

In *Dudgcon v. Thomson* (r), an interdict granted prior to the amendment was refused to be enforced after the amendment, on the ground that the amendment materially altered the patent, and that it was quite possible that there was no infringement of the patent as altered.

Section 21. "*Every amendment of a specification shall be advertised in the prescribed manner.*"

P. R. 1890, r. 59, provides that such advertisement shall be in the official journal of the Patent Office, and in such other manner (if any) as the comptroller may direct.

The effect of sections 18—20 of the Act is summed up in the judgment of A. L. Smith, J., in *Re Hall and Others* (s): "Sect. 18 gives power to a patentee, when he finds out the blunder in the specification himself, to seek leave to amend his specification by way of disclaimer, correction or explanation, and he can go *proprio motu*, to the comptroller, and say, 'I want to amend the blunder I have got in my specification as regards disclaimer, correction, or explanation.' Then there are a series of sub-sects. showing what the comptroller is to do; how notice is to be given; what has to be done, and how other parties may come in and object; and the last sub-sect. it seems to me, is most natural: 'The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending' (t). That means this, that where a patent is in litigation, he should not go behind the back of the other party and get these amendments and set himself quite right. . . . What would happen if that had remained there? After litigation had been commenced, if there had been no sect. 19, the patentee, as soon as the writ was issued, would be fixed, no matter what small technical blunder there might be in his specification. But what the Legislature says is this—and I read sect. 19 as a proviso to sect. 18:—'Provided always that a judge or the Court may give liberty,' but only liberty . . . to the patentee to apply

(r) L. R., 3 App. Cas. 34.

(s) 5 P. O. R. at p. 312.

(t) This sub-sect. is amended by sect. 5 of Act of 1885.

at the Patent Office for leave to amend his specification by way of disclaimer."

It has already been noticed that where leave to apply has been granted and the amendment allowed, without a term being imposed that the amendment shall not be retrospective, then the specification must be tested by the provisions of sect. 20, and the amendment will only be retrospective in its action if it can be clearly shown that the original claim was framed in good faith and with reasonable knowledge.

CHAPTER XII.

THE DEVOLUTION OF A PATENT.

WE have seen that a "patentee" is "the person for the time being entitled to the benefit of a patent." This includes the first inventor and any person or persons in whom the patent may have become vested by operation of law or by assignment.

The property of a patent passes, by operation of law, when the patentee dies or becomes a bankrupt. Upon the death of a patentee his interest in the property passes to his executors or administrators as the case may be in the like manner to the rest of his personal estate. Any step which in the Act is required to be taken by the patentee, may be taken by the executor or administrator, and sect. 34 of the Act provides that—"(1) *If a person, possessed of an invention, dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to, his legal representative.*" This undoubtedly, seeing the terms of the grant itself, will mean his legal personal representative (a). Some letters patent of the Crown (not for inventions) have a limitation to heirs or heirs male, such, for instance, as patents of nobility.

If the patentee becomes bankrupt the property in the patent will pass to his receiver, trustee or assignee in bankruptcy (b). It is doubtful whether the doctrine of apparent possession can be said to affect a patent right. The Lord Chancellor, in 1812, seems to have thought that it did (c). This, however, can hardly be quoted as an authority. The persons in whom the patent

(a) See *Re Edmund's Patent*, Griff. P. C. 281.

R. 215; *McAlpine v. Mangnall*, 15 L. J., C. P. 298.

(b) *Hesse v. Stevenson*, 3 B & P. 565; see also *Bloxam v. Elsee*, 9 D. &

(c) See *Ex parte Granger*, Godson on Patents, 2nd ed. p. 225.

vests, by reason of bankruptcy, are placed in all respects in the position of the original patentee, and may sue in respect of infringements (d).

The second method of devolution is by assignment *inter vivos*. This may be done either by absolute assignment of the whole of the patent, or by absolute assignment of the patent right for a limited area, or by assignment by way of mortgage, or by the grant of licences.

The right of the original inventor to assign the exclusive right which has been granted to him is recognised in the patent itself, which is granted to the said A. B., his executors, administrators or assigns. Without these words of limitation the property in the patent right would be merely personal, attaching to the person of the first inventor and becoming extinguished by his death.

By sect. 36 of the Act, "a patentee may assign his patent for any place in or part of the United Kingdom or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only."

The patent itself being a deed the assignment must also be by deed (e); but a parol agreement to assign will operate as an equitable assignment of the patent (f), and specific performance of such an agreement will be enforced (g).

Assignment may be made to any person, or to any two or more persons as tenants in common, or to a body corporate.

Executors may assign a patent after the grant, but prior to registration of the probate (h).

The assignment of a patent with no express warranty incorporated in the contract, like the assignment of an ascertained chattel, carries with it no implied warranty of its quality (i), and the question to be decided in each case is: "Did the defendants buy a good and indefeasible patent right, or was the contract

(d) *Bloxam v. Elsee*, supra.

N. S. 1079.

(e) Co. Lit. 9 b, 172 a; *Stewart v. Casey*, 9 P. O. R. 9, 13.

(i) *Hall v. Conder*, 26 L. J., C. P. 138, 142; *Smith v. Neale*, 26 L. J., C. P. 143, 148; see also 56 & 57 Vict. c. 71, sect. 14, ss. 1.

(f) *Stewart v. Casey*, 9 P. O. R. 9.

(g) *Lewin v. Brown*, 14 W. R. 640.

(h) *Ellwood v. Christy*, 10 Jur.,

merely to place the defendants in the same situation as the plaintiff was in, with reference to the alleged patent?" (k).

Where the plaintiff purports to assign the exclusive right of selling certain things for the manufacture of which a patent had been obtained, there is in such case an implied warranty that the patent is a valid one, since otherwise it would be impossible to assign such exclusive right (l).

Upon assignment of a patent without a warranty the assignee may not, in an action upon the contract of assignment, set up the invalidity of the patent as a defence; the cases and considerations which arise upon this point will be left to be dealt with in the succeeding chapter under the head of "Estoppel."

In *Re Railway and Electric Appliances Co.* (m), the patentees made an absolute assignment of their patent to the company on the terms that the company should pay to them a royalty upon every article "which should be manufactured or sold by the company" under the patent "while subsisting," and also a share of the profits; through inadvertence the renewal fee at the end of five years from the date of the patent was not paid by the assignors, and it was held by Kay, J., that there was no term in the contract, express or implied, whereby the assignees could be held liable on account of the lapse of the patent and consequent loss of royalties to the assignors.

An assignee of a distinct part of a patent is entitled to sue for an infringement of that part without joining the persons who are interested in the remaining part or parts (n).

Where an assignee of a patent covenants with the assignor for himself and his assigns that he will work the patent and pay certain royalties thereon to the assignor, a subsequent assignee with notice takes the patent subject to those covenants (o); so too an assignee can maintain a suit against subsequent licensees of the assignor with notice of the assignment, to restrain them from using the patent (p).

(k) Per Cresswell, J., in *Hall v. Conder*, 26 L. J., C. P. 143.

(l) *Chanter v. Leese*, 5 M. & W. 698; *Hall v. Conder*, 26 L. J., C. P. 143.

(m) L. R., 38 Ch. D. 597.

(n) *Dunnicliff v. Mallett*, 7 C. B., N. S. 209; 29 L. J., C. P. 70.

(o) *Werderman v. Société Générale D'Electricité*, L. R., 19 Ch. D. 246.

) *Hassall v Wright ht*, L. R., 10 Eq.

An agreement by the vendor of a patent to assign to the purchaser, all patent rights that he may subsequently acquire of a like nature to the patent then sold, is not contrary to public policy and will be upheld (*q*); so too a covenant by a licensee for the residue of a term of 14 years, of patented improvements in machinery for slubbing fibrous substances, not to make or vend any slubbing frames whatever without the invention applied to them, was held not to be void as a covenant in restraint of trade, and although the licensee subsequently discovered that the patent was useless and no one could be induced to purchase frames to which it was applied, the Court held that this was no answer to the action (*r*).

Where a grant of letters patent has been made to two or more persons, or has been assigned by the original patentee to two or more persons, each of the co-grantees or co-assignees, has the right to put the invention into practice without incurring the liability to account to his co-owners for the profits which he may make. In *Steers v. Rogers*, Lord Herschell, in delivering the judgment of the House of Lords, said (*s*): "Letters patent do not give the patentee any right to use the invention; they do not confer a right to manufacture according to his invention. That is a right which he would have equally effectually if there were no letters patent at all; only in that case all the world would equally have the right. What the letters patent confer is the right to exclude others from manufacturing in a particular way, and using a particular invention. When that is borne in mind it appears to me impossible to hold, under these circumstances, that where there are several patentees, either of them, if he uses the patent, can be called upon by the others to pay to them a portion of the profits which he makes by that manufacture, because they are all of them entitled, or perhaps any of them entitled, to prevent the rest of the world from using it" (*t*).

The rights of co-owners *inter se* are summed up by Lindley,

(*q*) *Printing & Numerical Registering Co. v. Sampson*, L. R., 19 Eq. 462; 44 L. J., Ch. 705; 32 L. T. 354; 23 W. R. 463.

(*r*) *Jones v. Lees*, 26 L. J., Ex. 9; 1

H. & N. 189; 2 Jur., N. S. 645.

(*s*) 10 P. O. R. 251; L. R., 1893, A. C. 235.

(*t*) See also *Mathers v. Green*, L. R., 1 Ch. 29.

L.J., in his book on Partnership (*u*): "In the case of a patent belonging to several persons in common, each co-owner can assign his share, and sue for an infringement (*x*); and can also work the patent himself, and give licences to work it, and sue for royalties payable to him for its use (*y*); and it is now settled that he is entitled to retain for his own benefit whatever profit he may derive from the working, although it is perhaps still open to question whether he is not liable to account for what he receives in respect of the licences" (*z*).

The grounds upon which one co-owner can sue for infringement of the patent without joining the other co-owners are clearly set out in the judgment of Page-Wood, V.-C., in *Dent v. Turpin* (*a*); the law as therein expressed is that although he may sue alone, the Court will not grant a decree for further relief than that which is purely personal to himself, that is to say, he may have an injunction against the infringer, but he will only receive that portion of the damages to which the Court may think he is entitled; this would seem to show that he is only entitled to such portion of the damages as bear a relation to his interest in the patent.

In *Smith v. L. & N. W. Ry. Co.* (*b*), it was decided that the right of co-owners to damages for infringement was a joint right and on the death of one the survivor was entitled to recover the whole.

Where a sole patentee worked the patent in partnership with another for some years during which time they were extensively advertised as joint patentees, it was held that the partner of the sole patentee thereby acquired such an interest in the patent as to enable him to work it independently after the partnership had expired (*c*), but this would not be the case if it were a term of the

(*u*) 5th ed. p. 62.

(*x*) *Dunnicliffe v. Mallett*, 7 C. B., N. S. 209; *Dent v. Turpin*, 2 J. & H. 139; 30 L. J., Ch. 495; *Sheehan v. Great Eastern Railway*, L. R., 16 Ch. D. 59, 63.

(*y*) *Sheehan v. Great Eastern Railway*, L. R., 16 Ch. D. 59.

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

29; *Russell's Patent*, 2 De G. & J. 130.

(*a*) 2 J. & H. 139; 30 L. J., Ch. 495, 496.

(*b*) 2 El. & Bl. 69, 74; 17 Jur. 1071; Macr. P. C. 188, 207.

(*c*) *Kenny's Patent Button-Holding Co. v. Somervell*, 38 L. T. 878; 28 W. R. 786.

partnership that the patent rights in the invention should belong exclusively to one of them (*d*).

A mortgagee registered as such at the Patent Office has not such an interest in the patent as to be a necessary party to an action for infringement, since the mortgagor and not the mortgagee is the person for the time being entitled to the benefit of the patent, and consequently in the same position as the mortgagor of any other property whether real or personal (*e*).

Fraudulent agreements for the assignment of patents, such, for instance, as bubble patents, will be set aside (*f*). But in the absence of fraud the agreement will be enforced, and it is no defence to the action that the plaintiff has not invented the alleged invention (*g*).

Licences differ from assignments, in that the patentee granting a licence does not part with his whole interest, but grants merely a right to use the patent for the whole term or any portion of the whole term, that is merely a right to do that which without a licence could not be done except by violating the monopoly granted to and still vested in the licensor (*h*).

Sect. 22 of the Act of 1883 provides for the granting of compulsory licences.

“ If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licences on reasonable terms—

“ (a) The patent is not being worked in the United Kingdom ; or,

“ (b) The reasonable requirements of the public with respect to the invention cannot be supplied ; or

“ (c) Any person is prevented from working or using to the best advantage an invention of which he is possessed, the Board may order the patentee to grant licences on such terms as to the amount of royalties, security for payment or otherwise, as the Board, having

(*d*) *Azmann v. Lund*, L. R., 18 Eq. 330, 336.

(*e*) *Van Gelder Aprimon & Co. v. The Sowerby Bridge Flour Society*, 7 P. O. R. 208 ; *Fairclough v. Marshall*, L. R. 4 Ex. D. 87.

(*f*) *Lovell v. Hicks*, 2 Y. & C. 46.

(*g*) *Smith v. Buckingham*, 18 W. R. 314.

(*h*) *Heap v. Hartley*, 6 P. O. R. 495, 500 ; see also *Muskett v. Hill*, 5 Bing. N. C. 694, 707 ; *Thomas v. Sorrell*, Vaugh. Rep. 351 ; *Newby v. Harrison*, 1 J. & H. 398 ; 8 De G. F. & J. 287.

regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus."

These provisions are entirely novel; (a) and (b) are capable of being reasonably construed; as to "(c)" it is difficult to understand how the Board of Trade will come to a decision as to whether "a person is prevented from working or using, to the best advantage, an invention of which he is possessed." The "invention" must be protected by letters patent (see the construction given in sect. 46).

The proceedings under sect. 22 are regulated by Patent Rules, 1890, rr. 60—66.

A licence granted by the patentee may be exclusive or otherwise, that is, it may be a grant of the sole right to put the invention into practice, or of a right limited in time or in area, or of a right only to be exercised in conjunction with others; but as has been pointed out above, a licence, even though it may be exclusive, does not convey such an interest in the patent as to amount to an assignment of it.

Licences should be under seal, the prohibition in the grant itself being "without the consent, licence or agreement of the said patentee in writing under his hand and seal."

A licence granted by a patentee, but not under seal, is, however, not void in the sense that the licensee, having used the patent, is not bound to pay the royalties contracted for. In *Chanter v. Deichurst (i)*, it was held that the defendants, having obtained the licence they had bargained for, and kept it, were bound to pay for it; and secondly, that the licence was not void as not being under seal. Baron Alderson said: "The defendants, in making the machine in question, are merely acting as agents for the patentee . . . in my opinion a licence for this purpose need not be under seal."

Although the words of the grant are "under his hand and seal," the document is not a deed, since it need not be delivered as a deed, nor need it be stamped as such (k).

In the absence of fraud money paid by a licensee for royalties

(i) 12 M. & W. 823.

408.

(k) *Chanter v. Johnson*, 14 M. & W.

cannot be recovered when it is ascertained that the patent was void *ab initio* (l). And if the licensees have kept the licence and used it, the licensor can recover from them the agreed royalties, although the patent may have been void and the licence not under seal (m); but otherwise, if the licensor knew from the first that the patent was void (n). But if the consideration for the money paid is that an application for a patent should be made and a licence to use the patent granted, no application being made for the patent, there is a total failure of consideration, and the price paid may be recovered (o). A licence is not assignable (p). A licence to a man and his assigns means a licence with power to licensee to sub-license (*idem*). A licensee may covenant not to manufacture without applying the patented invention; such a covenant is not in restraint of trade (q). A patentee having granted a licence cannot prevent anyone vending the articles which have been made in pursuance of the licence (r). And an inventor selling the patented article abroad cannot restrain its importation and sale in this country, although an assignee of the patent in this country might restrain the importation of an article made by the original inventor or his assignee abroad (s).

An exclusive licensee of an invention for a district cannot maintain an action against one who, having purchased a thing which was the subject-matter of the invention, should bring his purchase within such district without notice of the licence (t); registration at the Patent Office does not amount to notice to the whole world (*ibid.*). A latent ambiguity in a licence by deed may be explained by parol evidence in the same manner as other deeds (u). A licensor may in the licence deed stipulate for a

(l) *Taylor v. Hare*, 1 B. & P. (N. R.) 260.

(m) *Chanter v. Dewhurst*, 12 M. & W. 823.

(n) *Chanter v. Leese*, 4 M. & W. 295.

(o) *Knowles v. Bovill*, 22 L. T., N. S. 70.

(p) Per Maule, J., in *Bower v. Hodges*, 22 L. J., C. P. 198.

(q) *Jones v. Lees*, 1 H. & N. 189

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

(s) *Betts v. Willmott*, L. R., 6 Ch. 239; see also *Société Anonyme v. Tilghman*, L. R., 25 Ch. D. 1; 53 L. J., Ch. 1; 49 L. T. 451; 32 W. R. 71; *Heap v. Hartley*, 5 P. O. R. 610.

(t) *Heap v. Hartley*, 5 P. O. R. 603; 6 P. O. R. 495.

(u) *Roden v. The London Small Arms Co.*, 46 L. J., Q. B. 21

forfeiture in the event of royalties not being paid (*x*), but such forfeiture may be waived (*y*). The licensor may also agree that he will take all necessary steps to support the validity of the patent (*z*).

A licence may be created by parol (*a*), but whether by parol or under seal, if there is no time fixed for its duration (*b*), and no term in the licence which would necessitate a different construction (*c*), it may be determined at will by either party. In *Mills v. Carson* (*d*), the patentee granted by deed an exclusive licence to the defendant for the remainder of the term of the patent, in consideration of which the defendant agreed to pay 100% per annum for the remainder of that term, such a condition was held to be totally inconsistent with a licence revocable at will. Express notice to revoke must be given, and the mere plea that the licence has been abandoned is not in itself sufficient (*e*).

A licensee cannot sue alone for infringement of the patent, and this would appear to be so even in the case of an exclusive licensee (*f*), who must sue either in the name of the patentee (*g*), or be joined with the patentee as co-plaintiff.

In *Renard v. Levinstein* (*h*), the licensees and the owners of the patent were joined as co-plaintiffs; while the action was pending, the owners parted with their interest to a third party; under these circumstances Wood, V.-C., overruled the objection that the plaintiffs did not show sufficient interest to maintain the action.

(*x*) *Tielens v. Hooper*, 5 Exch. 830.

(*y*) *Warwick v. Hooper*, 3 M. & G. 60.

(*z*) *Henderson v. Mostyn Copper Co.*, L. R., 3 C. P. 202.

(*a*) *Crossley v. Dixon*, 10 H. L. Cas. 293; L. J., 32 Ch. 617, H. L.; *Chanter v. Dewhurst*, 12 M. & W. 823; 13 L. J., Ex. 198; *Post Card Automatic Supply Co. v. Samuel*, 6 P. O. R. 560.

(*b*) *Crossley v. Dixon*, 10 H. L. Cas. 293; *Redges v. Mulliner*, 10 P. O. R. 21, 27; *Cheetham v. Nuthall*, 10 P. O. R. 321, 333; see also *Wood v.*

Leadbitter, 13 M. & W. 838; 9 Jur. 187; 14 L. J. Ex. 161.

(*c*) *Ward v. Livesay*, 5 P. O. R. 102, 108; *Guyot v. Thomson*, 11 P. O. R. 541, 554.

(*d*) 9 P. O. R. 338; 10 P. O. R. 9.

(*e*) *Cheetham v. Nuthall*, 10 P. O. R. 321, 333.

(*f*) *Heap v. Hartley*, 6 P. O. R. 495, 500; *Renard v. Levinstein*, 2 H. & M. 628; *Barnett v. Barrett*, 1 P. O. R. 9; see also *Woolley v. Broad*, 9 P. O. R. 208.

(*g*) *Heap v. Hartley*, at page 501.

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

In *Cheetham v. Nuthall* (i), it was provided that the licensee should determine if the patent was declared invalid; in an action brought by the licensor against a third party for infringement, the patent was held to be invalid, but this judgment was reversed by consent; the defendant after due notice continued to work under his licence, and it was held that he was still liable to pay royalties for the use of the invention.

An assignee of a share of the profits is entitled to an account of the profit from the person by whom they are payable; but the account should be taken once for all in the presence of all the persons interested (j).

Sect. 23 of the Act provides:—“(1) *There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents and of amendments, extensions and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed; (2) the register of patents shall be prima facie evidence of any matters by this Act directed or authorized to be inserted therein; (3) copies of deeds, licences and any other documents affecting the proprietorship in any letters patent or in any licence thereunder, must be supplied to the comptroller in the prescribed manner for filing in the Patent Office.*”

By sect. 85, “*There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust, express, implied, or constructive.*” Sect. 87, as amended by sect. 21 of the Patents, &c., Act, 1888, provides for the entry in the register, at the request of the person becoming entitled, of any assignment or transmission of interest. The person registered shall have power to deal with such interest as he has registered, absolutely: “*Provided that any equities in respect of such patent, &c., may be enforced in like manner, as in respect of any other personal property.*” Sect. 88, as amended by sect. 22 of the Patents, &c., Act, 1888, deals with the inspection of registers, and the

(i) 10 P. O. R. 321.

17 Ch. D. 423.

(j) *Bergmann v. Macmillan*, L. R.,

obtaining of certified copies. By sect. 89 sealed copies are to be received in evidence.

The effect of these sections is to prohibit the entry upon the register of simple notices of trusts, but any other documents affecting the proprietorship of the patent, whether by creating trusts or otherwise, are not to be excluded (*k*); it has been already noticed that an assignment of a patent should be by deed, but an agreement to assign is an equitable assignment, and consequently may be entered on the register under section 23 (*l*), but the documents containing the agreement and entered on the register must be complete, and upon which specific performance of the agreement could be enforced, since otherwise no legal or equitable interest in the patent or proprietorship thereof would pass (*m*).

Sect. 90, as amended by sect. 23 of the Patents, &c., Act, 1888, empowers the Court (High Court of Justice) to order the alteration of the registers, upon the application of persons aggrieved, and upon sufficient cause shown. The comptroller may himself correct errors in registers which are merely of a clerical nature, sect. 91.

The comptroller may refuse to enter upon the register of patents a document dated before the patent, upon the ground that it does not contain a sufficient proof of title (*n*).

The regulations affecting registration under the above sections are contained in Patents Rules, 1890, rules 67—79.

Sect. 35 of the Act of 1852, after providing for the registration of proprietors, assignments, &c., of patents, proceeded: "Provided always, that, until such entries shall have been made, the grantee or grantees of letters patent shall be deemed and taken to be the sole and exclusive proprietor or proprietors of such letters patent, and of all licences and privileges thereby given or granted."

It will be observed that the Act of 1883, quoted above,

(*k*) *Stewart v. Casey*, 9 P. O. R. 9, 11, 15.

(*l*) *Ibid.*, at p. 15; see also *In re Fletcher's Patent*, 10 P. O. R. 252.

(*m*) *In re Fletcher's Patent*, 10

P. O. R. 252, 255; *Haslett v. Hutchinson*, 8 P. O. R. 457, 466.

(*n*) *In re Parnell's Patent*, 5 P. O. R. 126.

materially differs from this enactment. Hence *Chollett v. Hoffman* (o), and *Hassall v. Wright* (p), will not now apply.

Prior to the Act of 1883, the High Court of Justice exercised jurisdiction to alter and amend the register of patents (q).

The register should be amended whenever a fraudulent entry has been made. A patentee assigned half a patent to A., and afterwards he assigned the whole to B. by deed, reciting that he had already granted a licence to work and use to A. B.'s assignment was first registered :—Held, that B. had constructive notice of A.'s rights, and an entry was ordered to be made in the register that the licence referred to in B.'s assignment was the deed of assignment to A. subsequently entered (r).

Registration does not amount to notice to the whole world, so where the grant of an exclusive licence for a district had been entered on the register, it was held that this did not amount to notice so as to affect an innocent purchaser outside of that district bringing his purchase within the district in violation of the rights of the licensee (s).

A co-owner of a patent has no right to cause an entry to be made in the register, which purports to affect or prejudice the rights of the other, and should he do so, the entry will be expunged at the instance of the injured party (t).

(o) 7 Ell. & B. 686.

(p) L. R., 10 Eq. 509 ; 40 L. J., Ch. 145.

(q) *In re Morgan's Patent*, 24 W. R. 245.

(r) *In re Mosey's Patent*, 25 Beav.

581.

(s) *Heap v. Hartley*, 5 P. O. R. 603 ; 6 P. O. R. 495.

(t) *In re Horsley & Knighton's Patent*, L. R., 8 Eq. 475.

CHAPTER XIII.

ESTOPPEL.

HAVING assigned a patent, the original patentee cannot manufacture the patented article; should he do so and an action for infringement be brought against him by his assignee, he may not set up the defence that the patent is invalid; he is estopped by his deed (a), that is, by the deed of assignment, but when the assignment is by operation of law there is no such estoppel. In *Cropper v. Smith* (b), in 1873, letters patent for improvements in lace machines were granted to H., who in 1877 went into liquidation and the patent was sold by the trustee to the plaintiffs. H. afterwards entered into partnership with S., and this action was brought against S. and H. to restrain them from infringing the patent; held that H. was not estopped from disputing the validity of the patent either by matter of record, on the ground that the letters patent were of record; or by deed, by reason of the specification being under his seal; or by matter *in pais*, on the ground of the statements in his petition to the Crown, there being nothing to show that the plaintiffs bought on the faith of those statements. (But see Bankruptcy Act, 1883, sect. 50, sub-sect. 5.) It is probable that there is estoppel by record between the Crown and the grantee of letters patent (c), but this would only be against the subject, since no estoppel operates against the Crown. In an action brought by the assignor to enforce an agreement for an assignment of letters patent, it is

(a) *Oldham v. Langmead*, cit. in *Hayne v. Maltby*, 3 T. R. 488; *Lainson v. Tremere*, 1 A. & E. 792; *Chambers v. Crichley*, 33 Beav. 374.

(b) L. R., 28 Ch. D. 700; L. R., 10

App. Cas. 249; 1 P. O. R. 81; 2 P. O. R. 17.

(c) Per Fry, L.J., L. R., 26 Ch. D at p. 712.

not open to the assignee to challenge the validity of the patent (*d*).

An assignment of patent rights in a partnership dissolution deed will estop the retiring partner from subsequently setting up the invalidity of the patent by way of defence to an action brought by his late partners (*e*). But where the plaintiff and defendant had been partners, and had worked as such the defendant's patent, there being no deed between the plaintiff and defendant which inferred the validity of the patent, held that plaintiff was not estopped from denying the validity of the patent (*f*). And where partners are joined as defendants in an action for infringement, and one is assignor of the patent, the other is not debarred from setting up the pleas of invalidity (*g*).

In *Bowman v. Taylor and others* (*h*) the plaintiff sued the defendants for the non-payment of certain royalties due from the defendants to the plaintiff under a licence under seal for the use of the plaintiff's patent. The defendants defended on the grounds (1) that the invention was not a new invention, (2) that the plaintiff was not the first and true inventor, (3) that the specification was not sufficient—pleas which in effect endeavoured to put in issue the validity of the plaintiff's title. Upon demurrer, Taunton, J., said, "The law of estoppel is not so unjust or absurd as it has been too much the custom to represent. The principle is, that where a man has entered into a solemn engagement by deed under his hand and seal as to certain facts, he shall not be permitted to deny any matter which he has so asserted. The question here is, whether there is a matter so asserted by the defendant under his hand and seal that he shall not be permitted to deny it in pleading. It is said that the allegation in the deed is made by way of recital, but I do not see that a statement such as this is the less positive because it is introduced by a 'whereas.' Then the defendant has pleaded

(*d*) *Smith v. Buckingham*, 21 L. T. 874.

819; 18 W. R. 314; *Liardet v. Hammond Electric Light Co.*, 31 W. R. 710; *Hall v. Conder*, 26 L. J., C. P., 138; 3 Jur. N. S. 366; 2 C. B., N. S. 22.

(*e*) *Chambers v. Crichley*, 33 Beav.

(*f*) *Axmann v. Lund*, L. R., 18 Eq. 330; 22 W. R. 789.

(*g*) *Heugh v. Chamberlain*, 25 W. R. 742.

(*h*) 2 A. & E. 278.

that the supposed invention in the declaration and letters patent mentioned was not nor is a new invention. These words 'was not nor is a new invention' must be understood in the same sense as the words 'had invented' in the recital of the deed set out in the declaration, and must refer to the time of granting the patent, and if the invention could not then be termed a new invention, it could not, I think, have been truly said in the deed, that the plaintiff 'had invented' the improvements in the sense in which the deed uses the words. Then the plea directly negatives the deed, and comes within the rule that a party shall not deny what he has asserted by his solemn instrument under hand and seal." The learned judge then proceeds to distinguish *Hayne v. Maltby* (i), but for some reason does not refer to the element of fraud in that case, which certainly would take it out of the operation of the doctrine of estoppel.

Besseman v. Wright (k) was decided on the ground of partial as against total failure of consideration, and has no reference to the doctrine of estoppel, although it seems sometimes to have been thought that it had.

In *Adie v. Clark* (l), James, L.J., said, "A licensee cannot under any pretence whatever bring his licensor into litigation as to the novelty of any part of the patent." This case was afterwards affirmed in the House of Lords (m). But it appears that if the licence has been determined prior to the expiration of the term of the patent the ex-licensees may contest the validity of the patent, notwithstanding the covenants or recitals in the licence (n). In giving judgment, Lord Cottenham said, "That is exactly coming to the point which I put, whether, at law, the party was estopped from disputing the patentee's right, after having once dealt with him as the proprietor of that right. And it appears from the authority of that case (*Hayne v. Maltby* (o)), and from the other cases, that from the time of the last payment (i.e. expiration of licence), if the manufacturer can successfully resist the patent right of the party claiming the rent,

(i) 3 T. R. 438.

(k) 6 W. R. 719.

(l) L. R., 3 Ch. D. 144.

(m) L. R., 2 App. Cas. 423.

(n) *Neilson v. Fothergill*, 1 Web. P. C. 287.

(o) 3 T. R. 438.

that he may do so in answer to an action for the rent for the use of the patent during that year." The language is not clearly reported, but this appears to mean—to an action for the use and occupation, so to speak, of the patent after the expiration of the licence.

The following cases have been decided uniformly, and show that parties to a deed of assignment or licence are estopped from denying the validity of the patent, and that there is no implied warranty on the part of the assignor or licensor. *Cutler v. Bower* (p), *Smith v. Scott* (q), *Walton v. Lavater* (r), *Norton v. Brooks* (s), *Crossley v. Dixon* (t).

An assignor of a patent cannot be restrained from giving evidence in an action for infringement brought by the assignee against a third party, although such evidence should tend to prove that the patent is in fact bad (u).

If a patentee in granting a licence should expressly warrant the validity of the patent, and thereby confer upon the licensee the right to dispute its validity, the licensee will not be estopped from relying on this defence in an action brought against him by the licensor (x).

Mills v. Carson (y) was an action for royalties due under an indenture made between the patentee *W. Notley* of the one part, and the defendants *J. A. Carson* and *D. Coleman Defries* of the other part, whereby an exclusive licence to use the invention was granted to the defendants. One of the terms of the agreement was that the patentee or his assigns would at the request of the defendants, take proceedings against any person infringing the patent, and it was further agreed that "if the said *W. Notley* should at any time omit or refuse to take such proceedings as aforesaid, and if the said letters patent should become void or ineffectual by reason of any such omission or refusal on the part of the said *W. Notley*, or by reason of the said invention not being

(p) 11 Q. B. 973.

(q) 6 C. B., N. S. 771, and 28 L. J.,
C. P. 325.

(r) 8 C. B., N. S. 162.

(s) 7 H. & N. 499.

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

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

(x) *Wilson v. Union Oil Mills Co.*,
9 P. O. R. 57; *Mills v. Carson*, 10
P. O. R. 17.

(y) 9 P. O. R. 388; 10 P. O. R. 9.

novel, or being an infringement of other letters patent, then the payment of the said annual sum under the indenture should cease and determine." Relying upon this condition the defendants set up the defence that the invention was not new; it was held that they were estopped from doing so, and that the words, "by reason of the said invention not being novel," meant, if it was proved not to be novel in an action brought for infringement by the patentee at the instigation of the defendants (z).

But where the defendant took a licence from the plaintiff to work his invention "subject to the result of an enquiry into the validity of the patent," and after the expiration of six months refused to continue to work the plaintiff's process on the ground that the patent was bad, it was held, in an action for royalties under the agreement, that it was open to the defendant to contest the validity of the plaintiff's patent (a).

The licensee may refer to the state of public knowledge at the date of the patent for the purpose of showing what is the true ambit of the specification (b), and he may, following the analogy of lessor and lessee, show that the patent in question has in fact expired (c).

Fraud is practically the only plea which a licensee can put forward in an action brought against him for the recovery of royalties, but this must be distinctly pleaded (d), beyond that the only reply that is left to the licensee is that he has not worked the patent in question (e).

Where the plaintiff, fraudulently asserting that he had a right to a patent, induced the defendant to come to terms with him for a licence to use that patent, the defendant, in an action upon that agreement, is not estopped from alleging the want of title in the plaintiff as a defence (f). But it would be

(z) 10 P. O. R. 17, 18.

(a) *Wilson v. Union Oil Mills Co.*, 9 P. O. R. 57.

(b) *Young v. Hermand*, 9 P. O. R. 373; see also *Crosthwaite v. Steel*, 6 P. O. R. 190.

(c) *Muirhead v. Commercial Cable*

Co., 11 P. O. R. 317.

(d) *McDougall v. Partington*, 7 P. O. R. 223; *Ashworth v. Law*, 7 P. O. R. 234.

(e) *Clarke v. Adie*, L. R., 2 App. Cas. 428, 435.

(f) *Hayne v. Maltby*, 3 T. R. 438.

otherwise in the absence of fraud and where both parties are innocent, in that case neither the assignee nor licensee would be allowed to set up as a defence the bad title of the assignor or licensor (g).

After the termination of the license, the licensee is no longer estopped from denying the validity of the patent (h).

Judgment having been recovered against the defendant in an action for infringement, such defendant cannot plead the invalidity of the patent as a defence to a subsequent action brought against him for an infringement of the same patent, he is estopped by the first judgment, and this is so, even though the first judgment was entered by consent (i); but where the defendants in the second action are not the same as those in the first, there will be no estoppel (k), though in such a case, if the patent had been previously upheld by a court of co-ordinate or superior jurisdiction, strong additional evidence will be required in order to reverse the previous finding (l).

The Act of 1883 abolished proceedings by *scire facias* to repeal a patent, and substituted therefor petition to the Court. It was at one time thought that since the Crown had ceased to be a party to proceedings to revoke a patent, estoppel would operate as regards question of fact which had been decided in a previous action between the same parties, this point has now been decided by the Court of Appeal in *Re Deeley's Patent* (not yet reported). An action for infringement of that patent had been previously brought by the patentee against the present petitioner (m), in which it was held that the first claim had been anticipated by Perkes' patent of 1878; this claim was again attacked on the same grounds in the petition for revocation, in which the parties

(g) *Taylor v. Hare*, 1 Web. P. C. 292, 293.

(h) *Axmann v. Lund*, L. R., 18 Eq. 337; *Goucher v. Clayton*, 11 Jur., N. S. 107; 34 L. J., Ch. 239.

(i) *Thomson v. Moore*, 6 P. O. R. 426, 431, 441; 7 P. O. R. 325.

(k) *Goucher v. Clayton*, 11 Jur., N. S. 107; 34 L. J., Ch. 239; *Otto v. Steel*, 3 P. O. R. 109, 114.

(l) *Bovill v. Goodier*, 35 Beav. 427; *Otto v. Steel*, 3 P. O. R. 109, 114; *Slazenger v. Feltham*, 6 P. O. R. 130; *Automatic Weighing Machine Co. v. Combined Co.*, 6 P. O. R. 120, 367; *Edison v. Holland*, 6 P. O. R. 243; *Shaw v. Day*, 11 P. O. R. 189.

(m) *Westley Richards v. Perkes*, 10 P. O. R. 181, 190.

were the same as in the action for infringement, the Court of Appeal held that there was no estoppel, on the grounds that a petition for revocation is a petition presented on behalf of the public, and it is immaterial that the person so representing the public should happen to have been a party to a previous action when the same facts were in dispute.

“An estoppel must be certain to every intent and not be taken by argument or inference” (n); so where a question of infringement was submitted to an arbitrator, who, in his award found that the letters patent were not illegal or void, in a subsequent action for infringement against the same defendant, it was held that the arbitrator’s award was not such a decision as to make an estoppel within the above cited rule (o).

A licensee cannot take advantage of a judgment obtained by third parties against the patentee declaring the patent bad (p). But a licensee, in an action by the patentee, may claim to place the most favourable construction on the specification, which will support the validity of the patent, if another construction would make it bad (q).

(n) Com. Dig. tit. Estoppel (E 4).

Machine Co. v. Millard, 8 Jur., N. S.

(o) *Newall v. Elliot*, 32 L. J., Ex. 713.
120.

(q) *Trotman v. Wood*, 16 C. B.,

(p) *The Grover & Baker Sewing* N. S. 479.

CHAPTER XIV.

EXTENSION OF TERM OF PATENT.

SECT. 25 of the Act of 1883 provides :

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

The period of six months limited by this sub-section will not apply to patents granted before the 1st January, 1884. With regard to such patents, the provisions of 5 & 6 Will. IV. c. 83, will apply, and applications for extension may be made at any time prior to the expiration of the patent ; this is by reason of the 113th section of the Act of 1883 (a). But once a patent is extended it becomes a new patent, and the whole of the Act of 1883 applies to it (b).

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

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

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

(a) *Brandon's Patent*, L. R., 9 App. 154
Cas. 589 ; 53 L. J., P. C. 84 ; 1 P. O. R.

(b) *Cocking's Patent*, 2 P. O. R. 151.

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

It is the practice to grant a new patent, such new patent being subject to the conditions in the Act of 1883 (c).

“ (6) *It shall be lawful for her Majesty in Council to make from time to time rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the Judicial Committee.*

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

These provisions have made no substantial alteration in the law. Prior to the Act 5 & 6 Will. IV. c. 83, there was no power in the Crown to extend the duration of letters patent, and should an inventor have desired to apply for an extension of the term of his grant, he could only do so by applying for and obtaining a special Act of Parliament in his favour. The Act of Will. IV., and the amending Act of 2 & 3 Vict. c. 67, introduced the method of petitioning and obtaining an extension to the Privy Council.

It had been found that the procedure to obtain an Act upon each occasion, when an extension was sought, was too costly and cumbrous, hence the modern course of procedure was devised.

This being shortly the origin of the jurisdiction of the Privy Council, at first an impression gained ground that the Privy Council were to put themselves in the position of Parliament, and not in that of a court of law, in considering the claims of applicants who appeared before them; that they were to weigh the claims of the public interest very heavily in the balance as against the inventor. In *Re Soame's Patent* (d), Lord Brougham

(c) *Smith's Patent*, Griff. P. C. 263.

(d) 1 Web. P. C. 729.

said: "If this case were to be disposed of upon the ground which, in arguing such cases, has sometimes been assumed to be the fit one, that there must not only be merit and benefit to the public, and (which is essential) a want of sufficient remuneration in the course of using the patent; but that, moreover, the case is to be tried here as on a bill in parliament introduced to prolong the patent; then, I apprehend, there can really be no doubt whatever that in this case no bill would ever have passed through the two houses of parliament."

The true construction is, however, not so severe as that, although still sufficiently severe. In *Re Morgan's Patent (e)*, Lord Brougham said: "It is by no means their (the Privy Council) course to put themselves precisely in the situation of the Legislature, and never to grant an extension where an Act of Parliament would not have been obtained. At the same time there are some limits to this. They are to look to a certain degree at the position in which they are placed, and to consider that they here represent the Legislature, and that they are invested with somewhat similar powers of discretion to those exercised formerly by the whole three branches of parliament."

Such is the spirit in which the Privy Council will approach the subject of an extension, not benevolently to the applicant, but still with not so stern a regard to the interests of the public as parliament would entertain.

In considering their decision the Privy Council will consider:—

1. The nature and merits of the invention in relation to the public.
2. The adequacy or inadequacy of the profits made by the inventor as such.
3. The circumstances of the case.

In *Re Erard's Patent (f)*, Lord Lyndhurst said: "In cases of this kind we expect a very strong case of hardship to be made out as well as a strong case upon the utility of the invention;" and the same privy councillor in *Soame's case (g)* said: "We consider the invention as very meritorious, the result of a great deal of labour, care, and science, and that it is extremely useful in its effects. We are satisfied by reasonable evidence that the

(e) 1 Web. P. C. 737.

(g) 1 Web. P. C. 729.

(f) 1 Web. P. C. 557.

party has sustained very considerable loss, and under these circumstances we think that the period ought to be extended."

It will be observed that the three considerations for the Privy Council laid down by the Act of 1883 are almost identical to the grounds of extension as given by Lord Brougham in *Re Derosne's Patent* (h): "The parties must show in the first place some invention, in the next place a benefit to the public, and in the third place that they have not had adequate remuneration."

It is immaterial whether or not the application is opposed. The Privy Council will require every necessary ground for extension to be strictly proved before they advise an extension (i), and this even though the Crown through the attorney-general consents (k).

"The merit of an importer is less than of an inventor. We are sitting judicially, and it is an argument against the patent that it is imported and not invented. I do not say it takes away the merit, but it makes it much smaller" (l).

Where it appeared that the imported invention had great commercial value, and that the petitioners had embarked a large capital in bringing the patent into use, whereby they had sustained a loss of nearly £10,000, an extension for six years was granted (m).

Extension of the term will be granted to assignees, as they have, so to speak, purchased the merit of the original inventor, but the argument against importers will apply with equal force against assignees (n).

In *Whitehouse's Patent* (o), the inventor was a mechanic in the employ of the petitioner, the petitioner was the assignee of the patent, and had expended large sums of money on the necessary plant and machinery; an extension was granted for six years, on condition that the petitioner secured to Whitehouse an annuity of £500 during the term of the patent.

(h) 2 Web. P. C. 4.

(i) *In re Perkin's Patent*, 2 Web. P. C. 6.

(k) *In re Cardwell's Patent*, 10 Moo. P. C. C. 488; see also *Darby's Patent*, 8 P. O. R. 380, 383.

(l) Per Lord Brougham, *In re Soame's Patent*, 1 Web. P. C. 729.

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

187.

(n) See *In re Napier's Patent*, 13 Moo. P. C. C. 543. See also *Norton's Patent*, 1 Moo. P. C., N. S. 339; *Pitman's Patent*, L. R., 4 P. C. 84; 8 Moo. P. C., N. S. 293.

(o) 1 Web. P. C. 473; see also *Hardy's Patent*, 6 Moo. P. C. C. 441.

“ Merit ” here means the consideration which has been given to the state for the patent ; it does not mean the merit of the inventor, but the merit of the consideration which he has given. An inventor may have diligently worked for years in a most desorving manner, and yet have produced an improvement of the most trifling nature—the merit of the person in this case will not be considered. On the other hand, the invention, although a great one, may have been handed to him from abroad without thought or trouble on his part. This is what Lord Brougham contemplates when he says that the merit of an importer is less than that of an inventor. Again, the invention may have been a very simple one, produced by an inventor with a moment of thought, and yet of great importance to the world. This latter case would be one of merit—simplicity of an invention being an element of its value (*p*).

In *Bailey's Patent* (*q*), Lord Blackburn said : “ What the statute says is that the judicial committee shall, in considering their decision, have regard to the *nature and merits of the invention* before that evidence has been called which shows what can hardly be disputed, viz., that the invention which is the subject of the patent is a beneficial invention ; but as to the petitioner showing that there was any *special or peculiar advantage* in the invention in relation to the public to entitle the patentee to the large reward of an extension of his patent, their lordships are of opinion that he has totally failed to do so.”

To sustain a petition for prolongation, a greater degree of merit must be shown, than that which would be sufficient to support the patent in a court of law (*r*).

The Privy Council will not inquire into the novelty or utility of a patent, except in so far as such novelty or utility may form elements in the consideration of the merit of the invention (*s*), unless the patent is clearly invalid (*t*).

(*p*) *In re Muntz's Patent*, 2 Web. P. C. 113.

(*q*) Griff. P. C., at p. 254.

(*r*) Per Sir W. Grove, *In re Stoney's Patent*, 5 P. O. R. 520 ; see also *Saxby's Patent*, L. R., 3 P. C. 292, 294.

(*s*) *In re Saxby's Patent*, L. R., 3 P. C. 292 ; *Stewart's Patent*, 3 P. O. R. 7 ; *Kay's Patent*, 1 Web. P. C. 568 ; 3 Moo. P. C. C. 24.

(*t*) *Erard's Patent*, 1 Web. P. C. 557 ; *Woodcroft's Patent*, 2 Web. P. C. 18.

Non-user of the patent creates a strong presumption against the merit of an invention, which presumption can only be rebutted by the strongest evidence (*u*). But the same objection being raised in *Re Hughes' Patent* (*x*), the application was granted after strong and unanswered evidence of merit, though the patent had not been used in England during the whole term (*y*).

In *Re Botts' Patent* (*z*) Lord Chelmsford said: "Dobbs' specification may have given the petitioner the idea of the possibility of uniting the two metals tin and lead, and may thus have deprived him of the merit of originality. But in Dobbs' hands the discovery was barren; the petitioner, however, who followed out his suggestion, and after repeated experiments gave it a practical application, is the real benefactor to the public, and is entitled to claim that description of merit which constitutes one of the grounds for extending the term of a patent" (*a*).

Where the applicants are a company who have purchased the patent for the purpose of trading with it, and not at all with the view of encouraging or rewarding the inventor, and an extension of the term of the patent would confer no benefit upon the latter at all, the application will be refused (*b*), but otherwise, if the inventor will reap a profit from the extension (*c*).

Where part of the invention is sufficiently meritorious and part not so, an extension of the term will be granted for the meritorious part only (*d*).

Merit is a vague term. Different persons have different ideas as to wherein it consists. Each case that comes before the Privy Council must of necessity, therefore, be decided upon the facts of that particular case. It is otherwise with the other necessary condition for an extension, viz., the inadequacy of the remuneration.

(*u*) *In re Allan's Patent*, L. R., 1 P. C. 507; 4 Moo. P. C., N. S. 443; *Bakewell's Patent*, 15 Moo. P. C. C. 385.

(*x*) L. R., 4 App. Cas. 174.

(*y*) See also *In re Wright's Patent*, 1 Web. P. C. 575; *In re Herbert's Patent*, L. R., 1 P. C. 399; 4 Moo. P. C., N. S. 300; *Southby's Patent*, 8 P. O. R. 433.

(*z*) 1 Moo. P. C., N. S. 49.

(*a*) See also *In re Hill's Patent*, 1 Moo. P. C., N. S. 258, at p. 265.

(*b*) *Norton's Patent*, 1 Moo. P. C. N. S., 339; *Sillar's Patent*, Good P. C. 581, 582.

(*c*) *Houghton's Patent*, L. R., 3 P. C. 461; 7 Moo. P. C., N. S. 309.

