Holden* (1860), 30 L. J. (C. P.) 68; *Penn v. Bibby* (1866), 2 Ch. App. 127.

So the omission of a statement as to the advantages of the invention (*British Motor Coy. v. Universal Motor Coy.*, 16 R. P. C. 113; *cf.* also *Gaulard & Gibb's Patent*, 7 R. P. C. 367, H. L.) or a different statement as to the theory of a reaction (*Andrews' Patent*, 24 R. P. C. 249, C. A.) do not constitute disconformity. Nor a statement that devices can be used for other purposes (*Oxley v. Holden, supra*; *Wright v. Hitchcock* (1870),

39 L. J. (EX.) 97). *Cf.* also *Lyon v. Goddard*, 11 R. P. C. 354, H. L.

Again the addition of a descriptive adjective such as a "thin flexible paper tube" for a "thin paper tube" which does not really make any change is not disconformity. *Pirrie v. York Street Flax Spinning Coy.*, 10 R. P. C. 45, Ir.

(*k*) See *per* VAUGHAN WILLIAMS, L. J., in *Ward Brothers v. Hill*, 20 R. P. C. at p. 198, and in *Andrews' Patent*, 24 R. P. C. at p. 368.

A good example of disconformity caused by excision is *Lane-Fox v. Kensington & Knightsbridge Electricity Coy.*, 9 R. P. C. 413, C. A.

(*l*) Sect. 16.

(*m*) The probability of questions arising under this section and also under section 42 through the publication of matters during the period of provisional protection is greater than might be supposed. The inventor is nearly always unconscious of the disconformity, and is quite likely to show his new developments under the impression that they are protected by the provisional.

The following are cases in which

it was held that there was no dis-conformity:—

*Variations held to be fair develop-ments.*

The provisional specification of a patent for producing designs on waterproof fabrics, described a process as consisting of covering the fabrics with farina (which was old in itself), printing with colours dissolved in suitable media such as those employed in calico printing, and vulcanising by the "well-known cold vulcanising process." The complete extended the list of media and also said that another process, the "cold vapour" process could be used for vulcanising. *Moseley v. Victoria Rubber Coy.*, 4 R. P. C. 241.

The provisional specification of a patent for a cycle fitting described the movement of one part towards another by means of a single clip, and the complete also included a form with two clips with different screws so that the parts approached by double action; *Miller v. Scarle Baker & Coy.*, 10 R. P. C. 106, 111.

The provisional specification of a patent for a method of raising gas holders described racks and wheels, the wheels being all geared together, so that the holders should rise evenly. The complete also showed a device having a number of sets of four pulleys on which were continuous chains crossed in the middle. See illustrations in Roberts, p. 353. *Gadd v. Mayor of Manchester*, 9 R. P. C. 516, C. A.

The provisional specification of a patent for separating dust from chaff described the use of a fan above the exit or in the entry. The complete showed and claimed a fan in the interior of the machine. It also showed a collar not in the provisional specification. It was held that the patent was to be broadly interpreted. *Sutcliffe v. Abbot*, 20 R. P. C. 50.

The provisional specification of a patent for improvements in connection with dobbies described a rocking lever for bringing one of the two pattern rollers into action, and also proposed certain improvements in the needles actuated by these. In the complete specification the ordinary form of lever was adopted with such needles. *Ward Brothers v. Hill*, 20 R. P. C. 189, C. A.

The provisional specification of a patent for the application of composite C springs to the fronts of carriages

showed one method of anchoring the spring. In the complete an alternative method was shown. Held, by KEKEWICH, J., that this was not dis-conformity the provisional having pointed out the necessity of such anchoring, and the means being un-important. The point was not dis-cussed in the House of Lords. *Morgan v. Windover*, 4 R. P. C. 423.

The provisional specification of a patent for a pencil case described the lead as being contained in a movement having a pin projecting through a slot. In the complete an alternative was described in which the slot was in the movement and the pin on the casing. *Woodward v. Sansum*, 4 R. P. C. 166, C. A. See also *Walling v. Stevens*, 3 R. P. C. 147, C. A.

In the case of the Castner-Kelner apparatus (see p. 110), it was held that an alternative in which mercury was stationary, but the bell contained pure water and the space outside brine, did not cause dis-conformity. *Castner-Kelner Alkali Coy. v. Commercial Development Corporation*, 17 R. P. C. 593, H. L.

The provisional specification of a patent for steam traps described the steam as passing through two tubes of different metals arranged so as to form a triangle with a fixed base. The complete specification in addition gave one figure which showed only one tube with a tie rod made of different material. *Geipel's Patent*, 21 R. P. C. 379, C. A.

The provisional specification of a patent for a tyre cover described a cover which was split and joined round a tube, and said that it might be brought round within the rim and secured to the rim by an inner fasten-ing, or by expansion against the over-hanging sides of the metallic rim. The complete claimed a method of holding it on by pressure without overhanging sides. *Birmingham Pneumatic Tyre Syndicate v. Reliance Tyre Coy.*, 19 R. P. C. 295.

The provisional specification of the Welch patent described a tyre cover having in the edges wires which could be joined so as to become inextensible, in combination with a rim concave in the middle so that the two inexten-sible wires prevented the tyre slipping over the convexity on either side. It mentioned that the tyre might be fitted over the existing rubbers or that material such as cork might be

used in place of these. In the complete there was also shown and claimed a form in which the wires were made continuous from the first and the use of this cover with pneumatic tyres was also claimed. *Held*, no disconformity. In all cases the wires were continuous when holding the tyre on, and the fact that the inventor discovered that his arrangements for joining the ends were in some cases unnecessary did not change the nature of the invention, nor was its application to pneumatic tyres an undue extension. *Pneumatic Tyre Coy. v. Casswell*, 13 R. P. C. 164; *Same v. East London Rubber Coy.*, 14 R. P. C. 573, C. A.; *Same v. Ixion Patent Pneumatic Tyre Coy.*, 14 R. P. C. 869; *Same v. Leicester Pneumatic Tyre Coy.*, 16 R. P. C. 531. See also *Horrocks v. Stubbs*, 3 R. P. C. 221.

Where the provisional had described the use of wooden bearings, and the complete described as an alternative putting wood on the shaft to run in metal, but the claim was only for bearings, it was held that there was no disconformity since the wood on the shafts came within the term bearings as mentioned in the provisional, and if not was not claimed. *Penn v. Bibby* (1859), 2 Ch. App. 127.

Where the patent was for improvements in the manufacture of cases or envelopes for covering bottles, the specification described apparatus for, and a mode of, making these envelopes, and claimed these in combination, it was held to be no disconformity. *Patent Bottle Envelope Coy. v. Seymour* (1858), 28 R. P. C. (C. P.) 22.

Where the provisional specification was for improvements in the manufacture of frills or ruffles, and the machinery or apparatus employed therein, and the claim was for machinery for producing crimp frills or trimmings, etc., it was held that there was no disconformity. *Wright v. Hitchcock* (1870), L. R. 5 Ex. 37.

The provisional specification of a patent for a method of purifying flour described a process as working by oxidation. In fact, as stated in the complete, the action was one of nitration. Further nitrogen peroxide was claimed as an agent in the complete specification and not mentioned in the provisional, though there was a statement which might have included it. Ozone had been mentioned in the provisional

and expressly excluded in the complete. *Held*, no disconformity. *Andrews' Patent*, 25 R. P. C. 477, H. L.

*New matters claimed in combination.*

The provisional specification of a patent for apparatus for cable laying described a cone with a vertical axis on which the cable was coiled. The complete also described the use of a series of rings above the cone so that the cable passed inside them, and claimed these in combination. *Newall v. Elliott* (1858), 27 L. J. (C. P.) 337.

The provisional specification of a patent for a lamp to be hung on the hub of bicycle described only the lamp, the complete described, in addition, a device for fixing leather washers in barrel on round hub and claimed the whole in combination. *Lucas v. Miller*, 2 R. P. C. 155. See also *Sturz v. De la Rue* (1828), 5 Russ. 322; *Dudgeon v. Thomson* (1873), 3 S. XI. 863; *Crampton v. Patents Investment Coy.*, 6 R. P. C. 287, C. A.; *Kelvin v. Whyte-Thomson*, 25 R. P. C. 177, 190.

The provisional specification of a patent for an improved candlestick described a candlestick formed of a socket with fangs attached to the base. The complete specification described and claimed the same thing with the addition of bits between the fangs to hold the nozzle on the socket. *Carter v. Leyson*, 18 R. P. C. 508.

*Specific devices or directions added.*

The provisional specification of a patent for improvements in ships telegraphs, after mentioning that gongs were used, said "the gong is sounded, and the pointer moves up to the central or proper position as described practically simultaneously." The complete specification described and claimed special machinery for this purpose. *Held*, though with some doubt, no disconformity. *Chadburn v. Mehan*, 12 R. P. C. 120.

The provisional specification of a patent for a method of extracting gold by means of cyanide of potassium did not make any reference to the strength of the solution. The complete specification had a claim for the use of a dilute solution, and it was found that in fact the real invention was the use of such a dilute solution which had a selective preference for gold which a stronger solution had not. It was held that there was no disconformity, and the Court were of opinion that the object of the provisional was only to identify

the invention so that the Law Officer may see what it is. *Cassall Gold Extracting Coy. v. Cyanide Gold Recovery Syndicate*, 12 R. P. C. 232, C. A. It is difficult to reconcile this decision with other decisions such as *Nuttall v. Hargreaves, infra*.

In the following cases disconformity was found:—*Extensions or variations held not to be fair developments*.

The provisional specification of a patent for improvements in cycle saddles described a device for attaching a cycle saddle to the frame, the main novelty of which was that it permitted tilting. The complete showed forms which did not permit of tilting. The novelty of the invention was held to lie in the exact devices used. *Brooks v. Lamplugh*, 15 R. P. C. 33, 50, C. A.

The provisional specification of a patent for improvements in electrolytic apparatus for decomposing metallic salts stated that the apparatus had a stationary mercury cathode. The apparatus described had a chamber with mercury laid on the bottom and a bell containing salt water was traversed over it, the space outside the bell containing pure water. In the complete a form was shown in which the brine and water boxes were stationary while the mercury covered bottom revolved. It was held that this was disconformity since "stationary" had been advisedly used in the provisional to distinguish from former apparatus. *Castner-Kelner Alkali Coy. v. Commercial Development Corporation*, 17 R. P. C. 593, H. L.

The provisional specification of Edison's telephone patent only dealt with the electrical transmission of sound. The complete also described a phonograph and said that the reproducing diaphragm might either give out sound or work a tension regulator on an electric line to transmit sound elsewhere. The claim covered both forms. *United Telephone Coy. v. Harrison* (1883), 21 Ch. D. 731.

The provisional specification of a patent for improvements in roundabouts described a method of giving up and down movement to the horses by means of a crank (old in itself for this purpose) on which were suspended rods carried downwards and attached to a frame free to move radially so that the horses were kept at a proper distance apart. The complete claimed

a crank and rods, the rods being moved in a guide so that the horses could move individually. *Savage v. Brindle*, 17 R. P. C. 228.

The provisional specification of a patent described a certain process for thickening vegetable oils. The complete claimed in addition mixing vegetable oils, thickened by this or any other process, with mineral oils. *Hutchinson v. Pattulo*, 5 R. P. C. 251, I. H.

Where the provisional specification described the use of a solution of bi-sulphite of lime and gelatine for preserving meat it was held that a claim for the use of the bi-sulphite alone would amount to disconformity. *Bailey v. Robertson* (1878), 3 A. C. 1055.

The provisional specification of a patent dealing with the distribution of electricity described the use of batteries as reservoirs, but showed an electrometer governing the dynamos for the purpose of regulating them. In the amended complete specification the references to the electrometer were taken out and the regulating was done by means of the batteries. *Lane-Fox v. Kensington Electric Lighting Coy.*, 9 R. P. C. 413, C. A.

The provisional specification of a patent for a method of electrical distribution spoke of the use of a "number of induction coils of special construction for the creation of currents whose quality and value depends solely upon the construction of the said induction coils." The complete specification as amended claimed a system of distribution quite apart from any special construction of these coils. *Held*, by C. A. disconformity. The judgment of the various Lords in the House of Lords differed as to this. *Gaulard & Gibb's Patent*, 6 R. P. C. 215, C. A.; 7 R. P. C. 367, H. L.

The provisional specification of a patent for pneumatic tyres described forms in which either the margins of one band or of two separate bands lay over each other so as to form a complete air-tight chamber. The complete also claimed a form in which the margins did not lie over each other, but were simply forced against the rim. *Tubeless Pneumatic Tyre Coy. v. Trench Tubeless Tyre Coy.*, 16 R. P. C. 291. See also *Horrocks v. Stubbs*, 3 R. P. C. 221.

*Addition of elements which formed only novelty.*

Where the only novelty in a beer

tap was a wire gauze strainer which did not appear in the provisional held disconformity. *Nuttall v. Hargreaves*, 8 R. P. C. 450, C. A.

Where the provisional was merely for forming a spiral screw in a particular part of certain apparatus, and the complete claimed a screw of particular diameter and pitch, and these were the only elements of novelty, held disconformity. *Gillies v. Dunbar* (1877), 4 S. V. 337, L. H. See also *King Brown & Coy. v. Anglo-American Brush Corporation*, 7 R. P. C. 436, C. A.; *Cera Light Coy. v. Dobby*, 11 R. P. C. 10, L. H.; *Brookes v. Lamplugh*, 15 R. P. C. 33, 50, C. A.; *Adams v. Stevens*, 16 R. P. C. 225, 232.

*New elements claimed in combination.*

The provisional specification of a patent for improvements in adjusting driving chains of safety bicycles merely described these arrangements. The complete also described a special step which could be used in place of the ordinary step, and was better suited to this special gear, and one

of the claims was for a combination including this step. *Osmonds v. Balmoral Cycle Coy.*, 15 R. P. C. 505, C. A. See also *Kinmond v. Keay*, 20 R. P. C. 497, 508, O. H.

In the case of a patent for "certain improvements in the manufacture of gas for the purpose of illumination, and in the apparatus used when transmitting and measuring gas," the specification added after the word "used" the words "therein and" and the specification described (*inter alia*) an improved retort. Held disconformity on the ground that it materially extended the grant. *Croll v. Edge* (1847), 19 L. J. (C. P.) 261.

In the case of a patent for a new and improved method of drying and preparing malt, the specification described a process to be applied to malt already dried in the ordinary way to give it colouring properties. Held, disconformity. *R. v. Wheeler* (1819), 2 B. & Ald. 345.



## CHAPTER VIII

## CONSTRUCTION

LOGICALLY the construction of the Letters Patent, or the ascertainment of the nature and extent of the monopoly claimed, should be the first question in any patent action and should be decided apart from any other question. This, however, is a counsel of perfection not often followed. The main reason is that the specification is addressed to craftsmen of the trade concerned, and the Court cannot properly perform its duties until it is in a position to look at it with their eyes. An analogous case, though perhaps the analogy is not a perfect one, would be the construction of a contract made between foreigners and subject to foreign law. No Court would attempt to construe this until it had been informed by evidence as to what the foreign law was, and also as to customs and other circumstances affecting the matter of the contract, so that it was in a position to determine what the parties really meant by the words used. In fact the construction of the specification has often to be delayed until practically all the evidence has been taken, and it is often difficult to separate the decision on construction from decisions on other issues.

In particular the question of infringement is always closely joined with that of construction. This is only natural, since once it has been established what the defendant has done, it would appear to be only a question of construction whether or not this is within the monopoly granted. But it must be remembered that while the construction of the specification was always a question for the Court, the further question of the substantial identity of what the defendant had done with the invention for which the monopoly was granted was for the jury (a). There is, therefore, a distinction between the rules

Construction involves knowledge of art.

Questions of construction and infringement.

(a) Thus in *Betts v. Menzies* (1859), 10 H. L. C. 970, and *Betts v. Neilson* (1866), 3 Ch. App. 420. It was held that it was for the jury to determine

which the Court applies in construing the specification as a document, and the principles which should guide it as a jury in deciding on this question of substantial identity, and an attempt has been made to separate these questions as far as may be, dealing with the first in this chapter, and leaving the other to the chapter on infringement. It is not, however, possible to preserve the distinction in all cases, or to avoid a certain amount of repetition.

Varying  
doctrines of  
construction,

In applying former decisions on construction it is necessary to remember that the views of the Courts as to the interpretation of specifications have varied from time to time. In early times there was a view that the specification, being the patentee's own document, should be construed strictly against him, but about 1830 the Courts began to take a milder view (b), and later on it was held that the words in the grant "that these our Letters Patent shall be construed in the most beneficial sense for the advantage of the said patentee" applied more to the specification than to the Letters Patent themselves (c). This doctrine of benevolent interpretation has in turn been

whether, firstly, the terms of art used in specifications of different dates meant the same and, secondly, whether the inventions described in these specifications were identical.

In *Steiner v. Heald* (1851), 20 L. J. (EX.) 410, 17 Jur. 875, a new trial was granted because the Court had not left to the jury the question whether two processes were identical.

In *Bush v. Fox* (1852), 23 L. J. (EX.) 251, the Court directed the jury to find that the patent had been anticipated, but as to this case see judgment of BRANWELL, B., in *Hills v. London Gas Coy.* (1860), 29 L. J. (EX.) at p. 321. See also *Westinghouse v. Lancashire & Yorkshire Ry.*, 1 R. P. C. 229; *Neilson v. Harford* (1841), W. P. C. 273; *Thomas v. Foxell* (1858), 5 Jur. N. S. 37.

A Court will, however, feel bound to follow a previous decision of an equal or higher Court as to construction in the absence of further evidence. *Otto v. Steel*, 3 R. P. C. 109; *Hills v. Liverpool Gas Coy.* (1862), 32 L. J. (CH.) 38; *British Vacuum Cleaner Coy. v. Exton Hotels, Ltd.*, 25 R. P. C. 617.

Thus in *Edison v. Holland*, 6 R. P. C. 283, the C. A. held that they were bound by a former decision as to the following points:—

1. That the specification was not too vague and unintelligible to be construed by the Court.

2. That what was meant by "carbon filament" was reasonably plain from the specification.

3. As to how wide a certain claim was, but not as to whether the patentee had sufficiently described in what manner the invention was to be performed, that being a question of evidence.

So a decision as to disconformity, or as to whether an alleged prior grant was for the same invention, was considered binding in *Flour Oxidising Coy. v. Carr*, 25 R. P. C. 428; *Sum v. Hutchinson*, 26 R. P. C. 597.

As to cases where the plaintiff seeks to vary the construction, see p. 121.

(b) *Hallett v. Hague* (1831), 9 L. J. (O. S.) K. B. 243; *Russell v. Cowley* (1835), W. P. C. at p. 470; *Neilson v. Harford* (1841), W. P. C. p. 370 *et seq.*, but see p. 129, n. (f).

(c) *Feather v. The Queen* (1865), 35 L. J. (Q. B.) at p. 205. Cf. per Lord LINDLEY in *Hattersley v. Hodgson*, 23 R. P. C. at p. 203, and *Automatic Weighing Machine Coy. v. Knight*, 6 R. P. C. at p. 307, C. A.

disclaimed by the Courts, and there are many dicta that the specification should be construed without leaning either way (*d*), but, in fact, there has been little change, as the tendency still is to so construe the specification as to make it valid if this is reasonably possible (*e*).

It may be said, therefore, that the modern theory of construction of Letters Patent is that they are to be construed as other documents are (*f*), that is to say, the Court is to endeavour to assign a meaning if it is possible, and not to use minute verbal criticisms to destroy a meaning (*g*), that the meaning it is to assign is that which the document would bear to those to whom it is addressed (*h*), and that it is to apply the maxim *res magis valeat quam pereat*, and not to assume an interpretation that would make the grant unlawful if it can be avoided (*i*). The following "rules" only emphasise the points arising in the practical application of this theory.

### FIRST RULE

#### *The Specification is to be read as a whole*

The first important rule is that the specification is to be read as a whole, the claiming clauses being only a part—although undoubtedly an important part—of the specification, and in no sense a separate document (*k*), and the body of

(*d*) *Simpson v. Holliday* (1865), 35 L. J. (CH.) at p. 813; *Cropper v. Smith*, 1 R. P. C. at p. 89, C. A.; *Leadbeater v. Kitchin*, 7 R. P. C. at p. 244, C. A.; *Tolson v. Speight*, 13 R. P. C. 721; *Presto v. Orme*, 18 R. P. C. at p. 23, C. A.; *Patent Exploitation Coy. v. Siemens*, 21 R. P. C. 549, H. L.; *Turnbull v. Cruikshank*, 22 R. P. C. 521, O. H.

(*e*) *Oxley v. Holden* (1860), 30 L. J. (C. P.) 68; *Plimpton v. Spiller* (1877), 6 Ch. D. at p. 422 *et seq.*; *Otto v. Linford* (1881), 46 L. T. 35, C. A.; *Clippens v. Henderson* (1881), 4 S. X. 38, I. H.; *Needham v. Johnson*, 1 R. P. C. at p. 58, C. A.; *Horrocks v. Stubbs*, 3 R. P. C. 229; *Automatic Weighing Machine Coy. v. Knight*, *ubi supra*; *Edison v. Smith*, 11 R. P. C. at p. 400, C. A.; *Parkinson v. Simon*, 12 R. P. C. at p. 411, H. L.; *Young v. Morris*, 12 R. P. C. at p. 463, H. L.; *Cooper's Patent Coy. v. London County Council*, 13 R. P. C. at p. 295; *Hat-*

*tersley v. Hodgson*, 23 R. P. C. at p. 203, C. A.; *Van Berkel v. Simpson*, 23 R. P. C. at p. 259; *Bosworth v. Components, Ltd.*, 24 R. P. C. 772. The Courts apply this principle the more readily where the invention is meritorious. *Patent Exploitation Coy. v. Siemen's*, 20 R. P. C. 234, C. A.

(*f*) *Adie v. Clark* (1876), 24 W. R. 1008; *Simpson v. Holliday* (1866), L. R. I. H. L. 315; *Presto v. Orme*, 18 R. P. C. at p. 23, C. A.; *Leadbeater v. Kitchin*, 7 R. P. C. at p. 244, C. A. *Electric Construction Coy. v. Imperial Tramways Coy.*, 16 R. P. C. 630; *Incandescent Gas Coy. v. De Mare Incandescent System*, 13 R. P. C. 320.

(*g*) *Clippens v. Henderson* (1881), 4 S. X. 38, I. H.; *Tubes, Ltd. v. Perfecta, Ltd.*, 20 R. P. C. at p. 95, H. L.

(*h*) See p. 122 *et seq.*

(*i*) See n. (*e*), *supra*.

(*k*) *Arnold v. Bradbury* (1871), 6 Ch. App. at p. 712; *Plimpton v. Spiller* (1877), 6 Ch. D. at p. 426;

the specification should be read first (l). Although a patentee can by clear language claim what he will (m), the natural course is to take the claims as referring to the invention described, and not to something substantially larger or substantially different, even if the claims do not explicitly refer back to the body of the specification (n). The claims (which are of com-

*Parkinson v. Simon*, 11 R. P. C. 407, H. L.; *Edison v. Smith*, 11 R. P. C. 395, C. A.

(l) *Arnold v. Bradbury*, *supra*; *Tubes, Ltd. v. Perfecta*, 17 R. P. C. 587.

(m) *Cf. Consolidated Pneumatic Tool Coy. v. Ingersoll Sergeant Drill Coy.*, 25 R. P. C. 83 H. L.

(n) *Illustrative Cases* :—

Where a patent had as a claim "the production by machinery at one operation of gathered work which is simply gathered and secured on itself by stitches," it was held that this was not a functional claim, but must be referred to the machinery described. *Arnold v. Bradbury*, (1871), 6 Ch. App. 706.

In a case where there was a claim for the use of a centring device in telegraphic apparatus used for ships or for analogous purposes, it was held that the claim was not too wide, although similar apparatus had been used in looms, calendars, etc., since analogous purposes might well refer to other telegraphs, and in view of the specification would be so interpreted. *Chadburn v. Mecham*, 12 R. P. C. 120.

A very important ruling was made by Lord Cairns, viz. that a statement that the patentee did not limit himself to any particular mode of producing his new manufacture did not extend his right to anything substantially beyond what he had previously described. *Binney v. Feldtmann* (1875), Griff. 49, H. L.

Where a specification described a method of obtaining certain new chemical bodies and claimed "as new products the colouring matters hereinbefore called anisoxines obtained substantially in the manner set forth," it was held that the claim was not general for the bodies produced, but was only for bodies produced in that particular way. *Monnet v. Beck*, 14 R. P. C. 777.

Where a specification described a process for the manufacture of iron tubes, the apparatus described con-

taining no mandril such as had hitherto been used, it was held that the claim must be interpreted as only applying to cases where no mandril was employed. *Russell v. Cowley* (1834), W. P. C. 459.

In the case of Edison's telephone patent the second claim, which was for the use of a diaphragm as described in an instrument for transmitting electrical impulses by sound, was held to be confined to its use in instruments such as formed the subject of the patent. *United Telephone Coy. v. Harrison* (1882), 21 Ch. D. 721.

Where a patentee had invented a machine for sewing bindings on hats, and said that his invention was for a method of putting on bindings so that the ends of the binding were joined subsequent to the binding being sewn on, and before it was turned over, and the first claim was for the method as described (the other claims being for the special machine), it was held that as the only method described was attaching the binding by a machine the claim was confined to this. *Gammons v. Battersby*, 21 R. P. C. 332, C. A.

But *cf.* the following case. In the case of a patent for an improved boothook made from a single piece of wire, where the specification described the process of manufacture and claimed a hook having certain characteristics and made from a single piece of wire as above set forth and for the purposes specified, it was held that the claim covered a hook with these characteristics made from a single piece of wire in any way. The case was compromised on appeal. *Bray v. Gardner*, 4 R. P. C. 400.

For similar decisions and dicta, see the following cases: *Kay v. Marshall* (1836), 1 My. & Cr. at p. 382; *Newton v. Vaucher* (1851), 21 L. J. (ex.) 305; *Jackson v. Wolstenholme*, 1 R. P. C. at p. 108, C. A.; *Mackie v. Berry*, 2 R. P. C. 146; *Easterbrook v. Great Western Railway*, 2 R. P. C. 201; *Lister v. Norton*, 3 R. P. C. 199;

paratively modern origin) have been defined as disclaimers (o), throwing open to the world all the specification contains which they do not cover, and this supports the view that the natural trend of the claim is not to extend, but rather to limit, the invention described in the specification (p). In so reading the specification care must be taken to distinguish the introduction which states to what the invention relates, from the description of the invention itself (q). The title is, of course, a part of the specification, and in some of the older cases had an important influence on construction (r). The drawings being part of the specification must be read with it (s), but the Courts are generally unwilling to hold that the drawings define the invention, or confine the claim so as to make something an essential element of the invention which is not mentioned in the letterpress (t).

Generally the provisional specification should not be used,

*Edison v. Smith*, 11 R. P. C. at p. 401, C. A.; *Fauccett v. Homan*, 13 R. P. C. 398, C. A.; *Perry v. La Société des Lunetiers*, 13 R. P. C. at p. 669; *Sunlight Coy. v. Incandescent Lighting Coy.*, 14 R. P. C. 757; *Patent Exploitation Coy. v. Siemens*, 19 R. P. C. 122; *Tubes, Ltd. v. Perfecta*, 20 R. P. C. 77, H. L.; *Patent Exploitation Coy. v. American Novelty Coy.*, 22 R. P. C. 316, C. A.; *Max Muller's Patent*, 24 R. P. C. 465.

(o) *Illustrative Case*: Where a specification after describing a process of bleaching flour by means of oxides of nitrogen, mentioned that other named re-agents could be used, but in the claim only oxides of nitrogen were mentioned it was held that the claim was limited to the use of these. *Andrew's Patent*, 24 R. P. C. 244, C. A.

See also *Hinks v. Safety Lighting Coy.* (1876), 4 Ch. D. at p. 612; *Plimpton v. Spiller* (1877), 6 Ch. D. 412, C. A.; *Kay v. Marshall*, *supra*; *British Motor Coy. v. Andrews*, 18 R. P. C. 85, H. L.

(p) As to the limitation of this doctrine, see *Consolidated Pneumatic Tool Coy. v. Ingersoll Sergeant Drill Co.*, 25 R. P. C. 61, H. L.

Where, however, something is described in the body of the specification as an invention the tendency is to read the claims as covering it. *Cf. Leadbeater v. Kitchin*, 7 R. P. C. 243, C. A.

So too where in the body of the specification a statement is made that the invention can be carried out in various ways, the tendency is not to confine the claims to the special form shown. *Reason Manufacturing Coy. v. Moy*, 20 R. P. C. 205, C. A. See also *Pether v. Shaw*, 10 R. P. C. 296; *Andrew's Patent*, 24 R. P. C. 364, C. A.

(q) *Dudgeon v. Thomson* (1877), 3 A. C. 40.

(r) See *Newton v. Vaucher* (1851), 21 L. J. (EX.) 305; *Oxley v. Holden* (1860), 30 L. J. (C. P.) 68.

(s) Sect. 2 (3).

(t) *Illustrative Case*: Where the claims of a patent for the use of an auxiliary condenser for condensing glycerine referred to the body of the specification, and the drawings showed what was probably a tubular condenser, it was held that the claims were not limited to this special form of condenser. *Scott's Patent*, 20 R. P. C. 257, C. A.

See also *Tolson v. Speight*, 13 R. P. C. 718; *Clark v. Adie* (No. 1) (1877), 2 A. C. at p. 342, H. L.; *Hinks v. Safety Light Coy.* (1876), 4 Ch. D. 607; *Rhodes v. British Cotton and Wool Dye Association*, 28 R. P. C. 67; *Palmer Tyre Coy. v. Pneumatic Tyre Coy.*, 16 R. P. C. at p. 480; *British Motor Traction Coy. v. Friswell*, 18 R. P. C. 497; *Crothwaite v. Moorwood*, 11 R. P. C. 561. But in *Hattersley v. Hodgson*, 23 R. P. C. 192, H. L., it was held that the invention might

to construe the complete (*u*), though; of course; where dis-conformity is raised it could be argued that if a certain construction were adopted the patent would be bad on that ground (*v*). An unamended specification must not be used in any way for the construction of the amended specification, though possibly it could be referred to as a contemporary document to show the knowledge of the time or the use of technical terms (*x*).

The claims will also in general be interpreted so as to avoid making the patentee claim what is stated in the specification to be old, whether directly or by reference to other specifications. This may lead to a claim which is not on the face of it a subsidiary claim being so interpreted (*y*).

Where there were several classes of systems or apparatus known at the date of the grant (*z*), and the whole description refers to one of these, the Court is generally unwilling to interpret the claims as covering systems or apparatus of other classes, more especially if the problems to be solved are different (*a*).

So if there is a statement as to the evils to be overcome (*b*) or

be confined to the exact thing shown in the drawings in order to meet the objection of non-utility.

(*u*) In particular it is not a proper method of construction to hold that because something is expressly mentioned in the provisional, and not expressly mentioned in the complete, it is therefore outside the claims of the patent. *Sadow v. Szalay*, 23 R. P. C. 6, H. L.

The rule, however, has not been absolutely adhered to, *e.g.*

In *Bailey v. Robertson* (1879), 3 A. C. 1055, H. L. the provisional was looked at to identify invention.

In *Parkinson v. Simon*, 11 R. P. C. 493, C. A., it was used to explain the working of patentee's machine, and in *Perry v. La Société des Lunetiers*, 13 R. P. C. 664, a claim was confined by reference to it.

It also seems to have been referred to in the course of the hearing in *Hay v. Gonville*, 25 R. P. C. 164; *s.c.* also *Marine Torch Coy. v. Holmes*, 29 R. P. C. 695.

(*v*) *Cf.* order of H. L. in *Bailey v. Robertson*, *supra*.

(*x*) See p. 236, *n.* (*s*).

(*y*) *Tubes, Ltd. v. Perfecta*, 20 R. P. C. at p. 95, H. L., and see p. 125.

(*z*) A different rule applies where they were not so known, see p. 150, *n.* (*u*).

(*a*) *Illustrative Case*: In the case of a patent for an atmospheric hammer (there being two well-known classes of these, one with the lower end open where the fall was by gravity, and the other with an air chamber closed at both ends, the hammer being raised and lowered by pressure on one side or the other), the patentee had throughout described an apparatus of the first kind and spoke in his claims of the closed end of the cylinder. The problems to be faced in the two cases were different. It was held that the patent did not include hammers of the second class. *Pilkington v. Massey*, 21 R. P. C. 696, C. A.

See also *Cleaver v. Wallwerk*, 13 R. P. C. 277; *British Tanning Coy. v. Groth*, 8 R. P. C. 113; *Downes v. Falcon Engine & Car Works, Ltd.*, 3 R. P. C. 70, C. A.; but *cf.* *Acetylene Illuminating Coy. v. United Alkali Coy.*, 22 R. P. C. 145, 155, H. L.

(*b*) *Jackson v. Wolstenholme*, 1 R. P. C. 105, C. A.; *Clay v. Allcock*, 23 R. P. C. at p. 750, C. A., and cases at p. 138 (*u*).

as to the advantages of the invention (c), the claim may be read as restricted to forms accomplishing these objects or having these advantages.

In some cases the rest of the specification may widen the apparent meaning of a claim by showing that other means may be substituted for some part (d), or that part of the apparatus is merely for convenience and not essential (e), or that words apparently introducing a fresh integer into the claim are merely for the purpose of identifying another integer (f). So on the other hand if the draftsman has been careful to mention where variations may be made, this may have the effect of excluding variations in other parts.

## SECOND RULE

### *What is not claimed is disclaimed*

The next rule is that what is not claimed by the claiming clauses is held to be disclaimed. This rule has really a two-fold effect. Firstly, it recognises and defines the true function of the claiming clauses, and secondly, it emphasises that the grant of a patent is the grant of a definite legal monopoly defined by the claiming clauses, and that there is no infringement unless such monopoly is invaded (g).

It was not till the judgment of the House of Lords in *Harrison v. Anderston Foundry Company* (h), in 1876, that the rule was clearly laid down that the claiming clauses measured

(c) *Martin v. Consett Iron Coy.*, 25 R. P. C. at p. 34, C. A.

(d) See p. 138.

(e) See p. 143.

(f) *Illustrative Case*: In the case of a patent for a method of using spent shale to heat the retorts in which distillation was conducted, a common fire chamber was described, and also a particular type of valve in the passage leading to it. The third claim was "the applying of a valve in the passage or space through which the contents of each retort are transferred to the common fire chamber such valve (followed by a description of the valve)." It was held that the reference to the common fire chamber was only to identify the valve shown, and that the patent was infringed by the use of a similar valve in apparatus in which there was no common fire chamber. *Clippens v.*

*Henderson* (1881), 4 S. X. 38 I. H.

See also *Lister v. Dix*, 16 R. P. C. 89 (where, however, the limitation was not in the claim itself).

(g) "There is, by some confusion of ideas, a notion sometimes entertained that there may be something like an infringement of the equity of a patent. I cannot think that there is any sound principle of that kind in our law. That which is protected is that which is specified, and that which is held to be an infringement, must be an infringement of that which is specified." *Dudgeon v. Thomson* (1877), 3 A. C. per CAIRNS, L.C., at p. 44.

(h) *Harrison v. Anderston Foundry Coy.* (1876), 1 A. C. 574.

This case has been frequently followed, but the rule is so well established that it is unnecessary to give the later cases.

the whole extent of the monopoly, and that matters described and not claimed were not included in such monopoly. Prior to this the general rule of construction had been that if anything was described in the specification, and not stated expressly or by implication to be old, it was held to be claimed (*i*). This decision was really a recognition of the alteration which had gradually grown up in the mode of drafting patents by inserting at the end claiming clauses to define the monopoly sought (*k*). The change in the method of interpretation marked by this case is all-important in considering the effect of earlier decisions on modern cases.

Combination  
claims.

It therefore follows that even if an invention is described in the specification it does not come within the monopoly unless it is claimed (*l*). This rule is particularly important with regard to combination claims. If a combination only is claimed the separate integers or subsidiary combinations, though these may in fact be new, are not covered by the grant and the taking of these parts, except in the combination claimed or an equivalent combination, does not constitute infringement (*m*).

(*i*) Good examples of the old method of construction are to be found in: *Carpenter v. Smith* (1841), W. P. C. 530; *Telley v. Easton* (1854), 23 L. J. (Q. B.) 77; *De La Rue v. Dickinson* (1857), 7 E. & B. 738; *Lister v. Leather* (1858), 27 L. J. (Q. B.) 295; *Patent Bottle Envelope Coy. v. Seymour* (1858), 28 L. J. (C. P.) 22.

(*k*) It was not till the Act of 1883 that there was any direction to insert a claiming clause, and it has been held that even this provision is only directory. See *Siddell v. Vickers*, 7 R. P. C. 292, H. L.; *Kelly v. Heathman*, 7 R. P. C. 343; *Tubes, Ltd. v. Perfecta*, 20 R. P. C. 77, H. L.

(*l*) *Illustrative Case*: Where a patentee described a method of casting the cogged rim of a wheel in one piece, turning and fitting so as to make it fit the inner wheel and cutting into segments which were then attached to wheel, the patent was held not to be infringed by taking the turning and fitting processes only. *Jackson v. Wolstenholme*, 1 R. P. C. 105, C. A.

See also *Harrison v. Anderston Foundry Coy.* (1876), 1 A. C. 574; *Clarke v. Adie*, (No. 1) (1877), 2 A. C. 320, 667; *Harrison v. Nicholson*, 25 R. P. C. 404, 405 C. A.; *Plating*

*Coy. v. Farguharson* (1879), Griff. 187, H. L.; *Nordensfeldt v. Gardner*, 1 R. P. C. at p. 65; *Moore v. Bennet*, 1 R. P. C. 129, H. L.; *Thomson v. Moore*, 6 R. P. C. at p. 440, C. A. Ir.; *Automatic Diversions Syndicate v. Urry*, 14 R. P. C. 365; *Bunge v. Higginbottom*, 19 R. P. C. at p. 190, C. A.; *Hardtmuth v. Baker*, 22 R. P. C. 66.

This clear modern rule renders it unnecessary to consider such suggested rules as that to constitute infringement the part taken must itself have been capable of being patented. See *Tatham v. Dania* (1869), Griff. 213.

The rule that a subordinate integer or combination is not protected unless it is separately claimed is often applied, consciously or unconsciously by the Courts, in refusing to interpret the omnibus claim for the apparatus as described as being for some integer or subordinate combination not claimed separately elsewhere. See *Consolidated Car Heating Coy. v. Came*, 20 R. P. C. 745, P. C.; *Garrard v. Edge*, 6 R. P. C. 387, C. A.

(*m*) Even a statement that the invention is applicable to certain purposes other than those mentioned in the claim does not extend the claim so as to make it cover the use of the



The second effect of this rule is to prevent a patentee, once he has defined his monopoly, from seeking to extend it by showing that his invention was really wider than his claims. Even if this is so it is irrelevant, his invention has been given to the world and the public are at liberty to make use of it, as well during the term of the patent as after, so long as they do not infringe upon the monopoly defined by the claims (n), which monopoly is the consideration which the inventor has sought and received. Patentee not allowed to extend claim.

The importance of the rule that a patentee, who has represented to the public that he only has a limited monopoly, is not allowed to afterwards contend that he has wider rights, and could safely have made a broader claim, is shown by the number of cases in which attempts have been made to break through it, but without success (o). This rule

invention for those purposes. *Lyon v. Goddard*, 11 R. P. C. 113, H. L.; *Vickers v. Siddell*, 7 R. P. C. 306, H. L.; *Orley v. Holden* (1860), 30 L. J. (C. P.) 68.

Of course if there is a claim to the article *per se* this covers its use for any purpose. *Adhesive Dry Mounting Coy. v. Trapp*, 27 R. P. C. 341, and p. 150, n. (s).

(n) See p. 119, n. (g).

(o) *Illustrative Cases* :—

Where a patent claimed the production of explosives from soluble nitro-cellulose, and the defendant had found that the same process was also applicable to insoluble nitro-cellulose, it was held that the patentee was bound by his claim, and that there was no infringement. *Nobel v. Anderson*, 12 R. P. C. 164 H. L. See also *British Ore Concentration Coy. v. Minerals Separation Coy.*, 27 R. P. C. 33 H. L.

Where a patentee had described and claimed a self-centring controlling valve for steering engines, the centring being effected by a special arrangement mentioned in the claim, it was held that the patentee could not extend his claim to cover self-centring controlling valves broadly, even if these were in fact new. *Brown v. Hastie*, 23 R. P. C. 361, H. L.

Where in a patent for a sieving machine the patentee had included as part of the combination claimed "rotating arms furnished with brushes fastened to the inner walls of the sieves," it was held that having thus

limited his claim, for whatever reason, he could not extend it to cover machines in which the brushes were fastened to the outer walls. *Bunge v. Higginbottom*, 19 R. P. C. 187, C. A.

So where a patentee claimed dies for folding strips of iron with an opening for tongs in the upper part, it was held that a similar die with the opening in the lower part did not infringe. *Stewart v. Bell's Trustees* (1883), 4 S. XI., 236.

Where a patentee claimed a clinical thermometer having two chambers formed in the ordinary bore with a constriction at the end of each, it was held that a thermometer with only one chamber having a constriction at each end was no infringement. *Hicks v. Simmons*, 21 R. P. C. 632, C. A.

Where a patentee claimed adding heated manganese to the liquid stream of steel metal as it came from the furnace, it was held not to be infringed by adding cold manganese. *Siemens v. Taylor*, 9 R. P. C. 393.

Where a patentee described a process for making certain new dyes and claimed "as new products colouring matters from dyes hereinafore called anisoline obtained substantially in the manner set forth," it was held that the claim was confined to dyes made in the way described, whether or not a claim to the product *per se* would have been good had it been made. *Monnet v. Beck*, 14 R. P. C. 777.

See dicta in *Nobel v. Anderson*, 11

is applied with special strictness where there has been a disclaimer (*p*).

### THIRD RULE

*The Specification must be interpreted as it would be by a person skilled in the art*

The specifications of Letters Patent are addressed to those skilled in the art to which such Letters Patent relate, and must be interpreted by the Courts as they would be interpreted by such persons (*q*). This means considerably more than the Court takes cognisance of the technical meaning of the terms used. With regard to the determination of the scope of a patent, it implies that the Court must read the specification and claims in the same spirit as such a competent craftsman would, and must consider whether a claim so read would represent to him that the invention lay in the general methods described by the patentee, or in the particular mechanical devices chosen by him. In order to determine this it is generally necessary that the Court should be instructed as to the prior state of the art (*r*).

R. P. C. at p. 128; *Hinks v. Safety Lighting Coy.* (1876), 4 Ch. D. at p. 612; *Dudgeon v. Thomson* (1877), 3 A. C. at p. 43; *Thomson v. Moore*, 6 R. P. C. at p. 440, C. A. Ir.; *Monnet v. Beck*, 14 R. P. C. 843.

And for further illustrative cases :

*British Tanning Coy. v. Groth*, 8 R. P. C. 113; *Hayes v. Hallmark*, 9 R. P. C. 25; *Nettlefold v. Reynolds*, 9 R. P. C. 270; *Siemens v. Taylor*, 9 R. P. C. 393; *Lancashire Explosive Coy. v. Roburite Explosive Coy.*, 14 R. P. C. 303, 311, H. L.; *Peters v. Owen*, 15 R. P. C. 663; *Welsbach Incandescent Coy. v. Daylight Coy.*, 17 R. P. C. 141, 146, C. A.; *British Motor Syndicate v. Andrews*, 18 R. P. C. 85, 94, H. L.; *Dunlop Pneumatic Tyre Coy. v. Moseley*, 18 R. P. C. 411; *Bunge v. Higginbottom*, 19 R. P. C. 187, H. L.; *Pilkington v. Massey*, 21 R. P. C. 696, C. A.; *Ackroyd v. Thomas*, 21 R. P. C. 737, C. A.

*Cf. contra obiter dictum in Walling v. Stevens*, 3 R. P. C. at p. 147, C. A., which seems hardly reconcilable with these decisions. Probably the most successful attempt to evade this rule

will be found in *Incandescent Gas Light Coy. v. De Mare Incandescent System*, 13 R. P. C. 559, C. A., explained and distinguished in *Welsbach Incandescent Coy. v. Daylight Coy.*, *supra*.

(*p*) "A patentee who disclaims cannot be permitted to play fast and loose with the public. If he alters the terms of his claim originally wide and general by inserting limiting words he must be bound by the limitation which he has so designedly introduced." *Plating Coy. v. Farquharson* (1883), Griff. at p. 187. See also *Peters v. Owen Stone Coy.*, 17 R. P. C. p. 80; *Palmer Tyre Coy. v. Pneumatic Tyre Coy.*, 16 R. P. C. at p. 485; *Seed v. Higgins* (1858), 8 H. L. C. 551.

But *cf. Hocking v. Hocking*, 4 R. P. C. 439, C. A.

(*q*) *British Dynamite Coy. v. Krebs* (1879), 13 R. P. C. 192, H. L.; *Presto v. Orme*, 18 R. P. C. at p. 23; *Scott's Patent*, 20 R. P. C. 262;

(*r*) *Gandy v. Reddaway*, 2 R. P. C. 58, C. A.; *Sugg v. Bray*, 2 R. P. C. 230; *Fletcher v. Glasgow Gas Commissioners*, 4 R. P. C. 388, O. H.

The above remarks must not be understood to mean that there are two classes of patents with different rules of construction according to the nature of the invention (s). The same broad rules apply to all patents and the monopoly is in all cases decided by the claims. In the case of an absolutely new departure the claims may be so drawn as to render the monopoly very limited, while in the case where the only invention is a choice of particular means the claims may be so drawn that the monopoly sought is a very broad one, though, of course, in this case the patent would be bad. Where the problem before the Court is clearly decided by the wording of the specification and claims these secondary considerations do not apply, but in a very large number of cases the claims cannot be properly interpreted without comparison between what is described in the specification and what was previously generally known, and it is to such cases that the above rule applies.

Application of this rule.

The true interpretation of the grant is therefore to be arrived at by considering what a competent craftsman reading the specification at the date of the grant would have understood the patentee to have claimed (t). All later knowledge should be eliminated (u), as should knowledge which would not be possessed by such craftsman (x).

True rule of interpretation.

But it is for the Court, when properly instructed, to fill the place of the craftsman, and a specification must be construed from its own contents, including of course anything incorporated by reference (y). The evidence of experts, or of the inventor himself, is therefore not admissible on any question of construction, though of course they are entitled to instruct the Court on the state of public general knowledge and the meaning of terms, and they may draw the attention of the Court to points which it might otherwise have missed (z).

One effect of this rule is that the Courts are strongly averse to construction claiming what

(s) *Nobel v. Anderson*, 11 R. P. C. 523, C. A.; but cf. *Collins v. Green*, 29 R. P. C. 551, C. A.

(t) See cases in note (o), p. 133, especially *Incandescent Gas Coy. v. De Mare Incandescent Coy.*

(u) *Badische, etc. v. Levinstein*, 4 R. P. C. 449, 463, 465, H. L.; *Vidal Dye Syndicate v. Levinstein*, 29 R. P. C. 277, C. A.; *Lane-Fox v. Kensington Electric Lighting Coy.*, 9 R. P. C. 241. See also p. 67.

(x) *Gandy v. Reddaway*, 2 R. P. C.

52, 53, C. A., and p. 245.

(y) *Tubes, Ltd. v. Perfecta*, 20 R. P. C. at p. 95, H. L.

(z) See p. 188.

Of course this evidence to be relevant must deal with what the competent craftsman would have known, not with what the inventor himself knew. *Gandy v. Reddaway*, 2 R. P. C. 52, 53, C. A. See also as to evidence by inventor, *Bradford Dyers v. Williams*, 18 R. P. C. 220, 232.

is notoriously  
old to be  
avoided.

to construing a claim as being for what any competent man must have known to be old, if they can possibly avoid this interpretation. This is not merely because they follow the principle of supporting a patent if it be possible, but also because this is the way in which the person to whom the specification is addressed would naturally interpret the claim (a). The principle is similar to that referred to above by which claims are not taken to be for matters which are stated to be old on the face of the specification, though of course in the latter case the effect is even stronger (b). But while this is the general and proper line of construction a specification will not be construed to prevent its including something which is clearly claimed (c). The application of this rule may lead to a claim being interpreted as a "subsidiary" claim or as being confined to some particular class of apparatus or process (d). Of course this rule only applies in the case of matters which are really common knowledge, and which must be presumed to have been known to craftsmen generally and also to the patentee, it has no application to cases of prior user not generally known, or to matter contained in publications, such as specifications, which do not form part of common general knowledge (e).

Application  
to question of  
infringement.

The rule has also most important applications in connection with what constitutes infringement, but this is so closely connected with the doctrine of equivalents that it will be most conveniently treated in the next chapter (f).

(a) *Adie v. Clark* (1876), 14 W. R. 1008; *Haworth v. Hardcastle* (1834), W. P. C., at p. 484; *Oxley v. Holden* (1860), 30 L. J. (C. P.) at p. 68; *Morton v. Middleton* (1863), 3 S. 1. 721; *Plimpton v. Spiller* (1877), 6 C. D. 424, C. A.; *Walling v. Stevens*, 3 R. P. C. 153; *Spencer v. Ancoats Coy.*, 6 R. P. C. 46; *Electrolytic Coy. v. Evans*, 17 R. P. C. at p. 741; *Patent Exploitation Coy. v. Siemens*, 20 R. P. C. 234, C. A.; *Cooper Patent Coy. v. London County Council*, 23 R. P. C. 289; *Browns Patent*, 25 R. P. C. 114, C. A.; *Collins v. Green*, 29 R. P. C. 557, C. A..

In *Hinde v. Osborne*, 2 R. P. C. 66, C. A., it was suggested that this did not apply when patent purported to be for a new article and not for an improvement, *s. q.*

(b) See *Tubes, Ltd. v. Perfecta*, 20 R. P. C., at p. 97, H. L.

(c) *Clark v. Adie* (1877), 2 A. C., at p. 437; *Cropper v. Smith*, 1 R. P. C.

81, C. A.; *Sugg v. Bray*, 2 R. P. C. 223; *Leadbeater v. Kitchin*, 7 R. P. C. 233, C. A.; *Hinks v. Safety Lighting Coy.* (1876), 4 Ch. D. 607; *Webb v. Kynoch, Ltd.*, 17 R. P. C., at p. 116, H. L.; *Electric Construction Coy. v. Imperial Tramways Coy.*, 17 R. P. C., at p. 550, C. A.; *Turnbull v. Cruikshank*, 22 R. P. C. 521, O. H.

(d) See *Plimpton v. Spiller*, *supra*, and p. 118, *n. (y)*.

(e) *Adie v. Clark* (No. 2) (1876), 3 Ch. D. 134, C. A. For cases where such evidence has been excluded, see LICENCES, p. 245, *n. (g)*.

The fact that the patentee or his agent know of such publication would not matter; it is the interpretation to the trade that has to be ascertained: *cf. Webb v. Kynoch*, 15 R. P. C., at p. 577, C. A. Ir.

(f) See p. 132 *et seq.* The rule that a specification must be interpreted in view of the state of general knowledge

*Rules as to the bearing of one Claim on the Construction of another*

The general tendency is to construe claims in different language as not being co-extensive, although one may be construed as being merely for a special part of the monopoly claimed by the other (j). But this is by no means an absolute rule (h), and there are many cases in which, by reason of wording of the specification as a whole, or of the subject-matter of the patent, a series of claims have been construed as being practically identical (i). Again the Courts do not seek to differentiate the omnibus claim generally found at the end of a specification from those which have gone before (k).

Claims *prima facie* not co-extensive.

