

mode of doing it, for you are bound to make a *bonâ fide* full and candid disclosure.'” The case referred to by the learned judge was the case of *Liardet v. Johnson* (1778, 1 Web. P. C. 53).

Relative advantages need not be given.

In *The Badische Anilin und Soda Fabrik v. Levinstein* (1887, 4 P. O. R. 464; L. R. 12 A. C. 716), the patentee in his specification described four processes whereby he could produce sulpho-acids of oxyazo-naphthaline applicable to dyeing and printing, varying in colour from brown to red. All these processes he claimed, although only one of them was proved to have any practical value, and it was argued that the patent was bad on the ground that no description was given of the relative advantages of each particular shade of colour; it was held by the House of Lords, reversing the decision of the Court of Appeal, that to require such discrimination was to insist upon what was really impracticable; for, in the words of Lord Halsbury, L.C., “Upon the principle contended for, each shade must not only be shown, but its excellence or popularity must be distinguished separately by the patentee. This, as it appears to me, reduces the obligation supposed to press upon the patentee to an absurdity” (k).

Insufficiency in part only.

If the specification describes more than one process for arriving at a result, and fails in respect of one of them by reason of insufficiency, the whole patent will be void (l).

In *Tetley v. Easton* (1856, 2 Mac. P. C. 76), Pollock, C.B., said: “A man has no right to patent a principle and then give to the public the humblest instrument that can be made from his principle, and reserve to himself all the better part of it.” And in *Heath v. Unwin* (1850, 2 Web. P. C. 243), Coleridge, C.J., said: “If the inventor of an alleged discovery, knowing two equivalent agents for effecting the end, could, by the disclosure of one, preclude the public from the benefit of the other, he might, for his own profit, force upon the public an expensive and difficult process, keeping back the simple and

(k) And see *Otto v. Linford*, 1881, 116, p. 141, supra.

46 L. T. (N. S.) 35; *Thomson v. Batty*, 1889, 6 P. O. R. 97; *Leonhardt v. Kallé*, 1896, 12 P. O. R.

(l) See *Badische Anilin und Soda Fabrik v. La Société Chimique*, 1897, 14 P. O. R. 875; 15 P. O. R. 364.

cheap one, it would be directly contrary to the good faith required from a patentee in his communication to the public."

To sum up the effect of the decisions on deception and insufficiency:—

If the extraneous matter is put into the specification, *bonâ fide* thinking that it was necessary, the patent will not be held to be void; if it was put in *malâ fide*, with the intention of deceiving, or knowing it was extraneous and useless, the patent will be void. If the extraneous matter is in itself misleading, and would prevent a skilled workman from successfully carrying out the invention, whether it is put in *malâ fide* or *bonâ fide*, the patent will be void (*m*). It will be seen that in the latter case the specification is insufficient, and in the former two cases the question is one simply of *bona fides* on the part of the inventor (*n*). Effect of  
EXCESS.

The object of the patent is to benefit the world, and not to obstruct a subsequent invention; consequently, if the specification is worded in such a manner as to grasp at more than the patentee has actually invented, and to endeavour to cover, so to speak, wholesale problematic inventions, the patent will be void (*o*).

As has been noticed above, sect. 5, sub-sect. 4, of the Act of 1883 enacts that the complete specification must be accompanied by drawings if required. The drawings.

Before the Act, drawings were quite optional on the part of the patentee (*p*); but then, as now, if drawings had not been filed, and the invention had been too complicated to be understood without them, the patent would be invalid on account of insufficiency, and not because drawings were not filed. Drawings are merely part of the specification and to be read with the Part of  
specification.

(*m*) *Savory v. Price*, Ry. & M. 1 Web. P. C. 218; *Neilson v. Harford*, 1841, 8 M. & W. 806.  
1; 1 Web. P. C. 83; *Turner v. Winter*, 1 Web. P. C. 77; 1 T. R. 602.

(*o*) *Crossley v. Potter*, Macr. P. C. 45.

(*n*) *Simpson v. Holliday*, 1864, 20 Newton's Journal (N. S.) 108; *Crompton v. Ibbotson*, 1828, 1 Web. P. C. 83; *Dickford v. Skewes*, 1837, (*p*) *Boulton v. Bull*, 1795, Dav. P. C. 188; *In re Fox's Patent*, 1 Web. P. C. 431, n.



letterpress, and whether the invention will be limited by the drawings will depend on the nature of the invention (g).

Collins, M.R., said, in *Hattersley v. Hodgson* (1904, 21 P. O. R. at p. 525): "Now in my judgment (and I think it has been so held) a patentee may show what he claims either by the printed matter of the specification alone, or by the drawings alone, or by the combination of the two."

**Discrepancy.** It is sometimes asked, "What is to be done if there is a discrepancy between the printed matter and the drawings?" And this may be answered by the question, "Does the discrepancy produce ambiguity sufficient to mislead?" If it be clear to persons skilled in the trade what is meant, then the patent is not ambiguous, and it is immaterial from which part of the specification they have drawn their information. If there is ambiguity, the patent is invalid. It is submitted that this proposition covers the whole point.

By the words of sect. 2 of the Act of 1886, by which the above sub-section of the principal Act is amended, "*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.*"

**The nature of the invention.** We have seen that part of the consideration for the grant of letters patent is, that the inventor shall particularly describe and ascertain the nature of his invention, and in what manner it is to be performed; consequently for a specification to be sufficient it must particularly ascertain—(1) What the invention itself is; (2) How the invention is to be carried out. Under the first head the inventor must describe exactly and accurately what he has invented, and if in the course of the description of his invention it should be necessary for him to describe something which is old but which he wishes to use in the process of his invention, he must be careful to say, "This is old and I do not claim it as a part of my invention." There are two reasons why the inventor

(g) See, as instances, *Bloxam v. 186*; *Fairburn v. Household*, 1886, 3 P. O. R. 267; *Pickard v. Prescott*, 1890, 7 P. O. R. 365; *Miller v. Lawrence v. Perry*, 1885, 2 P. O. R. *Scarle*, 1893, 10 P. O. R. 111.

should be called upon to particularly state what he has invented: one is, that the public may be placed in a position to use the invention so soon as the period of protection has elapsed; and the other is, that the public may be protected by being carefully informed what it is that during the period of protection they are not to use. In a well-drawn specification the nature of the invention should be set out in the body of the specification, as well as in the "claims" hereinafter referred to, and, if possible, prior to the description of the manner of carrying the invention into effect. This arrangement is not absolutely necessary, since the nature of the invention must in any event be set out in the claims, but it is certainly advisable; since in the course of describing the operation of the invention it will very probably be necessary to include a description of something which is well known, and which it is not desired to claim.

By sect. 5, sub-sect. 5, of the Act of 1883, it is provided **The claims.** that "*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.*" This is, perhaps, emphasizing, in a more distinct manner than had been provided before the passing of this Act, the necessity of the inventor making a distinct and unambiguous claim.

It has been decided in the House of Lords that the enactment **Act merely directory.** in sect. 5 of the Act of 1883, that a complete specification must end with a distinct statement of the invention claimed, is directory only, and when letters patent have been granted, they will not be invalid because it has not been complied with (r), consequently the same rules will apply in cases where no distinct claim is appended to the specification as applied before the passing of that Act. Under the old law if no claim were inserted the patentee was taken to claim everything that was described in the specification, although disclaimer was not necessary in matters which manifestly formed no part of the invention (s).