(*d*) *Bodmer's Patent*, 8 Moo. P. C. C. 282; *Lec's Patent*, 10 Moo. P. C. C. 226; *Church's Patent*, 3 P. O. R. 95; *Joy's Patent*, 10 P. O. R. 89.

ration of the inventor. Here figures can be dealt with, and a nearer approach to uniformity of decision obtained. It is possible, therefore, to gather from the various decisions a reasonably accurate set of rules for the guidance of the applicant for an extension on the ground of the inadequacy of the remuneration.

The sufficiency of the remuneration will be estimated with a view to the importance of the invention and the benefit the public have derived from it. That which would be ample remuneration for one patent would be considered inadequate for another. Refining sugar by filtering it through animal charcoal was an invention of great value and importance. The patent was extended for six years on the ground that although there had been a considerable profit it bore no relation to the great merit of the invention (*e*). So in *Re Newton's Patent* (*f*) the Privy Council granted an extension on the ground that there had not been sufficient remuneration considering the value of the invention.

If the patentee is a manufacturer of the patented article, the Privy Council will not endeavour to distinguish accurately his profits as a patentee from his profits as a manufacturer, but will consider the gross amount of profits (*g*). In this case Lord Brougham said: "We cannot weigh in golden scales the proportions between manufacturers' profits and patentees, but we must take it in the gross, and apply our minds as men of the world, men of business—neither unfairly towards the inventor, nor extravagantly and romantically towards him in his favour—neither against him pressing, nor in his favour straining. We must ascertain whether he has, in the eyes of men of ordinary but enlightened understandings, judging fairly between him and the public, had a sufficient remuneration."

The ground of this view of the case appears to be that the possession of the patent has placed the manufacturer in an advantageous position in obtaining orders (*h*).

(*e*) *In re Derosne's Patent*, 2 Web. P. C. 1.

(*f*) 14 Moo. P. C. C. 156.

(*g*) *In re Muntz's Patent*, 2 Web. P. C. 113.

(*h*) *In re Johnson's Patent*, 8 Moo. P. C., N. S. 282; also *Saxby's Patent*, L. R., 3 P. C. 292; 7 Moo. P. C., N. S. 82.

In the accounts which the patentee must file upon an application for an extension, when he is a manufacturer of the patented article he should, so far as possible, distinguish profits as a manufacturer from profits as a patentee (*i*); and in cases where it can be shown that the reasoning in *Johnson's case* (*supra*) does not apply, he will be allowed to deduct his profits as a manufacturer before an estimate is taken of his profits as a patentee (*k*).

But where he ascribed two-thirds of the profits to the manufacturer, and only one-third to the patent, it was held to be unreasonable (*i*).

It will be observed that the cases quoted above appear to conflict with the principles laid down by Lord Brougham in *Muntz's case* (*m*). These words cannot be read as meaning that no regard whatever will be paid to the fact, that a great portion of the patentees' plant, expenditure, or time, is devoted to the business of an ordinary manufacture, from which some profits would be derived, even if no patent were in existence, but that no attempt will be made to go into minute details of figures. The profits will be treated in gross, and then their lordships will apply their general knowledge, as men of the world, in coming to a conclusion as to how much the patentee has received from the profits of his invention.

In estimating profits, a deduction will be allowed for the expenses of experiments in bringing the invention to perfection (*n*). And also in respect of the costs of litigation necessary to maintain the validity of the patent, and to restrain infringers (*o*). But not where actions have been compromised, improvidently, and costs abandoned without sufficient reason (*p*). The expenses of taking out the patent will be allowed as a deduction (*q*). So also will the expenses incurred in bringing the

(*i*) *In re Betts' Patent*, 1 Moo. P. C., 739; also *In re Kay's Patent*, 1 Web. N. S. 49. P. C. 568.

(*k*) *Ib.*

(*l*) *In re Hill's Patent*, 1 Moo. P. C., N. S. 258; also *Duncan & Wilson's Patent*, 1 P. O. R. 257.

(*m*) 2 Web. P. C. at p. 120.

(*n*) *In re Bate's Patent*, 1 Web. P. C.

(*o*) *In re Galloway's Patent*, 1 Web. P. C. 724.

(*p*) *In re Hill's Patent*, 1 Moo. P. C., N. S. 258.

(*q*) *In re Roberts' Patent*, 1 Web. P. C. 573.

invention in general public use (r). And a deduction will be allowed in respect of the personal expenses of the patentee, and by way of salary for the exclusive devotion of his time in bringing the patent into practical operation and public notice (s). A patentee residing in America, for the purpose of getting the patented article into general use in England, employed an agent and allowed him half profits. This half was allowed to be deducted (t).

But, on the other hand, the patentee must add to his profits the profits arising out of the manufacture of the patented article, even though intended for exportation (u).

So also he must add the profits which have been made by any other persons interested in the patent, such as his licensees (x) or the assignees of a part, with free right to use the invention (y).

And in *Re Johnson's* patent Lord Justice James said: "Their lordships are of opinion, that where the question to be considered is, whether an invention has been sufficiently remunerated or not, in taking into consideration the remuneration received, they must have regard to the remuneration which the invention has brought in to the patentee, or the person who claims the right of the patentee, *whether it be in one country or another*" (z).

We have seen by sub-section 6 of the section of the Act of 1883, now under consideration, the rules of the Privy Council, which have been heretofore in force, are to continue until amended or altered.

Rule 9 is as follows:—"A party applying for an extension of a patent . . . must lodge at the council office six printed copies of the specification, and also four copies of the balance sheet of expenditure and receipts relating to the patent in question, which accounts are to be proved on oath before the lords of the committee at the hearing." This must be done within one week of the hearing: rule 10.

(r) *In re Galloway's Patent*, supra.

(s) *In re Carr's Patent*, L. R., 4 P. C. 539.

(t) *In re Poole's Patent*, 4 Moo. P. C., N. S. 452.

(u) *In re Hardy's Patent*, 6 Moo. P. C. C. 441.

(x) *In re Trotman's Patent*, L. R.,

1 P. C. 118; 3 Moo. P. C., N. S. 488; but see *Thomas' Patents*, 9 P. O. R. 367, 373.

(y) *Thomas' Patents*, 9 P. O. R. 367.

(z) L. R., 4 P. C. 75; 8 Moo. P. C. N. S. 282; see also *Hardy's Patent*, 6 Moo. P. C. C. 441.

The judicial committee will not enter into the accounts in a case for extension unless they have been filed in accordance with this rule (a).

But in exceptional cases, the filing of perfect accounts may be excused (b). Where the estate of a deceased patentee was of little value, and no accounts had ever been kept, the petitioner, the administratrix and widow of the patentee, was examined to prove an allegation in the petition, to the effect that not only had there been no profits, but a considerable loss (c).

And where the invention was of exceptional merit and it was clear that a loss of about £8,000 had been incurred, it was held that extreme accuracy in the accounts was unnecessary (d).

The account of profit and loss ought to be clear and precise (e). The application will be refused if the petitioner's accounts are unsatisfactory (f). The accounts furnished by the petitioner not containing sufficiently full and accurate information in respect of the patent, or the remuneration received by him, the judicial committee declined to recommend a prolongation of the term (g). In one case, the accounts being *prima facie* unsatisfactory, the judicial committee directed the question of accounts to be taken before considering the merits of the invention (h). And where the accounts were *prima facie* satisfactory, the petitioners were allowed to prove the merits of the invention before going into the accounts (i). The books of the petitioner in respect to profits arising from his patent having been lost during his bankruptcy, the account of profit and loss was taken upon his own evidence (k). This was an exception to the general rule, which is, that evidence will not be received from the petitioner; but in the

(a) *In re Johnson's & Atkinson's Patent*, L. R., 5 P. C. 87; and see *In re Yates' & Kellett's Patent*, L. R., 12 App. Cas. 147.

(b) *In re Lowe's Patent*, 10 Jur. 363.

(c) *In re Heath's Patent*, 8 Moo. P. C. C. 217.

(d) *In re Darby's Patent*, 8 P. O. R. 380, 384.

(e) *In re Betts' Patent*, 1 Moo. P. C., N. S. 49; *In re Saxby's Patent*, 7 Moo. P. C., N. S. 82; *In re Lake's Patent*,

8 P. O. R. 227; but see *In re Deacon's Patent*, 4 P. O. R. 119, 122.

(f) *In re Trotman's Patent*, 3 Moo. P. C., N. S. 488.

(g) *In re Clark's Patent*, 7 Moo. P. C., N. S. 255.

(h) *In re Wield's Patent*, L. R., 4 P. C. 89.

(i) *In re Houghton's Patent*, L. R., 3 P. C. 461; 7 Moo. P. C., N. S. 309.

(k) *In re Hutchinson's Patent*, 14 Moo. P. C. C. 364.

absence of the books, without reasonable excuse, everything will be taken most strongly against the petitioner (*l*).

Where a patentee, whether English or foreign, has obtained foreign patents, they should be stated in a petition for prolongation, and the fullest information afforded as to the profits thereof (*m*). A patentee should preserve the clearest evidence of everything which has been paid or received on account of the patent. Whether or not his remuneration has been adequate, his furnishing a satisfactory account is a condition precedent to his obtaining an extension of his term (*n*), and no alteration has been made in this respect by sect. 25, sub-sect. 4 of the Act of 1883 (*o*).

Should the accounts filed in the first instance be unsatisfactory, an adjournment of the hearing will sometimes be granted to allow the petitioner to amend (*p*), but good reason must be disclosed, as otherwise the petition will be dismissed (*q*).

The third head of subjects to be inquired into, upon an application for prolongation, consist of the various grounds of objections to an extension which have been allowed hitherto by the committee, and which are included in the general term used in sub-sect. 4, viz., "All the circumstances of the case."

That the invention has not been brought into public use is a good ground of objection (*r*), but if the invention is shown to be exceedingly meritorious, and the fact of non-user by the public satisfactorily explained, this will amount to a special circumstance which will be taken into consideration by the committee in support of the petition for extension (*s*). Negligence on the part of the patentee in restraining infringement is a good ground of objection (*t*). So also that the invention was practically useless

(*l*) *In re Lawrence's Patent*, 9 P. O. R. 85; see also *Yates' & Kellett's Patent*, L. R., 12 App. Cas. 147; 4 P. O. R. 150.

(*m*) *Newton's Patent*, 1 P. O. R. 177.

(*n*) *In re Adair's Patent*, L. R., 6 App. Cas. 176.

(*o*) *Newton's Patent*, L. R., 9 App. Cas. 592.

(*p*) *Perkins' Patent*, 2 Web. P. C. 6; *Johnson's & Atkinson's Patents*, L. R.,

5 P. C. 87.

(*q*) *Newton's Patent*, 1 P. O. R. 177; L. R., 9 App. Cas. 592; also *Yates' & Kellett's Patent*, L. R., 12 App. Cas. 147; 4 P. O. R. 150.

(*r*) *In re Pinkus' Patent*, 12 Jur. 283.

(*s*) *Roper's Patent*, 4 P. O. R. 201.

(*t*) *In re Simister's Patent*, 1 Web. P. C. 721; also *In re Pinkus' Patent*, supra.

as originally described in the specification, but was subsequently made practicable by subsequent improvements, introduced from abroad (u). But, otherwise, where the invention was useful and meritorious, in its original form, subsequent improvements form no ground in support of objection (x). When the non-profitable use of the patent has been caused by the fault of the patentee himself, objection will be allowed (y). So also where a patentee has delayed, intentionally, putting his invention into practice, unless he can show that shortness of funds, or other reasons, placed it out of his power to avoid the delay (z).

False statements made as to profits in the prospectus of a company floated for the purpose of manufacturing under the patent will be taken into consideration by the committee (a). Insufficiency of the specification with regard to disclosure of the method of putting the invention into practice is an objection (b). Where the patentee had an accident, through the effects of which he was incapacitated for eight years from pushing his invention, the committee considered this to be a special circumstance, and having regard to the other facts of the case granted an extension for a period of seven years (c).

A grant by the patentee of an exclusive license to work his invention, together with a covenant to continue such exclusive license in the event of a renewal being granted, is a good ground of objection (d), but where the licensee had no rights to the exclusive use of the patent during any period of prolongation that might be granted, and it did not appear that the interest of the public had been in any way affected by the grant of the exclusive license, it was held that this was no objection to the petition for extension (e), and in *Shone's Patent* (f) an extension

(u) *In re Woodcroft's Patent*, 1 Web. 85.
P. C. 740.

(x) *In re Galloway's Patent*, 1 Web. 332.
P. C. 724; *In re Southby's Patent*, 8
P. O. R. 433; but see *Nussey & Leach-*
man's Patent, 7 P. O. R. 22.

(y) *In re Patterson's Patent*, 6 Moo.
P. C. C. 469.

(z) *In re Norton's Patent*, 1 Moo. 380.
P. C., N. S. 339.

(a) *In re Lawrence's Patent*, 9 P. O. R.

(b) *In re Livel's Patent*, 9 P. O. R.

(c) *In re Roper's Patent*, 4 P. O. R.
201.

(d) *Cardwell's Patent*, 10 Moo.
P. C. C. 488.

(e) *In re Darby's Patent*, 8 P. O. R.

(f) 9 P. O. R. 438.

was granted subject to the condition that the exclusive licensee abandoned all right and benefit under the license.

We have seen that the novelty or utility of a patent will not be inquired into, except so far as they bear upon the merit of the invention. Nor will the validity of the patent be inquired into, excepting in cases where it is obvious the patent is invalid. In *Re Hill's Patent* (g), Sir J. T. Coleridge said: "Their lordships have not in these cases been in the habit of trying the validity of patents. They will not, of course, recommend the extension of a patent which is manifestly bad; but, on the other hand, they will not generally enter into questions of doubtful validity. They lay aside, therefore, the questions of want of novelty and want of utility, so far as they affect the validity of the patent. Indeed the learned counsel for the opponents disclaimed, and very properly, any intention of impeaching its validity directly; but they contended that, both with respect to the novelty and the utility of the invention, the degree of merit to be attributed to the petitioner ought to be taken into account; and in their lordships' judgment they are right in that contention. Unless the patent be very clearly invalid, so that it would be altogether nugatory to prolong that patent, the court usually has been rather inclined to assume that the patent may be a good patent, and so leave the question to any legal consideration that may arise in a contest between the parties who are interested in it" (h).

An illustration of what is meant by the patent being clearly bad is given in *Re M'Innes' Patent* (i). The patent was for a metallic soap to be used for the purpose of preserving metals from rust. The specification was very widely worded. Sir W. Earle said, "Their lordships taking into consideration with reference to the public interest that the individual substance for the application of which the patent is sought to be prolonged is not specially defined, every kind of metallic soap being within the limits of the specification, are of opinion that many questions affecting the patent might be raised if any metallic soap was used by the public in ignorance of the specification being as wide as it

(g) 1 Moo. P. C., N. S. 258.

(i) 5 Moo. P. C., N. S. at p. 78; see

(h) Per Lord Langdale, M.R., *In re Pinkus' Patent*, 12 Jur. 233. also *Sillar's Patent*, Good. P. C. 581.

is. On the whole, therefore, their lordships are of opinion that they ought not to recommend her Majesty under such circumstances to grant a prolongation."

In *Re Lane Fox's Patent*, a Court of First Instance held the patent invalid; while an appeal from that decision was pending, a petition for prolongation was brought, the committee decided to hear the petition on the ground that it was not their duty to look into the validity of the patent, and the decision of the Court was one which might not be upheld and therefore in no way binding (k).

Sect. 25 of the Patent Law Amendment Act, 1852, provided that letters patent obtained in the United Kingdom for patented foreign inventions should not continue in force after the expiration of the foreign patent, and that any prolongation of letters patent should be made subject to that condition, consequently an inquiry into foreign patents and their duration was always an essential element of the proceedings before the Privy Council (l). The lapse of a foreign patent the date of which was subsequent to the date of protection obtained in England for the same invention did not affect the English patent, and was no objection to its prolongation (m).

This Act however is specifically repealed, and by sect. 45, subsects. 2 and 3 of the Act of 1883, it is provided:—

"Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licenses. In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed."

(k) 9 P. O. R. 411; see also *In re Kay's Patent*, 1 Web. P. C. 568; 3 Moo. P. C. C. 24.

(l) *In re Bodmer's Patent*, 8 Moo. P. C. C. 282; *In re Newton's Patent*, 15 Moo. P. C. C. 176; *In re Betts' Patent*, 1 Moo. P. C., N. S. 49; *In re Johnson's Patent*, 8 Moo. P. C., N. S. 282.

(m) *In re Betts' Patent*, 1 Moo. P. C., N. S. 49; *In re Poole's Patent*, 4 Moo. P. C., N. S. 452; *In re Adair's Patent*, L. R., 6 App. Cas. 176; 50 L. J., P. C. 68; but see *In re Blake's Patent*, L. R., 4 P. C. 535; 9 Moo. P. C., N. S. 373.

Thus it will be seen that after the commencement of the Act any prolongation of letters patent will be made regardless of foreign patents or their duration, saving with regard to the profits thereof as has been noticed above (n).

The Act of 1883 gives a patentee the right to petition, and, bearing in mind that the definition of the word patentee is by sect. 46, "Any person for the time being entitled to the benefit of a patent," it will be observed that the greatest latitude is given as to persons who may petition.

Prior to the Act of 1883 it had been held, in a series of cases, that executors and administrators of a grantee of letters patent might petition for an extension (o). So might the assignee of a patent, even though a public company (p). So might the executor of an assignee (q), so also any person having merely an equitable interest in the patent (r), an unpaid mortgagee should be joined as a party (s).

In *Herbert's Patent* (t) the petition was presented by the patentee and the assignees of a part share conjointly, while the petition was pending the patentee died, the committee permitted the hearing to proceed without adding a representation of the deceased patentee as a party, and granted an extension subject to a condition that the assignees should hold a moiety on behalf of the representative of the patentee.

In *Re Norton's Patent* (u), Sir John Romilly, then Master of the Rolls, said, "Under the late statute, 7 & 8 Vict. c. 69, s. 4, a person is not excluded from applying for an extension of a patent upon the ground of his being the assignee of the patent; but it must always be borne in mind that the assignee of a patent does not, unless under peculiar circumstances, apply on the same favourable footing that the original inventor does. The ground that the merits of the inventor ought to be properly rewarded, in

(n) But note *In re Jablockhoff's Patent*, 8 P. O. R. 281; *In re Livet's Patent*, 9 P. O. R. 327, 332; *Re Semet's Patent*, 12 P. O. R. 10.

(o) *In re Heath's Patent*, 8 Moo. P. C. C. 217.

(p) *In re Norton's Patent*, 1 Moo. P. C., N. S. 339.

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

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

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

(t) L. R., 1 P. C. 399; 4 Moo. P. C., N. S., 300.

(u) 1 Moo. P. C., N. S. 339.

dealing with an invention which has proved useful and beneficial to the public, does not exist in the case of an assignee, unless the assignee be a person who has assisted the patentee with funds to enable him to perfect and bring out his invention, and has thus enabled him to bring it into use."

And in *Re Pitman's Patent* (x) Sir J. W. Colvile said: "There are no doubt cases in which their lordships have granted applications by the assignees of the patentee for extension of the term, and have also considered, in some respects, the expenses incurred by the assignee in bringing the patent into notice, and for the merit as it may be said of the assignee in patronizing the patentee, and in pushing the patent into notice; but the general rule which their lordships entertain in applications on the part of assignees is, as was stated by Lord Brougham in *Re Morgan's Patent* (y), that by so doing 'they are, though not directly yet mediately and consequentially, as it were, giving a benefit to the inventor, because, if the assignee is not remunerated at all, it might be said that the chance of the patentee of making an advantageous conveyance to the assignee would be materially diminished, and consequently his interest damaged. For this reason consideration has been given to the claims of the assignee who has an interest in the patent.' "

It is difficult to estimate the effect of sect. 36 of the Act of 1883 upon this branch of the subject. Sect. 36 provides that: "*A patentee may assign his patent for any place in or part of the United Kingdom or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.*"

Will the Privy Council, on the application of an assignee for a portion of the kingdom, extend the patent for that portion, or must all parties to the patent join in the petition?

It is evident that whilst one district assignee of an electric light patent, for example, may have been amply remunerated, another may not have been remunerated at all, owing to the action of local authorities or other matters entirely beyond the assignee's control. How could the committee in justice refuse the latter an extension? On the other hand, how could they grant it to the other?

(x) 3 Moo. P. C., N. S. 293.

(y) 1 Web. P. C. 737.

Then again, if a patent may be extended for one district and not for another, we shall have the enormous practical difficulties and public inconveniences of an article being patented in one county and free in another, a state of affairs which, we venture to say, would be intolerable to the public.

The advertisement of the intention of the patentee to present a petition must be made in the manner prescribed by sect. 4 of 5 & 6 Will. IV. c. 83, that is to say, the petitioner must advertise in the *London Gazette* three times, and in three London papers, and three times in some country paper published in the town where or near to which he carries on any manufacture of anything made according to his specification, or near to or in which he resides, in case he carries on no such manufacture, or published in the county where he carries on such manufacture, or where he lives, in case there shall not be any paper published in such town (z).

Where the petitioner resided in France but had granted licenses to persons resident and carrying on business in London and Liverpool, advertisements inserted in the *Gazette* and newspapers published in those places were held to be sufficient (a).

The names of all the parties who join in presenting the petition must be inserted in the advertisements (b).

The advertisements must notify the day on which the petitioner intends to apply for a time to be fixed for hearing the matter of his petition, which day must be not less than four weeks from the date of the last of the advertisements inserted in the *London Gazette* (c), and the petition must be presented within one week from the insertion of such last advertisement (d), and must be accompanied by affidavits of advertisements having been inserted in accordance with the above provisions (e).

The petition must contain full disclosure, as "a petitioner seeking the grace and favour of the Crown is bound to strict

(z) For form of advertisement, see Appendix D.

(a) *Derosne's Patent*, 4 Moo. P. C. C. 416; 2 Web. P. C. 1.

(b) *Noble's Patent*, 7 Moo. P. C. C. 191.

(c) Priv. Coun. Rules, r. 2.

(d) Ibid. r. 3; see *In re Hutchinson's Patent*, 14 Moo. P. C. C. 364; for form of petition, see Appendix D.

(e) Ibid. r. 4.

truth, and to the utmost candour and frankness, to *uberrima fides*, in his statement" (*f*).

Two or more patents if of a similar nature may be the subject of one petition (*g*).

Any person may enter a caveat against the extension, and may be heard at the bar in support of their opposition (*h*); and where unreasonable opposition is offered, they will be ordered to pay the petitioner's costs (*i*). But where the opposition is well founded and successful, costs will be allowed to the opposing party (*k*). If the petition be abandoned, costs will be given to opposers, and they need not give the petitioner notice of their intended application for the same (*l*). Where the petitioner had fairly and honestly stated his case, both the things against and the things for him in his petition, and the inquiry had been prolonged by the opposition, the costs of the opposition refused, although the petition had been dismissed on the ground of sufficient remuneration (*m*).

Where two or more parties have opposed the petition separately and successfully, the committee will sometimes order a fixed sum to be paid by the petitioner to the opponents, to be apportioned between them in lieu of saddling him with several separate sets of taxed costs (*n*). We thus see that, whilst on the one hand an unwarranted application for an extension may be very costly, unreasonable opposition may be equally so, although costs are given upon the principle that persons should not be discouraged from coming forward to protect the interests of the public (*o*).

(*f*) Per James, L.J., *In re Clark's Patent*, L. R., 3 P. C. 421, 426.

(*g*) *In re Clark's Patent*, L. R., 3 P. C. 421; *In re Johnson's & Atkinson's Patent*, L. R., 5 P. C. 87; *In re Church's Patent*, 3 P. O. R. 95.

(*h*) *In re Lowe's Patent*, 8 Moo. P. C. C. 1; *In re Schlumberger's Patent*, 2 Eq. R. 1.

(*i*) *In re Downton's Patent*, 1 Web. P. C. 565; *In re Honiball's Patent*, 9 Moo. P. C. C. 394.

(*k*) *In re Westrupp & Gibbins'*

Patent, 1 Web. P. C. 554.

(*l*) *In re Bridson's Patent*, 7 Moo. P. C. C. 499. See, however, *In re Milner's Patent*, 9 Moo. P. C. C. 39.

(*m*) *In re Muntz's Patent*, 2 Web. P. C. 122.

(*n*) *In re Jones' Patent*, 9 Moo. P. C. C. 41; also *In re Hill's Patent*, 1 Moo. P. C., N. S. 258; *In re Wield's Patent*, 8 Moo. P. C., N. S. 300; *Newton's Patent*, L. R., 9 App. Cas. 592.

(*o*) *Westrupp & Gibbins' Patent*, 1

The Attorney-General always appears in the interest of the Crown (*p*).

The advertisements should be proved before the case is heard (*q*); if the advertisements have not been made in the prescribed manner, no extension will be granted. "If the statute requires anything to be done which is not done, the Crown has no power to grant a prolongation" (*r*).

The Attorney-General can at the hearing adduce prior specifications for the purpose of showing want of novelty in the invention of the petitioner, without having previously given notice of his intention to do so (*s*), and it would seem that it is open for any opponent to do the same, since it is the duty of the petitioner to call attention to every fact whether in favour of or against his petition, and therefore he cannot complain of the introduction at the hearing of any objection to the extension of his patent which he ought to have drawn attention to himself (*t*).

The practice on petition for prolongation is governed by the Privy Council Rules which were made to regulate the procedure under 5 & 6 Will. IV. c. 83, and are set out at length in the Appendix (*u*).

An extension of a patent having once been granted, the Privy Council have no jurisdiction to entertain a petition for a further prolongation, their power being exhausted; and this objection may be taken by an opposing party, even though omitted from the objections filed by them (*x*).

When an order has been made by the Privy Council for an extension of the term of a patent, the person in whose favour such order has been made must leave a copy at the Patent Office, and the order shall thereupon be entered upon the register of patents (*y*).

Web. P. C. 554; *In re Jones' Patent*, 9 Moo. P. C. C. 41; *In re Wield's Patent*, 8 Moo. P. C., N. S. 300; L. R., 4 P. C. 39.

(*p*) *In re Erard's Patent*, 1 Web. P. C. 557; *In re Smith's Patent*, 7 Moo. P. C. C. 133.

(*q*) *In re Perkins' Patent*, 2 Web. P. C. 8.

(*r*) Per Lord Brougham in *Noble's*

Patent, 7 Moo. P. C. C. at p. 194.

(*s*) *In re Ball's Patent*, L. R., 4 App. Cas. 171; *In re Stewart's Patent*, 3 P. O. R. 7; *In re Livel's Patent*, 9 P. O. R. 327.

(*t*) *Ibid*.

(*u*) See p. 457, post.

(*x*) *In re Goucher's Patent*, 2 Moo. P. C., N. S., 532.

(*y*) P. R. 1890, r. 74.

CHAPTER XV.

CONFIRMATION.

THE statute 5 & 6 Will. IV. c. 83, provided a remedy for cases of hardship, such as, where an invention had been invented or used and subsequently abandoned before the date of the patent in a manner unknown to the patentee at the time of his application. There would be a sufficient prior user to invalidate the patent, and yet there would be great merit probably in the patentee, and a great benefit to the public. The patentee might petition the Privy Council to confirm the patent, that is, to declare it valid, notwithstanding such prior user. The proceedings on such a petition were similar to those upon a petition for extension.

The Act of 1883 repeals the statute 5 & 6 Will. IV. c. 83, and with it all proceedings for confirmation; and this method of clothing an invalid patent with validity is abolished. In *Re Jablochkoff's Patent* the Privy Council seemed to be of opinion that the right to confirmation was retained in the case of patents granted prior to the date of the Act of 1883, by virtue of sect. 113 (a).

It is not strictly the purpose of a law work to criticise the enactments of the legislature, saving in their construction and application from an administrative point of view, otherwise a great deal might be said as to the advisability of abolishing that which was intended for and operated merely as a relief under very hard and exceptional circumstances.

(a) 8 P. O. R. 281, 284; see also remarks of Bowen, L.J., in *Singer v. Stassen*, 1 P. O. R. at p. 125.

CHAPTER XVI.

REMEDIES OF THE PATENTEE AND OF THE PUBLIC—ACTION FOR INFRINGEMENT.

AN action for infringement is the remedy which the patentee has, and the means which is given to him for enforcing his patent privileges.

The courts are bound to take notice of the patent, and are bound to give legal effect to it, provided it cannot be shown to have been granted contrary to law.

PARTIES TO THE ACTION.

The Act of 1883 gives no directions as to what persons may be plaintiffs or defendants in an action for infringement, and therefore leaves the question of the parties to the action as it was before the passing of the Act.

The original grantee, it is obvious, so long as he has not parted with the whole of his interest in the patent, may be a plaintiff. And so may the assignee of a patent (*a*), even though he has acquired the right by assignment of two separate moieties, and the party sued is the original grantee (*b*).

The assignee of a portion of a patent may sue for an infringement of that part. Erle, C.J., in giving judgment in *Dunnicliff v. Mallett* (*c*), said: "The question is whether an assignment of part of a patent is valid. I incline to think that it is. It is every day's practice for the sake of economy to include in one patent several things which are in their nature perfectly distinct and severable. . . . Being therefore inclined to think that

(*a*) *Electric Telegraph Co. v. Brett*, N. S. 162 ; 29 L. J., C. P. 275.
10 C. B. 838 ; 20 L. J., C. P. 123. (c) 7 C. B., N. S. 209 ; 29 L.
(*b*) *Walton v. Lavater*, 8 C. B., C. P. 70, 73.

a patent severable in its nature may be severed by the assignment of a part, I see no reason for holding that the assignee of a separate part which is the subject of infringement may not maintain an action." The plaintiff in such an action would not be allowed to sever his part from the rest of the patent, and he would be liable to be defeated if it could be shown that the patent in any of its parts was void. But, on the other hand, he would have to show that his part alone would have been sufficient to support a patent, *i.e.*, that it contains a new and useful invention. Sect. 33, however, of the Act of 1883, provides, "*Every patent . . . shall be granted for one invention only, but may contain more than one claim; but it shall not be competent for any person in an action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention.*"

By sect. 36, "*A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place or part only.*" The assignee for a district will be in a position to bring an action for infringement, but it is obvious that the infringement must be within his district, otherwise he will be unable to prove damage.

One of several joint owners of a patent may bring an action in his own name to restrain infringement, or for damages, without joining his other co-owners (*d*), and he may sue alone for an account of profits, and for payment to the plaintiff of such part of such profits as the plaintiff should be entitled to.

Abinger, C.B., in *Derosne v. Fairie* (*e*), said that "a mere licensee could maintain no action against anyone else for the infringement of a patent." He might, however, use the name of the grantor of the license for the purpose provided he were an exclusive licensee (*f*).

A mere licensee would have no exclusive right to use the invention; he is only a person who is permitted to use it. The grantor of such a license might grant a dozen other such licenses

(*d*) *Sheehan v. Great Eastern Railway Co.*, L. R., 16 Ch. D. 59; *Dent v. Turpin*, 2 J. & H. 139; see ante, Chap. XII.

(*e*) 1 Web. P. C. 154; see also *Heap v. Hartley*, 6 P. O. R. 495.

(*f*) *Renard v. Levinstein*, 2 Hem. & M. 628.

without prejudicing the rights of the licensee; but an exclusive licensee has a right of property in the monopoly, and stands very much in the same position as an assignee for a district. The term exclusive, as applied to a licensee, meaning exclusive within an area.

When the exclusive licensee finds it necessary to protect his rights by bringing an action in the name of the licensor he is liable to give the licensor security for the costs (*g*) which, in the event of defeat, the licensor would have to pay. The right, however, to assign for particular districts will make this branch of the subject unimportant, since exclusive licenses were only a scheme for the purpose of, in effect, assigning for districts.

The assignees or trustees in bankruptcy of a patentee may maintain action for infringement in their own name (*h*), and so may the executors or administrators of a patentee.

A mortgagee of a patent is not a necessary party in an action for infringement of that patent (*i*), although, as we have seen, he should be joined on a petition for prolongation (*k*).

A mere agent to introduce, sell, and grant licenses for the use of a foreign patent in this country is not entitled to take proceedings to restrain infringement (*l*).

As defendants, a person physically using a patented invention is liable, such as a contractor (*m*). When a person in the position of a servant uses a patented invention, the master, in law, is the person who physically uses the invention as well as the servant, and the master may be sued. If a servant uses an invention in the course of his employment the master is liable, even though the master has told the servant to avoid infringing the patent (*n*). The directors of a company whose servants infringe an invention are personally liable (*o*).

(*g*) *Evans v. Rees*, 2 Q. B. 334; 224.
Spicer v. Todd, 1 D. P. R. 306.

(*h*) *Bloxam v. Elsee*, 6 B. & C. 169.

(*i*) *Van Gelder v. Sowerby Bridge Flour Co.*, 7 P. O. R. 208.

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

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

(*m*) *Denley v. Blore*, 38 Lond Jour.

(*n*) *Betts v. De Vitre*, L. R., 3 Ch. 429; *Sykes v. Howarth*, L. R., 12 Ch. D. 826; *Whatman v. Pearson*, L. R., 3 C. P. 422.

(*o*) *Betts v. De Vitre*, L. R., 3 Ch. 429, 441; *Spencer v. Ancouts Rubber Co.*, 6 P. O. R. 100.

An architect specifying the use of a patented invention is not liable (p).

Aliens infringing a patent in this country by vending or otherwise are liable if they come within the jurisdiction of the courts (q). A person ordering goods to be made in England which are an infringement of a patent, although intended for exportation to him abroad, infringes the patent. "He that causes or procures to be made may be well said to have made himself." Per Tindal, C.J. (r).

A company, to whom the business of the defendants was assigned while an action for infringement of a patent was pending against them, cannot be joined as co-defendants in that action (s).

But where an indemnity was given by a third party to the defendants after the commencement of the action, it was held that the person giving such an indemnity should be joined as a party under R.S.C. Order XVI. r. 48 (t), but such third party will only be bound by the decision of the Court so far as such decision falls within the terms of the order by which he was directed to appear (u).

An action is properly brought by the patentee against a company who are innocent carriers of infringing articles, to restrain them from dealing with or handing over such articles to other persons, and on the discovery of the name of the consignee, such consignee should be joined as a co-defendant in the action (x).

The manufacturer and patentee of a machine, the use of which is claimed to be an infringement of another patent, cannot compel the plaintiff to join him as a co-defendant with the person by whom the machine was used and against whom the action for infringement was brought (y).

(p) *Denley v. Blore*, 38 Lond. Jour. 224.

(q) *Caldwell v. Vanvlissengen*, 9 Hare, 415.

(r) *Gibson v. Brand*, 11 L. J., C. P. 177, 183.

(s) *Briggs v. Lardeur*, 2 P. O. R. 13.

(t) *Edison v. Holland*, 3 P. O. R. 395.

(u) *Edison v. Holland*, 6 P. O. R. 243, 286.

(x) *Washburn and Moen Manufacturing Co. v. Cunard Steamship Co.*, 6 P. O. R. 398, 403.

(y) *Moser v. Marsden*, 9 P. O. R. 214.

CHAPTER XVII.

THE CAUSE OF ACTION—INFRINGEMENT.

THE infringement of a patent is the doing that which the patent prohibits from being done (*a*). The words of the Royal Command are as follows: "We do by these presents for us, our heirs and successors, strictly command all our subjects whatsoever within our United Kingdom of Great Britain and Ireland and the Isle of Man, that they do not at any time during the continuance of the said term of fourteen years, either directly or indirectly make use of or put in practice the said invention, or any part of the same, nor in anywise imitate the same, nor make or cause to be made any addition thereto or subtraction therefrom, whereby to pretend themselves the inventors thereof, without the consent, license or agreement of the said patentee in writing under his hand and seal, on pain, &c."

There is no duty cast upon a patentee to inform persons that what they are doing amounts to an infringement of his patent, and he is not estopped by omitting to give such information, although he knew of the infringement, from subsequently bringing his action (*b*).

The question of infringement or no infringement is one of fact, and therefore is for the jury (*c*). But this refers to the mere infringement alone within the meaning of Tindal, C.J., in *Muntz v. Foster* (*d*), when he told the jury that "for the purpose of inquiring whether the defendants have infringed the patent or not, we are to assume that it is a good patent, that no objection

(*a*) *Walton v. Bateman*, 1 Web. P. C. 613.

(*b*) *Proctor v. Bennis*, L. R., 36 Ch. D. 740.

(*c*) *Walton v. Potter*, 1 Web. P. C. 585; *De la Rue v. Dickenson*, 7 E. & B. 738.

(*d*) 2 Web. P. C. 99.

arises either to the nature of the grant or the specification which has been enrolled by the plaintiff."

If the patent is invalid there can be no infringement in the sense that a patent which has no legal existence cannot be infringed. But assuming that it has a legal existence, the question is for the jury. This explains the apparently contradictory decision in *Curtis v. Platt* (e), in the House of Lords. The question of infringement was there taken as involving the validity of the patent.

It is equally an infringement whether the defendant acted in ignorance of the plaintiff's patent or not. In *Heath v. Unwin* (f), Parke, B., delivering the judgment of the Court, said:—"There was therefore no intention to imitate the patentee's invention, and we do not think the defendant can be considered to be guilty of any indirect infringement if he did not intend to imitate at all." This judgment certainly gives an erroneous impression of the law, and Shadwell, V.-C., when the same case came before him (g), said:—"The party complaining of the act is not the less prejudiced by it because it was committed unintentionally; and my opinion is that, if a party has done an act that is injurious to the rights of another (though without any intention of doing him injury) he is answerable for the consequences. In *Stevens v. Keating* (h) the Lord Chancellor disapproved of the case in the Court of Exchequer; and I must decline to act upon the principle which it lays down."

Subsequently, when *Heath v. Unwin* came before the House of Lords, the opinion of the judges being taken, Parke, B. (i), acknowledged the error into which the Court had fallen, and approved of *Stevens v. Keating*.

In *Stead v. Anderson* (k), Wilde, C. J., tersely puts it:—"The question of infringement depends not on what the defendant intends, but on what he does."

So it is immaterial whether the defendant was aware that the thing was patented or not, since in law every person in the realm

(e) L. R., 1 H. L. 337; 35 L. J., Ch. 852.

(f) 14 L. J., Ex. at p. 156.

(g) 15 Sim. 553.

(h) 2 Web. P. C. 176.

(i) 25 L. J., C. P. at p. 19; 5 H. L. Cas. 505.

(k) 2 Web. P. C. 156.

is taken to have notice of a patent in the same way that he is taken to be aware of the law (*l*).

And the converse is also sound—if a person intending to infringe a patent does not in fact do so, he will not be taken to have infringed (*m*).

In *M'Cormick v. Gray* (*n*) the specification, after describing several parts of reaping machines, including some cutting blades of peculiar construction, claimed: "The construction of reaping machines according to the improvements before described—that is to say, the constructing and placing of holding fingers, cutting blades, and gathering reels, respectively, as before described, and the embodiment of those parts as so constructed and placed, all or any of them in machines for reaping purposes, whether such machines are constructed in other respects as before described, or however else the same may in other respects be constructed."

The defendant made and sold cutting blades similar to those described by the plaintiff's patent, which were *capable of being used* in the plaintiff's reaping machine. Bramwell, B., in giving judgment, said:—"A man could not make the blade of a knife without infringing this person's patent, because you may intend to put it into a machine, or you may not. I think it is a very clear case, and I am satisfied there is no difference between making a thing with one intent and making it with another, because I always understood that if a man may do a thing, he may do it with whatever intent he pleases." It will be observed, that in this case, to make the knives was no infringement, and there was no evidence of the defendant having applied them to reaping machines (*o*).

Thus we see that infringement, as taken apart from the question of validity, is a matter of fact, and that intention is not material to the conclusion (*p*).

To prove infringement, it must be shown that there is a

(*l*) *Walton v. Lavater*, 29 L. J., C. P. 275; *Curtis v. Platt*, 11 L. T., N. S. 245.

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

(*n*) 31 L. J., Ex. 42.

(*o*) See, however, *Bancroft v. Warden*, Romilly's Notes of Cases, 103.

(*p*) See also *Young v. Rosenthal*, 1 P. O. R. 29, 39.

substantial resemblance (*q*). The infringement must be of a part for which the patent was granted, and not merely of a part described in the specification (*r*).

The question as to what will or what will not amount to infringement, like many other points which arise in the law of letters patent, must depend upon the facts of each particular case, and the decision in one case cannot possibly bind the decision in another; consequently the consideration of decided cases is only useful as showing the principles which underlie the judgments in those cases.

In *Nobel's Explosives Co. v. Anderson*, Romer, J., said (*s*): "Several cases were cited to show the canons of construction on which the Courts have acted in different cases relating to infringements. But it is not necessary for me to deal with these cases in detail, for I desire emphatically to state that, in my view, one principle only governs all the cases, whether they relate to so-called 'master' patents, or patents dealing with discoveries in matter of principle, or to any other kind of patent; and that principle is this: In order to make out infringement, it must be established, to the satisfaction of the Court, that the alleged infringer, dealing with what he is doing as a matter of substance, is taking the invention claimed by the patent; not the invention which the patentee might have claimed if he had been well advised or bolder, but that which he has in fact and substance claimed on a fair construction of the specification."

In the same case, in the Court of Appeal, Kay, L.J., in his judgment, said (*t*): "I think the law now is reasonably well settled. There are two classes of cases; one where a patentee has invented a new method of producing a known result, the other where he has invented a new result, and has described one method of producing it. According to the *dictum* of Baron Alderson in *Jupe v. Pratt* (*u*), which, as has been pointed out in subsequent cases, was a *dictum* during the argument addressed to some argument of counsel which he was then considering, if a

(*q*) *Stead v. Anderson*, 2 Web. P. C. 151.

(*r*) *Croll v. Edge*, 19 L. J., C. P. at p. 261.

(*s*) 11 P. O. R. 115, 127.

(*t*) 11 P. O. R. 519, 527.

(*u*) 1 Web. P. C. 145.

patentee has invented a new result, and has described one method of obtaining that result, he may prevent anybody else from obtaining the same result by any other method. In my opinion that went much too far, and I need not refer to any authority which more clearly shows that than the subsequent judgment of Baron Alderson in *Neilson v. Harford* (x), where he pointed out that if that were the law the result of such a patent would be a patent of the principle itself, because when you had discovered a new result, if, by showing one method of producing that result, your patent covers every other method of producing that result, in point of fact you patent the principle which leads to that result; and that is perfectly good criticism upon the earlier *dictum* of Baron Alderson, which I cannot help thinking was only put *arguendo*, and is the proper limitation of the generality of that first *dictum*. Mr. Justice Pearson, in the *Badische Anilin* case (y), seems to have adopted the earlier *dictum* of Baron Alderson, without observing the limit put upon it by his subsequent judgment, and respectfully I differ from the statements of the law as stated by Mr. Justice Pearson in that case. The true result, I think, is stated very well by the late Lord Justice Cotton in the case of the *Automatic Weighing Machine Co. v. Knight* (z). He observes the *dictum* in *Jupe v. Pratt*, and he says:—‘Those were the expressions used by Baron Alderson during the discussion, probably to meet something that was said by counsel, and did not express his full opinion. You can prevent anyone from using the same method of carrying that principle into effect, and you can prevent anyone from using only the same thing, with a colourable difference. That is what we had to consider in *Proctor v. Bennis* (a). 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, and say they do it by a different mode, and looks to see whether, in effect, although the mode is not exactly the same, it is only a colourable difference, a mechanical equivalent for a substantial part of the patentee’s invention being looked upon as

(x) 1 Web. P. C. 295, 355; 8 M. & W. 806, 820.

(y) 2 P. O. R. 91.

(z) 6 P. O. R. 297, 304.

(a) 4 P. O. R. 333.

a mere colourable difference, and, therefore, he being entitled to an injunction against that mode of carrying out his principle, which is only the same in substance as that which he patented, though there are colourable differences.' I take the law as to be clearly settled thus, that if the result of the patent is entirely new, and one method of arriving at that result is described on the face of the patent, the patentee cannot say 'that enables me to treat every other method of arriving at that result as an infringement,' but the question is in every case whether the method which he says is an infringement is so like to the method which he has himself described as to be substantially the same, or, in other words, only colourably different."

In *Curtis v. Platt (b)*, Wood, V.-C., said :—" Where the thing is wholly novel and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machine for effecting the same object, to see whether or not they are merely colourable contrivances for evading that which has been before done. When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before has a right to extend very largely the interpretation of those means which he has adopted for carrying it into effect. Because otherwise that would be to say that the whole world is to be precluded from achieving some desirable and well-known object which everybody has had in view for years. In such a case it may be said that the means taken are simply mechanical equivalents for the means previously adopted for arriving at the same object."

The result of the decided cases clearly shows that a man will be held to have infringed if he has taken the pith and essence of the invention (*c*), and that when the invention is merely for an improved mode of attaining an old object the pith of his invention

(b) L. R., 3 Ch. D. 136, n. v. *Champion Gas Co.*, 9 P. O. R. 55,
 (c) *Clarke v. Adie*, L. R., 2 App. 56; *Benno Juffé v. Richardson*, 11
 Cas. 315, 320; *Proctor v. Bennis*, 4 P. O. R. 112.
 P. O. R. 333, 345; *Wenham Gas Co.*

is that particular improved method, and only by making use of that particular method will a man be held to have infringed (*d*), but when the invention is for a new method of attaining a new result, the novelty of the result itself is part of the merit of the invention and of the consideration given by the patentee in return for the grant (*e*); and, consequently, a man will be held to have infringed if he should have arrived at the same result by means of a process substantially the same as, or only colourably different from, that disclosed in the specification of the original invention (*f*).

If a man has taken the pith of an invention, the fact that he has improved upon it is immaterial (*g*).

The amount of prior user which will be sufficient to invalidate a patent differs considerably from the amount of user which will be held to infringe a patent:—"these are different questions, depending on wholly different considerations, the one upon the extent of previous knowledge, the other upon the effect of the grant" (*h*).

In *Barlow v. Baylis* (*i*) the patent was for "improvements in manufacturing metal nuts, and in machinery for stamping, forging, and rolling the same." Action for infringement; defence

(*d*) *Curtis v. Platt*, L. R., 2 Ch. D. 135, 136; *Nordenfelt v. Gardner*, 1 P. O. R. 61; *Proctor v. Bennis*, 4 P. O. R. 333; *Thomson v. Moore*, 6 P. O. R. 426; *Vorwerk v. Evans*, 7 P. O. R. 265; *Tweddale v. Ashworth*, 7 P. O. R. 426; 8 P. O. R. 49; 9 P. O. R. 121; *Miller v. The Clyde Bridge Steel Co.*, 8 P. O. R. 198; 9 P. O. R. 470; *Ashworth v. Roberts*, 9 P. O. R. 309; *Nettlefolds v. Reynolds*, 9 P. O. R. 270; *Preston Davies v. Black*, 11 P. O. R. 299, 574.

(*e*) *Proctor v. Bennis*, 4 P. O. R. 359.

(*f*) *Curtis v. Platt*, L. R., 3 Ch. D. 135, 136; *Proctor v. Bennis*, 4 P. O. R. 333; *Ehrlich v. Ihlee*, 5 P. O. R. 437, 453; *Thomson v. Moore*, 6 P. O. R. 426; 7 P. O. R. 325; *Automatic*

Weighing Machine Co. v. Knight, 6 P. O. R. 297, 304; *Automatic Weighing Machine Co. v. National Exhibitions Association*, 8 P. O. R. 345; 9 P. O. R. 41; *Tweddale v. Ashworth*, 9 P. O. R. 121, 126; *Young v. Hermand Oil Co.*, 9 P. O. R. 373; *Nobel's Explosives Co. v. Anderson*, 11 P. O. R. 519, 527; *Benno Jaffé v. Richardson*, 11 P. O. R. 93.