Where in addition to the main claim there are claims beginning "in a machine of the class described and claimed in claim so and so" these claims are construed as subsidiary or appendent, *i.e.* as claims not extending the monopoly covered by the former claim. But where the later claims do not contain such introductory words, or refer merely to a machine of the class described, and then refer to certain specific integers, they are generally interpreted as for such integers, even if

Subsidiary claims.

at the date of the grant, being a true rule of construction, applies of course whether validity is challenged or not. *Spencer v. Ancoats Coy.*, 6 R. P. C. 46; *Ashworth v. Roberts*, 9 R. P. C. 109, C. A.; *Schermully v. Paine*, 18 R. P. C. 529; see also cases at p. 246, *nn. (o) (p)*.

*(g) Illustrative Cases:—*

Where the first claim was for the construction of ships having an iron frame, combined with external wooden planking, and a later claim was practically identical with the addition of the words "as described," it was held that the first claim was for the combination generally and was not confined to the particular form described. *Jordan v. Moore* (1866), 35 L.J. (C. P.) 268.

Where the first three claims were for apparatus as described having a sieve and deposit surface and the fourth claim was for such apparatus having also a deflector, it was held that the deflector formed no part of the combination claimed in the earlier claims. *Parkinson v. Simon*, 12 R. P. C. 403, 407, H. L. See also, *Bailey v. Robertson* (1877), 4 S. IV, 245, I. H.; *Lawrence v. Perry*, 2 R. P. C., 184; *Rowcliffe v. Longford Wire Coy.* 4 R. P. C., p. 283; *Edison v. Smith*, 11 R. P. C., p. 400, C. A.; *Deeley's*

*Patent*, 12 R. P. C. 73; *Cassel Gold Extracting Coy. v. Cyanide Recovery Syndicate*, 12 R. P. C. 232, C. A.; *Kane v. Guest*, 16 R. P. C. 433; *Electric Construction Coy. v. Imperial Tramways Coy.*, 17 R. P. C. 537, C. A.; *Wilson Brothers, Ltd. v. Wilson & Coy.*, 20 R. P. C. 1, H. L.; *Kelvin v. Whyte Thomson*, 25 R. P. C. 177; *Rickerby v. Duncan*, 25 R. P. C. 248; *British United Shoe Machinery Coy. v. Collyer*, 26 R. P. C. 21; *Wallace v. Jack*, 22 R. P. C. 592, O. H.; *Graphic Arts Coy. v. Hunters, Ltd.*, 27 R. P. C. 677.

(h) "It is not a ground for invalidating a specification that it claims the same thing over again in different language." *Van Berkel v. Simpson*, 24 R. P. C., at p. 137, I. H.; see also *Edison v. Smith*, *supra*; *Wenham Gas Coy. v. Champion Gas Coy.*, 9 R. P. C. at p. 55.

(i) *E.g.* *American Braided Wire Coy. v. Thompson*, 6 R. P. C. 518; *Duckett v. Whitehead*, 12 R. P. C. 657, C. A., where the whole of the claims were interpreted as for the special combination.

(k) *Cf.* *Consolidated Car Heating Coy. v. Came*, 20 R. P. C. 745, P. C., but see *contra Presto v. Orme*, 18 R. P. C. 25, C. A.; *Annand v. Taylor*, 18 R. P. C. 53, H. L.

these were known to be old, and must stand or fall without reference to the patentability of other parts of the apparatus (*l*). If, however, the claims are not for a combination of integers, but for an application or mode of use notoriously old, the tendency is to read them as confined to such application or mode of use of the invention before claimed, and not of things in general (*m*). But where the use of an integer in a particular novel manner is claimed in one claim and the integer alone in another, this last is construed as being for the integer *per se* (*n*).

(*l*) *Illustrative Cases* :—

Where a specification described a bootnailing machine having special methods of feeding the work, holding the nail, etc., and one of the later claims was, "In a machine for driving hobnails into boots the use of a side guard, etc. . . . substantially as described," it was held that the claim was for the use of a side guard in any such nailing machine and not merely with the particular machine claimed. *British United Shoe Machinery Coy. v. Cloughton*, 24 R. P. C. 33, C. A. See also *Roberts v. Heywood* (1879), 27 W. R. 454; *Cropper v. Smith*, 1 R. P. C. 81, C. A.; *Britain v. Hirsch*, 5 R. P. C. 226, C. A.; *Haws v. Harding*, 14 R. P. C. 930, C. A.; *Dowler v. Keeling*, 15 R. P. C. 214, C. A.; *Taylor v. Annand*, 17 R. P. C. 126, 137, C. A.; *Consolidated Pneumatic Tool Coy. v. Ingersol Sergeant Drill Coy.*, 25 R. P. C. 574, H. L.; *British United Shoe Machinery v. Cloughton*, 23 R. P. C., at p. 335; *Klaber's Patent*, 23 R. P. C. 461, C. A.

The case of *Finlay v. Allen* (1857), 2 S. XIX. 1087, would seem hardly reconcilable with these cases. The same remark applies to the dicta in *Kelly v. Heathman*, 7 R. P. C., at p. 348.

In the case of a machine of a wholly new type the expression "in a machine of the class described" might be sufficient to confine a claim to the special machine. Cf. *Van Berkel v. Simpson*, 24 R. P. C. at p. 137; *Van Berkel v. Booth*, 23 R. P. C. 573.

The mere fact that one integer is described as "for use with" another will not make the claim a combination claim. *Rowcliffe v. Longford Wire Coy.*, 4 R. P. C. 281.

(*m*) *Illustrative Cases* :—

In the case of a patent for a new

explosive "dynamite" the second claim was for detonating this explosive with a known fuse. Held, appendent. *British Dynamite Coy. v. Krebs* (1879), 13 R. P. C. 190, H. L.

In a patent for a pneumatic tyre there was a claim for attaching the patented tyre by means not shown in the provisional. Held Appendent. *Pneumatic Tyre Coy. v. Casswell*, 13 R. P. C. 164.

Where the specification described and claimed a special runner for skates, and also described old means of fixing them, and there was a second claim for the mode of securing the runners and making them reversible "as above described," it was held to be confined to the use of this mode for the special runners. *Plimpton v. Spiller* (1877), 6 Ch. D. 412. See also *Betts v. Menzies* (1857), 10 H. L. C. 117; *Betts v. Neilson* (1866), 3 Ch. App. 429.

(*n*) See *Wilson Brothers, Ltd. v. Wilson & Coy.*, 20 R. P. C. 1, H. L.

For cases where claims have been held to be appendent, see *Ehrlich v. Ihlee*, 5 R. P. C. 437, C. A.; *Edison v. Smith*, 11 R. P. C. 389, C. A.; *Parker v. Satchwell*, 13 R. P. C. 299; *Halden v. Hall*, 21 R. P. C. 609; *Van Berkel v. Booth*, 23 R. P. C. 573, Ir.; *Van Berkel v. Simpson*, 24 R. P. C. 117, I. H.; *True and Variable Electric Lamp Coy. v. Bryant*, 25 R. P. C. 461; *Finlay v. Allen* (1857), 2 S. XIX. 1087. For cases where an opposite view has been taken, see *Britain v. Hirsch*, 5 R. P. C. 226, C. A.; *Kinmond v. Keay*, 20 R. P. C. 497; *Klaber's Patent*, 23 R. P. C. 461, C. A.; *Osmond's v. Balmoral Cycle Coy.*, 15 R. P. C. 505; and on the general question of appendent claims, *British Dynamite Coy. v. Krebs*, *supra*; *Pneumatic Tyre Coy. v. Casswell*, *supra*.

*Other Points of Construction*

The general tendency is to construe a single claim as being for one invention unless the words clearly show it is not so. Thus a claim for A and B is construed as a claim for the combination and not for A and B separately (o). In the case of claims such as "the herein-described improvements in the process of and apparatus for so and so" the question whether the claim is for the two matters jointly or separately will depend on the exact wording of the title and specification (p).

Generally speaking two processes or parts connected by the word "or" are to be understood as different alternatives (q), though in some cases this word is simply taken as introducing another definition of a technical term (r).

In the case of technical terms if it appears from the whole specification that they have been used in a sense different from

(o) *Illustrative Case*: In the case of a claim for "forming continuous supply and discharge conduits substantially as described" the Court were of opinion that the claim only covered apparatus in which both conduits were so formed. This was partly on the ground that any other construction would have made the patent bad. *Ncedham v. Johnson*, 1 R. P. C. 49, C. A.

For cases where a single claiming clause was construed as two claims, see *Dowler v. Keeling*, 15 R. P. C. 214, C. A.; *Tolson v. Speight*, 13 R. P. C. 718.

Generally each claim must be taken by itself, see *Haws v. Harding*, 14 R. P. C. 932, C. A.; but in *Kelly v. Heathman*, 7 R. P. C. 343, three separate claims were taken as for one combination.

(p) Cases where claim held to be single:—

Patent for "improvements in distillation of shale and apparatus therefor" held for one invention only. *Clippens v. Henderson* (1188), 4 S. X. 38, I. H.

A claim for "the metal fittings and the mode of applying the same described herein" held not to be a claim for the fittings apart from the mode of application. *Oxley v. Holden* (1860), 30 L. J. (C. P.), 68. Whereas in *Dowler v. Keeling*, *supra*, and *Tolson v. Speight*, *supra*, the claim was held to be for the two matters separately.

(q) *Simpson v. Holliday* (1866), L. R. 1 H. L. 315; *Elliot v. Turner*

(1845), 15 L. J. (C. P.) 49.

(r) *E.g.* in the following cases:—

"Hydrated or precipitated oxides of iron," *Hills v. London Gas Coy.* (1859), 29 L. J. (EX.) 409; *Hills v. Liverpool Gas Coy.* (1862), 32 L. J. (CH.) 28; "semi solid or plastic." *Patent Exploitation Coy. v. Siemens*, 21 R. P. C. at p. 547, H. L. See also *Patent Exploitation Coy. v. American Electrical Novelty Coy.*, 22 R. P. C. 316, C. A. "In line with or parallel to," *White v. Bertrams*, 14 R. P. C. 735, I. H.; "conditioning or improving," *Flour Oxidising Coy. v. Hutchinson*, 26 R. P. C. 597.

Where a specification prescribed the use of "soft or organzine silk such as is used in the making of satin," the Judge directed the jury that only the use of "organzine" silk would be an infringement. A new trial was ordered on the ground of misdirection because "or" was primarily disjunctive, though there might be evidence such as that organzine silk was the only silk used for making buttons at the date of the patent, which would justify the jury finding otherwise. On the second trial the verdict was for the plaintiff and was not disturbed. *Elliot v. Turner* (1846), 2 C. B. 446.

In the case of an alleged anticipation in which mention was made of "a groove or a projection or collar," the H. L. reversing the C. A. held that these must be taken to have been mentioned as equivalents and not

Claim presumed to be for single invention.

Interpretation of "or."

the ordinary, that sense will be adopted (s). In other cases the sense in which the ordinary craftsman in this country (t) would have understood them at the date of the patent is the right one (u). The Court will adopt the ordinary interpretation in preference to the strictly scientific one (x).

The ordinary meaning of technical terms are questions of fact (y).

“Substantially as described.”

There is considerable difficulty in assigning any consistent meaning to the phrase “substantially as described,” which is found in so many claims. It has been said that these words only express what the law implies (z), but in general they exercise a limiting effect on the claim by tying it more closely to the preceding description (a).

Many claims are for the combination of certain integers substantially as described. Where these integers are designated in the claim in general terms the limitation applies to the method of combination and not to the particular integers so as to confine them to the precise form shown (b), or to make

as alternatives acting in different ways.

*Kaye v. Chubb*, 5 R. P. C. 641, H. L.

(s) “Of course it (*i.e.* conduit) does mean that which the patentees have said it means. You are not to look into the dictionary to find out what conduit means, but you are to look at the specification to see in what sense the patentees have used it.” *Needham v. Johnson*, 1 R. P. C. 49.

See also *Patent Exploitation, Ltd. v. American Electrical Novelty Coy.*, 22 R. P. C. 316, C. A.; *Cutler's Patent* (1836), W. P. C. 418; *United Telephone Coy. v. Bassano*, 3 R. P. C. 315, C. A.; *Edison v. Woodhouse*, 4 R. P. C. 79, C. A.; *Lister v. Dix*, 16 R. P. C. 89; *Jandus Arc Lamp Coy. v. Johnson*, 17 R. P. C. 361; *Bowden's Patent*, 22 R. P. C. 49; *Brown's Patent*, 24 R. P. C. 313; 25 R. P. C. 119, C. A.; *Rogers v. Cochrane*, 26 R. P. C. 596, H. L.

(t) *Wegman v. Corcran* (1878), 13 Ch. D. 65; *Plating Coy. v. Farquharson* (1883), Griff. 187.

(u) *Clegg's Patent* (1829), W. P. C. 103; *Betts v. Menzies* (1857), 10 H. L. C. 117; *Muntz v. Foster* (1843), 2 W. P. C. 96; *Plating Coy. v. Farquharson*, *supra*; *Budische, etc. v. Levinstein*, 4 R. P. C. 463, H. L.; *Lane-Fox v. Kensington Electric Lighting Coy.*, 9 R. P. C. 241, 242; *Welsbach Incandescent Coy. v. New Incandescent Coy.*,

17 R. P. C. 237.

(x) *Simpson v. Holliday* (1866), L. R. 1 H. L. 315.

(y) *M'Dougall v. Girdwood* (1867), 3 S. V. 937, I. H.; *Betts v. Menzies*, *supra*; *Betts v. Neilson*, 3 Ch. App. 429; *Budische, etc. v. Levinstein*, *supra*.

(z) As to “substantially” being mere verbiage, see *Young v. Rosenthal*, 1 R. P. C. 29; *Westinghouse v. L. & Y. Rail. Coy.*, 1 R. P. C. 229.

(a) A good example will be found in the case of *Hattersley v. Hodgson*, 21 R. P. C. 517, C. A. See also *Miller v. Clyde Bridge Coy.*, 9 R. P. C. 480, H. L.; *Brooks v. Lamplugh*, 15 R. P. C. 49, C. A.

(b) *Illustrative Case*: In the case of a claim for “the application of a shuttle in combination with a needle as shown in sheet one of the drawings . . . whatever be the means employed for making and working such shuttle and needle when employed together,” it was held that “as shown in Fig. 1,” applied to the combination and not to the needle, and that the claim was not confined to the particular needle. *Thomas v. Foxell* (1858), 5 Jur. (N. S.) 37.

See also *Consolidated Pneumatic Coy. v. Ingersoll Sergeant Drill Coy.*, 25 R. P. C. 61, H. L.; *Parkinson v. Simon*, 12 R. P. C. 403, H. L.; *Holmes v. Associated Newspapers*, 27



essential what the specification describes as optional (c), if, however, these are more particularly identified by references to the specification the limitation *may* apply to them also (d).

The view has been expressed by the Courts that it is not a proper way of claiming a general principle of construction to describe a particular form and then claim the apparatus as described (e).

If there is a real doubt as to whether the claim includes what the defendant does, it would seem that he should have the benefit of it. It must be remembered that the words of the specification are those of the patentee, and should be taken more strongly against him. In the case where the doubt would affect the validity of the patent the application of this principle is limited by another maxim—*ut res magis valeat quam pereat*—but in a case where only the scope is affected it may be given full play (f).

Care has often to be taken in applying decisions of the Courts as to construction where the patent has been held to be valid and not to be infringed. There are a number of cases which can only be held to mean that the Court has thought it more merciful to the plaintiff to hold the patent to be confined to the particular example and not to be infringed than to hold it bad, and in such cases

R. P. C. 149, C. A.; *Deeley's Patent*, 12 R. P. C. 73; *Thompson v. Macdonald*, 8 R. P. C. 5; *Lawrence v. Perry*, 2 R. P. C. 183; *Crosthwaite v. Moorwood*, 11 R. P. C. 555; *Acetylene Corporation v. United Alkali Coy.*, 22 R. P. C. 145, H. L.; *Gamble v. Kurtz* (1846), 3 C. B. 435; *Farbenfabriken, &c. v. Chemische Fabrik, &c.*, 22 R. P. C. 517, but see *contra*; *American Braided Wire Coy. v. Thompson*, 6 R. P. C. 518, H. L.; *British Motor Traction Coy. v. Universal Motor Coy.*, 16 R. P. C. 113; *Duckett v. Whitehead*, 12 R. P. C. 376, C. A.; *Knight v. Argylls, Ltd.*, 29 R. P. C. 609.

(c) *Glover v. American Steel and Wire Coy.*, 19 R. P. C. 102; *Vidal Dyes Syndicate v. Levinstein*, 29 R. P. C. 270, C. A.

(d) *Illustrative Case*: A claim for "the combination of a guided lever A<sub>2</sub>," &c., was held to be confined to the particular lever shown. *Westinghouse v. Lancashire and Yorkshire Rail. Coy.*, 1 R. P. C. 229.

*Cf. Thomas v. Welch* (1866), 35 L. J. (C. P.) 200, but *cf. Thomas v. Foxell, supra*.

(e) *Ackroyd v. Thomas*, 21 R. P. C. at p. 750, C. A.; *cf. Davis v. Townsend*, 16 R. P. C. 497; *Fairburn v. Household*, 3 R. P. C. 263, C. A.

(f) See *Consolidated Car Heating Coy. v. Came*, 20 R. P. C. 756, P. C. See also as to the effect of ambiguity, *Badische, etc. v. Société des Usines du Rhone*, 15 R. P. C. 369, C. A.

Where infringement doubtful.

Anomalous decisions.

the specification is sometimes construed in a way which would seem to defy all rules (*g*).

(*g*) *Illustrative Case*: A patent for improvements in skirt waist bands described a method of weaving webs by means of three conical rollers, and then said that although three rollers had been shown two or any suitable greater number could be used. It was in fact old to use two, and the

defendant did this. The Court of Appeal restricted the claim to the use of three rollers on the ground that this was the only improvement made by the patentee. *Vorwerk v. Evans*, 7. R. P. C. 265, C. A. ; cf. also *Bovill v Pimm* (1856), 11 Ex. 718.

## CHAPTER IX

### INFRINGEMENT

#### PART I

#### RIGHTS DEPENDING ON THE CONSTRUCTION OF THE SPECIFICATION

WHERE a patent action was tried with a jury the question of infringement was always for them (a), subject, of course, to proper directions from the Court. In the earliest days, before there was any specification, when the only questions were, had the plaintiff made an invention, and had the defendant taken it, infringement was necessarily a pure question of fact. The earlier specifications too were rather descriptions of the new manufacture than attempts to define the essential features of the invention. Although the modern systems of claims is of great assistance in arriving at this definition, the question still remains, after the Court has decided what are the essential features claimed, whether the defendant has taken these features, and this is a question of fact and substance rather than of words (a). The historical development of this question here referred to is not without importance as indicating the spirit in which the question of infringement should be approached.

Infringement  
an issue of  
fact.

In the great majority of cases that come before the Courts it will be found that the defendant has made some variation in one or more of the elements of the invention as claimed.

(a) *Clark v. Adie* (1873), 2 A. C. 320. See also *Walton v. Potter* (1841), W. P. C., at p. 586; *Consolidated Car Heating Coy. v. Came*, 20 R. P. C. 745, P. C.; *De la Rue v. Dickenson* (1857), 7 E. & B. 738; *Incandescent Lighting Coy. v. De Mare Incandescent System*, 13 R. P. C., at p. 330; *Newell v. Lawson*, 24 R. P. C. 311, C. A.; *Hoffman Manufacturing Coy., Ltd. v. Auto-Machinery Coy., Ltd.*, 8 R. P. C., at p. 151.

It was, however, suggested that if everything was on paper, e.g. if the defendant admitted that he was working under a later patent, the Court might decide the question. *Bovill v. Pimm* (1856), 11 Ex. 718; *Westinghouse v. L. & Y. R.*, 1 R. P. C. 229.

This probably amounts to little more than that no other verdict than one which the Court approved would be tolerated in such a case.

In determining whether these variations are sufficient to avoid infringement it must be remembered that, as above explained, the specification was in its origin a practical description of the new manufacture for the practical craftsman. It does not purport to be a self-contained document as such an Act of Parliament where nearly every important expression is defined either by the words in the Act itself or by reference, and the meaning of the terms in a specification and how much they comprehend must be ascertained by the context and by reference to the knowledge of the art. This leads to the consideration of the doctrine of equivalents with which this portion of the present chapter is very largely concerned.

Doctrine of equivalents.

As has been mentioned in the chapter on subject-matter the doctrine of equivalents depends on the fact that to a skilled man mention of, say, some apparatus with the use of which he is acquainted brings more to his mind than the particular thing mentioned, since there is a surrounding penumbra suggesting other apparatus more or less closely connected with it, or equivalent to it for the various uses to which it may be put (*b*). The existence of this penumbra does not necessarily depend on the wording of the specification though this may extend, contract, or extinguish it. The Courts, therefore, recognize that in deciding whether the invention as defined has been taken it is proper to consider how far the claims may be read as including equivalents of the elements set out. This question is not wholly decided either by the state of knowledge or by the words used, but is governed by the two jointly, that is to say, by the effect that the specification would have on the mind of a reader skilled in the art (*c*).

Broad and narrow construction.

One of the most important considerations is whether the specification is such that the craftsman would understand that a new line had been struck out, or whether it would be clear to him that all that had been done was to propose a particular variation of old matters. In the former case he would naturally

(*b*) *Stevens v. Keating* (1847), 2 W. P. C., at p. 188.

(*c*) The standard of knowledge to be taken is that of the ordinary skilful mechanic or chemist, not that of the specialist. See *Heath v. Unwin* (1853), 22 L. J. (c. P.), at p. 14. In the case, however, of patents dealing with highly scientific subjects, the

Courts are now taking them to be addressed to very highly trained persons. See p. 89.

Of course this reading in of common knowledge as to equivalents is an absolute necessity unless each specification is to be made a text-book for the craft to which it relates.

feel that many modifications dictated by his general knowledge might be made without departing from the spirit of the invention. In the latter he would think that, as the success claimed depended on a small variation on what was old, it would not be safe to depart largely from what had been described, as by employing other devices which for many purposes are looked on as the equivalents of those mentioned, and yet expect to obtain the benefit sought by the patentee (*d*). Specifications which fall clearly into one of these two classes are often described as being such as came into consideration in the cases of *Proctor v. Bennis* and *Curtis v. Platt* respectively (*e*).

Although the Courts in proper cases still adopt a wide view on the question of equivalents there is a growing feeling that it is the business of the patentee to avail himself of the facilities given by the modern method of claiming clauses so as to state clearly what monopoly he claims, and that it is not a proper method of drawing a specification to describe a machine, and claim it as described, and then to resort to the doctrine of equivalents in order to turn the claim for the thing described into a claim for a system of construction (*f*), or to say that one feature, not picked out from the others in the specification;

Doctrine not  
remedy for  
faulty  
drafting.

(*d*) See also pp. 123, 124.

(*e*) *Proctor v. Bennis*, 4 R. P. C. 333, C. A.; *Curtis v. Platt* (1865), 35 L. J. (CH.) 852.

The distinction applies rather to the dicta of the two Courts than to the actual facts of the cases. The infringement in the first-named case was really a very clear one.

For cases illustrating the *Proctor v. Bennis* doctrine, see *inter alia*. *Moore v. Thomson*, 7 R. P. C. 325, H. L.; *Boyd v. Horrocks*, 9 R. P. C. 77, H. L.; *Incandescent Lighting Coy. v. De Mare Incandescent System*, 13 R. P. C. 559, C. A.; but see as to this case *Welsbach Incandescent Coy. v. Daylight Co.*, 17 R. P. C. 141, C. A.; *North British Rubber Coy. v. Gormully and Jeffreys*, 15 R. P. C. 245, H. L.; *Presto v. Orme*, 18 R. P. C. 17, C. A.; *Neil v. Macdonald*, 20 R. P. C. 213, O. H.; *British United Shoe Machinery Coy. v. Thompson*, 22 R. P. C. 177; *Sandow v. Szalay*, 23 R. P. C. 6, H. L.; *Van Berkel v. Simpson*, 24 R. P. C. 117, I. H.

For cases illustrating the *Curtis v. Platt* doctrine see, *inter alia*, *Gosnell v. Bishop*, 5 R. P. C. 597, C. A.;

*Wilson v. Barbour*, 5 R. P. C. 245, C. A. Ir.; *Boyd v. Horrocks*, 6 R. P. C. 152; *Tucker v. Kay*, 8 R. P. C. 230, C. A.; *Jahncke v. Bell*, 9 R. P. C. 94, C. A.; *Tweedale v. Ashworth*, 9 R. P. C. 121, H. L.; *Nettlefolds v. Reynolds*, 9 R. P. C. 270; *Brown v. Jackson*, 12 R. P. C. 311, P. C.; *Morris v. Young*, 12 R. P. C. 455, H. L.; *Birch v. Harrap*, 13 R. P. C. 615; *Brooks v. Steel*, 14 R. P. C. 46; *Tweedale v. Ashworth* (second action), 17 R. P. C. 620, C. A.; *Schermuly v. Pain*, 18 R. P. C. 529; *Crocker v. Aerators, Ltd.*, 20 R. P. C. 621, 790, H. L.; *White v. Hartley*, 20 R. P. C. 265, 273; *Bailey v. Airey*, 23 R. P. C. 277, C. A.; *Consolidated Pneumatic Tool Coy. v. Clark*, 24 R. P. C. 593, C. A.; *Ashworth v. English Card Clothing Co.*, 20 R. P. C. 790, H. L.; *Nicholls v. Kershaw*, 27 R. P. C. 237; *Collins v. Green*, 29 R. P. C. 551, C. A.; *British, etc. Automatic Coy. v. Metropolitan Gas Meters, Ltd.*, 29 R. P. C. 571, A. C.; *Knight v. Argylls, Ltd.*, 29 R. P. C. 593, 608.

(*f*) *Ackroyd v. Thomas*, 21 R. P. C. at p. 750, C. A., and see p. 129, *n.* (*e*).

is the essential feature, and all the other non-essentials for which equivalents may be used (g). The proper function of the doctrine of equivalents is to protect the patentee against evasions or variations which a reasonable man would either not have foreseen or not have considered it necessary to mention specifically in his specification, rather than to supplement faults of drafting by reading in claims which should have been inserted in the first instance.

Would the device have been recognised as equivalent?

In considering whether the device used by the defendant is an equivalent of that mentioned in the claim, the important question is would it, in the state of knowledge at the time of the grant, have been known to be an equivalent, or at any rate does it belong to a class which would have been known to be equivalent (h)? The fact that it would have needed invention or even ingenuity to see that the device used could be substituted for that claimed would generally avoid infringement (i), but if that invention or ingenuity has been exercised in obtaining a particularly favourable form of the device claimed, or of a device of an equivalent class, it does not do so (k).

Equivalence question of fact.

The question of equivalence being one of fact no definite rules can be laid down (l), and the following headings must be looked on chiefly as classifications of the relevant cases. In applying such cases great attention must be paid to the particular wording of the specifications considered, and to the evidence as to the state of knowledge.

Similarity of effect.

Although similarity of effect may be evidence on the question

(g) *Consolidated Pneumatic Tool Coy. v. Ingersoll Sergeant Drill Coy.*, 25 R. P. C. 574, H. L.; *Fairburn v. Household*, 3 R. P. C., at p. 267, C. A.; *Hardmuth v. Baker*, 22 R. P. C., at p. 75, C. A. See also pp. 128, 129.

(h) *Heath v. Unwin* (1853), 22 L. J. (C. P.), at p. 14, and also 5 H. L. C. 505; *Vidal Dye Syndicate v. Levinstein*, 29 R. P. C. 277, C. A.; *Electric Telegraph Coy. v. Brett* (1851), 20 L. J. (C. P.) 123; *Badische, etc. v. Levinstein*, 4 R. P. C. 449, H. L.; *Lane-Fox v. Kensington Electric Lighting Coy.*, 9 R. P. C. 221; *Nobel v. Anderson*, 11 R. P. C., at p. 523, C. A., and 12 R. P. C. 167, H. L.; *Welsbach Incandescent Coy. v. Daylight Incandescent Coy.*, 17 R. P. C. 141, C. A.; *Bunge v. Higginbottom*, 19 R. P. C., at p. 196, C. A.

(i) Cf. *Unwin v. Heath* (1853), 5 H. L. C. 505.

(k) *Illustrative case*:—Where a patentee had described a method for making tubes by drawing bent iron through conical holes, and the defendant had improved the process by drawing the pipe through grooved rollers, which avoided relative motion, it was nevertheless held an infringement. *Russell v. Cowley* (1834), 1 W. P. C. 459.

In Scotland, however, it was held that the specification did not include, nor was it anticipated by, the use of grooved rollers which themselves drew in the pipe. *Russell v. Crichton* (1839), 2 S. I. 893.

See also *Bunge v. Higginbottom*, 19 R. P. C. 187, C. A.; *Neilson's Patent* (1841), W. P. C. 273; *Badische, etc. v. Levinstein, supra.*

(l) See *Nobel v. Anderson*, 11 R. P. C., at p. 524, C. A.; *Newellite v. Lawson*, 24 R. P. C. 311, C. A.

of equivalence, it must always be remembered that a patent is for a new manufacture, and that the mere adoption of a new principle or idea does not constitute infringement unless the defendant has taken the patented way of carrying it out (*m*).

(*m*) "Although a man has obtained a patent for a given object, there are many modes still open for other men of ingenuity to obtain a patent for the same object; there may be many roads leading to one place." TINDAL, C.J., in *Walton v. Potter* (1841), W. P. C., at p. 590.

See also *Moore v. Thomson*, 7 R. P. C., per HERSCHELL, L.C., at p. 332, and *Saxby v. Clunes* (1877), 43 L. J. (EX.) 228, H. L.

*Illustrative cases* :—

Where a patentee claimed a meter for measuring current in which the current to be measured energised both magnets and armature, it was held that a meter in which this current only flowed through one of these, while the other was in circuit across the mains (which gave a practically constant current) was no infringement. *Chamberlain v. Bradford Corporation*, 20 R. P. C. 673, H. L. See also *Ferranti v. Thomson-Houston*, 20 R. P. C. 145, C. A.

Patent for a machine for testing wire by means of two drums differentially driven. *Held*, not infringed by a machine having two independent drums, one of which had a brake, the difference in pace of revolution being the effect, not the cause, of the stretching of the wire. *Johnson v. Rylands* (1873), Griff. 138. See also *Brown v. Jackson*, 12 R. P. C. 311, P. C.

Patent for improvements in apparatus for hardening and tempering steel wire. The claim was for the use of a chamber for cooling the wire, "the said chamber being supplied with a gas or mixture of gases free or nearly free from oxygen." *Held*, not infringed where there was no supply of inert gas from outside, but the effect was produced by preventing the access of fresh air, so that that in the chamber became deoxygenated. *Ashworth v. English Card Clothing Coy.*, 20 R. P. C. 790, H. L.

Where a patentee claimed a method of regulating the speed of a motor by causing the discharge valves to close and retain the products of combustion, and thus prevent the inlet valves from opening, it was held that regulating by direct actuation of

the inlet valves was not an infringement. *British Motor Syndicate v. Universal Motor Coy.*, 16 R. P. C. 113.

A patent for improved rivets for bicycle chains having the middle part case-hardened and small ends soft, described treating the surface of a bar with carbon, etc., so as to turn it into steel capable of case-hardening, cutting away the ends while the surface was still soft, which could be done with tools, heating, etc., and cooling quickly when the untouched surface hardened, but the small parts did not. The defendant hardened the whole and cut away the ends, having to use emery wheels. *Held*, no infringement. *Appleby v. Albert Eady Chain Coy.*, 16 R. P. C. 318.

A patent for grinding steel balls in grooves between revolving plates described a method of equalising by making the balls change from the outer to the inner grooves. For this purpose there was a segmental pocket joining all the grooves and at a certain point the balls fell into this and were distributed haphazard into the grooves. The defendants had at intervals passages leading from groove to groove so that each ball followed a fixed course. *Held*, no infringement. *Hoffman Manufacturing Coy. v. Auto-Machinery Coy.*, 28 R. P. C. 141.

For further cases illustrating this principle, see *Dudgeon v. Thomson* (1877), 3 A. C. 34; *British Motor Coy. v. Andrews*, 18 R. P. C. 85; *Brown v. Hastie*, 23 R. P. C. 361, H. L.; *Pneumatic Tyre Coy. v. Tubeless Tyre Coy.*, 15 R. P. C., at p. 78; 16 R. P. C. 77, 80, H. L.; *Pilkington v. Massey*, 21 R. P. C. 697, C. A.; *Saxby v. Clunes* (1877), 43 L. J. (EX.) 228, H. L.; *Lawrence v. Perry*, 2 R. P. C. 179; *Heyes v. Hallmark*, 9 R. P. C. 25; *Miller v. Clyde Bridge Coy.*, 9 R. P. C. 470, H. L.; *Parkinson v. Simon*, 11 R. P. C. 493, 506, C. A.; *Kopp v. Rosenwald*, 19 R. P. C. 211; *Crocker v. Aerators*, 20 R. P. C. 621; *Morrison v. Asplen*, 21 R. P. C. 557; *Ackroyd v. Thomas*, 21 R. P. C. 737, C. A.; *Bailey v. Airey*, 23 R. P. C. 277, C. A.; *Von der Linde v. Brummerstaedt*, 26 R. P. C. 289; *Spennymoor*

But where the novelty really lies in carrying out a new idea by a part having a certain function the Courts sometimes give what is in effect a functional interpretation to the claim, *i.e.* regard other devices having the same function as equivalents (*n*).

*Foundry Coy. v. Catherall*, 26 R. P. C. 826; *Stone & Coy. v. Broadfoot*, 27 R. P. C. 701, H. L.; *Riley v. Taylor*, 27 R. P. C. 747, C. A.; *Collins v. Green*, 29 R. P. C. 551, C. A.; *Knight v. Argylls, Ltd.*, 29 R. P. C. 593, 608.

(*n*) *Illustrative cases* :

The following cases illustrate how far the Courts are willing to go in their interpretation of claims as functional.

The specification of a patent for an automatic weighing machine, which commenced with a statement that the invention lay in constructing a new kind of weighing machine in such manner that the act of placing the coin or the like in the apparatus would cause the weight of the body being weighed to be indicated on the dial or the like, proceeded to describe a machine in which, when a person stood on the platform, the weighing took place and an internal pointer moved round to the proper weight, but the external pointer was not moved owing to a break between the two spindles, which break was bridged by the insertion of the coin. The first claim was "the manufacture of a new kind of weighing machine as herein described in which, on a coin or the like being placed in the apparatus, the weight of the person or body being weighed would be indicated on a dial or the like substantially as hereinbefore described." It was held in a number of cases that the patent did not cover any kind of automatic weighing machine worked by the insertion of a coin, but only one in which the weighing took place in the ordinary way and the insertion of the coin served to indicate the result of such weight externally. Thus a machine in which the whole weighing machinery was locked until a coin was inserted when it was set in motion by turning a handle (*Knights' Case*) and a machine in which the weighing machinery was set in motion by pushing a button (*Combined Weighing Machine Coy. Case*) were held not to infringe. But if the coin fulfilled the functions set out above the Courts practically held that it did not matter

what was the device actuated by it. Thus where a coin moved a shutter from an opening so that the internal dial could be seen (*International Hygienic Society Case*), where the coin closed an electrical contact and set the external indicator in action (*National Exhibition Association Case*), and where the coin allowed an externally turned handle to release the indicating mechanism (*Fearby's Case*) it was held that the patent was infringed. *Automatic Weighing Machine Coy. v. Knight*, 6 R. P. C. 297, C. A.; *Automatic Weighing Machine Coy. v. Combined Weighing Machine Coy.*, 6 R. P. C. 367, C. A.; *Automatic Weighing Machine Coy. v. International Hygienic*, 6 R. P. C. 475; *Automatic Weighing Machine Coy. v. National Exhibition*, 9 R. P. C. 41, C. A.; *Automatic Weighing Machine Coy. v. Fearby*, 10 R. P. C. 442. See also *Ticket Punch Coy. v. Colley*, 12 R. P. C. 171, C. A.

Where a patentee had claimed the combination in a telephone of a diaphragm and electric tension regulators, it was held that a diaphragm included anything dividing the air on one side from the air on the other so as to allow differences of pressure to be indicated. *United Telephone Coy. v. Bassano*, 3 R. P. C. 295; *United Telephone Coy. v. St. George*, 3 R. P. C. 321; *United Telephone Coy. v. Harrison* (1883), 21 Ch. D. 721.

Where a patentee had described and claimed an automatic milking machine in which the vacuum was controlled by the height of the column of milk between two reservoirs, it was held that the use of a safety valve instead of this method was an infringement. *Murchland v. Nicholson*, 10 R. P. C. 417, I. H. See also, *Moore v. Thomson*, 7 R. P. C. 325, H. L.

Where a patentee claimed "a rubber or an elastic tyre having the form of a saddle or arched in section lined with canvas in combination with two wires or sufficiently inelastic cords for securing the same to the rims or tyres substantially as herein described," it was held in a number of cases in which wires were



In such a case by appropriate wording all practical means of achieving the object may be covered (o).

Apart from the cases of this class equivalence of result, although of course important evidence on the question as to whether the apparatus or the process used is equivalent to that claimed (p), is not decisive as to infringement, since the real question is, would the devices adopted by the defendant have been seen *à priori* to be equivalent (q).

used which were not endless, but which were so fixed to the tyre, or made to overlap or the ends twisted, so that they were in practice inextensible, were infringements. *Pneumatic Tyre Coy. v. East London Rubber Coy.*, 14 R. P. C. 573, C. A.; *Pneumatic Tyre Coy. v. West London Rubber Coy.*, 15 R. P. C. 129; *Dunlop Pneumatic Tyre Coy. v. United Rubber Works*, 19 R. P. C. 406; *Dunlop Pneumatic Tyre Coy. v. New Lamb Tyre Coy.*, 20 R. P. C. 303, I. H.; *Dunlop Pneumatic Tyre Coy. v. Clifton Rubber Coy.*, 20 R. P. C. 393, C. A.; *Dunlop Pneumatic Tyre Coy. v. Ostrich Tyre Coy.*, 19 R. P. C. 365; *Dunlop Pneumatic Tyre Coy. v. Hyde Rubber Coy.*, 21 R. P. C. 208; but see *Pneumatic Tyre Coy. v. New Ixion Tyre Coy.*, 15 R. P. C. 389; *Dunlop Pneumatic Tyre Coy. v. Wapshare Tyre Coy.*, 17 R. P. C. 433, for cases where it was held that devices used were not equivalents.

Claim for a cream separator having a series of conical plates clamped together for dividing milk into layers. Defendant used solid cylinder with passages bored through which spread the milk out in a similar way. Held, infringement. *Aktiebolaget Separator v. Dairy Outfit Coy.*, 15 R. P. C. 527, C. A.

There is no point of patent law more overclouded by the wealth of judicial utterances than the rule that "you cannot patent a principle." Although the dictum of ALDERSON, B., in *Jupe v. Pratt* (1837), W. P. C., at p. 146, to the effect that if you discover a new principle and show one way of carrying it out, you are entitled to protect yourself against all other ways, has been disapproved, see *Nobel v. Anderson*, 11 R. P. C. 519, C. A.; there is considerable truth in it if the claim for the desired monopoly is appropriately framed. Perhaps the true law is best expressed

by COTTON, L.J., in *Automatic Weighing Machine Coy. v. Knight*, 6 R. P. C. at p. 304.

"Where there is a principle first applied in a machine capable of carrying it into effect, the Court looks more narrowly at those who carry out the same principle in other ways." The question is one really of degree more than principle, and there seems no logical distinction between allowing a functional interpretation to a claim for a single integer, and allowing it for an integer forming part of a combination as was done in the *Automatic Weighing Machine Cases*. See also *Jones v. Pearce* (1832), W. P. C. 122; *Neilson v. Harford* (1841), W. P. C. 273; *Edison v. Smith*, 11 R. P. C. at p. 163; *Edison v. Woodhouse*, R. P. C. 79.

(o) *E.g.* In the case of *Jupe v. Pratt*, *ubi supra*, it is difficult to see what possible objection there could have been, either as to validity or scope to a claim such as "a table constructed in sections formed to slide to and from a centre," provided that this was new.

(p) *Wenham v. May*, 4 R. P. C. 303; *Young and Beilby v. Hermand Oil Coy.*, 9 R. P. C. 373, H. L.; *Leeds Forge v. Deighton*, 21 R. P. C. 487, 496, H. L.; *Osrarn Lamp Works v. Z Electric Lamp Coy.*, 29 R. P. C. 425, 426.

(q) For cases where identity of result has been held insufficient, see *Seed v. Higgins* (1860), 8 H. L. C. 551; *British Motor Syndicate v. Universal Motor Coy.*, 16 R. P. C. 134; *British Motor Syndicate v. Andrews*, 18 R. P. C. 85, H. L.; *Brown v. Jackson*, 12 R. P. C. 311, P.C.; *Plating Coy. v. Farquharson* (1883), Griff. 187, H. L.; *Scott v. Hamling*, 14 R. P. C. 123; *Varey v. Walker*, 16 R. P. C. 596; *Musgrave v. Hicks*, 3 R. P. C. 49; *Wallace v. Jack*, 22 R. P. C., at p. 591.

Bearing of  
specification  
on equiva-  
lence.

The principle, referred to in the chapter on construction; that a claim is primarily regarded as a disclaimer cutting down rather than extending the invention described (*r*), has an important bearing on the question of equivalents, and if a clear idea of the patentee's real invention can be gathered from the description it usually gives a good test of the bounds within which equivalents of the integers specifically mentioned in the claims may lie.

Of course, if it is mentioned that equivalents may be used for a certain part the Court gives effect to this (*s*). In some cases also a patentee names a number of bodies in his specification as having similar properties to the particular one claimed, or makes like statements as to apparatus or processes, and here in general the inference is that these are to be regarded as equivalents (*t*). So, too, where a patentee clearly points out the evil he desires to overcome, or the result he seeks to obtain, or the advantages of his particular device, he greatly strengthens the argument that similarity in these respects should be regarded as evidence of equivalence (*u*).

(*r*) See p. 116 *n.* (*o*).

(*s*) The dictum of WOOD, V.-C., in *Curtis v. Platt* (1865), 35 L. J. (CH.) 852, that the insertion of "mechanical equivalents" in a claim makes no difference, is not sound. Of course, the Courts often hold that mechanical equivalents come within a claim even if the words are not there, but the addition of these words to particular integers would make it clear that the combination might be infringed where these particular integers are replaced by others. Probably, too, if a patentee points out a number of parts in which variations may be made, the Court would be likely to infer that the other parts were essentials not to be departed from.

(*t*) *Illustrative case* :—Where a specification for a method of fixing glass bricks to walls by attaching to their back "sand or granular material as crushed or broken glass," but in the claims only broken glass was mentioned, it was held that the use of other granular materials was within the claim. *National Opalite Coy. v. Grand Hotel Coy.*, 18 R. P. C. 249.

The mere mention, however, of alternative methods in the body of the specification does not bring them within the claim unless they can be

brought within the class of equivalents.

*Illustrative case* :—A patentee described a starting device in which a gaseous mixture flowed out of the cylinder and when the proper richness was arrived at, which was indicated by the sound, the rate of flow could be checked by a tap, so that the flame struck back and caused an explosion, which put the starting device out of action. The specification then stated that "the relative area of the nozzles may be such that the flame, instead of being caused to strike back by reduction of the rate of flow, strikes back on the mixture becoming sufficiently rich," and then described the appropriate arrangements for this variation. The claims spoke of "causing" the rate of outflow to be diminished. It was held that a device in which the flame struck back merely owing to the increase in richness of the mixture was not an infringement, since there was no causing of diminution of the rate of flow. *British Motor Syndicate v. Andrews*, 18 R. P. C. 85, H. L. See also *Monnet v. Beck*, 14 R. P. C., at p. 846.

(*u*) *Thomson v. Moore*, 7 R. P. C. 325, H. L.; *Clay v. Allcock*, 23 R. P. C. 745, C. A.; *Foden v. Wallis*, 25 R. P. C. 783, C. A.; *Wenham v. May*, 4 R. P. C. 303; *Jackson v. Wolstenholme*,

On the other hand, the Courts are unwilling to hold a device equivalent because it takes some features or produces some effect produced by the patented device, but which is not mentioned in the specification, or only incidentally mentioned there, or only to be gathered from reference to the drawings (*x*).

The converse rule is widely applied. Thus, where the patent claims (either expressly or impliedly) the use of a material, process, or apparatus, so as to produce a particular effect, there is no infringement if the method of use by the defendant is such as not to produce this effect (*y*). So if the primary object

1 R. P. C. 105, 109, C. A. ; *Evans v. Hoskins*, 24 R. P. C. 517, C. A. ; *Sandow v. Szalay*, 23 R. P. C. 6, H. L.

(*x*) *Illustrative case* :— In the case of a patent for a method of forming phonographic records, the plaintiffs contended that the essential feature of their invention was the method of allowing the air to escape between the record and the matrix. No mention of this was made in the specification, but something was shown in the drawing which might have had this result. *Held*, no infringement. *Lambert v. International Phonograph Coy.*, 21 R. P. C. 247, C. A. See also *Clay v. Allcock*, *supra* ; *Stewart v. Bell's Trustees* (1883), 4 S. XI. 236 ; *Fairburn v. Household*, 3 R. P. C. 263, C. A.

(*y*) *Illustrative cases* :—

Where in a patent for producing phonograph records the claim was for forcing a blank against a matrix by means of a heating fluid such as steam, and then continuing the pressure with a cooling fluid, such as air, so as to harden the wax, and the defendants, after applying pressure by means of steam, continued the pressure by means of air, which was not allowed to escape but remained unchanged for half an hour, and so did not act as a cooling fluid, the cooling being effected by means of water. *Held*, no infringement. *Lambert v. International Phonograph Coy.*, 21 R. P. C. 247, C. A.

So where a patent claimed making the handles of bicycles of sheet felt by grooving the felt so as to make it flexible, it was held that grooving the felt after the handles were made was no infringement. *Cooper v. Baedeker*, 17 R. P. C. 209, C. A.

Where a patentee claimed the use in an inverted gas-burner of two

concentric tubes joined at the top so that they were filled with rarified air which acted as a non-conductor, and the defendants employed similar tubes, but open at the top so that the air escaped and the non-conducting effect was not produced, it was held no infringement. *New Inverted Coy. v. Cope*, 23 R. P. C. 103.

Where a patentee claimed "the combination of a grooved rim or metal tyre and an arched tyre of indiarubber or other flexible material held in the groove by the pressure of an inflated tube within the arch which forces its edges against the side of the groove substantially as described," and laid special stress in his patent on the fact that the inner tube and outer tube could be renewed independently, it was held that a device in which there was no separate inner tube, but merely two flaps on the cover, which could be placed over each other and had soft soap put between them so that when in position they would hold the air, was not an infringement. *Pneumatic Tyre Coy. v. Tubeless Pneumatic Tyre Coy.*, 16 R. P. C. 77, H. L.

Where a patentee claimed a connecting piece between a horn and a sound box having, *inter alia*, the feature that it was tapered, and this was said to allow the sound to expand naturally, it was held that a similar part made with two cylindrical portions and a step was no infringement. *Gramophone Coy., Ltd. v. Ruhl*, 28 R. P. C. 20, C. A. ; <sup>v</sup> cf. *Gramophone Coy., Ltd. v. Ullman*, 23 R. P. C. 752, C. A.

Where a patentee commenced his specification by saying that in fabrics having intersecting threads in contact there was a danger of these sawing if the fabric was folded, etc., and then

of a patented apparatus is its use for a particular purpose the fact that the defendant's apparatus would be useless for that purpose tells strongly against infringement (z). Again, if a substance mentioned in the specification is defined as having certain properties and as used for this reason, the use of a body not having these properties would not in general be an infringement (a). So, too, the Courts have held that certain apparatus etc., were not equivalents on the grounds that the specification pointed away from them (b).

Infringement found more easily if substituted device no improvement.

The Courts hold that a device is an equivalent more easily if the substituted device is more expensive or less convenient than that claimed, than if the change is a real improve-

described a fabric made by embedding a series of parallel threads in a sheet of rubber, and joining two such sheets so that the threads were at right angles, it was held that where two series of parallel threads were placed at right angles and a film of rubber used merely to hold them together, the film being too thin to prevent sawing, there was no infringement. *Palmer Tyre Coy. v. Pneumatic Tyre Coy.*, 16 R. P. C. 451.

See also *Jackson v. Wolstenholme*, 1 R. P. C. 105; *Preston Davies v. Black*, 11 R. P. C. 574, I. H.; *Pennycooke v. Mackenzie* (1881), 4 S. IX. 414, I. H.; *Richardson v. Castry*, 4 R. P. C. 265; *Tucker v. Kay*, 8 R. P. C. 233, C. A.; *Tweeddale v. Ashworth*, 9 R. P. C. 121, H. L.; *Brooks v. Steel and Curry*, 14 R. P. C. 46; *Automatic Diversions Syndicate v. Urry*, 14 R. P. C. 365; *Sideley v. London Hygienic*, 14 R. P. C. 514; *Dunlop Pneumatic Tyre Co. v. New Ixion Coy.*, 16 R. P. C. 16, C. A.; *Appleby v. Albert Eady Chain Coy.*, 16 R. P. C. 318; *Palmer Tyre Coy. v. Pneumatic Tyre Coy.*, 16 R. P. C., at p. 485; *Tweeddale v. Ashworth* (second action), 17 R. P. C. 620, H. L.; *Schermuly v. Pain*, 18 R. P. C. 529; *Gillette Safety Razor Coy. v. Anglo-American Trading Coy.*, 29 R. P. C. 577, C. A.

(z) *Needham v. Johnson*, 1 R. P. C. 49.

So, too, if it does not possess an advantage on which stress is laid in the patent. *Martin v. Consell Iron Works*, 25 R. P. C. 27, 34, C. A.; cf. also *Appleby v. Eady Chain Coy.*, 16 R. P. C. 318 and p. 135, note (m).

(a) *Illustrative cases* :—

Where a patentee claimed making a backing for glass slabs by putting on pitch, etc., and clinker, etc., as an absorbent, and the defendants used broken pottery which, though it might be absorbent of water and other thin liquids, was not substantially absorbent of pitch, it was held no infringement. *Newellite v. Lawson*, 24 R. P. C. 305, C. A.

In the case of a patent for an electric battery in which the outer layer was to be made of plastic substance, it was held that a battery having the outer layer made of blotting-paper did not come within this claim, although blotting-paper might for some purposes be termed plastic, because the patent contemplated something which could be poured in, and all the examples were of plastic substances of this nature. *Patent Exploitation Ltd. v. American Electrical Novelty Coy.*, 22 R. P. C. 316, C. A.

Where a patent described and claimed a process for dipping incandescent gas-mantles after ignition into a substance that would set hard and protect the mantles from breakage, and said that high boiling-point paraffins were preferred, but that other substances that set hard at ordinary temperatures might be used, the patent was construed as confined to the use of substances that set by cooling, and as not covering the use of substances, such as collodion, that set by evaporation. *Sunlight Incandescent Coy. v. Incandescent Lighting Coy.*, 14 R. P. C. 757.

(b) Cf. *Morris v. Young*, 12 R. P. C. per Lord HERSCHELL, at p. 461, H. L., and *Nobel v. Anderson*, 12 R. P. C. 164, H. L.

ment (c). This follows from the fact that the patentee naturally gives, and in fact is bound to give, the best form of which he knows, and usually troubles little about inferior forms (d), while the craftsman seeing the cheapest or best form mentioned may easily think of using less convenient forms, but if an inferior form is named he will be apt to think that there is some special reason for choosing it, and that the better forms are purposely excluded (e). Another reason is that where a form which is worse is taken the Court is more apt to think that the change is only colourable and is an attempt to avoid infringement (f).

So where plaintiff's invention is of little or no utility the Courts lean against finding that a useful invention is equivalent to it (g).