The patentee must not claim too much, and yet he must claim **Act same as old law.**

(r) *Vickers v. Siddell*, 1890, 7 P. O. R. 292, 302, 306; L. R. 15 App. Cas. 496, 500, 505; *Kelly v. Heathman*, 1890, 7 P. O. R. 348.

(s) *Lister v. Leather*, 8 E. & B. 1004; *Tetley v. Easton*, 2 C. B. (N. S.) 706.



sufficient to show a useful manufacture, and he must distinguish in his claim what it is that is new in the process which he has described and what is old. So far as this goes, there is no doubt that the old law provided for similar declarations on the part of the inventor. In *Macfarlane v. Price* (1818, 1 Web. P. C. 74), Lord Ellenborough said: "The patentee in his specification ought to inform the person who consults it what is new and what is old; he should say, 'my improvement consists in this . . . .' A person ought to be warned by the specification against the use of the particular invention, but it would exceed the wit of man to discover from what he is warned in a case like this." (See p. 133, supra.)

Distinction  
between  
description  
and claim.

The Court must be taken to distinguish between describing too much and claiming too much. In the course of a well-drawn specification it is frequently necessary to describe something which is old, and, provided the claim says that the old parts do not constitute a portion of the invention, the description of the old parts in the specification will not invalidate the patent. But if two methods of doing a thing are described, one of which will answer and the other will not, it will be interpreted, unless one of them is specifically disclaimed, that both parts are claimed as being new and useful, and one of them not being useful the patent will be invalidated, because it is said there is a false suggestion in the specification.

The object of the claim is to crystallize the invention as described in the specification into one or more clauses, so as to render it quite clear what is and what is not the object of the patent. It is introduced (particularly in the case of a patent for an improvement) lest the patentee should have inadvertently described something which is not new, in order to render his description of the improvement intelligible. The claim is not intended to aid the description, but to ascertain the extent of what is claimed as new (t). But the importance of describing

(t) Lord Cottenham in *Kay v. Co.*, 1835, 2 P. O. R. 208; *Plimpton v. Spiller*, 1877, L. R. 6 C. D. 426; *Lucas v. Miller*, 1885, 2 P. O. R. 159.  
*Marshall*, 1836, 2 Web. P. C. 39; *Easterbrook v. Great Western Rail.*

the nature of the invention in the specification itself is shown in the cases which deal with combination claims.

Where a patent is for a combination of old or new parts, or for an improved arrangement of old mechanism, provided it be clear that the nature of the invention is the new combination, the specification need not discriminate between the new and old parts of such combination or improved apparatus (*u*) unless any of those subordinate parts are specifically claimed (*x*), since it is the new combination or improvement alone that constitutes the novelty and merit of the invention; but it is necessary for the patentee to particularly ascertain and define what his improvement consists of, or what are the exact parts of his new combination, so that any person of ordinary knowledge of the subject may be able at once, on reading the specification, to know that the invention consists of the new combination specified.

Combinations  
—how  
claimed.

In *Foxcell v. Bostock* (1864, 4 De G. J. & S. 313), Lord Westbury, L.C., said: "I must therefore lay down the rule, which is consistent with and in reality a mere sequence from the decided cases, that in a patent for an improved arrangement or new combination of machinery, the specification must describe the improvement and define the novelty otherwise, and in a more specific form than by the general description of the entire machine; it must, to use a logical phrase, assign the *differentia* of the new combination."

If the invention be for an improvement upon an old process very great care should be taken that the improvement alone is made the subject of the claim; so if it be for a combination of well-known parts, care must be taken that it be clearly shown that the patentee claims the combination, and not the parts. James, V.-C., commenting on *Foxcell v. Bostock* in *Parkes v. Stephens* (1869, L. R. 8 Eq. 365), said: "It is obvious that a

(*u*) *Kaye v. Chubb*, 1888, 5 P. O. R. 549; *Watling v. Stevens*, 1886, 3 P. O. R. 41; *Moore v. Bennett*, 1884, 1 P. O. R. 129, 143; *Kelly v. Heathman*, 1890, 7 P. O. R. 348; *Hookham v. Johnson*, 1897, 14 P. O. R. 558; *Perry v. Société des Lunetiers*, 1896, 13 P. O. R. 39;

*British United Shoe Co. v. Thompson*, 1905, 22 P. O. R. 138.

(*x*) *Lister v. Leather*, 1857, 8 El. & Bl. 1004; *Harrison v. Anderston Foundry Co.*, 1876, L. R. 1 App. Cas. 578; *Rowcliffe v. Morris*, 1886, 3 P. O. R. 23.



patentee does not comply as he ought to do with the condition of his grant if the improvement is only to be found, like a piece of gold, mixed up with a great quantity of alloy, and if a person desiring to find out what was new would have to get rid of a large portion of the specification, by eliminating from it all that was old and commonplace, all that was the subject of other patents, or of other improvements, bringing to the subject not only the knowledge of an ordinary skilled artizan, but of a patent lawyer or agent." And where a patent is taken out for a combination, it is not material to its validity that the specification should point out what parts are old and what are new, though, if an alleged infringement consists only in taking part of the combination, it is necessary that the patentee should in his specification have claimed the part so taken as new (*y*). If the whole combination constitutes the novelty of the invention the whole combination alone should be claimed, and subject to the substitution of equivalents and evasion, there will be no infringement unless the whole combination is taken; but if there is *merit and novelty in subordinate integers or subordinate combinations* they should be specially claimed, otherwise there will be no infringement in taking them. But in the case where there is *novelty in the result* of using the whole combination, and only the whole combination is claimed, then the Court will protect the patentee from infringement by taking the essence of the combination. *Proctor v. Bennis* (supra).

The invention  
must be  
claimed.

In *Harrison v. The Anderston Foundry Co.* (1876, L. R. 1 A. C. 574) it was finally held by the House of Lords that if the combination and application of old machinery be new and beneficial the invention of this combination may be protected by a patent. The specification commenced: "The invention consists of a new or improved simple and most efficient mode of and arrangement of mechanism for connecting the set or sets of compound or multiple shuttle-boxes of looms for weaving stripe, check or other ornamental or figured fabrics requiring two, three or more shuttle-boxes in each set." The specification then described in detail and by reference to drawings

(*y*) *Proctor v. Bennis*, 36 Ch. D. 740.

the arrangement of mechanism in question, and then continued: "What we believe to be novel and original, and therefore claim as the invention secured to us by letters patent, is—(1) The construction and arrangement of the parts and portion of the mechanism, and (2) a shuttle-box moving and holding mechanism as herein distinguished generally for actuating the shuttle-boxes of power-looms, all substantially in the new or improved manner herein described and shown in the drawings or any mere modification thereof." A great number of the parts of the machine were admittedly old, and one of the questions in this case was, whether the first claim above set forth was a sufficient claim to a combination. Lord Cairns, in giving judgment, said: "It is, as I read it, a claim for a combination, that is to say, a combination of all the movements going to make up the whole mechanism described; it must, for the present at least, be assumed that this combination, as a combination, is novel, that it is, to use the words of the Lord President, a new combination of old parts to produce a new result or to produce a known result in a more useful and beneficial way; it is not doubted that a combination such as this is may be the subject of a patent. What, then, are the objections to the first claim viewed as a claim for the combination? The first is an objection said to be founded upon the case of *Foxwell v. Bostock*, decided by the late Lord Westbury. It is said to be determined in that case that where there is a patent for a combination there must be a discovery or explanation of the novelty, and the specification must show what is the novelty and what the merit of the invention. I cannot think that, as applied to a patent for a combination, this is or was meant to be the effect of the decision in *Foxwell v. Bostock*. If there is a patent for a combination, the combination itself is *ex necessitate* the novelty, and the combination is also the merit, if it be a merit, which remains to be proved by evidence."