(*g*) *Ehrlich v. Ihlee*, 5 P. O. R. 454; *Thomson v. Moore*, 6 P. O. R. 426; *Wenham Gas Co. v. Champion Gas Co.*, 9 P. O. R. 49, 55.

(*h*) Per Turner, V.-C., in *Caldwell v. Vanvlissengen*, 9 Hare, 428; *Newton v. Grand Junction Railway Co.*, 5 Exch. 331.

(*i*) Griffin, P. C., at p. 44.

anticipated by Berry. It was contended by the plaintiff that Berry's machine would not work. Brett, J., in summing up to the jury, said :—“ Now, the first question about Berry's machine which I will ask you is this: Was Berry's ever a machine or invention in this sense, that a workman could, from his specification and drawings, make the machine described by him so that it would, more or less badly, do the work required of it? because in my opinion, if it would not, I do not say perfectly, but if it would not do the work required of it, it was not an invention at all, or a machine in a business sense. . . . I put the words ‘ more or less badly,’ because I do not think that if the only defect in the machine was some defect in the levers which any workman could find out at once, if it would make a nut, though badly, that would not prevent it from being a machine.”

The jury found that Berry's machine would not do the work more or less badly. Judgment for plaintiffs. Judgment upheld by the Court of Common Pleas.

In *Brereton v. Richardson* (*k*) infringement of a patent for “ a new and improved tricycle,” alleged prior user by Jackson and his family; reply, that this was merely an experimental user. Field, J., said :—“ Their driving to Cheam, Worcester Park, and Malden, going about on business night and day, and for pleasure; and the public notoriety which the thing had excited in the neighbourhood, so that it was called ‘ Jackson's patent threshing machine,’ all satisfy me that, provided I am right in holding that the thing was substantially the same, it was publicly used. A question of difficulty occurred to my mind as to what degree of public user is enough when you have to deal with a thing like that. I quite understand that if there were at this moment an axle running under an omnibus which I could not see, it might or might not be a public user. I think it would be a public user.” Action dismissed with costs.

We have seen that by sect. 33 of the Act of 1883, a patent may still contain more than one claim, and in such a case, provided every claim which is made is valid, a patent may be infringed by infringing any one claim. In *Gillett v. Wilby* (*l*)

(*k*) 1 P. O. R. 166.

(*l*) 9 C. & P. 336.

Coltman, J., said:—"If they are all new (the parts claimed), and the defendant has infringed any one of them, it will be sufficient to support the action, and it is not necessary that he should have infringed them all." In *Newton v. The Grand Junction Rail. Co.* (m), Pollock, C.B., said:—"But in considering the question of infringement, all that is to be looked at is, whether the defendant has pirated a part of that to which the patent applies; and if he has used that part for the purposes for which the patentee adapted his invention, and for which he has taken out his patent, and the jury are of opinion that the difference is merely colourable, it is an infringement;" and in *Sellers v. Dickenson* (n) the same Judge said:—"There may be an infringement by using so much of a combination as is material . . . if a portion of a patent for a new arrangement of machinery is in itself new and useful, and another person, for the purpose of producing the same effect, uses that portion of the arrangement, and substitutes for the other matters combined with it another mechanical equivalent, that would be an infringement of the patent."

"Where a patent is for a combination of two, three, or more old inventions, a user of any of them would not be an infringement of the patent; but where there is an invention consisting of several parts, the imitation or pirating of any part of the invention is an infringement of the patent" (o).

Speaking of this case in *Clark v. Adie* (p), James, L.J., said:—"Upon the authority of *Smith v. L. & N. W. Railway Co.*, it has been strongly contended before us that whenever there is a patent for a combination, that patent gives protection, not indeed to every distinct thing that enters into the combination, but to every combination, arrangement, and aggregate of two or more of those distinct things, even although such subordinate combination is not expressly or impliedly claimed in the specification. This, in our opinion, is so startling a violation of every principle of patent law, that we doubt whether we could follow any authority, short of the House of Lords, in applying such a doctrine. If a patent for a combination of several parts is in reality a patent, and gives

(m) 5 Exch. 331.

(n) 5 Exch. 324.

(o) Per Campbell, C.J., in *Smith v. London & North Western Railway Co.*,

2 E. & B. 76; *The Patent Bottle Co. v. Seymer*, 5 C. B. N. S. 172.

(p) L. R., 10 Ch. 674.

really a monopoly for every combination of any two or more of those parts, then it follows, from the very first principle of patent law, that if any conceivable combination of any two or more parts was old, the patent would be bad. On the other hand, if the patentees say, 'No, we do not claim to protect every combination of those parts, but only those subordinate combinations, or parts of the combination, which are new and useful,' then such a claim would be entirely inconsistent with the leading case of *Foxcell v. Bostock* (q), which, we may be permitted to say, is as good sense as it is sound and intelligible law . . . I will state what we conceive to be the real principle which underlies the case of *Lister v. Leather* (r), and which reconciles it with the other cases and with general principles, and common sense. A patent for a new combination or arrangement is to be entitled to the same protection, and on the same principles, as every other patent. In fact, every, or almost every patent, is a patent for a new combination. The patent is for the entire combination, but there is, or may be, an essence or substance of the invention underlying the mere accident of form, and that invention, like every other invention, may be pirated by a theft in a disguised or mutilated form, and it will be in every case a question of fact, whether the alleged piracy is the same in substance and effect, or is a substantially new or different combination."

In *Nordenfelt v. Gardner* (s), Brett, M.R., said:—"The machine which is challenged may have that combination actually without any variance at all. If so, it is obvious that the challenged machine is an infringement, or it may have that combination with some alteration. The alteration of a combination, as it seems to me, may be by addition, or subtraction, or substitution of parts. Any one of these alters the combination. If the alteration, whether it be by addition, or subtraction, or substitution, be merely colourable, then the two machines are substantially the same; although not mathematically exactly the same, they are substantially the same; and in any case, notwithstanding such colourable alteration, there may be an infringe-

(q) 12 W. R. 723; see also *Harrison v. Anderston Foundry Co.*, L. R., 1 App. Cas. 574.

(r) 8 E. & B. 1004.

(s) 1 P. O. R. 65.

ment (*t*). An *alteration by addition* may be an improvement, but then that will leave the whole of the original combination, and add something to it. If such an alteration of the combination be made, it seems to me that no good patent can be made with regard to the new machine except by claiming the invention as an improvement, and by showing distinctly what the addition is, so as to show what the improvement is. An *alteration by subtraction*, if it were more than a colourable subtraction, would, as it seems to me, alter the combination. It would not be a combination of the same things, it would be a combination of different things; and if the combination were altered by a material subtraction, I should think that it was a new combination. But an *alteration by substitution*, that is, by substitution of one of the material elements of the original combination, must to my mind be a new combination. The second combination, then, is a combination of different things from the first. There is a taking away of one of the elements, and a material element of the old combination, and a putting in of a new material element which is different from any of the elements of the former.”

Where, however, the application by the defendant of a portion of the invention of the plaintiff is for a different object, and with a view of carrying out a principle totally newly discovered by the defendant, and which was unknown to the plaintiff, there is no infringement, although at first sight there appears to be some similarity of process (*u*), but if a man, in the course of producing an improved combination, substantially uses a combination which already forms the subject of a patent, he thereby infringes the patent, notwithstanding that the combination he is making has a different end in view than that which has been patented (*x*).

But, on the other hand, where a patent is for a combination, a person who takes a new and material part of the combination, but not for a similar or analogous purpose to that to which it was applied in the patent, does not infringe the patent (*y*).

(*t*) See also *Murray v. Clayton*, L. R., 7 Ch. 570, 585; *Badische Anilin und Soda Fabrik v. Levinstein*, L. R., 24 Ch. D. 156, 175; 2 P. O. R. 93; *Kaye v. Chubb*, 5 P. O. R. 641; *Thomson v. Moore*, 6 P. O. R. 456.
 (*u*) *Newton v. Vaucher*, 6 Exch. 859; see also *Morewood v. Tupper*, 3 C. L. Rep. 718; *Preston Davies v. Black*, 11 P. O. R. 299, 574.
 (*x*) *Cannington v. Nuttall*, L. R., 5 H. L. 205, 230.
 (*y*) *Lister v. Eastwood*, 9 L. T. N. S. 766.

We have seen that sect. 5, sub-s. 5, provides that a complete specification must conclude with a distinct statement of the invention claimed; so that, if the invention be a combination, it must be so stated; if for parts, they must be claimed. There is no infringement if the defendant cannot be shown to have infringed, directly or indirectly, a part or parts of the claim (z). In *Lister v. Leather* (a) it was held that a valid patent for an entire combination, or for a process, gives protection to every part that is new and material, for the purpose of effecting that particular combination or process, without any express claim of particular parts, and notwithstanding that parts of the combination are old. In future, if any parts are desired to be protected, as well as the combination or process, the claim will have to be so drawn as to include those parts.

The jury will always have to consider whether the infringing machine, process, or combination is a substantial imitation (b). No fine lines can be drawn as to what amounts to substantial imitation. In *Clark v. Adie* (c), in the House of Lords, Lord Blackburn said:—"I incline to agree with what was said in the Exchequer Chamber in the case of *Lister v. Leather* (d), that you cannot decide in the abstract whether the using of two parts, A and B, of a combination of A, B, and C is or is not using part of that invention, nor can you decide in the abstract the other question, which was somewhat discussed in the case of the sewing machine (*Foxwell v. Bostock*) (e), whether or not the specification shows that A or B is sufficiently claimed as a part of the invention or not. I do not think that either of those questions can be decided in the abstract. I would wish, like the Exchequer Chamber in *Lister v. Leather*, before deciding it, to have before me the nature of the machine, in order that I may see what A, B, and C are, and what is their relation to each other."

In *Parkes v. Stevens* (f), James, V.-C., said:—"The authority of that case (*Lister v. Leather*) has been pressed upon me as if it really established this, which would be a most

(z) *Jackson v. Wolstenhulmes*, Griff. P. C. 134.

(a) 8 E. & B. 1004.

(b) *Thomas v. Foxwell*, 5 Jur., N. S.

(c) L. R., 2 App. Cas. 335.

(d) 8 E. & B. 1004.

(e) 12 W. R. 723.

(f) L. R., 8 Eq. 358, 366.

startling proposition, that a patent for a combination or arrangement would be a distinct patent for everything that was now and material and that went to make up the combination the judgment, if read well, will be found to give no warrant whatever for such, I must call it, baseless notion. The law is summed up thus. 'The cases establish that a valid patent for an entire combination for a process gives protection to each part thereof that is new and material *for that process*, which is really nothing more than stating in other words that you not only have no right to steal the whole, but you have no right to steal any part of a man's invention; and the question in every case is a question of fact—is it really and substantially a part of the invention?' (g). This judgment was affirmed on appeal (h).

If the invention be for a combination or process whereby an already well-known object is produced, it will be no infringement to make another combination, even of the same materials (provided they be also old and well-known), for the purpose of attaining the same object, for the patent is for the *means* of attaining the object, and if other means are employed there is no infringement. The patent is also for the *method* of combining the old and well-known materials, and if another method is adopted there is no infringement (i).

When the defendant has set himself to work to evade the plaintiff's patent by fraudulently making a colourable imitation, or substituting a mechanical or chemical equivalent, the cases show that the Courts will look strictly at what he has done, and will take care that he does not overstep the line which he is endeavouring to keep within.

The question of fraudulent evasion is, as we have shown, one of fact. "A slight departure from the specification, for the purpose of evasion only, would, of course, be a fraud upon the patent;

(g) See also *Wright v. Hitchcock*, L. R., 5 Ex. 37; *Automatic Weighing Machine Co. v. National Exhibitions Co.*, 8 P. O. R. 345, 350; 9 P. O. R. 41; *Miller v. Clyde Bridge Steel Co.*, 9 P. O. R. 470; *Peckover v. Rowland*, 10 P. O. R. 234; see also *White v.*

Fenn, 15 W. R. 348; *Garrard v. Edge*, 6 P. O. R. 563.

(h) L. R., 5 Ch. 36.

(i) *Curtis v. Platt*, in the House of Lords, 35 L. J., Ch. 852; L. R., 1 H. L. 387.

and therefore the question will be, whether the mode of working by the defendant has or has not been essentially or substantially different (*k*).

In *Dudgeon v. Thompson* (*l*) Lord Cairns makes strong objection to the use of the term **colourable imitation**, in connection with the infringement of patents, and proceeds:—"If there is a patented invention, and if you, the defendant, are found to have taken that invention, it will not save you from the punishment or from the restraint of the Court, that you have, at the same time that you have taken the invention, dressed it up colourably, added something to it; taken, it may be, something away from it, so that the whole of it may be said, as is said in this injunction, Here is a machine, which is either the plaintiff's machine, or differs from it only colourably. But underlying all that there must be a taking of the invention of the plaintiff. There used to be a theory in this country, that persons might infringe upon the equity of a statute, if it could not be shown that they had infringed the words of the statute; it was said that they had infringed the equity of the statute, and I know 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. My lords, 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. But I agree it will not be the less an infringement because it has been coloured or disguised by additions or subtractions, which additions or subtractions may exist, and yet the thing protected by the specification be taken notwithstanding."

Summing up the cases, therefore, we come to this. Strictly speaking, there is no such thing as a colourable imitation: either the defendant has infringed the thing specified or he has not. At the same time there is an essence or substance to every invention underlying the mere accident of form or words. If the defendant has imitated and adopted the essence of the invention, he will not

(*k*) Per Dallas, J., in *Hill v. Thompson*, 1 Web. P. C. 242.

(*l*) L. R., 3 App. Cas. at p. 44.

be allowed to escape because he has not adopted the form or words in which the essence of the invention is clothed (*m*).

There is a description of imitation which is produced by the substitution of chemical or mechanical equivalents. To the unscientific eye there is a total dissimilarity between the infringing machine or process and the original; but, none the less, it is a mere imitation—it is a robbery of the ideas and intentions of the first inventor, but a robbery conducted in a scientific manner.

We have seen that a patent cannot be granted for the discovery of a mere principle (*n*), but that, if the principle when discovered is at the same time applied, a valid grant may be made for the application of the principle. The essence of the patent is the fact of applying the newly-discovered principle to a particular end. Now, a mechanical or chemical equivalent is another method of producing the same result, a method which a skilled mechanic or chemist, having once seen the original invention, could at once suggest and apply without the necessity of any inventive power whatever. Equivalents may be substituted for parts as well as for the whole invention, so that it may happen that a patent is taken out which consists of three parts. An equivalent may be substituted for each part, so that in effect the whole invention may be changed and yet there may be a most flagrant infringement.

Take, for instance, the case of *Stevens v. Keating* (*o*). Here the patent was for the manufacture of cement. The cement was made from gypsum (sulphate of lime) by admixing it with pearl-ash (carbonate of potash) and sulphuric acid. Chemically, the

(*m*) *Thorn v. The Worthing Skating Rink Co.*, L. R., 6 Ch. D. 415; *Flower v. Lloyd*, W. N. 1877, p. 132; *Barrett v. Vernon*, 45 L. T., N. S. 755; *Bailey v. Robertson*, L. R., 3 App. Cas. 1055. And the older cases, *Bovill v. Moore*, Dav. P. C. 405; *Forsyth v. Riviere*, 1 Web. P. C. 97; *R. v. Lister*, Web. P. L. 80; *Minter v. Wells*, 1 Web. P. C. 130; *Morgan v. Seaward*, per Alderson, B., 1 Web. P. C. 171; *Walton v. Potter*, 1 Web. P. C. 586; *Neilson v. Harford*, 1 Web. P. C. 310; *Walton v. Baleman*, per Cresswell, J.,

1 Web. P. C. 816; *Muntz v. Foster*, per Tindal, C.J., 2 Web. P. C. 101; *Russell v. Ledsam*, 14 M. & W. 580; *Gamble v. Kurtz*, 3 C. B. 425; *Stead v. Anderson*, 2 Web. P. C. 156; *Unwin v. Heath*, 25 L. J., C. P. 8; *Curtis v. Platt*, 35 L. J., Ch. 852; *Murray v. Clayton*, L. R., 7 Ch. App. Cas. 585; also *Proctor v. Bennis*, L. R., 36 Ch. D. 740, 754; 4 P. O. R. 333, 352; *Thomson v. Moore*, 6 P. O. R. 426.

(*n*) *Ante*, p. 26.

(*o*) 2 Web. P. C. 181.

effect was this: Sulphate of potash was produced; this, combined with the sulphate of lime, produced a double salt, which, when submitted to a high temperature and subsequently ground to a fine powder, constituted the cement. The principle of this discovery was that sulphate of lime combined with salts of potash or soda, and when so combined, produced a substance which set very hard. The defendant substituted for the pearl ash and sulphuric acid a chemical equivalent, borate of soda (borax), and heated that with gypsum, producing in the same manner a double salt, and with the same resulting property of setting. This was properly held to be an infringement.

In *Russell v. Cowley (p)* the invention claimed was that of bringing to a welding heat a long piece of iron of the proper quality, after having turned up its edges, and drawing it through a hole of the size of the intended tube, so as to compress together the edges and give it a complete circular form. The defendants turned up the skelp, and, after heating it in the furnace, passed it through two rollers with grooves:—Held, that the two rollers with grooves were a mere mechanical equivalent for the hole through which the iron was passed under the patent (*q*).

But if such other substance or mechanical device have a different or better effect than that which is claimed in the specification, although to a certain extent it may be similar, and was not known to persons familiar with such things at the date of the patent as an equivalent, it will not be treated as an equivalent so as to come within the scope of the patent.

In *Nobel's Explosives Co. v. Anderson (r)*, the object of the invention was the production of an explosive suitable for propelling projectiles, in the use of which perfect combustion was obtained. The patentee in his specification confined his claim to

(*p*) 1 Web. P. C. 468.

(*q*) See also *Jupe v. Pratt*, 1 Web. P. C. 146; *The Electric Telegraph Co. v. Brett*, 10 C. B. 838; *Hancock v. Moulton*, Johnson's Patentees' Annual, 3rd ed. 208; *Bateman v. Gray*, Mac. P. C. 102; *Simpson v. Holliday*, 20 Newton's Lond. Journ. N. S. 111;

United Telephone Co. v. Harrison, L. R., 21 Ch. D. 720; *Winby v. Manchester Steam Tramways Co.*, 6 P. O. R. 859, 865; 8 P. O. R. 61, 68; *Murchland v. Nicholson*, 10 P. O. R. 417, 427.

(*r*) 11 P. O. R. 115, affirmed by House of Lords.

powder made from soluble nitro-cellulose and nitro-glycerine. It was not known at the date of the patent that insoluble nitro-cellulose could be used in the place of the soluble to effect the same object in a similar manner, and, in fact, anyone reading the specification of the patentee would be led to the conclusion that he was to avoid the use of insoluble nitro-cellulose. It was held by Romer, J., whose decision was confirmed in the Court of Appeal, that the use of the insoluble nitro-cellulose, although in a similar way and to effect a similar result to that attained by the soluble nitro-cellulose, did not amount to an infringement of the patent. In his judgment he said (s) :—“The soluble and insoluble are, in my opinion, distinct substances, having, as I pointed out above, distinct properties, and the insoluble cannot, for the purposes of the plaintiff's patent, be regarded as merely the chemical equivalent of the soluble. The plaintiff's patent and claim show that the patentee regarded the two as distinct for the purposes of his invention.”

“Equivalents which are not known at the time of the patent as equivalents and afterwards are found to answer the same purpose, are not included in the specification. They are new inventions.” Per Baron Parke (t).

Taking out a patent for a process or machine that infringes a prior patent does not in itself amount to infringement (u); infringement depends upon what the alleged infringer has done. There are three ways in which a patent may be infringed :—

1. By making the patented article or working the process.
2. By using.
3. By selling.

BY MAKING.

A person may infringe a patent by making the article himself, or by his agent, or by his servants. The agent and servants, it is true, will be considered as equally infringing the patent, and actions may be brought against them individually, but that in no way absolves the person who employs them for that purpose.

(s) At p. 127.

(u) *Tweedale v. Ashworth*, 7 P. O.

(t) *Unwin v. Heath*, 2 Web. P. C. R. 431.

In *Sykes v. Howarth* (x) a patent consisted of the application of cards or strips of leather covered with wire to rollers at "wide distances." A person who contracted to clothe rollers and supplied to a "nailer" cards of such width that when applied to the rollers they must of necessity leave wide spaces, and who himself paid the nailer, was held to have infringed the patent, though he alleged that his business was that of a card-maker only, and did not include the nailer's work. In giving judgment, Fry, J., said:—"I have come to the conclusion that the nailer must be deemed to have been the agent, for the purpose of nailing on, of the defendant . . . there is a contract to clothe in the manner prescribed by the particulars given to the defendant, and that contract was carried into effect by a person paid by the defendant—the defendant himself receiving the total amount for which he contracted. The consequence is that in my judgment all the defences fail."

We have seen that it is an infringement to colourably imitate an invention. It is no infringement to make, use, or vend the elements which afterwards enter into the combination. In *Townsend v. Haworth* (y), Jessel, M.R., said:—"The chief of these chemical substances are substances which are perfectly well known, and most of them are common substances; they are all old chemical compounds, and there is no claim in the patent at all except for the peculiar use of these chemical compounds for the purpose of preserving the cloth from mildew. No judge has ever said that the vendor of an ordinary ingredient does a wrong if the purchaser, coming to him, says, 'I want your compound because I want to preserve my cloth from mildew. I wish to try the question with the patentee.' No one would doubt that that sale would be perfectly legal. You cannot make out the proposition that any person selling any article, either organic or inorganic, either produced by nature or produced by art, which could in any way be used in the making of a patented article, can be sued as an infringer, because he knows that the purchaser intends to make use of it for that purpose."

(x) L. R., 12 Ch. D. 826.

(y) L. R., 12 Ch. D. 831, n.; see also *McCormick v. Gray*, 7 H. & N.

25; 31 L. J., Ex. 42; *Sykes v. Howarth*, L. R., 12 Ch. D. 826, 833.

But making and selling all the constituent parts of a machine, so that they could be easily put together, would probably amount to an infringement of a patent which had been granted for that machine (z).

In *Gibson v. Brand* (a) it was held that an order given by the defendant for the making of silk by a process which infringed the plaintiff's patent, which order was executed in England, was sufficient to satisfy the allegation that the defendant made, used, and put in practice the plaintiff's invention, though the silk was in fact made through the agency of others.

In *Higgs v. Godwin* (b) the plaintiff's patent was for the precipitation of animal and vegetable matter from sewage water by means of hydrate of lime, with the object of obtaining a product suitable for agricultural purposes. It was held that the use of the same process for the purpose of deodorizing and purifying sewage water and not for the purpose of commercial profit, did not amount to infringement of the plaintiff's patent.

In *Kelly v. Batchelar* (c) the plaintiff's patent was for a telescopic ladder, being two ladders joined together, the inner being raised or lowered by means of an endless cord. The plaintiff, for the purpose of adducing evidence of infringement, instructed an agent to order from the defendant an adjustable ladder with an endless cord. The defendant made a ladder to this order, but without a cord. The agent of the plaintiff said that it would not do, but must have a cord with pulleys, whereupon the defendant added the cord as instructed. In the action for infringement brought against the defendant, North, J., held that the defendant acted upon the express instructions of the plaintiff's agent, who had power and authority to give such instructions, and, consequently, that making this ladder did not amount to an infringement of the plaintiff's patent.

The working and making must be by way of using the invention, as distinguished from experimenting with it, so as to operate as an infringement. In *Jones v. Pearce* (d) Patteson, J.,

(z) *United Telephone Co. v. Dale*, 529; 5 Jur., N. S. 97.
L. R., 25 Ch. D. 778.

(a) 4 M. & G. 179.

(b) 27 L. J., Q. B. 421; E. B. & E.

(c) 10 P. O. R. 289; also *Henser v. Hardie*, 11 P. O. R. 421.

(d) 1 Web. P. C. 124.

said :—“ Now, if he did actually make these wheels, his making them would be a sufficient infringement of the patent, unless he merely made them for his own amusement or as a model. In *Ircarson v. Loe* (c), Jessel, M.R., adverting to this branch of the subject, said :—“ The other point raised was a curious one, and by no means free from difficulty, and what occurred with regard to that was this: that the defendant at various times made screw blanks, as he said, not in all more than 2 lbs., by various contrivances, by which no doubt screw blanks were made according to the plaintiff's patent of 1870, as well as that of 1875, they seem to have been an infringement of both. He said he did this merely by way of experiment, and no doubt if a man makes things merely by way of *bond fide* experiment, and not with the intention of selling and making use of the thing so made for the purpose of which a patent has been granted, but with the view of improving upon the invention, the subject of the patent, or with a view of seeing whether an improvement can be made or not, that is not an invasion of the exclusive rights granted by the patent. Patent rights were never granted to prevent persons of ingenuity exercising their talents in a fair way. But if there be neither using nor vending of the invention for profit, the mere making for the purpose of experiment and not for a fraudulent purpose ought not to be considered within the meaning of the prohibition, and if it were, it is certainly not the subject for an injunction.”

To purchase infringing articles for the purpose of instructing pupils and to enable them to pull them to pieces and put them together again, is not mere experimental user, and amounts to infringement (f).

It will be remembered that prior to the Act of 1883 letters patent did not operate as against the Crown; questions sometimes arose as to whether persons acting in the service of the Crown might manufacture a patented article or use a patented process.

When the persons using the invention were servants of the

(c) L. R., 9 Ch. D. 48; see also 109.
Muntz v. Foster, 2 Web. P. C. 101; (f) *United Telephone Co. v. Sharples*,
Proctor v. Bayley, 6 P. O. R. 106, L. R., 29 Ch. D. 164; 2 P. O. R. 28.

Crown, and acting in pursuance of their duty as servants, they were protected; but if they were contractors contracting with the Crown, they were not protected, but stood in exactly the same position as other subjects (g).

Sect. 27 of the Act of 1883 provides that a patent should bind the Crown, but that the Crown may use the invention "by agents or contractors" on terms to be before or after the use agreed upon.

BY USING.

It frequently occurs that very fine questions arise as to what constitutes using a patented invention. The general rule may be thus stated: That if the defendant has put the invention to the purpose for which it was intended he has used it in this country. In the case of *Neilson v. Betts* (h), in the House of Lords, the facts were as follows: Betts, the plaintiff in the suit, was the patentee of an invention for the manufacture of capsules for the purpose of covering bottles of liquid (wine, beer, or otherwise), and protecting them from the action of the atmosphere. Betts' patent did not extend to Scotland. Nielson and his co-appellants, defendants in the suit, were persons who bottled beer in Glasgow for the Indian market. They bottled the beer and covered it with capsules, which were made in Germany in pursuance of Betts' specification. The beer was shipped by the appellants in vessels which called at Liverpool to complete their cargoes; on some occasions the beer was transhipped in England, but no cases of beer were opened, nor was any of the beer sold in this country. Held, by the House of Lords, that, inasmuch as the object of Betts' invention was to make a capsule that would preserve the beer, whilst the beer was in England it was being preserved by the use of Betts' invention, and consequently that there was an infringement of the patent. Lord Chelmsford, in giving judgment in the Court below, said:—"It is the employment of the machine or article for the purpose for which it was

(g) *Dixon v. The London Small Arms Co.*, L. R., 10 Q. B. 130, and L. R., 1 App. Cas. 682, reversing decision of the Court of Appeal, L. R.,

1 Q. B. D. 384; also *Feather v. R.*, 6 B. & S. 257.

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

designed which constitutes its active use, and whether the capsules were intended for ornament, or for protection of the contents of the bottles upon which they were placed, the whole time they were in England they may be correctly said to be in active use for the very objects for which they were placed upon the bottles by the vendors. If the beer, after being purchased in Glasgow, had been sent to England, and had been afterwards sold here, there can be no doubt, I suppose, that this would have been an infringement, because it would have been a profitable user of the invention, and I cannot see how it can cease to be a user because England is not the final destination of the beer."

The case of *Nobel's Explosives Co. v. Jones, Scott & Co.* (i) is instructive upon the question of user. The subject of the plaintiff's patent, dynamite, is a mechanical compound of nitro-glycerine and infusorial earth. The compounding of nitro-glycerine in this manner is done for and effects the purpose of rendering it less liable to explosion from concussion. The object of the patent was, therefore, to enable nitro-glycerine to be kept and handled with safety. Held, by Bacon, V.-C., that the mere storage of dynamite made abroad, and only landed in this country for the purpose of transshipment, amounted to an infringement of the plaintiff's patent. This decision was reversed in the Court of Appeal, but upon another point, to be mentioned presently, and without in any manner impugning the correctness of the Vice-Chancellor's decision on this question.

In the case of *Caldwell v. Vanolissengen* (k), it was held by Turner, V.-C., that foreign ships coming into British ports, fitted with screw propellers, which were made in pursuance of the specification of an English patent, thereby infringed the patent. If the injunction which was granted be carefully read, it will be found to amount to a restraint from propelling the vessels with the propellers, not from having the ships merely fitted with them. Legally speaking, the user of propellers differs from that of capsules or dynamite in this important respect, that the one is in use only when in motion; the others are at use, the one when

(i) L. R., 17 Ch. D. 721; see also
The Universities of Oxford and Cam-

bridge v. Richardson, 6 Ves. 689.

(k) 21 L. J., Ch. 97.

merely affixed to the bottles, and the other when merely in possession. Subject to the applicability of the arguments adduced in the case of dynamite, it is submitted that mere possession, unaccompanied with user, does not constitute an infringement of letters patent, unless the possession is of such a character as to import a threat to use. But in *The United Telephone Co. v. The London Globe Telephone Co.* (1), Bacon, V.-C., said:—"That the defendants are in possession of instruments made in infringement of the plaintiff's patent is confessed by them and placed beyond the possibility of question, and that of itself gives to the plaintiffs a right to ask for an injunction to restrain the defendants from making use of that which by their own confession is an unlawful possession, and would be, if used, I presume, an unlawful use the defendants excuse themselves next on the ground that it is not their intention to use them. If it is not their intention to use the instruments then the injunction asked for can do them no harm. That would not be enough to dispose of the case, but it is the right of the plaintiffs to have an injunction against the defendants who have the means to the extent of 800 machines of injuring their patent rights."

In the case of *Adair v. Young* (m), certain pumps, which were an infringement of the plaintiff's patent, were fitted on board a British ship. There was no evidence of their having been used. Held, by the Court of Appeal, that there had been no infringement, but as there was evidence of an intention to use the pumps, an injunction would be granted against the use of the pumps.

But where the user complained of occurred six years before, and there was no ground for apprehending a repetition of the wrongful act, the Court of Appeal, reversing the decision of the Vice-Chancellor of the Palatine Court, held that it was not a proper case in which an injunction should be granted (n).

The use of an invention for a different purpose from that disclosed in the specification, will amount to an infringement of the

(1) L. R., 26 Ch. D. 766.

(n) *Proctor v. Bayley*, 6 P. O. R. 538.

(m) L. R., 12 Ch. D. 13.

patent which has been granted for that invention (*o*), but if the patent is for a new way of effecting an old object, and the patentee is in consequence strictly tied down to his particular method of performing it, in such a case the application of the invention to an entirely different object with slight variations will not amount to an infringement of the patent (*p*).

Sect. 43 of the Act of 1883 provides:—“(1) *A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of Her Majesty's Courts in the United Kingdom or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man.* (2) *But this section shall not extend to vessels of any foreign state of which the laws authorize subjects of such foreign state, having patents or like privileges, for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its Courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold or exported from the territories of such foreign state.*”

A patent is not infringed by being used on board an English vessel abroad (*q*).

In the case of *Nobel's Explosives Co. v. Jones & Scott* (*r*), mentioned above, the Court of Appeal reversed the decision of Vice-Chancellor Bacon, on the grounds that the defendants had not infringed the plaintiff's patent, they having merely acted as Custom House agents for the transshipment of the dynamite, and their functions being confined to obtaining papers necessary for such transshipment, and that they never had any ownership in or exercised any control over the dynamite.

This decision shows that the Courts will not recognize that a

(*o*) *Edison v. Holland*, 5 P. O. R. 459, 482; also *Cannington v. Nuttall*, L. R., 5 H. L. 205, 230.

(*p*) *Fletcher v. Glasgow Gas Commissioners*, 4 P. O. R. 386; *Preston Davies*

v. Black, 11 P. O. R. 299, 574.

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

(*r*) L. R., 17 Ch. D. 721. Affirmed by H. L., L. R., 8 App Cas 5.

person infringes a patent by aiding and abetting, so to speak, another to do so. There must be some actual infringement on the part of the defendant (s).

An action may properly be brought against innocent carriers of infringing articles for an injunction to restrain them from dealing with or disposing of such articles in any way (t).

SELLING.

A person infringes letters patent who sells the patented article within this realm. It is a putting in practice of the invention within the terms of the grant.

Lending is not selling (u).

The purchase of the patented article is not of itself an infringement of the patent, nor is the mere possession, since these do not come within the prohibition in the grant, which is against making use of, or putting in practice, the said invention (x).

This is always with exceptions such as in the case of dynamite, where the mere possession involves *ex necessitate* the use; and the importation of the patented article will not of itself amount to an infringement.

The possession of the patented article, combined with exposure for sale, if no sale is in fact effected, is no infringement (y).

But the making of the patented article, as we have seen, is an infringement, whether a sale was effected, or attempted or not (z).

Where the patent is for a process the manufacture of an article by the process abroad and sale in this country is an infringement. In *Elmslie v. Boursier* (a), Sir W. M. James, V.-O., said:—"It is said that tinfoil can be made by the plaintiff's process at less cost than by the old method; and it is conceded that nobody in England can use the plaintiff's process of making cast tinfoil as

(s) See also *Townsend v. Haworth*, L. R., 12 Ch. D. 831, n.; *Sykes v. Howarth*, L. R., 12 Ch. D. 826; *Tweeddale v. Ashworth*, 7 P. O. R. 426, 432.

(t) *Washburn & Moen Manufacturing Co. v. Cunard Steamship Co.*, 6 P. O. R. 398, 403; see also *Upmann v. Elkan*, L. R., 7 Ch. 130.

(u) *United Telephone Co. v. Henry*, 2 P. O. R. 11, Griff. P. C. 228.

(x) See *Minter v. Williams*, 1 Web. P. C. 135.

(y) *Ibid.*

(z) *Muntz v. Foster*, 2 Web. P. C. 101; *Oxley v. Holden*, 8 C. B., N. S. 666

(a) L. R., 9 Eq. at p. 222.

distinguished from rolled tinfoil without a licence from the plaintiff. If that cannot be done in England, it would be a very strange thing if a person in England could send an order to some one in France, get the same thing manufactured there in exactly the same way, and bring it here so as to compete with the person to whom the Crown has granted 'the whole profit, benefit, commodity, and advantage' arising from the patent. It would be a short mode of destroying 'every profit, benefit, commodity, and advantage' which a patentee could have from such a thing, if all that the man had to do was to get the thing made abroad, import it into this country, and then sell it here in competition with the English patentee."

In *Walton v. Lavater* (b) Erle, C. J., said:—"But it appears to me that the main purpose of the patent is to give the profit to the patentee, and that the main mode of defeating that purpose would be by selling the patented article; and it seems to me that without proof of the making of the article by the infringer, evidence that he sold the patented article for profit would be good evidence upon which a jury might find that he had infringed the patent. With respect to the defendant not being liable, because the articles were imported from abroad, I should say that, even if it was a simple case of importation, without any proof of knowledge of the article being patented, or of the infringement, it would be sufficient evidence of infringement that the defendant had imported and sold" (c).

In *The United Telephone Co. v. Sharples* (d), Kay, J., said:—"It is admitted by counsel for the defendant that if a man buys an instrument which he knows would, if made, sold, or used in this country, be an infringement of a patent in this country, if he buys it abroad, imports it into this country, has it in his possession, and sells it, although to a foreign customer, that would be a user which would be an infringement of the patent. I confess, as at present advised, I should have very little hesitation in saying that that would be so."

(b) 29 L. J., C. P. 275, 279.

(c) See also *Wright v. Hitchcock*, L. R., 5 Ex. 37; 39 L. J., Ex. 97; also *Von Heyden v. Neustadt*, L. R.,

14 Ch. D. 230; *The Carlsburn Sugar Refining Co. v. Sharp*, 1 P. O. R. 181, 186.

(d) 2 P. O. R. 28, 31.

Where the defendant has used and sold articles alleged to have been made by the patented process, the onus of proving that they were in fact made by that process is on the plaintiff, but where such articles were made abroad, and the plaintiffs, in consequence, could not be afforded full opportunity of inspecting the machinery by which they were made, it has been held that it lies with the defendants to rebut a *prima facie* case made out by the plaintiffs (e).

In *The Cartsburn Sugar Refining Co. v. Sharp* (f) the alleged infringement consisted in the sale in England of cube sugar manufactured in America by a machine made in accordance with the specification of the plaintiffs' patent, Lord Kinnear, in his judgment, said: "No witness has been examined of sufficient skill as a mechanic to give a detailed description of the machine in question. All that is proved is that it does not correspond in all respects, though in some respects it does correspond, to the description in *Hersey's* patent. It is said that as the manufacture complained of had taken place in America, it was incumbent on the respondents, upon the principle which received effect, in the case of *Neilson v. Betts* (*supra*), to prove by negative evidence that it was not manufactured according to the specified process. I think no such onus lies upon the respondents in the present case, because there can be no question on the evidence that such articles as were sold by the respondents may have been produced by machinery which involved no infringement of the complainer's patent. That being so, it lay upon the complainers to prove their case, and as they took a commission to America for the purpose of proving it, there could have been no difficulty in their obtaining a sufficient description of the machine to which it is alleged they have traced the cubes of sugar sold by the respondents, to enable them to establish the infringement, if infringement there was."

Selling known chemical substances with knowledge of and with a view to their being used for the purpose of infringing a patent is no offence, provided the vendor takes no actual personal part in the infringement (g).

(e) *Neilson v. Betts*, L. R., 5 H. L. 1, 11.

(f) 1 P. O. R., 181, 186.

(g) *Townsend v. Harworth*, L. R.,

12 Ch. D. 831; *Sykes v. Howarth*, L. R., 12 Ch. D. 826; but note *United Telephone Co. v. Dale*, L. R., 25 Ch. D. 778.

A patentee selling the patented article sells with it the right of free disposition as to that article, and if he sells the article in France, the purchaser may import and sell it in England. Lord Matherley, in *Betts v. Willmott* (*h*), said:—"Inasmuch as he has the right of vending the goods in France, or Belgium, or England, or in any other quarter of the globe, he transfers with the goods necessarily the licence to use them wherever the purchaser pleases. When a man has purchased an article he expects to have the control of it, and there must be some clear and explicit agreement to the contrary to justify the vendor in saying that he has not given the purchaser his licence to sell the article, or to use it wherever he pleases *as against himself*."

Where the defendants, being owners of patents in Belgium and England for an invention for making glass lamp globes, by a deed executed in Belgium, granted a licence to the plaintiffs to manufacture under their invention in Belgium but not elsewhere, and the plaintiffs under this licence manufactured articles in Belgium and sold them in England, it was held by the Court of Appeal, affirming Pearson, J., that the grant of the licence to use the patent in Belgium did not imply permission to sell the manufactured article in England in violation of the defendants' English patent (*i*).

And when the patentee has assigned his patent in France and kept it to himself in England, the French assignee may not, nor may a purchaser from him import and vend or use the goods made in France in England (*k*). In this case the sale of the article can only imply such licence as the vendor himself has, and the vendor has no right to sell in England.

Conversely, if the patentee had assigned his patent rights in England, he could not manufacture in France and sell in England, and the sale of an article in France would carry with it no implied right to import into or sell in England. But if the rights under the patent are vested in one and the same person for both France and England, or if there are no monopoly rights in France, but only in England, the patentee could not make and

(*h*) L. R., 6 Ch. at p. 245.

(*i*) *Société Anonyme des Manufactures de Glaces v. Tilghman's Patent*

Sand Blast Co., L. R., 25 Ch. D. 1.

(*k*) See the rule laid down in *Caldwell v. Vanvlissengen*, 9 Hare, 415.

sell in France and restrain the purchaser from selling or using the article in England, unless, indeed, there was a special agreement for that purpose; and then such agreement could not be held to attach to the article so as to prevent any person in whose hands it might come from importing it (*l*).

A vendee of a licensee, without an agreement to the contrary, has the same right of disposition with regard to things purchased as was vested in the licensee before (*m*), and where the licensee is restricted in his use of the patented article (*mm*), a purchaser from such licensee will not be affected by the restrictive covenant, unless he has due notice of its existence.

So, in *Heap v. Hartley* (*n*), the patentee granted to the plaintiff an exclusive licence for a district; subsequently he sold a machine made in accordance with the patent to the defendant, who brought this machine within the prohibited area. It was held by Bristowe, V.-C., and his decision was affirmed in the Court of Appeal, that the defendants were not affected by the exclusive licence for that district, since they had no notice of its existence.

In the course of his judgment Bristowe, V.-C., said (*o*):—
“Where a patentee sells that which he has a perfect right to do abroad to a person who has a perfect right to buy a machine abroad, and to use in England the thing so sold, you must, before you can attach the conscience of any sub-purchaser from that man, have something in the form of notice to that man that there is a restrictive user attachable to the particular machine so bought.”

But ignorance in the absence of an implied licence, as in the case we have been discussing, is no excuse, since, as has been pointed out above, infringement does not depend upon what a man intends, but upon what he does.

(*l*) *Betts v. Wilmott*, L. R., 6 Ch. 239.

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

(*mm*) For an instance of a limited

licence accompanying the sale of a patented article, see *The Incandescent Co. v. Cantelo*, 12 P. O. R. 262.

(*n*) 5 P. O. R. 603; 6 P. O. R. 495.

(*o*) 5 P. O. R. 610.

CHAPTER XVIII.

THE REMEDY—INJUNCTION.

THE remedy sought or granted in an action for infringement may consist of an injunction, together with an account of sales and profits, or damages.

The Judicature Acts and the Rules which have been made for the governing of the practice of the courts have introduced great changes in the method of procedure. The old practice of moving for an injunction by a suit in the Court of Chancery, and of trying the validity of the patent at common law, has disappeared; and in its place the patentee seeking to enforce his rights commences but one action in which he claims, and if entitled to, obtains every remedy which was formerly granted to him by the dual process.

Every patentee proceeding against an infringer must prove the validity of his patent and his title to an injunction; that being so, and the right to the injunction hanging so completely upon the question of validity, it is obvious that the new procedure and the new power of both divisions of the High Court of Justice to grant complete and sufficient remedies and to try every question is of great advantage to persons in possession of patent rights.

The basis of an injunction is the threat actual or implied on the part of the defendant, that he is about to do an act which is in violation of the plaintiff's rights; so that not only must it be clear that the plaintiff has rights, but also that the defendant has done something which induces the Court to believe that he is about to infringe those rights.

The fact that he has been guilty of an infringement of the patent rights will, under circumstances, be evidence that he

intends to continue his infringement, but whether he has actually infringed the patent or not, it will be sufficient if he has threatened to infringe it. Actual infringement is merely evidence upon which the Court implies an intention to continue in the same course.

In *Freearson v. Loe* (a), Jessel, M.R., said:—"I am not aware of any suit or action in the Court of Chancery which has been successful on the part of a patentee, without infringement having been proved; but, in my opinion, on principle there is no reason why a patentee should not succeed in obtaining an injunction without proving actual infringement. I think for this reason: where the defendant alleges an intention to infringe, and claims the right to infringe, the mischief done by the threatened infringement of the patent is very great, and I see no reason why a patentee should not be entitled to the same protection as every other person is entitled to claim from the Court from threatened injury, where that threatened injury will be very serious. No part of the jurisdiction of the old Court of Chancery was considered more valuable than that exercise of jurisdiction which prevented material injury being inflicted, and no subject was more frequently the cause of bills for injunction than the class of cases which were brought to restrain threatened injury, as distinguished from injury which was already accomplished. It seems to me, when you consider the nature of a patent right, that where there is a deliberate intention expressed, and about to be carried into execution, to infringe certain letters patent under the claim of a right to use the invention patented, the plaintiff is entitled to come to this Court to restrain that threatened injury. Of course it must be plain that what is threatened to be done is an infringement."

So in *Dowling v. Billington* (b), two acts of infringement of the plaintiff's patent were proved, the first of which took place prior to the acceptance of the complete specification by the Comptroller, while the second was committed a few days after the commencement of the action, it was held by Chatterton, V.-C., whose decision was affirmed by the Court of Appeal, that neither of these acts constituted an actionable infringement; but inasmuch

(a) L. R., 9 Ch. D. at p. 65.

(b) 7 P. O. R. 191.

as the conduct of the defendant showed a deliberate intention to infringe, the plaintiffs were entitled to an injunction upon the principle laid down by Jessel, M.R., in *Freearson v. Loe* (*supra*).

The actual infringement of the patent is taken by the Court to imply an intention to continue the infringement, notwithstanding any promises not to do so, and an injunction will be granted. Vice-Chancellor Shadwell, in *Losh v. Hague* (*c*), said: "If a threat had been used, and the defendant revokes the threat, that I can understand as making the plaintiff satisfied; but if once the thing complained of has been done, I apprehend this Court interferes, notwithstanding any promise the defendant may make not to do the same thing again."

If the fact of actual infringement is relied upon, and not a mere threat, it will be necessary to show very clearly that what has been done amounts to an infringement. In *Hancock v. Moulton* (*d*), it was held that the evidence must be so perfect, that if it were a motion to commit for the breach of an injunction, the Court would commit upon it. If the evidence of infringement is conflicting, either by reason that it is denied that the acts complained of were done, or that such acts as were done did not amount to an infringement of the patent, the Court should not grant an interim injunction before the hearing of the action (*e*).

If the evidence relied upon for the injunction is the sale by the defendant of the patented article, and not the manufacture, the plaintiff must show that such patented article was not made by himself or his licensees (*f*).

In the case of *Adair v. Young* (*g*), the defendant was the captain of a ship which was fitted with certain pumps which were an infringement of the plaintiff's patent. No act of using the pumps was proved; but it was shown that the ship was not supplied with other pumps. It was held that the possession of the pumps under such circumstances, although not of itself amounting to an infringement, was evidence upon which the Court would act that the defendant intended to use the pumps,

(c) 1 Web. P. C. 200.

(d) M. Dig. 506.

(e) *The Electric Telegraph Co. v. Nott*, 2 Coop. Ch. Cas. 41.

(f) *Betts v. Willmott*, L. R., 6 Ch. 239.

(g) L. R., 12 Ch. D. 13.

should occasion require. And the Court, Brett and Cotton, L.JJ., James, L.J., dissenting, granted an injunction.

Lord Justice James, in giving his reasons for dissenting, said : “ I think that an injunction ought not to be granted against a man unless he has done something which he ought not to have done, or permitted something which he ought to have prevented. Now, a master who comes on board ought not to be answerable on the ground that, when he takes command, there is on board a pump which infringes the patent. He does not, owing to his qualified possession, become at once an infringer. He had no power to take a pump out of the ship ; he had nothing to do with putting it there, and he was not wrong in allowing it to remain there, for he could not lawfully remove it. An injunction, therefore, can only be granted on the principle of *quia timet*, and in applying that principle I think that it would be a right exercise of the discretion of the Court not to grant an injunction against a master who has done nothing wrong when there is no difficulty in finding and suing the owner of the ship.”