(c) *Illustrative cases* :—

Where a patentee had taken a patent for the addition of carburet of manganese to steel in the process of casting, carburet of manganese being an expensive substance costing seven shillings a pound, and the defendants had found that common coal-tar and oxide of manganese, which did not cost one-hundredth part of the price of carburet of manganese, would do, and that the oxide of manganese did not attack the furnace sides as had been previously supposed, this was held not to be within the patent, the Lord Chancellor pointing out that if these simple and cheap substances were within the plaintiff's invention he ought to have named them, and not the more expensive. *Unwin v. Heath* (1855), 5 H. L. C. 505. Cf. also *Plating Coy. v. Farquharson* (1883), Griff. 107, C. A. and H. L.

Where a patent for producing a silky lustre on cotton goods spoke of forming a roller with irregular surfaces, lying at different angles to each other and arranged so as to form "a sort of parallel grooves," it was held that a roller with ordinary parallel grooves did not infringe, the specification rather leading away from this than to it. *Bradford Dyers v. Bury*, 18 R. P. C. 161; 19 R. P. C. 1, C. A.; *Bradford Dyers v. Williams*, 19 R. P. C. 125.

And compare with these cases the following:—

A patentee had claimed a process for distilling shale at two temperatures, the lower being more favourable for obtaining oil and the higher for getting off ammonia, and had described a

process by which the shale was fed into and withdrawn from a vertical retort in small quantities, and proposed to make the lower half of the retort of firebrick and the upper of iron, and only to heat directly the lower part, the upper portion being heated, but to a less degree, by conduction. The defendants made the whole of firebrick and led the hot gases round the whole, but of course these gases got cooler as they rose. The House of Lords held that although this arrangement did not get as sharp a variation of temperatures as the patentee's it was nevertheless within the patent. *Young and Beilby v. Hermand Oil Coy.*, 9 R. P. C. 373, H. L.

See also *Bunge v. Higginbottom*, 19 R. P. C., at p. 196, C. A.; *British Vacuum Cleaner Coy. v. Suctions, Ltd.* 21 R. P. C. 303, 312.

(d) *Unwin v. Heath, supra.*

(e) *Bradford Dyers v. Bury, supra*; *Bradford Dyers v. Williams, supra.*

(f) *Stevens v. Keating* (1847), 2 W. P. C. 175, 185; *Bunge v. Higginbottom, supra*; *Heine v. Coninco*, 21 R. P. C. 202, 207.

(g) *Illustrative case*: In the case of a patent for inter-locking mechanism for signals the patentee claimed that by his method the signals and points could never be antagonistic. This was found not to be true of the plaintiff's system, but it was true of the defendant's. It was held that this showed that the systems were not equivalents. *Easterbrook v. G. W. Ry. Coy.*, 2 R. P. C. 201. See also *Winby v. Manchester Steam Tramways*, 8 R. P. C. 61.

Combina-  
tions.

The rule referred to elsewhere that a claim for a combination only protects that combination as a whole (*h*), makes it necessary to consider in each case whether there is an equivalent for each integer of the combination claimed. Of course it is not always necessary that there should be a separate part corresponding to each separate integer, one part of the infringing machine may be an equivalent for several integers in the combination claimed or *vice versa* (*i*).

In the case of patents for combinations of old parts where neither the result nor the means are new in themselves and the invention is of the nature of selection, the doctrine of mechanical equivalents, though still applicable (*k*), is applied with much less freedom than where a new machine or process is claimed (*l*). The invention being one of selection, it is necessary to show that the infringer has adopted the same selection, and this can usually only be done where the variation is in minor parts.

Besides combinations of old elements there are many claims for a number of integers some of which are in themselves new. To establish infringement in such cases it must in general be shown that not only is the new integer (which a craftsman would necessarily consider to be an essential part of the invention) taken, but that it is taken in a combination which is in substance identical with the one claimed (*m*).

(*h*) See p. 120.

(*i*) Nor is it necessary for infringement of a combination that all the parts should be integral parts of one machine, if in fact they are used together. *Shoe Machinery v. Cutlan*, 12 R. P. C. 356.

(*k*) *Bunge v. Higginbottom*, 19 R. P. C., at p. 196, C. A. As to infringements of combination claims generally, see *Proctor v. Bennis*, 4 R. P. C. 333; *Lynch v. Phillips*, 25 R. P. C. 708; 26 R. P. C. 401, I. H.

(*l*) *Young v. Morris and Bastaert*, 12 R. P. C., at p. 459, 462, H. L.; *Tucker v. Kaye*, 8 R. P. C. 230, C. A.; *Wallace v. Jack*, 22 R. P. C. 581; *Lynch v. Phillips, supra*; *Bovill v. Pimm* (1856), 11 Ex. 718, 739; *Beston v. Watts*, 25 R. P. C. 26, C. A.

There are dicta to the effect that the doctrine does not apply at all in the case of combinations of old parts. See *Brown v. Jackson*, 12 R. P. C., at p. 324, P. C.; *Brooks v. Lamplugh*, 16 R. P. C., at p. 48; *Tweedale v. Ashworth*, 9 R. P. C. 521,

528, H. L.; *Tweedale v. Ashworth*, 17 R. P. C. 620, 625, H. L.; *Miller v. Clyde Bridge Coy.*, 9 R. P. C. 478 H. L. But undoubtedly the Courts do apply the doctrine to some extent; cf. *Harrison v. Nicholson*, 25 R. P. C. 405, C. A.

It has been suggested that in such cases the use of a mechanical equivalent would not be an infringement, but a colourable imitation would be, e.g. in *Lake and Elliott v. Rotax Motor Accessories Coy.*, 28 R. P. C. 532, 540, C. A. The distinction would seem merely verbal, except in so far as it points to the closeness of the imitation. As to meaning of "colourable imitation," see *Dudgeon v. Thomson* (1877), 3 A. C., per Lord CAIRNS, at p. 43.

(*m*) *Illustrative cases* :—

§ In the case of a patent for hardening and tempering wire by passing it through an open flame into a special oil-bath, it was held that the use of a tube on which a flame played together with this oil-bath was no

Although in general all the steps of a process or parts of a combination have to be taken to constitute infringement, there are certain cases where it would be clear to any competent reader that a special part or step, although it is incorporated in the claim directly or by reference, is only used for greater convenience or perfection, and is not essential (*n*). In such case infringement is sometimes found where such part or step is omitted, or a very wide interpretation is given to equivalence if a substitute is used (*o*). Such an interpretation, however,

infringement. *Ashworth v. Roberts*, 9 R. P. C. 309, C. A.

Where a patentee described a special adjustable frame, and showed its use in a reversible chair, and his claim was for a reversible chair, it was held that the use of the special frame apart from such chair was no infringement. *Davis v. Townsend*, 16 R. P. C. 497. See also *Harrison v. Anderston Foundry Coy.* (1876), 1 A. C., at p. 578, H. L.; *Dudgeon v. Thomson* (1877), 3 A. C. 34, H. L.; *Tucker v. Kay*, 8 R. P. C. 230, C. A.; *Welsbach Incandescent Coy. v. Daylight Coy.*, 17 R. P. C. 146, C. A.; *Osmond v. Balmoral Cycle Coy.*, 15 R. P. C. 505, C. A.; *Garrard v. Edge*, 6 R. P. C. 563, C. A.; *Hardmuth v. Baker*, 22 R. P. C., at p. 75, C. A.; *Nordenfeldt v. Gardner*, 1 R. P. C., at p. 65, C. A.

(*n*) It is to this class of case that the remarks of Lord CAIRNS in *Clark v. Adie* (1877), 2 A. C. 320, apply. See also *Proctor v. Bennis*, 4 R. P. C. 333, 354, C. A.

(*o*) *Illustrative cases* :—

Where in a patent for a new process of getting an ointment from wool fat the patentee had claimed a method which included putting a mixture into a centrifugal machine in order to separate two bodies of different specific gravities, it was held to be infringed by defendants who, instead of using a centrifugal machine, put the mixture into a settling pan, the centrifugal process merely being the best and quickest method of effecting the separation. *Benno-Jaffe, &c. v. Richardson*, 11 R. P. C. 261, C. A.

In a patent for making gas-mantles by impregnating a cotton fabric with the rare earths the plaintiff had described a process in which at one point the mantle was impregnated

with ammonia. This admittedly could not affect the final result after burning, and its omission was treated as not affecting infringement. *Incandescent Lighting Coy. v. De Mare Incandescent System*, 13 R. P. C. 559, C. A.

In the same case the Court apparently held that where a patentee claimed a new mantle made of zirconium and lanthanum the use in a mantle of zirconium without lanthanum was an infringement. In a subsequent case the Court of Appeal disapproved of this reasoning, and explained the former decision by saying that the Court had found that erbium, which had been used with the zirconium, was an equivalent for lanthanum. See *Welsbach Incandescent Coy. v. Daylight Coy.*, 17 R. P. C. 141, C. A.

In the case of a machine for sewing bindings on hats, the claim included as part of the combination a guiding loop for the tape. This was found not to be necessary in practice, and it was held that its omission did not prevent infringement. *Gammons v. Battersby*, 21 R. P. C. 322, 332, C. A.

See also *Wright v. Hitchcock* (1870), 39 L. J. (EX.) 97; *Clippens v. Henderson* (1882), 4 S. IX. 238, affirmed in H. L. (1883), 8 A. C. 813; *Automatic Air Tight Cover Coy. v. Stockford*, 19 R. P. C. 453; *Gwynne v. Drysdale*, 3 R. P. C. 65, 67, I. H., approved in *Consolidated Car Heating Coy. v. Came*, 20 R. P. C. 745, P. C.; *Osram Lamp Works v. Z. Electric Lamp Coy.*, 29 R. P. C. 425, 426.

Of course such decisions were frequent under the older system of construction. See p. 120 *n.* (*i*).

For a case where this was applied against the patentee, see *Farbenfabriken, &c. v. Chemische Fabrik, &c.*, 22 R. P. C. 501.

is only given, in the case of an omitted part at any rate, when such part can be looked on so to speak as a luxury; where a substantial part of the commercial utility of the patented process or combination depends on such part it is regarded as an essential part whose omission negatives infringement (*p*).

Part not  
claimed as  
new.

A broader extension is given to equivalents in the case of a part which is not suggested to be new or used in any new way, but is mentioned in the claim rather for the purpose of completing an apparatus or combination than as in itself showing anything new (*q*). So that even if an entirely new substitute is discovered for such part of the apparatus or combination claimed there may still be infringement if the other elements are taken (*r*).

Equivalents  
used for  
certain novel  
parts.

If the patented machine as claimed differs from one previously known in two or more respects, it is generally difficult to allege that a machine in which only one part of the novelty is adopted is an infringement, since if the doctrine of mechanical equivalents is invoked by the plaintiff to make the old the equivalent of the new in regard to part A, it will probably be also invoked by the defendant with regard to part B (*s*).

(*p*) *Illustrative case*: In the case of a being patent which was interpreted as for a coupling for steam-pipes in the lower part of which was a hinge, it was proved that the coupling would work without the hinge except in one or two per cent. of cases, but that the commercial user was rendered more certain by the use of such hinge. It was held that the hinge was a material part of the combination and that a coupling made without it was not an infringement. *Consolidated Car Heating Coy. v. Came*, 20 R. P. C. 745, P. C.

See also *Nettlefolds v. Reynolds*, 9 R. P. C. 270, C. A.; *Jackson v. Wolstenholme*, 1 R. P. C. 105, C. A., and p. 120, *n. (l)*, and cases at p. 152, *n. (d)*.

(*q*) *Electric Telegraph Coy. v. Brett and n. (r)*, *infra* (1851), 20 L. J. (C. P.), at p. 130; *Bovill v. Crate* (1867), Griff. N. C. 46; *North British Rubber Coy. v. Gormully and Jeffreys*, 15 R. P. C. 245, 254, H. L.; *Lane Fox v. Kensington Electric Lighting Coy.*, 9 R. P. C. 241, 242.

See also cases at p. 150, *n. (u)*.

(*r*) *Illustrative case*: A patentee showed a system by which a telegraphic signal was recorded at intermediate as well as terminal stations the title being "improvements in giving signals . . . by means of

electric currents transmitted through metallic circuits." At the date of the grant the only system known was a complete metallic circuit, but later the "earth return" was discovered. It was held that the application of the patented improvements on a system having an earth return constituted infringement. The rule was laid down that "a claim for improvements in the mode of doing something by a known process is sufficient to entitle the claimant to a patent for his improvements when applied either to the process known at the time of the claim or to the same process altered and improved by discoveries not known at the time of the claim so long as it remains identical with regard to the improvements claimed and their application." *Electric Telegraph Coy. v. Brett* (1851), 20 L. J. (C. P.) 130. See *contra*, *Barber v. Grace* (1848), 17 L. J. (EX.) 122; and *Plating Coy. v. Farquharson* (1883), Griff. 187, *per* JESSEL, M.R.

(*s*) *Illustrative case*: A patentee had described working the auxiliary piston of a lift by introducing water at high pressure into a cylinder surrounding the trunk of the piston



In the case of chemical patents the Courts at one time seemed to take the view that the doctrine of equivalents did not apply (t). Latterly this view has been questioned (u), and there is very little doubt that it no longer holds. This does not imply any change in the principles on which the Courts act, but merely that they recognise the changed state of facts, viz. that the progress of chemistry has carried the knowledge and classification of the behaviour of different bodies to a point where the doctrine of equivalents is in many cases applicable (x). Whether it would be so in any particular case would be a question of fact (y).

so as to act as a constant counter-balance to the weight of the lift, and letting the working water act on the end of the trunk which was in a second smaller cylinder. B. had previously suggested the use of an auxiliary cylinder, but had had a gravity counterpoise, and his working water acted on the end of the auxiliary piston. The defendants let their water into a cylinder surrounding the trunk of the piston, but this was the working water, and they had a gravity counter-weight. The plaintiffs contended that a gravity counter-weight and a water pressure counter-weight were equivalents, but it was pointed out that in that case their machine was not distinguishable from what had gone before, and the Court held that there was no infringement. *Ellington v. Clark*, 5 R. P. C. 319, C. A. See *Curtis v. Platt* (1865), 35 L. J. (CH.) 852, and cases at p. 133 n. (c); *Holmes v. L. & N. W. Ry. Coy.* (1852), 22 L. J. (C. P.) at p. 61; *Tucker v. Kaye*, 8 R. P. C. 230, 234, C. A.; *Fairburn v. Household*, 3 R. P. C., at p. 267, C. A.; *Hardmuth v. Baker*, 22 R. P. C. 66, C. A.; *Miller v. Clyde Bridge Coy.*, 9 R. P. C. 478, H. L.

Of course this rule must be modified where the specification points out one particular part as the essence of the invention.

(t) *Stevens v. Keating* (1847), 2 W. P. C., at p. 188; *Heath v. Unwin* (1855), 5 H. L. C. 505; *Lancashire Explosives Coy. v. Roburite Explosives Coy.*, 13 R. P. C., at p. 438. See also *Vidal Dye Syndicate v. Levinstein*, 20 R. P. C. 345, C. A.

In *Heath v. Unwin*, *supra*, it was suggested by Lord BROUGHAM that though where the elements were

specified, a compound of them might be an equivalent, the converse would not apply. This was doubtless suggested by the circumstances of the particular case (as to which see p. 141 n. (c)), and the rule cannot be regarded as general, e.g. it would not apply in a case where the compound was the cheapest or most convenient form, if a competent chemist could see that its action depended on the presence of the elements.

(u) *Nobel v. Anderson*, 12 R. P. C. 167, H. L.; *Andrews' Patent*, 24 R. P. C. 366, H. L.

(x) Of course such decision could only apply to the facts of the time and should have as little effect on a Court of to-day as a decision in the eighteenth century that a written warning was insufficient because it was not to be presumed that the ordinary man could read or write. The suggestion that the doctrine of equivalents does not apply to chemistry, or that "there can be no predication in chemistry," is particularly ludicrous in view of the fact that most of the doctrines of the science are founded on the theory of equivalents. Of course there are regions in chemistry where the success of a process would be doubtful, but any competent chemist could write the equations for many thousands of reactions which he has never performed or read of with the greatest confidence in their results.

(y) *Nobel v. Anderson*, 12 R. P. C. 167, H. L.; cf. also *Welsbach Incandescent Coy. v. Daylight Coy.*, 17 R. P. C., at p. 146. For examples of what have been held to be equivalents in chemical patents, see *Badische, &c. v. Levinstein*, 4 R. P. C. 449, H. L.; *Incandescent Lighting Coy. v. De Mare*

There is no class of cases where the thorough education of the Court by means of expert testimony is so necessary as in chemical cases. There are some reactions which are clear and straightforward and with regard to which a chemist would have no hesitation in applying his knowledge as to possible variations. In others, where the chemical nature of the reaction are obscure (*z*), or complicating reactions are probable or possible, or experiment is dangerous (*a*), he will be afraid to vary from the directions given, or uncertain of the result of such variations. Again in some cases a reaction is clearly quantitative and proportions important, while in others a reaction said to give a certain substance may obviously be one giving a mixed result, of which the substance named is only the main ingredient (*b*). Although generally the complete novelty of a discovery is favourable to a broad interpretation on the question of variations and equivalents, it must not be forgotten that such a discovery may lead the chemist into a *terra incognita*, where he will be chary of trusting to knowledge acquired in other fields (*c*).

All these varying considerations have to be taken into account in deciding how far the doctrine of equivalents may be applied, together with the question of whether a chemist would understand the invention to be a broad discovery or the choice of a particularly favourable example or method, and of whether there is anything in the wording or in the nature of the discovery which would indicate that substances, etc., other than those named are excluded (*d*). But the general

*Incandescent System*, 13 R. P. C. 559, C. A. (The reasoning in this case must be applied with care in view of the subsequent case of *Welsbach Incandescent Coy. v. Day-light Coy.*, *supra*.)

(*z*) Cf. *Vidal Dye Syndicate v. Levinstein*, 29 R. P. C. 245, 277, C. A.

(*a*) Cf. *Maxim Nordenfeldt Coy. v. Anderson*, *infra*.

(*b*) *Illustrative case*: A patentee claimed making artificial musk and said that for that purpose he prepared hydrocarbon of the  $C_{11}H_{16}$  group, "and proceeded as follows": and then described a process starting with toluene and (after certain reactions) distilling and taking the portion which came off between  $170^{\circ}C.$  and  $200^{\circ}C.$  It was found that it would be clear to a chemist with the knowledge of the time, from the wideness of the limits and the nature of the reactions,

that the product would not be pure butyl toluene (of the  $C_{11}H_{16}$  group), but a mixture of that and butyl xylene (which latter was not of the  $C_{11}H_{16}$  group). The defendant prepared an artificial musk, starting with xylene and getting again a mixture of butyl toluene and butyl xylene, though in different proportions to that given by the patented process. It was held that he infringed. *Fabriques, &c. v. Lafitte*, 16 R. P. C. 61.

(*c*) See *Maxim Nordenfeldt v. Anderson*, *infra*.

(*d*) *Illustrative case*: Where in a patent for producing gas-mantles from oxides of the rare earths the patentee had indicated lanthanum and zirconium and certain equivalents as the substances to be used, the Court held that the substitution of erbium for lanthanum was an

tendency is to adopt a wide construction on the question of reagents, proportions, temperatures, and details of preparation (*e*), unless apart from these there would be no invention (*f*), but such construction will not be extended so as to make the specification cover a change greater than could have been contemplated with the knowledge of the date of the grant (*g*).

In fact with a really new discovery in chemical matters the Courts take a very broad line of interpretation. There is no science where a statement is more suggestive of alternatives and developments than is the case with chemistry, or where it would be more hopeless to expect the inventor to name all possible means of carrying out his invention, and the recognition of this has led the Courts to consider what process or materials would suggest themselves as applicable to the trained chemist reading

equivalent, but where zirconium was only used for building the skeleton, and the light-giving power was obtained from a coating of oxide of chromium (which was not a rare earth or in any way suggested in the specification), this did not come within the patent. So, too, the use of zirconium and a small quantity of cerium (cerium being indicated in the patent as prejudicial) was not within it. *Incandescent Lighting Coy. v. De Mare Incandescent System*, 13 R. P. C. 559, C. A.; *Incandescent Lighting Coy. v. Sunlight Coy.*, 13 R. P. C. 333; *Welsbach Incandescent Coy. v. Daylight Coy.*, 17 R. P. C. 141, C. A. See also *Nobel v. Anderson*, 12 R. P. C. 164, H. L.; *Unwin v. Heath* (1855), 5 H. L. C. 505.

(*e*) On proportions generally, see *Patent Type Foundry Coy. v. Richards* (1860), 6 Jur. (N. S.) 39. For cases where such variations have been held to be infringements, see *Badische, &c. v. Levinstein*, 4 R. P. C. 449, H. L.; *Leonhardt v. Kalle*, 12 R. P. C. 103 (different reagent and proportions); *Fabriques, &c. v. Lafitte*, 16 R. P. C. 61 (different reagent and proportions); *Fabriques, &c. v. Caspers*, 15 R. P. C. 94 (different reagents) *Thermit, Ltd. v. Weldite, Ltd.*, 24 R. P. C. 441 (variation in reagent); *Saccharin Corporation v. Anglo-Continental Coy.*, 17 R. P. C., at p. 319 (directions as to temperature and time); *Cassel Gold Extraction Coy. v. Cyanide Recovery Coy.*, 11 R. P. C. 638 (addition of electric current); *Mosley v. Victoria Rubber Coy.*, 4

R. P. C. 241 (method of solution and fixing); *Farbenfabriken, &c. v. Chemische, &c.*, 22 R. P. C. 501 (method of purification); *Badische, &c. v. La Société des usines du Rhone*, 14 R. P. C. 875 (temperature); *Gamble v. Kurtz* (1846), 3 C. B. 425 (reagent); see also cases in notes (*f*) (*g*) (*h*) p. 153 but see *contra Lancashire Explosive Coy. v. Roburite Explosive Coy.*, 14 R. P. C. 303, H. L. (dissolving with heat); *Plating Coy. v. Farquharson* (1883), Griff. 187, H. L. (some parts of process omitted).

(*f*) For a case where directions as to strength were read in on this ground, see *Max Muller's Patent*, 24 R. P. C. 465. See also following cases, where detail directions were held essential—*Heidemunn v. Smokeless Powder Coy.*, 15 R. P. C. 305 (completely dissolving); *Davies v. Curtis and Harvey*, 20 R. P. C. 561, C. A. (use of special form of carbon); *Wilson v. Union Oil Mills*, 9 R. P. C. 57 (special reagent).

(*g*) *Illustrative case*: Where a patent claimed an explosive compound, consisting essentially of guncotton mixed with nitroglycerine and with castor oil or other suitable oil for the purpose specified, and gave an example in which the constituents were 2 to 5 per cent. castor oil, 10 to 16 per cent. of nitroglycerine, and the rest guncotton, it was held that a compound consisting of 58 per cent. nitroglycerine, 37 per cent. guncotton, and 5 per cent. vaseline was not an infringement. In the

the specification, or what he would understand to be the result of the reactions set out, rather than to hold the ambit of the invention to be indicated by the particular chemical substances named (*h*), or processes selected. Thus, where reagents are named for effecting well-known purposes, such as oxidation or reduction, the common knowledge of chemists will be freely incorporated so as to make the specification cover other suitable bodies (*i*), and the chemist will be assumed to apply the information at his disposal in deciding which are suitable (*j*).

Common  
equivalents.

One common class of alteration, usually held not to avoid infringement, is where the relative motion of two parts being kept the same, the actual motion is changed (*k*). So a mere change in the direction of motion will generally be held to be an equivalent (*l*). So too such variations as reciprocation for oscillation do not prevent infringement (*m*).

A few further cases of equivalents are collected in the notes (*n*).

state of knowledge at the date of the grant it would not have been known that it was possible so to vary the proportions. *Maxim Nordensfeldt Coy. v. Anderson*, 15 R. P. C. 421, H. L. See also *Vidal Dye Syndicate v. Levinstein*, 29 R. P. C. 274, 275, C. A.

(*h*) "The Court ought to take a broad view, and ought not to hold that ingredients substantially differ because they have different chemical names and only differ in minor and comparatively unimportant aspects from the substances mentioned." *Per* ROMER, L.J., in *Welsbach Incandescent Coy. v. Daylight Coy.*, 17 R. P. C., at p. 146, C. A.

(*i*) *Leonhardt v. Kalle*, 12 R. P. C. 103.

(*j*) *Thermit, Ltd. v. Weldite, Ltd.*, 24 R. P. C. 441.

Somewhat different views were expressed by the Court of Appeal in *Maxim Nordensfeldt Coy. v. Anderson*, 14 R. P. C. 671, 684, but these were doubted in the House of Lords, 15 R. P. C. 421, 429.

(*k*) *Illustrative cases* :—

In a patent for a brick-making machine the clay was described as being moved against cutting wires. The defendant moved the cutting wires against the clay. *Held*, infringement. *Murray v. Clayton* (1872), Ch. 10 App. 675 n.

In a patent for a pencil case the lead was described as held in a part which was moved forward by a pin in it moving in a slot in the outer

case. The defendant put the pin in the outer case and the slot in the moving part. *Held*, infringement. *Woodward v. Sansum*, 4 R. P. C. 166, C. A.

In a patent for a musical-box a disc was described as rotating and moving fixed levers. The defendant rotated the levers over a fixed disc. *Held*, infringement. *Ehrlich v. Ihlee*, 5 R. P. C. 437, C. A. See also *Electrolytic Coy. v. Evans*, 17 R. P. C. 733.

(*l*) *Illustrative case* : Where a patentee described a method of expanding tubes by forcing in a conical plug between rollers, and the defendant actuated his rollers by pulling out a plug, it was held an infringement. *Dudgeon v. Thompson* (1873), 3 S. XI. 863.

(*m*) See *White v. Bertrams*, 14 R. P. C. 735, I. H.; *Van Berkel v. Simpson*, 24 R. P. C. 117, C. A. Ir.

(*n*) Claim for tyre-cover with hooks on one edge fitting into eyes on the other. *Held*, infringed by tyre with two sets of hooks engaging with each other. *Birmingham Tyre Coy. v. Reliance Coy.*, 19 R. P. C. 298.

Claim for hair-curler as shown with legs having a series of twists for interlocking. *Held*, infringed by curler where legs had only one twist, but had also bulb at end which gave same effect. *Entwistle v. Cuthbert*, 14 R. P. C. 324. See also *Hinde v. Osborne*, 2 R. P. C. 64.

Quite apart from any question of equivalents the Courts have always held that a departure from some adjectival description such as "straight," so slight as not to change the effect, does not prevent infringement (o). This of course applies even more strongly when the limitation is said only to be preferable.

Variations which are infringements.

An extension of this class of cases is where some mathematical form is specified, and another similar form is taken which has to a greater or less degree the advantages desired (p).

Nor will a patentee in general be confined to the strict meaning of an adjective or technical term if it appears that it has been used in a popular or approximate sense (q).

Claim for cycle-saddle having supporting wires diverging from a point in front and attached to supporting plate at back. *Held*, infringed by a saddle where there was no plate, but the wires were turned in at back so as to form a support. *Brooks v. Rendall*, 24 R. P. C. 17.

In a machine where only small pressures were needed a fan was considered an equivalent for an air-pump. *Macdonald v. Fraser*, 11 R. P. C. 169, I. H. See also *Sutcliffe v. Abbott*, 20 R. P. C. 50.

Claim for tennis-marker having revolving disc to supply colour to marking wheel. *Held*, infringed where this was replaced by revolving brush. *Osmond v. Hirst*, 2 R. P. C. 265. See also *Electrolytic Coy. v. Evans*, 17 R. P. C. 733, but *cf. contra Wallace v. Jack*, 22 R. P. C. 581.

Substitution of square shank for circular shank and key, and casting two pieces in one. *Held*, to be infringement. *Lake and Elliott v. Rotax Motor Accessories Coy.*, 28 R. P. C. 532, C. A.

Substitution of cyclone for canvas filter. *British Vacuum Cleaner Coy. v. Exton Hotels, Ltd.*, 25 R. P. C. 617.

In the case of a patent for making a staple with unequal legs from a continuous wire driving into a boot and clicking, this being broadly new, it was held that a mere variation in the order of the cycle of operations did not prevent infringement. *British Shoe Machinery Coy. v. Thompson*, 22 R. P. C. 177.

(o) *Illustrative cases* :—

Where a patentee had spoken of "straight" seams for stays, and the

defendant had seams with a very small curvature, he was held to infringe. *Young v. Rosenthal*, 1 R. P. C. 29.

Where plaintiff had claimed a roller with circular grooves and the defendant had spiral grooves sixty to an inch so that they appeared circular, he was held to have infringed. *Ralston v. Smith* (1865), 11 H. L. C. 233.

(p) *Illustrative cases* :—

Where a patentee claimed a pavement light having glass "moulded so as to be of a prism-like form so as to divert light," and further said that "the sides of the prism may be flat or curved in a horizontal plane," but the patent was not confined to a prism of any particular angle, and in fact in one figure the side was composed of two parts inclined to one another, it was held that a light in which the inclined face was curved in a vertical plane, which was equivalent to having a number of facets at different angles, infringed. *Hayward v. Pavement Light Coy.*, 1 R. P. C. 207.

In the case of a patent for a combination which included a tapered horn, it was held that the use of a horn in the form of a stepped pyramid was an infringement. *Gramophone Coy. v. Ullman*, 23 R. P. C. 752, C. A. But *cf. Gramophone Coy. v. Ruhl*, 27 R. P. C. 629. See also *Newall v. Elliott* (1858), 4 C. B. (N. S.) 269; but *cf. Stead v. Anderson* (1846), 2 W. P. C. 147. Similar rules apply to changes in material, *United Telephone Coy. v. Bassano*, 3 R. P. C., at p. 307.

(q) *Illustrative cases* :—

In the case of a patent for making

Claim for  
new article.

A claim to a new article covers the article however made (r). So a claim to the use of an article for a special purpose covers such use, however the article may be prepared, even if the article is a new one and a special means of preparation is given in the specification (s). Of course if the means of preparation are incorporated in the claim this does not apply (t).

Use for  
different  
purpose.

Where a claim for a process or apparatus is not specifically confined to its use for a certain purpose it may be infringed by the application of such process or apparatus to purposes different from those described by the patentee, and even by its application to inventions of a later date (u).

gas mantles by impregnating cotton "fabric" with oxides of the rare earths and burning away the cotton, the Court held that "plumes" consisting of threads tied on platinum wire was within it. *Incandescent Lighting Coy. v. De Mare Incandescent System*, 13 R. P. C., at p. 330.

Where a patentee in describing his process for the distillation of shale at two temperatures for the purpose of getting out both the oil and ammonia proposed to effect both distillations in different parts of the same retort, but spoke of the lower part as being kept at a "low uniform temperature" and a "low equal temperature," and the upper part at a considerably higher temperature, it was held that these terms could not be strictly construed since it was a physical fact, well known both to the patentee and to any competent workman, that the temperature of the retort varied gradually, and at the point of division must be approximately the same in both parts. *Young and Beilby v. Hermand Oil Coy.*, 9 R. P. C. 373, H. L. See also *Clark v. Adie* (No. 2) (1876), 2 A. C. 423, H. L. (parallel); *United Telephone Coy. v. Bassano*, 3 R. P. C., at p. 306 (tympan); *Lister v. Dix*, 16 R. P. C. 89 (float); *Scott v. Hull Steam Fishing Coy.*, 14 R. P. C. 143 (rope); but cf. *Scott v. Hamling*, 14 R. P. C. 123; *Leeds Forge v. Deighton*, 21 R. P. C. 487, 494, H. L. (sharp ridge); *Roger v. Cochrane*, 26 R. P. C. 596, H. L. (fluid). See also cases at p. 128 n. (s).

(r) *Badische, &c. v. Levinstein*, 2 R. P. C., at pp. 90, 91; *Monnet v. Beck*, 14 R. P. C., at pp. 843, 844; *Fox v. Astrachans, Ltd.*, 27 R. P. C. 769. See also cases in note (s), *infra*.

This proposition was disapproved (at any rate by SMITH, L.J.) in *Nobel v. Anderson*, 11 R. P. C., at p. 534, C. A. Here, however, the patent in question was clearly for a special mode of preparation. See also *Vorwerk v. Evans*, 7 R. P. C. 171; *Kopp v. Rosenwald*, 19 R. P. C. 211, where doubts were expressed if a patent could be obtained for an article apart from a special method of manufacture.

It is extremely difficult to follow these doubts in view of the fact that the great majority of patents, e.g. for machines, etc., are for specific articles without reference to their mode of manufacture. See also *Vorwerk v. Evans*, 7 R. P. C. 274, C. A.

(s) *Illustrative cases* :—

Where a patentee claimed "in hoods prepared as illuminant appliances the use of thorium oxide . . . substantially as described," it was held that these last words qualified "use," and not "prepared," and that mantles containing thorium oxide, however prepared, were within the patent. *Welsbach Incandescent Coy. v. New Incandescent Coy.*, 17 R. P. C. 237.

Where a patent claimed the combination of a carbon filament and a glass receiver exhausted of air, it was held to include a filament, however made. *Edison v. Woodhouse*, 4 R. P. C. 79, C. A.

(t) *Plating Coy. v. Farquharson* (1883), Griff. 187, H. L.; *Nobel v. Anderson*, 12 R. P. C. 519.

(u) *Pneumatic Tyre Coy. v. East London Rubber Coy.*, 14 R. P. C., at pp. 103 and 573, C. A.; *Palmer Tyre Coy. v. Pneumatic Tyre Coy.*, 16 R. P. C., at p. 494; *North British Rubber Coy. v. Gormully and Jeffreys*,

Where the claim is for the use for a particular purpose of course it is only infringed by the use for this purpose and the relief is limited accordingly (x).

If the patentee speaks of substances being used in a process in a certain state and a defendant takes them in another state and subjects them to additional processes which in fact bring them into the specified state he does not escape infringement (y). So, too, if in normal user the substances are brought into the specified state the user is liable for infringement (z).

The class of cases last referred to must be distinguished from those in which an apparatus or material is manufactured

Substances in special state.

Fortuitous use of invention.

15 R. P. C. 254, H. L., and p. 154 n. (s); *Edison v. Holland*, 6 R. P. C. 243; *Electric Telegraph Coy. v. Brett* (1851), 20 L. J. (C. P.) 123 and p. 144 n. (r); *Adhesive Dry Mounting Coy. v. Trapp*, 27 R. P. C. 341; *Mouchel v. Coignet*, 24 R. P. C. 229, C. A., affirmed in H. L. under title *Hennibique v. Cowlin*, 26 R. P. C. 280; but cf. *Plating Coy. v. Farquharson* (1883), Griff., at p. 192.

(x) *Illustrative cases* :—

Where a patentee described and claimed a process for making tungsten filaments and the defendant used it not for making, but for improving a filament already made, it was held no infringement. *Osram Lamp Works Ltd. v. Z. Electric Lamp Coy.*, 29 R. P. C. 428.

See also *Macdonald v. Fraser*, 11 R. P. C. 169, I. H.; *Preston Davies v. Black*, 11 R. P. C. 313, O. H.; *Higgs v. Goodwin* (1858), 27 L. J. (Q. B.) 251. The dictum to the contrary effect in *Watling v. Stevens*, 3 R. P. C., at p. 131, C. A., would seem to go too far; but the onus may be on the party using it to show that it did not effect the same purpose. *Z. Electric Lamp Coy. v. Marples*, 27 R. P. C. 737, C. A.

(y) *Illustrative cases* :—

Where a patentee described a process in which bodies were put into fuming sulphuric acid, and the defendant put them into weaker sulphuric acid and then evaporated, he was held to infringe. *Badische, &c. v. Levinstein*, 4 R. P. C. 449, H. L. See also *Fabriques, &c. v. Lafitte*, 6 R. P. C. 61.

Where a patentee claimed a method of fixing glass bricks to walls by means of glass pellets placed on their backs, and the defendant used sand, etc., which vitrified in the course of

the operation, it was held that even if the patent was confined to the use of glass this would be an infringement. *National Opalite Coy. v. Grand Hotel Coy.*, 15 R. P. C. 249. See also *Muntz v. Foster* (1844), 2 W. P. C. 96; *Cheetham v. Nuttall*, 10 R. P. C. 321.

So, too, where a claim was for carrying out a process of reduction in an atmosphere of hydrogen and steam, it was held to be infringed by reducing in an atmosphere of hydrogen which contained *naturally* a little water vapour, which was sufficient for the purpose. *Osram Lamp Works v. Z. Electric Lamp Coy.*, 29 R. P. C. 425, 426.

(z) *Illustrative cases* :—

Where a patent for the use in the purification of gas of "precipitated or hydrated oxides" had been construed as meaning oxides which were artificially prepared, it was held that the use of "bog-ochre," which was a natural oxide, was not an infringement of the patent, but that continuing to use such "bog-ochre" after it had become charged with sulphur and then reoxidised to purify it was an infringement, because it was now an artificial oxide. *Hills v. Liverpool Gas Coy.* (1862), 32 L. J. (CH.) 28.

In the case of a patent for a stopper for aerated water bottles constructed of a cylinder or plug of hard wood having a greater specific gravity than water, it was held that it was infringed by using a stopper of wood which before use was not of greater specific gravity than water, but became so by immersion. *Barrett v. Vernon* (1877), 25 W. R. 343. See, however, *Binny v. Feldtman* (1879), Griff. 49. H. L., and p. 152 n. (a).

in one state, but in the course of use it deteriorates by wear into another. In these cases it is usually held that there is no infringement (a), nor is it considered that there is infringement because owing to an accident a machine might get into a state which would bring it within the patent (b). So, too, if the use of a substance A for a particular purpose is claimed, the use of another substance B would not be held to be an infringement, although it contained small portions of A as an impurity, if such impurity were not essential or advantageous in the defendant's process (c). In these cases the use of the patented manufacture is only fortuitous, but the Courts do not look on a use as fortuitous where, although other means may be provided for effecting the result desired, the patented device is used, and in the normal working of the machine affords an additional advantage or safeguard (d). The normal conditions

(a) *Illustrative cases* :—

Patent for a packing of fibrous strands impregnated with powdered mineral lubricant in which the specification described a process for such lubrication. Held, not to be infringed by selling packing composed of fibrous bags containing powdered lubricant, although in course of transit and use the packing worked into the fibre. *Binney v. Feldtman* (1875), Griff. 47, H. L..

It should be noted that in this case the manufacturer was sued. It is doubtful whether an action against a user would not have succeeded. At any rate the case is on the extreme border line. Cf. cases at p. 157 n. (g). and *Roger v. Cochrane*, 25 R. P. C. 762, I. H. The decision on this last case was reversed in H. L. 26 R. P. C. 591, but this point was not discussed.

Where in a patent for a brush-cutting machine in which the claim was held to be for a combination which included cutting plates whose edges were out of parallelism, it was held that a machine originally constructed with parallel plates did not become an infringement because in course of wear or by reasons of bad adjustment there was a slight want of parallelism. *Moore v. Bennett*, 1 R. P. C. 129, H. L. See also *Blackstone v. Bamford*, 27 R. P. C. 125; *Gwynne v. Drysdale*, 3 R. P. C. 66, I. H.; *Newall v. Elliott* (1863), 10 L. T. 792.

(b) *Illustrative case* : So the Court refused to hold that a gas-meter was

an infringement of a certain patent because it might become so if a spring broke or ceased to act. *Meters, Ltd. v. Metropolitan Gas Coy.*, 24 R. P. C. 500; but cf. *British Vacuum Cleaner Coy. v. Exton Hotels Coy.*, 25 R. P. C. 629. See also *Shoe Machinery Coy. v. Cullan* (No. 2), 13 R. P. C. 147.

(c) *Illustrative case* : Where the patent was for the production of an explosive by the treatment of soluble nitro-cellulose, and the defendant was applying the same process to the insoluble, it was held that the fact that the insoluble necessarily contained about 10 per cent. of soluble did not make this an infringement. *Nobel v. Anderson*, 12 R. P. C. 164, H. L. But see *Welsbach Incandescent Coy. v. New Incandescent Coy.*, 17 R. P. C. 217, p. 154 n. (p).

(d) *Illustrative case* : In an action brought for an infringement of the Welch patent for holding on a tyre by means of inextensible wires in the edge, it was contended that the defendant's tyre would hold on apart from the inextensibility of the edge and to prove this a test was made in which one was ridden with the edge cut. The Court, however, were of opinion that though it might hold on in ordinary circumstances with the wires cut, yet in the case of a sudden emergency it would be the inextensibility that would hold it on, and held that the patent was infringed. *Dunlop Pneumatic Tyre Coy. v. Clifton Tyre Coy.*, 20 R. P. C. 393, C. A. Cf. *Dunlop Pneumatic*



of user must also be considered in deciding whether an apparatus is an infringement (e).

The general tendency is to assume that statements as to proportions (f), means of preparation (g), or method of use (h), are directory rather than essential parts of the claim unless the wording of the specification shows otherwise, or unless apart from these details there would be no invention.

The joint effect of the two rules given in the chapter on construction, namely, that a claim is *prima facie* a disclaimer limiting rather than extending the invention as described (i), and that whatever may be the invention really made (or even described) the monopoly does not extend beyond the invention claimed (k), gives the defendant two lines of defence—that is to say, he may escape infringement either by showing that what he has done is not within the spirit of the patentee's real invention, though apparently within the wording of the claim (l), or he

Directions usually considered non-essential.

Alternative lines of defence.

*Tyre Coy. v. Wapshare Tyre Coy.*, 17 R. P. C. 433. See also *North British Rubber Coy. v. Gormully and Jeffreys*, 15 R. P. C. 254, H. L.; *Dunlop Pneumatic Tyre Coy. v. New Ixion Tyre Coy.*, 14 R. P. C., at p. 873; *Dunlop Pneumatic Tyre Coy. v. New Lamb Tyre Coy.*, 20 R. P. C. 303, I. H.; *Dunlop Pneumatic Tyre Coy. v. Ostrich Tyre Coy.*, 19 R. P. C. 365, 371; *Howes v. Webber*, 13 R. P. C. 39, C. A. Cf. *Consolidated Car Heating Coy. v. Came*, p. 144 n.(m).

So, too, where in a process some of the success came from the use of the patented invention. *Betts v. De Vitre* (1873), 3 Ch. App. 429.

(e) *Illustrative case*: Where in a patent for refrigerating apparatus certain pipes were shown as sloping so that water could run away, a defendant who fitted an apparatus aboard ship with pipes which were horizontal when the ship was at rest, but became inclined when the ship rolled, was held to infringe. *Haslam v. Hall*, 5 R. P. C. 1.

(f) *Betts v. Menzies* (1862), 10 H. L. C. 117; *Betts v. Neilson* (1871), 3 Ch. App. 429. See also *Saccharin Corporation, Ltd. v. Anglo-Continental Coy.* 17 R. P. C., at p. 319; *Patent Type Foundry Coy. v. Richards* (1860), 6 Jur. (N. S.) 39, and cases at p. 155 n. (u).

(g) *Illustrative case*: Where in a patent for a dry battery the specification spoke throughout of the materials being pulverised, but this was not

mentioned in the claim, it was held that the claim was not restricted to cases where the materials were so pulverised. *Patent Exploitation, Ltd. v. Siemens*, 21 R. P. C. 547, H. L. See also *British Shoe Machinery Coy. v. Thompson*, 22 R. P. C. 177; but cf. *Monnet v. Beck*, 14 R. P. C. 777.

(h) *Illustrative case*: The specification of a patent for a concrete pile spoke of the pile being armed with a shoe to facilitate driving, but said it could also be inserted by other methods. The claim was for the pile as described, and was held to include piles whether adapted for driving or not. *Mouchel v. Coignet*, 24 R. P. C. 229, C. A.; affirmed in H. L. under title *Hennebique v. Cowlen*, 26 R. P. C. 280.

(i) See chapter on "Construction," p. 116.

(k) See chapter on "Construction," p. 121.

(l) *Illustrative case*: Where a patentee described making by physical means a series of cells in the backing for a rubber stamp, and claimed the improved foundation consisting of a series of cells of any suitable shape adapted to receive the pressure upon their walls endwise, it was held that where by chemical means a series of cells having axes in all directions was formed in the backing of a stamp, this was no infringement. *Pneumatic Rubber Stamp Coy. v. Lindner*, 15 R. P. C. 525. See also *Bovill v. Pimm*

may say that whatever the patentee may have invented the public are only prohibited from taking what is claimed, and that he has not done this.

An improvement may be an infringement.

Although the fact that the defendant has shown ingenuity and has produced a real improvement may be evidence in his favour on the question of whether his device is an equivalent to that claimed (*n*), yet if what he has taken comes within the terms of the claim ingenuity is no defence (*o*). Nor is it any defence that he has added something to the patented device (*p*), or enabled it to fulfil other functions (*q*), or has made it slightly better or worse (*r*), nor that the object he seeks by its use is different to that sought by the patentee (*s*). Where the

(1856), 11 Ex., at p. 739; *Osborne v. Board*, 13 R. P. C. 740; *Atkins and Applegarth v. Castner Kellner Alkali Coy.*, 18 R. P. C. 281, 297; *Ashworth v. Roberts*, 9 R. P. C. 309, C. A.

(*n*) See pp. 140, 141

(*o*) "The superadding of ingenuity to robbery does not make the operation justifiable," *per* BOWEN, L.J., in *Wenham Gas Coy. v. Champion Gas Coy.*, 9 R. P. C., at p. 56, C. A.; *Proctor v. Bennis*, 4 R. P. C. 333, 354, C. A.; *Haskell v. Hutchinson (No. 2)*, 25 R. P. C. 194; *Marconi v. British Radio-Telegraph Coy.*, 28 R. P. C. 181, 218.

(*p*) *Illustrative cases* :—

A patent for the use of the hot blast in conjunction with hard coal in iron-making was held to be infringed by the use of a combination of hard and soft coal with a hot blast. *Crane v. Price* (1842), W. P. C. 377.

So where a patent claimed the use of thorium oxide in mantles a mixture of 99 per cent. of thorium and 1 per cent. cerium was held to infringe, though in fact the greater part of the illuminating power came from the cerium. *Welsbach Incandescent Coy. v. New Incandescent Coy.*, 17 R. P. C. 237.

A patent described and claimed a system of separating oxygen from nitrogen by freezing and applying the principle of rectification similar to that adopted in the Coffey still. The defendants improved on this process in two respects. Firstly, they got additional cooling by letting the expanding gases do additional work; secondly, they partly separated the gases before applying the rectifying principle. *Held*, infringement. *British*

*Liquid Air Coy. v. British Oxygen Coy.*, 26 R. P. C. 526, H. L. See also *Betts v. De Vitre* (1873), 37 L. J. (CH.) 325; *Needham v. Johnson*, 1 R. P. C. 53, C. A.; *Proctor v. Bennis*, 4 R. P. C. 333, 354, C. A.; *Laine v. Herrold*, 9 R. P. C. 447; *Howes v. Webber*, 13 R. P. C. 39, C. A.; *Actiengesellschaft, &c. v. Schroeder*, 13 R. P. C. 473; *Thermit, Ltd. v. Weldite, Ltd.*, 24 R. P. C. 441; *British Vacuum Cleaner Coy. v. Exton Hotels Coy.*, 25 R. P. C. 617; *Roger v. Cochrane*, 26 R. P. C. 591, H. L. See, however, *Dunlop Pneumatic Tyre Coy. v. Moseley*, 18 R. P. C. 411.

(*q*) *Illustrative case* : Where a patent claimed the use of a priming cap to effect ignition at starting when the walls of the cylinder were cold, and the defendants used a device which acted not only at the start, but also when the engine was running, this was held to be an infringement. *British Motor Coy. v. Universal Motor Coy.*, 16 R. P. C. 113. See also *United Telephone Coy. v. Harrison* (1883), 21 Ch. D. 721; *Cannington v. Nuttall* (1871), L. R. 5 H. L., at p. 230; *Macdonald v. Fraser*, 11 R. P. C. 169, I. H.; *Pneumatic Tyre Coy. v. East London Rubber Coy.*, 14 R. P. C., at p. 103; *Haskell v. Hutchinson*, 22 R. P. C. 493; *Crosthwaite v. Senior*, 26 R. P. C. 713.

(*r*) See *Useful Patents v. Rylands*, 2 R. P. C. 255; *Automatic Coal Gas Retort Coy. v. Salford Corporation*, 14 R. P. C. 450; *Heine v. Coninco*, 21 R. P. C. 202; *British Vacuum Cleaner Coy. v. Suctions, Ltd.*, 21 R. P. C. 303; *Halden v. Hall*, 21 R. P. C. 609.

(*s*) *Illustrative case* : Where the patent claimed an explosive compound

defendant has taken a substance, etc., within the claim, but different from those whose use is described in the specification, the variations from the directions given in the latter necessitated by the change (even if these involve ingenuity) do not usually avoid infringement (*t*).

In the case where the defendant makes small variations in an essential element, not coming under any of the classifications dealt with above, the Court really acts simply as a jury would, and finds in each case whether on the particular facts the invention claimed has in substance been taken or not, and consequently precedents are of little value. A certain number of decisions have, however, been collected here which may possibly prove useful in particular cases (*u*). Other variations.

in which oil was used as a moderant, the defendants used vaseline and said it was merely to prevent the metal being contaminated, *WRIGHT, J.*, was of opinion that this would not matter if vaseline was within claim (which he held was not the case). *Maxim Nordenfeldt Coy. v. Anderson*, 14 R. P. C. 371, 385.

(*t*) *Illustrative case*: A patentee claimed "the combination of a grooved rim or metal tyre and an arched tyre of India rubber or other flexible material held in the groove by the pressure of an inflated tube within the arch which forces its edges against the side of the groove substantially as described" and described the inner tube as being made with a combination of canvas and rubber. The defendant used a pure rubber tube and varied the form of the groove, and it was proved that a pure rubber would not have acted with the shape of groove shown by the patentee because it was too extensible. *Held*, infringement. So, too, in another case where the edges were thickened for the same purpose. *North British Rubber Coy. v. Gormully and Jeffreys*, 15 R. P. C. 245, H. L.; *North British Rubber Coy. v. Macintosh*, 11 R. P. C. 477.

But see p. 147 n. (*g*).

See also *Hookham v. Johnson*, 14 R. P. C., at p. 577; *Leonhardt v. Kalle*, 12 R. P. C. 103. See *contra*, per *ALDERSON, B.*, in *Morgan v. Seaward* (1837), W. P. C., at p. 178.

(*u*) Cases where variations held not to avoid infringement:—

PROPORTIONS: *Illustrative case*: Where in a patent for a fan the

patentee said that the depths of the blades should be preferably not greater than one-eighth of the diameter of the fan, and the defendant had made blades of one-sixth the diameter, but it was shown by experiment that they act in substantially the same way as those described in the specification, he was held to have infringed. *Davidson v. Sun Fan Coy.*, 23 R. P. C. 493. See also *Automatic Coal Gas Retort Coy. v. Salford Corporation*, 4 R. P. C. 450 (angles).

FORM: *Tweedale v. Howard*, 13 R. P. C. 522; *British Vacuum Cleaner Coy. v. Suctions, Ltd.*, 21 R. P. C. 303.

VARIATIONS FROM DRAWINGS: *Illustrative case*: In the case of a patent construed as being for the particular method of centring dobbie levers shown in the drawing (such method giving the minimum of friction on the knives), the defendants had slightly varied these positions so that though they did not get the minimum of friction, they got nearly the minimum. *Held*, infringement. *Hattersley v. Hodgson*, 22 R. P. C. 229, C. A. See also *Faucett v. Homan*, 13 R. P. C. 398, C. A.; *Leeds Forge v. Deighton*, 21 R. P. C. 487, 494, H. L.; *Wenham Gas Coy. v. May*, 4 R. P. C. 303; *Wenham Gas Coy. v. Champion Gas Light Coy.*, 9 R. P. C. 49, C. A.