In the same case Lord Hatherley said: "The judges extended as it appears to me with great respect, the doctrine of *Foxwell v. Bostock* in their application of it in this case; it was there held, and that I think was all that was held, that it is not competent to a man to take a well-known existing machine, and, having made some small improvement, to place that before the public



and say, 'I have made a better machine: there is this sewing-machine invented by so-and-so, I have improved upon that. That is mine! It is a much better machine than his;' that will not do; you must state clearly and distinctly what it is in which you say you have made an improvement. To use an illustration which was adopted, I think, by Lord Justice James in another case, 'I think it will not do if you invented the gridiron pendulum to say, I have invented a better clock than anybody else, not telling the public what you have done to make it better than any other clock which is known.'"

This case illustrates the importance of setting forth the nature of the invention in the body of the specification. It was clear that the nature of the invention was the arrangement of the mechanism.

In the case of *Holmes v. London and North-Western Railway* (1852, 22 L. J. C. P. 57), A. obtained a patent for an improved turning-table for railway purposes, and in his specification gave a description of the machinery, of which no part was new except certain suspending rods; the combination, however, was both new and useful. In the specification the patentee claimed as his invention "An improved turning-table hereinbefore described, such my invention being, to the best of my knowledge and belief, entirely new." It was held, that no construction of the claim could be put upon it as including a combination of the various parts which were old, but that it must be construed as meaning that the patentee claimed the several parts of the invention as being new, and the combination being the only part which was new, the patent was held void.

Claim for combination will not protect parts.

In *Moore v. Bennett* (1884, 1 P. O. R. 143), Selborne, L.C., in giving judgment in the House of Lords, said: "Your lordships have not at all to consider whether in the case of *Foxcell v. Bostock* the decision arrived at was correct or not; nor have you to consider whether, when interpreted with reference to the facts of that case, the language used by the very eminent and able judge who decided it may not be susceptible of an interpretation which would make that language correct in point of law. But, my lords, I feel that your lordships cannot refuse to regard the decision in *Foxcell v. Bostock* in the light in which

you have already explained, and interpreted, and commented upon it by your own decision in the case of *Harrison v. The Anderston Foundry Co.*, and so explained, it appears to me, to amount to no more than this: that when a claim is made for a general combination and arrangement of the different parts of a machine, if the Court sees that the combination is not new, but that there is some particular improvement in some particular part, it will not do to claim the whole combination as new, but you must condescend upon that which is improved (z). . . . . The case of *Foxwell v. Bostock* was qualified or explained in *Harrison v. The Anderston Foundry Co.* It was treated as an authority in such a way as to make it impossible to apply it to the present case, where, looking at the specification and at the evidence, it is perfectly clear that no such general combination as this had been at any time used, and where the material and important parts of the two arrangements and combinations, which are described, are clearly, plainly and intelligibly described. It would, in my judgment, be in direct contradiction to the decision in *Harrison v. The Anderston Foundry Co.* to hold the specification bad."

The effect of the two classes of cases is summed up by Mr. Justice Buckley in *The British United Shoe Co. v. Thompson* (1905, 22 P. O. R. 198): "I will endeavour to explain in my own language what I understand to be the result of *Foxwell v. Bostock*, and the cases which have followed it. Assume a known machine. If the invention consists in an improvement or addition to that machine, say a gridiron pendulum which is introduced into a clock, the patentee must indicate and claim the improvement or addition. He cannot claim the whole improved machine. He must say what part of it he claims. But if his invention be for a new arrangement and user of the constituent parts of a known machine in a particular way so as to produce a useful result, then *Foxwell v. Bostock* does not apply. In the former part, say nine parts are old and one is new, the inventor must say which is new. In the latter case

(z) See also *Clark v. Adie*, 1877, L. R. 2 A. C. 321; *Cropper v. Smith*, 1884, 1 P. O. R. 87.



all the parts are old, his invention is not an invention of any one of the parts; his invention lies in so arranging and using parts, each and every of which is old, as to achieve some useful result. In the latter case, *ex concessis*, all is old except that no one ever before so arranged and used the constituent parts as the patentee arranges and uses them. In that case, to use the words of Lord Cairns in *Harrison v. Anderston Foundry Co.*, the combination itself is, *ex necessitate*, the novelty. Again, if some of the elements are new, but the patentee claims only the combination as a whole and not the elements, then he need not show which elements are new. It is clear that the claim is for a combination and nothing but a combination; there is no infringement unless the whole combination is used, and it is in that way immaterial whether any, and which of the parts are new. The language is that of Lord Cairns in *Harrison v. Anderston Foundry Co.* The whole is summarised in a few words by saying that the patentee must show what is the new thing that he claims."

General  
result.

It must be carefully noted that this does not mean that every part must be old to bring the case within *Harrison v. Anderston Foundry Co.* The question is merely "What is the invention?" If the invention is the combination and that fact is clear, then the elements of the combination need not be distinguished in novelty. If, on the other hand, the invention is the introduction of some new feature, that new feature must be specified as new.

Construction  
of claims.

The claim will be construed with reference to the entire patent; and although at first sight there may be some appearance of obscurity in it, if it can be made clear by the consideration of the whole specification, the patent will not be thereby avoided (a).

(a) *Arnold v. Bradbury*, 1871, L. R. 6 Ch. 712; *Plimpton v. Spiller*, 1877, L. R. 6 Ch. D. 427; *Edison v. Woodhouse*, 1887, 4 P. O. R. 107; *Leadbeater v. Kitchin*, 1890, 7 P. O. R. 244; *Elias v. Grovesend Tin Plate Co.*, 1890, 7 P. O. R. 463; *Edison v. Smith*, 1894, 11 P. O. R. 395; *Parkinson v. Simon*, 1894, 11 P. O. R. 507; *Electric Construction Co. v. Imperial Tramways Co.*, 1899, 16 P. O. R. 638; *Tubes, Ltd. v. Perfecta Seamless Steel Tube Co.*, 1903, 20 P. O. R. 99.

In the case of *Arnold v. Bradbury* (1871, L. R. 6 Ch. 712), Lord Hatherley, in the course of his judgment, says: "I do not think that the proper way of dealing with this question is to look first at the claims, and then see what the full description of the invention is; but rather first to read the description of the invention, in order that your mind may be prepared for what it is the inventor is about to claim." This, of course, does not refer to that part in the body of the specification which should clearly set forth the nature of the invention prior to the description in detail (p. 149, supra).

As has been pointed out above, each subordinate part of an invention must be claimed specifically in order to be protected (*b*), for everything that is not claimed is considered to be disclaimed, and should a man describe ten inventions in his specification and claim only one of them, he thereby presents to the public the remaining nine (*c*).

Comprehensive words employed in a specification cannot have the effect of extending the scope of the patent beyond that which is substantially described (*d*).

A claim to "the apparatus as fully set forth and described in the above specification and drawings," has been held to be a claim for the combination of the constituent parts of that apparatus (*e*). (See Chapter VI., p. 151.)

The fact that one of the claims is practically a repetition of another will not vitiate a patent. In the *Wenham Gas Co. v. The Champion Gas Lamp Co.* (1892, 9 P. O. R. 55), Lindley, L.J., said: "I think the true construction of the fourth claim is pointing out the importance of the perforated tube in claim 3—a repetition in fact of claim 3—I do not think it is anything more. If so, it does not vitiate the patent. It

Repetition  
will not  
invalidate.