The Court, however, seem to have been of opinion that the ground upon which an injunction should be granted is not whether the defendant has done anything wrong or not, but whether there was evidence of an intention to use the patented invention. The Court held that the circumstances of the case showed an intention in the captain to use the invention.

The principle upon which the Court grants an injunction was clearly demonstrated in *Proctor v. Bayley* (*h*). In that case the infringement complained of took place six years before the trial of the action. It was proved that the user continued only for a few months, after which the machines were abandoned as unsatisfactory. It was held by the Court of Appeal, reversing the decision of Bristowe, V.-O., that it was clear that the defendants had no intention whatever of continuing the wrongful act, and consequently that it was not a proper case in which an injunction should be granted. Cotton, L.J., in his judgment, said (*i*) : “ There is no doubt that it was a good patent, and we must also take it that the defendants have infringed ; but the point is this : Is there any ground here which would justify the Court in

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

(*i*) Pp. 541, 542.

exercising the extraordinary jurisdiction of the Court of Chancery in granting an injunction? That, I think, has been a good deal lost sight of in the argument. It is not because a man has done a wrong that an injunction will be granted against him. If a man has done a wrong which will not be continued, at common law damages may be obtained for the wrong done, which the common law says is sufficient indemnity for that wrong; but then the Court of Chancery says this, in the exercise of its extraordinary jurisdiction: 'We will not be satisfied with that; we will grant an injunction, because a wrongful act has been done, in order to prevent that wrongful act'; and they grant an injunction where a wrongful act has been done and the Court is satisfied of the probability of the continuance of the wrongful act. . . . But here, although the defendants did infringe the plaintiff's patent, we must consider all the circumstances of the case in order to guide us in the consideration of this: Ought the Court to draw the inference that there will be a continuance of the wrongful act so as to justify the Court in granting the extraordinary interference and the protection which is exercised by the Court of Equity?" (k).

On the same principle an action for an injunction may be brought against innocent carriers of infringing articles, in *Upmann v. Elkan* (l), which was a trade mark case, Lord Hatherley, L.C., in his judgment, said: "It has been argued that the plaintiffs were not entitled to an injunction against the defendants, who had been guilty of no offence, being merely carriers receiving goods, which, though fraudulently marked, were not for their own use, nor to be sold by them for their own benefit, but were received merely for the purpose of transmitting them to the persons to whom they were consigned. I cannot conceive a doctrine more dangerous or mischievous, or more fatal to the authority of the Court with respect to trade marks. If that argument prevailed, any persons being abroad, as was the case in this instance, and minded to commit frauds upon an

(k) Note also *Millington v. Fox*, 3 M. & Cr. 338; *Geary v. Norton*, 1 De G. & S. 9.

(l) L. R., 7 Ch. 130, 132; see also

Washburn & Moen Manufacturing Co. v. Cunard Steamship Co., 6 P. O. R. 398, 403.

English trade mark, could easily do so by sending their different consignments together to persons in the position of the defendants, who appear to be respectable agents and warehousemen, thereby committing an injury in a manner most convenient to themselves, and very mischievous to the person entitled to the benefit of the trade marks."

The above reasoning would apply equally well to infringements of letters patent. The carriers, however, will be absolved from all liability if they make full disclosure of the names of the consignors and consignees of the goods complained of (*m*).

No injunction will be granted where the patentee has not proceeded with reasonable speed to prosecute infringers (*n*). But in cases where there are several infringers he is not justified in commencing a vast multitude of actions and applying for injunctions in each (*o*). His proper course is to "select that which he thought the best in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction. He might write at the same time to all the others who were *in simili casu*, and say to them, 'Are you willing to take this as a notice to you that the present case is to determine yours? Otherwise I shall proceed against you by way of interlocutory injunction; and if you will not object on the ground of delay, I do not mean to file bills against all of you at once. Am I to understand that you make no objection of that kind? If you do not object I shall file a bill against only one of you.' I do not think any court could complain of a patentee for taking the course I am suggesting" (*p*).

There are two forms of injunction, the interlocutory injunction and the perpetual injunction.

The interlocutory injunction stands very much upon the same footing, and will be granted for similar reasons and upon the same conditions that an injunction was formerly awarded by the Court

(*m*) Ibid.

(*n*) *Losh v. Hague*, 1 Web. P. C. 201; *Bacon v. Jones*, 4 My. & Cr. 438, 439; *Bridson v. Benecke*, 12 Beav. 1; *Baxter v. Combe*, 1 Ir. Ch. R. 284; *Hancock v. Moulton*, M. Dig. 506.

(*o*) *Foxwell v. Webster*, 3 N. R. 103,

at p. 180.

(*p*) Per Sir W. Page-Wood, V.C., *Bovill v. Crate*, L. R., 1 Eq. at p. 391. See also *Hancock v. Moulton*, M. Dig. 506; *Smith v. L. & S. W. Rail. Co.*, Kay, 408.

of Chancery when an action was directed to be tried at common law.

The perpetual injunction is granted after trial, and binds the parties against whom it is granted during the continuation of the term of the patent.

An interlocutory injunction may be granted *ex parte*, after the issue of the writ, and before service. An *ex parte* injunction will only be granted when it can be shown that great injury will accrue to the plaintiff by delay, and when he can clearly establish his title and the fact of infringement (*q*).

Notice of motion having been given, an interlocutory injunction will be granted after appearance, or with leave, upon notice of motion to be served with the writ.

By sect. 25 of the Judicature Act, 1871, sub-sect. 8: "A mandamus or an injunction may be granted, or a receiver appointed by an interlocutory order of the Court, in all cases in which it shall appear to the Court to be just or convenient that such order should be made; and any such order may be made either unconditionally or upon such terms and conditions as the Court shall think just; and if an injunction is asked either before, or at, or after the hearing of any cause or matter to prevent any threatened or apprehended waste or trespass, such injunction may be granted if the Court shall think fit, whether the person against whom such injunction is sought is or is not in possession under any claim of title or otherwise, or (if out of possession) does or does not claim a right to do the act sought to be restrained under any colour of title; and whether the estates claimed by both or either of the parties are legal or equitable."

It will be observed that this section confers upon the Court very wide limits within which, in its discretion, it may grant injunctions. It sweeps away a great deal of the technical rules which had been from time to time laid down by the Court of Chancery for the granting of injunctions, and it practically substitutes for them the opinion of the judge trying each particular action as to the balance of convenience upon a consideration of the facts of the case.

(*q*) *Gardner v. Broadbent*, 2 Jur., N. S. 1041.

Order L. rule 6, directs that: "An application for an order under sect. 25, sub-sect. 8, or under rules 2 or 3 of this Order, may be made to the Court or a judge by any party. If the application be by the plaintiff for an order under the said sub-sect. 8, it may be made either *ex parte* or with notice. . . ."

A master of the Queen's Bench Division has no power to grant an injunction. Order LIV. rule 12.

An interlocutory injunction will be granted whenever there has been such working, user and enjoyment of the patent rights by the patentee as will satisfy the Court that there are strong *prima facie* reasons for acting on the supposition that the patent is valid.

Lord Eldon, in the case of the *Universities of Oxford and Cambridge v. Richardson (r)*, said: "It is then said in cases of this sort the universal rule is that if the title is not clear at law the Court will not grant or sustain an injunction until it is made clear at law. With all deference to Lord Mansfield, I cannot accede to that proposition so unqualified. There are many instances in my own memory in which this Court has granted or continued an injunction to the hearing under such circumstances. In the case of patent rights, if the party gets his patent and puts his invention in execution and has proceeded to a sale, that may be called possession under it; however doubtful it may be whether the patent can be sustained, this Court has lately said possession under a colour of title is ground enough to enjoin, and to continue the injunction, till it shall be proved at law that it is only colour and not real title."

And in *Gardner v. Broadbent (s)*, Sir J. Stuart, V.-C., said: "I wish it to be understood that the law of the Court is that laid down by Lord Eldon in the *Universities of Oxford and Cambridge v. Richardson.*"

There having been a trial as to the validity of the patent, which has terminated in favour of the patentee, will be considered by the Court sufficient reason for granting an interlocutory injunction (*t*); and where the patentee has worked and enjoyed the

(r) 6 Ves. 689, 706.

(s) 2 Jur., N. S. 1041.

(t) *Dudgeon v. Thompson*, 30 L. T., N. S. 244; 22 W. R. 464; *Russell v.*

Cowley, 2 Coop. Ch. Ca. 59, n.; *United Telephone Co. v. St. George*, 3 P. O. R. 33; *Moser v. Sewell*, 10 P. O. R. 365.

patent for many years without dispute, an interlocutory injunction will be granted (*u*); so also where the defendant has admitted the validity of the patent (*x*), or is so placed in his relationship to the patentee as to be estopped from denying its validity (*y*).

In *Dudgeon v. Thompson* (*z*), Jessel, M.R., said: "The Court can grant an injunction before the hearing where the patent is an old one and the patentee has been in long and undisturbed enjoyment of it, or where its validity has been established elsewhere, and the Court sees no reason to doubt the propriety of the result, or where the conduct of the defendant is such as to enable the Court to say that, as against the defendant himself, there is no reason to doubt the validity of the patent."

So in *Betts v. Menzies* (*a*), Wood, V.-C., said:—"The law of this Court is, that where the patentee has had long enjoyment, then he shall have an injunction to protect his rights until trial, even although his rights under his patent be doubtful."

What amounts to long enjoyment is difficult to define, but decided cases would appear to suggest that undisturbed enjoyment for six years would be sufficient (*b*); but the user of the invention during that time must be active. The mere possession of a patent for a long period does not of itself give rise to a presumption of its validity (*c*).

An interlocutory injunction is seldom granted in the case of a new patent (*d*), unless very strong evidence in support of the motion be adduced (*e*), or where the validity of the patent has

(*u*) *Dudgeon v. Thompson*, 30 L. T., N. S. 244; *Curtis v. Cutts*, 2 Coop. Ch. Ca. 60, n.; *Davenport v. Goldberg*, 2 H. & M. 282; *Penn v. Bibby*, L. R. 3 Eq. 308; *Muntz v. Foster*, 2 Web. P. C. 95; *Bickford v. Skewes*, 1 Web. P. C. 211; *Plimpton v. Malcolmson*, 44 L. J., Ch. 257; *Rothwell v. King*, 3 P. O. R. 379; *Hayward v. Pavement Light Co.*, Griff. P. C. 124.

(*x*) *Dircks v. Mellor*, 26 Lon. Journ. 268.

(*y*) *Clarke v. Fergusson*, 1 Giff. 184.

(*z*) 30 L. T., N. S. 244.

(*a*) 3 Jur., N. S. at p. 358.

(*b*) *Bickford v. Skewes*, 1 Web. P. C. 211; *Rothwell v. King*, 3 P. O. R. 379.

(*c*) *Plimpton v. Malcolmson*, 44 L. J., Ch. 257.

(*d*) *Caldwell v. Vanvlissengen*, 9 Hare, 415, 424; *Renard v. Levinstein*, 10 L. T., N. S. 177; *Lister v. Norton*, 1 P. O. R. 114; *Jackson v. Needle*, 1 P. O. R. 174; *British Tanning Co. v. Groth*, 7 P. O. R. 1.

(*e*) *Gardner v. Broadbent*, 2 Jur., N. S. 1041.

been tried and upheld (*f*), though where the plaintiffs made out a *prima facie* case, and no substantial defence was put forward, the Court granted an interlocutory injunction (*g*). The usual practice in such cases is to order the motion to stand over to the trial without prejudice to any question, the defendants undertaking to keep an account.

An interlocutory injunction will not be granted in cases where the plaintiff is guilty of delay in making his motion (*h*).

The principle which may be gleaned from the decisions in motions for interlocutory injunctions is that the Court will consider the balance of convenience in each particular case (*i*).

If it should appear that irremediable injury will be sustained by the defendant if an injunction goes which may afterwards appear unfounded, the Court will require a very strong case to be made out by the plaintiff before granting such an injunction (*k*), and the converse would equally appear.

In *Bickford v. Skewes* (*l*), Shadwell, V.-C., said: "I have nothing to do with any other case than the case before me."

The Court will not infrequently grant or refuse the injunction until the hearing upon terms; the terms on the plaintiff being that he shall be answerable in damages, or on the defendant that he shall keep an account of the material manufactured, or of the articles sold, in pursuance of the patent process, but it is open to the plaintiff to show that if he succeeds the defendant's position is such that he will be unable to pay the damages or the amount of the account (*m*). In considering which course should be adopted, the Court will be influenced chiefly by the balance of convenience and the probability of injury to either side (*n*).

(*f*) *The Farben Fabriken, vorm. F. Bayer & Co. v. Dawson*, 8 P. O. R. 397.

(*g*) *Coles v. Baylis*, 3 P. O. R. 178.

(*h*) *Bovill v. Crate*, L. R., 1 Eq. 388; *Greer v. Bristol Tanning Co.*, 2 P. O. R. 268; but note *United Telephone Co. v. Equitable Telephone Co.*, 5 P. O. R. 233.

(*i*) *Walker v. Clarke*, 4 P. O. R. 111; *Challender v. Royle*, 4 P. O. R. 363; *Thomson v. Hughes*, 7 P. O. R. 71; *Bracher v. Bracher*, 7 P. O. R.

420; *Kensington, &c., Electric Lighting Co. v. Lane Fox*, 8 P. O. R. 277; *Moser v. Sewell*, 10 P. O. R. 365, 367.

(*k*) *Neilson v. Forman*, 2 Coop. Ch. Ca. 61, n.

(*l*) 1 Web. P. C. 213.

(*m*) *Newall v. Wilson*, 2 De G. M. & G. 282; *Bracher v. Bracher*, 7 P. O. R. 420.

(*n*) *Neilson v. Thompson*, 1 Web. P. C. 278; *Bridson v. M'Alpine*, 8 Beav. 229; and cases supra.

In *Plimpton v. Spiller* (o), James, L.J., said:—"The Court, not forming an opinion very strongly either one way or the other whether there is an infringement or not, but considering it is as a fairly open question to be determined at the hearing, and not to be prejudiced by any observations in the first instance, reserves the question of infringement as one which will have to be tried at the hearing and which it will then have to consider. There will always be, no doubt, the greatest possible difficulty in determining what is the best mode of keeping things *in statu quo*—for that is really what the Court has to do, to keep things *in statu quo*—until the final decision of the question; and then, of course, the Court says, 'We will not stop a going trade. We will not adopt a course which will result in a very great difficulty in giving compensation on the one side or on the other. We have to deal with it as a practical question, in the best way we can.' I think, on the whole, that the Master of the Rolls has made the right order, viz., by granting the injunction and putting the plaintiff upon an undertaking to abide by such order (if any) as to damages as the Court may think fit to make if he should ultimately turn out to be in the wrong, and that it would not be right in this case merely to put the defendant upon the terms of keeping an account which, I conceive, might be a very clumsy and inefficient mode of recompensing the plaintiff if he should turn out ultimately to be in the right." In the same case the present Master of the Rolls, Sir W. B. Brett, said (p):—"There will be a hardship on the one side or on the other, and the question is on which side does the balance appear to lie? Now, if the trade of a defendant be an old and established trade, I should say that the hardship upon him would be too great if any injunction were granted. But where, as here, the trade of the defendant is a new trade, and he is the seller of goods to a vast number of people, it seems to me to be less inconvenient and less likely to produce irreparable damage to stop him from selling, than it would be to allow him to sell and merely keep an account, thus forcing the plaintiff to commence a multitude of actions against the purchasers."

(o) L. R., 4 Ch. D. 289.

(p) At p. 292.

The evidence to be used upon an application for an interlocutory injunction is upon affidavit.

The affidavit should clearly point out in what the alleged infringement consists (*q*). If the plaintiff is the first inventor, he must distinctly swear to the fact, as also to the novelty and utility of the invention, and to the due filing of a sufficient specification (*r*). If the plaintiff is an assignee he must swear to the best of his belief (*s*). The affidavits in either case must state the facts as at the time of swearing, and it is not sufficient to swear that the invention was believed to be new when the patent was granted (*t*). An injunction granted prior to statement of claim will be dissolved if the statement of claim when delivered does not agree with the affidavits upon which the injunction was granted (*u*).

In the Chancery Division it is the practice to hear applications for interlocutory injunctions as motions in Court. In the Queen's Bench Division the application is heard by the Judge in Chambers upon a summons.

Forms of injunction upon undertaking as to damages (*x*), and of order refusing injunction upon terms (*y*), will be found in the Appendix.

After trial and judgment, and upon application for a perpetual injunction, when the nature of the infringing matter will permit of it, an order will be made that the articles (machinery or otherwise) be delivered up to the plaintiff or destroyed (*z*). This was done in *Plimpton v. Malcolmson* (supra); the reference to this cause is M.R., 28th Jan., 1876, B. 381. An inquiry will, when necessary, be directed as to the articles manufactured which are in the defendant's possession, and that they be destroyed, *Betts v. De Vitre*, V.-C. W., 1865, A. 119. The

(*q*) *Hill v. Thompson*, 3 Mer. 624; *Betts v. Willmott*, L. R., 6 Ch. 239.

(*r*) *Hill v. Thompson*, 3 Mer. 624; *Sturtz v. De la Rue* (per Lord Lyndhurst), 5 Russ. 329; *Whitton v. Jennings*, 1 Dr. & S. 110.

(*s*) *Gardner v. Broadbent*, 2 Jur., N. S. 1041.

(*t*) *Hill v. Thompson*, 3 Mer. 624.

(*u*) *Stocking v. Llewellyn*, 8 L. T. 38.

(*x*) Form 4, p. 472, post.

(*y*) Form 5, p. 473, post.

(*z*) *Frearson v. Lee*, L. R., 9 Ch. D. at p. 67; but see also *United Telephone Co. v. London & Globe Telephone Co.*, L. R., 26 Ch. D. at p. 776; *Siddell v. Vickers*, 5 P. O. R. at p. 101.

defendant will also be ordered to make discovery upon oath of the articles or machinery which he may have in his possession, and which infringe the plaintiff's patent, so that they may be delivered up and destroyed; this was done in *Tangye v. Stott*, V.-C. W., 12th Feb., 1866, B. 461. The right of property in the articles which infringe the patent remains in the infringer, although the Court may order the articles to be destroyed (a).

These mandatory orders are never made except after trial, and when the plaintiff has fully established to the satisfaction of the Court the validity of his patent and the fact of the defendant's infringement.

An injunction having been granted to restrain the defendant from infringing a patent for the manufacture of telephones: It was held to be a breach of the injunction to sell the separate parts of the patented telephones which anyone might put together (b).

The injunction falls with the expiration of the patent (c), but where machines have been manufactured or articles made in infringement of patent rights, an injunction will be granted to prevent their use or sale, even after the patent has expired (d).

A person against whom an injunction has been granted is liable to be committed should he be guilty of a breach of such injunction, but an application for committal, involving as it does the liberty of the subject, will require the strictest proof in its support (e).

In *Hopkinson v. St. James and Pall Mall Electric Light Co.* (f), an injunction was granted but was suspended for six months, the defendants agreeing to keep an account on the ground that great inconvenience would be caused to the public by suddenly stopping the use of the three wire system.

(a) *Varasseur v. Krupp*, L. R., 9 Ch. D. 351.

(b) *United Telephone Co. v. Dale*, L. R., 25 Ch. D. 778.

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

(d) *Crossley v. Beverley*, 1 Web. P.

C. 119; *Crossley v. The Derby Gas Light Co.*, 4 L. J., Ch. 25; see also *Pric's Patent Candle Co. v. Bauwen's Patent Candle Co.*, 4 K. & J. 727.

(e) *Dick v. Haslam*, 8 P. O. R. 196.

(f) 10 P. O. R. at p. 62.

DAMAGES.

In addition to an injunction, the defendant may be entitled, when there has been actual infringement as distinguished from an intention to infringe, to either damages or an account of sales and profits.

He is not entitled to both damages and an account, but he must elect which he will take (*g*). An account of sales and profits amounts to a condonation of the infringement (*h*).

The measure of damage is not the profit made by the infringer, but is the loss which the plaintiff has actually sustained (*i*). The question of damages is not synonymous with an account of profits, the basis of calculation being entirely different.

“The loss must be the natural and direct consequence of the respondent’s acts” (*k*), consequently the damages will be the estimated loss of profit incurred by the plaintiff by reason of the sale by the defendant of articles which infringed the plaintiff’s patent; such a question must be one of considerable difficulty, and can only be decided by a fair businesslike view of all the circumstances of the case.

A probable result of the sale by the defendant, of articles which infringe the plaintiff’s patent, is a reduction in price owing to the commercial competition, and a consequent loss of profit to the plaintiff; whether this source of damage may or may not be taken into consideration will depend upon the circumstances of the case.

In *The United Horse-shoe and Nail Co. v. Stewart* (*l*), loss of profit arising from such competition was not allowed. In that case the patent in question was one for a machine to produce horse-shoe nails more cheaply than had been done before; consequently anyone else could make nails in competition with the plaintiffs, they were only restrained from making them by means of that

(*g*) *De Vitre v. Betts*, L. R., 6 H. L. 319; *Neilson v. Betts*, L. R., 5 H. L. 1; *Needham v. Oxley*, 11 W. R. 852.

(*h*) Per Lord Westbury, *Neilson v. Betts*, supra; also *United Horsenail Co. v. Stewart*, 3 P. O. R. at p. 143.

(*i*) *United Horsenail Co. v. Stewart*, 3 P. O. R. at p. 143; 5 P. O. R. at p.

267; *Petman v. Bull*, 3 P. O. R. at p. 393.

(*k*) Per Lord Macnaghten, *United Horsenail Co. v. Stewart*, 5 P. O. R. at p. 268; see also *American Braided Wire Co. v. Thomson*, 7 P. O. R. 152.

(*l*) 3 P. O. R. 139; 4 P. O. R. 130; 5 P. O. R. 260.

particular description of machine, and further the plaintiffs had always gone a little before the defendants in reducing their prices, and so continually kept the prices lower than that quoted by the defendants.

In *The American Braided Wire Co. v. Thomson* (m), the patent infringed was one for the manufacture of a particular form of bustle; no one else being able to put a similar bustle on the market without infringing that patent, the plaintiffs did not reduce their prices until compelled to do so by the defendants, and then only reduced them to the level quoted by the defendants; the official referee in his finding said: "But for the defendants' competition and their selling at lower prices the plaintiffs would, subject to the allowances mentioned in paragraphs 2, 3, and 4, have made the sales made by the plaintiffs, and also those made by the defendants at the plaintiffs' original prices." Taking all these circumstances into consideration, the Court of Appeal held that the finding of the official referee was reasonable and fair, and that the plaintiffs were entitled to the full amount so found, including the loss of profit arising from the competition of the defendants.

In estimating damages, the Court will inquire into the extent of infringement and the amount of goods manufactured by the defendant, care being taken to distinguish this inquiry from that as to sales and profits.

In the *United Horse-nail Co. v. Stewart* (n), a Scotch case, the Lord Ordinary (Kinneir) said:—"It appears to me to be a fair enough ground for estimating their damages to take the whole profits which they would have made upon the sales actually made by the defenders, if the defenders had not interfered so as to prevent the pursuers effecting those sales themselves. That would mean the difference between the cost of manufacture and the prices at which they were selling at the time to their agent."

In *Ungar v. Sugg* (o), Wright, J., said: "No one can doubt that in this case there was substantial damage, and the difficulty and impossibility of stating the precise ground for assessing it at any particular figure, does not seem to be a

(m) 7 P. O. R. 152.

(n) 3 P. O. R. 143; see also *Boyd v.*

Tootal Broadhurst Co., 11 P. O. R. 175.

(o) 8 P. O. R. 385, 388.

sufficient reason for giving only a nominal sum," and Lord Esher, M.R., in the Court of Appeal, said (p) : "They were problematical damages, and had to be what is called guessed at: that is, not a mere guess, as if you were tossing up for the thing, but it must come to a mere question of what, in the mind of the person who has to estimate them, was a fair sum."

The fact that only part of the machine is an infringement is immaterial, since each thing produced by the assistance of such part is itself an infringement of the plaintiff's patent, and to that extent occasions damage by interfering with the plaintiff's trade (q).

Where bills to restrain the infringement of a patent have been filed against both the person who manufactures, and the person who uses the article, and issues of fact have been found for the plaintiff, it is the right of the plaintiff to have, not only an account against the manufacturer, but also damages against the person using the article, wherever it be found (r).

The fact that a patentee has recovered judgment and damages against a manufacturer of infringing articles, does not preclude him from taking further proceedings against the purchasers of infringing articles from such manufacturer (s).

Where licences have been granted, no account will be taken of profits which have been lost by reason of competition (t).

In *Penn v. Jack* (u) the plaintiff was not in the habit of manufacturing himself under his patent, but granted licences for the use of the invention. Sir W. Page-Wood, V.-C., fixed the amount of damage at the amount which would have been received had the defendant been working under a licence.

In aid of the inquiry as to damages, directed by the judgment for a perpetual injunction, the defendant must give full discovery, and will be required to set out the names and addresses of the persons to whom machines, made in infringement of the patent,

(p) 9 P. O. R. 113, 117.

(q) *United Horse-shoe and Nail Co. v. Stewart*, 5 P. O. R. 264.

(r) Headnote to *Penn v. Bilby*, L. R., 3 Eq. 308.

(s) *United Telephone Co. v. Walker*,

4 P. O. R. at p. 66.

(t) *Penn v. Jack*, L. R., 5 Eq. at p. 85.

(u) *Ibid.*; see also *United Telephone Co. v. Walker*, 4 P. O. R. 63.

have been sold ; but not the names of the agents concerned in the transaction (x).

ACCOUNT OF SALES AND PROFITS.

In cases where it is deemed to the advantage of the plaintiff, he may elect, in lieu of damages, to take an account of sales and profits ; that is, to condone the infringement upon the footing that the defendant has been acting as the plaintiff's agent in selling or using the invention (y).

An inquiry as to profits is one which involves many questions of great difficulty (z), and in consequence is usually attended by a great expenditure, both of time and money, " therefore, although the law is that a patentee has a right to elect which course he will take, as a matter of business he would generally be inclined to take an inquiry as to damages, rather than launch upon an inquiry as to profits " (a).

The plaintiff will not be allowed to claim an account if he has tacitly permitted the defendant to infringe his patent, relying upon an ultimate account of profits. In *Crossley v. The Derby Gas Light Co.* (b), Lord Brougham said :—" It is a principle of equity, that a party who claims a right should not lie by, and by his silence or acquiescence induce another to go on spending his money and incurring risk, and afterwards, if profit has been made, come and claim a share in that profit without having ever been exposed to share in the losses which might have been sustained. Upon this the defendants rely ; but it was to be considered, on the other hand, whether the plaintiff did not explain the delay which has taken place, and whether the conduct of the defendants has not been such as to lull the plaintiff's suspicions to sleep."

Where it appears at the trial that the defendant has made no profit, although the plaintiff may be entitled to damages, he will not be entitled to an account (c).

(x) *Murray v. Clayton*, L. R., 15 464, 467 ; 9 P. O. R. 152.
Eq. 115.

(y) *Betts v. De Vitre*, L. R., 6 H. L. 319 ; *United Horsenail Co. v. Stewart*, 3 P. O. R. 143.

(z) *Siddell v. Vickers*, 6 P. O. R. 387.

(a) Per Lindley, L.J., in *Siddell v. Vickers*, 9 P. O. R. at p. 163.

(b) 1 Web. P. C. 120.

(c) *Bacon v. Spottiswoode*, 1 Beav.

Where the defendant has acted in ignorance of the patent, and before action has offered to submit to an account and to pay to the plaintiff the amount of profits, the Court should exercise its discretion in disallowing costs (*d*), although it may grant the injunction. In such a case the plaintiff will proceed to an account at his peril, running the risk of nothing being found due.

Prior to the Judicature Acts it was held a rule in Courts of Equity, that in consequence of the terms of 21 & 22 Vict. c. 27, no relief could be awarded for damages or an account, unless an injunction could be granted at the same time; all other relief being merely incidental to the injunction (*e*). Thus, where a patent had expired after bill filed, but before an injunction could be granted, the Court declined to consider the question of damages (*f*). But now, in pursuance of sect. 24, sub-sect. 6, of the Judicature Act, 1873, a Court of Equity may give full relief; and so, wherever a court of law would, prior to the passing of the Act, have granted damages or an account, similar orders will be made by either branch of the High Court of Justice, irrespective of the question of injunction.

(*d*) *Nunn v. D'Albuquerque*, 34 Beav. 595; *Redges v. Mulliner*, 10 P. O. R. 21, 28.

(*e*) *Price's Patent Candle Co. v.*

Bauwen's Patent Candle Co., 4 K. & J. 727.

(*f*) *Bells v. Gallais*, L. R., 10 Eq.

892.

CHAPTER XIX.

REVOCATION.

WE have seen that the patentee has his remedy in an action for infringement. The public has also a remedy by petition for revocation.

Sec. 26 of the Act of 1883 provides:—

“(1) *The proceeding by scire facias to repeal a patent is hereby abolished.*

“(2) *Revocation of a patent may be obtained on petition to the Court.*

“(3) *Every ground on which a patent might, at the commencement of this Act, be repealed by scire facias shall be available by way of defence to an action for infringement, and shall also be a ground of revocation.*

“(4) *A petition for revocation of a patent may be presented by:—*

“(a) *The Attorney-General in England or Ireland, or the Lord Advocate in Scotland.*

“(b) *Any person authorised by the Attorney-General in England or Ireland, or the Lord Advocate in Scotland.*

“(c) *Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims.*

“(d) *Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee.*

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

“(5) *The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered.*

“(6) *Particulars delivered may be from time to time amended by leave of the Court or a judge.*

“(7) *The defendant shall be entitled to begin and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent the defendant shall be entitled to reply.*

“(8) *Where a patent has been revoked on the ground of fraud the comptroller may on the application of the true inventor, made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent so granted shall cease on the expiration of the term for which the revoked patent was granted.”*

Practically speaking, *scire facias* had fallen into desuetude before the passing of this Act; other methods of disputing the validity of patents were found, or thought to be, more to the advantage of persons opposing them. It is presumed, however, that the new procedure will find more favour, being simpler, more speedy, and more similar to the ordinary action for infringement than the old action of *scire facias*.

The grounds upon which a patent may be revoked are similar to those upon which it might have been cancelled by *scire facias* (a). These are in the Fourth Institute said to be: “*Firstly*, when the king by his letters patent doth grant by several letters patent one and the selfsame thing to several persons, the former patentee shall have a *scire facias* to repeal the second patent; *secondly*, when the king granteth anything that is grantable upon a false suggestion, the king by his prerogative *jure regio* may have a *scire facias* to repeal his own grant. When the king doth grant anything, which by law he cannot grant, he *jure regio* (for the advancement of justice and right) may have a *scire facias* to repeal his own letters patent.”

And it was held in *Sir Oliver Butler's case* (b), that “where a

(a) 4 Inst. 88.

(b) 2 Vent. 344.

patent is granted to the prejudice of the subject, the king, of right, is to permit him on his petition to use his name for the repeal of it in a *scire facias* at the king's suit, and to hinder multiplicity of actions upon the case."

Thus it will be seen that formerly any person might, on behalf of the public, proceed by *scire facias* to repeal a patent, although security for costs was required. Sub-sect. 4 of sect. 26 has very considerably narrowed and limited this general right.

Practically speaking, any ground which may be set up as a defence to an action for infringement may be employed as a ground for revocation—such as that the person to whom the letters patent were granted was not the first and true inventor, or that the invention was not new or useful, or that it was not true that the invention had not been practised before, or that the said invention did not come within the meaning of the words "a new manufacture," or that the specification was insufficient and did not disclose the nature of the invention.

The petition is to be presented to the High Court of Justice in England or in Ireland. By sect. 109 it is provided: (1) "*Proceedings in Scotland for revocation of a patent shall be in the form of an action of reduction at the instance of the Lord Advocate, or at the instance of a party having interest with his concurrence, which concurrence may be given on just cause shown only.*" And in respect to Ireland we find that, by sect. 110, "*All parties shall, notwithstanding anything in this Act, have in Ireland their remedies under or in respect of a patent as if the same had been granted to extend to Ireland only.*"

Only persons who come within the provisions of clauses c, d, and e, of sect. 26, sub-sect. 4, are entitled to present a petition for revocation as a matter of right; care, however, must be exercised to frame the petition under the proper clause.

In re Avery's Patent (c) was a petition for revocation presented under clause c; it was held by Stirling, J., and the Court of Appeal, that this applied only to cases of actual fraud, and would not be extended to questions of mistake, though the consequences might be to deprive the inventor of his patent rights. Cotton, L. J., said:—"If it is made out that the

present petitioner Avery is a person who brings himself within that clause, and *satisfies the Court* that the patent was obtained in fraud of his rights, then we should have to go into the other question, namely, whether the patent is or is not good” . . .

. . . (at p. 325), “an act, to be ‘in fraud of his rights,’ to my mind must involve an attempt by the agent to deprive the principal of something, or to gain for himself something at the expense of his principal.” The petition consequently was dismissed, but without prejudice to the right of the petitioner to present a fresh petition framed under clause d.

A person who is entitled to present a petition for revocation without the necessity of first obtaining the fiat of the Attorney-General, may rely upon any lawful ground whereby to impeach the validity of the patent in question, and is not confined to the ground upon which his title to present the petition is based (*d*).

Where a patent is revoked on the ground that it was obtained in fraud of the rights of the petitioner, the Court will decree that a fresh patent for the invention should be granted to the petitioner (*e*).

All persons beneficially interested in the patent must be made parties to the petition (*f*).

No petition for revocation will lie in respect of a patent granted for an invention which the Secretary of State has certified should be kept secret in the interest of the public service (*g*).

Should a person desire to present a petition for revocation, not being entitled to do so under clauses c, d, or e, he must first obtain the fiat of the Attorney-General; in order to obtain the fiat the following documents must be lodged with the Attorney-General’s clerk :—

1. A memorial drawn up on judicature paper setting out the history of the case and the grounds upon which the application is based; where there have been proceedings taken for infringement, these and their result must be mentioned. This memorial

(*d*) *In re Morgan’s Patent*, 5 P. O. R. 186.

(*e*) *In re Gale’s Patent*, 8 P. O. R. 438; *In re Avery’s Patent*, L. R., 36 Ch. D. 326.

(*f*) *In re Avery’s Patent*, 4 P. O. R. 159.

(*g*) 46 & 47 Vict. c. 57, s. 44, sub-s. 9.

must be accompanied by all specifications and documents referred to.

2. A declaration by the petitioner verifying the statements in the memorial; this also should be upon judicature paper.

3. Two copies of the proposed petition on brief paper.

4. Two copies of the particulars of objections.

5. A certificate by counsel on foolscap, that in his opinion the petition is a proper one for the grant of the fiat of the Attorney-General.

6. A certificate by a solicitor that the applicant is a proper person to present the petition, and that he is competent to answer the costs of all proceedings in connection with the petition.

7. A declaration by the applicant that the questions proposed to be raised by the petition, are not, and cannot be raised in any legal proceedings then pending in the United Kingdom (*h*).

The fees payable on lodging these documents amount to 2*l.* 13*s.* 4*d.*

It is submitted that the seventh of the above-mentioned documents, is one which ought not to be insisted upon by the Attorney-General, since if the fiat is to be refused when an action for infringement is pending and the questions proposed to be raised will in consequence be then considered, the public may be deprived of one of the greatest benefits which arise from the provisions of the legislature for the revocation of patents, for although the defendant may be successful in the action brought against him for infringement, it will still remain open to the patentee to amend his specification by abandoning a portion of his claim, and subsequently to bring a fresh action against the same defendant for infringement of the patent as amended; thus if the public are to be deprived of the power to revoke a patent simply because an action for infringement may be pending, in such a case as that stated above, a man against whom the action is brought either will be liable to a succession of actions or at the least will have to incur the expense of two actions, first as defendant in the infringement action, and secondly as

(*h*) For forms of these documents see Appendix D.

petitioner for revocation, to enable him to carry on his business in security (i), whereas by replying to an action brought against him by presenting a petition for revocation, the two actions would be consolidated into one, as was done in the recent case of *Weir v. Denny* (k), and the validity of the patent would be decided once and for all.

The Attorney-General has absolute discretion in granting or refusing his fiat; if the applicant shows sufficient interest, and makes out a good case, the Attorney-General will grant his fiat without hearing the patentee (l), but in some cases he will direct notice to be given to the persons interested in the patent, and will hear both parties and give his decision in the ordinary way (m); Sir H. James, A.-G., decided that he had no power under sect. 38 to give costs in these cases (n).

The form of the fiat of the Attorney-General will be found in the Appendix of Forms.

There are no provisions in the Patents Acts or elsewhere regulating the procedure in a petition for revocation, not even for filing an answer on the part of the patentee.

The practice is to take out a summons for directions, nominally for hearing, whereby the respondent is compelled to appear; a patent may be revoked at this stage when a clear case is made out (o), but the usual course is for the judge to give directions as to the filing of an answer, and also as to interrogatories, inspection, discovery, etc., and the manner of trial, after which the petition stands adjourned.

Where the patentee or other person interested in the patent is out of the jurisdiction, notice must be given to such person that

(i) This occurred in *Re Deeley's Patent*; for report of the infringement action see *Westley Richards v. Perkes*, 10 P. O. R. 181, 382; for proceedings on application for leave to amend the patent, *Deeley's Patent*, 11 P. O. R. 72. The petition for revocation was heard in December, 1894, before Romer, J., in which judgment was given for the petitioner, 12 P. O. R. 65.

(k) 11 P. O. R. 657.

(l) *Goulard and Gibbs Patent*, Griff. P. C. 820; *Rothwell's Patent*, Griff. P. C. 820.

(m) *Bell & Coleman's Patent*, Griff. P. C. 820; *Martin's Patent*, Griff. P. C. 820; *Siddell's Patent*, Griff. P. C. 820; *Walling's Patent*, Griff. P. C. 820.

(n) *Martin's Patent*, Griff. P. C. 820.

(o) *Vaisey's Patent*, 11 P. O. R. 591.

the petition has been presented (*p*), as the Court will not decree the revocation of a patent without giving all interested parties an opportunity of being heard, but the mere fact that the patentee is out of the jurisdiction will not prevent the institution of proceedings for revocation (*q*).

A respondent residing out of the jurisdiction will not be ordered to give security for costs (*r*).

The practice as to particulars is precisely similar to that in an action for infringement. It will, however, be observed that the judge has no power of certifying under sect. 31 that the validity of the patent came in question, nor will a certificate granted in a previous action for infringement affect the question of costs in proceedings for revocation, the words of sect. 31 being "*in any subsequent action for infringement.*"

Section 100 of the Judicature Act defines "pleading" as including any *petition* or summons, and also as including the statements, in writing, of the claims or demand of any plaintiff, and of the defence of any defendant thereto, and of the reply of the plaintiff to any counter-claim of a defendant.

Order XXXI. r. 1 of the rules of the Supreme Court, gives power to the Court, or a judge, to permit interrogatories "*in any cause or matter,*" to be delivered by either party to the other. It is presumed that leave will be given to the respondent (called defendant in the Patent Act, 1883) to deliver interrogatories to the petitioner, and circumstances may arise when it would be just to permit the petitioner to examine the respondent. The rules as to interrogatories will be similar to those in an action for infringement.

Section 28, sub-sect. (1), provides that the mode of trial of a petition for revocation shall be similar to that of an action for infringement.

(*p*) *Drummond's Patent*, 6 P. O. R. 576; L. R., 43 Ch. D. 80; *La Compagnie Générale d'Eaux Minérales Trade Marks*, 8 P. O. R. 446; L. R., 1891, 3 Ch. 451; *F. King & Co.'s Trade Mark*, 9 P. O. R. 350; L. R., 1892, 2 Ch. 462; *Kay's Patent*, 11 P. O. R. 279.
 (*q*) *Ib.*
 (*r*) *La Société Anonyme Trade Mark*, 10 P. O. R. 290; *Miller's Patent*, 11 P. O. R. 55.

And the parties are entitled to have the petition heard as *videlicet* evidence (s).

The evidence which will be required of the respondent (defendant), in the first instance, will be very slight, and will be similar to that which he would give as to the validity of the patent were he plaintiff in an action for infringement. The petitioner will then have to prove the case he alleges in his petition and particulars, and the respondent has the right of reply. It is merely to preserve this right to reply, that the respondent is made practically plaintiff at the trial.

By virtue of section 19 of the Act of 1883, in a proceeding for revocation of a patent, the patentee may at any time by leave of the Court apply to amend his specification by disclaimer, consequently after a decision has been given in favour of the petitioner in the Court of First Instance, the patentee may, pending appeal, obtain leave of the Court of Appeal to apply at the patent office for leave to strike out any portion of his claim which the judgment of the Court below may have convinced him to be incapable of being supported. But after judgment has been given by the Court of Appeal revoking the patent their power to give leave under section 19 is gone, and in consequence, it is submitted that, although only one claim may have been held invalid, the patent is *ipso facto* revoked and can only be revived by a successful appeal to the House of Lords, who, as we have noticed above, have no jurisdiction to give leave to apply to amend, not being included in the term Court in section 19 of the Act of 1883.

(s) *Gaulard & Gibbs' Patent*, L. R., 34 Ch. D. 396; 56 L. J., Ch. 606; 56 L. T. 284.

CHAPTER XX.

ACTION TO RESTRAIN THREATS.

SECT. 32 of the Patents Act, 1883, provides, "*Where any person claiming to be the patentee of an invention, by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings, or liability in respect of any alleged manufacture, use, sale or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase, to which the threats related, was not in fact an infringement of any legal rights of the person making such threats: Provided that this section shall not apply if the person making such threats, with due diligence, commences and prosecutes an action for infringement of his patent.*"

Prior to the Act of 1883, the proprietor of a patent might issue threats of proceedings for infringement broadcast without rendering himself liable to account for any of the damage which he might occasion thereby, provided such threats were made *bonâ fide* (a), in such a case the only remedy open to an injured person was to apply for an injunction to restrain the patentee from continuing to threaten him, and in this he could only be successful after showing that the statements made were in fact untrue (b).

In the case of malicious threats an action for damages lay similar to that of slander of title, when the plaintiff would have to show that the threat made amounted to a "malicious attempt

(a) *Halsey v. Brotherhood*, L. R., 15 Ch. D. 514, 517; *Wren v. Weild*, L. R., 4 Q. B. 730.

(b) *Halsey v. Brotherhood*, L. R., 15 Ch. D. 520.

to injure the plaintiffs by asserting a claim of right against his own knowledge that it was without any foundation (o)."

The object of sect. 32 was to remedy the hardship we have described, namely that of a man whose business is paralysed by the threats of the proprietor of a patent, without any opportunity being afforded him of putting the question to the test, the section is addressed to the case "of a patentee who causes damage by disseminating threats which he dare not or will not justify by an action, who is willing to wound but yet afraid to strike (d)."

It is immaterial that the threat was made *bonâ fide*, the question to be considered is what the defendant said or did, and not what he intended, and if damage is occasioned by the circulation of a threat, it is no reply to an action to say that damage was not intended if the threatener does not bring himself within the shelter of the proviso at the end of the section (e).

"By circulars, advertisements, or otherwise:"—These words have been held to include any document whatever, which either actually or merely by implication contains a threat of legal proceedings (f), whether written by the defendant himself (g) or his solicitors (h), or in answer to an inquiry made by the plaintiffs (i); and the addition of the words "without prejudice" to the document containing the threat will not absolve the person threatening from liability (k); it would seem that the word "otherwise" includes verbal threats (l).

The publication of a general warning to the whole world such as, "I have a patent for such and such a machine, proceedings

(c) Per Blackburn, J., in *Wren v. Weild*, L. R., 4 Q. B., at p. 737; *Halsey v. Brotherhood*, L. R., 15 Ch. D. 519.

(d) Per North, J., in *Day v. Foster*, 7 P. O. R. 60; see also *Challender v. Royle*, L. R., 36 Ch. D. 439, 440; *Skinner v. Perry*, 10 P. O. R. 5, 6.

(e) *Day v. Foster*, 7 P. O. R. 58; *Skinner v. Perry*, 10 P. O. R. 8.

(f) *Skinner v. Perry*, 10 P. O. R. 1; also *Crampton v. Patents Investment Co.*, 5 P. O. R. 393.

(g) *Walker v. Clarke*, 4 P. O. R.

111; *Kensington, &c., Electric Lighting Co. v. Lane-Fox Co.*, 8 P. O. R. 277.

(h) *Driffield v. Waterloo, &c. Co.*, 3 P. O. R. 46; L. R., 31 Ch. D. 638; *Combined, &c. Co. v. Automatic, &c. Co.*, 6 P. O. R. 502; *Day v. Foster*, 7 P. O. R. 54, 59; *Johnson v. Edge*, 9 P. O. R. 142.

(i) *Skinner v. Perry*, 10 P. O. R. 1, 7; also *Challender v. Royle*, L. R., 36 Ch. D. 425.

(k) *Kurtz v. Spence*, 5 P. O. R. 161, 173.

(l) *Ungar v. Sugg*, 6 P. O. R. 337.

will be taken against any person who infringes it"—will not be actionable (*m*), but should such warning amount by implication to a suggestion that the manufactures of a certain person are infringements of the patent referred to, and be circulated in the trade to the detriment of such manufacturer, an action will lie under the 32nd section.

In *Challender v. Royle*, Bowen, L.J., said:—"Suppose that a manufacturer is making and issuing machines which the patentee considers to be infringements of his patent, and the patentee issued a threat really directed against the manufacture and sale of those machines, I do not think he could escape from the section by wording his notice in such terms that according to the letter it was only a general warning to all persons not to infringe his patent (*n*)."

In the same case the same Lord Justice in his judgment suggested that the language of sect. 32 would not apply to threats relating to future infringements. Commenting upon that portion of the Lord Justice's judgment in *Johnson v. Edge*, Lindley, L.J., said: "I should like to qualify that a little by saying that I think upon the true construction of this section, the section might apply to an intended infringement, provided that you could make out that the intended infringement, if carried out, would be an actual infringement (*o*)," and Kay, L.J., in the same case said: "I can easily conceive one case of future infringement which would come entirely within the mischief which this section was intended to provide against. For instance, take this case; suppose a man issued a circular saying: 'I have a patent for such and such an article, I understand that Messrs. A. & Co. have recently erected a large manufactory for the purpose of manufacturing articles which, when made, will be an infringement of my patent.' Can it be said that a case like that would not come within the mischief intended to be provided against by this section (*p*)?"

(*m*) *Johnson v. Edge*, 9 P. O. R. 149; also *Challender v. Royle*, L. R., 36 Ch. D. 441; *Ungar v. Sugg*, 8 P. O. R. 388.

(*n*) L. R., 36 Ch. D. 441; see also *Johnson v. Edge*, 9 P. O. R. 142, 148,

149; *The Fusee Vestal Co. v. Bryant & May*, 4 P. O. R. 191.

(*o*) 9 P. O. R., at p. 148.

(*p*) *Ib.*, at p. 149; see also *Kurtz v. Spence*, 5 P. O. R., at p. 171.

“Any person or persons aggrieved:”—The right of action under the section is not limited merely to the person threatened, but any person to whom damage is occasioned by the issue of the threats is entitled to relief; so where circulars were issued to the trade intimating that the articles manufactured and sold by the plaintiff were infringements of the defendants' patent and that proceedings would be taken against any person dealing with such articles, and in consequence injury was done to the plaintiff's business, it was held that the plaintiff was a person aggrieved and could maintain an action although no threats were made to him personally (*q*).