ORDER OF OPERATIONS: *British United Shoe Machinery v. Thomson*, 22 R. P. C. 177, 196; *Hay v. Gonville*, 25 R. P. C. 161.

VARIATIONS IN ARRANGEMENT: *Thomson v. Moore*, 7 R. P. C. 325, H. L.; *Thomson v. Batty*, 6 R. P. C. 84.

Variations in old machine.

The fact that a defendant has merely varied or added to an old machine or process is, of course, no defence if such variation or addition brings him within the terms of the patent (v). But where both plaintiff and defendant have introduced variations in what was old, such variations being different, and all that is common being really what was known before, then there is no infringement (w).

Restricted interpretation.

In many cases a claim is restricted so as to make the patent merely for the example described. This is generally due to the fact that from absence of directions no further development could be made (x), or that owing to prior knowledge a narrow interpretation must be put upon the patent to preserve its validity (y).

Sometimes this is done so that a claim apparently to the use of a thing in general is confined to its use for the purpose described (z).

## PART II

### RIGHTS DEPENDING ON THE CONSTRUCTION OF THE GRANT

Extent of monopoly.

THE monopoly arises from and is defined by the patent itself (a), and is that of making, using, exercising, and vending the invention within the United Kingdom of Great Britain and Ireland and the Isle of Man (b), and any unauthorised person who does one or more of these acts thereby commits an infringement.

Cases where small variations held to avoid infringement:—

PROPORTIONS: see *Jandus Arc Coy. v. Arc Lamp Coy.*, 22 R. P. C. 384.

ORDER OF OPERATIONS: *Jahncke v. Bell*, 9 R. P. C. 94, C. A.

(v) *British Shoe Machinery Coy. v. Thomson*, 22 R. P. C. 177, 195; *English and American Machinery Coy. v. Union Coy.*, 11 R. P. C. 367, C. A.

(w) *Curtis v. Platt* (1865), 35 L. J. (CH.) 852, and cases at p. 133 n. (e). See also *Westinghouse v. Lancashire and Yorkshire Railway Coy.*, 1 R. P. C. 229; *Knight v. Argylls, Ltd.*, 29 R. P. C. 593, 608.

(x) *Maxim Nordenfeldt Coy. v. Anderson*, 15 R. P. C. 421, H. L.

(y) E.g. *Oddy v. Smith*, 5 R. P. C. 503; *Hocking v. Hocking*, 6 R. P. C. 69, H. L.; *Vorwerk v. Evans*, 7 R. P. C. 265, C. A.; *Preston Davies v.*

*Black*, 11 R. P. C. 574, I. H.; *Jardine v. King*, 13 R. P. C. 411; *Birch v. Harrap*, 13 R. P. C. 615; *Allen v. Pyatt*, 16 R. P. C. 135; *Peters v. Owen*, 17 R. P. C. 80; *Chamberlain v. Bradford Corporation*, 20 R. P. C. 673, H. L.; *Corrigal v. Armstrong*, 22 R. P. C. 268; *New Inverted Coy. v. Globe Coy.*, 23 R. P. C. 157, C. A.; *Bosworth v. Components*, 24 R. P. C. 765.

(z) *Allan v. Finlay* (1857), 2 S. XIX. 1087; *Fletcher v. Glasgow Gas Commissioners*, 4 R. P. C. 386.

(a) See form of Letters Patent, App. post. See also *Von Heyden v. Neustadt* (1880), 50 L. J. (CH.), at p. 130, C. A.

(b) The Channel Islands have not been included within the Realm for this purpose since 1883, see s. 14 (1) and 46 & 47 Vict. c. 57, s. 16.

The use of patented articles on a British or foreign ship <sup>Use on board ship.</sup> within British waters is an act of infringement (c), and in fact the mere presence of the article as part of the ship's equipment is sufficient to justify an injunction (d). But user on a British ship outside British waters is not an infringement (e).

The recent Act has created an exception to the above rule as to infringement by user on board a foreign ship in British waters. The use of an invention on a foreign vessel within the jurisdiction, which is not used therein for, or in connection with, the manufacture or preparation of anything intended to be sold in, or exported from, the United Kingdom or the Isle of Man, shall not be deemed an infringement provided the vessel belongs to a State which extends corresponding privileges to British ships in its waters (f).

The time during which an unauthorised act may be an infringement commences on the acceptance of the complete <sup>Time of monopoly.</sup> specification (g), and terminates on the expiration of the patent. It would also seem that a person who manufactures articles in this country in infringement of patent rights may be restrained from selling them even after the expiration of the patent (h); but there is no reported case in which the use of such articles by other persons after the expiration of the patent has been held to be an infringement. There are special provisions in the case of patents granted in lieu of others revoked on the ground of fraud (i), and of patents that have been revived (k), and the patent rights may be suspended where the patentee has infringed the provisions of the Act as to restrictive clauses in contracts (l).

(c) *Caldwell v. Van Vlissingen* (1852), 21 L. J. (CH.) 97; *Adair v. Young* (1879), 12 Ch. D. 13, C. A.

(d) *Adair v. Young*, *supra*; see, however, *Caldwell v. Van Vlissingen*, *supra*, as to injunctions against masters.

(e) *Newall v. Elliott* (1864), 10 Jur. (N. S.) 954.

The fitting of the apparatus here would probably be an infringement, *ibid.* See also *Goucher v. Clayton* (1865), 11 Jur. (N. S.), at p. 465.

(f) Sect. 48.

It should be noted that this section only applies to foreign ships.

The following foreign States expressly confer corresponding rights on ships coming into their waters:—

Austria-Hungary.	Finland.
Denmark.	Germany.

Japan.	Norway.
Mexico.	Salvador.

In the case of other countries the question as to whether their ships come within the provisions of this section would depend on the interpretation given by their Courts to the rights of patentees. In most countries the point has not been decided, but in the United States of America it has been decided that the use of an invention on a vessel coming into its ports is not an infringement. See *Brown v. Duchesne*, 19 Howard, 183.

(g) Sect. 10. See also *Dowling v. Billington*, 7 R. P. C. at p. 201.

(h) *Crossley v. Beverley* (1829), W. P. C. 119.

(i) See p. 216.

(k) See p. 284.

(l) See p. 249.

Articles made  
abroad.

As the invention is a new manufacture and manufacture in patent law includes both the process and the thing made (*m*), the commission of any of the prohibited acts with regard to either of these constitutes an infringement of the patent. Thus the sale of an article in this country, whether such article has been made here or abroad, is an infringement of a patent either for the article itself or for the process of making it (*n*). The same rule has been held to apply where a patented process has been used in making an article out of which the article imported is made (*o*).

A further extension of the rule (which in the author's opinion is open to doubt) is that where there is a patent for a machine, the sale within the realm of articles manufactured on that machine out of the realm is an infringement of the patent for the machine (*p*). It would appear difficult to assign any meaning to the word invention which would include an article made on a patented machine.

Acts constitu-  
ing infringe-  
ment.

Shortly, it may be said that any act which interferes with the full enjoyment by the patentee of the monopoly granted to him constitutes an infringement (*q*).

Making.

Under making is included any manufacture either for private use (*r*), or for sale here, or for export abroad (*s*).

Exercising  
or using.

(*m*) See p. 17.

(*n*) *Von Heyden v. Neudstadt* (1880), 14 Ch. D. 230, C. A.; *Walton v. Lavater* (1860), 29 L. J. (C.P.) 275; *Wright v. Hitchcock* (1870), L. R. 5 Ex. 37; *Elmslie v. Boursier* (1869), L. R. 9 Eq. 217; *Betts v. Neilson* (1868), 3 Ch. App. 429; *Betts v. Wilmot* (1871), 6 Ch. App. 239. See also *Badische, &c. v. Chemische Fabrik, &c.*, 21 R. P. C. 345.

(*o*) *Saccharin Corporation, Ltd. v. Quincey*, 17 R. P. C. at p. 339; *Same v. Anglo-Continental Coy.*, 17 R. P. C. at p. 318.

In these cases the patent was for a particular method of making toluene sulpho-chloride, which is an intermediate product in the manufacture of saccharin, and the infringement was the importation of saccharin manufactured from toluene sulpho-chloride so made. The latter case went to appeal and from certain remarks made by the Court during the argument they did not seem to wholly agree

with the view taken in the Court below. The case was finally settled.

(*p*) *United Horsenail Machinery Coy. v. Stewart*, 2 R. P. C. 122.

Lord Kinnear in *Cartsburn v. Sharpe*, 1 R. P. C. at p. 186, appeared to assume that the importation of sugar cubes made on the patented machine in America would be an infringement of an English patent for the machine, but he found that there was in fact no infringement. From some remarks in his judgment he does not seem to have distinguished between a patent for a machine and a patent for a process. See also *Wright v. Hitchcock, supra*.

(*q*) See *Saccharin Corporation, Ltd. v. Anglo-Continental Coy.*, 17 R. P. C. at p. 319.

(*r*) *United Telephone Coy. v. Sharples*, 2 R. P. C. 28.

(*s*) *Goucher v. Clayton* (1865), 11 Jur. (N. S.) at p. 465; *Lyon v. Goddard*, 11 R. P. C. 113.

for trade or private purposes or even for amusement (*t*). Thus it includes use for exhibition (*u*) or as samples (*x*), or for the purpose of instructing pupils (*y*), and even merely acquiring with intent to use or sell (*z*) or keeping or transporting an article with a view to sale (*a*), or keeping a machine as a standby which may be used in case of necessity (*b*) is sufficient to constitute infringement. Mere transport or warehousing by a carrying or warehousing agent does not constitute infringement (*c*), and the same principle probably applies to a person who has the article merely for the purpose of repair (*d*). It has also been said that using an invention for a purpose which is not a manufacture (*e*) is not an infringement, but it seems doubtful how far this dictum would be followed. *Bonâ fide* experiment for the purpose of making improvements or the like does not constitute infringement (*f*). Probably a much less liberal view

(*t*) *United Telephone Coy. v. Sharples*, 2 R. P. C. 28. See, however, direction of PATTESON, J., in *Jones v. Pearce* (1832), W. P. C. at p. 125.

(*u*) *Dunlop Pneumatic Tyre Coy. v. British and Colonial Motor Car Coy.*, 18 R. P. C. 313.

It was here found as a fact that the tyres on the car exhibited were not intended to be sold with it, but nevertheless their exhibition was held to constitute infringement.

(*x*) See remarks in *Badische, &c. v. Chemische Fabrik, &c.*, 20 R. P. C. 413, C. A.; *Same v. Thomson*, 20 R. P. C. 422, C. A.: the point, however, was not decided.

In *Hudson Scott v. Barringer*, 23 R. P. C. at p. 87, it was held that the use of articles as samples was sufficient to constitute prior user. See also *Oxley v. Holden* (1860), 8 C. B. N. S. 666.

(*y*) *United Telephone v. Sharples*, *supra*.

(*z*) *Saccharin Corporation v. Lyle*, 21 R. P. C. 604; *Same v. Ross*, 22 R. P. C. 246; *British Motor Syndicate v. Taylor*, 17 R. P. C. 723, C. A. See also *Adair v. Young* (1879), 12 Ch. D. 13, C. A.; but there must be evidence of intent to use in such a way as to infringe, *British United Shoe Machinery Coy. v. Collier*, 27 R. P. C. 571, H. L., *semble*, the mere act of purchase may be presumptive evidence of such intention, *ibid.*, *per* Lord DUNEDIN, at p. 572.

(*a*) *United Telephone Coy. v. London and Globe Coy.*, 1 R. P. C. 117. See

also *British Motor Syndicate v. Taylor*, *supra*; *Belts v. Neilson* (1868), 3 Ch. App. 429; but *cf.* *United Telephone Coy. v. Henry*, 2 R. P. C. 11, and cases in last note.

(*b*) *British United Shoe Machinery Coy. v. Collier*, 26 R. P. C. 534, C. A.

(*c*) *Nobel v. Jones* (1881), 8 A. C. 5 H. L.; but *cf.* *Washburn and Moen v. Cunard Steamship Coy.*, 6 R. P. C. 398; *Badische, &c. v. Johnson*, 14 R. P. C. 919, H. L.

(*d*) *United Telephone v. Henry*, *supra*.

(*e*) *Higgs v. Goodwin* (1858), 27 L. J. (Q. B.) 421.

Here the patent was for treating chemically the contents of sewers so that the same might be applied to agricultural and other useful purposes. It was held that the use of this process merely for the purpose of purifying sewage water, and not for obtaining manure, was not an infringement, since in the opinion of the Court such purification was not a manufacture, *sed. quaere*.

(*f*) *Per* JESSEL, M.R., in *Frearson v. Loe* (1878), 9 Ch. D. 48.

In this case, however, it was held that where the defendant had used a patented machine with a view to seeing how well it worked, and had made a small quantity of screws on it, he had committed an infringement.

So where a defendant after warning had used a variation of a patented article which came within the claim during the whole of a trip for fishing purposes, this was held to be more

would be taken of the permissible limits of experimental user where this is relied on as a defence to infringement than in the case of a prior user alleged to invalidate a patent (*g*).

Vending.

Vending covers selling or exposing for sale (*h*), whether for home use or for export (*i*).

Many cases have arisen as to sales of goods manufactured abroad. In such cases it is necessary in order to establish infringement to show that some act has been committed within the realm, by the defendant or his agent, which is contrary to the prohibition of the patent (*k*).

It is also necessary to show that what was sold was itself an infringement of the patent. The sale of an article which is not patented does not become an infringement because the seller knows it is to be used for a prohibited purpose (*l*). It has however been decided in one case that where an ordinary article was sold with directions to use it in a way that would involve infringement, such sale amounted to infringement (*m*).

It is possible that the sale of a machine deliberately made

than experimental user and to be an infringement. *Scott v. Hull Steam Fishing Coy.*, 14 R. P. C. 143. See also *Saccharin Corporation v. Ross*, 22 R. P. C. 246.

(*g*) Cf. *Caldwell v. Van Vlissingen* (1851), 9 Hare. 415, and see p. 71.

(*h*) *British Motor Coy. v. Taylor*, 17 R. P. C. 723, C. A.

Certain dicta in *Minter v. Williams* (1835), W. P. C. 135, which seem contrary to this were considered and explained in the above case. The earlier case really turned on a point of pleading. See also *Oxley v. Holden* (1860), 8 C. B. (N. S.) at p. 666.

(*i*) *British Motor v. Taylor*, 17 R. P. C. 723, C. A.; *Betts v. Neilson* (1868), 3 Ch. App. 429; *Lyon v. Goddard*, 11 R. P. C. 113; *United Telephone Coy. v. Sharples*, 2 R. P. C. 31; *Goucher v. Clayton* (1865), 11 Jur. (N. S.), at p. 465. See also *Oxley v. Holden* (1860), 8 C. B. (N. S.) 666.

(*k*) Thus a foreigner posting a patented article abroad to a customer here is not guilty of infringement, since the post office is the agent of the receiver. *Badische, &c. v. Johnson*, 14 R. P. C. 919, H. L.

Neither is it an infringement to enter into a contract in this country for the sale abroad of goods manufactured abroad, provided that they do not come into this country while in

the vendor's possession. *Saccharin Corporation v. Reitmeyer*, 17 R. P. C. 606; *Badische, &c. v. Hickson*, 23 R. P. C. 433, H. L.

But if the goods are consigned here and then exported it is infringement. *Betts v. Neilson* (1868), 3 Ch. App. 429; *British Motor Syndicate v. Taylor, supra*; *United Telephone Coy. v. Sharples*, 2 R. P. C. 28.

(*l*) *Townsend v. Haworth* (1875), 48 L. J. (C.H.) 770 n.; *Sykes v. Haworth* (1879), 48 L. J. (C.H.) 769; *McCormick v. Gray* (1861), 31 L. J. (EX.) 42; *Dunlop Pneumatic Tyre Coy. v. Moseley*, 21 R. P. C. 274, 281, C. A.; *Allen v. Doulton*, 4 R. P. C. 382. See also *Savage v. Brindle*, 13 R. P. C. 266.

(*m*) *Innes v. Short*, 15 R. P. C. 449.

The decision seems hard to reconcile with the other authorities cited above. It was distinguished in *Dunlop Pneumatic Tyre Coy. v. Moseley*, 21 R. P. C. 60, and doubted in *Adhesive Dry Mounting Coy. v. Trapp*, 27 R. P. C. 355. See also *McCormick v. Gray, supra*.

In *Briggs v. Lardcur*, 1 R. P. C. 126, a decision to the same effect was given by PEARSON, J., on a motion for an *interim* injunction. The injunction was dissolved on terms by the C. A. (1 R. P. C. 192), but there is no further report of the case.



and put on the market in such a form that by a simple alteration it could be made into an infringing machine, would be held to be an infringement, but the point has never been decided (*n*).

So the sale of parts of a combination does not amount to infringement of a patent for the combination (*o*) unless perhaps all the parts are sold together in such a form that they can be easily made into the combination (*p*).

Articles manufactured or sold by the patentee or his agents are in the absence of special stipulations licensed generally. Such licence gives the buyer the right to bring the articles into this country even if they were manufactured and sold abroad (*q*). Articles made or sold by patentee.

It has been held that the owner of a patented article is entitled to make *bond fide* repairs to prolong the life of the article, but such repairs must not amount to making a substantially new article (*r*). It has also been held that where one part of a combination is in the natural course of events liable to wear out quicker than the other parts, the owner is entitled to replace such part without being liable to an action for infringement of the combination (*s*). It would seem, too, that where there are claims for a separate integer, and also for the combination of this integer with old parts, the purchase from the patentee or his agent of the separate integer licenses its use in the combination (*t*). Repairs.

The question of whether an infringement has been committed is wholly independent of the knowledge of the defendant (*u*). Knowledge immaterial.

(*n*) See *Shoe Machinery Coy. v. Cutlan*, 13 R. P. C. at p. 147; *Gwynne v. Drysdale*, 3 R. P. C. 62; *Newall v. Elliott* (1864), 10 L. T. 792.

(*o*) *Dunlop Pneumatic Tyre Coy. v. Moseley*, 21 R. P. C. 274, C. A.

(*p*) See *United Telephone Coy. v. Dale* (1884), 25 Ch. D. 770; *Goucher v. Clayton* (1865), 11 Jur. (N. S.) 465; *Dunlop Pneumatic Tyre Coy. v. Moseley*, 21 R. P. C. 280, C. A.

(*q*) *Betts v. Wilmot* (1871), 6 Ch. App. 239.

As to the case where the seller is a licensee, under a foreign patent see *Société, &c., des Glaces v. Tilghman* (1883), 25 Ch. D. 1, C. A. See also

(*r*) *Dunlop Pneumatic Tyre Coy. v. Neal*, 16 R. P. C. 247; *Same v. Excelsior Tyre Coy.*, 18 R. P. C. 209; *Same v. The Holborn Tyre Coy.*, 18 R. P. C. 222.

In *Dunlop Pneumatic Tyre Coy. v.*

*Moseley*, 21 R. P. C. at p. 282, C. A., COZENS-HARDY, L.J., expressed a doubt whether *Dunlop v. Neal* had not gone too far in favour of the Patentee.

(*s*) *Sirdar Rubber Coy. v. Wallington Weston & Coy.*, 22 R. P. C. 257. See also *Roberts v. Heywood* (1879), 27 W. R. 454.

(*t*) *Arnold v. Bradbury* (1871), 6 Ch. App. 706. See also *Oxley v. Holden* (1860), 8 C. B. (N. S.) 666.

(*u*) The fact that a man may while acting in perfect innocence yet be guilty of infringement seems clearly recognised by s. 33, as to which see p. 197. See also *Stead v. Anderson* (1847), 2 W. P. C. at p. 156. See also remarks of ERLE, C.J., in *Walton v. Lavater* (1860), 29 L. J. (C.P.) at p. 279, and of PARKE, B., in the H. L. in *Heath v. Unwin* (1844), 5 H. L. C. at p. 537.

or of whether or not he has acted with the deliberate intention of infringing (x).

Acts done at plaintiff's instigation.

Where the act complained of is an act of manufacture or user, and is done at the instigation of the plaintiff, this is generally not sufficient to constitute infringement as it is considered as having been done with his leave (y). But the fact that a sale is made to an agent of the plaintiff does not prevent its being an infringement, because the agent has no power to license such sale (z).

Agency.

Of course a principal may be liable for the infringement of his agent, and a person may also be liable for infringement if he has really had a hand in the manufacture or sale of the infringing article, though not actually committing these acts himself (a).

Acts which are not infringements.

The grant of licences to other persons to manufacture under a patent by a process which is an infringement of a previous

The L. C. in *Stevens v. Keating* disapproved of the idea that intention to infringe must be proved, as appears from the judgment of SHADWELL, V.C., in *Heath v. Unwin* (1844), 15 Sim. at p. 553.

The contrary view, expressed in the judgment of the Court of Exchequer in *Heath v. Unwin* (1844), 2 W. P. C. at p. 227, and by some other judges, cf. *Seed v. Higgins* (1858), 27 L. J. (Q. B.) 417, *Jones v. Pearce* (1832), W. P. C. at p. 125, has never been followed in modern times, and seems utterly opposed to all principles of English civil law.

(x) See *Stead v. Anderson*, *supra*, commenting on *Heath v. Unwin*, *supra*; but as to making a workman merely executing orders a defendant, see *Savage v. Brindle*, 13 R. P. C. 266.

(y) Where an agent of the plaintiff had, without disclosing his identity, ordered a ladder to be made in a certain way which was in fact an infringement of the patent, it was held that such manufacture did not constitute an infringement; *Kelly v. Batchelar*, 10 R. P. C. 289, but cf. *Dunlop Pneumatic Tyre Coy. v. Neal*, *infra*.

In a case where the alleged infringement was by user it was proved that the plaintiff had been present on the occasion of the user, and in fact had ridden the machine complained of himself, though he had stated that

he would consult his solicitor on the subject. It was held that the acts were done with his leave; *Henser v. Hardie*, 11 R. P. C. at p. 437.

(z) In the majority of patent cases the evidence of infringement is a sale to the plaintiff's agent, and this has always been considered sufficient.

In *Dunlop Pneumatic Tyre Coy. v. Neal*, 16 R. P. C. 247, it was further held that where an agent of the plaintiff, who had no authority to license, took a tyre to the defendant to be repaired, and the repairs exceeded the limits which in the Court's opinion were permissible, this was sufficient evidence of infringement.

(a) Thus the Directors of a Company were held liable for the infringement by the servants of the company in the course of their duty, although such infringement was against their express orders. Apparently the company were also considered liable. *Betts v. De Vitrie* (1864), 3 Ch. App. 441.

So where a father had allowed his sons to carry on business in his name he was held responsible for their infringements; *Day v. Davies*, 22 R. P. C. 42. See also *Anderson v. Patent Oxonite Coy.*, 3 R. P. C. 279; *Incandescent Gas Light Coy. v. New Incandescent Mantle Coy.*, 15 R. P. C. 81; *Same v. Brogden*, 16 R. P. C. 179; *Sykes v. Howarth* (1879), 48 L. J. (CH.) 769; but cf. *Savage v. Brindle*, 13 R. P. C. 266.

patent does not in itself render such persons the agents of the licensor, or constitute infringement (*b*). Nor does merely lending a patented article amount to infringement (*c*).

Where a patented article is leased, licensed, or sold with the condition that it shall only be used in a certain way, user contrary to this condition constitutes infringement (*d*). It is, however, necessary to show that the condition was brought to the knowledge of the defendant before the sale was complete (*e*). The use of such restrictive conditions is much limited by the recent Act (*f*).

(*b*) *Montgomerie v. Paterson*, 11 R. P. C. at p. 237, and in L. H. at p. 633.

In *Anderson v. Patent Oxonite Coy.*, 3 R. P. C. 279, CHITTY, J., held that a Company who had purported to grant a licence guilty of infringement, but on the ground that the licensee was really their agent.

(*c*) *United Telephone Coy. v. Henry*, 2 R. P. C. 11.

(*d*) *Incandescent Gas Light Coy. v. Cantelo*, 12 R. P. C. 262; *Same v. Brogden*, 16 R. P. C. 179. See also *Welsbach Incandescent Coy. v. Dowle*, 16 R. P. C. 391; *Badische, &c. v. Isler*, 23 R. P. C. 633, C. A.

(*e*) *Incandescent Gas Light Coy. v. Cantelo*, *supra*.

(*f*) Sect. 38, see p. 248.

## CHAPTER X

## PRACTICE AND PROCEDURE

*Parties*

THE general rule is that the legal owner of the patent rights must be a party (a). If the plaintiff is an equitable owner, then the legal owner may be joined as defendant (b). The questions of part owners (c), licensees (d), and executors (e) suing have been dealt with elsewhere.

It would seem that a seller and a buyer can be joined as defendants in the same action (f), but a manufacturer has no right to be joined against the plaintiff's wish as defendant in an action against the purchaser from him (g).

Generally speaking, assignors and assignees of a business should not both be joined as defendants in the same action (h). In the case where a number of actions are brought on the same patent an order may be made with the consent of the parties that one action should be tried as a test action and the others abide

(a) *Bowden's Patent Syndicate v. Smith*, 21 R. P. C. 438. See also *Adams v. North British Rail. Coy.* (1873), 29 L. T. 367.

In *Actiengesellschaft für Cartonndägen Industrie v. Temler*, 16 R. P. C. 447, the plaintiff was granted an interim injunction, although his title was only equitable. A mortgagor may sue alone (*Van Gelder & Coy. v. Sowerby Coy.*, 7 R. P. C. 208, C. A.).

(b) This is frequently done, cf. *Spennymoor Foundry v. Catherall*, 26 R. P. C. 822, and cases at p. 240, n. (o).

(c) See p. 12, n. (i).

(d) See p. 7, n. (f).

(e) See p. 240, n. (o).

(f) See *Saccharin Corporation, Ltd. v. Lyle & Coy.*, 21 R. P. C. 604.

In a case where both makers and users were sued and only the makers entered a defence, CHITTY, J., refused leave for judgment on motion against the users; *Actiengesellschaft für Cartonndägen Industrie v. Remus*, 12 R. P. C. 94.

On this point cf. *Hocking v. Hocking*, 3 R. P. C. 291.

(g) *Moser v. Marsden*, 9 R. P. C. 214. See also *Laing's Sewing Machine v. Norrie* (1877), 4 S. V. 29 (I. H.), where it was held that owners of machine could not be joined as defendants, against the plaintiff's wish, with persons who had the machine on the premises and had been sued as users. But see *Washburn & Moen v. Cunard Steamship Coy.*, 6 R. P. C. 398, where consignees were held to be necessary and proper parties to be joined with a steamship company.

In *Varasseur v. Krupp* (1878), 9 Ch. D. 351, C. A., the Mikado was joined as a defendant at his own request, and obtained an order permitting him to remove the infringing articles.

(h) See *Saccharin Corporation v. Lyle & Coy.*, 21 R. P. C. 604; *Briggs v. Lardeur*, 2 R. P. C. 13: here application was by defendants.

the result (*i*). Third party procedure applies where manufacturers have given an indemnity since action brought (*k*).

#### *Service out of the Jurisdiction*

In patent actions leave to effect service out of the jurisdiction is usually sought on the ground that an injunction is asked for (*l*). In such cases it cannot be granted if the patent, or one of the patents, sued on has expired (*m*).

Another ground which is sometimes raised is that the defendant sought to be served is a necessary and proper party to an action in which another defendant has been properly served within the jurisdiction (*n*).

In either case the Court requires to be satisfied by evidence that a *prima facie* case of infringement has been made out, but will not decide doubtful points of law or fact adversely to the plaintiff at this stage, or on a motion to discharge the order (*o*).

In the case of defendants resident in Scotland or Ireland the Court requires evidence of acts that would give ground for an injunction in England or Wales, and also considers the balance of convenience (*p*).

Leave to serve notice of motion out of the jurisdiction is also given where leave so to serve the writ is granted (*q*).

#### *Pleading (qq).*

The plaintiff by his statement of claim alleges the grant of the Letters Patent and his title to the same (*r*), and also

Statement  
of claim.

(*i*) See *Foxwell v. Webster* (1863), 4 De J. & S. 77, where an agreement had been made that L a user should be bound by the result of the action against Y the manufacturer, and Y did not appear, ROMER, J., refused to hear counsel on behalf of L or to stay the judgment in the Y action to give L an opportunity of applying to have the agreement set aside; *Edison v. Young*, 11 R. P. C. 489.

(*k*) *Edison v. Holland*, 3 R. P. C. 394, see also *Edison v. Holland*, 6 R. P. C. 286, C. A., and *United Telephone Coy. v. Fleming*, 3 R. P. C. 268; as to when indemnities are enforceable, see *Townsend v. Haworth* (1875), 48 L. J. (CH.) 770n.

There is no implied warranty that an article sold is not an infringement of a patent. *Montforts v. Marsden*, 12 R. P. C. 266.

(*l*) O. 11, r. 1 (*f*).

(*m*) *Badische, &c. v. Chemische Fabrik, &c.*, 20 R. P. C. 413, C. A.

(*n*) O. 11, r. 1 (*f*). See *Badische, &c. v. Johnson*, 12 R. P. C. 535, C. A., *Washburn & Moen v. Cunard Steamship Coy.*, 6 R. P. C. 398.

As to contents of affidavits, see *Badische, &c. v. Chemische Fabrik, &c. supra*, and 21 R. P. C. 533, H. L.

(*o*) *Badische, &c. v. Johnson, supra*; *Same v. Chemische Fabrik, &c., supra*.

(*p*) See *Washburn & Moen v. Cunard Steamship Coy., supra*.

(*q*) *Washburn & Moen v. Cunard Steamship Coy., supra*.

(*qq*) See also forms in Appendix.

(*r*) As to what title the plaintiff must show, see p. 165.

The allegation that the patent was duly assigned means that all things

usually that the patent is valid (s). He then alleges infringement by the defendant of the patent or patents sued on.

In certain cases, where the plaintiff has claimed to have patented all practicable methods of manufacture of the substance alleged to be an infringement, he has been allowed to sue on several patents in the same action alleging infringement of each, though in fact some only could have been infringed (t).

The plaintiff is required to deliver with his statement of claim particulars of breaches, which shall state which of the claims are alleged to be infringed, and shall give at least one instance of each type of infringement of which complaint is made (u). The particulars must be in such form that the instances which will be relied on at the trial are clearly set out, though general words may be added reserving the right to

Particulars of Breaches.

necessary for perfecting the title, including registration if necessary, have been done. *Chollet v. Hoffman* (1857), 26 L. J. (Q. B.) 249.

This allegation may be simply traversed in the defence, as the particulars of objections refer to validity only, *ibid.*

(s) See p. 188.

(t) In *Saccharin Corporation Ltd. v. Quincey*, 17 R. P. C. 257, the plaintiff alleged infringement of twelve patents.

In *Saccharin Corporation Ltd. v. Dawson*, 19 R. P. C. 169, the plaintiff alleged infringement of five patents.

In *Saccharin Corporation Ltd. v. Wild*, 20 R. P. C. 243, C. A., the infringement of twenty-three patents was alleged, but an order was made by the C. A. confining the plaintiff to three patents. The former cases were discussed.

In *Saccharin Corporation Ltd. v. White*, 20 R. P. C. 454, C. A., the plaintiffs sued on twenty-three patents but were limited by the Court of Appeal to seven on special terms. The judgment in the former case was explained.

In *Saccharin Corporation Ltd. v. Jackson*, 20 R. P. C. 611, the plaintiffs sued on twenty-three patents. The defendants had not sought to limit the number.

In *Saccharin Corporation Ltd. v. Ross*, 22 R. P. C. 246, the plaintiffs sued on seven patents.

See also *Saccharin Corporation Ltd. v. Alliance Chemical Coy., Ltd.*, 22 R. P. C. 175, C. A., where plaintiffs were allowed to interrogate before

electing which patents they would rely on.

(u) O. 53a, rr. 13, 16.

The Court will, however, not generally interfere where the plaintiff alleges infringement of several or all the claims, this being a question of costs. See *Wenham Coy. v. Champion Gas Lamp Coy.*, 8 R. P. C. 22.

Inspection may in a proper case be ordered before delivery of the statement of claim in order to allow the plaintiff to particularise the claims infringed. *Edler v. Victoria Press*, 27 R. P. C. 114.

The Court will not order particulars as to the portions of the specification which describe the alleged infringement. *Cheetham v. Oldham & Fogg*, 5 R. P. C. 624; *Egleton v. Nicholls*, 7 R. P. C. 423; *Walter Church Engineering Coy. v. Wilson*, 3 R. P. C. 123. See also *Electric Telegraph Coy. v. Nott* (1847), 16 L. J. (C. P.) 174; *Batley v. Kynoch* (1874), L. R. 19 Eq. 229. *Casella v. Levinstein*, 8 R. P. C. 472.

An unreported case to the contrary effect was quoted in *Batley v. Kynoch, supra.*

Nor will the Court order particulars for the purpose of showing how the plaintiff proposes to argue his case, if the infringing article is properly identified. *Talbot v. La Roche* (1854), 15 C. B. 310; *Wenham Coy. v. Champion Gas Coy., supra*; but see note, *infra.* See also *Jones v. Lee*, 25 L. J. (EX.) 241, and *Saccharin Corporation v. Alliance Chemical Coy.*, 22 R. P. C. 175, C. A.

ultimately claim relief for any further infringements which may be brought to light on discovery (*x*).

The object of these particulars is to identify the acts complained of, and they should not throw on the defendant the task of construing the patent in order to find out what is meant (*y*), but, on the other hand, if the identification is complete the defendant cannot require the plaintiff to say how he will make out his case (*z*). Generally the plaintiff is not allowed to give evidence outside of his particulars, but the Court has a discretion to allow this (*a*). The Court has also of course the power to allow amendment (*b*).

It is usual to specify the dates of the acts complained of, though in some cases this is not insisted on till after discovery (*c*).

Defence.

The defendant by his defence usually raises the issue of non-infringement. The defence should make it clear whether what is denied is that the acts alleged in the particulars of breaches have been committed, or that the articles or processes therein mentioned come within the claims of the Letters Patent, or both.

The plea of leave or licence should be specifically raised if it is intended to rely on it, but it must be remembered that the onus of showing that the articles are not manufactured by the plaintiff or his agent lies on the plaintiff, so that if

(*x*) It is doubtful whether the form of order in *Talbot v. La Roche* (1854), 15 C. B. 310, and *Tilghman's Patent Sand Blast Coy. v. Wright & Butler*, 1 R. P. C. 103, would now be followed.

Where the action is on a patent which has been in part prolonged the plaintiff must make it clear whether he is suing on the original patent or the prolonged patent or on both. *Marconi v. Siemens*, 29 R. P. C. 147, C. A.

(*y*) See *Marsden v. Albrecht*, 27 R. P. C. 785, C. A. See also *Casella v. Levinstein*, *supra*; *Patent Type Foundry Coy. v. Richards* (1860), 2 L. T. 359, but *cf. Actiengesellschaft, &c. v. Levinstein*, 29 R. P. C. 677, C. A.

The decision in *Marsden v. Albrecht*, *supra*, would probably be held to overrule *Talbot v. La Roche*, *supra*.

In *Haslam v. Hall*, 5 R. P. C. 144, C. A., it was stated that it was for the defendant who applied for further particulars to show that these are really necessary. But see *Thermos*

*Ltd. v. Isola Ltd.*, 27 R. P. C. 195, C. A.

Greater particularity as to the process alleged to be used will be required in the case where the defendant is a seller than when he is the manufacturer. *Mandelberg v. Morley*, 10 R. P. C. 256.

See also *United Telephone Coy. v. Fleming*, 3 R. P. C. 268, where the plaintiff limited his particulars so as to exclude certain articles bought by the defendants from third parties.

(*z*) *Wenham Coy. v. Champion Gas Coy.*, *supra*.

(*a*) O. 53a, r. 21, see also p. 177, *nn. (b) &c.*

The discretion to allow evidence outside the particulars without amendment is seldom exercised. As to admission of evidence showing intention to infringe, see p. 187, *n. (b)*.

(*b*) For a case where this was exercised, see *Nobel v. Jones* (1880), 50 L. J. (CH.) 339.

(*c*) *Russel v. Hatfield*, 2 R. P. C. 144.

the licence relied on is the implied licence derived from a purchase from the plaintiff or his agent, this issue can be raised by a simple traverse (*d*).

The defendant may of course challenge the plaintiff's title (*e*), and the defence usually asserts that the patent is invalid by reason of the matters appearing in the particulars of objections (*f*). There are, however, certain pleas which are more properly raised in the defence itself. These include the allegations that the patented articles are wholly or mainly manufactured abroad (*g*), and that the requirements of the public have not been properly met (*h*). A plea based on the insertion of restrictive clauses in licences should also appear in the defence (*i*).

As in the case of particulars of breaches, the function of the particulars of objections is to identify the issues to be raised, and the facts relied on, not to argue the defendant's case (*k*). Particulars of objections.

It cannot be said that the points raised by all the different forms of particulars of objection are clearly distinguished from one another, and there are cases in which it is difficult to say in which form an objection should be raised. Unfortunately little assistance can be gained from the older cases, when pleadings were stricter than at present, since the practice of the Courts as to what is covered by the various forms of objection has changed so widely that these decisions have little or no application.

Taking first the objections dealing with want of novelty, these are nearly always raised in the double form that the alleged invention for which the patent was granted was not new, nor was it subject-matter for Letters Patent. These two objections are often indistinguishable, since either is usually held to raise the question that in view of what was known before there was no invention in what is claimed by the patentee (*k*). The objection of want of subject-matter would, Novelty.

(*d*) *Badische, &c. v. Dawson*, 6 R. P. C. 387; *Bells v. Wilmott* (1870), 6 Ch. App. 239.

(*e*) As the register is *prima facie* proof of this, little is gained by a formal traverse of title.

(*f*) O. 53a, r. 14. It has been said that these particulars do not constitute individual issues. *R. v. Mill* (1851), 20 L. J. (c. P.) 16.

As to the position where only one

of several defendants puts in particulars of objections, see *Cropper v. Smith*, 2 R. P. C. 17, H. L.

(*g*) See Chapter XVI., and as to particulars, p. 174.

(*h*) See p. 251.

(*i*) See p. 249, as to particulars required, see O. 53a, r. 10.

(*k*) See *Riekmann v. Thierry*, 14 R. P. C. 105, H. L., and remarks of



however, raise the further objection that the invention claimed was not a manufacture at all, *e.g.* in the case of a system of advertising, etc. (*l*).

It is sometimes suggested that want of subject-matter means that there is nothing new in view of common general knowledge, while want of novelty would mean that the invention has been anticipated by some individual suggestion or user. This distinction has not, however, been observed by the Courts.

General  
common  
knowledge.

The defendant is always entitled to plead generally that the alleged invention was not new or subject-matter for Letters Patent in view of the general common knowledge, without giving particulars of what that knowledge was or the evidence on which he will rely (*m*). It would seem doubtful if it is even necessary to plead general common knowledge if the objection of want of novelty is raised on other grounds, since both the patent itself and any anticipations relied on will be read in the light of such general common knowledge (*n*).

But though no particulars need be given of general common knowledge or practice, since this is matter presumably equally in the cognisance of all parties, the evidence allowed to be adduced under such objection is strictly confined to matters showing what was *generally* known or done, as, for example, references to text-books in general use or to the practice of a large portion of the trade, and it is not permissible to introduce references to, say, an isolated practice in one workshop. So, too, a specification or a scientific paper would not be admissible evidence under this objection (*o*).

Questions have arisen as to how far particulars are necessary when a practice which is general only in certain localities is pleaded, and the cases on this point are at variance. Probably, however, such practice may be pleaded without particulars

LINDLEY, L.J., and of Lord DAVEY in *Morris v. Young*, 12 R. P. C. 455, H. L.

(*l*) See p. 255 (*g*); and see *Bush v. Fox* (1856), 24 L. J. (EX.) 251, H. L.; *Spencer v. Jack* (1864), 3 De G., J. & S. 346; *Spilsbury v. Clough* (1842), W. P. C. 255.

(*m*) *Holliday v. Heppenstall*, 6 R. P. C. 320, C. A.; *Boxwell v. Cochrane*, 12 R. P. C. 169; *Siemens v. Karo*, 8 R. P. C. 377; *Z. Electric Lamp Coy. v. Marples*, 26 R. P. C. 762, C. A.

It is sufficient if the knowledge is

shown to be common in the trade to which the invention relates. Where it is intended to rely on the common knowledge of other trades this should be stated. *Fox v. Astrachans Ltd.*, 27 R. P. C. 377.

(*n*) See *per* Lord DAVEY in *Morris v. Young*, 12 R. P. C. at p. 460, H. L.; but *cf.* *Philips v. Ivel Cycle Coy.*, 7 R. P. C. 82.

(*o*) See p. 57, *n.* (*k*); *Ticklepenny v. Army & Navy Stores*, 5 R. P. C. 405, and *Peckover v. Rowland*, 10 R. P. C. 118.

since it is part of general common knowledge, and the reference to locality only serves to define the particular subjects to be dealt with (*p*).

Where the objection of want of novelty is to be supported by references to individual publications or users, these must be strictly defined. If the publication exists in a printed form, particulars of this must be stated, and where possible these particulars must show what parts of the publications are relied on (*q*). Particulars of the date and place of publication must also be given (*r*). In the case of an allegation of prior user even greater strictness is required (*s*). Not only must the place and time be stated, but also the names of the person or persons who are alleged to have made such prior user and whether such prior user continued down to the date of the patent, or if it did not a statement of the earliest and latest dates on which such prior user is alleged (*t*). Further, the

Individual  
Publications.

(*p*) A plea of anticipation by the "use of starch prepared from rice flour which was known and practised by persons engaged in the manufacture and finishing of lace and similar fabrics at Nottingham." Held, sufficient. *Jones v. Berger* (1843), W. P. C. 544.

So prior user "by candlemakers generally in the vicinity of London" held good. *Palmer v. Wagstaff* (1853), 22 L. T. 295. (But see *Palmer v. Cooper* (1853), 8 Ex. 840, 9 Ex. 231.)

The plea that certain facts were generally known to winders in Manchester, Rochdale, Middleton, and certain other (named) towns held good. *Boyd v. Horrocks*, 3 R. P. C. 285.

But user by "carriage builders generally throughout Great Britain or in or near London, Liverpool, or other great towns" held too vague. *Morgan v. Fuller* (1866), L. R. 2 Eq. 297.

"Use by A B and divers other persons within the Kingdom and elsewhere" held bad. *Fisher v. Dewick* (1838), W. P. C. 551 n.

Prior alleged user "inter alia at Sheffield, Birmingham, and London." Further and better particulars ordered. *Holland v. Fox* (1852), 1 W. R. 448.

Probably in these latter cases the particulars would be held sufficient if so drawn as to show that general

and not individual practice was relied on.

(*q*) For cases in which an order has been made to identify passages relied on, see *Harris v. Rothwell*, 3 R. P. C. 243; *Fowler v. Gaul*, 3 R. P. C. 247; *Holliday v. Heppenstall*, *supra*; *Heathfield v. Greenway*, 11 R. P. C. 17.

But if the Court is of opinion that the defendant honestly relies on the whole of certain specifications they will not bind his hands further. *Sidebottom v. Fielding*, 8 R. P. C. 266; *Siemens v. Karo*, *supra*; *Nettlefold v. Reynolds*, 8 R. P. C. 410; *Edison Bell Phonograph Coy. v. Columbia Coy.* 18 R. P. C. 4.

(*r*) See *Aktiebolaget Separator v. Dairy Outfit Coy.*, 13 R. P. C. 725; *Holliday v. Heppenstall*, *supra*; *Heathfield v. Greenway*, *supra*.

(*s*) These requirements are contained in O. 53a, r. 18. This rule only applies to information which the defendant can in fact give, since the obligation is only to give the best particulars in the defendant's power. Per EADY, J., in *Minerals Separation, Ltd. v. Ore Concentration Coy., Ltd.*, 26 R. P. C. at p. 418. See also *Bentley v. Keighley* (1844), 13 L. J. (C. P.) 169.

(*t*) If the prior user was not continuous definite dates of user should also be given where possible. *Smith v. Lang*, 7 R. P. C. 148.

particular thing used must be identified by aid of a description, and a drawing if necessary, and in the case of any machinery or apparatus a statement must be made whether the same is in existence and whether it can be inspected (*u*). The defendant is also bound to offer inspection of such apparatus if in his possession, or if not he must use his best endeavours to obtain inspection of the same for the plaintiff (*v*).

True and first inventor.

Another plea by which want of novelty was formerly raised was by alleging that the patentee was not the true and first inventor. Although an objection in the same form is continually pleaded it generally raises no real issue, as unless particulars are given of the person who was the true and first inventor no evidence can be given by the defendant under this objection (*x*). It is, however, a proper form if the defendants wish to raise the case that the patentee had in fact obtained the invention from some other person (*y*).

Insufficiency and non-utility.

Two other objections which the practice of the Courts has rendered it difficult to clearly distinguish are those of non-utility and insufficiency of description. The objection of non-utility raises the issue that the invention as described will not work or will not do what it is said to do, and may also raise the further issue that no improvement has in fact been made (*z*).

(*u*) The object of these particulars is identification of what was done, and not the disclosure of the defendant's case, and the information to be given may depend on the terms of the patent. Thus, in the case of a patent which claimed the use of oil generally in a process, an order for particulars of the kind of oil used in an alleged prior user was refused. *Minerals Separation, Ltd. v. Ore Concentration Coy., Ltd.*, 26 R. P. C. 413. See also *Crosthwaite Fire Bar Syndicate v. Senior*, 26 R. P. C. 260; *Scott v. Hull Steam Fishing Coy.*, 13 R. P. C. 206; *Brown's Patent*, 23 R. P. C. 792; *Boyd v. Farrar*, 5 R. P. C. 133; *Siemens v. Karo*, *supra*; *Sidebottom v. Fielden*, *supra*.

"Apparatus" does not include such things as minerals operated on, and inspection of these need not be given. *Minerals Separation, Ltd. v. Ore Concentration (1905), Ltd.*, *supra*.

Where the actual apparatus can be seen and examined a description and drawing need not be given. *Crosthwaite Fire Bar Syndicate v. Senior*, *supra*.

(*v*) O. 53 (a), r. 18.

(*x*) See *Poultton v. Adjustable Cover Coy.*, 22 R. P. C. 593, where, although it was pleaded that S. was first and true inventor, a communication by him to a person other than the patentee was not admitted in evidence.

There were older decisions to the contrary, see *Russell v. Ledsam* (1843), 12 L. J. (EX.) 439, and cases there quoted, but these would not now be followed.

This form should not now be used merely to raise issue of novelty. *Hill v. Thomas*, 24 R. P. C. 424, C. A.; *Morgan v. Windover*, 7 R. P. C. 449; *Thomson v. Macdonald*, 8 R. P. C. 9; *Hickson v. Redfern*, 22 R. P. C. 307; *Pneumatic Tyre Coy. v. Casswell*, 13 R. P. C. 187; *Smith's Patent*, 29 R. P. C. 340.

(*y*) *Hill v. Thomas*, *supra*.

(*z*) See chapter on UTILITY, and especially p. 80.

MAULE, J., expressed the view that this plea also raised the point that the manufacture was one that would be suppressed as injurious. *Bedells v. Massey* (1844), 13 L. J. (C. P.) 173.

The objection of insufficiency of description raises the issue that necessary directions are left out. The distinction in this case is of special importance since particulars are not required under the objection of non-utility (a), while very strict particulars have to be given in the case of a plea of insufficiency of description (b).

A case may arise where the defendant has carried out the invention as described in the specification, but has been unable to obtain a successful result. It may well be that he has no knowledge of the reasons of failure, and it would seem an unreasonable burden to say that he must point out what are the directions which the patentee should have given (c).

It would seem doubtful whether in any case further particulars would be ordered of the objections that the specification does not sufficiently define the nature of the invention, or does not distinguish what is new from what is old (d).

The obligation of the patentee is not only to give sufficient directions to attain a successful result, but also to give the best directions in his power (e). The objection of want of good faith in giving directions has not been discussed in many

(a) This is the general rule of practice, but see *Presto Collar Coy. v. Levy Brothers*, 28 R. P. C. 362, C. A. It must be remembered that the defendant does not know what the plaintiff will allege to be the advantages of the invention, and should therefore be allowed to traverse them generally.

(b) For reported cases in which further particulars of insufficiency were ordered, see *Heathfield v. Greenway*, 11 R. P. C. 17; *Birch v. Harrap*, 12 R. P. C. 431; *Crompton v. Anglo-American Brush Coy.*, 4 R. P. C. 179.

But an objection that the specification gives no sufficient directions to enable a skilled workman to carry the invention into effect is sufficient. It is not the defendant's business to say what ought to have been inserted. *Z Electric Lamp Coy. v. Marples*, 26 R. P. C. 762, C. A. See also *Crompton v. Anglo-American Brush Coy.*, 4 R. P. C. 200, C. A.

So, too, where the objection is that the specification does not sufficiently define the invention no further particulars need be given. *British Ore Concentration Coy. v. Minerals Separation Coy.*, 24 R. P. C. 798. See also *Heath v. Unwin* (1842), 12 L. J. (EX.) 47.

Where, however, non-utility was pleaded, and there was also an objection setting out several passages of the specification where the directions were insufficient, the petitioners were not allowed to raise objections to other passages under the objection of non-utility. *Tieman's Patent*, 16 R. P. C. 567. See also *Thermit, Ltd. v. Weldite, Ltd.*, 24 R. P. C. 441.

(c) See on this point *Z Electric Lamp Coy. v. Marples*, 26 R. P. C. 762, C. A.

In *Badische, &c. v. Société des Usines de Rhone*, 14 R. P. C. 875, where the defendants had pleaded non-utility, and at the trial it appeared that the invention worked with certain apparatus, but not with the apparatus employed by the defendants, though this was within the directions in the specification, WILLS, J., held defendants could not raise this point under the objection of non-utility. It is submitted that this decision was erroneous.

(d) *British Ore Concentration Coy. v. Minerals Separation Coy.*, 24 R. P. C. 790. But see *Boxwell v. Cochran*, 12 R. P. C. 170.

(e) See Chapter on SUFFICIENCY, p. 96.

modern cases, but it would appear to be covered by the ordinary objection of insufficiency (*f*).

Discon-  
formity.

In the case of disconformity clear particulars must be given of the respects in which the complete specification varies from the provisional (*g*). There is no decision as yet as to how the form of pleading is affected by the new provision that disconformity shall not affect the validity of the patent if the patentee was in fact the true and first inventor of the added portion, and such portion was new at the date of the complete specification (*h*). Strictly it would seem that the plaintiff should bring himself within the exception by pleading these facts in his reply, and the defendant should then rejoin if he disputes the novelty, but probably from considerations of convenience the objections to the novelty, etc., would be raised in the particulars of objections delivered with the defence.

Prior grant.

Where the defendant wishes to rely upon a prior grant, this must be distinctly stated (*i*), and of course particulars of the grant relied on must be given.

Other  
objections.

An objection that if the specification were so construed as to include the alleged infringement the patent would be bad as including what was old, is not embarrassing, but is unnecessary, since the same issues are raised by the plea of non-infringement and the objection of want of novelty (*k*).

Another objection is that the claim is larger than the invention (*l*).

Non-working.

Where the defence is raised that the patented articles are wholly or mainly made abroad, proper particulars must be given, in order to enable the plaintiff to see what is the case he has to meet and to limit discovery, so that the defendant may not have general discovery on a fishing case (*m*). Thus

(*f*) See *Plimpton v. Malcolmson* (1875), 3 Ch. D. 531; *Thomson v. Batty*, 6 R. P. C. 100.

(*g*) See *Anglo-American Brush Corporation v. Crompton*, 4 R. P. C. 27, C. A.; *Heathfield v. Greenway*, 11 R. P. C. 17; *Boyd v. Horrocks*, 3 R. P. C. 285.