(*b*) *Clark v. Adie*, 1877, L. R. 2 406.

App. Cas. 321; *Cropper v. Smith*, 1884, 1 P. O. R. 87.

(*c*) *Harrison v. Anderston Foundry Co.*, 1876, L. R. 1 App. Cas. 580; *Hinks v. Safety Lighting Co.*,

1876, L. R. 4 Ch. D. 612; *Parkinson v. Simon*, 1895, 12 P. O. R.

(*d*) *Binney v. Feldtman*, 1852, Griff. P. C. 52; *Miller v. Clyde Bridge Steel Co.*, 1892, 9 P. O. R. 480.

(*e*) *Peckover v. Rowland*, 1893, 10 P. O. R. 234, 237.



may be open to the criticism that it is redundant; but if it is nothing more than pointing out what is a valuable operation, and what has been claimed in clause 3, it does not thereby vitiate the patent."

**Nor invalidity  
of subordinate  
claim.**

So, too, where one of the claims in a specification, although strictly it may be for something old, is purely subordinate to the main invention and merely amounts to a declaration of one of the merits and advantages of the contrivance disclosed in the specification, it has been held that a patent is not void on that account.

## CHAPTER VIII.

### APPLICATION AND ACCEPTANCE.

IN a previous chapter the question as to who is entitled to apply for a grant of letters patent has already been considered, and in the present chapter it is proposed to deal with the law and practice relating to the application for a grant, and the acceptance of the complete specification by the Comptroller.

Sect. 5 of the Act of 1883, as amended by the Acts of 1885 and 1888, enacts :—

(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.*”

The practice under this section is now regulated by Rules 4 to 16 of the Patents Rules, 1903, which came into operation on January 12th, 1903. Forms of application.

Applications for patents for inventions made in Great Britain and Ireland and Isle of Man must be made in Form A, for inventions communicated from abroad in Form A 1, and applications for patent under international and colonial arrangements must be in Form A 2 (a). The applicant must himself sign the application, and certain other specified formal documents, but Agents. for many matters he may employ an agent. (See as to this, Rule 81 of the Patents Rules, 1903.) Such agent need not be a “patent agent,” but he must be an agent duly authorised to the satisfaction of the Comptroller (b). In the case of an application by two or more persons, the application must be signed by all those persons, but it is not absolutely essential that

(a) See Appendix.

9 P. O. R. 164; for forms of authorisation, see Appendix.

(b) See *Graham v. Fanta*, 1892,



the complete specification should be signed by more than one of them (c).

Application by representative of deceased inventor.

If a person possessed of an invention die without having made an application for a patent, application may be made by, and a patent for the invention granted to his legal representative, but such application must be made within six months of the decease of the inventor (d).

Order of recording applications.

A document sent to the Patent Office by post is deemed to have been left at the time when the letter containing the same would be delivered in the ordinary course of post, and it is sufficient to prove that the letter was properly addressed and posted (e).

Declarations;

*Sect. 5, sub-sect. 2, enacts: "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.*

specification to accompany.

*"The declaration may be either a statutory declaration under the Statutory Declarations Act, 1835, or not, as may be from time to time prescribed."*

Where inventor is incapable.

The form of such declaration and the manner in which it is to be made is regulated by Rules 25 and 26 of the Patents Rules, 1903. Where the inventor is incapable, by reason of infancy, lunacy, or other inability, of making any declaration or doing anything required or permitted by the Act, such declarations may be made and such things may be done on his behalf by the guardian or committee of such incapable person, or by any person appointed by the Court (f).

Declarations exempt from stamp duty.

Statutory declarations made in conformity with this Act are exempt from the stamp duty of two shillings and sixpence charged on a statutory declaration made under the Statutory Declarations Act, 1835, by the Stamp Act, 1870 (g).

(c) *McEvoy's Patent*, 1890, 7 P. O. R. 151.

(d) Sect. 34; see also P. R. 1903, r. 6.

(e) Sect. 97 of the Act of 1868; see also P. R. 1903, r. 8.

(f) Sect. 99.

(g) 47 & 48 Vict. c. 62, s. 9.

The application must be accompanied either by a provisional or by a complete specification. The specifications are referred to "examiners," who report to the Comptroller whether they comply with certain requirements. The nature of the report on a provisional is different from that on a complete. In the latter case the novelty of the invention is inquired into in addition to more formal matters.

Sect. 6 of the Act of 1883 enacts that:—"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."

In connection with this enactment it is important to notice sect. 33 of the Act of 1883 and Rule 5 of the Patents Rules, 1905, to the effect that every patent shall be granted for one invention only, though it may contain more than one claim—this requirement will be dealt with presently. It is, therefore, necessary to consider what are the formal requirements in respect of the specifications, and the points of practice thereon which particularly need attention.

(1) One Invention only must be described:—In *Jones' Patent*, Herschell, S.-G., said (Griff. P. C. 265): "I should always allow alternative devices for producing a particular object as one invention. But if you say I have invented six different kinds of railway sleepers, each of which has its own merits and purposes and objects distinct, then there are six inventions. . . . You may get in one patent the combination, and you may get all subordinate parts of that combination, so far as you claim to use them for one main purpose, but if you are going to claim a subordinate part, or one of the elements of the combination for a purpose independent of the purpose of the combination, then you have got an extra invention, and it is not all one."

One invention only.

Combinations and integers.

In *Hearson's Application* (1884, Griff. P. C. 309; 1 P. O. R. 213) the provisional specification intimated that the invention was applicable to "other purposes"; those words were struck out by the Comptroller on the ground that it amounted to more



than one invention, and this decision was affirmed by the Solicitor-General.

Office rules on  
this point.

By Rule 5 of the Patents Rules, 1905, repealing Rule 9 of the Patents Rules, 1903, it is provided :—

“When a specification comprises several distinct matters, they shall not be deemed to constitute one invention by reason only that they are all applicable to or may form parts of an existing machine, apparatus or process.

“Where a person making application for a patent has included in his specification more than one invention, the Comptroller may require or allow him to amend such application and specification and drawings or any of them so as to apply to one invention only, and the applicant may make application for a separate patent for any invention excluded by such amendment.

“Every such last-mentioned application may, if the Comptroller at any time so direct, bear the date of the original application, or such date between the date of the original application and the date of the application in question, as the Comptroller may direct, and shall otherwise be proceeded with as a substantive application in the manner prescribed by the said Acts (1883-1902) and by any Rules thereunder for the time being in force.

“Where the Comptroller has required or allowed any application, specifications or drawings to be amended as aforesaid, such application shall if the Comptroller at any time so direct, bear such date subsequent to the original date of the application and not later than the date when the amendment was made, as the Comptroller shall consider reasonably necessary to give sufficient time for the subsequent procedure relating to such application.”

(2) The specification and drawings must be drawn up in the manner prescribed by the Rules. The size, etc., of the documents is prescribed by Rule 15 of the Patents Rules, 1905, repealing Rule 17 of the Rules of 1903.

The character of the drawings must be such as to comply

with Rules 16 to 24 of the Patents Rules, 1905, repealing Rules 18 to 24 of the Rules of 1903.

The following points are worthy of attention, as a considerable waste of time and trouble are caused by the constant neglect of them by applicants:— Points to be remembered.