“If the alleged manufacture, &c. :”—In an action brought under this section the validity of the patent may be put in issue. In *Challender v. Royle*, Cotton, L.J., said: “In my opinion . . . the question whether the patent of the person making the threats is a valid patent must come into consideration if the plaintiff in the action seeks it, because I cannot see how, if a patent is invalid, there can be any act done in infringement of a legal right when the legal right depends only on the validity of that patent (*r*).”

To constitute a defence to an action under this section, not only must it be shown that the act complained of was an infringement of the patent in question, but also that it was an infringement of the legal rights of the defendant, that is to say, the defendant must be the legal owner of the patent and not merely possessed of a beneficial interest; so in *The Kensington, &c., Electric Light Co. v. Lane-Fox Co.* (*s*), where it appeared that an agreement had been entered into whereby the patentee had agreed to assign the patent alleged to have been infringed to the defendant company, but no assignment had in fact been executed, it was held that the defendants having only a beneficial interest in the patent, had no legal right in it capable of being infringed, and consequently the plaintiffs were entitled to judgment without

(*q*) *Kensington, &c. Electric Lighting Co. v. Lane-Fox Co.*, 8 P. O. R. 277, 279; see also *Walker v. Clarke*, 4 P. O. R. 111, 114; *Burt v. Morgan*, 4 P. O. R. 279, 280; *Johnson v. Edge*, 9 P. O. R. 142, 145.

(*r*) 4 P. O. R., at p. 371; L. R., 36 Ch. D., at p. 435; see also *Kurtz v. Spence*, 4 P. O. R. 427, 430; *Herrburger v. Squire*, 5 P. O. R. 581, 589.

(*s*) 8 P. O. R. 277.

entering into the consideration of the validity or invalidity of the patent.

The clause of section 32 now under consideration is a condition precedent to the right of the plaintiff to recover damages in respect of the threats complained of (*t*), consequently, *prima facie*, the burden of proof is on the shoulders of the plaintiff that what he has done is not an infringement of the defendant's patent. As to how far he must establish this will depend upon the facts of each particular case (*u*).

“Provided that this section shall not apply, &c. :”—In this proviso lies the most important part of the section, and many points arise in its consideration of considerable difficulty. It is proposed to deal with it first in detail, after which the effect of the proviso as a whole will be more easily understood. To take the last portion first, it is necessary that the person making such threats should commence and prosecute an action for infringement of his patent; it is not clearly provided against whom the action is to be brought, nor whether an action for a different form of an infringement from that complained of would be sufficient, and in the decided cases alone can an interpretation be found. As has been pointed out above, the beneficial owner of a patent cannot shelter himself under the saving clause; for similar reasons an action brought by the legal owner for infringement of his patent will not be such an action as to entitle the beneficial owner to the benefit of the proviso in an action in restraint of threats brought against him by alleged infringers (*x*). The action must be in respect of infringements which were alleged in the threats circulated by the patentee (*y*), and must be brought against some one of the persons threatened (*z*).

In *Day v. Foster* (*a*) the plaintiff, after threatening the defendant, who was a licensee under the plaintiff's patent, and also *Messrs. Barrett & Elers*, brought an action against the

(*t*) *Barney v. United Telephone Co.*,
2 P. O. R. 174.

(*u*) *Challender v. Royle*, 4 P. O. R.,
at p. 371.

(*x*) *Kensington, &c. Electric Light
Co. v. Lane-Fox Co.*, 8 P. O. R. 277.

(*y*) *Combined Weighing, &c. Co. v.*

Automatic, &c. Co., L. R., 42 Ch. D.,
at p. 670.

(*z*) *Challender v. Royle*, 4 P. O. R.,
at p. 373; L. R., 36 Ch. D. at p.
439.

(*a*) 7 P. O. R. 54.

defendant for infringement and royalties; he being a licensee, was unable to dispute the validity of the patent, and, consequently, *Messrs. Barrett & Elers* were anxious to be joined as co-defendants to the action. This being refused by the plaintiff, they instituted proceedings under section 32. North, J., held that the action of *Day v. Foster* was an action for infringement within the meaning of the proviso, and in accordance with the interpretation laid down by Cotton, L.J., in *Challender v. Royle* (*supra*): "That in order to bring the case within the proviso the action must be an honest action, honestly brought in order to test the validity of the patent, or the fact of infringement, whichever may be in question;" and in consequence held that the action was vexatious, and directed that all further proceedings in it should be stayed.

As is pointed out in the judgment of Cotton, L.J., quoted above, the action must be brought *bonâ fide* (*b*), and the onus of proof rests on the other party to show that the action was not in fact an honest one (*c*).

"With due diligence commences and prosecutes."—In considering whether such an action is brought with due diligence, the time of issuing the threats, and not the time when the party bringing the action first knew of the acts which he alleges to be infringements, is the period to be looked at (*d*), and it is immaterial whether the action is brought before or after the commencement of the threats action (*e*).

Where threats of proceedings were made by the patentee to another for the space of three years, after which continuous negotiations took place between the parties and further complaints made, it was held that an action for infringement brought on the termination of those negotiations by the patentee disclosed no lack of due diligence (*f*).

The section does not require that the action should be prose-

(*b*) *Challender v. Royle*, L. R., 38 Ch. D. 438, 439; 4 P. O. R. 373, 375; *Day v. Foster*, 7 P. O. R. 60; *Colley v. Hart*, 7 P. O. R. 112.

(*c*) *Colley v. Hart*, 7 P. O. R. 112.

(*d*) *Challender v. Royle*, L. R., 38 Ch. D. 425, 437; *Day v. Foster*, 7

P. O. R. 60.

(*e*) *Combined Weighing-Machine Co. v. Automatic, &c. Co.*, 6 P. O. R. 502; *Challender v. Royle*, *supra*.

(*f*) *Edlin v. Pneumatic Tyre, &c. Agency*, 10 P. O. R. 311.

ented to a successful termination, the bona fide institution of proceedings for infringement being held to be sufficient.

In *Colley v. Hart* (g) the facts were as follows: On the 15th September, 1888, the defendant issued a circular, threatening proceedings against the plaintiff, amongst others. On the 22nd of the same month the plaintiff commenced an action to restrain the threats of the defendant; on the 6th December the defendant commenced an action for infringement against the plaintiff, and delivered particulars of infringement in February in the following year, and on the 13th May delivered his statement of claim. On the 7th of November, after the close of the pleadings, but before trial, the defendant abandoned his action for infringement. It was held that this action had been prosecuted with due diligence within the meaning of the proviso in section 32. In his judgment, North, J., said: "Under those circumstances, of course, he is exactly in the same position by discontinuing a hopeless action before trial as he would have been in if he had prosecuted it to trial, and had then failed. As failure at the trial would not have prevented the action being one within the proviso, so, in my opinion, the discontinuance before trial does not put him in a worse position than if he had carried it to trial" (h).

In *The English and American Machinery Co. v. The Gare Machine Co.* (i) the facts were very similar to those in *Colley v. Hart* (supra), but in this case the defendants abandoned their infringement action before delivering their reply. It was held by Chitty, J., approving of the decision of North, J., in the earlier case, and upon the same grounds, that due diligence had been exercised in the prosecution of the action for infringement.

It is difficult to say how far the above reasoning might be carried, whether the mere serving of a writ would be held to amount to prosecuting with due diligence, or is it necessary to deliver a statement of claim? No doubt the circumstances of the case must be the guide. As has been pointed out above, bona fides is required, and if that is shown to be absent, no action would be sufficient; but if, on the other hand, the Court considers that the person making the threats did commence his action

(g) 7 P. O. R. 101.

(i) 11 P. O. R. 627.

(h) At p 111.

bonâ fide, and with due diligence, a very slight amount of prosecution, probably, would take the case out of the operation of the section (k).

But where the defendant showed great delay in taking proceedings for infringement, in accordance with his threats, and, further, it appeared that he only took such proceedings in order to escape from the liability to which he had exposed himself by reason of those threats, it was held that such proceedings were not sufficient to satisfy the proviso (l).

If an action to restrain threats has been commenced and stayed pending an action for infringement, and the action for infringement is not prosecuted with due diligence, an injunction will be granted upon the first action, and the stay removed (m).

In *The Fusee Vesta Co. v. Bryant & May* (n) the action, which was one for infringement of the plaintiff's patent, was stayed, pending the amendment by the plaintiffs of their specification; during the stay, and prior to amendment, the plaintiffs circulated post-cards among the customers of the defendants, threatening legal proceedings. On a motion by the defendants for an injunction to restrain such threats, Kay, J., granted the injunction applied for to extend to the trial of the action, or further order, the plaintiffs to pay the costs of the motion.

The effect of commencing and prosecuting an action for infringement with due diligence is to nullify the whole of the section, that is to say, its provisions cease to apply, and the rights of the person threatened are confined to those which existed prior to the Act of 1883 (o). What those rights were has already been indicated at the commencement of the present chapter; there it was pointed out that damages could only be recovered when the threats were malicious, but since the action to satisfy the proviso must be a bonâ fide one, and, in fact, it has been suggested that that action was required as a sort of test

(k) But see *Crampton v. Patents Investment Co.*, 5 P. O. R. 382, 393.

(l) *Johnson v. Edge*, 9 P. O. R. 142, 146; see also *Herrburger v. Squire*, 5 P. O. R. 581, 594.

(m) *Household v. Fairburn*, 2 P.

O. R. 140, 142.

(n) 4 P. O. R. 191.

(o) *Combined Weighing, &c. Co. v. Automatic, &c. Co.*, L. R., 42 Ch. D. 665; *Colley v. Hart*, 7 P. O. R. 101; *Day v. Foster*, 7 P. O. R. 60.

whether the threats were bonâ fide or not (*p*), it would be practically impossible to recover damages upon the plea that the threats were in fact malicious. The result is that in such a case the only course open to persons threatened, where the action for infringement has been dropped, as in *Colley v. Hart* (*supra*), and the question of infringement never tested in the Court, is to apply for an injunction to restrain the further issue of threats, but it is doubtful whether such an injunction would be granted under the circumstances, since, it being presumed that the threats were bonâ fide, the abandonment of the proceedings for infringement would imply, of necessity, that those threats would not be continued, and it has already been pointed out (*q*) that injunctions are only granted where there is a probability of the continuance of the acts complained of. Moreover, in the event of the renewal of the threats, the right of action under section 32 would be at once revived.

Where an action for infringement has been commenced after the institution of proceedings under section 32, the proper course for the parties in the latter action to pursue was indicated by Kekewich, J. (*r*). The patentee should take steps to get rid of the threats action, or to put a stay upon it, so that no unnecessary cost should be incurred, and in that case, where it appeared that the patentees had insisted upon having the threats action set down for trial and disposed of, the learned Judge, at the close of his judgment, said: "If I could with propriety make them (the patentees) pay the costs, I should be disposed to do so. I cannot do that. I dismiss the action, but I certainly shall dismiss it without costs."

The effect of section 32, taken as a whole, is not to deprive a patentee of the power, or it may be termed the duty (*s*), of warning infringers before rushing into litigation, but it does limit that power to one class of patentees, that is to say, only a man who is in possession of a patent which he is willing and

(*p*) *Challender v. Royle*, L. R., 36 Ch. D., at p. 439.

(*q*) Chap. XVIII.; see also *Sugg v. Bray*, 2 P. O. R., at p. 246.

(*r*) *Combined Weighing, &c. Co. v.*

Automatic, &c., Co., L. R., 42 Ch. D. 665.

(*s*) Per Jessel, M.R., in *Halsey v. Brotherhood*, L. R., 15 Ch. D., at p.

517.

intends to support in a Court of Law may threaten others with legal proceedings in respect of it. A. may be infringing through ignorance, B. through design, but both possibly would desist on receipt of a warning. But when an alleged infringer shows that, in spite of the warnings, he has no intention of desisting from the acts complained of, the patentee must put his threat into execution, by which means alone can he escape liability under the provisions of this section.

In *Challender v. Royle* (t), upon the subject of an interlocutory injunction to restrain threats, Cotton, L.J., said: "I think, however, that before going to the proviso I ought, having regard to the judgment of the Vice-Chancellor, to state my opinion as to how the matter ought to be dealt with in an interlocutory application. As far as I understand the Vice-Chancellor, he seems to have considered that he could not enter, or that he need not enter, at this stage of the cause into the question whether the sale of the plaintiffs' tap-unions was an infringement of the defendant's patent, or whether that patent was a valid patent, and that all he need consider was the balance of convenience and inconvenience as between these parties in granting or refusing the interlocutory injunction. I must express my dissent from that view. It is very true that in all cases of interlocutory injunction the Court does consider and ought to consider the balance of convenience and inconvenience in granting or refusing the injunction. But there is another and very material question to be considered—has the plaintiff made out a *prima facie* case? That is to say, if the evidence remains as it is, is it probable that at the hearing of the action he will get a decree in his favour? Therefore, though I quite agree that the Court ought not on an interlocutory injunction to attempt finally to decide the question whether the act complained of is an infringement, or (if the question of the validity of the patent is raised) whether the patent is a valid one or not, yet in my opinion it ought to be satisfied that on one or both of these two points the plaintiff in the action has made out a *prima facie* case, and unless the Court is so satisfied it would be wrong to grant an

(t) L. R., 36 Ch. D., at p. 435; see also *Walker v. Clarke*, 4 P. O. R. 111.

injunction merely on the ground that it cannot do the defendant any harm."

Where there was a conflict of testimony as to the fact of infringement, the Court refused to grant an interlocutory injunction (u).

In *Colley v. Hart* (x), which was a motion for an interlocutory injunction to restrain threats, North, J., said: "When there is a doubt whether the thing does infringe what he calls his rights or not, the fact that the defendant refrains from bringing an action to assert his rights is a fact I cannot leave out of consideration in forming an opinion as to whether he has such rights or not."

The question of damages generally has already been discussed in an earlier chapter.

The defendant in an action under this section is entitled to particulars of the threats upon which the plaintiff relies (y), and if the validity of the patent is put in question the general rules relating to particulars of objections will apply (z). Those rules will be considered in detail hereafter.

Where there was a doubt upon which patents the defendants had based their threats, the Court ordered that the defendants should deliver to the plaintiffs a list of such patents (a).

And where the plaintiffs alleged that the threats were made by the defendants' agents, it was held that the defendants were entitled to particulars of the names of those agents (b).

(u) *Barney v. United Telephone Co.*, 2 P. O. R. 173.

(x) 6 P. O. R., at p. 21.

(y) *Law v. Ashworth*, 7 P. O. R. 86.

(z) *Union Electrical Power Co. v. Electrical Power Storage Co.*, 5 P. O. R. 329; *Law v. Ashworth*, 7 P. O. R.

86.

(a) *Union Electrical Power Co. v. Electrical Storage Co.*, 5 P. O. R. 329.

(b) *Taylor v. The Drosophore Co.*, 11 P. O. R. 536.

CHAPTER XXI.

PRACTICE IN AN ACTION FOR INFRINGEMENT.

AN action for infringement is commenced by writ issued out of the High Court of Justice.

Subject to the special provisions of the Patents, &c., Acts, the rules of the Supreme Court apply to actions for infringement of patents and petitions for revocation (a).

The writ may be endorsed merely for damages for infringement, or for an account of sales and profits, and it may be endorsed for an injunction claiming that the defendant may be restrained from continuing to infringe the patent, and for a mandatory order that the defendant may be ordered to deliver up to the plaintiff the articles made in infringement of the patent which are in his custody or power, or in the custody or power of his servants or agents, so that they may be broken up or destroyed (c). The plaintiff may not claim both an account of sales and profits and damages for infringement; the two claims being inconsistent, since, if an account is taken, the infringement is condoned (d).

Service of a writ in Scotland for an infringement in England will be allowed (e).

STATEMENT OF CLAIM.

The Rules of Court of 1883 have rendered the form of pleadings of less importance than hitherto. Ord. XIX. rule 26,

(a) *Haddan's Patent*, 54 L. J., Ch. 126; Griffin, P. C. 108.

(c) Form, p. 470. See *Tangye v. Stott*, 14 W. R. 386; *Betts v. De Vitre*, 34 L. J., Ch. 289.

(d) Per Lord Westbury in *Neilson v. Betts*, L. R., 5 H. L. 1. See also

De Vitre v. Betts, L. R., 6 H. L. 321; *Needham v. Oxley*, 11 W. R. 852

But see *Hills v. Evans*, 4 De G. F. & J. 288.

(e) *Speckhart v. Campbell, Achnach & Co.*, Solicitors' Journal, Feb. 2, 1884.

provides: "No technical objection shall be raised to any pleading on the ground of any alleged want of form;" but by rule 27 the power of the Court to strike out pleadings on the grounds that they are unnecessary, scandalous, or embarrassing, is preserved.

Ord. XIX. rule 4, requires all material facts to be pleaded, and prohibits the pleading of evidence. Rule 5 is as follows:—"The forms in Appendices (C., D., and E.), when applicable, and where they are not applicable forms of the like character, as near as may be, shall be used for all pleadings, and where such forms are applicable and sufficient, any longer forms shall be deemed prolix, and the costs occasioned by such prolixity shall be disallowed to or borne by the party so using the same, as the case may be."

The forms mentioned relate to pleadings in an action for the infringement of a patent, but there is no provision made for the case where infringement has only been threatened, nor for the case when a mandatory order or an account of sales and profits is required (*f*).

It will be observed that the statement of claim in patent cases, which is rendered obligatory by Ord. XIX. rule 5, contains no allegation as to the matters going to constitute the validity of the patent, nor does it give the date, time or place of the infringement; but it refers to the particulars of breaches which are delivered "herewith."

PARTICULARS OF BREACHES.

Particulars of breaches were required to be delivered in every action for the infringement of a patent by sect. 41 of the Patent Law Amendment Act, 1852; and now by sect. 29 (1) of the Act of 1883, it is provided:—"In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or the judge at any subsequent time, particulars of the breaches complained of; (4) at the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement, or objection of which particulars are not so

(*f*) See Form, p. 476, et seq.

delivered; (b) particulars delivered may be from time to time amended by leave of the Court or a judge."

Particulars of breaches are particulars of the times, places, occasions, and manner in which the plaintiff says the defendant has infringed his letters patent. The defendant must have full, fair, and distinct notice of the case to be made against him (g). In *Batley v. Kynock* (h), Sir James Bacon, V.-C., said: "All that is required and provided by the Patent Law Amendment Act, 1852, which has made no alteration in the practice to be observed in these cases, is that the defendants shall not be taken by surprise, and it is the duty of the judge to take care that by the particulars of breaches they shall have full and fair notice of the case that they will have to meet."

It had undoubtedly prior to the passing of the Patent Law Amendment Act, 1852, been the practice of the Courts to compel plaintiffs to give particulars of breaches, and the cases which were then decided as to the sufficiency of particulars are applicable now; for then, as now, the object was that the defendant should be warned with reasonable certainty of the case that was to be made against him.

The plaintiff cannot be required to place a construction upon his patent in his particulars of breaches (i).

The requirements of particulars of objections differ materially from those of particulars of breaches. In the case of objections taken by the defendant to the plaintiff's patent, it is essential that each objection should be set out in detail and that the defendant should be tied down to the particular instances of anticipation which he discloses in those particulars, since the objections to be taken by the defendant at the trial cannot otherwise lie within the plaintiff's knowledge, whereas in the case of particulars of breaches, to use the words of Bristowe, V.-C. (k): "You must always bear this in mind, that the plaintiff,

(g) *Needham v. Oxley*, 1 H. & M. 248; *Mandleberg v. Morley*, 10 P. O. R. 256.

(h) L. R., 19 Eq. at p. 231.

(i) *Wenham Co. v. Champion Gas Co.*, 8 P. O. R. 22.

(k) *Cheetham v. Oldham*, 5 P. O. R. at p. 626; see also *Talbot v. La Roche*, 15 C. B., at p. 321; *Ledgard v. Bull*, L. R., 11 App. Cas. 648; *Haslam v. Hall*, 4 P. O. R. 206.

asserting his patent, knows what he claims, and he says, I tell the public according to that which I am bound to do by the specification that which I do claim;’ and the defendant well knows, or the defendants, as in this case, perfectly well know what they are doing.” Consequently to fulfil the object for which such particulars are required, it is only necessary for the plaintiff to indicate what patent or portions of what patent he relies upon, and in what way he considers the defendant to have infringed, and if these two points be made clear without adducing specific instances, that will be sufficient (l).

When the patent consists of two or more processes, or distinct and separable inventions, particulars of breaches should distinguish which of the processes it is alleged has been infringed (m), and should particularly indicate what parts of the defendant’s machine or manufactured article are claimed to constitute an infringement (n); but when the process was one entire invention, the Court declined to compel the plaintiff to point out the particular parts of the specification which were alleged to be infringed. Jervis, C.J., said: “If the two processes described in the specification are wholly distinct from each other, and the defendant’s process may be an infringement of the one and not of the other, he ought to have better particulars; but if the whole is substantially one process, he is not entitled to them. . . . We must not make the particulars more complicated than the specification (o).”

As a general rule it is not necessary to state the lines in the letterpress of the specification upon which the plaintiff relies, an indication of the claims being all that is required. In *Church v. Wilson*, Grove, J., said (p): “It seems to me that the plaintiffs

(l) *Talbot v. La Roche*, 15 C. B. 310; *Needham v. Oxley*, 1 H. & M. 248; *Ledgard v. Bull*, L. R., 11 App. Cas. 648; *Egleton v. Nichols*, 7 P. O. R. 423.

(m) *Church v. Wilson*, 3 P. O. R. 123; *Haslam v. Hall*, 4 P. O. R. 208; *Cheetham v. Oldham*, 5 P. O. R., at p. 628.

(n) *Lamb v. Nottingham Manufac-*

turers’ Co., Seton, 4th Ed. 349.

(o) *Talbot v. La Roche*, 15 C. B. 310; see also *The Electric Telegraph Co. v. Nott*, 4 C. B. 462; *Tilghman’s, &c. v. Wright*, Griff., P. C. 216; 1 P. O. R. 103; *Egleton v. Nichols*, 7 P. O. R. 423.

(p) 3 P. O. R., at p. 127; see also *Cheetham v. Oldham*, 5 P. O. R., at p. 627.

have given more information indeed than is necessary; and merely to evolve the information in some other form of words, or to mark the parts of the specification of which they complain, when there are claims, seems to me quite unnecessary. What it might be where the machines are not given or where the specification has no specific claims, but only a description of the invention and a general claim of novelty, is a very different thing (*q*)."

Where the plaintiff's patent is of a simple nature, such for instance as the manufacture of a particular form of cartridge, and the articles made by the defendants must be infringements in every respect or not at all, it has been held sufficient to give one or two specific instances to denote the type of infringement complained of coupled with general words, so as not to confine the plaintiff to those particular instances at the trial of the action (*r*); but general words will not be allowed should they tend to embarrass the defendant (*s*).

Further particulars of breaches will sometimes be postponed to discovery on the ground that the defendant knows the breaches which he has committed better than the plaintiff (*t*).

In *Elsay v. Butler* (*u*), an action for infringement of a patent for "improvements in the manufacture of lace, in twist lace machinery, and in apparatus employed therein," the following particulars of breaches were held by Pearson, J., to be sufficient:—"The defendant has infringed by the production in a twist lace machine, or in twist lace machines, of lace fabrics in the manner described in the specification of the said patent, page 3, line 22 to page 9, line 39, or in a manner only colourably differing therefrom; and by the use of the improved combination of apparatus therein described, and also in particular by the production in a twist lace machine, or in twist lace machines, of fabric known as 'Double tie Swiss Net' in the manner described in the specification of the said patent, page 6, line 57 to page 7,

(*q*) Note *Lamb v. Nottingham Manufacturers' Co.*, Seton, 4th Ed. 349.

(*r*) *Talbot v. La Roche*, 15 C. B. 310; *Batley v. Kynock*, L. R., 19 Eq. 229; *Tilghman v. Wright*, 1 P. O. R. 103.

(*s*) *The Patent Type Foundry Co. v. Richard*, 2 L. T., N. S. 359; *Church v. Wilson*, 3 P. O. R. 123.

(*t*) *Russell v. Hatfield*, Griff. P. C. 204; 2 P. O. R. 144.

(*u*) Griff. P. C. 96.

line 38, or in a manner only colourably differing therefrom, and by the use of the improved combination of apparatus therein described."

Where an action is brought against the vendor of articles alleged to have been made by a process which infringed the plaintiffs' patent, a greater degree of precision is required in the particulars of breaches than if the defendant was the manufacturer himself.

In *Mandleberg v. Morley* (x), Stirling, J., said (y) : " Now if a manufacturer is attacked for infringing a patent by a particular process he does not want to be told in the shape of particulars, or otherwise, what the process is he is using. He knows what the process he is using is. But it is a very different thing with respect to a vendor. The vendor does not know with certainty what process is being used by the person from whom he himself buys, and who manufactures the article."

In that case the particulars of breaches alleged that : " The plaintiffs complain that each of the said letters patent of the plaintiffs have been infringed by the sale and exposure for sale by the defendants of each of the said garments, known as ' The Champion,' and ' The Distingué,' and by the sale and exposure for sale of other waterproof garments made by the manufacturers of ' The Champion,' ' The Distingué,' and ' The Tropical Odourless,' but not bearing their distinguishing names, but which unnamed garments are manufactured by similar processes to the three named garments." It was held that the reference to unnamed garments was not sufficiently specific, as it was not clear that the unnamed garments referred to were substantially the same as those which were specifically mentioned.

If the particulars delivered are too general, the defendant should apply for further and better particulars.

If at the trial evidence is tendered which comes within the literal meaning of the particulars it will be admitted, notwithstanding that the particulars are too general, as the defendant should have objected to the particulars, and not have waited until the trial to take his objection (z).

(x) 10 P. O. R. 256.

(y) At p. 260.

(z) *Hull v. Bollard*, 25 L. J., Ex. 304.

The plaintiff having delivered particulars of breaches specifying certain sales by the defendant of rollers, and in particular to Shaw and Smith, the defendant, in answer to interrogatories, admitted sales to Hirst. Fry, J., in giving judgment, said: "In this case I think I must admit the evidence tendered in respect of Hirst's case. It is said that in respect of those cases which are not mentioned by name in the particulars of breaches, the plaintiff cannot give evidence. It may be that the particulars were not sufficient, or tended to embarrass. But the defendant did not apply for amended particulars, according to the case of *Hull v. Bollard*. It appears to me I have to inquire what is the meaning of the particulars. I find the case of Hirst is within the literal meaning of the particulars. If I had found that the case of Hirst was likely to create surprise, or likely to introduce any point not raised by *Smith's* or *Shaw's* case, I should probably have given an opportunity to the defendant to bring fresh evidence. I have asked whether there is any witness not here whom the defendants would desire to bring in respect of Hirst's case, and have received no satisfactory answer on that point, and must assume there is no such witness" (a).

Conversely where the particulars of breaches complained only of infringement by user, the Court refused to enter into the question as to whether there had been infringement by manufacturing the articles complained of (b).

Particulars of breaches, as we have seen, may also be ordered in actions which are not strictly actions for the infringement of patents; this is done under the ordinary jurisdiction of the Court (c). In an action charging that the defendant falsely and maliciously wrote and told persons who had bought certain machines of the plaintiffs that the machines were infringements of his, the defendant's patents, the defendant having pleaded not guilty, the court ordered the defendant to deliver particulars, showing in what part the plaintiffs' machines were an infringement of the defendant's patents, and pointing out by reference to the page and line of the defendant's specifications, which part

(a) *Sykes v. Howarth*, L. R., 12 Ch. 421, 427.

D. 826.

(c) *Perry v. Mitchell*, 1 Web. P. O.

(b) *Henser v. Hardie*, 11 P. O. R. 269.

of the inventions therein described he alleged to have been infringed (*d*).

STATEMENT OF DEFENCE.

The statement of defence in patent actions is now, under the rules of the Supreme Court, 1883, a very brief and concise document, giving no particulars or details whatever, and remitting the plaintiff to the particulars of objections and the answers to the interrogatories for information as to the case which is to be made against him. Under Order XIX. rule 5, the form given in Appendix (D.), sect. VI., is rendered obligatory. That form merely gives headings of defence which is all that is to be allowed; for instance:—“(1) That the defendant did not infringe the patent; (2) The invention was not new; (3) The plaintiff was not the first and true inventor; (4) The invention was not useful; (5) The patent was not assigned to the plaintiff.” And to these might be added:—That the title did not disclose the nature of the invention (*e*); that the title, the provisional specification, and the complete specification, or any two of them, did not substantially refer to the same invention (*f*); that the specification was not sufficient (*g*); that the claim in the specification was not sufficient to distinguish what was new from what was old (*h*); that the patent was obtained in fraud of the defendant, as, for instance, when a person employed to carry out or assist in experiments, applies for letters patent himself, or where the patentee has obtained the invention from the confidence of the defendant.

It will be observed that any one of these defences will be sufficient to constitute a complete defence to an action; and that the greater portion of them are of a nature to require elaborate and costly evidence to prove or disprove them. Too much care cannot, therefore, be taken in preparing a statement of defence to avoid setting up defences which it is not expected will be satisfactorily proved at the trial, regard being had to the provisions of the rules of 1883 as to costs; otherwise, even if the

(*d*) *Wren v. Weild*, L. R., 4 Q. B. 213.

(*e*) *Ante*, p. 78, *et seq.*

(*f*) *Ante*, p. 84, *et seq.*

(*g*) *Ante*, p. 106, *et seq.*

(*h*) *Ante*, p. 116, *et seq.*

defendant succeeds in the action, he may be mulcted in heavy costs to the other side.

The defence that the plaintiff was not the first and true inventor should not be set up unless it is intended to prove that somebody else was the inventor, as the issue that the invention was not new, and in consequence that it was not invented by the plaintiff, should be raised under the other headings of defence (i).

A statement of defence alleged that if the specification were construed so as to make the defendant an infringer, the claims of invention would be bad for want of novelty, as including matters described in certain specifications (stating them). North, J., refused to strike out par. 2 under Order XIX. rule 27; the Court of appeal dismissed the appeal with costs (k).

A statement of defence admitted infringement in ten instances and no more, the plaintiffs elected to move for judgment upon such admissions; held that they were entitled to an enquiry as to damages as to these ten instances of infringement and no more, and that all evidence as to any other instances of infringement alleged to have been committed by the defendant must be excluded (l).

Where the defendants in an action for infringement have been indemnified by another person or company, such other person or company may be joined as a third party under Order XVI. rule 48, of the rules of the Supreme Court (m).

PARTICULARS OF OBJECTIONS.

Section 29, sub-sect. (2) of the Act of 1883, provides :—“ *The defendant must deliver with his statement of defence, or by order of the Court, or a judge at any subsequent time, particulars of any objections on which he relies in support thereof; (3) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it; and*

(i) *Morgan v. Windover*, 7 P. O. R. 449; *Thomson v. Macdonald*, 8 P. O. R. 9.

(k) *Hocking v. Hocking*, Griff. P. C. 129; 3 P. O. R. 291.

(l) *United Telephone Co. v. Donohoe*, L. R., 31 Ch. D. 399.

(m) *Edison v. Holland*, L. R., 33 Ch. D. 497.

if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him; (4) At the hearing, no evidence shall, except by leave of the Court, or a judge, be admitted in proof of any alleged infringement or objection, of which particulars are not so delivered; (5) Particulars delivered may be from time to time amended, by leave of the Court, or a judge."

Order XIX. rule 6, of the Rules of the Supreme Court, 1883, provides: "In all cases in which the party pleading relies on any misrepresentation, fraud, breach of trust, wilful default, or undue influence, and in all other cases in which particulars may be necessary beyond such as are exemplified in the forms aforesaid, particulars (with dates and items if necessary) shall be stated in the pleading: provided that if the particulars be of debt, expenses, or damages, and exceed three folios, the fact must be so stated, and a reference to full particulars already delivered or to be delivered with the pleading."

It is not easy to reconcile the practice under this rule with the language of the 29th sect. of the Patent Act, or, indeed, with the form of defence given in the form to the rules quoted above. Order XIX. rule 6, provides that particulars shall be incorporated with the pleading; on the other hand, the form and the Patent Act seem to indicate a separate document. Hitherto the practice has been to deliver a separate document, and it is apprehended that when the balance of convenience is considered the Courts will hold that in respect of a patent action the practice has remained unchanged.

Where it was a condition precedent to an agreement to assign letters patent, that the assignee should first satisfy himself as to the validity of the patent, in an action brought for specific performance of this agreement, and resisted by the assignee on the ground of his right under the condition precedent, it was held that the validity of the patent was at issue and that the plaintiff was entitled to particulars of objections (n).

It is not necessary for every one of two or more defendants defending in the same interest to deliver particulars of objections (o).

(n) *Hazlehurst v. Rylands*, 9 P. O. Cas. 249, reversing L. R., 26 Ch. D. R. 1. 700.

(o) *Smith v. Cropper*, L. R., 10 App.

Any of the objections which we have discussed in previous chapters may be taken in order to upset a patent, but the particulars must set out those objections in such terms that the plaintiff may be informed what case he will have to meet at the trial of the action.

When the objection is, that the grantee was not the true inventor, the Court will not require the defendant to say who was the true inventor (*p*). The fact upon which the objection is based, is the want of consideration, not the fact of some one having performed the invention before. The performance of the invention by some one else before the patent would not, of necessity, invalidate the patent. As, for instance, if it were done in secret; but if the invention was communicated to the grantee, the patent would be void for want of consideration. Now the foundation of the objection is, the fact of that communication, and the knowledge of this, and the time and place of it, might be within the patentee's knowledge only, and might not be extracted from him until in the witness box.

The objection that the specification is insufficient is enough without explaining in what way it is insufficient (*q*). A litigant could scarcely be required to argue his case on paper before he went into Court, and the sufficiency or insufficiency of a specification is to a great extent a matter of mere argument.

In *Jones v. Berger* (*r*), it was held that objections that the specification "did not sufficiently distinguish between what was old and what was new," and that the inventor "did not disclose the most beneficial method with which he was then acquainted of practising his said invention," were sufficient.

In *Heathfield v. Greenway* (*s*), the following objections, viz.: "That the specification does not sufficiently describe and ascertain the nature of the invention, and the manner in which the same is to be performed;" and, "That the said specification is ambiguous and framed in a manner calculated to mislead;" were held to be too vague.

(*p*) *Russell v. Ledsam*, 11 M. & W. 647. But see *Jones v. Berger*, 5 M. & G. 208; 1 Web. P. C. 544; *Morgan v. Windover*, 7 P. O. R. 449; *Thomson*

v. Macdonald, 8 P. O. R. 9.

(*q*) *Heath v. Unwin*, 10 M. & W. 687.

(*r*) 5 M. & G. 208.

(*s*) 11 P. O. R. 17.

When the objection is on the ground of want of conformity between the provisional and complete specification, "the defendant ought to give such particulars as would inform the plaintiffs of the nature and scope of this objection of nonconformity. This does not mean that the defendants must furnish the plaintiffs with the heads of what the defendants' argument will be at the trial, but only such information as the plaintiffs may reasonably require in order to know precisely the nature of the case that will be raised against them. Each case must depend on its own circumstances." Per Cotton, L. J. (*t*), C. A. And when the objection is the insufficiency of the specification, the defendant must condescend to particulars of insufficiency (*u*).

We have seen that Ord. XIX. rule 6, requires particulars in case of fraud to be delivered with the statement of defence.

Fraud is a valid objection to a patent. The practice of the Court is to require accurate and detailed particulars of any fraudulent acts alleged. The species of "fraud, covin, or misrepresentation" should be given (*x*).

The objection to a patent which is generally relied upon is want of novelty, either on the ground of prior user, prior publication, or common knowledge.

Prior user.—The objection on the ground of prior user must state the time and place when such user occurred; but it will be observed that the persons by whom used is not mentioned in sub-sect. (3). The Act, however, does not direct that such particulars shall not be required. The Patent Law Amendment Act, 1852, sect. 41, required that the place of prior user should be given, and was silent as to times or persons. Notwithstanding this, in *Palmer v. Cooper* (*y*), Baron Alderson went even further than to require the names of the persons who had used the invention, and the present addresses of such persons were ordered to be given, "As otherwise the plaintiff would not know

(*t*) *Anglo - American Brush Light Corporation v. Crompton*, L. R. 34 Ch. D. 152; 56 L. J., Ch. 167; 4 P. O. R. 27.

(*u*) *Crompton v. Anglo - American Brush Light Corporation*, L. R., 35 Ch. D. 283; 56 L. J., Ch. 802; 57

L. T. 291; 4 P. O. R. 197.

(*x*) *Russell v. Ledsam*, 11 M. & W. 647.

(*y*) 9 Ex. 231; see also *Bulnois v. Mackenzie*, 4 Bing. N. C. 132; *Galloway v. Bleadon*, 1 Web. P. C. 268 (*n*).

where to go for his evidence." The object of particulars is, in the words of Tindal, C.J. (z), "Not, indeed, to limit the defence, but to limit the expense of the parties, and more particularly to prevent the patentee from being upset by some unexpected turn of the evidence. Under the fifth section (5 & 6 Will. 4, c. 83), therefore, it was intended that the defendant should give an honest statement of the objections on which he means to rely." In *Palmer v. Cooper* (*supra*), Parke, B., said: "The defendant's particulars ought to give the plaintiff such information as will enable him to make the necessary inquiries at the place named."

It will be evident, therefore, that there are cases where to omit giving the names and addresses of the persons who are alleged to have anticipated the invention would be to supply the plaintiff with objections which would be practically useless.

There are cases where the names and addresses have been refused. In *Carpenter v. Walker* (a), the objections stated that the invention had been used by "the defendant and divers persons." It was refused to order the defendant either to give the names and addresses of the "divers persons," or to have those words struck out.

It may be argued that the reason of such refusal was that a disclosure was required of the witnesses and case of the defendant. It is obvious that, although it is a recognized principle that one litigant shall not be permitted to inquire as to what witnesses the other is about to call at the trial, still that by far the more important principle is that neither party should be taken by surprise, and that the plaintiff should have a fair opportunity of critically examining every alleged anticipation which may be attempted to be established against him.

It does not of necessity follow that persons who have anticipated the invention should be the only and necessary witnesses of such anticipation. On the whole, therefore, it is submitted that names and addresses of such persons should be given in particulars of objections.

General words are inadmissible in particulars; for instance,

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

(a) 1 Web. P. C. 268 (n.).

expressions such as "and divors other pooplo" (*b*), and "Inter alia at Sheffield, Birmingham, and London" (*c*). But in *Bentley v. Keighley* (*d*), Mr. Justice Maule, under special circumstances, allowed the words "and others" to be sufficient.

In *Flower v. Lloyd* (*e*), Field, J., said: "I cannot follow the cases which have been cited; we have advanced in our ideas since they were decided (*f*). If the defendants know that their processes have been used by other persons in London and Birmingham, besides those specified, they must know the persons by whom they have been used, and must give more specific information. I do not say that they need give the name and address of every such person, but they must give fair information. If they can give no further information, the words in question are useless, and too indefinite, and must be struck out."

In *Boyd v. Farrar* (*g*), the allegation of prior user "by articles made according to the supposed invention, being publicly exhibited in use by Messrs. J. H. & S., at their works," was held too general, so in *Siemens v. Karo* (*h*), "by the general use of the Wenham regenerative gas lamp for several years prior to the patent," did not sufficiently particularize any variety of lamp, it is not necessary to refer to any particular article, but the defendant should specify the kind of article referred to in express terms, so that there may be no doubt what it is that he alleges to be an anticipation of the plaintiff's patent (*i*).

The time at which the alleged prior user took place should be clearly defined, a general statement that the user continued from 1832 to 1862 was held in 1890 to be too general, and it was ordered that further particulars should be given (*k*).

When the allegation of the defendant is that the patent is void by reason of a portion of the described invention being old, the

(*b*) *Fisher v. Dewick*, 1 Web. P. C. 551 (n.); *Galloway v. Bleaden*, 1 Web. P. C. 268, (n.); *Boyd v. Horrocks*, 3 P. O. R. 285.

(*c*) *Holland v. Fox*, 1 W. R. 448; 1 C. L. R. 440; *Morgan v. Fuller*, L. R., 2 Eq. 297; *Boyd v. Horrocks*, 3 P. O. R. 285.

(*d*) 7 M. & G. 652; see also *Jones v. Berger*, 1 Web. P. C. 549.

(*e*) Solicitors' Journal, 1876, p. 860.

(*f*) *Bentley v. Keighley*, 7 M. & G. 652; *Palmer v. Wagstaff*, 8 Ex. 840.

(*g*) 5 P. O. R. 33.

(*h*) 8 P. O. R. 376; also *Boyd v. Horrocks*, 3 P. O. R. 285.

(*i*) *Sidebottom v. Fielden*, 8 P. O. R. 266.

(*k*) *Smith v. Lung*, 7 P. O. R. 148.

particulars should clearly distinguish which part is alleged to be old, as well as the times and places of prior user (*l*).

Objections on the ground of prior publication stand very much upon the same footing as those on the ground of prior user.

If the prior publication is alleged to be in books or newspapers, the plaintiff is entitled to be told the name of the book or newspaper, and to be given such details of the books or newspapers as will enable them to be found and identified by the plaintiff (*m*).

In *Fowler v. Gaul* (*n*), the defendants, by their particulars of objections, alleged (*inter alia*), "5. That the alleged invention was published prior to the patent by certain patents and the specifications thereof (naming them); 8. The plaintiff's specification claims some of the matters specified or patented in certain specifications (naming them)." The District Registrar, affirmed subsequently by the Judge in Chambers and Divisional Court, ordered "better particulars, showing in detail what part or parts of the patents or specifications respectively referred to in the 5th and 8th objections showed prior publication, and what parts were relied on as being claimed by the plaintiff's specification. In default of delivery, objections 5 and 8 to be struck out."

In *Plimpton v. Spiller* (*o*), the particulars were—"before the date of the alleged letters patent the alleged invention had been published in England in the 'Commissioners of Patents Journal,' of the 6th February, 1863, and in the 'Scientific American,' of the 24th January, 1863, and in drawings and sketches deposited in the Patent Office library in July, 1865." Mr. Justice Field directed that the defendant should amend his particulars by stating the date of the American patent, and in whose name it had been granted. And also by giving the pages of the publications mentioned, but not the lines. And also by giving such written details as would enable the drawings mentioned to be identified, and to state whether the drawings were or were not

(*l*) *Heath v. Unwin*, 10 M. & W. 684; *Russell v. Leedsam*, 11 M. & W. 647.

(*m*) *Jones v. Berger*, 5 M. & G. 208; *Palmer v. Cooper*, 9 Ex. 231.

(*n*) Griff. P. C. 99; 3 P. O. R. 247;

see also *Harris v. Rothwell*, Griff. P. C. 109; 3 P. O. R. 243.

(*o*) 20 Solicitors' Journal, 1876, p. 860; see also *Flower v. Lloyd*, same reference.

contained in books, and what books. Notice of objections, on the ground that the grantee of the letters patent was not the first and true inventor, does not stand upon the same footing as objections on the ground of prior user or publication. Sect. 29, sub-sect. 3, does not require the defendant to state more than generally on what grounds he objects, and a statement that his objection is that the plaintiff was not the true inventor, that is, that the consideration did not move from him, will be sufficient, care being taken to distinguish this objection from that of prior user or publication.

Whether or not a defendant will be required to give particulars of lines and pages of the specifications upon which he relies in his objections will depend upon the circumstances of the case and the nature of those specifications (*p*); where it appeared that the defendant had, figuratively speaking, "thrown at the head" of the plaintiff a large number of specifications without any attempt at discrimination, further particulars were required (*q*), but if the defendant *bonâ fide* relies upon the whole of a specification, or any number of specifications in reason, his particulars of objections will not be interfered with. In *Nettlefolds v. Reynolds* (*r*), Lindley, L.J., said: "It appears to me, therefore, that the moment the learned Judge came to the conclusion, as he did in fact, that the defendant here had honestly done his best to give to the plaintiff that information that he is entitled to, unless the Court came to the conclusion that there was some grievous or some obvious mistake, he ought to be satisfied with that, and not to say, 'I shall order further particulars, because I know from experience that if you say you rely on the whole of the specification, when you come into court nine-tenths will not be referred to.' If the defendant is to be bound hand and foot to a particular page, and to a particular line, it will be perfectly impossible for him to defend his case, or to impeach the patent to the extent and in the manner in which he is entitled to do it."

The object of particulars of objections is to ascertain the lines

(*p*) *Heathfield v. Greenway*, 11 P. O. R. 19.

(*q*) *Sidcbottom v. Fielden*, 8 P. O. R. 266, 270; *Holliday v. Heppenstall*, 6

P. O. R. 320; *Heathfield v. Greenway*, 11 P. O. R. 17.

(*r*) 8 P. O. R., at p. 417; see also *Siemens v. Karo*, 8 P. O. R. 376.

upon which the plaintiff's patent is to be attacked, and thereby prevent surprise, consequently it is not only necessary to define the objection to the plaintiff's patent upon which the defendant intends to rely, but also, where the patent in question is of some complexity, to define the part of it against which the attack is directed (s).

Objections on the ground of common knowledge must be carefully distinguished from objections on the ground of prior publication; in the latter case every book or document must be particularized, as no instance of anticipation can be adduced at the trial of which particulars have not been delivered, but when the objection to a patent is based upon common knowledge, no particular instances need be referred to, as this objection can only be proved by the examination of witnesses and reference to well-known standard works upon the subject (t). Specifications may not be put in at the trial in proof of common knowledge, but must be specifically mentioned in the particulars (u).

Evidence will be admitted at the trial, provided the language of the particulars of objections is large enough to admit it; for instance, if the plaintiff has allowed such words as "and elsewhere" to stand until the trial, the defendant will be allowed to give evidence of prior user anywhere (x). The proper course for the plaintiff to take should the defendant deliver vague particulars is to issue a summons before a judge in chambers for further and better particulars, or, in the alternative, to have the objectionable words struck out (y).

In *Sugg v. Silber* (z), Mellish, L. J., said:—"The authorities cited by Mr. Cave were cases where objections had been taken to the notices of objection at the time when they were delivered,

(s) *Harris v. Rothwell*, 3 P. O. R. 243; *Boyd v. Farrar*, 5 P. O. R. 33.

(t) *Holliday v. Heppenstall*, 6 P. O. R. 320; *English and American Machinery Co. v. Union Boot Co.*, 11 P. O. R. 367.

(u) *Solvo Laundry Co. v. Mackie*, 10 P. O. R. 68; *Peckover v. Rowland*, 10 P. O. R. 118; *English and American Machinery Co. v. Union Boot Co.*,

11 P. O. R. 37, 373.

(x) *Hull v. Bollard*, 25 L. J., Ex. 304; *Sykes v. Howarth*, L. R., 12 Ch. D. 826.

(y) *Fisher v. Dewick*, 1 Web. P. C. 551 (n.); *Carpenter v. Walker*, 1 Web. P. C. 268 (n.); *Holland v. Fox*, 1 C. L. R. 440.