(*h*) Sect. 42.

(*i*) *Rothwell v. Macintosh*, 12 R. P. C. 274; *Blackett v. Dickson*, 26 R. P. C. 730, O. H.; *Birmingham Pneumatic Tyre Coy. v. Reliance Tyre Coy.*, 17 R. P. C. 277.

(*k*) *Hocking v. Hocking*, 3 R. P. C. 291.

In *Bailey v. Robertson* (1877), 3 A. C. at p. 1081, the H. L. varied the judgment below so as to read "the complete specification if large enough to cover the use of bi-sulphite would claim an invention," etc. See also *Morris v. Young*, 12 R. P. C. 457, 464, H. L.

(*l*) *Flour Oxidising Coy. v. Hutchinson*, 26 R. P. C. 599.

Particulars were ordered of this plea in *Boxwell v. Cochran*, 12 R. P. C. 170. See also pp. 19, 20.

(*m*) *Thermos Ltd. v. Isola Ltd.*, 27 R. P. C. 195, C. A. overruling *Thermos Ltd. v. British Caloris Coy.*, 26

the defendant has been ordered to state whether the articles which he alleges were wholly or mainly manufactured abroad were the articles sold in this country, and where such articles are alleged to be manufactured and by whom (*n*), he has also been ordered to give particulars as to which of the patented processes he alleges was used in the manufacture of such articles (*o*).

Where the attack is on the scope of one or more claims these should be specified (*p*), and in other cases the parts of the specification objected to should be indicated where possible (*q*). But it is not the object of the particulars to show how the defendant proposes to make out his case (*r*), and it is advantageous to keep the objections in the simplest forms, e.g. the said invention was not new, was not useful, was not subject-matter, rather than to condescend to argumentative details such as "the principle was known" or "the invention only differs by the use of equivalents from." Such variations from common form often lead to orders for further particulars (*s*).

Similar particulars may be ordered in cases not coming within the rules, e.g. in threats actions (*t*) or actions for royalties (*u*).

Amendments of the particulars of objections before the

R. P. C. 827. See also *Vidal Dyes Syndicate v. Read Holliday & Coy.*, 28 R. P. C. 323, C. A.

(*n*) *Thermos Ltd. v. Isola Ltd.*, *supra*; *Saccharin Corporation Ltd. v. National Saccharin Coy.*, 26 R. P. C. 737; 27 R. P. C. 354, C. A.; *Colman v. Cook & Coy.*, 29 R. P. C. 175, where particulars were also ordered as to the times when such manufacture commenced.

(*o*) *Saccharin Corporation Ltd. v. National Saccharin Coy.*, *supra*.

(*p*) O. 53a, r. 17.

(*q*) E.g. where insufficiency is alleged. This is the invariable modern practice, see *inter alia Boyd v. Horrocks*, *supra*; *Birmingham Pneumatic Tyre Coy. v. Reliance Tyre Coy.*, 17 R. P. C. 277; *Harris v. Rothwell*, 3 R. P. C. 253. See also *Birch v. Harrap*, 12 R. P. C. 431; *Law v. Ashworth*, 7 R. P. C. 86; *Fisher v. Dewick* (1838), 4 Bing. N. C. 706; but if the defendant wishes to rely on the objections against all the claims he is entitled to do so. *Edison Bell*

*Phonograph Corporation v. Columbia Phonograph Coy.*, 18 R. P. C. 4.

This practice was to some extent departed from in *Boyd v. Farrar*, 5 R. P. C. 33.

(*r*) *Brown's Patent*, 23 R. P. C. 792, C. A.; *Heath v. Unwin* (1842), 12 L. J. (EX.) 47.

(*s*) See for example *Boyd v. Horrocks*, 3 R. P. C. 285; *Birch v. Harrap*, 12 R. P. C. 431; *Darraah v. Purser*, 6 R. P. C. 306.

(*t*) *Wren v. Weild* (1869), 38 L. J. (Q. B.) 327; but see **THREATS**, p. 228, *n.* (*u*), and *Nadel v. Martin*, 20 R. P. C., *per* COZENS-HARDY, L.J., at p. 733. See also *Smith v. Lange*, 7 R. P. C. 145.

(*u*) *Jones v. Lee* (1856), 25 L. J. (EX.) 241.

So in an action for specific performance where the real issue was as to the validity of a patent, particulars of objection were ordered, *Hazlehurst v. Rylands*, 9 R. P. C. 1.

Form of  
particulars.

Particulars in  
other actions.

Amendment  
of particulars  
of objection.

trial is usually allowed on the terms that the plaintiff is given six weeks from the delivery of the amended particulars in which to elect whether he will discontinue the action or not, and in the event of discontinuance he pays the costs to the date of the delivery of the first particulars, but gets any costs incurred by him since such date (x). Where amendment is sought at the hearing the terms are more onerous (y). The Court of Appeal, though it has power to allow amendment of the particulars of objections, will generally not

(x) This order was first made in the case of *Baird v. Moules Patent Earth Closet* (1876), 17 Ch. D. 137 n., and has been subsequently followed in many cases, including *Aveling v. Maclaren* (1880), 17 Ch. D. 139 n.; *Edison Telephone Coy. v. India Rubber Coy.* (1880), 17 Ch. D. 137; *Ehrlich v. Ihlee*, 4 R. P. C. 115; *Darrah v. Purser*, 6 R. P. C. 365.

Where there is a second amendment before issue joined the date from which the costs are to be the plaintiff's is that of the delivery of the first amended particulars. *Wilson Brothers Ltd. v. Wilson & Coy.*, 16 R. P. C. 315; *aliter* if issue has been joined, *Ehrlich v. Ihlee*, *supra*.

The discretion of the judge as to the terms on which amendment is allowed will not be interfered with. *Wilson Brothers Ltd., v. Wilson & Coy.* *supra*, approving *Wooley v. Broad*, 9 R. P. C. 208.

In *United Telephone Coy. v. Bassano*, 2 R. P. C. 70, leave to amend was given on simply paying the costs of the application.

A similar order was made in *Parker v. Maigen's Filter Coy.*, 5 R. P. C. 207, the plaintiff electing to continue after amendment. See also *Kelly v. Heathman*, 7 R. P. C. 343; *Otto v. Steel*, 2 R. P. C. 139.

The Courts discourage an amendment raising the question of validity for the first time on the eve of trial, see *Sugg v. Bray*, 1 R. P. C. 45, though leave is sometimes granted, see *United Telephone Coy. v. Bassano*, *supra*.

Leave to amend should always be given where the defendant has discovered facts which he could not have discovered earlier. *Per* JESSEL, M.R., in *Holste v. Roberston* (1877), 4 Ch. D. 9. See also *Moss v. Malins*, 3 R. P. C. 375.

(y) Where non-infringement only is

pleaded the Court will not generally allow the issue of invalidity to be raised by amendment at the hearing, see *Shrewsbury & Talbot v. Sterckx*, 12 R. P. C. 336; *Sugg v. Bray*, *supra*; *Edison Electric Light Coy. v. Shippey*, 4 R. P. C. 472; but *cf.* *United Telephone Coy. v. Bassano*, *supra*.

For a case where the evidence was admitted practically without terms, see *Pascall v. Toope*, 7 R. P. C. 125. See also *Hills v. Adams*, 10 R. P. C. 104; *Lifeboat Coy. v. Chambers*, 8 R. P. C. 422.

In *Chadburn v. Mechan*, 12 R. P. C. 120, ROMER, J., offered to allow an amendment of the particulars attacking certain claims on new grounds on the terms that if the plaintiff elected to disclaim he should get the costs thrown away.

In *Solvo v. Mackie*, 10 R. P. C. 68, leave to amend was given at the trial on the terms of *Edison Telephone Coy. v. Indiarubber Coy.*, *supra*.

In *Allen v. Horton*, 10 R. P. C. 412, the defendant amended at the trial and proved a complete anticipation. He also succeeded on the grounds in the particulars, but the action was dismissed without costs on the ground that if the new matter had been pleaded in the first instance the plaintiff would not have gone on with the action. See also *Renard v. Levinstein* (1864), 11 L. T. 766 (leave given); *Peckover v. Rowlands*, 10 R. P. C. 118 (leave refused). *Otto v. Steel*, 13 R. P. C. 112 (leave given); *Badische, &c. v. Société des Usines du Rhone*, 14 R. P. C. 875 (leave given on special terms); *Moss v. Malins*, 3 R. P. C. 375 (leave refused); *Thermit, Ltd. v. Weldite, Ltd.*, 21 R. P. C. 455 (leave refused); *Edison v. Shippey*, *supra* (leave refused); *Crosthwaite v. Moorwood*, 11 R. P. C. 558 (leave given).

do so (z). Where an order for further and better particulars is made against the defendant, he cannot utilise this order for the purpose of adding new particulars (a).

The rules say that no evidence shall be admitted, except by leave of the Court or a judge, going beyond the particulars of breaches or objections (b). Cases have, however, occurred where the plaintiff's own evidence disclosed a fatal objection to the patent and the action has been dismissed, although the point was not raised in the objections (c).

The defendant may now claim revocation by way of counter-claim if entitled to present a petition (d). It is doubtful whether he can claim a declaration of invalidity (e).

The only case where a reply is in general necessary in a patent action is where the defendant relies on a prior grant, and the plaintiff then attacks the validity of such grant. In such case he must raise objections in the ordinary way (f).

### Discovery

The general practice in patent actions is to defer discovery relating to infringements, other than those specifically mentioned in the particulars of breaches, till after the plaintiff has obtained judgment (g). If the defendant alleges that he is working under a secret process discovery before trial tending to disclose this process will probably be refused (h), but documents relating

(z) *Shoe Machinery Coy. v. Cullan*, 12 R. P. C. 530, C. A.; *Andrews' Patent*, 24 R. P. C. 349, C. A.; 25 R. P. C. 490, H. L.; *Brown v. Hasties*, 22 R. P. C. 85, and 12 Sc. L. J. 131, I. H. But leave was given in *Pirrie v. York Street Flax Coy.*, 11 R. P. C. 431, C. A. (Ir.).

(a) *Akticbolaget Separator v. Dairy Outfit Coy.*, 13 R. P. C. 725.

(b) O. 53a, r. 21.

As to the admission of evidence going beyond the particulars without amendment, see *Britain v. Hirsch*, 5 R. P. C. 226, C. A. It would seem that this should only be allowed where the evidence goes to show common knowledge, as in *Appleby v. Eadie*, 16 R. P. C. 335. See also *Pascall v. Toope*, 7 R. P. C. 125; *Scott v. Hull Steam Fishing Coy.*, 13 R. P. C. 209, C. A.; *Daw v. Eley* (1865), L. R. 1 Eq. 38; *Renard v. Levinstein* (1864), 11 L. T. 766.

The Court will not consider evidence against the validity of a patent not coming within the particulars (unless admitted by leave), even if it has

been admitted on another issue. *British United Shoe Machinery v. Fussell*, 25 R. P. C., at p. 660, C. A.

In an old case where the only objection was that the invention was not new, and no particulars had been sought, it was held that the defendant could give specific instances of anticipation under this objection. *Hall v. Bolland* (1856), 25 L. J. (EX.) 302.

For cases of evidence being admitted as to matters not in the particulars of breaches, see *Dowling v. Billington*, 7 R. P. C. 191 (Ir.); but cf. *McClay v. Lawes*, 22 R. P. C. 199.

(c) E.g. *Germ Milling Coy. v. Robinson*, 3 R. P. C. 254, see last note.

(d) Sect. 32, and see REVOCATION, p. 211, nn. (a) & (c).

(e) See p. 217, n. (a) & p. 199, n. (g).

(f) See PRIOR GRANT, p. 76.

(g) See *Smith v. G. W. R. Coy.* (1854), 3 W. R. 69.

(h) *Rawes v. Chance*, 7 R. P. C. 275; *Carnegie v. Bell Brothers*, 24 R. P. C. 82, C. A.; but see *Ashworth v. Roberts*, 7 R. P. C. 451; *Benno Jaffe v. Richardson*, 10 R. P. C. 136.



to such process should be included in the affidavit and an objection made to produce them on the ground of the injury such production would cause (*i*).

Documents relating to former actions on the same patent, or to a petition to revoke the patent, are usually relevant and must be included in the affidavit, though, if they were brought into existence merely for the purpose of a communication to the solicitor in the former action, they may be privileged (*k*). There is no privilege attaching to communications to a patent agent unless these are privileged on other grounds, and where the solicitor to a party is also a patent agent he should state that the communications for which privilege is claimed were made to him as solicitor (*l*). Where documents in a defendant's possession relate merely to prior user they are part of his case and need not be disclosed (*m*). Where a party swears that certain documents are not relevant the affidavit cannot be attacked on the ground that their relevancy may depend upon the construction of the patent (*n*). Discovery will not generally be given before defence (*o*), and where the defendant wishes to allege prior user by the plaintiff himself he must do so generally and state that he cannot give further particulars until after discovery (*p*).

Interrogatories.

The object of interrogatories is to elicit facts or evidence, and the Courts will not permit interrogatories which would compel either party to swear to a construction of the patent (*q*).

Where utility is denied interrogatories are allowed as to whether in fact the patentee uses the patented machine or

(*i*) *Carnegie v. Bell Brothers, supra.*

(*k*) *Haslam v. Hall*, 5 R. P. C. 1; *Bown v. Sansom & Coy.*, 5 R. P. C. 510; *Thomson v. Hughes*, 7 R. P. C. 187. See also *Edison v. Holland*, 5 R. P. C. 213, C. A.

(*l*) *Moseley v. Victoria Rubber Coy.*, 3 R. P. C. 351.

(*m*) *Carnegie v. Bell Brothers, supra.*

(*n*) *Ibid.*

(*o*) *Woolfe v. Automatic Picture Gallery*, 19 R. P. C. 161, C. A.

(*p*) *Ibid.*

(*q*) *Bibby & Baron, Ltd. v. Duerden*, 27 R. P. C. 283, C. A. See also *Delta Metal Coy. v. Maxim*, 8 R. P. C. 169.

So a patentee cannot be asked if an alleged prior user was constructed as claimed in his patent (*ibid.*), or as to how he alleges that the defen-

dant's articles infringe his patent. *Moseley v. Victoria Rubber Coy.*, 3 R. P. C. 351.

Nor is an interrogatory admissible as to what useful addition he has made to public knowledge. *Erhlich v. Ihlee*, 5 R. P. C. 437.

On the other hand, interrogatories as to whether certain parts of the patented machine were not mere equivalents for other devices have been allowed (*Hoffmann v. Pastill* (1869), 4 Ch. App. 673); and interrogatories as to the meaning of technical terms in the specification were allowed in *Renard v. Levinstein* (1864), 11 L. T. 81.

In this case too, questions were permitted as to the meaning of the specification: but *cf. Bibby & Baron Ltd. v. Duerden, supra.*

process, or what modifications he has introduced (r). The plaintiff may be interrogated as to whether a certain person was not the true inventor of the patented process (s).

In the case of a company the directors are only bound in answering interrogatories to give the knowledge they have acquired as servants of the company, and not knowledge otherwise acquired (t). It has been said that greater scope should be allowed to the defendant than to the plaintiff in the matter of interrogatories (u). Where non-manufacture in this country, or the insertion by the patentee of improper clauses in licences, is relied on by the defendant, discovery will be strictly limited so as to defeat a fishing case (x).

Formerly, where infringement was not denied, the plaintiff was allowed to interrogate as to persons to whom defendant had sold (y), and a similar rule applied in the case of a licensee even where infringement was denied (z). These decisions would probably not now be followed.

Interrogatories as to infringement.

Interrogatories as to definite sales will be allowed unless infringement is admitted (a). The defendant may be interrogated as to whether he uses what is described in the specification, but whether he can be asked how his process differs from the patented process is a matter of discretion. The Court, while protecting trade secrets, does not give the defendant an absolute right to say that the question of validity must be tried first, especially if there are doubts as to the genuineness of the grounds of objection to answer (b).

Where the defendant is a user and says he does not know how the article is made, he may be ordered to give the name of the manufacturer if the Court is satisfied that this will enable the plaintiff to prove infringement (c).

The plaintiff is not allowed to interrogate before delivering his particulars of breaches, but he might in a proper case be

(r) *Renard v. Levinstein*, *supra*; *Rylands v. Ashley*, 7 R. P. C. 175, C. A.; but see *contra Jourdain v. Palmer* (1866), 12 Jur. (N. S.) 214.

(s) *Hoffmann v. Pastill*, *supra*.

(t) *Welsbach Incandescent Coy. v. New Sunlight Coy.*, 17 R. P. C. 401.

(u) *Hoffmann v. Pastill* (1869), 4 Ch. App. 673.

(x) See O. 53a, r. 10; *Vidal Dyes Syndicate Ltd. v. Read, Holliday & Sons*, 28 R. P. C. 323, C. A., and p. 174.

(y) *Tetley v. Easton* (1856), 25 L. J. (C. P.) 293.

(z) *Ashworth v. Roberts*, 7 R. P. C. 451.

(a) *Lister v. Norton*, 2 R. P. C. 68.

(b) See *Ashworth v. Roberts*, *supra*; *Benno-Jaffé v. Richardson*, 10 R. P. C. 136; *Renard v. Levinstein* (1864), 10 L. T. 94; *cf.*, however, *Badische Anilin und Soda Fabrik v. Levinstein*, 2 R. P. C. 73.

(c) *Saccharin Corporation, Ltd. v. Haynes*, 15 R. P. C. 344.

allowed after such delivery to interrogate with a view to amending (*d*).

Interrogatories as to prior user.

In view of the new rules dealing with allegations of prior user, interrogatories as to this will probably be infrequent (*e*). Interrogatories have been allowed as to the names and addresses of prior users even where such use has been pleaded as general use (*f*). Generally a defendant cannot be compelled by interrogatories to give all details of a machine, since it is not fair that the plaintiff should know exactly what is to be produced against him before starting his case (*g*).

### Inspection.

The Court has power to order inspection at the instance of either party (*h*). It will, however, protect parties against trade rivals using this process to discover trade secrets (*i*), and it is for the party seeking such inspection to show that it is really necessary for him to have it (*k*).

It is doubtful whether the Court can order machinery to be worked during inspection though such an order has been made (*l*), and in general no difficulty is raised on this point. It

(*d*) *Jones v. Platt* (1861), 7 Jur. (N. S.) 978; but see *Edler v. Victoria Coy.*, 27 R. P. C. 114.

(*e*) O. 53a, r. 18.

(*f*) *Alliance White Lead Coy. v. McIvor*, 8 R. P. C. 321.

Other cases where interrogatories to defendant as to prior user were allowed are: *Birch v. Mather* (1883), 22 Ch. D. 629; *Crossley v. Tomey* (1876), 2 Ch. D. 533; *General Electric Coy. v. Safety Lift Coy.*, 21 R. P. C. 109, where interrogatory as to present address of prior users allowed: see *contra*, *Flower v. Lloyd* (1876), 45 L. J. (CH.) 746, and 20 Sol. Jo. 860; explained in *Birch v. Mather*, *supra*, and as to limits of interrogatory, see *Daw v. Eley* (1865), 2 H. & M. 925.

(*g*) *Brown's Patent*, 24 R. P. C. 61, C. A. See also *Delta Metal Coy. v. Maxim*, 8 R. P. C. 169.

(*h*) Sect. 34.

(*i*) In *Swain v. Edlin*, 20 R. P. C. 435, the plaintiff, a trade rival, was not allowed to be present at the inspection.

In *Cheetham v. Oldham & Fogg*, 5 R. P. C. 617, 622, the plaintiff, though a trade rival, was allowed to attend.

See also *Colley v. Hart*, 7 R. P. C. at p. 104 (where a special order was

made); *Germ Milling Coy. v. Robinson*, 1 R. P. C. 217; *McDougall v. Partington*, 7 R. P. C. 216, C. A.

(*k*) *Ames v. Kelsey* (1853), 22 L. J. (Q. B.) 84; *Shaw v. Bank of England* (1852), 22 L. J. (EX.) 26; *Piggott v. Anglo-American Coy.* (1868), 19 L. T. 46; where it was stated that the plaintiff must also show that his case is not a hopeless one; *McDougall v. Partington*, *supra*; *Batley v. Kynoch* (1874), L. R. 19 Eq. 90.

Mere suspicion by the plaintiff that an infringing machine is being used is not sufficient; *Germ Milling Coy. v. Robinson*, *supra*; *Cheetham v. Oldham & Fogg*, *supra*; *Patent Type Foundry v. Lloyd* (1860), 5 H. & N. 192; *Shaw v. Bank of England*, *supra*.

(*l*) An order to this effect was made by KAY, J., in *Germ Milling Coy. v. Robinson*, 3 R. P. C. 254; but in *Drake v. Muntz Metal Coy.*, 3 R. P. C. 44, BACON, V.C., held he had no power to make such an order.

In *Rylands v. Ashley*, 7 R. P. C. 175, STIRLING, J., seemed to doubt if he could order this. Here the machine belonged to third parties. See also *Sidebottom v. Fielden*, 8

is also doubtful if inspection can be ordered on the premises of third parties (*m*). Where the defendant raises a question of prior user, he is bound to give or procure inspection if possible (*n*).

There also seems a doubt as to whether the Court can order an affidavit verifying the machine inspected (*o*) or the giving of samples to be tested in a way that would cause their destruction (*p*).

The proper time for inspection is in the discretion of the Court. Thus the Court may defer inspection till a preliminary point has been tried (*q*).

Inspection may in a proper case be ordered before the delivery of the statement of claim in order that the plaintiff may give proper particulars of breaches (*r*). The Court has power to give inspection of exhibits in its possession even to parties in another action (*s*).

### *Interim Injunction.*

On an application for an interim injunction the Court is unwilling to try any question of validity (*t*), and in recent years it has been very rare to grant such an injunction against the opposition of a defendant who denies validity, unless the plaintiff has already obtained a certificate of validity (*u*). But in proper cases the Court would probably still grant injunctions, where the old rule of the plaintiff being able to show considerable user over a long period without interference with his monopoly is satisfied (*x*). Where a certificate of validity has been obtained

R. P. C. 266, where BRISTOWE, V.C., refused the order on the ground that it was unnecessary.

(*m*) An order for inspection on the premises of licensees was made in *Germ Milling Coy. v. Robinson*, *supra*.

In *Rylands v. Ashley*, *supra*, the judge directed the plaintiff to apply to his licensees for permission which was given.

(*n*) O. 53*a*, r. 18.

(*o*) BRISTOWE, V.C., held that he had no power to order such an affidavit: *Drake v. Muntz Metal Coy.*, *supra*; but in *Singer v. Wilson* (1865), 13 W. R. 560, an order was made for the defendants to make an affidavit of all machines exposed for sale between certain dates and to produce one of each type to the plaintiff's agent.

(*p*) See *Patent Type Foundry v. Lloyd* (1860), 5 H. & N. 192.

(*q*) *McDougall v. Partington*, 7 R. P. C. 217, C. A.

(*r*) *Edler v. Victoria Coy.*, 27 R. P. C. 114.

(*s*) *Smith v. Lang*, 7 R. P. C. 150, C. A.

(*t*) See cases in *n.* (*x*), *infra*.

(*u*) *Spencer v. Holt*, 20 R. P. C. 142; *Bovill v. Goodier* (1866), 35 Beav. 427; *Holophane Ltd. v. Berend*, 15 R. P. C. 18.

(*x*) See on the general principle: *Caldwell v. Van Vlissingen* (1851), 9 Hare, 415, 424; *Spencer v. Holt*, *supra*; *Newall v. Wilson* (1852), 2 De G. M. & G. 282; *Clarke v. Ferguson* (1859), 5 Jur. N. S. 1155; *British Tanning Coy. v. Groth*, 7 R. P. C. 1.

The fact that there is now a Patent Office search does not entitle the patentee to an interim injunction. *Zenith Motors Ltd. v. Collier*, 28 R. P. C. 563.

the Court will in general grant an interim injunction unless it is convinced that there is substantial fresh evidence on the question of validity (z), or unless the Court which tried the original action has granted a stay of the injunction pending appeal (a). The plaintiff must, of course, file evidence as to the novelty of the invention (b), and the Court also requires that the plaintiff should make out at least a *prima facie* case of infringement (c). Such an injunction will only be granted

The following are some cases in which an interim injunction has been granted, before the validity of the patent had been established, with period of enjoyment: *Bickford v. Shives* (1837), W. P. C. 211, six years; *Stevens v. Keating* (1847), 2 W. P. C. 175, twelve years; *Muntz v. Foster* (1834), 2 W. P. C. 93, eleven years; *Shillito v. Larmuth*, 2 R. P. C. 1, ten years; *Read v. Andrew*, 2 R. P. C. 119, thirteen years; *Gardner v. Broadbent* (1856), 2 Jur. (N. S.) 1041, one year (a very doubtful case); *Wheatstone v. Wild* (1861), Griffin, 247; *Rothwell v. King*, 3 R. P. C. 279, six years; *Bracher v. Bracher, Dean & Coy.*, 7 R. P. C. 420, twelve years; *Natural Colour Kinematograph Coy. v. Speer*, 29 R. P. C. 669, four years. See also *Briggs v. Lardeur*, 1 R. P. C. 126, 192, C. A., and notes to *Electric Telegraph Coy. v. Nottingham* (1847), 2 C. & C. 41, for further list of cases.

In *Shillito v. Larmuth*, *supra*, and *Briggs v. Lardeur*, *supra*, it was said that an injunction would be granted on an old and largely used patent unless on the face of it it was hopelessly bad.

The following are some cases in which interim injunctions have been refused on the ground that the patent was too new or user insufficient: *Jackson v. Needle*, 1 R. P. C. 174, C. A., seven months; *Holophane Coy. v. Berend*, 15 R. P. C. 18, five years; *Zenith Motors Ltd. v. Collier*, 28 R. P. C. 63, four years; *Hill v. Thompson* (1817), W. P. C. 229, two years; *Trautner v. Patmore*, 29 R. P. C. 63, one year.

An injunction was refused even where the patent was twelve years old, and there had been large user in view of a substantial case as to invalidity. *Saccharin Corporation v. Chemical & Drugs Coy.*, 15 R. P. C. 53.

In *Lister v. Norton*, 1 R. P. C. 114, CHITTY, J., expressed the view that three years' user was too little for an interim injunction.

The user to be shown must be substantial public user. *Plimpton v. Malcolmson* (1875), L. R. 20 Eq. 37.

The user must also have been undisturbed. See *Collard v. Allison* (1839), 4 My. & C. 487.

But where the only disturbance had been by persons who ceased using, apparently at the plaintiff's request, the user was considered undisturbed. *Rothwell v. King*, 3 R. P. C. 379.

Where the defendant has not appeared, an interim injunction will be granted even in the case of a recent patent. *Pneumatic Tyre Coy. v. Ferguson*, 11 R. P. C. 459; *Clark v. Nicholls*, 12 R. P. C. 350.

In *Coles v. Bayliss*, 3 R. P. C. 178, an injunction was granted where the judge doubted whether what was alleged by the defendant was in law an objection, *cf. Pessers v. Moody*, 26 R. P. C. 68.

(z) See *Edison v. Bernstein*, 14 R. P. C. 33; *Welsbach Incandescent Coy. v. Vulcan Coy.*, 18 R. P. C. 279.

(a) The mere fact of an appeal being pending will not necessarily prevent the Court from acting. *Moser v. Sewell*, 10 R. P. C. 365.

In *Collard v. Allison* (1839), 4 My. & C. 487, an interim injunction was refused where the plaintiff had succeeded at law, but a rule *nisi* for a new trial had been granted.

(b) This evidence should show belief in the novelty at the date of the affidavit, since matters affecting the question of novelty may have come to the plaintiff's notice since the date of the patent. *Hill v. Thompson* (1817), W. P. C. 229; *Sturz v. De La Rue* (1822), 5 Russ. 322.

(c) BRISTOWE, V.C., in *Shillito v. Larmuth*, 2 R. P. C. 1, thought a *prima facie* case of infringement sufficient. This view was also expressed by the majority of the Court in *Plimpton v. Spiller* (1876), 4 Ch. D. 286, C. A.

where the Court thinks that it is really necessary for the plaintiff's protection (*d*), and in order to entitle himself to an interim injunction the plaintiff must act promptly, any long delay being fatal (*e*). In a case which is on the border line the Court will sometimes take into account the balance of convenience and the probability of the defendant being able to

But in *Electric Telegraph Coy. v. Nottingham* (1847), 2 Ch. C. 41; and *Wood v. Cockerel* (1819), 2 Cooper & Cott. 58, Lord COTTENHAM expressed the view that unless there was no doubt, infringement as well as validity should have been established at law.

As to the sufficiency of an affidavit merely speaking of information, see *Badische, &c. v. Thompson*, 19 R. P. C. 503.

As to necessary evidence generally, see *Société Anonyme des Manufactures de Glace v. Tilghmann* (1883), 25 Ch. D. 1, C. A.

(*d*) Thus where the plaintiff had succeeded in another action and the defendant had offered an undertaking not to infringe until the trial, the motion was dismissed with costs. *Lyon v. Mayor, &c., of Newcastle*, 11 R. P. C. 218.

Again, where a satisfactory undertaking had been offered between the writ and the notice of motion the judge refused to give the plaintiffs the reserved costs of the motion. *Perry v. La Société des Lunetiers*, 13 R. P. C. 664. See also *Dunlop Pneumatic Tyre Coy. v. Stone*, 14 R. P. C. 263; *Spaul v. Monopole Coy.*, 23 R. P. C. 647.

(*e*) The following are some cases where interim relief was refused on ground of laches, with period of delay: *Aluminium Coy. v. Domiere*, 15 R. P. C., one year; *Bovill v. Crate* (1865), L. R. 1 Eq. 388, seven months; *Bridson v. Benecke* (1849), 12 Beav. 1, eleven months; *Aktiengesellschaft für Cartonndügen Industrie v. Temler*, 16 R. P. C. 447, four months; *Leonhardt v. Kallé*, 11 R. P. C. 534, ten months; *Gillette Safety Razor Coy. v. Gamage*, 24 R. P. C. 1; *Edison v. Hough*, 11 R. P. C. 594.

In most of these cases the defendant undertook to keep an account. Sometimes special terms as to early trial are imposed as in *Leonhardt v. Kallé*, *supra*. See also p. 185, *n.* (*c*).

It is probable that laches may be counted against the owners of a patent irrespective of a change of ownership.

In *Gillette Safety Razor Coy. v. Gamage*, *supra*, the plaintiffs were only equitable owners until just before the motion, but the judge held that they could have completed their title sooner had they wished to.

A plaintiff, however, is not generally bound to move until actual infringement occurs. *United Telephone Coy. v. Equitable Telephone Association*, 5 R. P. C. 233.

But if he has allowed the defendant to erect special works he may be prevented from getting interim relief, see *Neilson v. Thompson* (1841), W. P. C. 275; *Neilson v. Fothergill* (1841), W. P. C. 287, where, however, special orders as to payments of sums into Court by way of royalty were made.

Nor is laches in prosecuting other infringers a reason for refusing an interim injunction. *Pneumatic Tyre Coy. v. Warrilow*, 13 R. P. C. 284.

The plaintiff's actual knowledge of the infringement must be shown, thus a mere statement that the plaintiff must have known of the infringement because the defendants had taken out a patent was held sufficient. *Osmond v. Hirst*, 2 R. P. C. 265.

The proper course for a plaintiff, who has not established his patent, when he knows of a number of infringers is to write to each asking if they will allow the first case to determine theirs, and if not to issue writs. The fact that the delay was due to the plaintiff proceeding in another action is no answer to the objection of laches. *Bovill v. Crate* (1865), L. R. 5 Eq. 388; followed in *North British Rubber Coy. v. Gormully & Jeffreys*, 12 R. P. C. 17; see also *Actiengesellschaft für Cartonndügen Industrie v. Temler*, 16 R. P. C. 447.

For an *ex parte* injunction (which in any case is rarely given) the plaintiff should come if possible the very day he hears of the infringement. *Greer v. Bristol Tanning Coy.*, 2 R. P. C. 268. Such an injunction was granted in *Moser v. Jones*, 10 R. P. C. 368.

pay damages (*f*), and the position or conduct of the parties may also influence the Court (*g*). In all cases where an interim injunction is granted the plaintiff must give an undertaking as to any damages that the defendant may suffer by reason of such injunction, should it be held that there was no ground for granting it (*h*). The course which is almost invariably followed in modern practice in a case where there is any substantial

(*f*) See *Bracher v. Bracher, Dean & Coy.*, 7 R. P. C. 420; *Thomson v. Hughes*, 7 R. P. C. 71; *Newall v. Wilson* (1852), 2 De G. M. & G. 282; but possible inconvenience will not prevent the Court acting when the patent is well established. *Davenport v. Jepson* (1862), 4 De G. J. & F. 440,

(*g*) *E.g.* where a defendant had tendered on a contract, it being part of the conditions that the goods supplied were to be "special seat blocks of Messrs. P.'s pattern" in an action by Messrs. P. for infringement and passing off an interim injunction was granted under both heads, although the patent was not established. *Poulton v. Kelly*, 21 R. P. C. 392. See also *Spencer v. Holt*, 20 R. P. C. 142.

The fact that the defendant has been in negotiation to acquire rights under the patent, and has only set up invalidity at the last moment, influences the Court. *Clark v. Ferguson* (1859), 5 Jur. (N. S.) 1155.

So also does the fact that the defendant has acted as plaintiff's adviser. *Wheatstone v. Wild* (1861), Griff. 247.

Where the defendants had formerly been partners of the plaintiff for working the patent, the partnership articles being apparently founded on its presumed validity, and such partnership had brought an action against a third party, an injunction was granted. *Muntz v. Grenfell* (1842), 2 W. P. C. 91.

Where the plaintiff had succeeded in an action against P. who had been indemnified by D., and also against D., an injunction was granted against a company of which D. was the manager, and which had apparently been formed for the purpose of infringing. *Farbenfabriken, &c. v. Dawson*, 8 R. P. C. 397.

So where the plaintiff had succeeded against the defendant in Scotland (*Dudgeon v. Thomson* (1874),

22 W. R. 464), or before an arbitrator (*Lister v. Eastwood* (1856), 26 L. T. (O. S.) 4), an injunction was granted.

The fact that the defendant has a guarantee that the articles have not been made by an infringing process is not sufficient to prevent the Court acting. *Saccharin Corporation Ltd. v. National Saccharin Coy.*, 26 R. P. C. 657.

But merely evasive conduct by the defendants in the proceedings is not in itself a ground for granting an interim injunction. *Renard v. Levinstein* (1864), 10 L. T. 177.

Nor *semble*, that he has applied for a licence. *Zenith Motors Ltd. v. Collier*, 28 R. P. C. 563. See also *Heine v. Norden*, 21 R. P. C. 573; *Crosthwaite v. Steel*, 5 R. P. C. 220.

On the other hand where the plaintiffs had successfully resisted discovery as to an alleged prior user by their predecessors in title, which necessitated a commission abroad to take evidence, interim injunctions were refused in other actions. *Welsbach Incandescent Coy. v. General Incandescent Coy.*, 18 R. P. C. 533, C. A.

Again where it was proved that the plaintiff, who was an assignee, had himself infringed the patent before he acquired it, the injunction was dissolved. *Curtis v. Coultts* (1839), 8 L. J. (CH.) 184; and where plaintiff had obtained an injunction in another case by an agreement to pay the defendant's costs, and then advertised, interim relief was refused. *Roberts v. Graydon*, 20 R. P. C. 578; see *contra Betts v. Menzies* (1857), 3 Jur. (N. S.) 357.

(*h*) This applies also where the defendant gives an undertaking.

Where the plaintiff was only the agent of the real inventor, and gave his address at an hotel was required to get the security of a householder. *Moser v. Sewell*, 10 R. P. C. 365, C. A.; but *cf. Plimpton v. Spiller*, 4 Ch. D. 286, C. A.

For a case of an inquiry as to such

dispute, is that the defendant undertakes to keep an account of the articles sold so as to enable damages to be easily assessed or an account of profits properly obtained (*i*), but the plaintiff has no right to insist on such terms where he has no proper case for an injunction (*j*).

The general rule as to costs is that if the injunction is granted, the costs are made costs in the action (*k*), if it is refused on the ground that there is a substantial question to be tried the practice varies (*l*). If, however, the injunction is refused on grounds such as laches which do not depend on a final determination of the rights of the parties the costs may be given to the defendants (*m*). In some cases the costs are reserved until the trial or further order (*n*).

### Trial.

A patent case will not be sent to a jury in the absence of special direction (*o*). The judge may, if he thinks fit, and shall on the application of either party, try the case either wholly or partially with an assessor (*p*). The Court may also call in an independent expert to report on certain points or to make certain experiments (*q*). The Court may in a proper case

damages being ordered, see *Rothwell v. King*, 4 R. P. C. 76. Other terms, such as an undertaking to supply the defendant, may also be imposed. See *United Telephone Coy. v. Tasker*, 5 R. P. C. 628.

(*i*) Sometimes, too, terms as to payment into Court may be imposed. See *Pneumatic Tyre Coy., Ltd. v. Goodman*, 13 R. P. C. at p. 724; *Neilson's Patent* (1841), W. P. C. 273, 286; *Edison v. Hough*, 11 R. P. C. 594; *North British Rubber Coy. v. Gormully & Jeffreys*, 12 R. P. C. 21. See also *Briggs v. Lardeur*, 1 R. P. C. 192, C. A.; *Spencer v. Holt*, 20 R. P. C. 142.

(*j*) *British Tanning Coy. v. Groth*, 7 R. P. C. 1. But see *Pneumatic Tyre Coy. v. Friswell*, 13 R. P. C. 15.

(*k*) In one case an interim injunction has been granted with costs. *Hayward v. Pavement Lighting Coy.*, 1 R. P. C. 207; but this decision is hardly likely to be followed.

(*l*) See O. 65, r. 23 notes.

(*m*) This, however, is not the invariable course, see *inter alia*, *Aluminium Coy. v. Domiere*, 15 R. P. C. 32; *Actiengesellschaft für Cartonndägen Industrie v. Temler*, 16 R. P. C. 447; *Leonhardt v. Kallé*, 11

R. P. C. 534; *Thomson v. Butty*, 6 R. P. C. 84.

(*n*) See *Lister v. Norton*, 1 R. P. C. 114.

(*o*) Sect. 31 (1).

Occasionally even in recent times patent cases have been tried on circuit with a jury.

(*p*) Sect. 31. In spite of these provisions the inconvenience of trial with an assessor has rendered the course very rare, except with regard to special points in a case. For the procedure when an assessor sits, see *Hattersley v. Hodgson*, 22 R. P. C. 229; *Mackie v. Berry*, 2 R. P. C. 146. No case is reported where the C. A. have sat with an assessor, though they have ordered experiments by an independent expert. *Moore v. Bennet*, 1 R. P. C. 129, C. A.

(*q*) See *Badische, &c. v. Levinstein*, 2 R. P. C. 73; *Moore v. Bennet, supra*. This may be done after the case on both sides has been closed. *North British Rubber Coy. v. Macintosh*, 11 R. P. C. 477. As to costs, see *ibid.* The C. A. may make such a reference. *British Motor Syndicate v. Andrews*, 16 R. P. C. 591, 595. If a party desires additional questions to be put to a witness this should be done at the



order a preliminary point to be tried first (*r*). The practice varies as to adjourning a case where another case or petition involving the same point is to be tried elsewhere, or an appeal in another case is pending (*s*).

The patentee has the right to begin in all cases on an infringement action or petition (*t*), and generally the right of reply as well (*u*). In certain cases the Court will vary the order of the evidence, *e.g.* will take the defendant's evidence as to his process before the plaintiff's case is closed (*x*).

It is entirely in the discretion of the Court whether they will determine a question between the parties not actually necessary for deciding the action before them (*y*).

Secret  
process.

If the defendant claims to be working under a secret process the question of infringement may be postponed till the validity of the patent has been established, and the evidence on this point may be taken *in camera* (*z*).

Onus.

The onus is, of course, on the plaintiff so far as the proof

trial; it is too late on appeal. *Badische, &c. v. Levinstein*, 4 R. P. C. 460, H. L. See also *Mellin v. Monico* (1877), 3 C. P. D. 158.

(*r*) *Woolfe v. Automatic Picture Gallery*, 19 R. P. C. 425. In *United Telephone Coy. v. Mottishead*, 3 R. P. C. 213, KAY, J., refused to order issue of infringement to be tried first unless validity was admitted. See also *Hutchinson v. Pattulo*, 5 R. P. C. 356, I. H.

(*s*) Where the defendant in an infringement action had succeeded on a *scire facias*, but a rule *nisi* had been granted for a new trial, the trial of the action was, on the application of the patentee, ordered to stand over till after the argument on the rule. *Smith v. Upton* (1843), 6 M. & G. 251. But where neither action nor *scire facias* had been tried the Court refused to postpone trial of action. *Muntz v. Foster* (1842), 7 Sc. N. R. 898. Where the defendants who were users applied at the trial for case to stand over and abide the result of the action against the manufacturers in London, it was held that the application was too late. *Welsbach v. M'Grady*, 18 R. P. C. 513 (Ir.). See also *Dunlop Pneumatic Tyre Coy. v. Rimington*, 17 R. P. C. 665, C. A.

(*t*) As to threats action, see p. 228, *n.* (*y*).

(*u*) In a case where infringement

was admitted and the only real issue was a prior user, ROMER, J., gave the defendants the right to reply on this, reserving a further general right of reply to the plaintiffs if necessary. *Pneumatic Tyre Coy. v. Marwood & Cross*, 14 R. P. C. 240.

(*x*) See *Monnet v. Beck*, 14 R. P. C. 777.

(*y*) In *Dudgeon v. Thomson* (1877), 3 A. C. 34, the Lords, although of opinion that the action was wrong in form, heard arguments on and decided the point of substance between the parties. See also *Nordensfeldt v. Gardner*, 1 R. P. C. 61, C. A.

In *Parkinson v. Simon*, 12 R. P. C. 403, H. L., the Lords holding one claim bad refused to decide whether another claim had been infringed, and expressed disapproval of the course taken by the other Courts who had done this.

In *Tubeless Pneumatic Tyre Coy. v. Trench Tyre Coy.*, 16 R. P. C. 291, BYRNE, J., refused, after consideration, to decide the issue of infringement where he had held the patent bad.

(*z*) *Badische, &c. v. Levinstein*, 2 R. P. C. 73.

For form of order preventing disclosure of evidence, see *ibid.*, at p. 93.

As to proper time for making objection, see *Edison v. Woodhouse*, 3 B. P. C. 172.

of his title (a) and the proof of infringement (b) is concerned.

(a) The register or a properly certified extract is *prima facie* evidence of matters which ought to be entered therein, s. 28 (3), s. 78, and s. 79. See *Jandus Arc Lamp Coy. v. Johnson*, 17 R. P. C. 361.

(b) This involves proof of the acts complained of (see *Nobel v. Jones* (1881), 17 Ch. D. 721, C. A.), proof that the article alleged to be an infringement was not made by the patentee or a licensee (*Betts v. Willmott* (1870), 6 Ch. App. 237), and evidence to explain any technical terms in the specification relevant to the question of infringement. In *Farbenfabriken, &c. v. Bowker*, 8 R. P. C. 389, the plaintiff was allowed to give evidence on this issue after the close of his case. Rebutting evidence is sometimes allowed on this issue. *Adair v. Young* (1879), 40 L. T. 41. The onus may shift in the course of the trial. *Z Electric Lamp Coy. v. Marples*, 27 R. P. C. 312, 320.

When the patent is for a process the plaintiff has of course to offer some evidence than the article complained of as an infringement has been made by this process, the mere production of the article being insufficient. *Palmer v. Wagstaff* (1854), 23 L. J. (EX.) 217; *Carlsburn v. Sharp*, 1 R. P. C. 181.

This evidence may of course be derived from the actual witnesses of the manufacture, or may be to the effect that no other process would produce the article.

The following are some examples of the evidence which has been considered sufficient:—

In the case of a patent for a new method of making rope, the production of rope made by the defendants together with the evidence of experts that they knew of no other method than that patented by which it could have been made, and proof of secrecy of manufacture, was held sufficient. *Huddardt v. Grimshaw* (1803), W. P. C. 85. See also *Hall's Patent* (1817), W. P. C. 97; *Thermal Syndicate v. Silicaware*, 28 R. P. C. 665; *Badische, &c. v. Chemische Fabrik*, 21 R. P. C. 345.

In the case of a patent for amalgamating lead and tin by rolling, the production of articles which experts swore were apparently made by this process, together with evidence that at one time the defendants used the

process, was held sufficient. *Betts v. Neilson* (1871), L. R. 5 H. L. 1.

In the case of the Saccharin patents, evidence that Saccharin of the quality produced could only be made by one of the processes covered by the plaintiffs' patents, or could only be made at the price at which it was sold by such methods, was held sufficient. The injunction and damages were limited to the time of expiration of the first of the patents sued on. *Saccharin Corporation v. Quincey*, 17 R. P. C. 337; *Saccharin Corporation v. Dawson*, 19 R. P. C. 169; *Saccharin Corporation v. Jackson*, 20 R. P. C. 611; *Saccharin Corporation v. Mack*, 23 R. P. C. 25; *Saccharin Corporation v. Lockwood*, 23 R. P. C. 274; *Saccharin Corporation v. Scott*, 23 R. P. C. 276; *Saccharin Corporation v. Jones*, 23 R. P. C. 275; *Saccharin Corporation v. National Saccharin Coy.*, 26 R. P. C. 735.

Where a process was claimed for the purpose of reducing the carbon in Tungsten filaments, and it was shown that the defendants had used it, and that its natural effect was to reduce the carbon, it was held that the onus was on the defendants to show that it did not do so. *Z Electric Lamp Coy. v. Marples*, 27 R. P. C. 737, C. A.

The question of whether the article etc., is within the claim is of course a matter for the Court. *Graphic Arts Coy. v. Hunters Ltd.*, 27 R. P. C. 677.

Where the plaintiff relies on admissions or answers by the defendant, these must be such as to negative the possibility of non-infringement. *Winby v. Manchester Steam Tramways*, 7 R. P. C. 30, C. A.; *Wilson Brothers Bobbin Coy., Ltd. v. Wilson & Coy.*, 20 R. P. C. 1, H. L. See also *Ashworth v. English Card Clothing Coy.*, 20 R. P. C. 790, H. L.; *Morrison v. Asplin*, 21 R. P. C. 557.

In *Parkinson v. Simon*, 11 R. P. C. 238, it was held that the fact of the defendants calling a certain part a deflector was no evidence that it was a deflector within the meaning of the specification. See also *Osborne v. Board*, 13 R. P. C. at p. 748. But see *contra*, *Morgan v. Windover*, 4 R. P. C. 446.

Evidence of intention to infringe may be sufficient for the purposes of obtaining an injunction. *Plumpton v.*

As to the issues going to the validity of the patent the opinion expressed by the Courts differ (c), but the general practice is for the plaintiff to make a *prima facie* case on the issues of novelty, utility and sufficiency. The onus of the issues of leave and licence (d), non-manufacture or non-fulfilment of the reasonable requirements of the public, are on the defendant in the first instance (e).

Expert  
evidence.

A large portion of the evidence in patent cases is what is usually called expert evidence. The object of such evidence is mainly to instruct the Court as to the state of knowledge, the meaning of terms of art, and other surrounding circumstances, so that it may be better able to construe the specification and to form a judgment on the various issues. But it is not the

*Spiller* (1877), 4 Ch. D. 286; *Frcreson v. Loe* (1878), 9 Ch. D. 48; *Dowling v. Billington*, 7 R. P. C. 191 (Ir.). But see *Shoe Machinery Coy. v. Cutlan*, 12 R. P. C. 342; *McClay v. Lawes*, 22 R. P. C. 199.

Evidence of acts after the commencement of the action may show such intention. *Dowling v. Billington*, *supra*.

But as to when such evidence is admissible, see *Shoe Machinery Coy. v. Cutlan*, *ubi supra*; *Welsbach Incandescent Coy. v. Dowle*, 16 R. P. C. 391.

The evidence must be clear that what is intended to be done will be an infringement, see *Babcock & Wilcox Ltd. v. Danks*, 27 R. P. C. 713; *cf. Poulton v. Kelly*, 21 R. P. C. 393.

(c) The general onus as to novelty was said to be on the plaintiff in *Penn v. Jack* (1866), 14 L. T. 495; *Russel v. Ledsam* (1843), 12 L. J. (EX.) 439; *Rollins v. Hinks* (1872), L. R. 13 Eq. 355 (unless the patent is an old one).

On the other hand opinions that a patent is *prima facie* valid and that the onus is on the defendant were expressed in *Young v. White* (1853), 17 Beav. 532; *Ward Brothers v. Hill*, 18 R. P. C. 481 (cases referred to). *Peroni v. Hudson*, 1 R. P. C. 263; *Amory v. Brown* (1869), L. R. 8 Eq. 663; *Young v. Rosenthal*, 1 R. P. C. 29; *Minter v. Wells* (1834), W. P. C. 127; *Halsey v. Brotherhood* (1880), 15 Ch. D. 514.

Of course the onus as to specific instances of prior user is on the defendant, and the plaintiff can call

evidence in rebuttal. This has been admitted even after the hearing. *Boyd v. Horrocks*, 5 R. P. C. 557.

In *Penn v. Jack*, *ubi supra*, further evidence to contradict such rebutting evidence was not allowed; but *cf. Blakey v. Latham*, 6 R. P. C. 36.

As to admissibility of statements by alleged prior users see *Hyde v. Palmer* (1863), 32 L. J. (Q. B.) 26.

In one case where an alleged description in a classical work was relied on as an anticipation, a passage in Ovid showing the real nature of the article was admitted to disprove the anticipation. *Benno Jaffe, &c. v. Richardson*, 11 R. P. C. 93, and 261, C. A.

As to proper course where user not in particulars is proved, see *Barcroft v. Barcroft*, 14 R. P. C. 172, C. A.

As to the onus on the issue of utility, see *Minter v. Wells*, *supra*. Rebutting evidence on this issue was allowed on special terms in *Easterbrook v. Great Western Railway*, 2 R. P. C. 201.

With the modern interpretation of the issue of first and true inventor the onus of this objection is of course on the defendant. See also *Nickels v. Ross* (1849), 8 C. B. 679; *Pilking-ton v. Yeakley*, 18 R. P. C. 459; *Ward Brothers v. Hill*, *supra*; *Kelvin v. Whyte-Thomson*, 25 R. P. C. 177.

(d) See *Badische, &c. v. Dawson*, 6 R. P. C. 387.

(e) See p. 174.

Of course the defendants may elicit this evidence by cross-examination. *Saccharin Corporation v. National Saccharin Coy.*, 28 R. P. C. 291.

function of such witnesses to pronounce on the issues (whether of law or fact) which are for the Court, and direct questions such as whether an article is an infringement, or a document an anticipation, should not be put (*f*).

The ordinary rules of evidence, of course, govern patent cases, but a note of a few miscellaneous points may be useful. Models (*g*) and drawings are freely used, and may be put to witnesses as illustrating what they have seen, although not made by such witnesses (*h*). Awards at public exhibitions cannot be received as evidence of novelty or utility unless a juror is called (*i*). The Court will require the production of unpublished provisional specifications if of opinion that it is necessary in the interests of justice (*k*). Observations have been made on the danger of relying on single experiments, (*l*) and on the tendency of trade evidence to be against the patentee (*m*). Where joint tests of an apparatus

Miscellaneous  
points of  
evidence.

(*f*) *Graphic Arts Coy. v. Hunters Ltd.*, 27 R. P. C. 677; *Gadd v. Mayor of Manchester*, 9 R. P. C. 530, C. A.; *Parkinson v. Simon*, 11 R. P. C. at p. 506, C. A. See also as to the function of expert evidence, *Boyd v. Horrocks*, 9 R. P. C. 81, H. L.; *Lead-beater v. Kitchin*, 7 R. P. C. 247.