- (1) The specification must be dated and signed (by the applicant or his authorised agent).
- (2) In the case of an application on Form A 2 under sect. 103 of the Act of 1888, a copy of the foreign specification, a translation and drawings all duly certified by the official head of the foreign patent office must be enclosed.
- (3) Drawings must be furnished in duplicate, marked respectively "original" and "true copy," but the lettering of the duplicate drawings must be in black lead pencil, and not in ink.

This is somewhat irritating, but the reason for it is cogent. The drawings have to be reduced in size for abridgment in the *Journal*, and were all the lettering to be proportionately reduced great indistinctness would result. Where the lettering is in pencil it may be erased and only replaced so far as may be required when the drawing is reduced.

The duplicate may be on tracing cloth.

It may further be noticed that the office are prepared to supply the required duplicate drawings at a small cost.

(3) If a provisional specification is filed it must clearly indicate the nature of the invention. The description must be quite clear, although the detail is not required (see pp. 115 to 120). Provisional must be clear.

(4) The claims must be succinct as well as separate and distinct from the body of the specification. It must be remembered that the object of the claim is to give a perfectly clear statement of the invention claimed. Of late years a superstition has arisen that a patent is more valid and has a greater hold over infringements if every possible permutation and combination of the elements entering into the invention is separately claimed, and it has become a practice to file claims The claims.



which are copies of those used in American specifications. American claims may be very useful in dealing with American law, but in English law such prolixity does not help a court which, whether in considering novelty or infringement, invariably seeks to obtain an answer to the broad question, "What has this man invented?"

The matter has recently come before both law officers of the Crown on the interpretation of Rule 4 of the Patents Rules, 1905, and the decision is reported *in extenso* in the *Official Journal* for August 2nd, 1905, at p. 1017. The Attorney-General pointed out that certain kinds of inventions might be such as to justify a large number of claims. "So long as the statement of each claim is in itself clear and succinct, and so long as there is an absence of repetition in the separate claims, we do not think that there is necessarily any infringement of this Rule. . . . But in the present case we think that the decision of the Chief Examiner was right. . . . An attempt is made to deal with every possible contingency. . . . I must say that I deprecate very much the multiplication of claims by the system, which seems to have prevailed in America, of attempting to deal with every possible contingency. I do not think it results in clearness. I think that the system of claims with which we are more familiar in this country is really clearer in the result, and that those who have American patents and who desire protection in this country, in bringing forward their claims, must endeavour to conform to the practice which has prevailed in this country."

**The title.**

(5) The title of the invention must sufficiently indicate the subject-matter of the invention.

**Discon-  
formity.**

(6) The complete specification and the provisional must describe substantially the same invention, and the titles must correspond.

Sect. 2 of the Act of 1888 repeals sect. 7 of the principal Act, and enacts that:—

**Examination  
as to form.**

(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.

(2) "Where the Comptroller refuses to accept an application or 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 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."

In addition to the inquiries directed by the Act of 1883, the novelty of the invention is examined into under sect. 1 of the Act of 1902, which came into force on January 1st, 1905, and enacts:—

1.—(1) "Where an application for a patent has been made and a complete specification has been deposited by the applicant, the examiner shall forthwith, in addition to the inquiries which he is directed to make by the Patents, Designs and Trade Marks Act, 1883 (in this Act referred to as the Principal Act), make a further investigation for the purpose of ascertaining whether the invention claimed has been wholly or in part claimed or described in any specification (other than a provisional specification not followed by a complete specification) published before the date of the application, and deposited pursuant to any application for a patent made in the United Kingdom within fifty years next before the date of the application.

**Examination  
as to novelty  
on complete  
specification.**

(2) "If on investigation it appears that the invention has been



*wholly or in part claimed or described in any such specification, the applicant shall be informed thereof, and the applicant may within such time as may be prescribed [two months, Rule 8, 1905] amend his specification, and the amended specification shall be investigated in like manner as the original specification.*

(3) *“The examiner shall report to the Comptroller the result of his investigations in such manner as the Board of Trade may direct.*

(4) *“The provisions of sub-sect. 5 of sect. 9 of the principal Act, as amended by any subsequent enactment, shall apply to reports under this section. (See this section as to secrecy of the Report.)*

(5) *“If the Comptroller is satisfied that no objection exists to the specification on the ground that the invention claimed thereby has been wholly or in part claimed or described in a previous specification as before mentioned, he shall, in the absence of any other lawful ground of objection, accept the specification.*

(6) *“If the Comptroller is not so satisfied, he shall, after hearing the applicant, and unless the objection be removed by amending the specification to the satisfaction of the Comptroller, determine whether a reference to any, and, if so, what, prior specifications ought to be made in the specification by way of notice to the public.*

(7) *“An appeal shall lie from the decision of the Comptroller under this section to the law officer.”*

#### OFFICE PRACTICE.

#### Practice.

As a result of these enactments the following system of office practice has sprung up:—The actual operation of searching is performed by the assistant examiners, and the result handed over to one of the examiners. The applicant or his agent then receives a letter in which the deficiencies of his specification are indicated. In the case of a complete specification he receives a further intimation of the result of the search on the novelty of the invention and a list of specifications which the examiner may consider to be wholly or in part anticipations. If the examiner considers that a complete anticipation has been found, the fact is communicated to the applicant and the search is temporarily stayed.

The applicant has now a choice of courses:—He may consider that the specifications cited reduce the scope of his invention. In this case he will do wisely to amend the description of the nature of his invention and modify his claims. He has two months in which to do this, and on re-submitting the specification the examiner may make further objections. The <sup>Time.</sup> question of time is very important. The two months in which the inventor may endeavour to satisfy the Office run from the date of the first official letter in which an objection is raised to the specification, and is not extended by fresh objections. A considerable amount of annoyance has been felt by agents who are accustomed to the practice of the United States, where the time may be extended indefinitely by correspondence; and it is well to be fully prepared on this point. In suitable cases, however, the Comptroller may extend the time. The reason for the limitation is to be found in sect. 9, sub-sect. 4 of the Act of 1883, which enacts that the application is to be deemed to be abandoned if the specification be not accepted within twelve months.

It is possible that the applicant may feel that the matter is of too difficult a nature to be conveniently dealt with by correspondence. He has now a further choice—he may either refuse to amend the specification according to the suggestions of the examiner and may formally apply for a hearing before the Comptroller.

The better course, however, is to apply for an interview with the examiner who has the case in hand. A time will be appointed, and in view of the amount of work with which the examiners have to deal it is advisable to be punctual. The interview is of an informal and conversational character, and the applicant or his agent or his counsel presents his view of the case in the form of an argument. This usually results in an agreement in which the applicant is content to amend his specification and claims and re-submit them. If, however, the matter arrive at a deadlock, and the applicant is of opinion that the examiner is wrong, he had better apply for a formal hearing before the Comptroller.

At this hearing, which takes place privately, the examiner and the applicant are present, and the Comptroller or the Chief



Examiner sits as a tribunal. The applicant should open his case quite briefly, and describe the nature of what he considers to be his invention, and leave the objections to the examiner. The applicant replies to the objections of the examiner, a discussion usually then takes place to endeavour to arrive at a conclusion, and finally the Comptroller gives his decision.