(z) L. R., 2 Q. B. D. 495.

and further and better particulars were asked for. In my opinion there is a very large difference between a case where a judge has been applied to and has ordered further particulars in order to state an objection more specifically, and a case where at the trial the plaintiff asserts that the defendant ought to be prevented from availing himself of an objection. It is perfectly obvious that, if Mr. Cave was right in saying that the two questions are the same, and that wherever the Court would order further particulars because the objection had not been particularly specified, it would also hold that the party was precluded from raising it at the trial. Nobody would be foolish enough to apply to a judge for further particulars. Although the objections did not specifically point out that the invention consisted of several claims, yet the objection, that the invention is not the subject matter of a patent, is sufficient to open the objection that the whole, or some particular part of it, is not the subject matter of a patent, and that consequently the patent is bad" (a).

In *Britain v. Hirsch* (b), in the Court of Appeal, Cotton, L. J., said: "In my opinion, under the present Act of Parliament, it is within the discretion of a judge who hears evidence in a patent case to allow evidence to go beyond the particulars actually delivered."

The defendant will not be allowed at the hearing of the action to introduce evidence of prior user, not disclosed in the particulars of objection, although such evidence may have only come to his knowledge since the delivery of the particulars of objection. His proper course is to obtain leave by summons or by serving short notice of motion for leave to amend, when an order will be made upon the terms mentioned below; and with an added term to delay the trial should it appear just that the plaintiff should have time to investigate the new evidence (c).

Page-Wood, V.-C., in *Penn v. Bibby* (d), permitted a defendant in his amended particulars, to preface his statement of the

(a) See also *Hull v. Bollard*, 1 H. & N. 134; *Neilson v. Harford*, 1 Web. P. C. 331; *Bovill v. Goodier*, L. R., 1 Eq. 35.

(b) 5 P. O. R., at p. 231.

(c) *Daw v. Elcy*, L. R., 1 Eq. 38.

(d) L. R., 1 Eq. 548.

specific instances of alleged prior user, with the words " amongst other instances " in order to give him an opportunity to apply for leave to re-amend by inserting any further instances of prior user which he might discover.

Liberty to amend particulars of objections at the trial was given upon terms in *Renard v. Levenstein* (a); but in *Moss v. Malings* (b), North, J., refused leave, and said:—" I could only grant it if the defendant showed that he could not, with reasonable diligence, have discovered the new facts sooner. This he has not done. I must, therefore, refuse the application."

In *Allen v. Horton* (c), the defendant amended his particulars of objections at the trial by leave of the Court; judgment was given for the defendant, but costs refused owing to the late stage at which the amendment was made.

The terms upon which amendment is permitted are, first, that the plaintiff should be at liberty, if he pleases, to discontinue the action, and to be in the same position as to costs, as if the proposed amended particulars had been delivered in the first instance (d), and, secondly, that the defendant should be put under such terms as to costs, as to the judge or Court may seem just. The particulars of objections give notice to the plaintiff of the case which is to be made against him; thereupon he may discontinue or not, as he pleases, paying the defendant's costs. The defendant should not be permitted to keep back his most salient objections, and so to entice the plaintiff to proceed and incur costs, and then to amend his particulars at the last moment.

In *Pirrie v. York Street Spinning Company* (e), leave to amend the particulars of objections was granted pending appeal.

Forms of orders, for delivery of further particulars of objections, and for liberty to amend, will be found in the appendix (f).

(a) 11 L. T. at p. 506; also *Allen v. Horton*, 10 P. O. R. 412.

(b) L. R., 33 Ch. D. 603; 3 P. O. R. 375; also *Peckover v. Rowland*, 10 P. O. R., at p. 120.

(c) 10 P. O. R. 412; note also *Westley Richards v. Perkes*, 10 P. O. R. 181, 186.

(d) *Baird v. Moule's Patent Earth*

Closet Co., L. R., 17 Ch. D. 189 (n.); and *Aveling v. Maclaren*, same page; also *Edison Telephone Co. v. India-rubber Co.*, L. R., 17 Ch. D. 137; *Parker v. Maignen's Filter Co.*, 5 P. O. R. 207.

(e) 11 P. O. R. 431.

(f) P. 483, post.

INTERROGATORIES.

Order XXXI. rule 1, of the rules of the Supreme Court, 1883, provides that either party to an action, with leave of the Court or a judge, may interrogate the other party.

Interrogatories must be relevant to the issue, and will not be allowed to be used for the purpose of cross-examination. Since it is not possible to say precisely what the issues between the parties are before the statement of defence is delivered, neither party, except under special circumstances, will be allowed to interrogate until that stage of the action has been reached (*g*).

Rule 26 provides that 5*l.* or some further sum, should be brought into Court by the party desiring to interrogate before he shall be at liberty to do so.

The general rules as to interrogatories in ordinary actions apply equally to actions for infringement.

The plaintiff may interrogate the defendant, and the defendant must answer as to what infringement he has been guilty of; and he must disclose, if asked, the names and addresses of all persons, whether in England or abroad, from whom he may have received money for the use of articles alleged to be made in infringement of the patent (*h*).

In *Lister v. Norton* (*i*), the defendants put in a defence denying infringement, and the plaintiff interrogated the defendants, and asked in one interrogatory whether the defendant's firm had not sold imitation sealskins (the patent being for "Improvements in the manufacture of velvets and of pile fabrics in imitation of seal-skin and other similar materials") to certain firms, naming sixteen firms. This interrogatory the defendants declined to answer, on the ground that the information was not *bonâ fide* sought for the purposes of the action. Chitty, J., ordered an answer to the interrogatory, unless within fourteen days the defendant admitted infringement.

(*g*) *Mercier v. Cotton*, L. R., 1 Q. B. 547; *Ashworth v. Roberts*, 7 P. O. R. D. 442. 455.

(*h*) *Crossley v. Stewart*, 1 N. R. 426; *How v. McKernan*, 30 Beav. R. 68. (*i*) Griff. P. C., at p. 149; 2 P. O. R. 68.

In *Benno Jaffé v. Richardson* (*k*) the plaintiff administered interrogatories to the defendant, framing them upon the statements in his specification, which he alleged that the defendant had infringed, and thereby asked the defendant if he had used the processes described in the specification, taking them step by step. Some of these interrogatories the defendant refused to answer, on the ground that they were not relevant until the patent was established. It was held by North, J., that the plaintiff was entitled to further answers.

But where the materiality of an interrogatory depends upon the construction of the patent, no answer need be given (*l*).

The fact that the defendant's particulars of objections are sufficient will not necessarily preclude the plaintiff from obtaining more detailed information by administering interrogatories. In *Birch v. Mather*, Chitty, J., said: "The right to interrogate is conferred by the general orders, and I cannot say as a matter of principle that it can be laid down that the plaintiff is not entitled to interrogate the defendant, and *vice versa*, with reference to these matters which may be covered by the particulars. I hold, therefore, on the general question, that there is a right to deliver interrogatories, and provided the interrogatories are properly worded, interrogatories with reference to these very matters which ought to be covered by the particulars" (*m*).

The plaintiff is entitled to interrogate as to the names and addresses of the persons by whom the defendant alleges the invention was used prior to the date of the plaintiff's patent, also as to the places where such prior user occurred (*n*).

In a petition for revocation under section 26, interrogatories will be allowed to be administered by the petitioner to the respondent, inquiring into the manufacture, use, and sale of the patented article prior to the date of the patent (*o*).

(*k*) 10 P. O. R. 136; see also *Ashworth v. Roberts*, 7 F. O. R. 451.

(*l*) *Delta Metal Co. v. Maxim-Nordenfelt Guns Co.*, 8 P. O. R. 169.

(*m*) L. R., 22 Ch. D., at p. 631; see also *Alliance Pure Whitelead Syndicate v. MacIvor's Patents*, 8 P. O. R., at p. 322

(*n*) *Finnegan v. James*, L. R., 19 Eq. 72; *Crossley v. Toney*, L. R., 2 Ch. D. 533; *Birch v. Mather*, L. R., 22 Ch. D. 629; *Alliance Pure Whitelead Syndicate v. MacIvor's Patents*, 8 P. O. R. 321.

(*o*) *Haddan's Patent*, 54 L. J., Ch. 126.

Where a defendant alleged that his process was secret, he was bound to answer whether he used the materials mentioned in the specification, and whether he used any additional materials, but not to disclose the proportions in which he used the specified materials, or what the additional materials were (*p*).

“The mere plea of secret process is not sufficient to defeat discovery, but, on the other hand, interrogatories must not be made the means of unfair treatment of a man who is fighting fairly” (*q*).

When there is nothing to show that the defendant has infringed the patent, and he has denied on oath having infringed the patent, the plaintiff will not be permitted to interrogate as to the articles made and sold by the defendant, there being nothing to show that the articles sold infringe the patent. If *Lea v. Saxby* (*r*) be read, this proposition will be seen to follow.

Crossley v. Tomey (*s*) was an action to restrain infringement. The defendant in interrogatories was required to state whether he was not making articles in all respects identical with those of the plaintiff, and to set forth in what respects they differed, and by what process they were made. It was held that the defendant, who alleged prior user by himself and others, had sufficiently answered by stating that, save so far as the articles manufactured by him before the date of the patent were similar to those of the plaintiff, the articles he now made differed from those made by the plaintiff, but he could not show in what they differed without ocular demonstration.

Communications between a man and his patent agent are not privileged, consequently, where the plaintiff's patent agent also acted as his solicitor, he was ordered to answer interrogatories with reference to documents which passed between them at the time the specification was prepared, such communications having taken place in the relationship of patent agent, and not of solicitor and client (*t*).

In the same case interrogatories which sought to compel the

(*p*) *Renard v. Levinstein*, 8 N. R. 665.

(*q*) Per Kekewich, J., in *Ashworth v. Roberts*, 7 P. O. R., at p. 455.

(*r*) 32 L. T., N. S. 731.

(*s*) L. R., 2 Ch. D. 533.

(*t*) *Mosley v. Victoria Rubber Co.*, 3 P. O. R. 351.

plaintiff to particularise the alleged breaches by stating what parts of the plaintiff's specification were infringed by the defendants (the defendants having in answers to interrogatories disclosed what they had done) were disallowed on the ground that the defendants could for themselves compare the plaintiff's specification with what they admitted they had done.

In *Borill v. Smith* (u), the following interrogatory was disallowed: "Does not the defendant allege that the plaintiff's invention was publicly used within this realm before the date of the plaintiff's patent? Set forth particularly when, and in what place or places, and in what manner, does the defendant allege that the plaintiff's invention, or any or what part thereof, was publicly used within this realm before the date of the plaintiff's patent." Sir W. Page Wood, V.-C., said that the plaintiff was not entitled to enquire generally into the way in which the defendant shaped his case in order to find out whether some of the persons alleged by him to have used the process before the date of the patent, were the persons against whom the plaintiff had succeeded in other suits, though he might have asked if the process was the same as that used by A. B., or any one person specifically named, who had been a defendant in some former suit.

A defendant who submits to answer must answer fully: he cannot, by denying the plaintiff's title, escape answering. Discovery of title deeds and of professional communications form an exception. The plaintiff and defendant had both patents for making gelatine; the plaintiff interrogated as to the article manufactured by the defendant, and as to the names and addresses of the customers, and as to prices and profits. The defendant denied all infringement. He said he had made his article according to his own, and not according to the plaintiff's, patent, and he declined to give an account of such article. Held, that notwithstanding his denial, he was bound to do so (x). It is doubtful whether this case would be followed now, for it is difficult to understand how the question could be relevant to the issue. It might be relevant after judgment, but before judgment the issue

(u) L. R., 2 Eq. 459; see also *Daw* 416; but note *Lea v. Saxby*, 32 L. T., v. *Eley*, 2 H. & M. 725. N. S. 731.

(x) *Swinborne v. Nelson*, 16 Beav.

is, infringement or no infringement. The names of the customers could not bear upon this question.

After trial, and in pursuance of the terms of the judgment, if the plaintiff has been successful he is entitled to interrogate the defendant, or to require that the defendant "should make and file an affidavit stating what machines of the same construction as that supplied by him to A. or B., including such machines as are in his possession or power," see *Seton*, 4th ed. p. 352. The answer or affidavit of the defendant must be complete. In *Murray v. Clayton* (y), a patentee of improvements in brick-cutting machines, who was a manufacturer of the machines by an agent at the agent's works and not a licensor, having obtained a perpetual injunction against the defendants (who were also manufacturers of brick-cutting machines), from infringement, the defendants were ordered to file an affidavit stating the number of machines made by them since the date of the patent, and the names and addresses of the persons to whom the same had been sold, and of the agents concerned in the transactions. Upon motion to vary the order, it was held that the plaintiff was entitled to have discovery of the names and addresses of the purchasers, but not of the agents concerned, there being nothing to show that any agents had been employed.

In answering interrogatories filed by a defendant for the examination of the plaintiff, the general rule applies that he who is bound to answer must answer fully (z).

Interrogatories for the examination of a plaintiff are on a different footing from those for the examination of a defendant in this respect, that a plaintiff is not entitled to discovery of the defendant's case, but a defendant may ask any questions tending to destroy the plaintiff's claim (a).

In determining whether a question is one of fact, and, therefore, to be answered, it makes no difference that it is asked with reference to a written document (b).

A defendant in a suit for infringement of a patent in order to prove that there was no novelty in the plaintiff's patent, interro-

(y) L. R., 15 Eq. 115.

(z) *Hoffman v. Posthill*, L. R., 4
Ch. 673.

(a) *Hoffman v. Posthill*.

(b) *Ibid.*

gated the plaintiff as to the inventions described in the specifications of various patents, and asked him to show in what respects they differed from his. The plaintiff declined to answer these interrogatories on the ground that the questions were not questions of fact, and that they related to the plaintiff's case; the defendant excepted to the answer, and the exceptions were allowed (c).

A plaintiff in a patent suit was required by interrogatories to set out a correspondence between himself and a third party, and also to state the particulars of the infringement of his patent on which he relied. He refused to answer these questions on the ground that the defendant might obtain an order in chambers to inspect the correspondence: and that he had sufficiently set out the particulars of the infringement in his bill. These answers were held to be sufficient (d).

We have set out the effect of this case at length, because it is founded upon and exemplifies in many ways the principle upon which a defendant may examine a plaintiff. Lord Justice Giffard, in giving judgment, said: "As regards the case of *Daw v. Eley* (e), it must be always remembered that that was the case of a plaintiff exhibiting interrogatories to a defendant, and it was there held that the plaintiff could not call on the defendant to set forth the particulars of his defence. But when you come to the case of a defendant asking questions of a plaintiff, it is a very different thing. It is the defendant's business to destroy the plaintiff's case, and there the defendant has a right to ask all questions which are fairly calculated to show that the patent is not a good patent (f), or that what he alleges to be an infringement is not an infringement." Lord Justice Selwyn had said: "Our decision in this case will leave it entirely within the power of the learned Vice-Chancellor to order that all the costs occasioned by the interrogatories, the answer, the exceptions, the hearing the exceptions before him, and the hearing of this appeal, shall be dealt with as he, in his discretion, shall think fit; and if it shall appear that the power which the Court, for the purpose of justice and dis-

(c) *Hoffman v. Posthill*.

(d) *Ibid*.

(e) 2 H. & M. 725.

(f) *Rylands v. Ashley's Patent Bottle Co.*, 7 P. O. R. 175.

covery, gives to the parties to administer interrogatories to each other has been abused, I have no doubt the learned Vice-Chancellor will take care that justice shall be done, and will make the party who is to blame pay all the costs of the improper exercise of this power."

INSPECTION.

Sect. 30 of the Patents, &c. Act of 1883, provides: "*In an action for infringement of a patent, the Court or a judge may, on the application of either party, make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon, as the Court or a judge may see fit.*"

The power to order an inspection was always assumed by the Courts; in *Bovill v. Moore* (g), Lord Eldon said: "There is no use in this Court directing an action to be brought, if it does not possess the power to have the action properly tried. The plaintiff has a patent for a machine used in making bobbin lace. The defendant is a manufacturer of that article; and, as the plaintiff alleges, he is making it with a machine constructed upon the principle of the machine protected by the plaintiff's patent. Now the manufactory of the defendant is carried on in secret. The machine which the defendant uses to make bobbin lace, and which the plaintiff alleges to be a piracy of his invention, is in the defendant's own possession, and no one can have access to it without his permission. The evidence of the piracy, at present, is the bobbin lace made by the defendant. The witnesses say that this lace must have been manufactured by the plaintiff's machine, or by a machine similar to it in principle. This is obviously in a great measure conjecture. No Court can be content with evidence of this description. There must be an order that plaintiff's witnesses shall be permitted before the trial of the action to inspect the defendant's machine, and to see it work."

"The right to inspection is a right to be given at the discretion of the Court—to be exercised with a judicial discretion and

(g) 2 Coop. Ch. Ca. 56 (n.).

with due regard to the interests of the parties concerned in the litigation" (h).

The object which the Court has in view in all cases where an inspection is permitted, is to ensure that the true facts of the case shall be carefully sifted; but at the same time the Court will take care that the process of the law is not abused, and that an action for infringement shall not be made a means and lever for the discovery of other persons' secrets.

The Court requires, before granting an order for inspection, that a *prima facie* case shall be made out of infringement (i). And when the interests of justice require, the inspection will be granted to scientific witnesses, who will be required to keep any secrets which they may have discovered, and which do not affect the question of infringement (k). And in *Flower v. Lloyd* (l) the Court of Appeal strictly limited the inspection to scientific men, and excluded the plaintiff from being present.

In *Pigott v. The Anglo-American Telegraph Co.* (m), it was alleged that an inspection would disclose important secrets. Giffard, V.-C., in refusing an order to inspect, said: "Of late years greater readiness has been shown by the equity Courts to allow inspection in patent cases than by the courts of common law. But it has never been considered as a matter of right, nor have the equity Courts considered themselves as precluded from exercising a proper discretion in applications of this description. The Court ought to be satisfied of two things: that there really is a case to be tried at the hearing of the cause, and that the inspection asked for is of material importance to the plaintiff's case as made out by his evidence."

In *Batley v. Kynock* (n), Sir James Bacon, V.-C., said: "Upon the single point which is raised before me, there can

(h) Per Bristowe, V.-C., in *McDougall v. Partington*, 7 P. O. R., at p. 357.

(i) *Bovill v. Moore*, supra; *The Singer Sewing Machine Co. v. Wilson*, 12 L. T., N. S. 140; *Shaw v. The Bank of England*, 22 L. J., Ex. 26; *Batley v. Kynock*, L. R., 19 Eq. 90; *Germ Milling Co. v. Robinson*, 55

L. J., Ch. 287; 1 P. O. R. 217.

(k) See *Russell v. Crichton*, 1 Web. P. C. 667 (n.); 15 Dec. Ct. of Sess. 1270.

(l) W. N. 1876, 169, 230; see also *The Plating Co. v. Farquharson*, Griff. P. C. 187.

(m) 19 L. T., N. S. 46.

(n) L. R., 19 Eq. 92.

be no doubt that the plaintiff in such a suit as this is entitled to an inspection of the means which the defendants employ in the manufacture of the articles alleged to be violations of the plaintiff's patent, when such inspection is essential for the purpose of enabling the plaintiff to prove his case; upon the materials before me that is not made out. There is no allegation by the plaintiff that he cannot make out his case without inspection. But there is on the part of the defendants a plain allegation that inspection is not necessary for the purposes of the suit; upon that only I must decide this question. I would rather not go into the other matters which have been referred to. The description in the specification and the allegation in the bill—but as I read both the description in the specification and the allegation in the bill—I find that the charge made by the plaintiff is that the cartridges, the right of manufacturing which is vested in him exclusively, have been imitated and copied by the defendant, and if that fact can be made out the plaintiff's case can be clearly established. The mode of making that out is by examination of the cartridges, the means by which they have been made, whether by a machine or hammer or a screw cannot signify in the least if the cartridges of the defendant when made are made upon the principle of the patent claimed by the plaintiff."

As we have seen, the plea of secret process is of no avail for the purpose of resisting an order for inspection, but in such a case before granting the order the Court will require the plaintiff to make out a strong *prima facie* case of infringement (o).

In *Drake v. Muntz Metal Co.* (p), before statement of claim application was made to Bacon, V.-C., that the defendants by their proper officer should make an affidavit verifying the machines and processes used by the defendant company in bending metal tubes since the date of the plaintiff's patent and for inspection. The Vice-Chancellor said that sect. 30 (*supra*) did not give him power to direct an affidavit to be made, but ordered inspection of the machines.

The Court, in the case of *The Patent Type Founding Co. v.*

(o) *Germ Milling Co. v. Robinson*, (p) 3 P. O. R. 43.
1 P. O. R., at p. 219.

Walter (q), assumed the jurisdiction to order the defendant to deliver to the plaintiff a sample of the type made by him so that the plaintiff might have the same analysed, for the purpose of ascertaining whether the composition was similar to the plaintiff's patented composition.

In that case it was also held that laches sufficient to defeat the plaintiff's right to an interlocutory injunction was no bar to an order on the same motion for inspection.

Inspection will only be allowed of that with regard to which a *prima facie* case of infringement has been made out (*r*).

In some cases where it is necessary, the Court will order the defendant and the plaintiff to give mutual inspection, and to show both the patented machine and the alleged infringement at work, and to permit either party to take away any of the work or samples of the work which has been done in their presence (*s*).

Whether the plaintiff will be entitled to see the alleged infringing machine at work or not will depend upon the circumstances of the case (*t*).

Where the defendant has delivered to the plaintiff specimens of the alleged infringing articles, the latter is not entitled to see those articles in actual use on the defendant's premises (*u*).

No order will be made for inspection by the plaintiff of articles not within the control of the defendant, nor of exhibits which the defendant's witnesses will give in evidence (*x*).

In *McDougall v. Partington (y)* the plaintiff's right to inspection depended upon a contract which was the matter in dispute, and since he was unable to show that inspection was necessary to prepare his case, it was held that no inspection should be granted

(*q*) 8 W. R. 353 ; John. 727 ; see also *Germ Milling Co. v. Robinson*, 3 P. O. R. 11.

(*r*) *Cheetham v. Oldham*, 5 P. O. R. 617, 621.

(*s*) *Davenport v. Jepson*, 1 N. R. 307 ; see also *The Singer Sewing Machine Co. v. Wilson*, 5 N. R. 505 ; *The Germ Milling Co. v. Robinson*, 55 L. J., Ch. 288 ; 3 P. O. R. 11.

(*t*) *The Germ Milling Co. v. Robinson*, 3 P. O. R. 11 ; *Drake v. Muntz Metal Co.*, 3 P. O. R. 43 ; *Sidebottom v. Fielden*, 8 P. O. R. 266.

(*u*) *Sidebottom v. Fielden*, 8 P. O. R. 266.

(*x*) *Garrard v. Edge*, 6 P. O. R. 372 ; also *Sidebottom v. Fielden*, 8 P. O. R. 266, 269.

(*y*) 8 P. O. R. 351, 472.

on the ground that the right depended upon the question to be determined at the trial.

The application may be made on motion to the Court or by summons; it is usually made upon the application for an interim injunction, but it is immaterial at what stage of the proceedings the application is made. The evidence in support must be on affidavit, and a *prima facie* case of infringement must be made out, and that the inspection is material to the plaintiff's case.

Order L. of the Rules of the Supreme Court, 1883, contains some provisions as to inspection which must be noticed.

Rule 3 provides for the inspection of property and the taking of samples, or for "any observations to be made or experiment to be tried which may be necessary or expedient for the purpose of obtaining full information or evidence." Rule 4: "It shall be lawful for any judge, by whom any cause or matter may be heard or tried with or without a jury, or before whom any cause or matter may be brought by way of appeal, to inspect any property or thing concerning which any question may arise therein."

This last mentioned rule was introduced by the Rules 1883. Before, the parties must have consented to a view being had. In *Jackson v. The Duke of Newcastle* (z), Lord Westbury said: "A judge is bound to pronounce his decision according to the evidence before him, but his inspection of the premises may bring him to a conclusion directly opposite to that which is established by the evidence."

THE TRIAL.

The constitution of the Court which is to hear and determine patent actions is provided for by sect. 28, sub-sect. 1, of the Act of 1883: "*In an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall on the request of either of the parties to the proceeding, call in the aid of an assessor, specially qualified, and hear and try the case wholly or partially with his assistance; the action shall be tried without a jury, unless the Court shall otherwise direct.*"

(z) 33 L. J., Ch. 698.

Under the old statute, either party had an absolute right to have the questions of fact decided by a jury, and the Court had no power to deprive them of this right (a).

Under the 57th sect. of the Judicature Act, 1873, the Court had power, without the consent of the parties, "in any such cause or matter requiring any prolonged examination of documents or accounts or *any scientific or local investigation* which cannot, in the opinion of the Court or a judge, conveniently be made before a jury, or conducted by the Court through its other ordinary officers, the Court or a judge may at any time, on such terms as may be thought proper, order any question or issue of fact, or any question of account arising therein, to be tried either before an official referee, to be appointed as hereinafter provided, or before a special referee to be agreed on between the parties; and any such special referee so agreed on, shall have the same powers and duties, and proceed in the same manner as an official referee. All such trials before referees shall be conducted in such manner as may be prescribed by rules of Court, and subject thereto in such manner as the Court or judge ordering the same shall direct."

In the case of *Sarby v. The Gloucester Wagon Co.* (b), Mr. Justice Hawkins was of opinion that a patent case was a case which required a "prolonged scientific examination," and consequently he remitted the action to that which he considered the most proper tribunal for difficult scientific questions, "*the official referee.*" We are inclined to think that sect. 28 of the Patents &c., Act, does away with this option. The words appear to read: "*The Court may employ an assessor, and shall do so on the application of either party, and shall try the case; and the action shall be tried without a jury, &c.*"

Ord. XXXVI. rule 5 of the Rules of the Supreme Court provides, "The Court or a judge may direct the trial without a jury, of any cause, matter, or issue, requiring any prolonged examination of documents or accounts or any scientific or local examination which cannot, in their or his opinion, conveniently be made with a jury"; and rule 6: "In any other cause or matter, upon the application of any party thereto, for a trial with a jury." These

(a) *Sugg v. Silber*, L. R., 1 Q. B. D. 362. (b) W. N. 1880, p. 28.

rules, together with the provisions of sect. 28 of the Patent Act, would show that the better opinion probably is that, unless a judge or the Court otherwise orders, the constitution of the Court shall be a judge sitting without a jury, and with or without an assessor.

The grounds of application for a trial by jury would be that the evidence shows a **conflict of testimony** in material parts, or that **grave questions of credibility** are likely to arise, or that a **charge of fraud** is made against either party.

Mr. Hindmarch, at p. 291 of his celebrated work, says : “ Few causes require so much care and industry in preparing for trial as patent actions, in which very nice points of law and difficult questions of fact must often be decided between the parties ; and it will frequently happen that a party will succeed or fail in obtaining a verdict according to the industry with which he has got up his case for trial. Properly to understand the questions raised in such actions and prepare the necessary proofs, a competent knowledge, not only of law, but also of science in general and the useful arts, is essentially requisite.”

Prior to the Act of 1883 the jurisdiction of the **Palatine Court of Lancaster** was “ the jurisdiction of the old Court of Chancery within the boundary ” (c), and its jurisdiction to award damages depended upon the provisions of Lord Cairns’ Act (d), which limited that jurisdiction to cases where the Court had power to grant an injunction ; consequently where it was held that no injunction could under the circumstances be granted, the plaintiffs were unable to recover damages in that Court for the infringement of their patent (e).

The Act of 1883 made no mention of the Palatine Court, defining the word “ Court ” as the High Court of Justice, and by the general repeal of previous Acts relating to letters patent, without excepting their application to proceedings in the Palatine

(c) Per Jessel, M.R. ; *Re Longden-dale Cotton Spinning Co.*, L. R., 8 Ch. D. 152 ; 26 W. R. 491.

(d) 21 & 22 Vict. c. 27.

(e) *Proctor v. Bayley*, 6 P. O. R. 538, 545 ; see also upon this point *Hindley v. Emery*, L. R., 1 Eq. 52 ;

Davenport v. Rylands, L. R., 1 Eq. 302 ; *Swaine v. Great Northern Rail. Co.*, 12 W. R. 391 ; *Wedmar v. Corporation of Bristol*, 11 W. R. 136 ; *Cory v. Thames Iron Co.*, 11 W. R. 589 ; *Catton v. Wylde*, 32 Beav. 266.

Court, confined the jurisdiction of that Court to the general rule relating to proceedings in a Chancery action for the infringement of a right of any description, unless special jurisdiction could be found in the interpretation of the word "judge" in the Act of 1883.

In *Winter v. Baybut* (f) the Vice-Chancellor held that the words "The Court or a judge" in the 19th sect. meant "The High Court or a judge with power to try actions for infringement," and consequently held that he had jurisdiction to give liberty to the plaintiff to apply for leave to amend his specification while an action for infringement was pending before him. But in *Proctor v. Sutton* (g) Day, J., held that the same words in the 31st sect. meant "The Court or a judge thereof," and consequently that the Vice-Chancellor had no jurisdiction to grant a certificate of validity under that section.

If the latter be the correct interpretation it would appear that the jurisdiction in patent actions given to the Vice-Chancellor under the provisions of the Acts which were repealed by the Act of 1883, was by that Act taken away.

The Chancery of Lancaster Act, 1890, sect. 3, enacts:—

"From and after the passing of this Act the Court of Chancery of the County Palatine of Lancaster (in this Act called the Lancaster Chancery Court), shall, as regards all persons, bodies corporate, and property within or becoming subject to its jurisdiction, have and exercise the like powers and jurisdiction, and in a similar manner, and subject to the same restrictions in all respects, as the High Court in its Chancery Division now has and exercises, or may, under or by virtue of any Act of Parliament hereafter passed, and not expressly enacting to the contrary hereof, have and exercise, in respect of all persons, bodies corporate, and property within its jurisdiction."

The effect of this Act is to extend the meaning of the word "Court" in the Patents, &c., Acts, to the Palatine Court so far as it relates to actions for infringement.

A grant of letters patent gives to the patentee a right which extends over the whole of the United Kingdom, and only a small portion of that right lies in the district which is within the jurisdiction of the Palatine Court, consequently the Chancery of

(f) 1 P. O. R. 76.

(g) 5 P. O. R. 184.

Lancaster Act, 1890, does not give to that Court power to adjudicate upon a petition for revocation of letters patent since the whole of the property which is the subject of the petition does not lie within its jurisdiction.

A county court has no jurisdiction to try an action for infringement when the validity of the patent is in dispute (*h*).

It is no ground for postponing the trial of an action for infringement that a petition has been presented by the defendant or any other person under sect. 26 to revoke the patent.

We have seen that proceedings for revocation are similar to, and for the same purpose as, *scire facias* prior to the Act of 1883. In *Muntz v. Foster* (*i*) it had been held that the fact of a writ of *scire facias* being pending was no ground for staying the action for infringement. Tindal, C.J., said: "As a general rule, a plaintiff has a right to have his cause go on for trial according to the ordinary course of business. Special circumstances may exist upon which the Court may see fit to interfere; but the present does not appear to us to be a case in which we ought to interfere by staying the proceedings in the action."

The ground of this decision was that the plaintiff in the action for infringement, being defendant in the proceedings by *scire facias*, had not the conduct of those proceedings, and that the defendant in the action for infringement might delay them; but where, in *Patteson v. Holland* (*k*), an action for infringement had been tried, and a rule *nisi* for a new trial had been obtained and argued, and it appeared that another action was pending in that Court for another infringement of the same patent, and that a *scire facias* had been sued out to repeal the patent, the Court suspended their judgment upon the rule for a new trial, and ordered the trial of the other action to be postponed until after the trial of the *scire facias*.

And where a verdict had already gone for the Crown on *scire facias*, but a new trial was pending, the plaintiff was not permitted to proceed to trial with his action for infringement until

(*h*) *R. v. County Court Judge of Halifax*, L. R., 1891, 1 Q. B. 793; L. R., 1891, 2 Q. B. 263; 8 P. O. R.

(*i*) 2 Web. P. C. 93 (n.); 1 Dowl. & Low. 942.

(*k*) Hindmarch, p. 293.

the rule for the new trial in *scire facias* had been disposed of (l).

In an action for infringement the plaintiff has the right of beginning and of replying, notwithstanding that the burden of proof may really be on the defendant, as, for instance, where the case principally turns upon questions of prior user or prior publication, which are introduced by the defendant. It sometimes happened that this privilege, particularly in cases of conflicting evidence, was of great value, and for the purpose of snatching it from the plaintiff the defendant did not wait for the plaintiff to commence his action, but commenced proceedings himself by *scire facias* to repeal the patent, so as to place himself in the position of plaintiff. But, by sect. 26, sub-sect. 7, of the Act of 1883, it is provided that in cases where it is sought to revoke a patent, "*The defendant shall be entitled to begin and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent, the defendant shall be entitled to reply.*"

In *Westley Richards v. Perkes* (m) the fact of infringement was admitted, and the case turned upon the validity of the plaintiff's patent. Kay, L.J., stopped the plaintiff's counsel after having made out a *primâ facie* case, the burden of proof as to invalidity being on the shoulders of the defendant, and in that case the learned judge gave leave to the defendant's counsel to reply on the whole case. Probably this was owing to the fact that the point that the alleged anticipation was never published was not taken by the plaintiff's counsel until he replied generally to the defendant's case.

The plaintiff must give evidence of the issues, which he is bound to prove. It is for him to support his patent and to establish its validity. He must prove his patent if the grant be denied. This is done by producing the patent itself, with the great seal—or, under the Act of 1883, the seal of the Patent Office—attached to it. Sect. 12, sub-sect. 2, provides that, "*A patent so sealed shall have the same effect as if it were sealed with the great seal of the United Kingdom*"; or under sect. 89, if it be not convenient or possible to produce the original, "*Printed or written copies or*

(l) *Smith v. Upton*, 6 M. & G. 251. (m) 10 P. O. R. 181.

extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, disclaimers, and other documents in the Patent Office, and of or from registers and other books kept there shall be admitted in evidence in all Courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals."

If the plaintiff sues as assignee, or under any derivative title, and his title is denied, the entry from the register of patents may be proved in the manner suggested by the 89th section.

Under the 96th section "*a certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be primâ facie evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.*"

For instance, if an entry in the register is denied by the defendant, he may prove its omission by a certificate under the 96th section.

If the fact of infringement is denied, the plaintiff must be ready with evidence that the defendant has made, used, or sold the articles or process, and any one of these Acts, as we have already seen, will satisfy the allegation of infringement, whether intentional or not (n).

The burden of proving infringement is strictly on the plaintiff, and if he does not satisfactorily prove it there is no necessity of entering upon the defendant's case on other matters. The plaintiff must always give evidence when the alleged infringement is the sale or use of an article, that it was not made by himself or his agents (o).

The plaintiff must, if the matter be put in issue, prove that the title, provisional specification and complete specification, correspond and substantially describe the same invention (γ).

If it is alleged by the defendant that the invention is illegal or useless, the burden of proof is on the plaintiff.

So the plaintiff must be prepared, if he intends to claim

(n) See Chap. XVII.

(p) *Ante*, p. 78, *et seq.*

(o) *Betts v. Willmott*, L.R., 6 Ch. 239.

damages, and not an account, to prove the damage which he has sustained (*q*).

When the defendant alleges that there is a defect or insufficiency in the specification, the burden of proving that there is no such defect is on the plaintiff.

We have seen (*r*) that it is for the jury to say whether a specification is sufficient or intelligible or not; it is for the Court to place a construction upon the language used in the specification. The plaintiff must therefore be prepared with evidence of an expert character as to the sufficiency of the specification; and in selecting this evidence the plaintiff cannot be better guided than by the judgment of Sir George Jessel in *Plimpton v. Malcolmson* (*s*); he must not select eminent engineers or celebrated chemists as the persons to whom the specification must be intelligible, but he must choose "ordinary workmen" in the particular branch of trade to which the invention refers—"not a careless man, but a careful man, though not possessed of that great scientific knowledge or power of invention which would enable him by himself unaided to supplement a defective description or correct an erroneous description." He may, of course, call eminent engineers, but their evidence can only be, "placing myself in the position of an ordinary workman I think it would or would not be intelligible or sufficient to me." If the specification be not sufficiently clear to be understood by an ordinary workman (a witness for the plaintiff), witnesses will not be allowed to be called to explain the intention of the patentee, and the plaintiff will be non-suited (*t*).

An expert witness cannot be asked his opinion as to whether or not there has been infringement. That is a question for the jury, or the Court in the absence of a jury (*u*).

The description of evidence which is admissible in an action for infringement has been considered in an earlier chapter (*v*); questions, however, which may be put to an expert witness in exami-

(*q*) As to measure of damage, see Chap. XVIII., *ante*.

(*r*) *Ante*, p. 93.

(*s*) L. R., 3 Ch. D. 531; see also *ante*, p. 93, *et seq.*

(*t*) *Brooks v. Ripley*, 2 Lond. Jour. C. S. 35.

(*u*) Per Lord Wensleydale, in *Seed v. Higgins*, 8 H. L. Cas. 550.

(*v*) *Ante*, p. 96.

nation in chief differ to some extent from those which may be put in cross-examination. When the witness has stated in his examination that an ordinary workman would make a certain machine from the description contained in the specification, it is open to the counsel on the other side to cross-examine him upon the specification, taking it line by line for the purpose of showing that what he said in the first instance was incorrect, although that method of questioning would not be permitted on examination in chief.

The Court will consider the circumstances of the case, the behaviour of the witnesses and their credibility, when considering the question of infringement or no infringement.

In *Clark v. Adie* (x), Lord Blackburn said:—"Whenever a man knowing for the first time of an invention, either by seeing a machine at work or by reading a specification, proceeds to do what he never did before, and takes a part of the invention, it is always a very strong *argumentum ad hominem* to say: You are, by the very fact of taking this, making evidence against yourself that it was a new invention; otherwise, why did you take it? You are making evidence against yourself that at all events the part you took was new, or why did you take it? and whenever there is a case of theft or stealing knowingly, that observation ought to have some weight, although I think in practice it has more weight given to it than it ought to have. But where there is a case of an innocent infringement of property, by an unwitting use of this sort, that observation can have no weight against the party in the slightest degree, and I think it ought not to have any."

Experiments conducted for the express purpose of manufacturing evidence, with a view to litigation, are to be looked at with distrust (y).

When the defendant pleads that the grantee of the letters patent was not the true and first inventor, or that the invention was not new, it will be sufficient if the plaintiff gives some *primâ facie* evidence of novelty (z). It will be sufficient to call one or

(x) L. R., 2 App. Cas. 337.

(y) *Young v. Fernie*, 4 Giff. 609.

(z) *Turner v. Winter*, 1 T. R. 606 ;

Westley Richards v. Perkes, 10 P. O. R. 181, 186.

two persons acquainted practically with the trade to which the invention refers, to say that they never heard of it, or saw or heard of its having been put in practice or published before the date of the patent. Gibbs, C.J., said: "The first witness, a man of considerable experience, had never seen locks with the lips so perforated; *primâ facie* that is good evidence; but when the question is, whether this had existence previous to the patent, fifty witnesses proving that they never saw it before, would be of no avail if one was called who had seen it and practised it (a).

The plaintiff having given this *primâ facie* evidence, the burden of proof as to prior user or prior publication is shifted to the defendant, and if he would invalidate the patent he must prove his case.

We have previously discussed what amounts to prior use^(a) and prior publication (b). The evidence which the defendant brings must be complete and satisfactory, and the question is one of fact.

If the defendant has succeeded in establishing a case against the plaintiff, the latter will be permitted before the defendant sums up, to adduce rebutting evidence. In *Penn v. Jack and Others* (c), Sir W. Page-Wood, V.-C., said: "I think the plaintiff is entitled to adduce evidence, in reply, for the purpose of rebutting the case set up by the defendants; and for this reason that it is quite impossible for him to know what is the nature of the evidence which is to be produced. The defendants, who contest the validity of the invention, have in effect put in a plea denying the novelty of the plaintiff's patent; and the affirmative of the issue just raised in reality rests with the defendants who are not obliged to give the names of their witnesses. How can the plaintiff possibly meet such a case until he hears the evidence for the defence, and knows what their witnesses will prove? I should be very sorry to have to put the parties to all the expense and delay of a new trial, which I should have to direct, if this evidence were excluded. Besides which, the witnesses are at hand and ready, and the sensible and obvious course is to examine them now. The practice at common law is stated in Taylor on

(a) *Manton v. Manton*, Dav. P. C. 350.

(b) *Ante*, Chap. V.

(c) L. R., 2 Eq., at p. 317.

Evidence; and it appears that where, as here, several issues are joined, the plaintiff may content himself with adducing evidence in support of those issues which he is bound to prove, reserving the right of rebutting his adversary's proofs, in the event of the defendant establishing a *prima facie* case with respect to the issues which lie upon him. In support of this proposition, *Shaw v. Beck* (*d*) is cited, where Parke, B., used the following expression: 'But Abbott, C.J., laid down what appears to me to be a more reasonable rule, by holding that the defendant was bound to prove his plea, and that the plaintiff might answer it by additional evidence.' Other instances are also mentioned, all showing the wide discretion given to the judge in allowing evidence to be given by the plaintiff in reply. The plaintiff has put in his letters patent as formal evidence of his title. The defendants then plead want of novelty, and give, in proof of the issues thus raised by them, special evidence, which the plaintiff is entitled to rebut, by evidence in reply. Regarding this case as one of an affirmative plea, the burden of proving which rests on the defendants, I feel bound to admit the evidence proposed to be given by the plaintiff in reply."

Although the plaintiff may, as of right, rebut the case made by the defendant, upon any issue which rests with the defendant, where the plaintiff has given such rebutting evidence, the defendant will not be allowed to strengthen the case which he had made by adducing further evidence; and this will apply with greater force when the defendant's counsel has summed up the evidence which has been offered (*e*).

At the hearing of the action, no objection will be allowed either to the particulars of objections, or to the particulars of breaches, and any evidence will be received which they are wide enough to admit of. If there is any vagueness or insufficiency in the particulars, the party requiring further information must apply for it to a judge in chambers, within reasonable time before the trial of the action; but they will not be allowed to permit the opposite side to go to trial, and then to submit that for want of sufficient particularity in the objection, the evidence is not admissible (*f*).

(*d*) 8 Ex. 392.

p. 318.

(*e*) *Penn v. Jack*, L. R., 2 Eq., at

(*f*) *Ante*, pp. 290, 301.

Where the defendant alleged a secret process in an action for infringement, the hearing was conducted *in camera*, and the shorthand notes of the trial impounded by order of the Court (g).

QUESTIONS FOR COURT AND JURY.

WE have seen that, as a rule, actions for the infringement of letters patent are directed to be tried before the Court without a jury. Still, under special circumstances, the parties, or either of them, may obtain an order to try before a jury. Under these circumstances it will still be material to consider what are the questions which the Court should leave to the jury, and which are left to the decision of the Court.

As to the specification. The construction is for the Court (h); and the rules of construction are similar to those which govern the construction of other documents (i). In *Hills v. Evans* (k), Lord Westbury said: "It is undoubtedly true, as a proposition of law, that the construction of a specification, as the construction of all other written instruments, belongs to the Court; but a specification of an invention contains most generally, if not always, some technical terms, some phrases of art, some processes, and requires generally the aid of the light derived from what are called surrounding circumstances. It is, therefore, an admitted rule of law that the explanation of the words or technical terms of art, the phrases used in commerce, and the proofs and results of the processes which are described (and in a chemical patent the ascertainment of chemical equivalents), that all these are matters of fact upon which evidence may be given, contradictory testimony may be adduced, and upon which undoubtedly it is the province and the right of a jury to decide. But when these portions of a specification are abstracted and made the subject of evidence, and therefore brought within the province of the jury, the direction to be given to the jury with regard to the construction of the rest of the patent, which is conceived in ordinary language, must be a direction given only conditionally, that is to say, a direction as to the meaning of the

(g) *Badische Anilin und Soda Fabrik v. Levinstein*, L. R., 24 Ch. D. 156.

(h) *Ante*, p. 93, *et seq.*

(i) *Ante*, p. 95.

(k) 31 L. J., Ch. 457.

patent upon the hypothesis or the basis of the jury arriving at a certain conclusion with regard to the meaning of those terms, the signification of those phrases, the truth of those processes, and the result of the technical procedure described in the specification. And so the rule is given by Parke, B., in delivering the judgment of the Court of Exchequer in the case, I think, of *Neilson v. Harford* (1). The language of the learned judge, which I adopt, is in these words: 'The construction of all written instruments belongs to the Court alone, whose duty it is to construe all such instruments as soon as the true meaning of the words in which they are couched and the surrounding circumstances, if any, have been ascertained as facts by the jury; and it is the duty of the jury to take the construction from the Court, either absolutely, if there be no words to be construed as words of art or phrases used in commerce, and no surrounding circumstances to be ascertained, or conditionally, when those words or circumstances are necessarily referred to them.' Now, adopting that as the rule in the comparison of two specifications, each of which is filled with terms of art and with the description of technical processes, the duty of the Court would be confined to this—to give the legal construction of such documents taken independently. But, after that duty is discharged, there would remain a most important function to be still performed, which is the comparison of the two instruments when they have received their legal exposition and interpretation; and as it is always a matter of evidence what external thing is indicated and denoted by any description, when the jury have been informed of the meaning of the description contained in each specification, the work of comparing the two, and ascertaining whether the words, as interpreted by the Court, contained in specification A, do or do not denote the same external matter as the words, as interpreted and explained by the Court, contained in specification B, is a matter of fact, and is, I conceive, a matter within the province of the jury, and not within the function of the Court."

Epitomising this elaborate judgment. When the language used is that which has an ordinary and legal meaning the question is, what has the man said? not what did he intend to

say P and, therefore, the Court will place the legal meaning on his words. When the language used is that which has no ordinary legal meaning, or which under different circumstances may have two or more ordinary legal meanings, the question is, as a fact, with what meaning did the writer use the words or expressions which he has used P and that is a question which the Court should require the jury to solve. The matter could not be placed more lucidly than it is by Lord Westbury in the last dozen lines of the judgment which we have quoted.

It is for the jury to say whether the specification is intelligible (m) or not, and it is for the Court to direct the jury as to the class of persons to whom it must be intelligible (n).

It is for the jury to say whether the specification is sufficient or not, that is, whether it contains a sufficient description of the invention; but it is for the Court to inform the jury the degree of sufficiency which the law requires in specifications (o).

The novelty of the invention is a question for the jury. Questions of prior user or prior publication are always questions of fact, and it is for the jury to compare what has been done before and what is set up as being new, and to say whether or not they are identical. And so any document which is said to amount to prior publication must be construed by the Court, but it is for the jury to compare it with the specification and to say whether the described matter is the same or not (p).

The utility of the invention is also for the jury, subject to the directions of the Court as to the degree of utility which the law requires for the purpose of supporting the validity of a patent (q).

The question of infringement is for the jury. In *De la Rue v.*

(m) *Ante*, pp. 93, 99, *et seq.*

(n) *Ante*, p. 99, *et seq.*

(o) *Hill v. Thompson*, 1 Web. P. C. 235; *Bickford v. Skewes*, 1 Q. B. 938; *Neilson v. Harford*, 1 Web. P. C. 295; *Walton v. Bateman*, 1 Web. P. C. 621; *Beard v. Egerton*, 19 L. J., C. P. 38; *Wallington v. Dale*, 7 Ex. 888; *Parkes v. Stevens*, L. R., 8 Eq. 858; L. R., 5 Ch. 96.

(p) *Cornish v. Keene*, 1 Web. P. C.

519; *Elliott v. Aston*, 1 Web. P. C. 222; *Muntz v. Foster*, 2 Web. P. C. 107; *Spencer v. Jack*, 11 L. T., N. S. 242; also cases quoted *ante*, p. 96.