Such witnesses should not be needlessly multiplied. *Automatic Weighing Machine Coy. v. Knight*, 6 R. P. C. 113. (The general limit is two on each side apart from those speaking to special points.)

It has also been doubted whether these witnesses, in general highly trained scientists, can properly speak as to what an ordinary workman would do. *Proctor v. Bennis*, 4 R. P. C. 361, C. A.

Expert evidence is admissible as to originality or as to a variation being obvious. *Fletcher v. Glasgow Gas Commissioners*, 4 R. P. C. 388, O. H.

Although construction is for the Court a witness may be asked what he understands by a specification. *Kaye v. Chubb*, 5 R. P. C., per Lord HALSBURY, at p. 650.

But it has been said that they should not be asked what was the substance of the invention (*Brooks v. Steel*, 14 R. P. C. 73), or whether two parts of a specification refer to the same thing. *Jandus Arc Lamp Coy. v. Arc Lamp Coy.*, 22 R. P. C. 286. See also p. 123,

(*g*) Once a model is put in it should not be altered or even cleaned without the consent of all parties. *Winby v. Manchester Steam Tramways*, 8 R. P. C. 61.

Where models are not put to plaintiff's witnesses these may be recalled. *Nettlefolds v. Reynolds*, 9 R. P. C. 282.

(*h*) *R. v. Haddan* (1826), 2 Car. & P. 184. But in such cases the witness must have sufficient technical knowledge to be able to speak to details. *Perry v. La Société des Lunetiers*, 13 R. P. C. 664.

Where a witness says that what he saw was identical with what was in use in some other factory, evidence cannot be called in contradiction to show what in fact was in use in such factory. *Haggenmacher's Patent*, 15 R. P. C. 437.

Models may also be used to illustrate the arguments of counsel though not in evidence. *Boyd v. Horrocks*, 6 R. P. C. 154, C. A.; but see *Tweedale v. Ashworth*, 8 R. P. C. 52, C. A.

(*i*) *Young v. White* (1854), 23 L. J. (CH.) 197.

(*k*) *Pneumatic Tyre Coy., Ltd. v. English Cycle Coy.*, 14 R. P. C. 851.

(*l*) *Dunlop Pneumatic Tyre Coy. v. Clifton Tyre Coy.*, 20 R. P. C. 404, C. A.

(*m*) *Pirrie v. York Street Flax Coy.*, 11 R. P. C. 441, C. A. (Ir.).

have been made further tests should not be made without notice to the other side (*n*).

Appeal  
evidence.

The Court of Appeal will form its own inferences of facts not depending on the credibility of witnesses (*o*).

It will not in general admit fresh evidence where this would involve an amendment of the pleadings (*p*). Fresh evidence not involving an amendment of the pleadings may be admitted when it could not have been discovered earlier (*q*), or where a party has been taken by surprise (*r*) or misled (*s*). It may also sometimes be admitted where the party who was successful below called no evidence (*t*), or where there has been a slip in the evidence, or, in such cases, a new trial may be granted (*u*). Sometimes evidence will be admitted to clear up a point which the Court thinks doubtful (*x*). Models not used or put to witnesses below cannot be used on appeal (*y*). Fresh evidence will not be admitted simply because the unsuccessful party thinks he can strengthen his case (*z*), nor will it be admitted where its admission would not in the opinion of the Court enable the party to succeed (*a*). The application should in general be made before the appeal and supported by an affidavit, though the application is frequently adjourned to come on with the appeal (*b*).

Fresh points  
on appeal.

Fresh points not involving new evidence may be taken on appeal, unless they involve an entire change of case (*c*).

(*n*) *Young v. Hermand Oil Coy.*, 9 R. P. C. 382, H. L.

(*o*) See *Moore v. Bennett*, 1 R. P. C. 126, C. A. and H. L.; *Rickmann v. Thierry*, 14 R. P. C. 116, H. L.; but cf. *Nobel's Explosive Coy. v. Anderson*, 12 R. P. C. 166, H. L.; *Newellite Coy. v. Lawson*, 24 R. P. C. 311, C. A.

(*p*) *Hinde v. Osborne*, 2 R. P. C. 64, C. A.; *Browne v. Hastie*, 22 R. P. C. 85, I. H., and S. L. T. 12, 121; but fresh specifications were allowed to be pleaded in *Pirrie v. York Street Flax Coy.*, 11 R. P. C. 431, C. A. Ir.

(*q*) See *Hinde v. Osborne*, *supra*; *Walling v. Stevens*, 3 R. P. C. 147, C. A.; *Walker v. Hydrocarbon Syndicate Ltd.*, 3 R. P. C. 254, C. A.

(*r*) Leave was refused where no application for adjournment had been made below. *Barcroft v. Barcroft & Smith*, 14 R. P. C. 172, C. A.

An affidavit as to surprise is necessary. *Haggenmacher v. Watson*, 14 R. P. C. 631, C. A.

(*s*) *American Braided Wire Coy. v. Thomson*, 5 R. P. C. 113, C. A.; *Britain v. Hirsch*, 5 R. P. C. 226, C. A.

(*t*) *Deutsche Nahmaschinen Fabrik v. Pfaff*, 7 R. P. C. 251, C. A. But see *Lancashire Explosive Coy. v. Roburite Explosive Coy.*, 12 R. P. C. 480, C. A.

(*u*) *Germ Milling Coy. v. Robinson*, 3 R. P. C. 398, C. A.

(*x*) In *Moore v. Bennett*, 1 R. P. C. 126, the C. A. ordered an independent expert to make a report.

(*y*) *Erhlich v. Ihlee*, 5 R. P. C. 437, C. A.

(*z*) *Hinde v. Osborne*, *supra*; *Nadel v. Martin*, 20 R. P. C. 723, C. A.

(*a*) *Gammons v. Singer*, 22 R. P. C. 452, C. A.

(*b*) See *Walling v. Stevens*, *supra*; *Blakey v. Latham*, 6 R. P. C. 186, C. A.

(*c*) *E.g.* where in the first Court the plaintiff had admitted that an article would be an anticipation, but

A plaintiff is not entitled to put a different construction on his patent in the Court of Appeal to that which he contended for in the first Court, at any rate if the evidence might have been affected had this construction been argued in the first instance (*d*).

### Relief.

The relief granted may include an injunction, damages or an account of profits, an order for the delivery up or destruction of the infringing articles, a certificate of validity, and costs. <sup>Forms of relief.</sup>

### Injunction.

The object of an injunction being to prevent repetition of infringement, it would in theory only be granted where there was reason to think that otherwise the offence would be repeated (*e*). But in the case where the defendant has deliberately infringed or has set up a claim of right to do what the Court holds to be unlawful, either by his defence or otherwise (*h*), the Court presumes that an injunction is necessary to protect the plaintiff, even though the defendant has subsequently offered an undertaking (*i*), unless there are special circumstances which show there is no probability of the infringement being repeated (*k*). <sup>Grounds for injunction.</sup>

But in the case of an infringer who has acted innocently and has promptly discontinued and offered a proper undertaking

challenged its authenticity, he was not allowed on appeal to suggest it would not anticipate. *Westley Richards & Coy. v. Perkes*, 10 R. P. C. 382, C. A.

(*d*) *Badische, &c. v. Société des Usines de Rhone*, 15 R. P. C. 359, C. A. Cf. also *Gillette Safety Razor Coy. v. Anglo-American Trading Coy.*, 29 R. P. C. 340, C. A.

(*e*) See *Proctor v. Bayley*, 6 R. P. C. 538, C. A., and cases there quoted.

(*h*) *Dowling v. Billington*, 7 R. P. C. 191, C. A. Ir. 286; *Plimpton v. Spiller* (1877), 4 Ch. D., C. A.

(*i*) See *per SHADWELL*, V.C., in *Losh v. Hague* (1837), 1 W. 200. See also *Geary v. Norton* (1846), 1 De G. & S. 9; *Edison v. London Phonograph Coy.*, 11 R. P. C. 741.

(*k*) Where the defendant had been captain of a ship having the infringing machinery, but had given up his

position, the injunction was refused. *Caldwell v. Van Vlissingen* (1851), 21 L. J. (CH.) 97.

Where the defendants had used the plaintiff's apparatus for one trip for fishing purposes, but had abandoned it as useless an injunction was refused. *Scott v. Hull Steam Fishing Coy.*, 14 R. P. C. 143.

Where the defendants had abandoned the business an injunction was refused. *Welsbach Incandescent Coy. v. New Incandescent Coy.*, 17 R. P. C. 237. See also *Hudson v. Chatteris Engineering Coy.*, 15 R. P. C. 438; *Kernot v. Potter* (1861), 3 De G. F. & J. 447.

Where the defendant had dismantled the machinery four years before action an injunction was refused, although he had challenged the plaintiff's rights. *Proctor v. Bayley*, 6 R. P. C. 538, C. A.

and compensation, the Court will not generally interfere by injunction (*l*).

The Court is sometimes reluctant to grant injunctions where the defendant does not oppose and it suspects that the plaintiff's object in getting the injunction is to advertise it (*m*).

In modern times there is no case of a final injunction being refused on the ground of delay (*n*).

It would seem that an injunction might be granted, even after the expiration of a patent, against the sale of articles manufactured in this country in infringement of such patent during its life (*o*).

Form of  
injunction.

In ordinary cases a successful plaintiff is entitled to a general injunction against infringement of the patent sued on. Sometimes, however, when the Court finds that the defendant is making two substantially different articles the injunction may be limited to articles similar to a certain exhibit (*p*), or the plaintiff may be put on the terms of not raising the question of infringement by certain forms on a motion to commit (*q*).

Stay of  
injunction.

The question of staying the injunction where the plaintiff is successful is one entirely in the discretion of the Court (*r*),

(*l*) *Jenkins v. Hope*, 13 R. P. C. 57; *Betts v. Wilmott* (1870), 18 W. R. 946. See also *Fletcher v. Glasgow Gas Commissioners*, 4 R. P. C. 386; but the undertaking must be full and clear, see *United Telephone Coy. v. London & Globe Coy.*, 1 R. P. C. 118.

(*m*) *Dover v. New Townsend Coy.*, 21 R. P. C. 135; *Badische, &c. v. Spivey*, 22 R. P. C. 65.

But in *Savage v. Brindle*, 17 R. P. C. 288, an injunction was granted against a defendant who had submitted to judgment, although the patent was held to be bad, but *cf.* *Cropper v. Smith*, 2 R. P. C. 17, H. L.

(*n*) In *Gadd v. Mayor of Manchester*, 9 R. P. C. 528, C. A., the Court refused to grant a mandatory injunction ordering the defendants to remove a gas holder, which they had erected, or to restrain them using it, although they were restrained from building fresh ones.

But in *Automatic Coal Gas Retort Coy. v. Mayor of Salford*, 14 R. P. C. 450, an injunction was granted restraining the further use of the retorts which had been erected. See also p. 209, *n.* (*y*).

(*o*) *Crossley v. Derby Gas Light Coy.* (1834), 44 L. J. (CH.) 25; *Price's*

*Patent Candle Coy. v. Bawens* (1858), 4 K. & J. 727.

(*p*) *Dunlop Pneumatic Tyre Coy. v. New Ixion Coy.*, 15 R. P. C. 389, and 16 R. P. C. 16, C. A. But see *Shoe Machinery Coy. v. Cutlan*, 3 R. P. C. 141.

(*q*) *Dunlop Pneumatic Tyre Coy. v. Clifton Tyre Coy.*, 20 R. P. C. 393.

Special orders were made in some of the *Saccharin Cases*, where the plaintiff succeeded by showing that the defendant must have infringed one of a number of patents. Here the injunction was against infringing any of the patents, but was limited to the duration of the oldest patent. See *Saccharin Corporation v. Dawson*, 19 R. P. C. 169. But *cf.* *Saccharin Corporation v. Hopkinson*, 21 R. P. C. 272.

The Court will not in general lay down limits as to what the defendant may do. See *Edison v. Woodhouse*, 3 R. P. C., at p. 178.

(*r*) Usually, however, the defendant should show some special reason for a stay. See *Otto v. Steel*, 3 R. P. C. 109; *Hayward v. Hamilton* (1879), Griff. 124; *Hicks v. Simmons*, 21 R. P. C. 413; *Pilkington v. Massey*, 21 R. P. C. 421. See also

but the Court of Appeal will review its decision, at any rate in the interest of the defendants, and sometimes the defendant is directed to make an application to the Court of Appeal (s). A stay is very rarely granted after judgment for the plaintiff in the Court of Appeal, except by consent (t). Sometimes an exception from the injunction is made with regard to certain articles under order (u). A stay will not be granted where the defendant has no existing trade (x).

### *Damages and Profits.*

A successful plaintiff has in general the right either to damages (y) or an account of profits, but must elect before judgment is finally given which of the two he will take (z). Plaintiff may take account of inquiry.

*Penn v. Bibby* (1860), 15 W. R. 192. In *Hopkinson v. St. James's Electric Lighting Coy.*, 10 R. P. C. 62, the injunction was suspended for six months on the ground of public convenience.

The application is usually made at the trial, though sometimes a separate motion may be ordered. See *Otto v. Steel*, *supra*.

The following cases are examples of the terms sometimes imposed if a stay is granted:—

The defendants ordered to give security for the recovery of the royalties on articles made between trial and appeal. *National Opalite Coy. v. Ceralite Coy.*, 13 R. P. C. 649.

The defendants ordered to pay royalties which should be returned if they succeeded. *Jandus Arc Coy. v. Arc Lamp Coy.*, 22 R. P. C. 297, C. A.

The defendants ordered to pay £100 into Court or £200 towards costs and damages. *Birmingham Tyre Coy. v. Reliance Coy.*, 19 R. P. C. 298.

Stay granted for three weeks by the Court of Appeal on payment of a further £500 into Court in addition to amount already in. *North British Rubber Coy. v. Gormully and Jeffreys*, 14 R. P. C. 302.

Stay granted on payment into Court of a penny per lamp made. *Osrarn Lamp Works v. Z Electric Lamp Coy.*, 29 R. P. C. 430.

Where the defendants were supplying the Government the injunction was stayed so far as the articles supplied to the Government were concerned, a receiver being ap-

pointed to hold the money paid. *Nordenfeldt v. Gardner*, 1 R. P. C. 63.

(s) *Leeds Forge v. Deighton*, 18 R. P. C. 233.

(t) See *Hayward v. Hamilton* (1879), Griff. 124; *Lyon v. Goddard*, 10 R. P. C. 121, C. A.

The practice suggested by the Court of Appeal in *Proctor v. Bennis*, 4 R. P. C. 363, that a separate motion should be made is not always followed. In *Patent Exploitation Coy. v. Siemens*, 20 R. P. C. 225, the plaintiffs did not oppose the stay.

(u) See *Lyon v. Goddard*, *supra*; *Duckett v. Whitehead*, 12 R. P. C. 376; *Nordenfeldt v. Gardner*, *supra*.

(x) *Proctor v. Bennis*, *supra*; *Pilkington v. Ycakley Coy.*, 18 R. P. C. 459, C. A.

The dictum in *Proctor v. Bennis*, *supra*, as to granting a stay where defendant has existing trade has not been generally followed, at any rate after judgment by the Court of Appeal. It does not apply if defendant can so alter the articles as not to infringe and yet continue business. *British Motor Syndicate v. Andrews*, 16 R. P. C. 581, C. A.

(y) The action being for infringement of a legal right, a successful plaintiff is in any case entitled to nominal damages. Cf. *Davenport v. Rylands* (1865), L. R. 1 Eq. 302, and 14 W. R. 244.

(z) *Betts v. De Vitre* (1864), L. R. 6 H. L. 319; *Betts v. Neilson* (1866), L. R. 5 H. L. 1, overruling *Hill v. Evans* (1862), 4 De G. F. & J., at p. 309.

The old equity rule was that an



## Measure of damages.

In the case of damages the plaintiff continues to treat the action of the defendant as a tort, and is given compensation for the loss caused to him by such tort, consequently the damages are usually ascertained by assuming that the plaintiff or his licensees would have sold the whole or a portion of the articles sold by the defendant, and considering what would have been his profit on such sales (a). But the plaintiff is allowed to increase the damage by showing that the defendant's

account would only be ordered as ancillary to an injunction and in a case where an injunction would have been granted. Thus laches would have been an objection to giving such an account (*Crossley v. Derby Gas Light Coy.* (1820), W. P. C., at p. 119; *Smith v. L. & S. W. Ry. Coy.* (1854), Kay, 408; *Price's Patent Candle Coy. v. Bauwen* (1858), 4 K. & J. 727), as would the fact that the patent had expired. *Betts v. Galtais* (1870), 22 L. T. 341; but see *contra*, *Fox v. Jones* (1866), 15 W. R. 194; *Davenport v. Rylands* (1866), 35 L. J. (CH.) 204.

This rule was not, however, recognised by the Common Law Courts as binding on them. *Vidi v. Smith* (1854), 23 L. J. (Q. B.) 342. It does not seem to have been acted on in recent years. As to old Common Law practice, see also *Holland v. Fox* (1854), 23 L. J. (Q. B.) 77 and 357.

Where the defendant goes bankrupt the patentee can continue the action and prove in bankruptcy for the profits, though not for damages. *Watson v. Holliday* (1882), 20 Ch. D. 780. See also generally on the distinction between these remedies, *Slazenger v. Spalding*, 27 R. P. C. 20; *Watson v. Holliday*, *supra*; *Nunn v. d'Albuquerque* (1864), 34 Beav. 595; *Betts v. De Vitre* (1865), 34 L. J. (CH.) 291.

(a) The loss to the plaintiff necessarily depends on his method of trading, and is in general highest where he is himself a manufacturer. If he grants licences the fact that a licensee might have sold the article may be taken into account as reducing the damages, though an infringer cannot claim to be put on the same footing as a licensee. *Boyd v. Tootal, Broadhurst, Lee & Coy.*, 11 R. P. C. 175. Where the plaintiff neither manufactures nor licenses, the damages may be nominal, and

in such case an account of profits would generally be preferable.

The following are some examples of how damages have been fixed.

Where the plaintiff was in the habit of granting licences at 2s. 6d. per H.P., this figure was taken in fixing damages. *Penn v. Jack* (1866), L. R. 5 Eq. 81.

But where the plaintiffs supplied tyres on which the profits were 12s. 6d., which alone were put on first-grade machines, but licensed tyres for second-grade machines at 2s. 6d. each, and the infringing tyres were only used on second-grade machines, the Court of Appeal held that the judge was wrong in assuming that a licence would have been granted for the infringing tyres at this amount, though they did not disturb his figures which were in the main based on this. *Pneumatic Tyre Coy. v. Puncture Proof Tyre Coy.*, 16 R. P. C. 209, C. A. See also *Dunlop Pneumatic Tyre Coy. v. Green*, 17 R. P. C. 234, where this case was considered and distinguished, and *British Motor Syndicate v. Taylor*, 17 R. P. C. 723, C. A., where a sum larger than the amount at which plaintiff's licensed, but less than their full profit, was given.

In *Boyd v. Tootal, Broadhurst, Lee & Coy.*, *supra*, the plaintiff's full profit was given as damages, though he had offered to accept a less sum from persons submitting without litigation.

In *English and American Shoe Machinery Coy. v. Union Boot and Shoe Coy.*, 13 R. P. C. 164, where the plaintiff's general system was to license, though some machines had been sold, the damages were assessed on basis of loss of royalties up to the date of the injunction.

In *Leeds Forge v. Deighton*, 25 R. P. C. 209, the damages were assessed at the plaintiff's full rate of profit, although he had made a special

unlawful competition has caused him to lower prices (b), or has otherwise caused him loss (c). Generally speaking, the plaintiff is only entitled to the loss of profit on the sale of the patented articles, and not that on other articles which he might have sold with them (d). In a case where the plaintiff takes the inquiry as to damages he is entitled to proceed against the purchasers of the articles, and to recover further damages from them (e).

In the case of an account of profits the patentee treats the wrongdoer as his agent, and recovers the profits made by him (f). Account of profits.

arrangement for licence with one manufacturer. The damages were also assessed on the basis of the plaintiff's profits in *Dey v. Howard*, 20 R. P. C. 21.

In *Automatic Gas Coal Retort Coy. v. Salford Corporation*, 14 R. P. C. 450, it was arranged on the judge's suggestion that the damages should be ascertained by determining what would have been a proper sum for the defendants to pay by way of royalty.

(b) *Meters, Ltd. v. Metropolitan Gas Coy.*, 28 R. P. C. 157, C. A.; *United Horsenail Machinery Coy. v. Stewart*, 5 R. P. C. 160, H. L.; *American Braided Wire Coy. v. Thomson*, 7 R. P. C. 152, where *United Horsenail Machinery Coy. v. Stewart* is considered and explained. *Leeds Forge v. Deighton*, 25 R. P. C. 209.

So, too, a sum may be added if the infringement were such as to injure plaintiff's reputation. *Pneumatic Tyre Coy. v. Puncture Proof Tyre Coy.*, 15 R. P. C. 405.

In *Boyd v. Tootal, Broadhurst, Lee & Coy.*, *supra*, ROBINSON, V.-C., was of opinion that where the defendant was not a manufacturer but a user, damage from reduction in the plaintiff's price was too remote.

Where infringement has been found it is not open to the defendants on the inquiry to say that the invention was useless, nor *semble* does it affect the damages that the infringing part only formed a small portion of the machinery on which the articles sold were made. *United Horsenail Machinery Coy. v. Stewart*, *supra*.

In *Gavioli v. Shepherd*, 17 R. P. C. 157, it was held that as the defendants who were users had bought a machine only half the price of the plaintiff's, and swore they could not have paid more, there were no damages.

But a contrary view was taken in *British United Shoe Machinery Coy. v. Fussell*, 27 R. P. C. 205, and in *Meters, Ltd. v. Metropolitan Gas Coy., Ltd.*, 28 R. P. C. 157, C. A., the Court held that it was not necessary for the plaintiff to prove he would have got the orders and that there may be damage even if it is shown that he would not. See also *Leeds Forge v. Deighton*, 25 R. P. C. 209, and *William, Seager, and Head, Ltd. v. Burstinglaus*, 28 R. P. C. 326 (competing tenders); *Dey v. Howard*, 20 R. P. C. 21.

(c) *E.g.* That decrease of orders has thrown a greater portion of establishment charges on other work. *Leeds Forge v. Deighton*, *supra*.

(d) See *Penn v. Jack* (1866), L. R. 5 Eq. 81; *Clement Talbot v. Wilson*, 26 R. P. C. 467, C. A.

In *British Insulated Wire Coy. v. Dublin United Tramway Coy.*, 17 R. P. C. 14, the plaintiffs and defendants had both tendered for a contract in which the infringing articles were used. The plaintiffs sought to recover the amount of profit they would have made had their tender been accepted, but it was held that the damages were confined to loss on infringing articles actually imported before the patent expired.

But where the patented part is an integral part of the article sold, this rule does not apply, and the plaintiff is entitled to a profit on the whole article. *Meters, Ltd. v. Metropolitan Gas Coy., Ltd.*, 28 R. P. C. 157, C. A. See also *United Telephone Coy. v. Walker*, 4 R. P. C. 63; *Brown Bros. & Coy. v. Hasties*, 21 R. P. C. 462, O.H.

(e) *United Telephone Coy. v. Walker*, *supra*; but see *Penn v. Jack*, *supra*.

(f) *Betts v. Neilson* (1866), L. R. 5 H. L. 1; *Betts v. De Vitre* (1864), L. R. 6 H. L. 319; *Watson v. Holliday*

The loss to the plaintiff would not here come into account, but only the profit made by the defendant (g). In such a case it would seem doubtful whether the plaintiff can bring further actions against the purchasers of the articles on which he has received the profit (h).

Accounts and inquiries.

The costs of either an account or an inquiry are usually reserved and dealt with after such account or inquiry has been held (i). Neither damages nor profits can be given for more than six years (k) before action brought, nor can they go beyond the time when the plaintiff or one of the plaintiffs was at least an equitable owner of the patent (l).

Where it is clear there has been no real damage an account

(1882), 20 Ch. D. 782, C. A.; *Saccharin Corporation, Ltd. v. Chemical and Drugs Coy.*, 17 R. P. C. 612, C. A.

An account of profits is generally preferable where the defendant has an established trade supposed to be profitable, especially where the plaintiff is not trading. But see *Siddle v. Vickers*, *infra*.

In taking an account of profits, a comparison sometimes has to be made between the defendant's costs of working before and after the use of the invention. In such cases the plaintiff is given discovery of the matters necessary to make the comparison. *Siddle v. Vickers*, 6 R. P. C. 464. Probably the defendant might show that he could have used other labour-saving devices, *ibid*. As to other facts affecting the account, see this case and *Crossley v. Derby Gas Coy.* (1829), 3 My. & Cr. 428; 3 Jur. 692.

(g) *Ellwood v. Christy* (1865), 34 L. J. (C. P.) 130.

The onus lies on the plaintiff to show that the defendant has in fact made profits. *Bacon v. Spottiswoode* (1839), 3 Jur. (O. S.) 476.

(h) It was held by WOOD, V.-C., in *Penn v. Jack* (1866), L. R. 5 Eq. 81, that taking profits from the manufacturer did not prevent damages being obtained from users, but this was before *Betts v. Neilson*, *supra*.

This also seems to have been assumed in *Saccharin Corporation v. Chemical and Drugs Coy.*, *supra*, where, however, it was not to the interest of either party to argue to the contrary. It seems difficult to reconcile this view with the dicta in the cases in n. (f), *supra*, and especially

with the grounds of the decision in *Watson v. Holliday* (1882), 20 Ch. D. 780, that in taking an account of profits the patentee treats the infringer as his agent, and adopts his acts, and can therefore prove in bankruptcy.

See remarks of CHITTY, J., in *United Telephone Coy. v. Walker*, 4 R. P. C., at p. 67, and of WOOD, V.-C., in *Penn v. Jack*, *supra*.

(i) This is the usual practice, and applies where the judgment is in default of defence. *United Telephone Coy. v. Fleming*, 3 R. P. C. 282; *Same v. Faulkner*, 3 R. P. C. 282 n.; but in *Craig v. Dowding*, 25 R. P. C. 9, KEKEWICH, J., said the costs were only reserved when there was a doubt as to there being any real damages. See also *Rothwell v. King*, 4 R. P. C. 76. The defendants may offer a sum for damages, and if a less sum is awarded will usually get the costs of the inquiry from the date of the offer. *Pneumatic Tyre Coy. v. Puncture Proof Tyre Co.*, 15 R. P. C. 405; 16 R. P. C. 209, C. A.; *British Vacuum Cleaner Coy. v. Exton Hotels Coy.*, 25 R. P. C. 617.

(k) *Crossley v. Derby Gas Light Coy.* (1839), W. P. C. 119.

(l) In *Ellwood v. Christy* (1865), 34 L. J. (C. P.) 130, it was held that an account only ran from the completion of the legal title.

In *United Horsenail Machinery Coy. v. Stewart*, 5 R. P. C. 260, H. L., damages were given from the date when the plaintiffs became equitable owners of the patents, and Lord MACNAGHTEN was of opinion they should have gone back further to the date when the plaintiffs took over the business.

or inquiry may be refused (*m*). Where judgment is signed on admissions in the defence the inquiry is limited to the admitted infringements (*n*). The inquiry is usually held before a chief clerk, but it may be sent to an official referee (*o*). It is doubtful whether it can be sent to a jury (*p*).

It is not usual to stay an inquiry or account where there is an appeal (*r*), and the damages should be assessed as if the inquiry were conducted instantaneously (*s*). On an inquiry or account the plaintiff is entitled to an order for full inspection of the defendants' books, including the names of customers, without any terms being imposed as to not bringing actions against such customers (*t*).

The Act provides that in the case of a patent granted after the commencement of the Act (*u*) the patentee shall not recover any damages in respect of infringement of such patent from a defendant who proves that at the date of the infringement he was not aware, and had not reasonable means of making himself aware, of the existence of the patent, but this does not affect the right to an injunction (*x*). It is provided that marking the article with such words as "patent" without the number

Limitation of damages.

(*m*) See *United Telephone Coy. v. Sharples*, 2 R. P. C. 28.

Sometimes the Court will itself fix a sum. See *Cole v. Saqui*, 5 R. P. C. 489.

(*n*) *United Telephone Coy. v. Donohoe*, 3 R. P. C. 45.

(*o*) *American Braided Wire Coy. v. Thomson*, 5 R. P. C. 696, C. A.

(*p*) *American Braided Wire Coy. v. Thomson*, *supra*. See also *Fenessey v. Rabbits* (1887), 56 L. T. 138.

(*r*) *Evans v. Hoskins*, 21 R. P. C. 682; *Hyde v. Terry* (1880), 29 W. R. 32.

In *Adair v. Young* (1879), 11 Ch. D. 136, C. A., and *Craig v. Dowding*, 25 R. P. C. 9, a stay was granted. See also *Muirhead v. Commercial Cable Coy.*, 12 R. P. C. 258, C. A.

(*s*) *Per Court of Appeal in Poulton v. Adjustable Cover Coy.*, 25 R. P. C. 661.

The fact that the patent has been revoked before the inquiry has been held does not affect the question of damages, *ibid*.

(*t*) *Saxby v. Easterbrook* (1872), L. R. 7 Ex. 207; *Murray v. Clayton* (1872), L. R. 15 Eq. 115 (damages); *Saccharin Corporation v. Chemical and Drugs Coy.*, 17 R. P. C. 743, C. A. (profits); *American Braided Wire Coy. v. Thomson*, 4 R. P. C. 375 (damages).

The dictum to the contrary effect, in *Holland v. Fox* (1854), 22 L. T. (o. s.) 228, must be taken to be overruled.

It has been held in Scotland that the plaintiff also must give discovery of his books in order to allow the falling off in trade to be ascertained. *Hamilton v. Neilson*, 26 R. P. C. 671.

(*u*) Sect. 33. This section is new, and only applies to patents "granted after the commencement of this Act," i.e. January 1st, 1908. These words are difficult to interpret. Considering the language of this section and of s. 98 (2), to which it forms an exception, it would certainly appear that a patent granted after the commencement of the Act means one which had been in fact sealed and issued after that date. On the other hand, s. 13 says that "a patent shall be dated and sealed as of the date of application," and for all other purposes the date of application is taken as the date of the grant. This point will need judicial determination.

(*x*) It is not clear whether this would affect an account of profits. As to the distinction between damages and profits, see pp. 194, 195.

The account of profits was a remedy

and year of the patent shall not be deemed to constitute notice (y).

The damages are also limited in cases where the patent has been amended (z).

#### *Delivery up.*

In addition to his remedy by injunction and damages the plaintiff is entitled to an order directing the defendant to deliver up to him or to destroy infringing articles (a). Modern practice has been to limit, where possible, this delivery up to the removal of infringing parts (b). Where the parts are not patentable in themselves and the only patent is for their use in a particular way the defendant may be allowed to keep the parts though ordered to remove them from the patented combination (c).

#### *Certificate of Validity.*

The Act provides that in an action for infringement the Court may certify that the validity of a patent came into

ancillary to an injunction, and in theory simply put the patentee in the same position as if the infringer were his agent. Since theoretically the infringer would be in no worse position than if he had not used the patent, it may be that it was intended to leave the right to such an account.

(y) The general object of the section would seem to be to force the patentee to adopt a practice of marking his articles similar to that enforced in the case of designs, but the provisions in the two cases vary widely. The onus of proving ignorance would be on the defendant. For a fuller discussion on this subject, see *Patents and Designs Act, 1907* (ROBERTS and MOULTON), p. 69.

(z) See p. 236.

(a) Delivery up is an additional remedy to damages, and the value of the articles delivered up will not be deducted from the damages. *United Telephone Coy. v. Walker*, 4 R. P. C. 63.

This order is not unfrequently stayed in view of an appeal. *Lancashire Explosives Coy. v. Roburite Explosives Coy.*, 12 R. P. C. 470, C. A.; *Hocking v. Fraser*, 3 R. P. C. 9. Sometimes on an undertaking by the defendant's solicitors. *Washburn and Moen Coy. v. Patterson*, 1 R. P. C. 191.

For other cases where delivery up was ordered, see *Frearson v. Loe* (1878),

9 Ch. D. 48; *Saccharin Corporation v. Anglo-Continental Coy.*, 17 R. P. C. 307; but see *British Motor Syndicate v. Andrews*, 16 R. P. C. 577; *Siddell v. Vickers*, 5 R. P. C. 101.

If not asked for at trial, it may be granted on an application to vary minutes (*Edison v. Holland*, 5 R. P. C. 483), but where delivery up has been ordered, it is too late for the defendants on such a motion to ask for the option of the destruction of the infringing parts. *British Westinghouse Coy. v. Electrical Coy.*, 28 R. P. C. 530.

In *United Telephone Coy. v. Henry*, 2 R. P. C. 11, where BACON, V.-C., decided for the defendant on the ground that the articles had not been sold, but only lent to a person who was in fact the plaintiff's agent, he dismissed a counter-claim by the defendant for the return of the articles on the ground that they were piracies. Cf. *contra*, *Vavasseur v. Krupp* (1870), 9 Ch. D. 357, C. A.

(b) *Edison v. Smith*, 11 R. P. C. 389, C. A.; *British Vacuum Cleaner Coy. v. Suctions, Ltd.*, 21 R. P. C. 303; *Needham v. Oxley* (1863), 8 L. T. 604 (the machines in this case were marked so that the plaintiff could follow them); *Automatic Weighing Machine Coy. v. Fearby*, 10 R. P. C. 442; *Howes v. Webber*, 12 R. P. C. 478.

(c) *Morgan v. Windover*, 7 R. P. C. 446.

question, and if such a certificate is given then the plaintiff in any subsequent action (*d*) for infringement shall recover his full costs, charges, and expenses as between solicitor and client (*e*), unless the Court otherwise directs (*f*).

The practice is to only give this certificate when the validity of the patent is wholly or in part established (*g*), but if validity is disputed in the defence the general practice is to give a certificate to a successful plaintiff, even if the defendant abandons his attack on the validity at the trial or does not appear (*h*).

If the Court is of opinion that the validity has been established it will in general grant the certificate even if the plaintiff

(*d*) Subsequent action means an action commenced after the certificate has been granted. *Automatic Weighing Machine Coy. v. Combined Weighing Machine Coy.*, 6 R. P. C. 120; *Same v. The International Hygienic Society*, 6 R. P. C. 475; *Saccharin Corporation v. Anglo-Continental Coy.*, 17 R. P. C. 307. See also *Penn v. Jack* (1866), 15 L. T. 385. The provision does not extend to petitions. As to threats actions, see p. 229 (*d*). A certificate may be given in respect of an expired patent. *Kane v. Boyle*, 18 R. P. C. 325.

(*e*) These costs may be on the higher scale. *Flour Oxidising Coy. v. Hutchinson*, 26 R. P. C. 597.

(*f*) Sect. 35.

(*g*) In one case a certificate was granted where the patent was held invalid, but the precedent has never been followed. *Haslam v. Hall*, 5 R. P. C. 1. This case was disapproved in *Acetylene Illuminating Coy., Ltd. v. United Alkali Coy., Ltd.*, 19 R. P. C. 213. Certificates have been granted as to certain claims when these have been held to be good though other claims were found to be bad. *Badische, &c. v. La Société des Usines de Rhone*, 14 R. P. C. 875.

Any attack on the patent is sufficient to justify a certificate, e.g. merely raising issue that patent was obtained by fraud. *Pilkington v. Yeakley*, 18 R. P. C. 457; *Sunlight Incandescent Gas Lamp Coy. v. Incandescent Gas Light Coy.*, 14 R. P. C. 757.

In *Witham Bros., Ltd. v. Catlow*, 25 R. P. C. 788, a certificate was granted that the grant was invalid, and in *Brooks v. Lamplugh*, 16 R. P. C. 46, that an alleged prior grant was invalid; but see p. 217, *n.* (*a*).

(*h*) There has been some divergence in the practice as to granting a certificate where the defendant does not appear at the trial. The following list of cases as to this, which is believed to be complete, may therefore be useful. The certificate has been granted where defendant did not appear at trial in *Haydock v. Bradbury*, 4 R. P. C. 74; *Edison Bell Phonograph Corporation v. Edison Phonograph Coy.*, 11 R. P. C. 33; *Edison United Phonograph Coy. v. Young*, 11 R. P. C. 489; *Saccharin Corporation v. Sitos*, 17 R. P. C. 536, *n.*; *Acetylene Illuminating Coy., Ltd. v. Midland Acetylene Coy.*, 17 R. P. C. 535; *Welsbach Incandescent Gas Light Coy. v. Krumm*, 18 R. P. C. 211; *Same v. M'Grady*, 18 R. P. C. 513; *Brooks v. Lycett*, 20 R. P. C. 390; *Soda Stream, Ltd. v. Davey*, 24 R. P. C. 763; *Jackson Boilers, Ltd. v. Fourness Lamp Coy.*, 28 R. P. C. 459.

It has been refused where defendant did not appear at trial in *Peroni v. Hudson*, 1 R. P. C. 261; *Webb Lamp Coy., Ltd. v. Thomas Atkinson*, 19 R. P. C. 599; *Gall v. O'Neill*, 27 R. P. C. 18.

It has also been granted in the following cases where defendant gave up contest as to validity at the trial. *Consolidated Pneumatic Tool Coy. v. Churchill*, 22 R. P. C. 367; *Chadburn v. Robinson*, 18 R. P. C. 468; *Bowden's Patent Syndicate, Ltd. v. Smith*, 22 R. P. C. 498.

It was refused under these circumstances in an old case. *Stocker v. Rodgers* (1843), 1 Car. & Kir. 99, and in *Presto Gear Case Coy., Ltd. v. Simplex Coy.*, 15 R. P. C. 644.

It has been granted in certain cases

fails on infringement (i), but it is sometimes refused where a decision is given for the defendant on infringement and the question of validity has not really been decided (k).

The certificate can be given by any Court (l) and there is no appeal against the grant of a certificate alone (m), though, of course, if the Court varies the decision below in other respects, it may also vary it as to the certificate. The propriety of the grant of the certificate cannot be challenged in a subsequent action (o).

Formerly the Courts were averse to granting a second certificate in regard to a patent (p), but this is now done if different issues have been raised in the second case (q).

The plaintiff should plead the fact that a certificate has been obtained (r). On proof of the certificate the plaintiff obtains his costs as between solicitor and client unless the Court deprives him of them. As a general rule he gets these costs even if the

where the action has been settled on terms. *Delta Metal Coy. v. Maxim Nordenfeldt Coy.*, 8 R. P. C. 247; *Coles v. Baylis*, 3 R. P. C. 178, but was refused in *Robertson v. Standard Piston Ring Coy.*, 27 R. P. C. 266, O. H.; *Ferguson Superheaters, Ltd. v. Askern Colliery Coy.*, 29 R. P. C. 431, where further authorities are given; *Claughten v. Foster*, 21 R. P. C. 17.

(i) *Automatic Weighing Machine Coy. v. Knight*, 6 R. P. C., at p. 307; *Shoe Machinery Coy. v. Cutkan*, 13 R. P. C. 141; *Birch v. Harrap*, 13 R. P. C. 615; *Pneumatic Rubber Stamp Coy. v. Lindner*, 15 R. P. C. 525; *Morrison v. Asplin*, 21 R. P. C. 557; *Hoffmann Manufacturing Coy. v. Auto Machinery Coy.*, 28 R. P. C. 153.

Where the Court of Appeal allows an appeal on the ground of non-infringement, it may allow the certificate to stand. *Hardmuth v. Baker*, 22 R. P. C. 66, C. A.; but this is not always done, e.g. *Gillette Safety Razor Coy. v. Anglo-American Trading Coy.*, 29 R. P. C. 341.

The House of Lords, in *Morris v. Young*, 12 R. P. C. 465, doubted whether a certificate could be given where the action was dismissed, but the practice now seems well established.

(k) *New Inverted Incandescent Coy. v. Cope and Timmins*, 23 R. P. C. 103; *Same v. Globe Coy.*, 23 R. P. C. 157.

See also *Jardine v. King*, 13 R. P. C. 411; *Martin v. Consell Iron Coy.*, 25 R. P. C. 27.

(l) There is no reported case where it has been granted by the House of Lords. It has frequently been granted by the Court of Appeal, e.g. *Birch v. Harrap*, 13 R. P. C. 615, C. A. It would seem that it can be granted by the Palatine Court. See Chancery of Lancaster Act (57 & 58 Vict. c. 16), s. 4. Prior to this Act the contrary was held in *Proctor v. Sutton Lodge Chemical Coy.*, 5 R. P. C. 184, but this decision was not followed in *Birch v. Harrap*, *supra*.

(m) *Haslam v. Hall*, 5 R. P. C. 144.

(o) *Peter Pilkington, Ltd. v. Massey*, 21 R. P. C. 697.

(p) E.g. *Edison and Swan Coy. v. Holland*, 6 R. P. C. 287.

(q) E.g. *Flour Oxidising Coy. v. Hutchinson*, 26 R. P. C. 597.

(r) *Pneumatic Tyre Coy. v. Chisholm*, 13 R. P. C. 488.

Solicitor and client costs were, however, given in this case. They had been claimed in the statement of claim, although the certificate had not been pleaded. In an old case Lord CAMPBELL, C.J., held that the proper course was to produce the record in the first case after the verdict in the second. *Newhall v. Wilkins* (1851), 17 L. T. (o. s.) 20; but see *Bovill v. Hadley* (1864), 17 C. B. (n. s.) 435.

issues in the second case are substantially different or if infringement only is in issue (s). It is not clear whether a certificate gives the patentee a right to solicitor and client costs if he has subsequently amended his patent (t). The right to solicitor and client costs does not extend to the costs of an appeal (u), or of a counterclaim for revocation (x).

### Costs.

Costs on the higher scale are frequently allowed in patent cases on the ground that scientific evidence has been necessary. But even in patent cases the allowance of such costs is the exception, not the rule, at the present day (y). These costs are allowed less frequently with regard to the proceedings on appeal, since the need for expert assistance is less (z), but they are sometimes given even there (a).

(s) See *Welsbach Incandescent Gas Light Coy. v. Daylight Coy.*, 16 R. P. C. 344; *United Telephone Coy. v. Townshend*, 3 R. P. C. 10; *Fabriques de Produits Chimiques de Thann v. Lafitte & Coy.*, 16 R. P. C. 61; *British Motor Syndicate, Ltd. v. Andrews*, 18 R. P. C. 577, C. A.; *United Telephone Coy. v. Patterson*, 6 R. P. C. 140; *British Vacuum Cleaner Coy., Ltd. v. Exton Hotels, Ltd.*, 25 R. P. C. 617; *United Telephone Coy. v. St. George*, 3 R. P. C. 321; *Automatic Weighing Machine Coy. v. Fearby*, 10 R. P. C. 442.

Solicitor and client costs have also been granted on judgment in default of appearance in *Saccharin Corporation v. Skidmore*, 21 R. P. C. 31, and on judgment in default of defence in *Saccharin Corporation v. Hopkinson*, 21 R. P. C. 272. On the other hand, they have been refused in *Otto v. Steel*, 3 R. P. C. 109; *Dunlop Pneumatic Tyre Coy., Ltd. v. Buckingham*, 18 R. P. C. 423; *Saccharin Corporation v. Dawson*, 19 R. P. C. 169; *Edison Bell Phonograph Coy. v. Waterfield, Clifford & Coy.*, 19 R. P. C. 329; *Automatic Weighing Machine Coy. v. National Exhibition Associations, Ltd.*, 8 R. P. C. 354. See also *Dunlop Pneumatic Tyre Coy., Ltd. v. Wilson*, 17 R. P. C. 332; *Same v. British and Colonial Coy.*, 18 R. P. C. 313; *Betts v. De Vitre* (1865), 11 Jur. (N. S.) 9. In *Dunlop Pneumatic Tyre Coy. v. New Ixion Tyre Coy.*, 15 R. P. C. 404, the

plaintiffs were given solicitor and client costs on the issue of validity only.

(t) In *Brooks v. Rendell*, 24 R. P. C. 17, it was held that amendment destroyed the effect of the certificate for this purpose; in *Badische, &c. v. Thompson*, 21 R. P. C. 480, that it did not. If the former view is correct, the certificate as to certain claims being valid, cf. p. 199, n. (g), would seem to be useless.

(u) *Incandescent Gas Light Coy. v. De Mare Coy.*, 13 R. P. C. 579, C. A.

(x) *British Vacuum Cleaner Coy. v. L. & S. W. Ry. Coy.*, 27 R. P. C. 670.

(y) They were given very much more freely in earlier days. The principles of the allowance of such costs are discussed in *Gadd v. Mayor of Manchester*, 9 R. P. C. 535; *Ellington v. Clarke*, 5 R. P. C. 319, C. A.; *Dunlop Pneumatic Tyre Coy. v. Wapshare Coy.*, 17 R. P. C. 460; *Consolidated Pneumatic Tool Coy. v. Clarke*, 23 R. P. C. 666; *Marconi v. British Radio Telegraph Coy.*, 28 R. P. C. 181.

Where the necessity for such evidence arises from the faulty drafting of the patent, they should not be allowed to the plaintiff. *Wenham Gas Coy. v. Champion Gas Coy.*, 8 R. P. C. 313.

(z) *Automatic Weighing Machine Coy. v. Combined weighing Machine Coy.*, 6 R. P. C. 372, C. A.

(a) E.g. In *Kaye v. Chubb*, 4 R. P. C. 303; *Andrews' Patent*, 24 R. P. C.



Solicitor and  
client costs.

Solicitor and client costs have been allowed to a defendant authority under the provisions of the Public Authorities Protection Act in English cases (*b*), but have been refused in Scotland (*c*). These costs may also be given where the plaintiff has obtained a certificate of validity in a previous action (*d*).

Cost of  
different  
issues.

Where a defendant succeeds on one of the issues of infringement or invalidity and loses on the other, there is considerable diversity in the practice as to costs. Some judges have taken the view that a defendant is entitled to come "armed with sword and dagger" and that if the plaintiff fails to prove that the defendant has infringed his legal rights he should pay all the costs. In other cases the costs have been given according to the issues (*e*). In many cases the issues, though legally

349; *Ellington v. Clark*, 5 R. P. C. 319; *British Liquid Air Coy. v. British Oxygen Coy.*, 25 R. P. C. 577; *Consolidated Pneumatic Tool Coy. v. Clark*, 24 R. P. C. 593; but *cf. Chamberlain v. Bradford Corporation*, 17 R. P. C. 78.

(*b*) *Chamberlain v. Bradford Corporation*, 17 R. P. C. 78; *Chamberlain v. Bradford Corporation*, 17 R. P. C. 78; *British Thomson Houston v. Manchester Corporation*, 20 R. P. C. 461.

(*c*) *New Conveyer Coy. v. Edinburgh, &c., Gas Commissioners*, 21 R. P. C. 147.

(*d*) See pp. 198 *et seq.*

(*e*) The following are some cases illustrating the diversities of practice.

Defendant succeeding on validity, no costs of infringement. *Philips v. Ivel Cycle Coy.*, 7 R. P. C. 77.

Defendant succeeding on infringement, no costs of issue of validity. *Needham v. Johnson*, 1 R. P. C. 49, C. A.; *Pilkington v. Massey*, 21 R. P. C. 712, C. A.

Costs of certain issues of validity to unsuccessful plaintiff. *Nordenfeldt v. Gardner*, 1 R. P. C. 75, C. A.; *Philpott v. Hanbury*, 2 R. P. C. 33; *Badische, &c. v. Levinstein*, 2 R. P. C. 73, C. A.; *Simmonds v. Hitchman*, 2 R. P. C. 117, *n.*; *American Braided Wire Coy. v. Thompson*, 4 R. P. C. 322; *Automatic Weighing Machine Coy. v. Knight*, 6 R. P. C. 120 and 306, C. A.; *Ungar v. Sugg*, 6 R. P. C. 337; *Tweedale v. Ashworth*, 7 R. P. C. 436; *Nobel's Explosive Coy. v. Anderson*, 11 R. P. C. 128; *Shoe Machinery Coy. v. Cutlan*, 13 R. P. C. 395; *Scott v. Hamling*, 14 R. P. C. 123;

*Sunlight v. Incandescent*, 14 R. P. C. 757; *Leeds Forge v. Deighton*, 19 R. P. C. 285; *Sirdar Rubber Coy. v. Wallington*, 22 R. P. C. 257; *Robertson v. Purdey*, 24 R. P. C. 273; *Foden v. Wallis*, 25 R. P. C. 501. See also *Preston and Ralston's Patent*, 26 R. P. C. 313; *Atkinson v. Britton*, 27 R. P. C. 469. For older cases see *Leish v. Hague* (1839), W. P. C. 209. See also *Deeley's Patent*, 12 R. P. C. 200, C. A.; *Geipel's Patent*, 21 R. P. C. 391, C. A.

Plaintiff succeeding on validity and defendant on infringement, a set-off ordered. *Foden v. Wallis*, 25 R. P. C. 501.

Petitioner succeeding on only one case of anticipation given whole general costs. *Andrews' Patent*, 23 R. P. C. 441.

Costs of infringement to unsuccessful plaintiff. *Young v. Rosenthal*, 1 R. P. C. 29; *Badische, &c. v. Levinstein*, 2 R. P. C. 73, 117, C. A.; *Pooley v. Pointon*, 2 R. P. C. 165 (and certain issues as to validity); *Lister v. Norton*, 3 R. P. C. 199 (and certain issues as to validity); *Binnington v. Hill*, 8 R. P. C. 332; *Cassel Gold Extraction Coy. v. Cyanide Recovery Coy.*, 11 R. P. C. 652; *Fawcett v. Homan*, 13 R. P. C. 275; *Kane v. Guest*, 16 R. P. C. 433.

Costs of both issues to defendant succeeding on infringement. *Musgrave v. Hicks*, 3 R. P. C. 49; *Ellington v. Clarke*, 5 R. P. C. 328, C. A.; *Boyd v. Horrocks*, 6 R. P. C. 162, C. A.; *Heideman v. Smokeless Powder Coy.*, 15 R. P. C. 305; *New Inverted Coy. v. Globe Coy.*, 22 R. P. C. 431.

Where defendant succeeded on

distinct, are practically the same, and although the defendant may succeed on non-infringement he only does so by showing that any wide interpretation of the patent would render it invalid (*f*).

Where a plaintiff sues on two or more patents, succeeding as to some but failing as to others, the usual course is to give him the general costs of the action but to order him to pay any extra costs due to the inclusion of the patents on which he has failed (*g*). Where several patents sued on.

The question of whether costs of more than two counsel shall be allowed is usually left to the Taxing Master (*h*), but sometimes the Court gives directions on this point (*i*). Certain Other points as to costs.

non-infringement, and had a counter-claim for revocation which was not opened, both action and counter-claim were dismissed with costs. *Babcock and Wilcox, Ltd. v. Water Tube Coy.*, 27 R. P. C. 627.

Where a defendant first denied and then admitted a licence, but succeeded on non-infringement, he was given all the costs. *Ashworth v. Roberts*, 9 R. P. C. 89, 109.

Costs of both issues to defendant succeeding on invalidity. *Guilbert Martin v. Kerr*, 4 R. P. C. 18; *Kaye v. Chubb*, 4 R. P. C. 289; *Edison v. Holland*, 5 R. P. C. 483; *Blakey v. Latham*, 6 R. P. C. 184, C. A.; *Wesley Richards v. Perkes*, 10 R. P. C. 181; *Parkinson v. Simon*, 11 R. P. C. 256; *Bimm v. Shoppee*, 28 R. P. C. 274, C. A.; *Donnersmarckhütte, &c. v. Electrical Construction Coy.*, 27 R. P. C. 774, C. A.

In some cases, though by no means always, the Court of Appeal have given no costs where the plaintiff appellant succeeds as to validity, but not as to infringement. *Cf. Moore v. Bennett*, 1 R. P. C. 129.