If the applicant should decide on obtaining this hearing he should make sure that all the objections put forward by the examiner and still remaining undecided receive the attention of the Comptroller. It is very irritating after a decision, apparently, that the specification is to be accepted subject to certain specified conditions to find that the examiner still has some objections that may necessitate another hearing. This is certainly an infrequent occurrence, but the extra expense for skilled advice and the annoyance may be considerable. It would sometimes, however, happen that a further search and objections may be unavoidable. An applicant may claim as his invention the combination of A, B, C, and D, and it may turn out, as a result of the search, that these elements of his invention have been so combined before. In his specification, however, he may have described an improvement in the element D, and the Comptroller may decide to allow him so to amend the specification and claims as to claim this only. A search to investigate the novelty of this new claim will obviously have to be on different lines to that which took place on the earlier form of the specification.

#### THE DECISION OF THE COMPTROLLER.

If the applicant does not himself apply for a hearing, he will receive ten days' notice of the intention of the Comptroller to arrive at a decision and fixing a time for a hearing. If the applicant does not appear the Comptroller will decide in his absence.

If the specification is objected to on grounds other than that of novelty, *e.g.*, that the invention is not a "new manufacture" within the Statute of Monopolies, or that the invention described in the complete specification is distinctly wider than that in the

provisional, the Comptroller may refuse altogether to accept the specification.

If, however, the invention be objected to on the ground of want of novelty under sect. 1 of the Act of 1905, and the applicant does not succeed in removing the objection, Rule 10 of 1905 will apply.

“When under sub-sect. 6 the Comptroller determines that a reference to a prior specification ought to be made by way of notice to the public, the form of reference shall be as follows, and shall be inserted after the claims:—

Reference has been directed in pursuance of sect. 1, sub-sect. 6, of the Patents Act, 1902, to the following specification of Letters Patent No. granted to .

Where the reference is inserted as the result of a provisional report under Rule 7, a statement to that effect shall be added to the reference.”

It is to be noticed that the Comptroller has no power to refuse to grant a patent on the ground of want of novelty, but merely brands it with his notice that it is probably invalid.

No power to refuse patent under Act of 1902.

The report of the examiner is not to bind the judgment of the Comptroller, but merely to assist him in making his decision as to whether the application and specifications fulfil the requirements of the Act (h). It is difficult to define exactly what is the meaning of the words “whether the nature of the invention has been fairly described,” and there is no direct decision on the point, but it is to be presumed that the duty of the Comptroller and examiner does not extend to a minute criticism of specifications. It is clear, however, that the invention must be sufficiently described to enable the inquiry as to novelty to proceed. As a matter of practice, the examiners always require ambiguous descriptions to be made clear, and this is distinctly advantageous to applicants. In *Re Smith's Patent* (Griff. P. C. 268), Herschell, S.-G., said: “There is no power in the Patent Office to examine into the conformity of the claims put forward by the patentee with the description of the invention which he has given. I should only guard myself by saying this: that if the statement of the invention claimed were such

(h) *In re C.'s Application*, 1890, 7 P. O. R. 250.



as 'I claim the invention described in the specification,' that would be regarded as a mere colourable compliance with the terms of the statute, and not as a distinct statement of the invention claimed, because it would merely refer back to the previous description." But the facts of that case are not reported, and it is highly probable that under the Act of 1905 the power of the Comptroller is much wider than as defined by this judgment. The Comptroller has the power to require the claims to be modified in accordance with the results of the inquiry into novelty, and the invention must be sufficiently clearly described to show what the claims actually mean. It would be strange if the claims need not conform to the description.

Sect. 9 of the Act of 1883 expressly throws upon the Comptroller the duty of deciding whether the provisional and complete specifications describe substantially the same invention, but this section can hardly mean that the Comptroller must go into fine questions of construction, but must merely amount to a direction to the Comptroller that an application shall not be accepted if the two specifications on the face of them describe inventions which are substantially different (*i*), since it is always the rule in the Patent Office and of the law officer in questions of doubt to accept an application and leave the sufficiency of the specifications and the other points that arise in that connection for the consideration of the Courts, should the question ever come before them (*k*).

Under the provisions of sect. 86 the Comptroller may refuse to grant a patent for an invention, of which the use would, in his opinion, be contrary to law or morality.

He may also refuse a patent where the invention is not a "new manufacture" within the Statute of Monopolies (*l*). As

(*i*) *In re Anderson's Patent*, 1890, 7 P. O. R. 323, 325; but see per Lindley, L.J., *Gadd v. Mayor of Manchester*, 1892, 9 P. O. R. 527.

(*k*) *Re Chandler's Patent*, 1886, Griff. P. C. 274; *Re Cumming's Patent*, 1884, Griff. P. C. 277;

*Edmunds' Patent*, 1886, Griff. P. C. 283.

(*l*) *Bridge's Application*, 1901, 18 P. O. R. 257; *Cooper's Application*, 1902, 19 P. O. R. 53; *Johnson's Application*, 1902, 19 P. O. R. 56.

a matter of fact applications are frequently made to patent most ingenious notions and systems which are not "new manufactures."

Before exercising any discretionary power adversely to the applicant, the Comptroller must give him ten days' notice, so that he may be heard personally or by his agent on the point in question (m).

When two persons who are joint applicants quarrel, and each lodges a complete specification, the one specification differing from the other, the Comptroller has no jurisdiction to say which specification is to be filed (n).

An applicant who threatens to withdraw or otherwise attempts to wreck an application may be restrained by interim injunction (o) on motion by his co-applicant.

The subject of appeal to the law officer from decisions of the Comptroller will be dealt with in the chapter relating to Opposition to a grant of letters patent.

Sect. 8 of the Act of 1883, as amended by sect. 3 of the Act of 1885, enacts:—

(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. 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.*

(2) "*Unless a complete specification is left within that time the application shall be deemed to be abandoned.*"

The time prescribed is modified by sect. 1, sub-sect. 8, of the Act of 1902:—

(8) "*Sect. 8 of the principal Act, and sect. 3 of the Patents, Designs, and Trade Marks (Amendment) Act, 1885 (which regulate the time for depositing a complete specification), shall have effect as if references therein to the period of nine months were references to the period of six months.*"

(m) Sect. 94 of the Act of 1883; see also P. R. 1903, r. 28, and 1905, r. 9.

(n) *Apostolloff and Freudenberg's Application*, 1896, 13 P. O. R. 275.

(o) *The Wool Syndicate v. Riches*, 1902, 19 P. O. R. 127.



The six months allowed by this section for the filing of the complete specification are calendar months (*p*), and are reckoned exclusive of the day of application (*q*), and in the event of the last day of such six months falling on Christmas Day, Good Friday, or on a Saturday or Sunday, or on any Bank Holiday, or day of public fast or thanksgiving, the specification may be filed on the day succeeding such excluded day or days (*r*).

Extension  
of time.

An application for enlargement of time for leaving a complete specification must state in detail the grounds upon which such extension is applied for, and the applicant must produce such evidence in support of his application as the Comptroller may require (*s*); the prescribed fee is £2 (*t*).

Publication  
of abandoned  
specifications.

In the event of an application being abandoned, the specifications and drawings which were left in connection with the application are not published, nor are they at any time open to public inspection (*u*), except in the case of an abandoned application under sect. 103 of the Act of 1883 (*x*).

Sect. 9 of the Act of 1883, as amended by the Acts of 1885 and 1888, enacts:—

(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. 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 ” (*y*).

(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, unless the Court or officer having power to order discovery in such legal proceeding shall certify that

(*p*) 13 & 14 Vict. c. 21, s. 4.

(*q*) *Russell v. Ledsam*, 1847, 14 M. & W. 574, 582; *Williams v. Nash*, 1859, 28 Beav. 93; 1859, 5 Jur. N. S. 696.