(q) *Hill v. Thompson*, 1 Web. P. C. 237; *Bloxam v. Elsee*, 1 C. & P. 565; *Cornish v. Keene*, 1 Web. P. C. 506; *Morgan v. Seaward*, 1 Web. P. C. 186; *Macnamara v. Hulse*, C. & M. 471.

Dickenson (r), Campbell, C.J., said :—“ There may well be a case where the judge may and ought to take upon himself to say that the plaintiff has offered no evidence to be left to the jury to prove infringement, as if there were a patent for a chemical composition, and the evidence was that the defendant had constructed and used a machine for combing wool. But, if the evidence has a tendency to show that the defendant has used substantially the same means to obtain the same result as specified by the plaintiff, and scientific witnesses have sworn that the defendant actually has used such means, the question becomes one of fact, mixed with law, which the judge is bound to submit to the jury.”

In *Seed v. Higgins (s)*, Lord Chelmsford in the House of Lords said :—“ What the defendant had done in any case was of course a question of fact, but whether, on proof of certain acts having been done by a defendant, the plaintiff had any case to go to a jury, was a question for the judge ” (*t*).

CERTIFICATES.

SECT. 31 of the Patents, &c., Act, 1883, is as follows :—“ In an action for infringement of a patent, the Court or a judge may certify that the validity of the patent came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges and expenses as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same.”

Similar provisions were contained in 5 & 6 Will. IV. c. 83, and also in the 43rd section of the Patent Law Amendment Act, 1883.

The object of these sections is to prevent patentees of important inventions being ruined by successive actions, which they are bound to bring to restrain infringements, manufacturers banding themselves together to defeat a patentee's rights in this manner.

(*r*) 7 E. & B., at p. 755.

(*s*) 30 L. J., Q. B., at p. 317.

(*t*) See also *Walton v. Potter*, 1 Web. P. C. 586; *Macnamara v. Hulsc*, Car. & M. 471; *Newton v.*

Grand Junction Rail. Co., 5 Ex. 331;

Stevens v. Keating, 2 Web. P. C. 101;

Sellers v. Dickinson, 5 Ex. 323;

Curtis v. Platt, 35 L. J., Ch. 852.

The Act of William IV. cited above gave the patentee a right to treble costs, but this was taken away by 5 & 6 Vict. c. 117, which gave him full costs; and now, as we have seen, costs between solicitor and client are substituted for full costs.

To acquire the protection of the 31st section a certificate is requisite, and this should be applied for at the trial of the action, and the application must be made to the Court or judge who have tried the cause (u).

The Court has no power to order full costs upon the first trial in which the validity of the patent came in question, the words of the statute being "in any subsequent action for infringement" (x).

When a certificate of validity has once been granted, the Court will not grant another in a subsequent action upon the same patent (a).

An action was compromised at the trial by a verdict being entered for the plaintiff in the action for 40*s.* damages and costs, with all usual certificates. Subsequently, upon an *ex parte* application, the judge endorsed on the record a certificate that the record in a certain action, wherein Bovill was plaintiff and Keyworth was defendant, and the certificate thereon endorsed was given in evidence at the trial of this action (*Bovill v. Hadley*), it was held that this certificate was improperly granted, the record and certificate in the former action not having been given in evidence, and it not being under the circumstances a "usual certificate" within the contemplation of the parties (b). Upon the trial of the second action the record of the first action with the endorsement must be produced, but not before the verdict, in such a manner as to prejudice the second trial (c).

It does not appear clear whether or not a certificate might be granted in an action to restrain threats, that the validity of the patent came in question. This point arose in *Crampton v. The Patents Investments Co.* (d), which was an action under section 32.

(u) *Gillett v. Green*, 7 M. & W. 347.

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

(a) *Edison v. Holland*, 6 P. O. R. 243.

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

(c) *Newall v. Wilkins*, 17 L. T. 20.

(d) 5 P. O. R. 382.

In that case it was held that the defendant's patent was valid, and had been infringed; application was made by the counsel for the defendant for a certificate under section 31, Field, J., said: "I entertain great doubt whether I have jurisdiction, and I think the safer course will be for me to give a certificate without prejudice to the validity of it, if it should come into operation (e).

In obtaining this certificate the plaintiff and the country are the parties, not the defendant, and the judge is bound to protect the interests of the country and to see that the certificate is not given when the validity of the patent has not, in fact, been proved to the satisfaction of the Court; otherwise, there is nothing to prevent collusive actions being merely brought for the purpose of obtaining this valuable privilege—a privilege which can be used as an enormous lever, preventing persons from incurring the risk of a conflict with the patentee (f).

Of late years it would seem that these certificates have been granted somewhat too easily, having regard to the importance of the consequences indicated above.

In *Haydock v. Bradbury* (g) the validity of the patent was put in issue by the defence, but the defendant not appearing at the trial, the validity of the patent was not seriously contested. Judgment was given for the plaintiff and a certificate of validity granted.

In *The Delta Metal Co. v. Maxim Nordenfelt Co.* (h), after the trial had been in progress for some days, the parties agreed to a compromise in the following terms: "Judgment for plaintiff on validity of patent. Plaintiffs to be at liberty to ask the judge for a certificate. Judgment for defendants on infringement. Plaintiffs to pay 300% towards the defendants' costs. No other action to be brought on plaintiffs' patent against defendants or their customers."

Judgment was given upon the terms of the compromise. In answer to an application of plaintiffs' counsel for a certificate of validity, Collins, J., said: "I am not asked to pronounce any

(e) At p. 404.

(f) *Stocker v. Rodgers*, 1 C. & K. 99; see also *Peroni v. Hudson*, 1 P. O. R. 261.

(g) 4 P. O. R. 74; also *United Phonograph Co. v. Young*, 11 P. O. R. 492.

(h) 8 P. O. R. 248.

opinion, and I do not pronounce any opinion. It has unquestionably been brought in question, and you have arranged between yourselves how it is to be decided. You will hand the terms in—I do not do anything. I simply give judgment in accordance with the terms of your consent, that is all.” Certificate granted.

In neither of the above cases was the validity of the patent put to the test, and it must be surmised that the certificates were granted in those cases owing to the fact that the judgment of Erle, J., in *Stocker v. Rogers*, referred to above, was not brought under the notice of the judge, owing, in the one case to the absence of, and in the other to the acquiescence by the defendant, and in consequence the *ratio decidendi* of that judgment was not properly taken into consideration by the Court.

In the first of the two cases (*Haydock v. Bradbury*), Kekowich, J., said: “Unless there is some authority to the contrary, I do not see why you should not have a certificate where the defendant retires from the contest.” The counsel for the plaintiff intimated that he did not know of any authority on the point, and a certificate was accordingly granted.

On the authority of the decision in *Haydock v. Bradbury*, a certificate of validity was granted in *The United Phonograph Co. v. Young* (i), in which the circumstances were precisely similar.

The case of *The Delta Metal Co. v. The Maxim Nordenfellt Co.* (*supra*), seems to fall exactly within the evil contemplated by Erle, J., and which he considered it to be so important to avoid.

No appeal will lie from a granting or refusing to grant a certificate that the validity of the patent came in question; such appeal not being from a judgment or order within sect. 19 of the Judicature Act (k).

“In any subsequent action for infringement:” A certificate of validity granted in one action will not affect the costs in another, although decided at a later date, provided that the latter proceedings were instituted before the grant of the certificate in the earlier action (l).

(i) 11 P. O. R. 492.

(k) *Haslam v. Hall*, L. R., 20 Q. B. D. 491; 5 P. O. R. 144.

(l) *The Automatic Weighing Ma-*

chine Co. v. The International Hygienic Soc., 6 P. O. R., at p. 480; see also *Penn v. Fernie*, L. R., 3 Eq. 308.

It does not appear to be quite clearly settled whether or not solicitor and client costs will be allowed in the second action when the validity of the patent is not put in issue. In *The Automatic Weighing Machine Co. v. The International Hygienic Society* (m), Charles, J., expressed an opinion that sect. 31 did not apply if the validity of the patent was not disputed in the subsequent action; and in *Otto v. Steel* (n), solicitor and client costs were refused on the ground that the validity of the patent was disputed upon different grounds to those which were relied upon in the earlier action.

In *The United Telephone Co. v. Townsend* (o), the validity of the patent was not put in issue, a certificate had been granted in an earlier action, Bacon, V.-C., said: "The policy of the Act is, that if a patentee is put to the trouble of bringing an action after he has established his right, the infringer shall pay solicitor and client costs; and that must be the order here."

And in *The United Telephone Co. v. Patterson* (p), Chitty, J., said: "The mere fact of the validity of the patent not being called in question in a subsequent action for infringement is no ground, by itself, for the judge exercising his discretion in favour of the defendant."

"Unless the Court or judge trying the action certifies that he ought not to have the same." This clause gives unlimited discretion to the judge, a discretion which is exercised in view of the facts of each particular case; so where the second action was vexatious (q), or where litigation was the natural consequence of the vague and lax manner in which the specification had been drawn up (r), costs as between solicitor and client were refused (s). The burden is on the defendant to show cause why he should not pay solicitor and client costs under this section (t).

(m) *Ibid.*

(n) 3 P. O. R. 120; but note *The Automatic Weighing Machine Co. v. Fearby*, 10 P. O. R. 442.

(o) 3 P. O. R. 10; see also *United Telephone Co. v. St. George*, 3 P. O. R. 321.

(p) 6 P. O. R. 142.

(q) *Proctor v. Sutton*, 5 P. O. R. 184.

(r) *Automatic Weighing Machine Co. v. National Exhibitions Association*, 8 P. O. R. 352.

(s) See also *Boyd v. The Tootal Broadhurst Lee Co.*, 11 P. O. R., at p. 185.

(t) *United Telephone Co. v. Patterson*, 6 P. O. R. 142; see also *United Telephone Co. v. St. George*, 3 P. O. R. at p. 339.

Sec. 29 of the Act of 1883, after providing for the delivery of particulars of breaches and objections, enacts :—“(6.) On taxation of costs regard shall be had to the particulars delivered by the plaintiff and by the defendant, and they respectively shall not be allowed any costs in respect of any particular delivered by them unless the same is certified by the Court or a judge to have been proven, or to have been reasonable and proper without regard to the general costs of the case.”

Where the plaintiff is successful on some issues, and the defendant on some, the costs should be apportioned (u). In *Badische Anilin Fabrik v. Levinstein* (x), in the Court of Appeal, Bowen, L.J., said: “I am of opinion in this case that the plaintiffs should have the costs occasioned by the issues raised by the particulars of breaches, and that in respect of all the other costs the costs in the action should follow the usual result, and be awarded to the successful party. It seems to me that without laying down any hard-and-fast line, or trying to fetter our discretion at a future period in any other case, we are acting on a sensible and sound principle, namely, the principle that the parties ought not, even if right in the action, to add to the expenses of an action by fighting issues in which they are in the wrong. It may be very reasonable with regard to their own interest, and may help them in the conduct of the action, that they should raise issues in which, in the end, they are defeated, but the defendant who does so does it in his own interest, and I think he ought to do it at his own expense. The order, therefore, I think ought to be as I have stated.”

Costs will be apportioned both where the patent is held to be invalid and the acts alleged to be infringements proved (y), and where the plaintiff fails on the issue of infringement, and suc-

(u) *Wegmann v. Corcoran*, 27 W. R. 357; *Pooley v. Pointon*, 2 P. O. R. at p. 173; *Nordenfelt v. Gardner*, 1 P. O. R., at p. 75.

(x) L. R., 29 Ch. D., at p. 418; 2 P. O. R., at p. 118.

(y) *Ibid.* See also *Young v. Rosenthal*, 1 P. O. R. 41; *Phillips v. Ivel Cycle Co.*, 7 P. O. R., at p. 85; *Bin-*

nington v. Hill, 8 P. O. R., at p. 332; *Cassel Gold Extracting Co. v. Cyanide Gold Recovery Syn.*, 11 P. O. R., at p. 653; but note *United Telephone Co. v. Harrison*, L. R., 21 Ch. D. 720, 747; and *Blakey v. Latham*, 6 P. O. R. 29, 38; also in C. A., 6 P. O. R. 184, 190.

ceeds in upholding his patent (s), but in each of these cases the issues must be perfectly distinct (s).

Where the act of infringement was admitted before the trial, the plaintiffs were not allowed any costs on that issue, their patent being held to be invalid (b).

Where the plaintiffs brought an action for infringement of two patents, but abandoned their case as to one of them at the trial of the action, it was held that the plaintiffs should pay all costs incurred by the defendants so far as occasioned by the claim to the patent so abandoned, although successful in the remainder of their action (c).

The certificates granted under this section must not be confused with the certificate under sect. 31. The object of sect. 29 is to provide what costs shall be payable in the action itself, and the object of sect. 31 is to provide for the costs of future actions.

Care must be taken at the trial to ask the Judge to certify as to each particular breach mentioned in the particulars of breaches, and as to each particular objection; and no costs of witnesses, or of, and incidental to, such breach or objection, as is not specially certified for, will be allowed (d).

Omission to ask the Judge at the trial for his certificate does not preclude the successful party from obtaining it, provided he makes his application within a reasonable time (e).

If an action is not tried out, it is obvious that a difficulty may arise as to costs, since the parties have had no opportunity to prove or disprove their particulars. In *Greaves v. The Eastern Counties Railway Co.* (f), it was held that where the defendant

(s) *Tweddale v. Ashworth*, 7 P. O. R., at p. 435; *Nobel's Explosives Co. v. Anderson*, 11 P. O. R., at p. 128; but note *The Automatic Weighing Machine Co. v. The Combined Weighing Machine Co.*, 6 P. O. R. 387.

(a) *Guilbert-Martin v. Kerr*, 4 P. O. R. 18; *Kaye v. Chubb*, 4 P. O. R., at p. 300; *Ellington v. Clark*, 5 P. O. R. 328; *Parkinson v. Simon*, 11 P. O. R. 238, 256.

(b) *Westley Richards v. Perkes*, 10

P. O. R., at p. 194.

(c) *Hocking v. Fraser*, 3 P. O. R. 3; see also *Edison v. Woodhouse*, 3 P. O. R. 167, 178.

(d) *Horiball v. Bloomer*, 10 Exch. 538; see also *Losh v. Hague*, 5 M. & W. 387; *Parnell v. Mort, Liddell & Co.*, L. R., 29 Ch. D. 325; *Longbottom v. Shaw*, 6 P. O. R. 510.

(e) *Rowcliffe v. Morris*, 8 P. O. R. 145.

(f) 1 E. & E. 961; *Batley v. Ky-*

had delivered particulars of objections, and just before trial the plaintiff had abandoned his action, thus giving the defendant no opportunity of proving or disproving his objections, the defendant was entitled to the costs of the objections and of the witnesses, for the act did not apply, except where the cause came on for trial.

But where the action came on for hearing, and the case breaks down before all the particulars have been tried out, the Court will not go through all those particulars with a view to ascertain whether they are reasonable and proper and can be substantiated, and a certificate will only be granted with respect to those particulars upon which the action was decided (*g*).

The reason of this distinction is that in the first case, that is, when the plaintiff abandons his action before trial, he thereby admits the substantial nature of the objections taken to his patent by the defendant; but in the second case, that is, where judgment is given upon some particular point without the necessity of considering any of the other objections relied on by the defendant, it does not at all follow that the other particulars were proper and could be substantiated, as there is neither judgment of the Court nor admission by the plaintiff to that effect.

No mention is made in sect. 29 to a petition for revocation, so probably in such case the provisions of that section will be held not to apply (*h*).

No costs were allowed a defendant who was successful by reason of anticipations only put in by amendment of his particulars of objections at the trial of the action (*i*).

We have seen that since the Judicature Acts, the Common Law Division and the Chancery Division can either of them grant full relief in an action for the infringement of a patent, granting both an injunction and damages, or an account. In olden times the Common Law Courts merely inquired into damages, and if

noch, L. R., 20 Eq. 632; *Peroni v. Hudson*, 1 P. O. R. 261; *Willoughby v. Taylor*, 11 P. O. R. 45, 55.

(*g*) *Longbottom v. Shaw*, 5 P. O. R. 497, 502; 6 P. O. R. 143, 147; *Boyd v. Horrocks*, 6 P. O. R. 152, 162;

Garrard v. Edge, 6 P. O. R., 372, 533; 7 P. O. R. 139.

(*h*) *Gaulard v. Gibbs' Patent*, 5 P. O. R. 525, 537.

(*i*) *Allen v. Horton*, 10 P. O. R. 412.

less than 40s. was recovered a question arose as to whether or not County Court costs should not alone be allowed; but now in every patent case an injunction may be granted, and this removes the case from the operation of 30 & 31 Vict. c. 142, s. 5.

The Rules of the Supreme Court, 1883, provide for cases where the higher scale and lower scale of costs are to be allowed; and in future, notwithstanding that an injunction is granted, it will be necessary to ask the judge at the trial to certify for costs on the higher scale.

Order LXV. r. 8, provides: "In causes and matters commenced after these rules come into operation, solicitors shall be entitled to charge and be allowed the fees set forth in the column headed 'lower scale,' in Appendix N. in all causes and matters, and no higher fees shall be allowed in any case, except such as are by this order otherwise provided for; and in causes and matters pending at the time when these rules come into operation, to which the higher scale of costs previously in force was applicable, the same scale shall continue to be applied."

Rule 9.—"The fees set forth in the column headed 'higher scale' in Appendix N. may be allowed, either generally in any cause or matter, or as to the costs of any particular application made, or business done, in any cause or matter, if, on special grounds arising out of the nature and importance, or the difficulty or urgency of the case, the Court or a judge shall, at the trial or hearing, or further consideration of the cause or matter, or at the hearing of every application therein, whether the cause or matter shall or shall not be brought to trial or hearing, or to further consideration (as the case may be) so order; or if the taxing officer, under directions given to him for that purpose by the Court or a judge, shall think that such allowance ought to be made upon such special grounds as aforesaid."

Costs on the higher scale are only allowed in cases of exceptional difficulty, where a special class of witnesses was necessary for making clear the points at issue (*k*).

(*k*) *Ellington v. Clark*, 5 P. O. R. 319, 328; *The Automatic Weighing Machine Co. v. The Combined Co.*, 6 P. O. R. 367, 372; *Farbenfabriken*

Vorm F. Bayer & Co. v. Bowker, 8 P. O. R. 389, 397; *Hopkinson v. St. James' Electric Light Co.*, 10 P. O. R. 46, 62.

In *Gadd v. The Mayor, &c., of Manchester* (l), Lindley, L.J., said: "I think costs on the higher scale ought only to be given where there are cases of very unusual difficulty and skill—antiquarian research and things of that kind. The idea of giving costs on the higher scale in all patent cases is one that I will not sanction."

The Courts have of late been very reluctant to order costs on the higher scale (m).

In *The Wenham Gas Co. v. The Champion Gas Co.* (n), costs on the higher scale were refused on the ground that the necessity for scientific evidence was largely due to the unfortunate wording of the specification.

Sect. 49 of the Judicature Act, 1873, provides that there shall be no appeal as to costs; but this was held not to apply where the costs were a matter of right, and not discretionary (o). Under the Rules of Court, which were in operation prior to the 24th October, 1883, the question of higher or lower scale was a matter of right (p). Hence, in *Re Terrell* (q), the Court of Appeal held that there was an appeal, but now it will be observed that the order is in the absolute discretion of the judge, and, therefore, it is submitted there is no appeal.

The directors of a limited company, whose servants have infringed a patent, may be ordered to pay costs personally.

In *Spencer v. The Ancoats Vale Co.* (r), it was ordered that costs on the higher scale should be paid by the defendant company, and by the directors in the event of the company not paying.

Judgment having been recovered, minutes of judgment should be prepared. The minutes will be in accordance with one or other of the precedents given hereafter. We have drawn attention in previous pages to those points which should be attended to in preparing these minutes. Care should be exercised

(l) 9 P. O. R. 516, 535.

(m) Ibid. Also *Edison Bell Phonograph Co. v. Smith & Young*, 11 P. O. R. 148, 160; *Parkinson v. Simon*, 11 P. O. R. 238, 256.

(n) 8 P. O. R., at p. 320.

(o) *Turner v. Hancock*, C. A., L. R., 20 Ch. D. 303.

(p) Rules of S. C., 1875.

(q) L. R., 22 Ch. D. 473.

(r) 6 P. O. R. 46; see also *Betts v. De Vitre*, L. R., 3 Ch. 429.

when an account is directed to be taken that provision be made for the payment of costs to the plaintiff up to and including the hearing, otherwise the payment of all costs will be delayed until the final account has been taken, which in some cases has been known to amount to a delay of years.

A stay will be put upon a judgment pending appeal when the matter at issue is of great importance, and when in the event of the judgment being reversed great injury would otherwise be incurred by the defendant, but in such cases the defendant is ordered to keep an account, and to bring his appeal without delay (s).

PRACTICE ON APPEAL.

UNDER Order LVIII. rule 4, the Court of Appeal has all the powers and duties as to amendment and otherwise of the High Court, together with full discretionary power to receive further evidence upon questions of fact, such evidence to be either by oral examination in Court, by affidavit, or by deposition taken before an examiner or commissioner. Such further evidence may be given without special leave upon interlocutory application, or in any case as to matters which have occurred after the date of the decision from which the appeal is brought. Upon appeals from a judgment after trial or hearing of any cause or matter upon the merits, such further evidence (save as to matters subsequent as aforesaid) shall be admitted on special grounds only, and not without special leave of the Court.

As to further evidence in *Hinde v. Osborne* (t), Lindley, L.J., said: "The power given to the Court of Appeal to hear fresh evidence is an extremely valuable one, and is given by Order LVIII. r. 4. I cannot understand that as meaning that the Court of Appeal ought to grant leave to adduce fresh evidence, simply because a man has failed at the trial and he thinks he can

(s) *The North British Rubber Co. v. Macintosh*, 11 P. O. R. 477, 489; see also *Hocking v. Fraser*, 3 P. O. R. 7; *Kaye v. Chubb*, 4 P. O. R. 27; *Proctor v. Bennis*, 4 P. O. R. 363; *Lyon v. Goddard*, 10 P. O. R. 135. For form of order see *Lyon v. Goddard*, 10 P.

O. R., at p. 136.

(t) 2 P. O. R., at p. 47; instances where fresh evidence was allowed on appeal, *Britain v. Hirsch*, 5 P. O. R. 226; *Spencer v. Ancoats Rubber Co.*, 6 P. O. R. 46; *Blakey v. Latham*, 6 P. O. R., at p. 186.

get more evidence, which, if he had got it before, would have enabled him to succeed on the trial. That cannot be. There must be some ground shown to satisfy the Court that there is some evidence now forthcoming, which, with due diligence, he could not have got, and it must, therefore, in accordance with the usual practice, be evidence, not merely swearing by affidavits or anything of that kind, but something in the nature of the production of a lost document, or something of that sort, which will not expose the parties to a mere flood of affidavits made up to meet the blots and defects which have been disclosed upon the first trial."

As to amendment of pleadings and particulars, in *Cropper v. Smith*, Bowen, L.J., said (u) :—"Now, I think it is a well established principle that the object of Courts is to decide the rights of the parties, and not to punish them for mistakes they make in the conduct of their cases by deciding otherwise than in accordance with their rights. Speaking for myself, and in conformity with what I have heard laid down by the other division of the Court of Appeal, and by myself as a member of it, I know of no kind of error or mistake which, if not fraudulent or intended to overreach, the Court ought not to correct, if it can be done without injustice to the other party. Courts do not exist for the sake of discipline, but for the sake of deciding matters in controversy, and I do not regard such amendment as a matter of favour or of grace."

On appeal to the House of Lords it was held in a case where the Court of Appeal had held the specification bad and for the defendant on the infringement issue, but the House had reversed the decision on the specification and upheld it on the infringement issue, that each party must pay their own costs of the appeal (x).

(u) L. R., 26 Ch. D. 710; instance when amendment was allowed, *Pirrie v. York Street Spinning Company*, 11 P. O. R., at p. 431.

(x) *Moore v. Bennett*, 1 P. O. R., at

p. 148; Griff. P. C. at p. 161; see also as to costs on reversal of decision of C. A. by House of Lords, *The United Horsenail Co. v. Stewart*, 5 P. O. R. 260, 269.

APPENDIX A.

STATUTES.

I.—STATUTE OF MONOPOLIES (1628).

[21 JAC. I. c. 8.]

An Act concerning Monopolies and Dispensations of Penal Laws and the Forfeitures thereof.

FOR as much as your most excellent Majesty, in your royal judgment, and of your blessed disposition to the weal and quiet of your subjects, did in the year of our Lord God 1610, publish in print to the whole realm, and to all posterity, that all grants and monopolies and of the benefit of any penal laws, or of power to dispense with the law, or to compound for the forfeiture, are contrary to your Majesty's laws, which your Majesty's declaration is truly consonant, and agreeable to the ancient and fundamental laws of this your realm. And whereas your Majesty was further graciously pleased expressly to command that no suitor should presume to move your Majesty for matters of that nature: yet, nevertheless, upon misinformations and untrue pretences of public good many such grants have been unduly obtained and unlawfully put in execution, to the great grievance and inconvenience of your Majesty's subjects contrary to the laws of this your realm, and contrary to your Majesty's most royal and blessed intention, so published as aforesaid: For avoiding whereof and preventing of the like in time to come, be it enacted, that all monopolies and all commissions, grants, licences, charters, and letters patent heretofore made or granted, or hereafter to be made or granted, to any person or persons, bodies politic or corporate whatsoever, of or for the sole buying, selling, making, working, or using of anything within this realm or the dominion of Wales, or of any other monopolies, or of power, liberty, or faculty, to dispense with any others, or to give licence or tole-

All monopolies,
&c., shall be
void.

ration to do, use, or exercise anything against the tenor or purport of any law or statute; or to give or make any warrant for any such dispensation, licence, or toleration to be had or made; or to agree or compound with any others for any penalty or forfeiture limited by any statute; or of any grant or promise of the benefit, profit, or commodity of any forfeiture, penalty, or sum of money that is or shall be due by any statute before judgment thereupon had; and all proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things whatsoever, any way tending to the instituting, erecting, strengthening, furthering, or countenancing of the same, or any of them, are altogether contrary to the laws of this realm, and so are and shall be utterly void and of none effect, and in no wise to be put in use or execution.

Monopolies, &c., shall be tried by the common laws of this realm.

2. That all monopolies, and all such commissions, grants, licences, charters, letters patent, proclamations, inhibitions, restraints, warrants of assistance, and all other matters and things tending as aforesaid, and the force and validity of them, and of every of them, ought to be, and shall be for ever hereafter examined, heard, tried, and determined, by and according to the common laws of this realm, and not otherwise.

All persons disabled to use monopolies, &c.

3. That all person and persons, bodies politic and corporate whatsoever, which now are or hereafter shall be, shall stand and be disabled, and incapable to have, use, exercise or put in use any monopoly, or any such commission, grant, licence, charter, letters patent, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, or any liberty, power, or faculty grounded or pretended to be grounded upon them, or any of them.

The party grieved by pretext of a monopoly, &c., shall recover treble damages and double costs.

4. That if any person or persons at any time after the end of forty days next after the end of this present session of parliament shall be hindered, grieved, or disturbed, or disquieted, or his or their goods or chattels any way seized, attached, distrained, taken, carried away, or detained by occasion or pretext of any monopoly, or of any such commission, grant, licence, power, liberty, faculty, letters patent, proclamation, inhibition, restraint, warrant of assistance, or other matter or thing tending as aforesaid, and will sue to be relieved in or for any of the premises, that then and in every such case the same person and persons shall and may have his and their remedy for the same

at the common law by any action or actions to be grounded upon this statute; the same action and actions to be heard and determined in the Courts of King's Bench, Common Pleas, and Exchequer, or in any of them, against him or them by whom he or they shall be so hindered, grieved, disturbed or disquieted, or against him or them by whom his or their goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained; wherein all and every such person and persons which shall be so hindered, grieved, disturbed, or disquieted, or whose goods or chattels shall be so seized, attached, distrained, taken, carried away, or detained, shall recover three times so much as the damages which he or they sustained by means or occasion of being so hindered, grieved, disturbed or disquieted, or by means of having his or their goods or chattels seized, attached, distrained, taken, carried away, or detained, and double costs: and in such suits or for the staying or delaying thereof, no essoign, protection, wager of law, aid, prayer, privilege, injunction, or order of restraint, shall be in any wise prayed, granted, admitted, or allowed, nor any more than one imparlance; and if any person or persons shall after notice given that the action depending is grounded upon this statute, cause or procure any action at the common law grounded upon this statute, to be stayed or delayed before judgment by colour or means of any order, warrant, power, or authority, save only of the court wherein such action as aforesaid shall be brought and depending, or after judgment had upon such action shall cause or procure the execution of or upon any such judgment to be stayed or delayed by colour or means of any order, warrant, power, or authority, save only by writ of error or attain; and then the said person and persons so offending shall incur and sustain the pains, penalties, and forfeitures ordained and provided by the statute of provision and præmunire made in the sixteenth year of the reign of King Richard the Second.

6. Provided also, that any declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures within this realm to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patent and grants shall not use, so as also they be not

What new patents to be good.

contrary to the law nor mischievous to the State by raising prices of commodities at home, or hurt of trade, or generally inconvenient : the said fourteen years to be accounted from the date of the first letters patents or grants of such privilege hereafter to be made, but that the same shall be of such force as they should be if this Act had never been made, and of none other.

Proviso.

7. Provided also, that this Act or anything therein contained shall not in anywise extend or be prejudicial to any grant or privilege, power, or authority whatsoever heretofore made, granted, allowed, or confirmed by any Act of Parliament now in force, so long as the same shall so continue in force.

Warrants
granted to
justices saved.

8. Provided also, that this Act shall not extend to any warrant or privy seal made or directed, or to be made or directed, by His Majesty, his heirs or successors, to the justices of the Courts of the King's Bench or Common Pleas and barons of the Exchequer, justices of assize, justices of oyer and terminer and gaol delivery, justices of the peace, and other justices for the time being, having power to hear and determine offences done against any penal statute, to compound for the forfeitures of any penal statute depending in suit and question before them, or any of them respectively, after plea pleaded by the party defendant.

Charters
granted to
corporations
saved.

9. Provided also, that this Act or anything therein contained shall not in anywise extend or be prejudicial unto the city of London, or to any city, borough, or town corporate within this realm, for or concerning any grants, charters, or letters patent to them, or any of them made or granted, or for or concerning any custom or customs used by or within them or any of them ; or unto any corporation, companies, or fellowships of any art, trade, occupation, or mystery, or to any companies or societies of merchants within this realm erected for the maintenance, enlargement, or ordering of any trade or merchandise ; but that the same charters, customs, corporations, companies, fellowships, and societies, and their liberties, privileges, powers, and immunities, shall be and continue of such force and effect as they were before the making of this Act, and of none other ; anything before in this Act contained to the contrary in any wise notwithstanding.

II.—PATENTS, DESIGNS AND TRADE MARKS ACTS, 1883—88, CONSOLIDATED.

Being—

46 & 47 Vict. c. 57.—An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks.

48 & 49 Vict. c. 68.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

49 & 50 Vict. c. 87.—An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions.

51 & 52 Vict. c. 50.—An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

NOTE.—The general text of the Act of 1883 is adhered to. The repealed parts are printed in italics, and the additions in heavier type. The amending Act and section are quoted in the margin.

Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords, spiritual and temporal, and Commons, in the present Parliament assembled, and by the authority of the same, as follows :—

PART I.—PRELIMINARY.

1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883. Short title.

2. This Act is divided into parts, as follows :—

PART I.—Preliminary.

PART II.—Patents.

PART III.—Designs.

PART IV.—Trade Marks.

PART V.—General.

Division of Act
into parts.

3. This Act, except where it is otherwise expressed, shall Commence-
ment of Act.

commence from and immediately after the 31st day of December, 1883.

PART II.—PATENTS.

Application for and Grant of Patent.

Persons entitled to apply for patent.
Joint application.

4.—(1) Any person, whether a British subject or not, may make an application for a patent [p. 8].

(2) Two or more persons may make a joint application for a patent, and a patent may be granted to them jointly [p. 9].

Act, 1885, s. 5.

Whereas doubts have arisen whether under the principal Act a patent may lawfully be granted to several persons jointly, some or one of whom only are or is the true and first inventors or inventor; be it therefore enacted and declared that it has been and is lawful under the principal Act to grant such a patent [p. 9].

Application and specification.

5.—(1) An application for a patent must be made in the form set forth in the first schedule to this Act, or in such other form as may be from time to time prescribed; and must be left at, or sent by post to, the Patent Office in the prescribed manner (*a*).

Declaration.

(2) An application must contain a declaration to the effect that the applicant is in possession of an invention, whereof he, or in the case of a joint application, one or more of the applicants, claims or claim to be the true and first inventor or inventors, and for which he or they desires or desire to obtain a patent; and must be accompanied by either a provisional or complete specification.

Act, 1885, s. 2.

The declaration may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed (*b*).

Provisional specification.

(3) A provisional specification must describe the nature of the invention, and be accompanied by drawings, if required (*c*).

Complete specification.

(4) A complete specification, whether left on application or subsequently, must particularly describe and ascertain the

(*a*) See Chapter VIII.; as to documents accompanying an application, see P. R. 1890, rr. 8—10; as to application under international arrangements, see P. R. 1890, rr. 24—29; and generally P. R. 1890, rr. 18—23.

(*b*) See pp. 9, 127; as to statutory declarations, see P. R., 1890, rr. 17, 17A.

(*c*) pp. 88—90; as to drawings, see p. 124, and P. R., 1890, rr. 30—33.

nature of the invention, and in what manner it is to be performed, and must be accompanied by drawings, if required [pp. 90, 124].

The requirement of this sub-section as to drawings shall not be deemed to be insufficiently complied with by reason only that instead of being accompanied by drawings the complete specification refers to the drawings which accompanied the provisional specification. And no patent heretofore sealed shall be invalid by reason only that the complete specification was not accompanied by drawings, but referred to those which accompanied the provisional specification (d).

The same drawings may accompany both specifications. Act, 1886, s. 2.

(5) A specification, whether provisional or complete, must commence with the title, and in the case of a complete specification must end with a distinct statement of the invention claimed [pp. 78, 116].

6. The comptroller shall refer every application to an examiner, who shall ascertain and report to the comptroller whether the nature of the invention has been fairly described, and the application, specification, and drawings (if any) have been prepared in the prescribed manner, and the title sufficiently indicates the subject matter of the invention [p. 128].

Reference of application to examiner.

[7. (1) *If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not or have not been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject-matter of the invention, the comptroller may require that the application, specification, or drawings be amended before he proceeds with the application.*

Power for comptroller to refuse application or require amendment. Repealed Act, 1888, s. 2.

(2) *Where the comptroller requires an amendment, the applicant may appeal from his decision to the law officer.*

(3) *The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the application shall be accepted.*

(4) *The comptroller shall, when an application has been accepted, give notice thereof to the applicant.*

(5) *If after an application has been made, but before a patent has been sealed, an application is made, accompanied by a specification bearing the same or a similar title, it shall be the duty of*

(d) See P. R., 1890, r. 33.

the examiner to report to the comptroller whether the specification appears to him to comprise the same invention; and, if he reports in the affirmative, the comptroller shall give notice to the applicants that he has so reported.

(6) *Where the examiner reports in the affirmative, the comptroller may determine, subject to an appeal to the law officer, whether the invention comprised in both applications is the same, and if so he may refuse to seal a patent on the application of the second applicant.]*

Power of
comptroller
to refuse
application
or require
amendment.
Act, 1888, s. 2.

7.—(1) If the examiner reports that the nature of the invention is not fairly described, or that the application, specification, or drawings has not, or have not, been prepared in the prescribed manner, or that the title does not sufficiently indicate the subject matter of the invention, the comptroller may refuse to accept the application, or require that the application, specification or drawings be amended before he proceeds with the application; and in the latter case the application shall, if the comptroller so directs, bear date as from the time when the requirement is complied with [pp. 129, 152].

(2) When the comptroller refuses to accept an application or requires an amendment, the applicant may appeal from his decision to the law officer (e).

(3) The law officer shall, if required, hear the applicant and comptroller, and may make an order determining whether, and subject to what conditions (if any), the application shall be accepted.

(4) The comptroller shall, when an application has been accepted, give notice thereof to the applicant.

(5) If, after an application for a patent has been made, but before the patent thereon has been sealed, another application for a patent is made, accompanied by a specification bearing the same or a similar title, the comptroller, if he thinks fit, on the request of the second applicant, or of his legal representative, may, within two months of the grant of a patent on the first application, either decline to proceed with the second application or allow the surrender of the patent, if any, granted thereon.

(e) See Law Officers' Rules.

8.—(1) If the applicant does not leave a complete specification with his application, he may leave it at any subsequent time within nine months from the date of application [p. 181]. Time for leaving complete specification.

A complete specification may be left within such extended time, not exceeding one month after the said nine months, as the comptroller may on payment of the prescribed fee allow (f). Act, 1885, s. 3.

(2) Unless a complete specification is left within that time the application shall be deemed to be abandoned. When specification deemed abandoned.

9.—(1) Where a complete specification is left after a provisional specification, the comptroller shall refer both specifications to an examiner for the purpose of ascertaining whether the complete specification has been prepared in the prescribed manner, and whether the invention particularly described in the complete specification is substantially the same as that which is described in the provisional specification [p. 181]. Comparison of provisional and complete specification.

(2) If the examiner reports that the conditions hereinbefore contained have not been complied with, the comptroller may refuse to accept the complete specification unless and until the same shall have been amended to his satisfaction; but any such refusal shall be subject to appeal to the law officer. Power of comptroller to refuse until amended.

(3) The law officer shall, if required, hear the applicant and the comptroller, and may make an order determining whether and subject to what conditions, if any, the complete specification shall be accepted. Power of law officer.

(4) Unless a complete specification is accepted within twelve months from the date of application, then (save in the case of an appeal having been lodged against the refusal to accept) the application shall, at the expiration of those twelve months, become void. When specification void.

A complete specification may be accepted within such extended time, not exceeding three months after the said twelve months, as the comptroller may on payment of the prescribed fee allow. Act, 1885, s. 3.

(5) Reports of examiners shall not in any case be published or be open to public inspection, and shall not be liable to production or inspection in any legal proceeding [other than an appeal to the law officer under this Act], unless the court or officer having power to order discovery in such legal proceeding Reports of examiners to be private. Act, 1888, s. 3.

(f) See P. R., 1890, rr. 49—51.

shall certify that such production or inspection is desirable in the interests of justice, and ought to be allowed.

Advertisement on acceptance of complete specification.

10. On the acceptance of the complete specification the comptroller shall advertise the acceptance; and the application and specification or specifications with the drawings (if any) shall be open to public inspection [p. 132 (g)].

Opposition to grant of patent. Time and grounds for.

11.—(1) Any person may at any time within two months from the date of the advertisement of the acceptance of a complete specification give notice at the Patent Office of opposition to the grant of the patent on the ground of the applicant having obtained the invention from him, or from a person of whom he is the legal representative, or on the ground that the invention has been patented in this country on an application of prior date [or on the ground of an examiner having reported to the comptroller that the specification appears to him to comprise the same invention as is comprised in a specification bearing the same or a similar title and accompanying a previous application], or on the ground that the complete specification describes or claims an invention other than that described in the provisional specification, and that such other invention forms the subject of an application made by the opponent in the interval between the leaving of the provisional specification and the leaving of the complete specification, but on no other ground (h).

Repealed Act, 1888, s. 4.

Act, 1888, s. 4.

After notice comptroller to decide.

(2) Where such notice is given the comptroller shall give notice of the opposition to the applicant, and shall, on the expiration of those two months, after hearing the applicant and the person so giving notice, if desirous of being heard, decide on the case, but subject to appeal to the law officer [p. 141].

Or on appeal, law officer.

(3) The law officer shall, if required, hear the applicant and any person so giving notice and being, in the opinion of the law officer, entitled to be heard in opposition to the grant, and shall determine whether the grant ought or ought not to be made [p. 141].

Who may obtain expert's assistance.

(4) The law officer may, if he thinks fit, obtain the assistance of an expert, who shall be paid such remuneration as the law officer, with the consent of the treasury, shall appoint [p. 142].

Sealing of patent.

12.—(1) If there is no opposition, or, in case of opposi-

When sealed.

(g) See P. R., 1890, rr. 21, 22.

(h) See Chapter IX., "Opposition," P. R., 1890, rr. 84—44.

tion, if the determination is in favour of the grant of a patent, the comptroller shall cause a patent to be sealed with the seal of the Patent Office [p. 143].

(2) A patent so sealed shall have the same effect as if it were sealed with the great seal of the united kingdom [p. 143].

Great seal abolished for patents.

(3) A patent shall be sealed as soon as may be, and not after the expiration of fifteen months from the date of the application, except in the cases hereinafter mentioned, that is to say—

Time for sealing.

Exceptions to limit.

(a) Where the sealing is delayed by an appeal to the law officer, or by opposition to the grant of the patent, the patent may be sealed at such time as the law officer may direct.

(a) For legal proceedings.

(b) If the person making the application dies before the expiration of the fifteen months aforesaid, the patent may be granted to his legal representative and sealed at any time within twelve months after the death of the applicant.

(b) When applicant dead.

A complete specification may be left and accepted within such extended times, not exceeding one month and three months respectively after the said nine months and twelve months respectively, as the comptroller may, on payment of the prescribed fee allow, and where such extension of time has been allowed, a further extension of four months after the said fifteen months shall be allowed for the sealing of the patent; and the principal Act shall have effect as if any time so allowed were added to the said periods specified in the principal Act.

Extension of time for sealing. Act, 1885, s. 3.

13. Every patent shall be dated and sealed as of the day of the application : provided that no proceedings shall be taken in respect of an infringement committed before the publication of the complete specification : provided also, that in case of more than one application for a patent for the same invention, the sealing of a patent on one of those applications shall not prevent the sealing of a patent on an earlier application [pp. 132, 143].

Date of patent.

When an application for a patent has been abandoned, or become void, the specification or specifications and drawings (if any) accompanying or left in connection with such application, shall not at any time be open to public inspection or be published by the comptroller.

Application abandoned, specification not to be published. Act, 1885, s. 4.

Provisional Protection.

Provisional protection.

14. Where an application for a patent in respect of an invention has been accepted, the invention may during the period between the date of the application and the date of sealing such patent be used and published without prejudice to the patent to be granted for the same; and such protection from the consequences of use and publication is in this Act referred to as provisional protection [pp. 19, 88, 182].

Protection by Complete Specification.

Effect of acceptance of complete specification.

15. After the acceptance of a complete specification and until the date of sealing a patent in respect thereof, or the expiration of the time for sealing, the applicant shall have the like privileges and rights as if a patent for the invention had been sealed on the date of the acceptance of the complete specification: provided that an applicant shall not be entitled to institute any proceeding for infringement unless and until a patent for the invention has been granted to him [pp. 90, 138].

Patent.

Extent of patent.

16. Every patent when sealed shall have effect throughout the united kingdom and the Isle of Man.

Term of patent.

17.—(1) The term limited in every patent for the duration thereof shall be fourteen years from its date.

Ceases on failure of payments.

(2) But every patent shall, notwithstanding anything therein or in this Act, cease if the patentee fails to make the prescribed payments within the prescribed times (i).

Exception by application to comptroller.

(3) If, nevertheless, in any case, by accident, mistake or inadvertence, a patentee fails to make any prescribed payment within the prescribed time, he may apply to the comptroller for an enlargement of the time for making that payment.

Extension of time for payment upon terms.

(4) Thereupon the comptroller shall, if satisfied that the failure has arisen from any of the above-mentioned causes, on receipt of the prescribed fee for enlargement, not exceeding ten pounds, enlarge the time accordingly, subject to the following conditions:

(a) Period of extension.

(a) The time for making any payment shall not in any case be enlarged for more than three months.

(b) Damages for infringement in the interval.

(b) If any proceeding shall be taken in respect of an in-

(i) See P. R. 1890, rr. 45—48.

fringement of the patent committed after a failure to make any payment within the prescribed time, and before the enlargement thereof, the court before which the proceeding is proposed to be taken may, if it shall think fit, refuse to award or give any damages in respect of such infringement.

Amendment of Specification.

18.—(1) An applicant or a patentee may, from time to time, by request in writing left at the patent office, seek leave to amend his specification, including drawings forming part thereof, by way of disclaimer, correction, or explanation, stating the nature of such amendment and his reasons for the same (k). Amendment of specification.

(2) The request and the nature of such proposed amendment shall be advertised in the prescribed manner, and at any time within one month from its first advertisement any person may give notice at the patent office of opposition to the amendment [p. 158]. Advertisement of amendment and notice of opposition to be given.

(3) Where such notice is given the comptroller shall give notice of the opposition to the person making the request, and shall hear and decide the case subject to an appeal to the law officer [p. 159]. Where notice given comptroller decides.

(4) The law officer shall, if required, hear the person making the request and the person so giving notice, and being in the opinion of the law officer entitled to be heard in opposition to the request, and shall determine whether and subject to what conditions, if any, the amendment ought to be allowed [p. 159]. Appeal to law officer.

(5) Where no notice of opposition is given, or the person so giving notice does not appear, the comptroller shall determine whether and subject to what conditions, if any, the amendment ought to be allowed [p. 162]. Where no notice comptroller determines conditions of amendment.

(6) When leave to amend is refused by the comptroller, the person making the request may appeal from his decision to the law officer [p. 162].

(7) The law officer shall, if required, hear the person making the request, and the comptroller, and may make an order determining whether, and subject to what conditions, if any, the amendment ought to be allowed [p. 163]. Appeal to law officer.

(k) See Chapter XI., also P. R., 1890, rr. 52—59.

No amendment allowed so as to enlarge or alter materially specification.

(8) No amendment shall be allowed that would make the specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the specification as it stood before amendment [p. 168].

Leave conclusive except in case of fraud; amendment forms part of specification.

(9) Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in case of fraud; and the amendment shall in all courts and for all purposes be deemed to form part of the specification [p. 166].

Repealed Act, 1888, s. 5.

(10) [*The foregoing provisions of this section do not apply when and so long as any action for infringement or other legal proceeding in relation to a patent is pending.*]

Proceedings pending. Act, 1888, s. 5.

(10) The foregoing provisions of this section do not apply when and so long as any action for infringement or proceeding for revocation of a patent is pending [p. 169].

Power to disclaim part of invention during action, &c.

19.—(1) In an action for infringement of a patent, and in a proceeding for revocation of a patent, the court or a judge may at any time order that the patentee shall, subject to such terms as to costs and otherwise as the court or a judge may impose, be at liberty to apply at the Patent Office for leave to amend his specification by way of disclaimer, and may direct that in the meantime the trial or hearing of the action shall be postponed [p. 170].

Restriction on recovery of damages.

20. Where an amendment by way of disclaimer, correction, or explanation, has been allowed under this Act, no damages shall be given in any action in respect of the use of the invention before the disclaimer, correction or explanation, unless the patentee establishes to the satisfaction of the court that his original claim was framed in good faith and with reasonable skill and knowledge [p. 172].

Advertisement of amendment.

21. Every amendment of a specification shall be advertised in the prescribed manner [p. 174].

Compulsory Licences.

Power for Board of Trade to order grant of licences.