Sometimes an unsuccessful defendant has been given the costs of certain issues of infringement on which plaintiff failed. *Taylor v. Annand*, 17 R. P. C. 138, C. A.; *Mouchel v. Coignet*, 23 R. P. C. 665.

In some cases the whole costs have been apportioned where each party succeeded on some issues. *Monnet v. Beck*, 14 R. P. C. 777; *Dunlop Pneumatic Tyre Coy. v. New Ixion Coy.*, 15 R. P. C. 389.

Sometimes a party is given a portion of his costs. *Pneumatic Tyre Coy. v.*

*Casswell*, 13 R. P. C. 189; *Incandescent Gas Light Coy. v. Sunlight Coy.*, 13 R. P. C. 333. See also *Consolidated Pneumatic Tool Coy. v. Clark*, 24 R. P. C. 593, C. A.

(*f*) It is submitted that where a defendant shows that what he is doing was old at the date of the patent he should be entitled to the whole of the costs, whichever issue he may succeed on.

(*g*) *Edison v. Woodhouse*, 3 R. P. C. 178; *Hocking v. Fraser*, 3 R. P. C. 7; *Sutcliffe v. Abbott*, 20 R. P. C. 50; *Badische, &c. v. Hickson*, 22 R. P. C. 63; *True and Variable Electric Lamp Syndicate v. Bryant*, 25 R. P. C. 461; *Crosthwaite Fire Bar Syndicate v. Senior*, 26 R. P. C. 733.

In some cases there is an apportionment of the whole costs. *Incandescent Gas Light Coy. v. Sunlight Coy.*, 13 R. P. C. 346. See also *Consolidated Pneumatic Tool Coy. v. Clark*, 24 R. P. C. 593.

Where a plaintiff succeeded on two patents in two actions against the same defendant, he was only given the costs he would have obtained if one action had been brought. *United Telephone Coy. v. Sharples*, 2 R. P. C. 28.

(*h*) *Andrews' Patent*, 24 R. P. C. 378, C. A.

(*i*) *E.g. Carnegie Steel Coy. v. Bell Bros.*, 26 R. P. C. 265 (three counsel for one defendant, two for another); *Wilson v. Wilson Bros. Bobbin Coy.*, 28 R. P. C. 741 (three counsel refused). Sometimes three counsel have been allowed in the Court of Appeal, *e.g. Huskell Golf Ball Coy. v. Hutchinson*, 23 R. P. C. 320.

costs of shorthand notes may be allowed (*k*). The costs of exhibits may be allowed even if they have not been put to witnesses (*l*), and such exhibits remain the property of the party using them, although the other party has to pay such costs (*m*). The costs of inspections, etc., may be allowed even where these have been made without a special order (*n*). The costs of experts in the Court of Appeal will in general not be allowed, and if it is desired to get these costs an application should be made to this Court (*o*). The successful party in the Court of Appeal will receive his costs without an undertaking from his solicitor unless special cause is shown (*p*). Where the plaintiff is a company whose assets consist practically of the patent in question security for costs may be ordered (*q*).

Certificates.

Where any action for infringement, or petition under section 25 or counterclaim under section 32 for revocation, has proceeded to trial, the plaintiff shall not recover any costs on the issues raised in his particulars of breaches unless he obtains a certificate that he has proved them, and the defendant shall not get any costs of the issues raised by the particulars of objections unless he obtains a certificate that they were reasonable and proper (*r*). In cases where the action, etc., has not

(*k*) *British Westinghouse Coy. v. Braulik*, 27 R. P. C. 233, C. A. See also *Monnet v. Beck*, 14 R. P. C. 777; *Atkins and Applegarth v. Castner Kellner Coy.*, 18 R. P. C. 281; *Heidemann v. Smokeless Powder Coy.*, 15 R. P. C. 305; *Nordensfeldt v. Gardner*, 1 R. P. C. 61.

(*l*) *Wilson v. Wilson Bros. Bobbin Coy.*, *supra*.

(*m*) *Horrocks v. Stubbs*, 3 R. P. C. 229.

(*n*) *Ashworth v. English Card Clothing Coy.*, 21 R. P. C. 353; *Leeds Forge v. Deighton*, 20 R. P. C. 185.

(*o*) *Consolidated Pneumatic Tool Coy. v. Ingersoll Sergeant Drill Coy.*, 25 R. P. C. 574.

(*p*) Cf. *British Vacuum Cleaner Coy. v. L. & S. W. Ry. Coy.*, 28 R. P. C. 108, C. A.

(*q*) *Diamond Steel Coy. v. Harrison Brothers*, 27 R. P. C. 451.

(*r*) O. 53a, r. 22.

The application for these certificates should be made by the successful

party at the hearing. If made later no costs of such application will in general be allowed. *Rowcliffe v. Morris*, 3 R. P. C. 145; *Duckett v. Sankey*, 16 R. P. C. 357.

The certificate may be granted by any Court, e.g. by the Court of Appeal (see *Castner Kellner Alkali Coy. v. Commercial Development Coy.*, 16 R. P. C. 276), or the House of Lords. See *Morris v. Young*, 12 R. P. C. 455.

In *Haskell Golf Ball Coy. v. Hutchinson*, 23 R. P. C. 320, where the defendant succeeded in both Courts, the Court of Appeal gave a certificate for further particulars not allowed by the judge below (see also *Deutsche Nahmaschinen Fabrik v. Plaff*, 7 R. P. C. 259). It may be granted by a judge who has not tried the action. See *Rowcliffe v. Morris*, *supra*.

The Palatine Court has power to give these certificates. See Chancery of Lancaster Act, 1890 (57 & 58 Vict. c. 16), s. 4.

A plaintiff is entitled to the costs of proving the breaches unless unambiguous admissions have been made. *Bray v. Gardner*, 4 R. P. C. 400. See also *Badische, &c. v. Hickson*, 22 R. P. C. 63.

No certificate will be given where the plaintiff is not entitled to any costs. *Germ Milling Coy. v. Robinson*, 3 R. P. C. 260.

While a plaintiff has to prove his breaches, the defendant is entitled to a certificate if the objections are reasonable and proper. It is suggested that the proper criterion as to this is whether in the judge's opinion the defendant's advisers were justified in putting these objections forward in view of the case raised by the plaintiff in his pleadings, the character of the infringement, etc. See *New Inverted Coy. v. Globe Coy.*, 22 R. P. C. 431; *Jardine v. King*, 13 R. P. C. 411; *Philips v. Ivel Cycle Coy.*, 7 R. P. C. 77.

In general it is sufficient if they are reasonable and proper against any claim. *Cassel Gold Extracting Coy. v. Cyanide Gold Recovery Syndicate*, 12 R. P. C. 303, C. A.

Where the defendant proves that what he was doing was in fact old, it is submitted that the relevant particulars should in all cases be allowed, even if he succeeds on non-infringement, since the plaintiff's case must clearly have been based on a construction of the patent which would have covered what was in fact old.

As a general rule a Court will not give a certificate unless it is in a position to judge whether the particulars were reasonable and proper, nor will it hear evidence merely for this purpose. Where the plaintiff's case breaks down early, the defendant may therefore fail to obtain a certificate. *Mandleburg v. Morley*, 12 R. P. C. 35; *Dairy v. Bailey*, 8 R. P. C. 168; *Cole v. Saqui*, 5 R. P. C. 489; *Allen v. Pyatt*, 15 R. P. C. 723; *American Steel and Wire Coy. v. Glover*, 19 R. P. C. 111; *May v. Yuill*, 27 R. P. C. 526; *Badham v. Bird*, 5 R. P. C. 238; *Newsum v. Mann*, 7 R. P. C. 307; *Peters v. Owen Stone Coy.*, 15 R. P. C. 663. But see *Nuttall v. Hargreaves*, 8 R. P. C. 276.

It is not always necessary for particulars to be put separately, if plaintiff's witnesses admit the point. *Cooper v. London County Council*,

23 R. P. C. 289. See also *Germ Milling Coy. v. Robinson*, 3 R. P. C. 254; *Griffen v. Fever*, 6 R. P. C. 396.

The fact that the same particulars have been certified for in another action is not a reason for certifying. *New Inverted Coy. v. General Incandescent Coy.*, 22 R. P. C. 614; *Ashworth v. Horsfall*, 21 R. P. C. 47; *Cooper v. British Electric Coy.*, 23 R. P. C. 608. But *semble* proceedings in same action may be. *Ashworth v. Horsfall*, *supra*.

The former rule was that the Court of Appeal would not give a certificate unless they had gone into the case of invalidity. *Boyd v. Horrocks*, 6 R. P. C. 162, C. A. See also *Longbottom v. Shaw*, 6 R. P. C. 143, C. A.; but see *Castner Kellner Alkali Coy. v. Commercial Development Coy.*, 16 R. P. C. 276, C. A.; *Gillette Safety Razor Coy. v. Anglo-American Trading Coy.*, 29 R. P. C. 577, C. A.

In *Mouchel v. Coignet*, 24 R. P. C. 229, the Court of Appeal certified for such particulars as might be agreed, or in default of agreement settled by one of the judges.

An application may, however, be made to the judge of first instance for a certificate where the defendant has been successful on appeal. *Morgan v. Windover*, 7 R. P. C. 446. See also *Cropper v. Smith*, 2 R. P. C. 61.

Even where the defendant fails to obtain a certificate, the plaintiff does not get any costs of the particulars unless they are expressly given. *Garrard v. Edge*, 7 R. P. C. 139.

The Taxing Master may also allow proper costs of witnesses on other points, although they were primarily called on the issues raised by the particulars not included in the certificate. *Haskell Golf Ball Coy. v. Hutchinson*, 23 R. P. C. 125.

So also costs incurred as to prior specifications necessary to enable the judge to appreciate the state of prior knowledge for the purpose of construing the patent may be allowed by the Taxing Master without a certificate. *Piggott v. Hanley*, 23 R. P. C. 639. See also *Shoe Machinery Coy. v. Cutlan*, 12 R. P. C. 360; *Kelvin v. Whyte-Thomson*, 26 R. P. C. 734, O. H.; but sometimes a certificate is given for these: *Nettlefold v. Reynolds*, 9 R. P. C. 290; *Beavis v. Rylands*, 17 R. P. C. 93.

proceeded to trial (s) these costs remain in the discretion of the Taxing Master (t).

#### *Contempt of Court.*

The question frequently arises as to whether statements, made in the form of advertisements or otherwise during legal proceedings, as to the rights of the parties, or as to proceedings that are taking place in Court, constitute contempt of Court. The rule would seem to be that the existence of proceedings is no reason why the plaintiff should not continue the warnings that he will prosecute infringers (u), though he should not state that his success in the pending proceedings is certain or that the defendants have infringed (x). It is also a contempt of Court to make statements as to the invention being old (y).

With regard to accounts of proceedings that have taken place in Court a party is entitled to advertise these if the account is a true one, and if the proceedings have not been collusive. But any misrepresentation by the parties as to proceedings which have taken place in Court will be treated as a contempt (z), as may also be advertisements of proceedings which were in fact collusive, if another action is pending (a).

Where, however, both parties have written to the Press the Court will generally not interfere (b). It would seem that

(s) As to when an action has proceeded to trial, see *May v. Yuill*, 27 R. P. C. 526, where it was held that the action had proceeded to trial although the plaintiff did not appear at the hearing.

In *Thermos, Ltd. v. Isola, Ltd.* (unreported on this point), however, NEVILLE, J., held that where the plaintiff's counsel in opening had abandoned the case as to one of the patents sued on, the action with regard to this patent had not proceeded to trial.

Certificates for particulars have been given on judgment in default of appearance. *Saccharin Corporation v. Skidmore*, 21 R. P. C. 31, and in default of defence in *Brooks v. Hall*, 21 R. P. C. 29, and *Saccharin Corporation v. Hey*, 22 R. P. C. 212, where authorities are quoted.

(t) There is no reported case that throws light on what materials the Taxing Master will rely on, but see cases in note (r), *supra*, and *Bates v. Horsfall*, 22 R. P. C. 519. In general, when an action is discontinued by leave, these costs will be left to the

Taxing Master. *Bibby and Baron, Ltd. v. Duerden*, 28 R. P. C. 305.

(u) *Fenner v. Wilson*, 10 R. P. C. 283, C. A.; *Dunlop Pneumatic Tyre Coy. v. Clifton Tyre Coy.*, 19 R. P. C. 527; *Haskell Golf Ball Coy. v. Hutchinson*, 21 R. P. C. 497. But see *Fusee Vesta Coy. v. Bryant and May*, 4 R. P. C. 191 (threats after application to amend). See also *St. Mungo Manufacturing Coy. v. Hutchinson*, 25 R. P. C. 326.

(x) *Gaulard and Gibbs v. Lindsay*, 4 R. P. C. 189; *Fenner v. Wilson, supra*.

(y) *Daw v. Eley* (1865), L. R. 1 Eq. 49. See also *British Vacuum Cleaner Coy., Ltd. v. Suctions, Ltd.*, 21 R. P. C. 303; *St. Mungo Manufacturing Coy. v. Hutchinson*, 25 R. P. C. 356, O. H.

(z) *Edlin v. Pneumatic Tyre Coy.*, 10 R. P. C. 317; *Gillette Safety Razor Coy. v. Gamage*, 24 R. P. C. 1.

(a) *Roberts v. Graydon* (1903), unreported.

(b) *Daw v. Eley* (1865), L. R. 1 Eq. 49. See also *De Mare's Patent*, 16 R. P. C. 527.

where an injunction is granted to restrain such contempts no undertaking as to damages need be given (c).

### *Injunction—Breach.*

When a plaintiff has obtained an injunction against infringement he is entitled to raise the question of further infringement against the defendant, his servants or agents (d) by motion to commit for breach of the injunction, even if the infringement is of a substantially different character (e). It would seem, however, that it is not proper to raise the question in this way if the patent has been amended since the injunction, and, indeed, that such an amendment dissolves the injunction (f). Where the original injunction is held to be wrong and is dissolved, it would seem that the attachment proceedings fall with it (g).

When a breach of an injunction has been established an order may be made for the committal or attachment of the defendant, or, in the case of a limited company, an order for sequestration may be issued as well as orders for committal or attachment against the directors. In cases where the offence has been committed inadvertently or in ignorance of law or fact, the Court generally, instead of committing the defendant, orders him to pay the costs as between solicitor and client, and to make monetary compensation to the plaintiff (h). A motion for attachment or sequestration should only be made if there is

(c) See *Fenner v. Wilson, supra*.

(d) A person not a party to the former action, nor a servant or agent, will only be committed if he knowingly aids person enjoined not to infringe. *Incandescent Gas Light Coy. v. Sluce*, 17 R. P. C. 173. See also *Dudgeon v. Thomson* (1877), 3 A. C. 34, H. L., where the petition was to commit previous defendant and his partner.

(e) *Lancashire Explosives Coy. v. Roburite Explosives Coy.*, 13 R. P. C. 429, C. A., and 14 R. P. C. 303, H. L.; *Thomson v. Moore*, 7 R. P. C. 325, C. A. Ir.

Where an injunction was granted against dealing in "Victoria" lamps, *KEKEWICH, J.*, held on a motion to commit for breach that if a lamp came within the class known as Victoria lamps it was immaterial whether it in fact infringed or not. The case was compromised on appeal. *Brockie Pell Coy. v. Johnson*, 17 R. P. C. 697. Cf. *Daw v. Eley* (1867), L. R. 3 Eq. 496.

In the same case he held that where certain lamps already sold on which damages were paid were excepted from the injunction, it was, nevertheless, a breach to buy them back and sell them again.

For cases where articles made according to a special process are excepted from the injunction, see *Spencer v. Ancoats Coy.*, 6 R. P. C. 46. See also *Roberts v. Graydon*, 21 R. P. C. 194.

(f) *Dudgeon v. Thomson, supra*.

(g) See per Lords **HERSCHELL** and **MORRISON**, in *Graydon v. Basset*, 13 R. P. C.

(h) See *inter alia*, *Welsbach Incandescent Coy. v. Keegan*, 17 R. P. C. 44; *Lyon v. Goddard*, 11 R. P. C. 113.

In *Spencer v. Ancoats Coy., supra*, solicitor and client costs were not given.

In *Plimpton v. Spiller* (1877), 4 Ch. D., C. A., an interim injunction was granted.

In *Hattersley v. Hodgson*, 22 R. P. C. 229, an order for sequestration was

wilful disobedience to the order (*i*). The ordinary rule as to the evidence being served with the notice applies (*k*). There is an appeal when an order is made against the defendant (*l*).

### *Estoppel.*

The circumstances under which parties are precluded from disputing the validity of Letters Patent because of their position as licensees (*m*) or assignors (*n*) has been discussed elsewhere, but certain other questions of estoppel arise in patent cases.

The point has several times been discussed how far the decisions on different issues act as an estoppel in a subsequent action between the same parties and their agents (*o*). Where a plaintiff has been successful further questions of infringement are usually tried on a motion to commit the defendants for breach of the injunction (*p*), when, of course, validity does not come into question, but if a separate action is started the defendant cannot challenge validity on any ground which would have been open to him in the first action (*q*). The

issued, but ordered to lie in the office until there was another infringement. The defendants appealed unsuccessfully, but solicitor and client costs of the appeal were not allowed. See also *Harvie v. Ross*, 4 R. P. C. 239, I. H.

(*i*) *Meters, Ltd. v. Metropolitan Gas Meters*, 24 R. P. C. 506.

As to the position of persons, such as a ship's captain, who are under the necessity either of disobeying an injunction or neglecting their duty, see *Adair v. Young* (1879), 12 Ch. D. 21.

(*k*) O. 44, r. 1.

In *Spencer v. Ancoats Coy.*, *supra*, the Court of Appeal allowed the plaintiff to introduce fresh evidence. The point as to the necessity of copies of the evidence being served with the notice of motion does not seem to have been raised.

In *Badische, &c. v. Thomson*, 21 R. P. C. 469, C. A., where plaintiff had abandoned a motion to commit, a second motion for a breach prior to the first motion was dismissed.

(*l*) *E.g.* in *Bassett v. Graydon*, 14 R. P. C. 704, H. L., see generally O. 44, r. 1. It is very doubtful where the Court of Appeal would ever interfere with a refusal to commit. *Cf. Badische, &c. v. Thompson*, 21 R. P. C. 472, C. A.

(*m*) See p. 244.

(*n*) See p. 8.

(*o*) Of course agents mean agents in law, not merely what may be called agents in a particular trade. *Cf. Dunlop Pneumatic Tyre Coy. v. Rimington*, 17 R. P. C. 655, C. A.

Although there is no direct decision there can be little doubt that the estoppel would apply in the case of an action by the assignee of the patent.

(*p*) See p. 207.

(*q*) See *Brown v. Hastie*, 23 R. P. C. 360, H. L.; *Dunlop Pneumatic Tyre Coy. v. Rimington*, *supra*; *Thomson v. Moore*, 7 R. P. C. 325, H. L.

In *Goucher v. Clayton* (1865), 11 L. T. 732, where in an action judgment was allowed by agreement to go for the plaintiffs for 40s. damages, the plaintiffs agreeing to grant the defendants a licence for a certain term, it was held that in an action brought after the termination of the licence there was no estoppel by the previous judgment, as the judgment and licence were all part of one arrangement. In *Newall v. Elliot* (1863), 32 L. J. (EX.) 120, it was held that the award of an arbitrator finding generally that a patent was valid was not an estoppel on the question of validity in a subsequent action on another infringement.

It would be open to the defendant to raise objections which could not

decision on the issue of infringement binds the defendant only so far as concern articles identical, or substantially identical (*r*), with those in the former action. The fact that in the former action the patent was treated as one to be interpreted broadly does not prevent the defendant contending in a later action that its scope is restricted (*s*). But if the defendant was successful on the issue of non-infringement it would appear that the plaintiff could not sue for any infringement prior to the issue of the writ in the first action (*t*).

Where certain issues have been decided in favour of the plaintiff and certain others in favour of the defendant it would seem there may be an estoppel in the case of a further action against contesting these issues if the circumstances are identical (*u*). It is very doubtful how far this is the case where the patent has been amended in the interval (*x*).

Questions have also arisen as to how far parties who have allowed infringement to continue, or induced it by their acts, are estopped from claiming relief. There is no case where such estoppel has been established so as to bar all relief unless the plaintiff or his agent was actually a party to the acts in question (*y*).

have been raised in the prior action, e.g. that the patent had lapsed, or was invalid on the ground of the manufacture now being carried on wholly abroad, or because of contracts made since the date of the previous action containing terms repugnant to s. 38.

(*r*) See *Thomson v. Moore*, 7 R. P. C. 325, 334, H. L.; *Same v. Hughes*, 7 R. P. C. 71.

(*s*) *Brown v. Hastie*, 23 R. P. C. 361, H. L. See also *Dudgeon v. Thomson* (1877), 3 A. C. 34, H. L.

In *Brown v. Hastie*, *supra*, the defendant in the second action referred to prior specifications to limit the construction of the patent. These were not considered in the House of Lords.

(*t*) Cf. *Badische, &c. v. Thompson*, 21 R. P. C. 471.

(*u*) Where in one action the Court decided that a patent was valid, but had not been infringed, it was held that in a second action on a different infringement the defendant could not attack validity. *Shoe Machinery Coy. v. Cutlan*, 13 R. P. C. 141.

(*x*) See *Horrocks v. Stubbs*, 13 R. P. C. 69, C. A.; *Deeley's Patent*, 11 R. P. C. 716; 12 R. P. C. 199, C. A. *Westinghouse v. Lancashire and Yorkshire Ry. Coy.*, 1 R. P. C. 229.

(*y*) See *Procter v. Bennis*, 4 R. P. C. 333, C. A.

As to delay barring right to special relief, see *Thomson v. Moore*, 6 R. P. C. 426, C. A. Ir. See also *Siddell v. Vickers*, 5 R. P. C. 100, and cases at p. 192, *n.* (*n*), and p. 162, *n.* (*y*).



## CHAPTER XI

### REVOCATION

A PETITION for the revocation of Letters Patent may be presented by the following persons (a)— Who may petition.

(1) The Attorney-General or any person authorised by him (b).

The Attorney-General's fiat is not granted as a matter of right (c), but is generally granted if the petitioner is a responsible person who shows an interest in obtaining the revocation and makes out a *prima facie* case (d). It will be granted

(a) Sect. 25. The defendant in an infringement action who would be entitled to petition may also proceed by way of counterclaim: s. 32.

(b) In Scotland the procedure is by an action of reduction at the suit of the Lord-Advocate or some person interested authorised by him: s. 94 (3). Even where this authority has been given the action will be dismissed unless the pursuer can show a personal interest, *Melville v. Cummings*, 29 R. P. C. 100 O. H.; reversed on facts, 29 R. P. C. 665, I. H. It would seem that in Ireland the Attorney-General for Ireland can grant the fiat though the point is not clear: s. 95.

(c) See *R. v. Prosser* (1848), 18 L. J. (CH.) 35.

(d) The fact that the applicant is an *alien ami* is no bar to the fiat being granted. *R. v. Prosser, ubi supra*.

The procedure for obtaining the fiat is as follows:—

The following documents have to be lodged with the Law Officer's chief clerk, Law Courts:—

(i) Memorial asking for fiat signed by party applying, or in the case of a firm by a partner on its behalf. In the case of a company this must be under seal.

(ii) Statutory declaration that statements in memorial are true, to be made by the parties signing the memorial, or in the case of a company by the secretary or other proper officer able to verify the statements.

(iii) Two copies of proposed particulars of objections.

(iv) Two copies of proposed petition; or of defence and counter-claim.

(v) In an action one copy of Pleadings so far as they have gone.

(vi) Certificate of counsel that it is a fit and proper case for the fiat to be granted.

(vii) Certificate of solicitor that the petitioner is a fit and proper person to petition, and is able to answer all costs in connection with the same.

(viii) A short statement showing in what respects the inventions described in the specifications referred to in the particulars of objections resemble those in the Letters Patent sought to be revoked.

A fee of £2 13s. 4d. has to be paid and the declaration must bear a 2s. 6d. impressed stamp.

All information, etc., has to be written on judicature paper on one side only, and all papers are to be headed:

to enable a defendant to claim revocation by way of counter-claim (e), and may be granted even if the patent has expired (f).

(2) A person alleging that he or some person under or through whom he claims was the first and true inventor. The question of who is the first and true inventor is dealt with elsewhere (g). There is no reported decision of the High Court as to what is covered by the words "under or through whom he claims," but a mere power of attorney does not give a person a locus to petition (h).

(3) A person alleging that the patent has been obtained in fraud of his rights or of the rights of some person under or through whom he claims. Fraud here, as ordinarily, implies a dishonest action of some kind, and a mistake honestly made does not give rise to any claim under this head, nor will the Court consider whether a party, who has acted honestly, has correctly interpreted his legal rights (i). The fraud must be proved conclusively, and the Court is not ready to infer it (k). On the other hand the Court will look at the conduct of the patentee subsequent to the application for the patent, as throwing light on his motives, and the fact that the petitioner has acquiesced in the patentee's obtaining the patent will not prevent his

" In the Matter of the Patents and Designs Act, 1907,

In the Matter of Patent No. . . . "

and in the case where the proposed petition is to be by way of counter-claim the style of the action is also to be added.

(e) *E.g.* in *British Vacuum Cleaner Coy., Ltd. v. L. & S. W. Rail. Coy.*, 27 R. P. C. 649.

(f) *North-Eastern Marine Engineering Coy., Ltd. v. Leeds Forge Coy., Ltd.*, 23 R. P. C. 96 and 529, C. A.

(g) See Chapter IV., pt. 1. In *Walker v. Hydrocarbon Syndicate*, 1 R. P. C. 37, the respondent was allowed to refer to prior specifications to show that the petitioner had not made the invention or to limit his claims, see also p. 266, n. (a).

(h) *Avery's Patent*, 4 R. P. C. 152; but see *Gascoigne's Patent*, 27 R. P. C., 78 C. G., where it was held to mean only executors and administrators.

(i) *Avery's Patent*, 4 R. P. C. 165 and 322, C. A.; *Jackson's Patent*, 22 R. P. C. 387; *Marks's Patent*, 25

R. P. C. 553; *Preston and Ralston's Patent*, 26 R. P. C. 313.

(k) *Marks's Patent, supra.*

The following are cases where fraud was held to be proved:—

*Haddan's Patent*, 2 R. P. C. 218; *Gale's Patent*, 8 R. P. C. 438; *Norwood's Patents*, 12 R. P. C. 214; *Norwood's Patents (No. 2)*, 15 R. P. C. 98; *Marshall and Naylor's Patent*, 17 R. P. C. 553; *Smith's Patent*, 22 R. P. C. 57; *Preston and Ralston's Patent*, 26 R. P. C. 313.

In the case of *Norwood's Patent (No. 2)*, *supra*, a second patent for a mere offshoot from the invention made by the petitioner which he would have been entitled to include in the first patent, which it was proved had been obtained in fraud of his rights, was ordered to be revoked.

In the following cases fraud was held not to be proved:—

*Avery's Patent, supra*; *Marks's Patent, supra*; *Jameson's Patent*, 19 R. P. C. 246; *Scott's Patent*, 20 R. P. C. 257; *Jackson's Patent*, 22 R. P. C. 384.

succeeding if fraud is proved (*l*). It is not necessary that all the patentees should have been parties to the fraud (*m*).

Where it is proved that part of the invention has been obtained in fraud of the petitioner the patentee will not in general be given an opportunity of amending by disclaimer, but the patent will be revoked (*n*).

This ground is quite distinct from the ground that the petitioner is the true and first inventor, and if the petition only alleges fraud the petitioner will not be allowed to try the question of true and first inventor (*o*).

As the importer of an invention is the inventor within the meaning of the Statute of Monopolies (*p*) the Court does not consider the question of fraud abroad (*q*).

(4) A person alleging that he, or some person under or through whom he claims an interest in any trade business, or manufacture, had publicly manufactured used or sold within this realm prior to the date of the patent anything which the patentee claims as his invention.

It would seem that where the petitioners' title is a derived one the user by his predecessors must have been in the course of the business, etc., to which the petitioner has succeeded. It is necessary for the petitioner to show strictly that the claim covers that which he has done, the grounds are much narrower than those on which subject-matter can be attacked (*r*).

Any person petitioning may rely on any ground on which the patent might immediately before January 1, 1884, have been repealed by *scire facias*, i.e. on any of the ordinary grounds of objection to Letters Patent, and may also allege that the invention has not been worked to a sufficient extent in this country, or that there are grounds on which the patent might be revoked as an alternative to the grant of a compulsory license (*s*). It would seem, however, although the point has

Grounds for revocation.

(*l*) *Ralston's Patent*, 26 R. P. C. 313. See also *Marshall and Naylor's Patent*, 17 R. P. C. 533.

(*m*) *Ralston's Patent*, *ubi supra*.

(*n*) *Ralston's Patent*, *ubi supra*; cf. *Norwood's Patent (No. 2)*, *ubi supra*.

(*o*) *Avery's Patent*, *ubi supra*.

(*p*) See Chapter IV., pt. 1.

(*q*) *Avery's Patent*, *ubi supra*, and see pp. 73, 74. As to equitable relief see p. 73, nn. (*q*) and (*r*).

(*r*) *Dege's Patent*, 12 R. P. C. 448, 452. See also *Mark's Patent*, 25

R. P. C. 553. For a case where this ground was established, see *Sinnette's Patent*, 15 R. P. C. 761.

(*s*) Sect. 25, and *Morgan's Patent*, 5 R. P. C. 186, 187. See NON-WORKING, Ch. XVI., and COMPULSORY LICENSES, p. 251.

Grounds of defence based on the provisions of s. 38 (restrictive conditions), see p. 248, cannot be relied on by a petitioner. It would seem that the grounds mentioned are the only grounds for such a petition, and that

never been definitely decided, that unless the Petitioner establishes those facts which give him a *locus standi* the petition will be dismissed (*t*). It is therefore safer in all cases to obtain the fiat of the Attorney-General.

**Parties.**

There may be more than one petitioner, but in general they cannot sever and be separately represented, though this has been permitted by consent (*u*). The petitioner may be ordered to give security for costs in cases coming within the rules (*x*).

All parties beneficially interested should be made parties to the petition, and if the interest appears from the petition or the register the Court will insist on this being done (*y*). In the case of other persons who are not made parties having an interest the Court will usually allow them to appear (*z*), but if the patent be revoked in their absence they apparently have no remedy. It is no longer necessary to join persons whose interest has ceased, and the Court will probably exercise its old jurisdiction in the case of a *scire facias* to protect persons who have been unnecessarily joined (*a*).

In the case of a patentee residing abroad the general course has been to direct notice of the petition to be sent to him, and for the case to go into the witness list. If the patentee does not then appear the case proceeds in his absence (*b*). A

other grounds, *e.g.* that the patent was taken out to defeat an Act of Parliament, cannot be used. *Vaisey's Patent*, 11 R. P. C. 591, 593. This point, however, would not seem free from doubt. For a case in which the objection that the object of the patented invention was illegal was raised, see *Pessers v. Hayden*, 26 R. P. C. 60.

(*t*) *Dege's Patent*, 12 R. P. C. 448. *Max Muller's Patent*, 24 R. P. C. 465. In these cases, and also in *Jameson's Patent*, 19 R. P. C. 246, the petitioner was allowed to obtain the fiat and amend his petition accordingly. See *contra*, *Morgan's Patent*, 5 R. P. C. 187.

(*u*) *Norwood's Patent*, 12 R. P. C. 214.

(*x*) See O. 65, r. 6 n, "Petitioner." Where the fiat is obtained terms as to security may be imposed.

(*y*) *Avery's Patent*, 4 R. P. C. 159.

If two respondents are served and are separately represented, they are each entitled to costs, although one may have taken no part in the case. *Brown's Patent*, 24 R. P. C. 346.

(*z*) *Miller's Patent*, 15 R. P. C. 205.

In *Haddan's Patent*, 2 R. P. C. 218, the patentee had assigned after the petition, and the new patentee was allowed to be substituted for the old on terms as to security for costs. See also *Golstein's Application*, 27 R. P. C. 289, C. G., p. 291.

(*a*) See *R. v. Betts* (1850), 19 L. J. (q. B.) 531.

(*b*) *Drummond's Patent*, 6 R. P. C. 576; *Kay's Patent*, 11 R. P. C. 279, following the practice adopted in a Trade Mark case. *In the Matter of Frederick King & Coy.'s Trade Mark*, 9 R. P. C. 350, C. A.; *Hirschfield's Patent*, 11 R. P. C. 514; *Goertz und Hoegh's Patent*, 12 R. P. C. 370; *Cerckle's Patent*, 15 R. P. C. 500.

It should be noted that in *Drummond's Patent*, *ubi supra*, the patentee was resident in Scotland, and the right was reserved to him to object to the jurisdiction.

In *Kay's Patent*, *ubi supra*, special directions were given that case should not come on for hearing in

respondent out of the jurisdiction will not be ordered to give security for costs (c).

A petition can be presented to any division of the Court, *Procedura*, and may be transferred from one division to another (d).

A patent can only be revoked in open Court (e), and the patentee has in all cases the right to have the case heard on oral evidence (f). In many cases, however, the patent has been revoked by consent (g), or on evidence by affidavit (h), and the patentee can also at any time offer to abandon the patent (i).

The order for revocation is as a rule made with costs even where there is no opposition (k). Generally where fraud is alleged the costs of this issue are dealt with separately (l).

The petition should not be put into the witness list till it is ready to come on as an effective cause (m).

The onus is on the petitioner to prove his grounds for revocation (n), but the patentee always has the right to begin (o), although he may waive such right (p).

the absence of the foreign patentee, without leave from the judge.

The Patent Rules provide for the registration of an address for service by foreign applicants and patentees, see r. 8, and as to service of proceedings at such address, see *Smollen's Trade Mark*, 29 R. P. C. 158.

(c) *Miller's Patent*, 11 R. P. C. 55.

(d) *Edmund's Patent*, 6 R. P. C. 355; *Edge's Patent*, 8 R. P. C. 74.

In fact such petitions are now always presented to the Chancery Division. They are not necessarily assigned to the Special Judge. See Patent and Designs Act, 1908 (8 Ed. VII, c. 4), s. 1.

(e) This order will not be made in Chambers even by consent, *Clifton's Patent*, 21 R. P. C. 515. The remarks of JOYCE, J., in *Scott's Patent*, 20 R. P. C. 604, did not mean that this could be done, see *per* BUCKLEY, J., in *Clifton's Patent*, *ubi supra*. See also *Dawson's Patent*, 24 R. P. C. 140.

(f) *Gaulard and Gibb's Patent* (1887), 34 Ch. D. 396.

(g) It is not necessary for the patentee to be separately represented, *Clifton's Patent*, *ubi supra*, or apparently to be represented at all, *Simmon's Patent*, 12 R. P. C. 446.

This order may be made on application for directions. *Simmon's Patent*, *ubi supra*; *Wallace's Patent*, 12 R. P. C. 444; *Vaisey's Patent*, 11 R. P. C. 591;

*Kay's Patent*, 11 R. P. C. 279; *Sleight's Patent*, 10 R. P. C. 447.

(h) *Slingsby's Patent*, 27 R. P. C. 524; *Vaisey's Patent*, 11 R. P. C. 591; *Lee's Patent*, 23 R. P. C. 233.

(i) Sect. 26 (4).

(k) *Scott's Patent*, 20 R. P. C. 604; *Scott's Patent*, 19 R. P. C. 280; *Simmon's Patent*, *ubi supra*; *Wallace's Patent*, *ubi supra*; *Rendell's Patent*, 11 R. P. C. 277; *Sleight's Patent*, 10 R. P. C. 447, and even if no notice was given of the intention to present the petition, *Aylott's Patent*, 28 R. P. C. 228; *Merryweather's Patent*, 29 R. P. C. 64. These costs include costs of obtaining fiat. *Poullton's Patent*, 23 R. P. C. 571; but see *Rendell's Patent*, *ubi supra*.

In *Slingsby's Patent*, 27 R. P. C. 524, the order was made without costs on the ground that the petitioners had themselves suggested to the respondents that they should take out the patent.

(l) *E.g. Scott's Patent*, 19 R. P. C. 280.

(m) *Borrowman's Patent*, 19 R. P. C. 159; *Scott's Patent*, 19 R. P. C. 273.

(n) *Cf. inter alia*, *Jameson's Patent*, 19 R. P. C. 246. This was also so in *scire facias*. *R. v. Cutler* (1847), 3 Car. & K. 215.

(o) O. 53a, r. 12.

(p) *E.g. Edmond's Patent*, 6 R. P. C. 55.

No estoppel  
against  
petitioner.

As the petitioner is considered to be acting in a public capacity neither he nor the patentee is estopped by a decision in a previous action (*q*). Consequently the Court would in general not interfere with the trial of a petition on the ground of other proceedings or appeals being pending, but such an order has been made on agreed terms (*r*). There are no decisions showing how far the petitioner may be estopped by his conduct (*s*).

An unsuccessful petitioner can also apparently petition again on fresh grounds (*t*).

Order and  
appeal.

Of course an order for revocation puts an end to an injunction and all other rights depending on the patent. It does not, however, affect a claim for past royalties or for damages under an order already made, whether such damages are ascertained or not (*u*).

If an order is made revoking the patent it is the common course to stay such order pending an appeal (*x*).

Grant of fresh  
patent.

Where the petitioner establishes that the patent has been obtained in fraud of his rights the comptroller may, on the application of the true inventor, grant him a patent in lieu of and bearing the same date as the patent so revoked, but no action shall be brought for any infringement committed before the actual date when such patent was granted (*y*).

(*q*) Thus an unsuccessful defendant may petition for revocation. *Deeley's Patent*, 12 R. P. C. 192; *Jameson's Patent*, 19 R. P. C. 246, 252; *Poullton's Patent*, 23 R. P. C. 183. There is no decision as to whether this applies to a counter-claim.

So a decision in an action as to a patent covering a particular machine does not bind the Court on a subsequent petition, except that it may, as a decision on a pure point of construction, bind a Court of equal jurisdiction. *Lewis and Sterckler's Patent*, 14 R. P. C. 24.

(*r*) *E.g. Hitchcock's Patent*, 20 R. P. C. 767.

(*s*) *E.g.* if he is assignor of patent. The motives of the petitioner would seem to be unimportant *cf. Taylor's Patent*, 28 R. P. C. 296.

In *Brown's Patent*, 25 R. P. C., at p. 111, C. A., statements made by the petitioner (who was not called) in a provisional specification were taken against him, and this evidence would only seem to be relevant on the ground of estoppel.

Formerly the Court would stay a *scire facias* pending an appeal in an action. *R. v. Neilson* (1842), W. P. C. 673.

In *Scott's Patent*, 24 R. P. C. 100, an order was made by consent that unless an appeal in a patent action was successful the patent should be revoked with costs, if it was successful the petition should be dismissed with costs.

(*t*) *Avery's Patent*, 4 R. P. C. 152, 166.

(*u*) *Poullton v. Adjustable Boiler Coy.*, 25 R. P. C. 529, 661, C. A.

(*x*) *E.g. Poullton's Patent*, 23 R. P. C. 183.

Terms may, however, be imposed; thus in this case it was made a term of granting a stay that an injunction obtained by the respondent against the petitioner should be suspended. For other instance of special terms, see *Alsop's Patent*, 24 R. P. C. 733.

(*y*) Sect. 15. Where only part of the invention has been obtained from the petitioner the declaration is

In the case of a petition to the Court for revocation there is an unrestricted right of appeal (z).

Where there is a remedy by way of petition for revocation the Court will not entertain an action asking for a declaration that the patent is bad, or that a state of facts exist that would justify revocation (a). But a petition may be presented even after the patent has expired (b). Where open petition is proper remedy.

The practice in regard to giving particulars of objection and obtaining certificates for the same (c), amendment of the specification during proceedings (d), and the course of procedure generally, is identical with that in infringement actions (e). The provisions as to certificate of validity, and the consequences as to costs, apply only to actions for infringement and not to proceedings for revocation (f). Points of practice.

only as to that part. *Ralston's Patent, ubi supra.*

(z) Patent and Designs Act, 1908 (8 Ed. VII. c. 4), s. 1.

(a) *North Eastern Marine Engineering Coy., Ltd. v. Leeds Forge, Ltd.*, 23 R. P. C. 529, C. A.; *Traction Corporation v. Bennett*, 25 R. P. C. 819.

In the latter case the Court held that an allegation of fraud, not amounting to fraud actionable at Common Law, but which might form grounds for a petition for revocation, gave no right to damages or an injunction against dealing with the patent.

(b) See cases in last note. However, in *Ludlow's Patent*, 29 R. P. C. 616, where the petition had been presented after the patent had lapsed it was dismissed with costs.

The object of such a petition is, of course, to prevent claims for past breaches.

(c) O. 53a, rr. 11-22.

(d) See Chapter on AMENDMENT.

(e) The petition may be amended from time to time with the leave of the Court. For cases where amendment has been allowed see *Avery's Patent*, 4 R. P. C. 159; *Dege's Patent*, 12 R. P. C. 452; *Jameson's Patent*, 19 R. P. C. 246; *Max Muller's Patent*, 24 R. P. C. 465.

For cases where it has been refused see *Avery's Patent*, 4 R. P. C. 328, C. A.

Amendments of the particulars are allowed on the ordinary terms, see Chapter on PRACTICE, pp. 175 *et seq.*, and O. 53a, r. 19.

(f) Sect. 35.

## CHAPTER XII

## THREATS

A PERSON who is aggrieved by statements to the effect that he is infringing a patent may have one or more of three remedies. Remedies for threats.

Firstly, he may rely on his common law rights and bring an action on the case on the ground that the defendant has maliciously made untrue statements which have caused, or must inevitably cause, actual damage to him. This action lies against any person, whether he purport to be a patentee or not, but the plaintiff must establish the three necessary points, viz. untrue statements, malice, and actual damage. Since this burden lies on the plaintiff, and the Court is not asked to presume either malice or damage, there is probably no limitation to the form of statement which will give a cause of action, such as there is in the case of an action founded on section 36 of the Act. Common law remedy.

On the first point the plaintiff must prove publication by the defendant or his agent of the statement complained of, and that such statement was untrue in fact. In cases where such statement involves the fact that certain Letters Patent are valid the plaintiff may have to attack their validity (a). Untrue statement.

The plaintiff has also to prove actual malice (b), i.e. that the statements were made without any belief in their truth, and Malice.

(a) Cf. *Wren v. Wild* (1869), 38 L. J. (Q. B.) 88. As the onus of proving invalidity is on the plaintiff he has the right to begin and reply, *ibid.*

(b) *Colley v. Hast*, 7 R. P. C. 101, 112; *Halsey v. Brotherhood* (1881), 19 Ch. D. 386, 388, 390, C. A.; *Wren v. Wild* (1869), 38 L. J. (Q. B.) 327; *Gillespie v. Young* (1867), 3 S. IV. 715, H. L.; *Burnett v. Tate* (1882), 45 L. T. 743; *Sugg v. Bray*, 2 R. P. C. 223 (where authorities are

collected); *Brauer v. Sharp*, 3 R. P. C. 193, 197; *Herrburger v. Schwander et Cie v. Squire*, 5 R. P. C. 581; *Incandescent Gas Lighting Coy. v. Sunlight Coy.*, 14 R. P. C. 180; *Temler v. Stevenson*, 15 R. P. C. 24; *Cars v. Bland Light Syndicate, Ltd.*, 28 R. P. C. 33.

In *Cars v. Bland Light Syndicate, Ltd.*, *supra*, at p. 38, WARRINGTON, J., held that knowingly false statements, not referring to the patents, contained in the circulars complained of



with the knowledge that they might be injurious to some person, though it is probably not necessary to show that the defendant had any feeling of hostility against the actual plaintiff (c). Absence of any reasonable or probable ground for making the statement would only be evidence on this issue, though in some cases it might make it so impossible to believe that the statement complained of had been made *bond fide* that the Court would act on this evidence alone (d).

In the case of statements made by an agent of the party sued presumably the same rules would apply as in actions for deceit (e), or for libel where there is qualified privilege (f).

Actual  
damage.

Proof of actual damage is essential, and only such damages can be recovered in an action on the case (g).

were evidence of malice. He also held that the object of the circulars being to stop the plaintiff's trade they were malicious. But as to the last point, see *Halsey v. Brotherhood* (1881), 19 Ch. D., at p. 388, C. A.; cf. also *Mellin v. White*, [1895] A. C. 154; *Montgomery v. Paterson*, 11 R. P. C. 237 O. H.

Some of the earlier cases, such as *Dick v. Brooks* (1880), 15 Ch. D. 22, C. A., would seem to suggest that if the patentee mis-stated his rights even honestly, it would give a cause of action, but this case is explained in *Halsey v. Brotherhood*, *supra*, at p. 391.

See also generally cases where actual malice must be proved, e.g. trade libel (*Mellin v. White*, [1895] A. C. 154, H. L., *Royal Baking Powder Coy. v. Wright, Crossley & Coy.*, 18 R. P. C. 95, 99, H. L.), slander of title (*Malachy v. Soper* (1836), 3 Bing. N. C. 371), and cases of qualified privilege.

The Equity Courts seem to have taken a wider view of their powers where only an injunction was sought, see *Rollins v. Hinks* (1872), L. R. 13 Eq. 355. *Azman v. Lund* (1874), 43 L. J. (CH.) 655; *Burnett v. Tate*, *supra*, but these decisions are hardly reconcilable with the judgments in *Mellin v. White*, *supra*.

In *Burnett v. Tate*, *supra*, it was held that though threats had been uttered *bond fide*, an injunction might be granted against their repetition, but in *Sugg v. Bray*, *supra*; *Brauer v. Sharp*, *supra*, it was held that if

the plaintiff had believed the statements when made, the fact that he had sought to justify them at the trial was no evidence that he would repeat them once it had been decided that they were not justified.

(c) *Halsey v. Brotherhood* (1881), 19 Ch. D., per BAGGALAY, L.J., at p. 391.

This would seem to agree with the rule laid down by BRETT, L.J., in *Henty v. Capital and Counties Bank* (1880), 5 C. P. D., at p. 540, that where a statement is not *prima facie* libellous it is necessary to show that the defendant knew of the circumstances that made it libellous. It is probably unnecessary to show that the statements made were intended to injure the actual plaintiff, cf. *Jones v. Hulton*, [1910] A. C. 20.

(d) Cf. *Palmer v. Hummerston* (1883), Cab. & Ell. 36.

As to absence of reasonable cause for believing not necessarily being proof of *mala fides*, see *Derry v. Peek* (1889), 14 A. C. 337; *Hicks v. Faulkner* (1881), 8 Q. B. D. 167.

(e) E.g. *Barwick v. English Joint-Stock Bank* (1867), L. R. 2 Ex. 259.

(f) E.g. *Citizens Life Assurance Coy., Ltd. v. Brown*, [1904] A. C. 423, P. C.

(g) *Mellin v. White*, [1895] A. C. 154; *Dicks v. Brooks* (1880), 15 Ch. D. 22 C. A.

General loss of trade may, of course, constitute such damage: cf. *Ratcliffe v. Evans*, [1892] 2 Q. B. 524, C. A. See also *Skinner v. Perry*, 11 R. P. C. 406.

It would, however, seem that if the practical certainty of damage if the threats are not restrained is established an injunction might be granted (*h*).

There is also a remedy at Common Law for a licensee who is being interfered with by threats on the part of the licensor (*i*). Remedy of licensee.

The second course open to the person aggrieved is the possible remedy offered by section 4 of the Statute of Monopolies. There is no record of any action of this kind till the subject was discussed in a recent case (*k*). There seems some doubt whether mere threats would give a cause of action, and also whether the section applies to actions brought for the enforcement of patent rights (*l*). Action on statute of monopolies.

Thirdly, there is the statutory remedy (*m*) open to any person aggrieved (*n*) by threats of legal proceedings or liability in respect of alleged infringement of a patent. This action only lies against a person who, either by himself or his agents, has both threatened and claimed to be a patentee—it does not lie, for example, against a person claiming to be a licensee (*o*). Statutory remedy.

(*h*) *Cf. Darley Main Colliery Coy. v. Mitchell* (1887), 11 A. C., per Lord BRAMWELL, at p. 145.

(*i*) See *Clark v. Adie* (1873), 21 W. R. 456, 754; *Société Anonyme des Manufactures de Glace v. Tilghmann* (1883), 25 Ch. D. 21 C. A.

(*k*) 21 Jac. 1, c. 3, s. 4. This section in effect provides that a person who is injured by a pretext of a monopoly shall have an action for three times the damage suffered and double costs.

(*l*) *Peck v. Hindes*, 15 R. P. C. 113.

In this case the plaintiff relied on former unsuccessful patent proceedings which had been brought against him. MATHEW, J., doubted whether bringing an action in good faith could ever subject the plaintiff to further consequences than costs, and also seemed of opinion that the sixth section excepted patents purporting to be for new inventions from the operation of s. 4, whether or no they were valid. He, however, decided for the defendant on the ground that the patent having been since rendered valid by amendment the effect of s. 18 (9) of the Act of 1883 (s. 21 (7) of the present Act) was to render it valid from the first, and so bring it within the exception of the sixth section of the Statute of Monopolies.

With regard to the suggestion of

the learned judge that patents purporting to be for new inventions came within the exception of s. 6, whether valid or not, it should be remembered that the validity is usually tested by considering whether the patent comes within this exception.

(*m*) Sect. 36.

(*n*) A wide view has been taken of the meaning of the word "aggrieved," and any person who finds himself hampered by threats would seem to have a remedy. See *Burt v. Morgan*, 4 R. P. C. 278; *Hoffnung & Coy. v. Salisbury*, 16 R. P. C. 375; *Johnson v. Edge*, 9 R. P. C. 142.

The mere fact that a plaintiff might have a legal remedy against a customer, who refuses to perform a contract by reason of the threats, does not prevent his being aggrieved. *Hoffnung & Coy. v. Salisbury, supra.*

(*o*) *Temler v. Stevenson*, 15 R. P. C. 24.

In *Overton & Coy. v. Burn, Lowe & Sons*, 13 R. P. C. 455, the patentee was resident abroad and the threats were made by his solicitors. KEREWICH, J., seemed to be of opinion that an action did not lie against these defendants as they had not purported to be patentees, but gave leave to join the patentees, and granted an *ex parte* injunction against them and their agents.

It is not necessary for this cause of action that the threats should have issued *malâ fide* or that any actual damage should be proved. On the other hand the action does not lie if the person threatening with due diligence brings and prosecutes a *bonâ fide* action for infringement.

What is a threat.

A threat within this section may be either addressed to the plaintiff (*p*), his customers (*q*), or manufacturers (*r*), or may be simply published to the world in general (*s*). It may be a threat of action or simply a statement of liability (*t*), and may be contained in a solicitor's letter (*u*), or in a statement without prejudice (*x*), or in an answer to inquiries (*y*).

The alleged threat must in some way point to the articles or class of articles manufactured or used by the plaintiff. A mere general statement that the patentee will protect his rights, or that action will be taken against infringers, is not sufficient (*z*). But if the document really would be understood as a threat the form is unimportant (*a*).

It was at one time stated that to come within the section the threat must refer to what is happening at present and not only to what may happen in the future (*b*). This view has been

(*p*) *Driffeld Coy. v. Waterloo Coy.*, 3 R. P. C. 46.

(*q*) *Burt v. Morgan*, 4 R. P. C. 278; *Hoffnung & Coy. v. Salisbury*, 10 R. P. C. 375; *Craig v. Dowding*, 25 R. P. C. 1.

(*r*) *Willoughby v. Taylor*, 11 R. P. C. 45; *Webb v. Levinstein*, 15 R. P. C. 78.

(*s*) *Johnson v. Edge*, 9 R. P. C. 142.

(*t*) Under the old law this scarcely seemed actionable. See *Gillespie v. Young* (1861), 2 S. XXIII. 135.