(*r*) Sect. 98 of the Act of 1883; see also P. R. 1903.

(*s*) P. R. 1903, r. 10.

(*t*) P. R. 1903, schedule of fees.

(*u*) 48 & 49 Vict. c. 63, s. 4; see ante, Chap. V. p. 95.

(*x*) *The Patents Act*, 1901, 1 Ed. VII. c. 18.

(*y*) See schedule of fees, Appendix.

*such production or inspection is desirable in the interests of justice, and ought to be allowed."*

Sect. 10 of the principal Act enacts:—

*"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."*

The advertisements are published in the *Illustrated Official Journal*, which is issued every Wednesday (z). Advertisements.

Sect. 14 enacts:—

*"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."*

By sect. 7 (10) of the Act of 1902 and Rule 13 of 1905 an additional fee of 1*l.* is charged on account of the investigation into novelty, to be paid on or before the last day on which the patent may lawfully be sealed; and if the fee be not paid the patent will not be sealed. Sealing fee.

Provisional protection exists for the purpose of enabling an inventor to work at and improve his invention without thereby avoiding the patent subsequently granted to him on the ground of want of novelty (a); it does not afford him the perfect rights which he obtains when his patent is sealed, since he cannot bring an action in respect of any infringement committed before the publication of his complete specification (b), and further, he may not style the invention which is provisionally protected as "patent," but he may make use of such words as "patent applied for" (c). Right to use the word "patent."

Sect. 15 enacts:—

*"After the acceptance of a complete specification, and until the*

(z) P. R. 1903, rr. 11 and 12.

(b) Sect. 13 of the Act of 1883.

(a) Per Earl Cairns, L.C., in *In re Dering's Patent*, 1879, L. R. 13 Ch. D. 395; and see Chap. VII., p. 116.

(c) Sect. 105; see *R. v. Wallis*, 1886, 3 P. O. R. 1; *R. v. Crampton*, 1886, 3 P. O. R. 367.



*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."*

It is no offence, therefore, to describe an article as "patented" after the complete specification has been accepted but before the patent is sealed (*d*).

The mere fact that the article has at one time been the subject of a patent now expired will not entitle the patentee to mark it as "patented," as the word implies that there is an existing patent (*e*).

The effect of sects. 13, 14, and 15 is that no proceedings for infringement may be taken before the patent is sealed, after which time proceedings can only be taken with reference to infringements committed after the acceptance and publication of the complete specification.

The effect of the provisions of the Patents, &c. Acts to prevent fraudulent applications, and also of those for the protection of foreign inventors, has already been discussed in an earlier chapter.

(*d*) *Reg. v. Townsend*, 1896, 13 P. O. R. 265.

(*e*) See *Cheavin v. Walker*, 1877, L. R. 5 C. D. 862.

## CHAPTER IX.

## OPPOSITION.

SECT. 10 of the Act of 1883 provides that upon acceptance of the complete specification, but before sealing the patent, the Comptroller shall advertise the acceptance, and that then the application and specifications, with the drawings, if any, shall be open to public inspection.

Sect. 11, as amended by the Patents, &c. Act, 1888, is as follows:—

(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 to 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 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.”

} First  
ground.

Second  
ground.

Third  
ground.

Prior to the passing of this Act any ground was available for the purpose of opposition which would have been available for the purpose of destroying the validity of the patent. Prior user was a frequent ground of opposition (*In re Samuda*, Hindmarch, p. 534), so also was an alleged dedication to the public by the inventor himself (*In re Adamson's Patent*, 1856, 6 De G. M. & G. 420; 25 L. J. Ch. 456; 4 W. R. 473); but it was



always considered necessary that the ground of the opposition should be proved beyond the shadow of a doubt (*In re Tolhausen's Patent*, 14 W. R. 551, and also *In re Vincent's Patent*, 1867, L. R. 2 Ch. 341). If there was any doubt the patent ought to be sealed, so as to give the inventor the benefit of an exhaustive trial.

Who may  
oppose.

Under sect. 11 there are three grounds of opposition and three only. The section says that "any person" may oppose the grant. In order to oppose on the first or third grounds it is clear that the opponent must be a person who is interested in the invention. But there was considerable doubt as to whether anyone could oppose on the ground that the invention had been previously patented, whether he were interested or not in such prior patent. In a very important case (*The Queen v. The Comptroller-General of Patents*, 1899, 16 P. O. R. 242), it was shown that an opposition had been entered to the grant of a patent on the second ground, but that the opponent had no interest in the prior patent. The Comptroller applied to the law officer for directions under sect. 95. Sir R. Webster, A.-G., construed the section to mean that the opponent must have an interest in such prior patent. The Court of Appeal decided that no Court had any power to review a decision of the law officer under the Act, but agreed with this construction, which applies also to oppositions to applications to amend under sect. 18 (see p. 196). But, as a general rule, if there has been a *bonâ fide* attempt to carry out the invention sought to be protected by the person who desires to be heard in opposition, and proof that he may be damaged or affected by the application which he desires to oppose, he is entitled to be heard (a). Each case will depend on its merits. The mere fact, however, that the opponent has manufactured under the prior patent will not give him a *locus standi* unless he is the patentee (b).

In *Heath and Frost's Patent* (1886, Griff. P. C. 290), Sir E. Clarke said: "It appears to me that by sect. 11 it is quite clear that the only class of persons who are entitled to be heard in

(a) *Meyer's Application*, 1899, 16 P. O. R. 527.

(b) *MacEvoy's Patent*, 1888, 5 P. O. R. 285.

opposition before the law officer, are persons who are interested with a real and legitimate interest in the prior patent upon which an application is opposed, or persons who, while they have not patented the invention, have yet been the originators of it, from whom the person seeking the patent has obtained it."

In that case the opponent was an agent for the patentee, and although it had been common in opposition cases, for the sake of simplicity, for patent agents acting on behalf of clients to oppose grants of patents in their own names, the law officer decided that the opponent had not such an interest as to be entitled to be heard, and furthermore refused to grant leave to amend the notice of opposition.

An opponent who has a *locus standi* on the first or third grounds may, therefore, be unable to oppose on the second ground (c)

The first ground of opposition as defined by the Act is that the applicant has obtained the invention from the opposing party, or from one of whom he is the legal representative. This question involves the credibility of witnesses. The Comptroller has no power to examine witnesses, although he may request the voluntary attendance for explanation of anyone who has made a declaration (d); and if there is a conflict shown in the declarations, the usual practice is that the Comptroller allows the patent to be sealed, and the opponent appeals to the law officer, who takes oral evidence on oath (e). But the law officer will not decide a case of this kind against the applicant unless there is very little doubt on the facts, since the opponent always has an opportunity of having the question tried in open court on a petition to revoke the patent under sect. 26.

First ground.

Effect of a conflict of evidence.

In *Edmund's Patent* (1886, Griff. P. C. 283), Sir R. Webster, A.-G., said: "I am clearly of opinion that, under the circumstances, the Comptroller-General was right in declining to stop the patent in the present case. Had he done so, or if I were now to do so, there would be no means of reviewing our decision, whereas, if the patent is sealed, the question can be

(c) *J. and J.'s Application*, 1902, 19 P. O. R. 555.

(d) Rule 34, 1903.

T.—P.

(e) *Evans and Otway's Patent*, 1884, Griff. P. C. 279; *Luke's Patent*, 1886, Griff. P. C. 294.



raised either in the proceedings to which I have already referred, or it may be in proceedings for revocation, should the parties be advised to institute any such proceedings."