22. If on the petition of any person interested it is proved to the Board of Trade that by reason of the default of a patentee to grant licences on reasonable terms— [p. 181] (1)

(a) The patent is not being worked in the United Kingdom;

OR

(1) See P. R., 1890, rr. 60—66.

(b) The reasonable requirements of the public with respect to the invention cannot be supplied ; or

(c) Any person is prevented from working or using to the best advantage an invention of which he is possessed, the Board may order the patentee to grant licences on such terms as to the amount of royalties, security for payment, or otherwise, as the Board, having regard to the nature of the invention and the circumstances of the case, may deem just, and any such order may be enforced by mandamus.

Register of Patents.

23.—(1) There shall be kept at the Patent Office a book called the Register of Patents, wherein shall be entered the names and addresses of grantees of patents, notifications of assignments and of transmissions of patents, of licences under patents, and of amendments, extensions, and revocations of patents, and such other matters affecting the validity or proprietorship of patents as may from time to time be prescribed [p. 185] (*m*). Register of patents.
Where to be kept and contents.

(2) The register of patents shall be *prima facie* evidence of any matters by this Act directed or authorised to be inserted therein. Is evidence.

(3) Copies of deeds, licences, and any other documents affecting the proprietorship in any letters patent or in any licence thereunder, must be supplied to the comptroller in the prescribed manner for filing in the patent office. Copies for filing.

Fees.

24.—(1) There shall be paid in respect of the several instruments described in the second schedule to this Act, the fees in that schedule mentioned, and there shall likewise be paid, in respect of other matters under this part of the Act, such fees as may be from time to time, with the sanction of the treasury, prescribed by the Board of Trade ; and such fees shall be levied and paid to the account of her Majesty's exchequer in such manner as the treasury may from time to time direct. Fees payable.

(2) The Board of Trade may from time to time, if they think fit, with the consent of the treasury, reduce any of those fees. Power to reduce fees.

(*m*) See P. R., 1890, rr. 67—79.

Extension of Term of Patent.

Extension of term of patent on petition to Queen in council.

When applied for.

Entry of caveat.

Privy Council jurisdiction.

Powers of judicial committee.

On their report extension granted on conditions.

Power to make rules for such proceedings.

Costs.

Abolition of scire facias.

25.—(1) A patentee may, after advertising in manner directed by any rules made under this section his intention to do so, present a petition to her Majesty in council, praying that his patent may be extended for a further term; but such petition must be presented at least six months before the time limited for the expiration of the patent [pp. 195 *et seq.*].

(2) Any person may enter a caveat, addressed to the registrar of the council at the council office, against the extension.

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

(4) The judicial committee shall, in considering their decision, have regard to the nature and merits of the invention in relation to the public, to the profits made by the patentee as such, and to all the circumstances of the case [p. 197].

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

(6) It shall be lawful for her Majesty in council to make, from time to time, rules of procedure and practice for regulating proceedings on such petitions, and subject thereto such proceedings shall be regulated according to the existing procedure and practice in patent matters of the judicial committee [p. 196].

(7) The costs of all parties of and incident to such proceedings shall be in the discretion of the judicial committee; and the orders of the committee respecting costs shall be enforceable as if they were orders of a division of the high court of justice.

Revocation.

26.—(1) The proceeding by scire facias to repeal a patent is hereby abolished [pp. 266 *et seq.*]

(2) Revocation of a patent may be obtained on petition to the court. Revocation of patent.

(3) Every ground on which a patent might, at the commencement of this Act, be repealed by scire facias shall be available by way of defence to an action of infringement, and shall also be a ground of revocation. How revocation obtained.
Grounds of revocation.

(4) A petition for revocation of a patent may be presented by— Petition for revocation, who may present.

(a) The attorney-general in England or Ireland, or the lord advocate in Scotland : [p. 268].

(b) Any person authorised by the attorney-general in England or Ireland, or the lord advocate in Scotland : [p. 269].

(c) Any person alleging that the patent was obtained in fraud of his rights, or of the rights of any person under or through whom he claims : [pp. 268, 269].

(d) Any person alleging that he, or any person under or through whom he claims, was the true inventor of any invention included in the claim of the patentee :

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

(5) The plaintiff must deliver with his petition particulars of the objections on which he means to rely, and no evidence shall, except by leave of the Court or a judge, be admitted in proof of any objection of which particulars are not so delivered [p. 301]. Plaintiff must deliver and be bound by particulars.

(6) Particulars delivered may be from time to time amended by leave of the Court or a judge [p. 302]. Amendment of particulars.

(7) The defendant shall be entitled to begin, and give evidence in support of the patent, and if the plaintiff gives evidence impeaching the validity of the patent, the defendant shall be entitled to reply [p. 319]. Patentee though defendant has privileges of plaintiff at trial.

(8) Where a patent has been revoked on the ground of fraud, the comptroller may, on the application of the true inventor, made in accordance with the provisions of this Act, grant to him a patent in lieu of and bearing the same date as the date of revocation of the patent so revoked, but the patent Where patent revoked for fraud, first true inventor may obtain patent.

so granted shall cease on the expiration of the term for which the revoked patent was granted [p. 269].

Crown.

Patent to
bind crown.

27.—(1) A patent shall have to all intents the like effect as against Her Majesty the Queen, her heirs and successors, as it has against a subject [p. 151].

Exceptions.

(2) But the officers or authorities administering any department of the service of the Crown may, by themselves, their agents, contractors, or others, at any time after the application, use the invention for the services of the Crown on terms to be before or after the use thereof agreed on, with the approval of the treasury, between those officers or authorities and the patentee, or, in default of such agreement, on such terms as may be settled by the treasury after hearing all parties interested [p. 151].

Legal Proceedings.

Hearing with
assessor.
By court.

28.—(1) In an action or proceeding for infringement or revocation of a patent, the Court may, if it thinks fit, and shall, on the request of either of the parties to the proceeding, call in the aid of an assessor specially qualified, and try and hear the case wholly or partially with his assistance; the action shall be tried without a jury unless the Court shall otherwise direct [p. 314].

Court of appeal
or privy council
may sit with
assessors.

(2) The Court of Appeal or the judicial committee of the privy council may, if they see fit, in any proceeding before them respectively, call in the aid of an assessor as aforesaid.

Assessors' fees.

(3) The remuneration, if any, to be paid to an assessor under this section shall be determined by the Court or the Court of Appeal or judicial committee, as the case may be, and be paid in the same manner as the other expenses of the execution of this Act.

Delivery of
particulars
of breaches;

29.—(1) In an action for infringement of a patent the plaintiff must deliver with his statement of claim, or by order of the Court or the judge, at any subsequent time, particulars of the breaches complained of [p. 286].

of objections.

(2) The defendant must deliver, with his statement of defence, or, by order of the Court or a judge, at any subsequent time, particulars of any objections on which he relies in support thereof [pp. 293 *et seq.*].

(8) If the defendant disputes the validity of the patent, the particulars delivered by him must state on what grounds he disputes it, and if one of those grounds is want of novelty, must state the time and place of the previous publication or user alleged by him [p. 294]. Grounds must be stated.

(4) At the hearing no evidence shall, except by leave of the Court or a judge, be admitted in proof of any alleged infringement or objection of which particulars are not so delivered [pp. 290, 301]. Evidence must not go beyond particulars.

(5) Particulars delivered may be, from time to time, amended, by leave of the Court or a judge [p. 303]. Amendment.

(6) On taxation of costs, regard shall be had to the particulars delivered by the plaintiff and by the defendant; and they respectively shall not be allowed any costs in respect of any particular delivered by them, unless the same is certified by the Court or a judge to have been proven, or to have been reasonable and proper, without regard to the general costs of the case [pp. 333 *et seq.*]. Costs.

30. In an action for infringement of a patent, the Court or a judge may, on the application of either party, make such order for an injunction, inspection, or account, and impose such terms and give such directions respecting the same and the proceedings thereon as the Court or a judge may see fit [p. 310]. Order for inspection, &c., in action.

31. In an action for infringement of a patent, the Court or a judge may certify that the validity of a patent came in question; and if the Court or a judge so certifies, then in any subsequent action for infringement, the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses, as between solicitor and client, unless the Court or judge trying the action certifies that he ought not to have the same [pp. 328 *et seq.*]. Certificate that validity questioned.

32. Where any person claiming to be the patentee of an invention by circulars, advertisements, or otherwise, threatens any other person with any legal proceedings or liability in respect of any alleged manufacture, use, sale, or purchase of the invention, any person or persons aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may recover such damage (if any) as may have been sustained thereby, if the alleged manufacture, use, sale, or purchase to Remedy in case of groundless threats of legal proceedings.

which the threats related was not, in fact, an infringement of any legal rights of the person making such threats : Provided that this section shall not apply if the person making such threats with due diligence commences and prosecutes an action for infringement of his patent [pp. 274 *et seq.*].

Miscellaneous.

Patent for one invention only.

33. Every patent may be in the form in the first schedule to this Act, and shall be granted for one invention only, but may contain more than one claim ; but it shall not be competent for any person in any action or other proceeding to take any objection to a patent on the ground that it comprises more than one invention [pp. 128, 216].

Patent on application of representative of deceased inventor.

34. (1) If a person possessed of an invention dies without making application for a patent for the invention, application may be made by, and a patent for the invention granted to his legal representative [pp. 10, 176].

Time and contents of application.

(2) Every such application must be made within six months of the decease of such person, and must contain a declaration by the legal representative that he believes such person to be the true and first inventor of the invention.

Patent to first inventor not invalidated by application in fraud of him.

35. A patent granted to the true and first inventor shall not be invalidated by an application in fraud of him, or by provisional protection obtained thereon, or by any use or publication of the invention subsequent to that fraudulent application during the period of provisional protection [p. 18].

Assignment for particular places.

36. A patentee may assign his patent for any place in or part of the United Kingdom, or Isle of Man, as effectually as if the patent were originally granted to extend to that place, or part only [pp. 177, 210, 216].

Loss or destruction of patent.

37. If a patent is lost or destroyed, or its non-production is accounted for to the satisfaction of the comptroller, the comptroller may, at any time, cause a duplicate thereof to be sealed.

Proceedings and costs before law officer.

38. The law officers may examine witnesses on oath, and administer oaths for that purpose under this part of this Act, and may, from time to time, make, alter, and rescind rules, regulating references and appeals to the law officers, and the practice and procedure before them under this part of this Act ; and in any proceeding before either of the law officers under this part of this Act, the law officer may order costs to

be paid by either party, and any such order may be made a rule of the Court [p. 142 (n)].

39. The exhibition of an invention at an industrial or international exhibition, certified as such by the Board of Trade, or the publication of any description of the invention during the period of the holding of the exhibition, or the use of the invention for the purpose of the exhibition in the place where the exhibition is held, or the use of the invention during the period of the holding of the exhibition by any person elsewhere, without the privity or consent of the inventor, shall not prejudice the right of the inventor or his legal personal representative to apply for and obtain provisional protection and a patent in respect of the invention or the validity of any patent granted on the application, provided that both the following conditions are complied with, namely,—[p. 68].

Exhibition at industrial or international exhibition not to prejudice patent rights.

(a) The exhibitor must, before exhibiting the invention, give the comptroller the prescribed notice of his intention to do so ; and

Conditions :
(a) Notice ;

(b) The application for a patent must be made before or within six months from the date of the opening of the exhibition.

(b) Patent must be applied for.

Whereas it is expedient to provide for the extension of this section to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows :

It shall be lawful for Her Majesty, by Order in Council, from time to time to declare that sections 39 and 57 of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order, in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the condition, specified in the said sections, of giving notice to the comptroller of his intention to exhibit, and shall be so relieved, either absolutely or upon such terms and conditions as to Her Majesty in Council may seem fit.

Protection of patents and designs exhibited at international exhibitions.
Act, 1886, s. 3.

40.—(1) The comptroller shall cause to be issued periodically an illustrated journal of patented inventions, as well as reports of patent cases decided by courts of law, and

Publication of illustrated journal, indexes, &c.

(n) See Law Officers' Rules.

any other information that the comptroller may deem generally useful or important.

Copies to be on sale.

(2) Provision shall be made by the comptroller for keeping on sale copies of such journal, and also of all complete specifications of patents for the time being in force, with their accompanying drawings, if any.

Continuation of publication.

(3) The comptroller shall continue, in such form as he may deem expedient, the indexes and abridgements of specifications hitherto published, and shall from time to time prepare and publish such other indexes, abridgements of specifications, catalogues, and other works relating to inventions, as he may see fit.

Patent museum.

41. The control and management of the existing patent museum and its contents shall, from and after the commencement of this Act, be transferred to and vested in the department of science and art, subject to such directions as Her Majesty in council may see fit to give.

Power to require models on payment.

42. The department of science and art may at any time require a patentee to furnish them with a model of his invention on payment to the patentee of the cost of the manufacture of the model ; the amount to be settled, in case of dispute, by the Board of Trade.

Foreign vessels in British waters.

43.—(1) A patent shall not prevent the use of an invention for the purposes of the navigation of a foreign vessel within the jurisdiction of any of Her Majesty's Courts in the United Kingdom, or Isle of Man, or the use of an invention in a foreign vessel within that jurisdiction, provided it is not used therein for or in connection with the manufacture or preparation of anything intended to be sold in or exported from the United Kingdom or Isle of Man [p. 242].

Exception.

(2) But this section shall not extend to vessels of any foreign state of which the laws authorise subjects of such foreign state, having patents or like privileges for the exclusive use or exercise of inventions within its territories, to prevent or interfere with the use of such inventions in British vessels while in the ports of such foreign state, or in the waters within the jurisdiction of its Courts, where such inventions are not so used for the manufacture or preparation of anything intended to be sold in or exported from the territories of such foreign state.

Assignment to secretary for

44.—(1) The inventor of any improvement in instruments

or munitions of war, his executors, administrators, or assigns (who are in this section comprised in the expression the inventor), may (either for or without valuable consideration) assign to her Majesty's principal secretary of state for the war department (hereinafter referred to as the secretary of state), on behalf of Her Majesty, all the benefit of the invention and of any patent obtained or to be obtained for the same; and the secretary of state may be a party to the assignment [pp. 151, 468].

war of certain inventions.

(2) The assignment shall effectually vest the benefit of the invention and patent in the secretary of state for the time being on behalf of Her Majesty, and all covenants and agreements therein contained for keeping the invention secret and otherwise shall be valid and effectual (notwithstanding any want of valuable consideration), and may be enforced accordingly by the secretary of state for the time being.

Extent of assignment.

(3) Where any such assignment has been made to the secretary of state, he may at any time before the application for a patent for the invention, or before publication of the specification or specifications, certify to the comptroller his opinion that, in the interest of the public service, the particulars of the invention and of the manner in which it is to be performed should be kept secret.

Power of secretary of state for war to keep invention secret on certifying that it is in public interest to do so.

(4) If the secretary of state so certifies, the application and specification or specifications, with the drawings (if any), and any amendment of the specification or specifications, and any copies of such documents and drawings, shall, instead of being left in the ordinary manner at the Patent Office, be delivered to the comptroller in a packet sealed by authority of the secretary of state.

In which case specifications and documents are sealed up.

(5) Such packet shall, until the expiration of the term or extended term during which a patent for the invention may be in force, be kept sealed by the comptroller, and shall not be opened save under the authority of an order of the secretary of state, or of the law officers.

For term of patent.

(6) Such sealed packet shall be delivered at any time during the continuance of the patent to any person authorised by writing under the hand of the secretary of state to receive the same, and shall if returned to the comptroller be again kept sealed by him.

Delivery of packet under secretary of state's authority during term.

At expiration. (7) On the expiration of the term or extended term of the patent, such sealed packet shall be delivered to any person authorised by writing under the hand of the secretary of state to receive it.

Foregoing subsections to apply where patent applied for but specifications not published. (8) Where the secretary of state certifies as aforesaid after an application for a patent has been left at the Patent Office, but before the publication of the specification or specifications, the application, specification or specifications, with the drawings (if any), shall be forthwith placed in a packet sealed by authority of the comptroller, and such packet shall be subject to the foregoing provisions respecting a packet sealed by authority of the secretary of state.

Where certified by secretary of state no petition for revocation. (9) No proceeding by petition or otherwise shall lie for revocation of a patent granted for an invention in relation to which the secretary of state has certified as aforesaid [p. 269].

No copy of any secret specifications to be made public. (10) No copy of any specification or other document or drawing by this section required to be placed in a sealed packet, shall in any manner whatever be published or open to the inspection of the public, but save as in this section otherwise directed, the provisions of this part of this Act shall apply in respect of any such invention and patent as aforesaid.

Power of secretary of state to waive benefit of section. (11) The secretary of state may, at any time by writing under his hand, waive the benefit of this section with respect to any particular invention, and the specifications, documents and drawings shall be thenceforth kept and dealt with in the ordinary way.

Communication to secretary of state for war not to be deemed publication. (12) The communication of any invention for any improvement in instruments or munitions of war to the secretary of state, or to any person or persons authorised by him to investigate the same or the merits thereof, shall not, nor shall anything done for the purposes of the investigation, be deemed use or publication of such invention so as to prejudice the grant or validity of any patent for the same.

Existing Patents.

Provisions respecting existing patents. 45.—(1) The provisions of this Act relating to applications for patents and proceedings thereon shall have effect in respect only of applications made after the commencement of this Act.

(2) Every patent granted before the commencement of this Act, or on an application then pending, shall remain unaffected by the provisions of this Act relating to patents binding the Crown, and to compulsory licences [p. 208].

(3) In all other respects (including the amount and time of payment of fees) this Act shall extend to all patents granted before the commencement of this Act, or on applications then pending, in substitution for such enactments as would have applied thereto, if this Act had not been passed [p. 208].

(4) All instruments relating to patents granted before the commencement of this Act required to be left or filed in the great seal Patent Office shall be deemed to be so left or filed if left or filed before or after the commencement of this Act in the Patent Office.

Documents left at great seal Patent Office deemed left at Patent Office on commencement of this Act.

Definitions.

46. In and for the purposes of this Act—

Definitions of

“ Patent ” means letters patent for an invention :

“ Patent ; ”

“ Patentee ” means the person for the time being entitled to the benefit of a patent : [p. 7].

“ Patentee ; ”

“ Invention ” means any manner of new manufacture the subject of letters patent and grant of privilege within sect. 6 of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter 3, intituled, “ An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof ”), and includes an alleged invention [p. 26].

“ Invention ; ”

In Scotland “ injunction ” means “ interdict.”

“ Injunction ” in Scotland.

PART III.—DESIGNS.

Registration of Designs.

47.—(1) The comptroller may, on application by or on behalf of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this part of this Act.

Application for registration of designs.

(2) The application must be made in the form set forth in the first schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the Patent Office in the prescribed manner.

(3) The application must contain a statement of the nature

of the design, and the class or classes of goods in which the applicant desires that the design be registered.

(4) The same design may be registered in more than one class.

(5) In case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.

(6) The comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal therefrom to the Board of Trade.

(7) The Board of Trade shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

Drawings, &c.,
to be furnished
on application.

48.—(1) On application for registration of a design the applicant shall furnish to the comptroller the prescribed number of copies of drawings, photographs, or tracings of the designs sufficient, in the opinion of the comptroller, for enabling him to identify the design; or the applicant may, instead of such copies, furnish exact representations or specimens of the design.

(2) The comptroller may, if he thinks fit, refuse any drawing, photograph, tracing, representation, or specimen which is not, in his opinion, suitable for the official records.

Certificate of
registration.

49.—(1) The comptroller shall grant a certificate of registration to the proprietor of the design when registered.

(2) The comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, grant a copy or copies of the certificate.

Copyright in Registered Designs.

Copyright on
registration.

50.—(1) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration.

(2) Before delivery on sale of any articles to which a registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration), furnish to the comptroller the prescribed number of exact representations or specimens of the design;

and if he fails to do so, the comptroller may erase his name from the register, and thereupon his copyright in the design shall cease.

51. Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words or figures, denoting that the design is registered; and if he fails to do so the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article.

Marking
registered
designs.

52.—(1) During the existence of copyright in a design, the design shall not be open to inspection except by the proprietor, or a person authorised in writing by the proprietor, or a person authorised by the comptroller or by the Court, and furnishing such information as may enable the comptroller to identify the design, nor except in the presence of the comptroller, or of an officer acting under him, nor except on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof.

Inspection of
registered
designs.

“Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.”

Act, 1888,
s. 6.

(2) When the copyright in a design has ceased, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

53. On the request of any person producing a particular design, together with its mark of registration, or producing only its mark of registration, or furnishing such information as may enable the comptroller to identify the design, and on payment of the prescribed fee, it shall be the duty of the comptroller to inform such person whether the registration still exists in respect of such design, and if so, in respect of what class or classes of goods, and stating also the date of registration, and the name and address of the registered proprietor.

Information as
to existence of
copyright.

54. If a registered design is used in manufacture in any foreign country and is not used in this country within six months of its registration in this country, the copyright in the design shall cease.

Cesser of copy-
right in certain
events.

Register of Designs.

Register of
designs.

55.—(1) There shall be kept at the patent office a book called the Register of Designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed.

(2) The register of designs shall be *prima facie* evidence of any matters by this Act directed or authorised to be entered therein.

Fees.

Fees on registra-
tion, &c.

56. There shall be paid in respect of applications and registration and other matters under this part of this Act such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury shall from time to time direct.

Industrial and International Exhibitions.

Exhibition at
industrial or
international
exhibition not
to prevent or
invalidate
registration.

57. The exhibition at an industrial or international exhibition certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof, provided that both the following conditions are complied with; namely:—

(a) The exhibitor must, before exhibiting the design or article, or publishing a description of the design, give the comptroller the prescribed notice of his intention to do so; and

(b) The application for registration must be made before or within six months from the date of the opening of the exhibition.

Act, 1886,
s. 3.

And whereas it is expedient to provide for the extension of this section to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:—

It shall be lawful for Her Majesty, by Order in Council, from time to time to declare that sections 36 and 57 of the

Patents, Designs, and Trade Marks Act, 1883, or either of those sections shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions specified in the said sections of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to Her Majesty in Council may seem fit.

Legal Proceedings.

58. During the existence of copyright in any design—

(a) It shall not be lawful for any person without the licence or written consent of the registered proprietor to apply, or cause to be applied, such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale to any article of manufacture or to any substance artificial or natural, or partly artificial and partly natural ; and

(b) It shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any court of competent jurisdiction : Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds.

59. Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture or substance, or from the publication, sale, or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so

Penalty on piracy of registered design.

Act, 1888, s. 7.

Act, 1888, s. 7.

Action for damages.

applied, such person knowing that the proprietor had not given his consent to such application.

Definitions.

Definition
of "design,"
"copyright."

60. In and for the purposes of this Act—

"Design" means any design applicable to any article of manufacture, or to any substance artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, chapter fifty-six).

"Copyright" means the exclusive right to apply a design to any article of manufacture or to any such substance as aforesaid in the class or classes in which the design is registered.

Definition of
proprietor.

61. The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise.

PART IV.—TRADE MARKS.

Registration of Trade Marks.

Application for
registration.

62.—(1) The comptroller may, on application by or on behalf of any person claiming to be the proprietor of a trade mark, register the trade mark.

(2) The application must be made in the form set forth in the first schedule to this Act, or in such other form as may

be from time to time prescribed, and must be left at, or sent *Act, 1888,*
by post to, [*the Patent Office in the prescribed manner*] such ^{s. 8.}
place and in such manner as may be prescribed.

(3) The application must be accompanied by the prescribed number of representations of the trade mark, and must state the particular goods or classes of goods in connection with which the applicant desires the trade mark to be registered.

(4) The comptroller may, if he thinks fit, refuse to register a trade mark, but any such refusal shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(5) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court; and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

“(6) Where an applicant for the registration of a trade *Act, 1888,*
mark otherwise than under an international convention is ^{s. 8.}
out of the United Kingdom at the time of making the application he shall give the comptroller an address for service in the United Kingdom, and if he fails to do so the application shall not be proceeded with until the address has been given.”

63. Where registration of a trade mark has not been or shall ^{Limit of time}
not be completed within twelve months from the date of the ^{for proceeding}
application, by reason of default on the part of the applicant ^{with applica-}
[*the application shall be deemed to be abandoned*], “the comp- *Act, 1888,*
troller shall give notice of the non-completion to the agent ^{s. 9.}
employed on behalf of the applicant, and if at the expira-
tion of fourteen days from that notice the registration is
not completed, shall give the like notice to the applicant,
and if at the expiration of the latter fourteen days, or such
further time as the comptroller may in special cases permit,
the registration is not completed, the application shall be
deemed to be abandoned.”

[64.—(1) *For the purposes of this Act, a trade mark must consist* ^{Conditions of}
of or contain at least one of the following essential particulars: ^{registration of}
^{trade mark.}
(a) *A name of an individual or firm printed, impressed, or* ^{Repealed.}
woven in some particular and distinctive manner; or ^{*Act, 1888,*}
(b) *A written signature or copy of a written signature of the* ^{s. 10.}

individual or firm applying for registration thereof as a trade mark ; or

(c) A distinctive device, mark, brand, heading, label, ticket, or fancy word or words not in common use.

(2) There may be added to any one or more of these particulars any letters, words, or figures, or combination of letters, words, or figures, or of any of them.

(3) Provided that any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the thirteenth day of August, one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act.]

Act, 1888,
s. 10

“ 64.—(1) For the purposes of this Act a trade mark must consist of or contain at least one of the following essential particulars :

“ (a) A name of an individual or firm printed, impressed, or woven in some particular and distinctive manner ; or

“ (b) A written signature or copy of a written signature of the individual or firm applying for registration thereof as a trade mark ; or

“ (c) A distinctive device, mark, brand, heading, label, or ticket ; or

“ (d) An invented word or invented words ; or

“ (e) A word or words having no reference to the character or quality of the goods, and not being a geographical name.

“ (2) There may be added to any one or more of the essential particulars mentioned in this section any letters, words, or figures, or combination of letters, words, or figures, or of any of them, but the applicant for registration of any such additional matter must state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter, and a copy of the statement and disclaimer shall be entered on the register.

“ (3) Provided as follows :

“ (i.) A person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof ;

“(11.) Any special and distinctive word or words, letter, figure, or combination of letters or figures, or of letters and figures used as a trade mark before the thirteenth day of August, one thousand eight hundred and seventy-five, may be registered as a trade mark under this part of this Act.”

65. A trade mark must be registered for particular goods or classes of goods.

Connexion of trade mark with goods.

66. When a person claiming to be the proprietor of several trade marks which, while resembling each other in the material particulars thereof, yet differ in respect of (a) the statement of the goods for which they are respectively used or proposed to be used, or (b) statements of numbers, or (c) statements of price, or (d) statements of quality, or (e) statements of names of places, seeks to register such trade marks, they may be registered as a series in one registration. A series of trade marks shall be assignable and transmissible only as a whole, but for all other purposes each of the trade marks composing a series shall be deemed and treated as registered separately.

Registration of a series of marks.

67. A trade mark may be registered in any colour or colours, and such registration shall (subject to the provisions of this Act) confer on the registered owner the exclusive right to use the same in that or any other colour or colours.

Trade marks may be registered in any colour.

Act, 1888

s. 11.

68. Every application for registration of a trade mark under this part of this Act shall as soon as may be after its receipt be advertised by the comptroller, unless the comptroller refuse to entertain the application.

Advertisement of application.

Act, 1888,

s. 12.

69.—(1) Any person may within [two months] one month or such further time, not exceeding three months as the comptroller may allow, of the [first] advertisement of the application, give notice in duplicate at the patent office of opposition to registration of the trade mark, and the comptroller shall send one copy of such notice to the applicant.

Opposition to registration.

Act, 1888, s. 13, sub-s. 1, 2.

(2) Within [two months] one month after receipt of such notice or such further time as the comptroller may allow, the applicant may send to the comptroller a counter-statement in duplicate of the grounds on which he relies for his application, and if he does not do so, shall be deemed to have abandoned his application.

Act, 1888,

s. 13, sub-s. 3.

[(3) If the applicant sends such counter-statement, the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall require him to give security in such

Repealed.

Act, 1888,

s. 13, sub-s. 4.

manner and to such amount as the comptroller may require for such costs as may be awarded in respect of such opposition; and if such security is not given within fourteen days after such requirement was made, or such further time as the comptroller may allow, the opposition shall be deemed to be withdrawn.

(4) If the person who gave notice of opposition duly gives such security as aforesaid, the comptroller shall inform the applicant thereof in writing, and thereupon the case shall be deemed to stand for the determination of the Court.]

*Act, 1888,
s. 13, sub-s. 4.*

"(8) If the applicant sends such counter-statement the comptroller shall furnish a copy thereof to the person who gave notice of opposition, and shall, after hearing the applicant and the opponent, if so required, decide whether the trade mark is to be registered, but his decision shall be subject to appeal to the Board of Trade, who shall, if required, hear the applicant and the opponent and the comptroller, and may make an order determining whether, and subject to what conditions (if any), registration is to be permitted.

"(4) The Board of Trade may, however, if it appears expedient, refer the appeal to the Court, and in that event the Court shall have jurisdiction to hear and determine the appeal, and may make such order as aforesaid.

"(5) If the applicant abandons his application after notice of opposition in pursuance of this section he shall be liable to pay to the opponent such costs in respect of the opposition as the comptroller may determine to be reasonable.

"(6) Where the opponent is out of the United Kingdom he shall give the comptroller an address for service in the United Kingdom."

**Assignment
and transmis-
sion of trade
mark.**

70. A trade mark, when registered, shall be assigned and transmitted only in connection with the goodwill of the business concerned in the particular goods or classes of goods for which it has been registered, and shall be determinable with that goodwill.

**Conflicting
claims to
registration.**

71. Where each of several persons claims to be registered as proprietor of the same trade mark, the comptroller may refuse to register any of them until their rights have been determined according to law, and the comptroller may himself submit or require the claimants to submit their rights to the Court.

72.—(1) Except where the Court has decided that two or more persons are entitled to be registered as proprietors of the same trade mark, the comptroller shall not register in respect of the same goods or description of goods a trade mark identical with one already on the register with respect to such goods or description of goods.

(2) Except as aforesaid the comptroller shall not register with respect to the same goods or description of goods a trade mark [so nearly resembling] having such resemblance to a trade mark already on the register with respect to such goods or description of goods as to be calculated to deceive.

73. It shall not be lawful to register as part of or in combination with a trade mark any words the [exclusive] use of which would by reason of their being calculated to deceive or otherwise, be deemed disentitled to protection in a court of justice, or any scandalous design.

74.—(1) Nothing in this Act shall be construed to prevent the comptroller entering on the register, in the prescribed manner, and subject to the prescribed conditions, as an addition to any trade mark—

(a) In the case of an application for registration of a trade mark used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive device, mark, brand, heading, label, ticket, letter, word, or figure, or combination of letters, words, or figures, though the same is common to the trade in the goods with respect to which the application is made ;

(b) In the case of an application for registration of a trade mark not used before the thirteenth day of August one thousand eight hundred and seventy-five—

Any distinctive word or combination of words, though the same is common to the trade in the goods with respect to which the application is made ;

[(2) *The applicant for entry of any such common particular or particulars must, however, disclaim in his application any right to the exclusive use of the same, and a copy of the disclaimer shall be entered on the register.*]

“(2) The applicant for registration of any such addition must, however, state in his application the essential particulars of the trade mark, and must disclaim in his application any right to the exclusive use of the added matter,

Restrictions on registration.

Act, 1888, s. 14.

Further restriction on registration. Act, 1888, s. 15.

Saving for power to provide for entry on register of common marks as additions to trade marks.

Repealed, Act, 1888, s. 16.

Act, 1888, s. 16.

and a copy of the statement and disclaimer shall be entered on the register.

“Provided that a person need not under this section disclaim his own name or the foreign equivalent thereof, or his place of business, but no entry of any such name shall affect the right of any owner of the same name to use that name or the foreign equivalent thereof.”

(3) Any device, mark, brand, heading, label, ticket, letter, word, figure, or combination of letters, words, or figures, which was or were, before the thirteenth day of August one thousand eight hundred and seventy-five, publicly used by more than three persons on the same or a similar description of goods shall, for the purposes of this section, be deemed common to the trade in such goods.

Effect of Registration.

Registration equivalent to public use.
Act, 1888,
s. 17.

75. [*Registration of a trade mark shall be deemed to be equivalent to public use of the trade mark.*]

“Application for registration of a trade mark shall be deemed to be equivalent to public use of the trade mark, and the date of the application shall for the purposes of this Act be deemed to be, and as from the first day of January one thousand eight hundred and seventy-six to have been, the date of the registration.”

Right of first proprietor to exclusive use of trade mark.

76. The registration of a person as proprietor of a trade mark shall be *prima facie* evidence of his right to the exclusive use of the trade mark, and shall, after the expiration of five years from the date of the registration, be conclusive evidence of his right to the exclusive use of the trade mark subject to the provisions of this Act.

Restrictions on actions for infringement, and on defence to action in certain cases.

77. A person shall not be entitled to institute any proceeding to prevent or to recover damages for the infringement of a trade mark unless, in the case of a trade mark capable of being registered under this Act, it has been registered in pursuance of this Act, or of an enactment repealed by this Act, or, in the case of any other trade mark in use before the thirteenth of August one thousand eight hundred and seventy-five, registration thereof under this part of this Act, or of an enactment repealed by this Act, has been refused. The controller may, on request, and on payment of the prescribed fee, grant a certificate that such registration has been refused.

77 (a). "In an action for infringement of a registered trade mark, the Court or a judge may certify that the right to the exclusive use of the trade mark came in question, and if the Court or a judge so certifies, then in any subsequent action for infringement the plaintiff in that action, on obtaining a final order or judgment in his favour, shall have his full costs, charges, and expenses as between solicitor and client, unless the Court or judge trying the subsequent action certifies that he ought not to have the same." Certificate to exclusive use, and costs thereon. Act, 1888, s. 18.

Register of Trade Marks.

78. There shall be kept at the patent office a book called the Register of Trade Marks, wherein shall be entered the names and addresses of proprietors of registered trade marks, notifications of assignments and of transmissions of trade marks, and such other matters as may be from time to time prescribed. Register of trade marks.

79.—(1) At a time not being less than two months nor more than three months before the expiration of fourteen years from the date of the registration of a trade mark, the comptroller shall send notice to the registered proprietor that the trade mark will be removed from the register unless the proprietor pays to the comptroller before the expiration of such fourteen years (naming the date at which the same will expire) the prescribed fee ; and if such fee be not previously paid, he shall at the expiration of one month from the date of the giving of the first notice send a second notice to the same effect. Removal of trade mark after fourteen years unless fee paid.

(2) If such fee be not paid before the expiration of such fourteen years the comptroller may after the end of three months from the expiration of such fourteen years remove the mark from the register, and so from time to time at the expiration of every period of fourteen years.

(3) If before the expiration of the said three months the registered proprietor pays the said fee together with the additional prescribed fee, the comptroller may without removing such trade mark from the register accept the said fee as if it had been paid before the expiration of the said fourteen years.

(4) Where after the said three months a trade mark has

been removed from the register for nonpayment of the prescribed fee, the comptroller may, if satisfied that it is just so to do, restore such trade mark to the register on payment of the prescribed additional fee.

Act, 1888,
s. 19, sub-s. 1.

Act, 1888,
s. 19, sub-s. 2.

(5) Where a trade mark has been removed from the register for nonpayment of the fee or otherwise, such trade mark shall nevertheless for the purpose of any application for registration during [*the five years*] one year next after the date of such removal, be deemed to be a trade mark which is already registered, “ unless it is shown to the satisfaction of the comptroller that the nonpayment of the fee arises from the death or bankruptcy of the registered proprietor, or from his having ceased to carry on business, and that no person claiming under that proprietor or under his bankruptcy is using the trade mark.”

Fees.

Fees for
registration,
&c.

80. There shall be paid in respect of applications and registration and other matters under this part of this Act, such fees as may be from time to time, with the sanction of the Treasury, prescribed by the board of trade; and such fees shall be levied and paid to the account of Her Majesty's exchequer in such manner as the Treasury may from time to time direct.

Sheffield Marks.

Registration
by Cutlers'
Company of
Sheffield
marks.

81. With respect to the master, wardens, searchers, assistants, and commonalty of the Company of Cutlers in Hallamshire, in the County of York (in this Act called the Cutlers' Company) and the marks or devices (in this Act called Sheffield marks) assigned or registered by the master, wardens, searchers and assistants of that company, the following provisions shall have effect:

(1) The Cutlers' Company shall establish and keep at Sheffield a new register of trade marks (in this Act called the Sheffield register):

Repealed.
Act, 1888,
s. 20, sub-s. 1.

[(2) *The Cutlers' Company shall enter in the Sheffield register, in respect of cutlery, edge tools, or raw steel, and the goods mentioned in the next sub-section all the trade marks entered before the commencement of this Act in respect of cutlery, edge tools or raw steel and such goods in the register estab-*

lished under the Trade Marks Registration Act, 1875, belonging to persons carrying on business in Hallamshire, or within six miles thereof, and shall also enter in such register, in respect of the same goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the commencement of this Act, but which have not been entered in the register established under the Trade Marks Registration Act, 1875.]

- “(2) The Cutlers' Company shall enter in the Sheffield Act, 1888, s. 20, sub-s. 1. register, in respect of metal goods as defined in this section, all the trade marks entered before the first day of January, One thousand eight hundred and eighty-nine in respect of metal goods either in the register established under the Trade Marks Registration Act, 1875, or in the register of trade marks under this Act, belonging to persons carrying on business in Hallamshire or within six miles thereof. The Cutlers' Company shall also, on request made in the prescribed manner, enter in the Sheffield register, in respect of metal goods, all the trade marks which shall have been assigned by the Cutlers' Company and actually used before the first day of January, One thousand eight hundred and eighty-four, but which have not been entered in either of the said other registers.”
- (3) An application for registration of a trade mark used Act, 1888, s. 20, sub-s. 2. [on cutlery, edge tools, or on raw steel, or on goods made of steel, or of steel and iron combined, whether with or without a cutting edge] on metal goods shall, if made after the commencement of this Act by a person carrying on business in Hallamshire, or within six miles thereof, be made to the Cutlers' Company :
- (4) Every application so made to the Cutlers' Company shall be notified to the comptroller in the prescribed manner, and unless the comptroller within the prescribed time gives notice to the Cutlers' Company that he objects to the acceptance of the application, it shall be proceeded with by the Cutlers' Company in the prescribed manner :
- (5) If the comptroller gives notice of objection as aforesaid, the application shall not be proceeded with by the Cutlers' Company, but any person aggrieved may appeal to the Court :

(6) Upon the registration of a trade mark in the Sheffield register the Cutlers' Company shall give notice thereof to the comptroller, who shall thereupon enter the mark in the register of trade marks; and such registration shall bear date as of the day of application to the Cutlers' Company, and have the same effect as if the application had been made to the comptroller on that day.

Repealed,
Act, 1888,
s. 20, sub-s. 3.

[(7) The provisions of this Act, and of any general rules made under this Act, with respect to application for registration in the register of trade marks, the effect of such registration, and the assignment and transmission of rights in a registered trade mark shall apply in the case of applications and registration in the Sheffield register; and notice of every entry made in the Sheffield register must be given to the comptroller by the Cutlers' Company, save and except that the provisions of this sub-section shall not prejudice or affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register:]

Act, 1888,
s. 20, sub-s 3

(7) The provisions of this Act and of any general rules made under this Act with respect to the registration of trade marks, and all matters relating thereto, shall, subject to the provisions of this section, apply to the registration of trade marks on metal goods by the Cutlers' Company, and to all matters relating thereto; and this Act and any such general rules shall, so far as applicable, be construed accordingly with the substitution of the Cutlers' Company, the office of the Cutler's Company, and the Sheffield register, for the Comptroller, the Patent Office, and the Register of Trade Marks, respectively; and notice of every entry, cancellation, or correction made in the Sheffield register shall be given to the Comptroller by the Cutlers' Company: Provided that this section shall not affect any life estate and interest of a widow of the holder of any Sheffield mark which may be in force in respect of such mark at the time when it shall be placed upon the Sheffield register.

(8) Where the comptroller receives from any person not carrying on business in Hallamshire or within six miles

thereof an application for registration of a trade mark *Act, 1888,*
 used [on cutlery, edge tools, or on raw steel, or on goods ^{s. 20, sub-s. 2.}
made of steel, or of steel and iron combined, whether with or
without a cutting edge], on metal goods, he shall in the
 prescribed manner notify the application and proceedings
 thereon to the Cutlers' Company :

- (9) At the expiration of five years from the commencement of this Act the Cutlers' Company shall close the Cutlers' register of corporate trade marks, and thereupon all marks entered therein shall, unless entered in the Sheffield register, be deemed to have been abandoned :
- (10) A person may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of two or more trade marks :
- (11) A body of persons, corporate or not corporate, may (notwithstanding anything in any Act relating to the Cutlers' Company) be registered in the Sheffield register as proprietor of a trade mark or trade marks :
- (12) Any person aggrieved by a decision of the Cutlers' Company in respect of anything done or omitted under this Act may, in the prescribed manner, appeal to the comptroller, who shall have power to confirm, reverse, or modify the decision, but the decision of the comptroller shall be subject to a further appeal to the Court :
- (13) So much of the Cutlers' Company's Acts as applies to the summary punishment of persons counterfeiting Sheffield corporate marks, that is to say, the fifth section of the Cutlers' Company's Act of 1814, and the provisions in relation to the recovery and application of the penalty imposed by such last-mentioned section contained in the Cutlers' Company's Act of 1791, shall apply to any mark entered in the Sheffield register.
- (14) For the purposes of this section the expression *Act, 1888,*
 "metal goods" means all metals, whether wrought, ^{s. 20, sub-s. 4.}
 unwrought, or partly wrought, and all goods composed wholly or partly of any metal.
- (15) For the purpose of legal proceedings in relation to trade marks entered in the Sheffield register, a certificate under the hand of the master of the Cutlers' Company shall have the same effect as the certificate of the comptroller.

PART V.—GENERAL.

Patent Office and Proceedings thereat.

Patent Office.

82.—(1) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as the Patent Office.

(2) Until a new patent office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the patent office within the meaning of this Act.

(3) The patent office shall be under the immediate control of an officer called the comptroller-general of patents, designs, and trade marks, who shall act under the superintendence and direction of the Board of Trade.

(4) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

Officers and clerks.

83.—(1) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade marks, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

Seal of patent office.

84. There shall be a seal for the patent office, and impressions thereof shall be judicially noticed and admitted in evidence [p. 144].

Trust not to be entered in registers.

85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed, implied or constructive [pp. 23, 185].

Refusal to grant patent,

86. The comptroller may refuse to grant a patent for an in-

vention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality [p. 130].

Ac., in certain cases.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request, and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design or trade mark, in the register of patents, designs or trade marks, as the case may be. The person for the time being entered in the register of patents, designs or trade marks, as proprietor of a patent, copyright in a design or trade mark as the case may be, shall, subject to the provisions of this Act and to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, licence or dealing. Provided that any equities in respect of such patent, design or trade mark may be enforced in like manner as in respect of any other personal property [p. 185].

Entry of assignments and transmissions in registers.

Act, 1888, s. 21.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed; and certified copies, sealed with the seal of the patent office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee [p. 185].

Inspection of and extracts from registers. *Act*, 1888, s. 22.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the patent office, of or from patents, specifications, disclaimers and other documents in the patent office, and of or from registers and other books kept there, shall be admitted in evidence in all courts in her Majesty's dominions, and in all proceedings, without further proof or production of the originals [p. 186].

Sealed copies to be received in evidence.

90.—(1) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person, or of any other particulars from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging or varying the entry, as the Court thinks fit; or the

Rectification of registers by court. *Act*, 1888, s. 23.

Court may refuse the application ; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit [p. 186].

(2) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller.

91. The comptroller may, on request in writing accompanied by the prescribed fee [p. 186],

(a) Correct any clerical error in or in connection with an application for a patent, or for registration of a design or trade mark ; or

(b) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design or trade mark ;

(c) Cancel the entry or part of the entry of a trade mark on the register : Provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark.

(d) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connection with which he has desired the design or trade mark to be registered.

*Act, 1888,
s. 24.*

*Alteration of
registered
mark.*

92.—(1) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

*Notice to be
given.*

(2) Notice of any intended application to the Court under this section shall be given to the comptroller by the applicant ; and the comptroller shall be entitled to be heard on the application.

*Comptroller
to alter in
accordance
with order.*

(3) If the Court grants leave, the comptroller shall, on proof thereof and on payment of the prescribed fee, cause the register to be altered in conformity with the order of leave.

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

Falsification of entries in registers.

94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent [p. 130] (o).

Exercise of discretionary power by comptroller.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for direction in the matter.

Power of comptroller to take directions of law officers.

96. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *prima facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone [p. 320].

Certificate of comptroller to be evidence.

97.—(1) Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office, or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made, or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

Applications and notices by post.

(2) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Proof.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a

Provision as to days for leaving documents at office.

(o) See P. R., 1890, r. 11.

day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document, or to pay such fee, on the day next following such excluded day, or days if two or more of them occur consecutively [p. 181] (p).

Declaration
by infant,
lunatic, &c.

99. If any person is, by reason of infancy, lunacy, or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted [pp. 10, 127].

Transmission
of certified
printed copies
of specifica-
tions, &c.

100. Copies of all specifications, drawings, and amendments, left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh museum of science and art, and to the enrolments office of the chancery division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the Patent Office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for
board of trade
to make gene-
ral rules for
classifying
goods and
regulating
business of
Patent Office.

101.—(1) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act [p. 182]:

- (a) For regulating the practice of registration under this Act:
- (b) For classifying goods for the purposes of designs and trade marks:

(p) See P. R., 1890, r. 7.

(c) For making or requiring duplicates of specifications, amendments, drawings, and other documents :

(d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments, and other documents :

(e) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office ; and providing for the inspection of indexes and abridgments and other documents :

(f) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad :

(g) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2) Any of the forms in the first schedule to this Act may be altered or amended by rules made by the Board as aforesaid : Alteration of forms.

(3) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed. General rules ;

(4) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller. to be laid before parliament and advertised

(5) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

102. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under Annual reports of comptroller.

him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

Proceedings of
Board of Trade.
Act, 1888,
s. 25.

102A.—(1) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the president, or a secretary or an assistant secretary of the Board.

(2) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the president of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3) A certificate signed by the president of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

International and Colonial Arrangements.

International
arrangements
for protection
of inventions,
designs, and
trade marks.

Act, 1885,
s. 8.

Time.

No protection
prior to speci-
fication or
registration.

103.—(1) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such state shall be entitled to a patent for his invention, or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the [*date of protection obtained*] date of the application in such foreign state [pp. 24, 68].

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2) The publication in the United Kingdom or the Isle of Man, during the respective periods aforesaid, of any description of the invention or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark :

Publication at or use in exhibition not to invalidate patent or trade mark.

(3) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act : Provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act :

Application under this section to be made in same manner as ordinary application.

(4) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from time to time by order in council declare them to be applicable, and so long only in the case of each state as the order in council shall continue in force with respect to that state.

Application of this section.

104.—(1) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty, from time to time, by order in council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in council may seem fit, to such British possession.

Provision for colonies and India.

(2) An order in council under this Act shall, from a date to be mentioned for the purpose in the order, take effect as if its provisions had been contained in this Act ; but it shall be lawful for Her Majesty in council to revoke any order in council made under this Act.

Effect of order in council.

Offences.

105.—(1) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be

Penalty on falsely representing article to be patented