(*u*) *Crampton v. Patents Investment Coy.*, 5 R. P. C. 393; *Combined Weighing Machine Coy. v. Automatic Weighing Machine Coy.*, 6 R. P. C. 502; *Engels v. Huberts*, 19 R. P. C. 201. But see *Day v. Forster*, 7 R. P. C. 54.

(*x*) *Kurtz v. Spence*, 5 R. P. C. 161, 173.

(*y*) *Skinner v. Perry*, 10 R. P. C. 1 C. A.

(*z*) *Crowthier v. United Flexible Metallic Tube Coy.*, 22 R. P. C. 549; *Dick v. Haslam*, 8 R. P. C. 196; *Brauer v. Sharpe*, 3 R. P. C. 193, 197; *Willoughby v. Taylor*, 11 R. P. C. 45.

A true statement that an action has been brought is not a threat. *Beven v. Welsbach Incandescent Coy.*,

20 R. P. C. 73; *Incandescent Gas Light Coy., Ltd. v. Sunlight Incandescent Coy., Ltd.*, 14 R. P. C. 180.

(*a*) *Douglas v. Pintsch's Patent Lighting Coy.*, 13 R. P. C. 673; *Johnson v. Edge*, 9 R. P. C. 142, C. A.; *Craig v. Dowding*, 25 R. P. C. 1, and 259, C. A.; *Kurtz v. Spence*, 5 R. P. C., 173; *Cars v. Bland Light Syndicate, Ltd.*, 28 R. P. C. 33.

In *Johnson v. Edge*, *supra*, the statement complained of was in the form, "Information of extensive violation of Mr. Edge's Patent rights have been received. All parties are warned not to infringe these rights." The Court found that persons to whom it was sent (some of whom were plaintiff's customers) would think that the infringements mentioned would mean the plaintiff's goods as well as those of certain other manufacturers, and held it to be a threat. *Per KAY, L.J.*, at p. 147, it was for the defendant to show that the threats were not directed against the plaintiff. *Cf.* with this case, *Crowthier v. United Flexible Metallic Tube Coy.*, *supra*.

(*b*) *Challender v. Royle*, 4 R. P. C. 362, 375, explained in *Kurtz v. Spence*, 5 R. P. C. 161, 171.

modified somewhat in a later case (c) where it was stated that the mere wording of a threat so as apparently to apply only to future acts would not prevent it from coming within the section (d). But it must be remembered that the section is clearly intended to apply to the case of patentees who threaten, and do not then take proper action (e), and it would therefore seem not applicable to a case where a patentee says such and such a thing would be an infringement if put on the market, but does not bring an action because there is no infringement (f). Though this point has never actually been decided it would probably be held either that such a statement was not a threat within the section, or that the fact that the patentee was ready to start an action if any infringement took place would bring him within the proviso (g).

The actual bringing of an infringement action is not a threat or allegation within section 36 of the Patents and Designs Act (h), nor apparently within section 4 of the Statute of Monopolies (i). The bringing of an action which the plaintiff knows to be utterly unfounded may, however, give rise to an action on the case at Common Law (k).

The question of whether any "legal rights" of the patentee have been infringed involves the question of validity as well as that of infringement (l). Moreover, it must be shown that

(c) *Kurtz v. Spence, supra*; *Johnson v. Edge*, 9 R. P. C. 142, 148, C. A.

(d) *Cf. Challender v. Royle, supra*; *Kurtz v. Spence, supra*; *Skinner v. Perry*, 10 R. P. C. 1, C. A.

(e) *Skinner v. Perry, ubi supra*, at p. 8.

(f) See *Dick v. Haslam*, 8 R. P. C. 196; *cf. also Colley v. Hart*, 7 R. P. C., at p. 108.

(g) The rule laid down in *Challender v. Royle*, 4 R. P. C. 363, C. A., and *Colley v. Hart*, 7 R. P. C. 101, that the question of due diligence is to be considered with regard to the date of the threats and not of the infringement, would not apply to such cases as these, where the patentee has no opportunity of bringing an action. A person wishing to manufacture a certain class of article can always bring the matter to a head by expressing his intention to do so in such a way as to give the patentee an opportunity of bringing an action for an injunction. *Cf. Johnson v. Edge*, 9 R. P. C., *per* LINDLEY, L.J.,

at p. 148, C. A., and *Skinner v. Perry*, 9 R. P. C. 406, 407.

(h) See *Beven v. Welsbach Incandescent Coy.*, 20 R. P. C. 73.

In this case an undertaking had been given not to threaten or allege that certain articles were infringements. *Held*, that bringing an action in which this was alleged was not a breach, nor was a statement that such an action had been brought. See also *Waite v. Johnson*, 18 R. P. C. 1.

(i) *Peck v. Hindes*, see p. 221, *n.* (l).

(k) See *Wren v. Wild* (1869), 38 L. J. (Q. B.) 327, and cases there quoted.

(l) *Challender v. Royle*, 4 R. P. C. 363, C. A.; *Kurtz v. Spence*, 5 R. P. C. 161; *Dowson Taylor & Coy., Ltd. v. Drosophore Coy.*, 12 R. P. C. 95, C. A.

From the last case it appears that the onus being on the plaintiff he cannot get particulars of breaches. He may attack validity either in the Statement of Claim or in Reply.

such legal rights are those of the party threatening, and it is only an action by such party that satisfies the proviso (*m*).

Action by  
patentee.

An action to come within the proviso should be one that would enable the question raised by the threats to be decided (*n*). Generally speaking it should be one in which the defendant has the opportunity of raising both the defences of non-infringement and of invalidity, though of course it does not matter if he in fact does not do so (*o*). If, however, the threats are made to a licensee an action against him is sufficient, though he cannot challenge validity (*p*), and the same rule would seem to apply if the plaintiff in the threats action were himself a licensee of the defendant. The action need not be brought against the person aggrieved (*q*), provided that it refers to the class of article mentioned in the threats and in which he is interested (*r*).

Where the threats refer to several patents which are independent the action should be brought on all (*s*), but if the claims of some of these are in fact covered by the claims of the others the action need not necessarily be brought on the subsidiary patents (*t*).

Due diligence.

In deciding whether an action has been brought with due diligence the object of the section must be kept in mind, viz. that a patentee should not be able to continue to hamper others by threats unless he is prepared to test his rights in Court (*u*). The patentee is generally entitled to take proper time to decide

(*m*) *Kensington Electric Lighting Coy. v. Lane-Fox*, 8 R. P. C. 277; but cf. *Barnett v. Barrets Screw Stopper Bottling Coy.*, 1 R. P. C. 9.

Although an action by the legal owner is not an answer to an action for threats brought against a licensee or equitable owner, yet if such infringement action were successful it might be held to destroy the claim for damages.

(*n*) *Combined Weighing Machine Coy. v. Automatic Weighing Machine Coy.*, 6 R. P. C. 502.

(*o*) *Dunlop Pneumatic Tyre Coy. v. New Seddon Coy.*, 14 R. P. C. 332, C. A.

(*p*) *Day v. Foster*, 7 R. P. C. 54, 59.

(*q*) *Challender v. Royle*, 4 R. P. C. 363, C. A.; *Z. Electric Lamp Manufacturing Coy., Ltd. v. Osram Lamp Works, Ltd.*, 28 R. P. C. 480.

(*r*) *Combined Weighing Machine Coy. v. Automatic Weighing Machine Coy.*, *supra*.

Formerly it was held to be sufficient if the action covered such articles, e.g. if they would have come within the scope of an enquiry as to damages even if they were not mentioned in the Particulars of Breaches (*Lycett v. Brooks*, 21 R. P. C. 656). It seems doubtful if this case would now be followed in view of the new system of pleading laid down by O. 53a, r. 16.

(*s*) *Dowson Taylor & Coy. v. Drosophore Coy., Ltd.*, 12 R. P. C. 95, C. A.

(*t*) *Temler v. Stevenson*, 15 R. P. C. 24.

(*u*) "The sword of Damocles either should not be suspended or should fall at once." *Skinner v. Perry*, 10 R. P. C., per BOWEN, L.J., at p. 8, C. A.

as to his course of action even after threats have been made (x); and it would seem that he might be entitled to amend his patent before bringing the action (y). The question of diligence is to be judged with reference to the date of the threats and not to the date when the patentee knew of the infringement (z). Where there is a pending action which was being duly prosecuted when the threats were made the proviso is satisfied (a). The fact that the threats action has been commenced before the infringement action does not show the patentee has not acted with due diligence (b).

(x) *Challender v. Royle*, 4 R. P. C. 363, C. A.

Probably there might be cases where the patentee would be estopped by the form of the threat from alleging that he needed time to decide on his course of action.

(y) *Hall v. Stepney Spare Motor Wheel, Ltd.*, 27 R. P. C. 233, 235; but cf. *Fusee Vesta Coy. v. Bryant & May*, 4 R. P. C. 191.

In *Hall's case*, *supra*, the action was commenced before the amendment was complete, but the statement of claim proceeded on the amended specification. See *Stepney Spare Motor Wheel, Ltd. v. Hall*, 28 R. P. C. 381, and *Davies and Davies Patent*, 28 R. P. C. 50, L. O.

(z) *Challender v. Royle*, *supra*; *Colley v. Hart*, 7 R. P. C. 101, 108.

In *Colley v. Hart*, *supra*, NORTH, J., also pointed out that the patentee cannot be expected to start an action till he finds some one who persists in infringing. See also p. 223, n. (g).

(a) *Dunlop Pneumatic Tyre Coy., Ltd. v. New Seddon Coy., Ltd.*, 14 R. P. C. 332, C. A.; *Incandescent Gas Light Coy., Ltd. v. Sunlight Incandescent Coy., Ltd.*, 14 R. P. C. 180, 188; *Berliner v. Edison Bell Phonograph Coy., Ltd.*, 16 R. P. C. 336, 338; *Haskell Golf Ball Coy. v. Hutchinson*, 21 R. P. C. 497.

(b) The following are cases where the action has been held to have been brought with due diligence:—

Threats in March, letters in April from persons aggrieved, infringement action on 15th June after issue, but before service, of writ in threats action. *Challender v. Royle*, 4 R. P. C. 363, C. A.

Threats 15th September. Threats action 27th September. Infringement action 6th December. The judge

L.P.

expressed his opinion that it was proper to wait a reasonable time for the statement of claim in the threats action so as to raise the question of infringement by counterclaim. *Colley v. Hart*, 7 R. P. C. 101.

Threats action started immediately after threats, infringement action a fortnight later. *Waite v. Johnson*, 18 R. P. C. 1. See also *Household v. Fairburn*, 1 R. P. C. 109; *Mackie v. Solvo Laundry Coy.*, 9 R. P. C. 465; *Edlin v. Pneumatic Tyre Coy.*, 10 R. P. C. 311; *Peck v. Hindes*, 15 R. P. C. 113.

The following are cases where the action has been held not to have been brought with due diligence:—

Where threats were made in September, 1886, and again in September, 1887, threats action commenced in October, 1887, and infringement action in November, 1887. *Herrburger Schwander et Cie v. Squire*, 5 R. P. C. 581.

Where threats had been issued since September, 1890, and the patentee, after a threats action had been commenced, on the 4th February, 1891, amended the statement of claim in a passing off action by inserting a claim for infringement, and then consented to the revocation of his patent, MATHEW, J., held that the action had not been brought with due diligence. The decision seems to have been partly at least on the ground that the action was not *bonâ fide*. *Johnson v. Edge*, 9 R. P. C. 142, C. A.

Where patentee threatened on the 30th August, issued a writ, but then said he would not serve it, and after the commencement of the threats action (on the 30th September) counterclaimed for infringement, PHILLIMORE, J., left question to the jury who found the action had not

Q

Whether the action has been prosecuted with due diligence is of course a question of fact, but it is not necessary that the action should proceed to trial in order to satisfy this condition. If the patentee, after he has seen the defence and the particulars of objections, considers that the action will not be successful he may abandon it without losing the benefit of the proviso (c). But if the Court are of opinion that the patentee is deliberately delaying the action he will be held not to have proceeded with due diligence (d).

Whether  
action *bona*  
*fide*.

In some cases there has been a discussion on the question of whether or not the action brought by the patentee was *bona fide*. This point may be of importance where the action is not against the party aggrieved, since a collusive action, or one brought against a person whom the patentee knew would not defend, would not be within the spirit of the proviso (e). But where the action is against the plaintiff in the threats action it is difficult to see how, if it is brought and prosecuted with due diligence, it can fail to be an answer to the threats action (f). The fact that the patentee has been advised that he will fail does not prevent the action being *bona fide* (g).

Interim  
injunction.

The proceedings in a threats action usually commence by an application for an interim injunction to restrain the threats. The ordinary rule that the Courts will not interfere by means of interlocutory injunction, unless the plaintiff shows a strong

been brought with due diligence. *Appleby v. Albert Eady Chain Coy.*, 16 R. P. C. 318.

(c) *Colley v. Hart*, 7 R. P. C. 101; *English and American Machinery Coy., Ltd. v. Gare Machine Coy.*, 11 R. P. C. 627; *Craig v. Dowding*, 25 R. P. C. 259, C. A.

For other cases in which the action has been held to have been prosecuted with diligence, see *Combined Weighing Machine Coy. v. Automatic Weighing Machine Coy.*, 6 R. P. C. 502; *Peck v. Hindes*, 15 R. P. C. 113; *Voelker Incandescent Mantle, Ltd. v. Welsbach Incandescent Coy., Ltd.*, 18 R. P. C. 494.

In *Colley v. Hart*, *ubi supra*, at p. 109, NORTH, J., held that, where a threats action had been commenced, the patentee, before proceeding in the infringement action, was entitled to wait for the statement of claim in the threats action in order to decide if he would proceed for infringement by way of counterclaim. This would

only apply if the infringement action had been commenced with due diligence. Cf. *Herrberger Schwander et Cie v. Squire*, 5 R. P. C. 581.

(d) *Household v. Fairburn*, 2 R. P. C. 140; *Bishop v. Inman*, 17 R. P. C. 749. See also *Peck v. Hindes*, *supra*.

The question is very similar to that of whether the action is a *bona fide* one.

(e) See *Challender v. Royle*, 4 R. P. C. 363, 373, C. A.

(f) See *Craig v. Dowding*, 25 R. P. C. 259, C. A.; *Colley v. Hart*, 7 R. P. C., at p. 112; *Peck v. Hindes*, 15 R. P. C. 113.

The infringement action was held not to have been brought *bona fide* in *Bishop v. Inman*, 17 R. P. C. 749, and possibly in *Johnson v. Edge*, 9 R. P. C. 142 (see *Craig v. Dowding*, 25 R. P. C. at p. 262). In these cases however, it was also held that the infringement actions were not prosecuted with due diligence.

(g) *Craig v. Dowding*, *supra*.

probability of success at the trial, applies also in the case of threats action, and the argument that the balance of convenience lies in restraining the threats is not allowed to prevail where the plaintiff cannot make out a *prima facie* cause of action (*h*). To do this he has to show that there have been threats (*i*), that he is infringing no legal rights of the defendant (*k*), and also, if an action has been brought, that it has not been brought *bona fide* or with due diligence, or that it is not being duly prosecuted (*l*). Generally speaking, the Court will only decide non-infringement or invalidity on motion in the clearest possible cases (*m*), and the Court will not generally try questions of *bona fides* on affidavit (*n*). It is a very common course for the defendant to apply for the stay of the threats action in order to enable him to bring an infringement action (*o*), and in such case the action may either be stayed generally—the costs

(*h*) The Courts recognise that if the patentee has rights it is proper to warn purchasers. *Société, &c. des Glaces v. Tilghmann's Patent Sand Blast Coy.* (1883), 25 Ch. D. 1.

Injunctions have been refused in the following cases:—

*Challender v. Royle*, 4 R. P. C. 363, 372, C. A.; *Société, &c. des Glaces v. Tilghmann's Patent Sand Blast Coy.*, *supra*; *Household v. Fairburn*, 1 R. P. C. 109 (subsequently granted, *vide infra*); *Barber v. Nathan*, 19 R. P. C. 331; *Barney v. United Telephone Coy.*, 2 R. P. C. 173; *Mackie v. Solvo Laundry Coy.*, 9 R. P. C. 465; *Edlin v. Pneumatic Tyre Coy.*, 10 R. P. C. 311; *Douglas v. Pintsch's Patent Lighting Coy.*, 13 R. P. C. 69; *Parnell v. Dredge*, 13 R. P. C. 392; *Berliner v. Edison Bell Phonograph Coy., Ltd.*, 16 R. P. C. 336; *cf. Bonnard v. Perryman*, [1891] 2 Ch. 269, C. A.

In *Walker v. Clarke*, 4 R. P. C. 111, it was said that the granting of the injunction depended on the balance of convenience.

Injunctions have been granted in:—

*Household v. Fairburn*, 2 R. P. C. 141; *Colley v. Hart*, 6 R. P. C. 17; *Kensington Electric Lighting Coy. v. Lane-Fox Electrical Coy.*, 8 R. P. C. 277; *Engels v. Hubert*, 19 R. P. C. 210 (dissolved by consent in C. A.).

The rule as to plaintiff disentitling himself to *interim* relief by reason of delay also applies. *Edlin v. Pneumatic Tyre Coy.*, 10 R. P. C. 316.

Injunctions in these actions are seldom granted, *ex parte*. Such an injunction was refused in *Wilson v. Church Engineering Coy.*, 2 R. P. C. 175; *Commercial Development Coy. v. Castner Kellner Alkali Coy.*, 14 R. P. C. 939. But see *Overton v. Burn*, 13 R. P. C. 455.

(*i*) *Barber v. Nathan*, 19 R. P. C. 331.

(*k*) See p. 223, *n.* (*l*).

(*l*) Where an action within the proviso has been brought the defendant cannot be restrained under this section from issuing further threats. *Day v. Foster*, 7 R. P. C. 54; *Dunlop Pneumatic Tyre Coy. v. New Seddon Coy.*, 14 R. P. C. 332, C. A.; *Haskell Golf Ball Coy. v. Hutchinson*, 21 R. P. C. 497.

(*m*) *Household v. Fairburn*, 1 R. P. C. 109; *Barney v. United Telephone Coy.*, 2 R. P. C. 173; *Berliner v. Edison Bell Phonograph Corporation*, 16 R. P. C. 336.

For a case where the Court decided on these points, see *Colley v. Hart*, 6 R. P. C. 17.

(*n*) *Household v. Fairburn*, 1 R. P. C. 109; *Parnell v. Dredge*, 13 R. P. C. 392; *Barber v. Nathan*, *ubi supra*.

(*o*) It would seem to be the patentee's duty to prevent both actions going on. *Combined Weighing Machine Coy. v. Automatic Weighing Machine Coy.*, 6 R. P. C. 370 and 509.

Trying the question of infringement in a separate action gives the patentee the advantage of the opening.



usually being made costs in the infringement action (*p*)—or until after the trial of the latter action (*q*). It is not usual to require any undertaking as to the cessation of threats, though this is sometimes done (*r*).

Onus.

The burden of proof lies on the plaintiff throughout (*s*) and he has to prove the issue of the threats (and, if these were by agents, the authority of such agents) (*t*), and that no legal rights of the defendant have been infringed (*u*). The onus of proving that an action within the proviso has been duly brought and prosecuted would probably lie on the defendant. The defendant can also counterclaim for infringement (*x*).

The general rule is that the plaintiff in a threats action has the right to begin even if the defence is that he has infringed the defendant's patent (*y*).

Relief.

The ordinary remedy is an injunction against continuing to threaten (*z*), and damages or an inquiry as to damages.

(*p*) In *Dowson, Taylor & Coy. v. Drosophore Coy.*, 12 R. P. C. 95, where the threats related to four patents, and the infringement action to one only, the Court refused to stay the threats action, see p. 224, *n.* (*s*).

In one case where a licensee had threatened the threats action was stayed for the patentee to bring an action. *Barnett v. Barrett's Screw Stopper Bottling Coy., Ltd.*, 1 R. P. C. 9.

But see p. 224, *n.* (*m*).

For form of order, see *Wrightson v. Taylor*, 24 R. P. C. 347.

(*q*) *Edlin v. Pneumatic Tyre Coy.*, 10 R. P. C. 316.

(*r*) Such an undertaking was given in *Johnson v. Edge*, 9 R. P. C. 145; *Wrightson v. Taylor*, 24 R. P. C. 347.

Where defendants refused to give undertaking but disclaimed any present intention of threatening, and brought infringement action, no order was made, but liberty was given to renew the motion if the threats were continued. *Mackie v. Solvo Laundry Coy.*, 9 R. P. C. 465.

(*s*) *Dowson, Taylor & Coy. v. Drosophore Coy., Ltd.*, 11 R. P. C. 656.

(*t*) He must give particulars as to the threats and by whom they were issued (*Dowson, Taylor & Coy. v. Drosophore Coy., Ltd.*, 11 R. P. C. 538; *Law v. Ashworth*, 7 R. P. C. 86). He need not, however, in his pleadings give particulars of the customers who have ceased dealing with him if the relief asked for is in the form of an inquiry as to

damages. *Law v. Ashworth, supra.*

(*u*) The plaintiff may, if he considers that he knows the patents on which the defendant is relying, attack their validity in the statement of claim (see *Union Electrical Power Coy. v. Electrical Power Storage Coy.*, 5 R. P. C. 329), or he may plead that he has infringed no legal rights of the defendants, and if they then say that certain patents have been infringed he may attack the validity of these by his reply. *Dowson, Taylor & Coy. v. Drosophore Coy.*, 12 R. P. C. 95.

On the other hand, the defendant may without giving particulars of breaches simply traverse the allegation that the plaintiff has not infringed any of his legal rights. This course, however, is an inconvenient one, and may lead to delay at the trial. *Dowson, Taylor & Coy. v. Drosophore Coy., Ltd.*, 11 R. P. C. 656.

In any case the defendant is entitled to proper particulars of objections. *Law v. Ashworth, supra*; *Dowson, Taylor & Coy. v. Drosophore Coy., Ltd.*, 12 R. P. C. 95; *Union Electrical Power Coy. v. Electrical Power Storage Coy., supra.*

(*x*) *Colley v. Hart*, 7 R. P. C. 101, 108.

(*y*) But see *contra Crampton v. Patents Investment Coy.*, 5 R. P. C. 382, where the defendants apparently began.

(*z*) For forms see *Challender v. Royle*, 4 R. P. C. 363, 368; *Colley v. Hart*, 6 R. P. C. 21. Consult also

With regard to the quantum of damages this must necessarily be largely a matter of estimate. Something is generally allowed for general loss of trade over and above those orders whose loss is actually proved (a). But a distinction must be made between the loss that can be traced to the defendant's threats and that due to the feeling in the trade, not caused by such threats, that there may be a dispute as to patent rights and that it is better not to be involved in it (b).

Generally speaking, the higher Courts will not interfere with the figure fixed by the master or judge unless he has clearly acted on wrong principles (c).

The provisions as to a certificate of validity, or as to the consequences when one has been previously granted, have no application to threats actions, unless of course there is a counter-claim for infringement (d).

Costs generally follow the event (e), but in some cases, especially where the successful defence is founded on the proviso, the action has been dismissed without costs (f).

*Ellam v. Martyn*, 16 R. P. C. 28, as showing need for carefully covering possible contingencies.

(a) *Ungar v. Sugg*, 9 R. P. C. 113, C. A.; *Skinner v. Perry*, 11 R. P. C. 406. See also *Cars v. Bland Light Syndicate, Ltd.*, 28 R. P. C. 33, 41.

(b) *Ungar v. Sugg*, 8 R. P. C. 388.

Where the threats had been addressed to the plaintiffs themselves, BACON, V.C., refused to give damages. *Driffield Coy. v. Waterloo Coy.*, 3 R. P. C. 46. It would seem that damages may be given although the plaintiff might have proceeded against his customer for breach of contract. *Hoffnung & Coy. v. Salisbury*, 16 R. P. C. 375.

(c) *Ungar v. Sugg*, 9 R. P. C. 113, C. A.

(d) See s. 35 and *Kurtz v. Spence*, 5 R. P. C. 184.

In *Crampton v. Patents Investment Coy.*, 5 R. P. C. 404, such a certificate was granted, but its validity was expressly left open to be determined subsequently.

(e) E.g. *Colley v. Hart*, 7 R. P. C. 101; *Craig v. Dowding*, 25 R. P. C. 259, C. A.

In *Kurtz v. Spence*, 5 R. P. C. 161, the plaintiff was given the whole of the costs, though he failed on the issues of infringement and novelty, the patent being held bad for non-utility.

(f) E.g. *Combined Weighing Machine Coy. v. Automatic Weighing Machine Coy.*, 6 R. P. C. 502; *Temler v. Stevenson*, 15 R. P. C. 24; *Metropolitan Gas Meters Ltd. v. British &c., Automatic Light Coy.*, 29 R. P. C. 680.

## CHAPTER XIII

## AMENDMENT

THE present Act, like former Acts (a), contains provisions for the amendment of the specification of Letters Patent. Such amendment may be made either by the Comptroller or the Court. The present chapter only deals with the conditions for, and effect of, such amendment, and the practice in amendment by the Court itself. The procedure in amendment by the Comptroller is to be found in the chapter on Patent Office Practice (b).

Provisions for amendment.

The Comptroller has no jurisdiction to entertain an application for leave to amend made during the pendency of an action for infringement or proceeding before the Court for revocation, and if he does so the amendment is void and of no effect (c). If, however, the application is duly made while no proceedings are pending, the fact that proceedings are started before the amendment is completed does not oust his jurisdiction (d). The amendment once made dates back to the

Amendment by comptroller.

(a) See 5 & 6 Will. IV. c. 83; 7 & 8 Vict. c. 69; 15 & 16 Vict. c. 83, s. 29; 46 & 47 Vict. c. 57, ss. 18, 21; 51 & 52 Vict. c. 37, s. 5.

(b) See p. 279 *et seq.*

(c) Sect. 21 (8). It should be noted that a threats action would apparently not affect the Comptroller's jurisdiction (see in the matter of *Hall and Others*, 5 R. P. C. 307). It does not seem clear whether a petition to the Board of Trade for a compulsory licence or in the alternative for revocation, referred to the Court under the provisions of s. 24 (2), is a proceeding before the Court. As the validity of the patent is not in question in such petition there would seem no reason why the power of the Comptroller to amend should be restricted. Questions may also arise as to whether appeals from the Comptroller under

ss. 26 and 27 are proceedings before the Court. *Cf. Cropper v. Smith*, 1 R. P. C. 254.

An action is pending even though it has been taken out of the list and is practically dead, and where an amendment was effected before such action was actually discontinued it was in a subsequent action held to be void. Leave was, however, given to apply to amend. *Brooks v. Lycett*, 21 R. P. C. 651. An appeal, at any rate an appeal to the H. L., was held not to prevent a patentee applying to the Comptroller for leave to amend. *Cropper v. Smith*, 1 R. P. C. 254.

(d) *Andrew v. Crossley*, 9 R. P. C. 165, C. A.; *Wolfe v. Automatic Picture Gallery*, 20 R. P. C. 177, C. A.

As to prohibition against the Comptroller on the ground of want of jurisdiction, see p. 290.

original date of grant (e), except as expressly provided by the Act (f), and consequently a specification so amended can be given in evidence in proceedings commenced before the amendment is complete (g).

Amendment  
by the Court.

In the excepted cases the application to amend the patent must be made to the Court (h). Such application need only be made in one action, etc., although several may be pending (i). The procedure, however, permits any person interested to oppose the amendment, and the Comptroller has also the right to be heard (k). Whether leave to amend be given is purely a matter of judicial discretion, and the higher Courts will not interfere with such discretion unless they are clearly of opinion that it has been wrongly exercised (l), and, if such leave has been given, they will in practice not consider an appeal against the imposition or non-imposition of certain terms (m).

The only amendment which can be made by leave of the Court is one by way of disclaimer (n). There are, however, very few decisions throwing light on what amendments come within this term (o).

(e) *Stocker v. Warner* (1845), 14 L. J. (C. P.) 90; *R. v. Mill* (1851), 20 L. J. (C. P.) 16; *Wolfe v. Automatic Picture Gallery, supra*; *Stepney Spare Motor Wheel, Ltd. v. Hall*, 28 R. P. C. 251.

(f) *I.e.* as to damages for infringements before amendment, see p. 237, n. (x).

(g) *Andrew v. Crossley, supra*, which only decided the point when leave to amend had been obtained; but in *Stepney Spare Motor Wheel, Ltd. v. Hall, supra*, it was held that even where proceedings were started before such leave was obtained the amended specification could be given in evidence. It would also appear from *Hall v. Stepney Spare Motor Wheel, Ltd.*, 27 R. P. C. 233, that such amended specification could be used in proceedings for threats made before the date of the amendment. See also cases in note (c), *supra*, and *Singer v. Strassen*, 1 R. P. C. 121. The dictum in *Stocker v. Warner, supra* (also to be found in *Perry v. Skinner* (1837), W. P. C. 251), that an amendment does not relate back so as to make acts wrongful by relation hardly seems reconcilable with these cases.

(h) Sect. 22. In the case of proceedings in the Palatine Court this Court has power to grant leave to

amend. See Chancery of Lancaster Act, 1890 (53 & 54 Vict. c. 23), s. 4. See also *Winter v. Baybutt*, 1 R. P. C. 77.

It would seem doubtful if the H. L. could exercise this power, or whether it would have to be referred back to the High Court. Sect. 92 defines "the Court" as the High Court, but the H. L. have exercised certain powers of the Court, *e.g.* have granted a certificate as to particulars, see p. 204, n. (r).

(i) *In the matter of Hall and Others*, 5 R. P. C. 307.

(k) O. 53a, r. 23.

(l) *Armstrong's Patent*, 14 R. P. C. 747, C. A.; *New Conveyer Coy. v. Edinburgh Gas Commissioners*, 21 R. P. C. 147, I. H.

For cases where the higher Courts have given leave although leave was refused by the judge of first instance, see *Gaulard v. Lindsey*, 5 R. P. C. 192, C. A.; *Decley's Patent*, 13 R. P. C. 581, H. L.; *Alsop's Patent*, 23 R. P. C. 65, C. A.

(m) *Allen v. Doulton*, 4 R. P. C. 377, C. A.; *Lang v. Whitecross Iron Coy.*, 7 R. P. C. 389, H. L.; *Pitt's Patent*, 17 R. P. C. 745, H. L.; *Geipel's Patent*, 21 R. P. C. 379, C. A.

(n) Sect. 22.

(o) For cases where the proposed amendment has been held not to be by way of disclaimer, see *Lang's Patent*, 7 R. P. C. 469; *Armstrong's Patent*, 14

Leave to amend is frequently given in petitions after judgment, and it is not usual to make the patentee elect between amending and appealing (*p*). It is not, however, customary to give the plaintiff in an action leave to amend after judgment (*q*). The Court may give leave to amend more than once (*r*).

Amendment  
after judg-  
ment.

Before leave to amend will be given by the Court, at any rate after judgment, the patentee must make out a *prima facie* case that the patent when so amended will be good (*s*).

In the case of amendment pending legal proceedings terms are in general imposed on the patentee. These terms vary according to the period of the proceedings at which the application for amendment is made. If this is before trial the usual order as to costs is that the patentee should pay the costs of amendment and all costs up to date except so far as they are for matters which can be utilised after the amendment (*t*). The defendant or petitioner is also generally given leave to amend the particulars of objections (*u*). If leave is sought after judgment has been given against the patentee the terms

Terms  
imposed

R. P. C. 747, C. A.; *Owen's Patent*, 15 R. P. C. 755; *Rhenische Gummi Fabrik v. British Xylonite Coy.*, 29 R. P. C. 672. See also *Alsop's Patent*, 24 R. P. C. 684 (L. O.), and *Ralston v. Smith* (1865), 11 H. L. C. 223.

Where an amendment consists of excisions only it is *prima facie* by way of disclaimer. *Alsop's Patent*, 23 R. P. C. 65, C. A.

For cases where an amendment has been held to be by way of disclaimer, see *Seed v. Higgins* (1862), 8 H. L. C. 551.

For the general question of what are permissible amendments, see p. 280.

(*p*) *Deeley's Patent*, 13 R. P. C. 581, H. L.; *Justice's Patent*, 18 R. P. C. 241; *Bowden's Patent*, 22 R. P. C. 49; *Haggenmacher's Patent*, 15 R. P. C. 437.

It would appear that the amendment in this case would not be during legal proceedings, and would therefore be made by the Comptroller and not by the Court, and could be by way of disclaimer, correction, or amendment. There has been no case under the present Act, but under the former Act the order of the Court did not give leave to apply to the Comptroller, as would have been necessary in a case where proceedings were pending, but simply said that the patent should be revoked if leave to amend were not

obtained, cf. *Deeley's Patent*, *supra*.

(*q*) *Lawrence v. Perry*, 2 R. P. C. 187; *Gillette Safety Razor Coy. v. Gamage*, 26 R. P. C. 761.

(*r*) *Chatwood's v. Mercantile Bank of Lancaster*, 17 R. P. C. 23.

(*s*) *Armstrong's Patent*, 14 R. P. C. 747, C. A.; *Klaber's Patent*, 22 R. P. C. 205, 216, C. A.; *Singer v. Rudge*, 11 R. P. C. 463; *Alsop's Patent*, 24 R. P. C. 761.

(*t*) *Jandus Arc Lamp Coy. v. Arc Lamp Coy.*, 21 R. P. C. 115; *Codd v. Bratby*, 1 R. P. C. 209; *Chatwood's Patent*, 16 R. P. C. 374. See also *Haslam Foundry Coy. v. Goodfellow*, 5 R. P. C. 28.

In *Chatwood's Patent*, *supra*, the petitioners were given fourteen days after amendment to elect if they would discontinue, in which case they were to have all costs.

The above forms of orders are those now generally adopted. In *Lang v. White Cross Coy.*, 7 R. P. C. 389, the costs up to the date of the order were ordered to be defendant's costs in cause.

Formerly the patentee was frequently ordered to pay all costs up to date. *Gaulard and Gibbs' Patent*, 5 R. P. C. 189; *Gaulard and Gibbs v. Lindsay*, 5 R. P. C. 192.

(*u*) *Chatwood's Patent*, 16 R. P. C. 374.

are naturally more onerous, and he will be ordered to pay all costs.

In some cases, especially where there has been delay on the part of the patentee, terms may be imposed that no action shall be brought in respect of past infringements or the use of articles made before a certain date (*x*).

A term which was formerly frequently imposed was that the amended specification should not be given in evidence in the pending proceedings. This was a most inconvenient procedure since the proceedings continued on a specification which was admittedly invalid. Further, the old specification being completely superseded, it is difficult to see how it could be received in evidence. This condition has not been imposed in recent times (*y*).

Other special terms, such as an undertaking not to threaten (*z*), or a consent to the dissolution of an injunction, are sometimes imposed (*a*). The Court may also impose terms as a condition of giving leave which could not be imposed directly (*b*).

In the case of an amendment before the Comptroller the Comptroller or law officer has power to impose such conditions

(*x*) Terms that no action be brought in respect of any articles made by defendant or petitioner before a certain date, *Lang v. Whitecross Iron Coy.*, 7 R. P. C. 389, H. L.; *Deeley v. Perkes*, 13 R. P. C. 581, 590, H. L. (a petition for revocation); *Allison's Patent*, 17 R. P. C. 513, C. A.; *Luddington Cigarette Coy. v. Baron Cigarette Coy., Ltd.*; *Pitt's Patent*, 17 R. P. C. 745, H. L.; *Corrigal v. Armstrong*, 20 R. P. C. 523; *Scott's Patent*, 20 R. P. C. 257; *Jandus Arc Lamp Coy. v. Arc Lamp Coy.*, 21 R. P. C. 115. See, however, remarks of HALSBURY, L.C., in the *Luddington Case*, *ubi supra*, at p. 747, that this form of order is not of general application, especially in actions. It was not imposed in *Alsop's Patent*, 23 R. P. C. 78, C. A.

In *Geipel's Patent*, 20 R. P. C. 545, C. A., the terms were imposed that no injunction should be asked in respect to any articles made prior to the judgment unless the Court were of opinion that the original claims, etc. Followed in *Klaber's Patent*, 25 R. P. C. 336. In *Gillette Safety Razor Coy. v. Luna Safety*

*Razor Coy., Ltd.*, 27 R. P. C. 527, where the patent had been held bad in a concurrent action, leave was only given on the plaintiff's undertaking to discontinue all pending actions, and on the terms that no action should be brought against any member of the public (as distinguished from the trade) in respect of any razor acquired by him before the date of the application to amend, and no action against any person with regard to any razor made or imported before that date unless the Court were of opinion, etc., see also *Layland v. Boldy*, 29 R. P. C. 637.

(*y*) See *Jandus Arc Lamp Coy. v. Arc Lamp Coy.*, 21 R. P. C. 115.

For cases where the term was imposed, see *inter alia*. *Fusee Vesta Coy. v. Bryant & May*, 4 R. P. C. 77; *Bray v. Gardiner*, 4 R. P. C. 40.

(*z*) *Chatwood's v. Ratner Safe Coy., Ltd.*, 16 R. P. C. 450; *Alsop's Patent*, 23 R. P. C. 78, C. A.

(*a*) *Kenrich and Jefferson's Patent*, 29 R. P. C. 25. See also p. 237, *n.* (*a*).

(*b*) *E.g.* payment of costs occasioned by abortive application to comptroller; *Codd v. Bratby*, 1 R. P. C. 209.

as they may deem just (c). A condition so imposed forms a good defence to an action (d); and presumably the same would apply where terms have been imposed by the Court.

Once an amendment has been made by the Comptroller the amended specification is in all Courts, and for all purposes, deemed to have formed part of the Letters Patent at the date of grant (f), with a statutory exception as regards damages for past infringements (g). It follows that the Court will not entertain any objection based on the contents of the original specification (h), or consider whether the amended specification claims an invention substantially larger than or different from the invention originally claimed (i). The only grounds on which such an amendment can be attacked are that it was obtained by fraud (k), or that the Comptroller had no jurisdiction to entertain the application (l).

The effect of an amendment by the Court (m) when an action for infringement or proceedings (n) before the Court for the revocation of the patent are pending is not so clear. The provisions as to the amended specifications being substituted for the original, and as to leave to amend being conclusive of the right to make the amendment, are expressly stated not to apply if such action or proceedings are pending (o). The last point is specially important, and it must be remembered that it was held before the Act of 1883 and in some cases after that date (p), that the validity of such amendment could be

(c) See PATENT OFFICE PRACTICE, p. 282, n. (b).

(d) *United Telephone Coy. v. London and Globe Telephone Coy.*, 1 R. P. C. 113.

(f) Sect. 21 (7).

(g) Sect. 23. See p. 237, n. (x).

(h) *E.g.* that the original claims were not drawn in good faith. *British United Shoe Machinery Coy. v. Fussel*, 25 R. P. C. 660, C. A.

(i) *Moser v. Marsden*, 13 R. P. C. 24 H. L.

This rule has been dissented from in a recent case, *Knight v. Argylls, Ltd.*, 29 R. P. C. 610, but it is difficult to reconcile the judgments of Lords HALSBURY, WATSON, and DAVEY in *Moser v. Marsden, supra*, with any other view of the law.

(k) Sect. 21 (7). There has been no decision as to the meaning of this provision.

(l) See p. 231, *cf.* also *Re Hall and Others*, 5 R. P. C. 307.

No objection can be raised on the ground that the person making the amendment had no interest in the patent. *Wallington v. Dale* (1854), 23 L. J. (EX.) 49. See also *Spilsbury v. Clough* (1842), W. P. C. 255.

Nor *semble* will the Court inquire into whether proper steps as to advertisement, etc., have been taken. *Farbenfabriken, etc. v. Bowker*, 8 R. P. C. 389.

(m) The remarks in this paragraph would also apply to an amendment by the Comptroller during the proceedings in an application to revoke under the provisions of s. 26 if in fact legal proceedings were pending, see s. 26 (1) and (2).

(n) See p. 231, n. (c).

(o) Sect. 21 (8).

(p) *Ralston v. Smith* (1865), 11 H. L. C. 223; *Foxwell v. Bostock*

Effect of amendment.

questioned, although the contrary view finally prevailed in the House of Lords (q). But the decision of the House of Lords was based on the sub-section which enacted that leave to amend should be conclusive of the right to make the amendment. As this provision is reproduced in the new Act only in the case of amendments made by the Comptroller it would seem that in the case of a specification amended by the Court during legal proceedings an objection might be raised to its validity in a later case on the ground that the amendment was not such as ought to have been permitted, *e.g.* that it claimed a substantially different or a substantially larger invention, or was not by way of disclaimer only. Doubtless, however, the Courts would be reluctant to establish a difference between the effect of the two amendments as this would lead to grave difficulties, and possibly they may read into the power given to the Court to amend all the consequences stated in the earlier section as arising out of an amendment, though this would be to strain the literal interpretation of the Act (r).

Construction  
of amended  
specification.

The rule would now seem clear that the amended specification only is to be looked at for the purposes of construction, and that no comparison must be made between the amended and unamended specifications in order to determine the scope of the former (s).

Infringement  
before  
amendment.

Although for other purposes the amended specification is deemed to have formed part of the letters patent *ab*

(1864), 4 De G. J. & S. 298; But see *Clarke v. Kenrick* (1844), 13 L. J. (EX.) 6. See also *Van Gelder's Patent*, 6 R. P. C. 22.

(q) *Moser v. Marsden*, 13 R. P. C. 24, H. L. See also *per HALSBURY, L.C.*, in *Ohamberlain v. Bradford Corporation*, 20 R. P. C. 673. So no question can be raised as to amendment not having been properly carried out. *Farbenfabriken, etc. v. Bowker*, 8 R. P. C. 389.

But the fact that the Comptroller had no jurisdiction to make the amendment owing to the pendency of legal proceedings can be raised. *Brooks v. Lycett*, 21 R. P. C. 651; *Woolfe v. Automatic Picture Gallery*, 20 R. P. C. 177, C. A. Nor can it be questioned on the ground of want of interest in the person making it, *Spilsbury v. Clough* (1842), W. P. C. 255; *Wallington v. Dale* (1854), 23 L. J. (EX.) 49.

(r) *Cf. Re Hall and Others*, 5 R. P. C., *per CAVE, J.*, at p. 310.

(s) *Hattersley v. Hodgson*, 21 R. P. C. 517, C. A.; *Jandus Arc Lamp Coy., Ltd. v. Arc Lamp Coy.*, 22 R. P. C. 277; *Reason Manufacturing Coy. v. Moy*, 20 R. P. C. 211; *British United Shoe Machinery Coy. v. Claughton*, 23 R. P. C. 335.

WILLS, J., expressed a contrary opinion in *Palmer Tyre Coy. v. Pneumatic Tyre Coy.*, 16 R. P. C. 251. See also *Ricker v. London Electric Supply Corporation*, 17 R. P. C. 294.

The amended specification was referred to by the H. L. in *Dudgeon v. Thomson* (1879), 3 A. C. 34.

The effect of the judgment of the H. L. in *Moser v. Marsden*, 13 R. P. C. 24, on this point is not very clear, nor was the point discussed in the appeal to the H. L. in *Hattersley v. Hodgson*, 23 R. P. C. 192. See also *Alsop's Patent*, 24 R. P. C. 733.



*initio* (*t*), yet infringements before the date of the amendment (*u*), although giving a right of action and forming a ground for an injunction, do not give a right to damages unless the Court is of opinion that the original claims were drawn in good faith and with reasonable skill and knowledge (*x*).

Where the plaintiff seeks damages for infringement before the date of amendment he should raise by his pleadings the issue that the original claims were drawn in good faith and with reasonable skill and knowledge, and the onus is on him to establish this issue (*y*). Such damages are rarely granted (*z*).

The substitution of the amended for the original specification does not extend to orders of the Court made on the latter. Thus an injunction is automatically dissolved by an amendment of the specification (*a*). It is a doubtful point whether a decision on the unamended specification acts as an estoppel with regard to a dispute as to the amended specification (*b*).

Effect of amendment on injunction.

(*t*) See p. 235, *n.* (*f*).

(*u*) The Act does not define what is the date of amendment. It is probably the date when leave to amend is given by the Comptroller of *Andrew v. Crossley*, 9 R. P. C. 165, C. A.

(*x*) Sect. 23. The question whether an account of profits—an equitable remedy ancillary to an injunction—could be granted in respect to such infringements has never been discussed. Cf. p. 197, *n.* (*x*).

(*y*) *Kane v. Boyle*, 18 R. P. C. 325; *Jandus Arc Lamp Coy. v. Arc Lamp Coy.*, 22 R. P. C. 297. This issue should be raised in the opening, *ibid.*

The practice as to pleading on this point is not, however, fixed.

The Court must have materials before it to justify the grant of such a declaration. *Lake and Elliot v. Rotary Motor Accessories Coy.*, 28 R. P. C. 204.

(*z*) The only reported cases where such damages have been given are :—

*Hopkinson v. St. James and Pall Mall Electric Light Coy., Ltd.*, 10 R. P. C. 41; *Brooks v. Lycett*, 20 R. P. C. 390; *Brooks v. Rendell*, 24 R. P. C. 17; *Van Berkee v. Booth Brothers*, 23 R. P. C. 605, C. A.

In *Kane v. Boyle, supra*, BRYNE, J. suggested that the section meant that the patentee must show that he did not intend to claim more than he knew he had invented. Probably, too, the Court should consider whether what is excluded by the amendment was a matter of common knowledge which a competent man should have known to be old and should have excluded, or some private user, or little known publication of which he could not be expected to know.

(*a*) *Dudgeon v. Thomson* (1878), 3 A. C. 34.

(*b*) See ESTOPPEL, p. 208. *Dudgeon v. Thomson, supra*; *Deeley's Patent*, 11 R. P. C. 76.

## CHAPTER XIV

## LICENCES

A LEGAL licence can be granted by the legal owner of letters patent for the time being, and if such legal owner is the registered proprietor, and nothing which appears on the register derogates from his power of granting licences, such licence will bind his successors. It is doubtful whether a licence by an owner who is not registered would bind such successors unless they had notice at the time of assignment (a). A licence granted by an equitable owner who afterwards acquires the legal title is good (b). In the case of joint ownership of a patent all the owners must concur in granting a licence (c), and the same rule would in general apply to ownership in common (d). A licensee cannot in the absence of special terms grant sub-licences (e).

Who can  
grant licences.

Although the letters patent only provide for a licence under seal (f), licences can be acquired in other ways, and the Courts freely recognise parol licences (g), implied licences (h), and

Different  
kinds of  
licences.

(a) Cf. s. 71 (3), as to which see p. 10, and *Frentzill v. Dougill*, 21 R. P. C. 639. This applies where the licence is not in writing. *Kenny's Patent Buttonhole Coy. v. Somervell* (1878), 38 L. T. 878.

But it does not apply where the successors had, to the knowledge of the licensee at the date of the licence, a right to an assignment of the patent. *New Ixion Coy., Ltd. v. Spilsbury*, 15 R. P. C. 567, C. A.

(b) *Jandus Arc Lamp Coy., Ltd. v. Johnson*, 17 R. P. C. 361.

Such a licence could in any case be enforced by making the equitable owner a party to the action.

(c) Sect. 37.

(d) See pp. 11 & 12.

(e) Cf. cases at p. 242, n. (c).

(f) See form of patent, Appendix, *post*.

This need not be by deed, and if not so need not be stamped as a deed. *Chanter v. Johnson* (1845), 14 L. J. (EX.) 289.

(g) *Crossley v. Dixon* (1863), 10 H. L. C. 293; *Chanter v. Dewhurst* (1844), 13 L. J. (EX.) 198; *Chanter v. Johnson, supra*.

(h) E.g. the implied licence to use a patented machine given by its sale by the patentee, and the implied licence given to purchasers from the patentee, or from a licensee who has power to sell. This licence extended to subsequent purchasers, *Thomas v. Hunt* (1864), 17 C. B. (N. S.) 183. It should be noted that the implied licence by purchase from a patentee extends, in the absence of express terms to the contrary, to all countries where such patentee then owns the

licences by estoppel (i). No special words or form seem necessary to a licence and an agreement to grant a licence, if the parties act under it, has much the same effect as a licence (k). Where the Courts find that a party has continued to use a patent after the expiration of the licence they may hold that there was an implied licence for him to go on using on the old terms, and that royalty on such terms is payable (l). Similarly where one party has been allowed to use the patented invention while negotiations for a licence were proceeding, such user has been treated as under a licence (m).

Licencee has no property in patent.

Although in some cases a licence may transfer practically the whole benefit of a patent, it is quite distinct in its nature from an assignment (n). There is no reported case in which a licencee has been held entitled to sue for infringement without joining the patentee (o), though an exclusive licencee may restrain the patentee from infringing (p), and probably also purchasers from the patentee with notice of the exclusive licence (q).

patent rights, *Betts v. Wilmot* (1871), 6 Ch. App. 239, whereas a licence to manufacture under a foreign patent does not in general give the right to import into this country. *Société &c. des Glaces v. Tilghmann's Patent Sand Blast Coy.* (1883), 25 Ch. D. 1, C. A. Of course a purchaser from a licencee cannot be in this respect in a better position than such licencee. *Coppin v. Palmer*, 15 R. P. C. 373; cf. also *Dunlop Pneumatic Tyre Coy. v. Buckingham*, 18 R. P. C. 423.

(i) *Kenny's Patent Buttonhole Coy. v. Somervell* (1878), 38 L. T. 878; *Lawson v. Donald Macpherson & Coy.*, 14 R. P. C. 697; *Badische, &c. v. Isler*, 23 R. P. C. 173, 180.

(k) Cf. *Ward v. Livesey*, 5 R. P. C. 102; *Postcard Automatic Supply Coy. v. Samuel*, 6 R. P. C. 560. But see *Henderson v. Shicks*, 24 R. P. C. 108, and p. 246, n. (r).

(l) See *Goucher v. Clayton* (1865), 13 L. T. 115; *Warwick v. Hooper* (1852), 2 Mac. & G. 60.

(m) *Tweedale v. Howard*, 13 R. P. C. 522.

In some cases the proposed licencee may be in a position to elect whether or no he will be treated as a licencee. *Postcard Automatic Supply Coy. v. Samuel*, 6 R. P. C. 560.

Where the negotiations for a licence fell through damages were refused for acts done with the patentees' knowledge during such

negotiations. *Coslett Anti-Rust Syndicate v. Bennett*, 29 R. P. C. 481.

(n) *Heap v. Hartley*, 6 R. P. C. 495, C. A. See also *Protheroe v. May* (1839), W. P. C. 414.

A licence is in the nature of a chose in action. *British Microscope Coy. v. Homer*, 18 R. P. C. 177.

It is probable that a licencee could compel the legal owner to perform acts necessary for his full enjoyment of the patent. Cf. *Frentzill v. Dougill*, 21 R. P. C. 641.

(o) *Heap v. Hartley*, *ubi supra*. See also *Frentzill v. Dougill*, *ubi supra*, at p. 645.

An interim injunction was granted, however, to a licencee in *Thorne v. Worthing* (1878), 6 Ch. D. 415.

This rule has been questioned in Scotland, see *Cochrane & Coy. v. Martin (Birmingham), Ltd.*, 28 R. P. C. 284.

It is sufficient if the patentee is joined as defendant. *Renard v. Levinstein* (1865), 2 H. & M. 628.

In this case it was also said that a licencee could sue persons infringing with knowledge of his rights. See also same case at 13 W. R. 382; see also *Hassal v. Wright* (1870), L. R. 10 Eq. 509, and p. 12, n. (i).

(p) *Rapid Steel Coy. v. Blakestone*, 24 R. P. C. 529; *Hassal v. Wright* (1870), 40 L. J. (CH.) 144.

(q) *Heap v. Hartley*, *ubi supra*; cf. also *Guyot v. Thomson*, 11 R. P. C. 541.