In *In re Stuart's Application* (1892, 9 P. O. R. 452), Sir E. Clarke, S.-G., said: "I think that the law officer is only entitled to stop the issue of a patent, having examined all the evidence given on one side or the other, if he is so clearly of opinion that the opponent has made out his case that he would, if a jury were to find in favour of the applicant, refuse to accept it and overrule the decision on the ground that it was perverse and contrary to the obvious weight and effect of the evidence."

Where both parties meritorious.

In the case of an opposition upon the first ground, it frequently happens that the law officer is of opinion that both the applicant and the opponent contributed materially to the invention. In such case terms will be imposed giving both parties an interest in the patent (*f*).

Master and servant.

In *David and Woodley* (1884, Griff. L. O. C. 26), upon the question of workman and master, Sir H. Davey said: "I am of opinion that if a workman is employed by an inventor to make a model for the purpose of carrying out his invention, and the workman suggests improvements in detail of the machine, which are adopted in the machine or model as completed, those suggestions are the property of his employer, and the workman cannot afterwards take out a patent for them" (*g*).

It is not a question of "true and first inventor."

The words "obtained the invention" do not necessarily imply that the person from whom the invention had been obtained had taken out or even intended to take out a patent for it; it refers to the identity of the invention, not the right of the person from whom it was obtained to be regarded as the first and true inventor (*h*).

Where it appeared that a part of the subject of the applica-

(*f*) *Russell's Patent*, 1857, 2 De G. M. & J. 130; Good. P. C. 589; P. C. 279; *Re Garthwaite*, 1886, Griff. P. C. 284.

*Luke's Patent*, 1886, Griff. P. C. 294; *Re Hatfield*, 1884, Griff. P. C. 288; *Re Eadie*, 1885, Griff. P. C. 279; *Evans v. Otway*, 1884, Griff. P. O. R. 429; and p. 26 et seq.

(*g*) See also *Re Heald*, 1891, 8 P. O. R. 429; and p. 26 et seq. (*h*) *Re Thwaite's Application*, 1892, 9 P. O. R. 515.

tion had been obtained from the opponent, the law officer struck out that portion and allowed the remainder to go on (*i*).

In *In re Edmunds* (1886, Griff. P. C. 281), the Comptroller was of opinion that the words "legal representative" in sect. 11 meant the executor or administrator of a deceased person and would not include a person holding a power of attorney (*k*). Meaning of "legal representative."

In the case of inventions communicated from abroad neither the Comptroller nor the law officer will inquire into what happened outside the United Kingdom, the importer is the true and first inventor, and the means by which he may have obtained the invention are of no importance and will not be considered, since the merit of the invention consists in its importation into this country (*l*). Fraud abroad will not be considered.

The other two grounds of opposition are such as can readily be proved or disproved, hence the power of the law officer can be exercised with less prejudice to the interests of justice. In *Cummings' Patent* (1884, Griff. P. C. 277) (*m*), Sir Henry James, although of opinion that the applicant's invention and that which formed the ground of opposition were very nearly the same, thought there was just sufficient difference (although a very slight difference) to justify him in affirming the Comptroller-General's decision. He felt, too, that if he refused a patent his decision would be final.

It will make no difference in the exercise of the discretion of the law officer, upon the report of the Comptroller, if the specification appears to him to comprise the same invention as is comprised in a previous application, that the validity of the first patent is in dispute (*n*), nor that the opponent's patent has expired (*o*). The invalidity of opponent's patent immaterial.

Therefore the invalidity of the opponent's patent on account

(*i*) *Re Thwaite's Application*, L. O. C. 33.  
1892, 9 P. O. R. 515.

(*k*) See also *Re Adolph Spiel*, P. C. 286; *Haythornthwaite's Application*, 1890, 7 P. O. R. 70; *Thornborough and Wilks' Application*, 1896, 13 P. O. R. 116.

(*l*) *Re Edmunds*, 1886, Griff. P. C. 281; *Re Lake*, 1888, 5 P. O. R. 415; *Re Higgins*, 1892, 9 P. O. R. 74.

(*m*) See also *Jones' Patent*, Griff. P. C. 293; *Stewart's Application*, 1896, 13 P. O. R. 628.

(*n*) *Green's Patent*, 1885, Griff. P. C. 286; *Haythornthwaite's Application*, 1890, 7 P. O. R. 70; *Thornborough and Wilks' Application*, 1896, 13 P. O. R. 116.

(*o*) *Lancaster's Patent*, 1884, Griff. P. C. 293; *Stewart's Application*, 1896, 13 P. O. R. 628.



of disconformity is immaterial (*p*). But where the opponent's complete specification was filed between the dates of the filing by the applicant of his provisional and complete specifications, and it had been expressly decided in a former case that the part relied on by the opponents was not within their provisional and could not therefore be claimed, it was held that the opposition could not succeed (*q*). But where the facts were the same so far as the dates of filing were concerned, but there had been no such decision, the applicants were not allowed to rely on disconformity between the opponent's provisional and his complete (*r*).

"On the ground that the invention has been patented in this country" will not give a *locus standi* for opposition where only provisional protection has been granted for the previous invention (*s*); but it is otherwise where the opponent has brought himself within the terms of sect. 15 (*t*). The invention to be patented must be claimed in the prior patent, and mere description is not sufficient (*u*).

Identity is required to stop applicant's patent.

In *Stubbs' Patent* (1884, Griff. P. C. 298), Sir R. Webster said: "As this is the first case I have had to deal with, I should like to explain what I mean to do in these cases. Of course, I need not remind you that stopping a patent is a very serious step, because there are no means whatever of an applicant getting that which he applies for if I stop it, and it must be distinctly understood that I shall not stop the patent unless I am satisfied that the inventions are identical. I shall not hesitate to stop it if I can see clearly they are identical. . . . I shall, as a rule, allow costs to follow the event" (*x*).

This means that the comparison between the two specifications

(*p*) *Haythornthwaite's Application*, 1890, 7 P. O. R. 70.

(*q*) *Barrett's Application*, 1892, 9 P. O. R. 511.

(*r*) *Green's Application*, 1885, Griff. P. C. 286.

(*s*) *Bailey's Patent*, 1884, Griff. P. C. 269.

(*t*) *L'Oiseau and Pierrard*, 1886, Griff. L. O. C. 36.

(*u*) *Von Buch's Application*, 1886, Griff. L. O. C. 40; *Bartlett's Application*, 1892, 9 P. O. R. 514.

(*x*) See also *Cumming's Application*, 1884, Griff. P. C. 277; *Re Todd*, 1892, 9 P. O. R. 487; *Re Tattersall*, 1892, 9 P. O. R. 150; *Nahnsen's Application*, 1900, 17 P. O. R. 203.

will be made with greater strictness against the earlier one than would be the case were the question one of infringement. But if the differences are immaterial the opposition will be successful (y). But immaterial differences will not avail.

In *Smith's Patent* (1896, 13 P. O. R. 201), Sir R. Webster said: "It is only in cases in which the law officer is satisfied that there is no difference which can be regarded as amounting to invention that the later patent can be stopped. . . . I desire to say that it is quite incorrect to suppose that, in giving judgment in *Stubbs' Case*, I ever intended to suggest that the law officer ought not to consider mechanical equivalents as bearing upon the question of identity of invention. I entirely agree with the judgment of my then colleague, Sir E. Clarke, in *Haythornthwaite's Case*: and on many occasions when I had to deal with the matter previously, I did consider the question of mechanical equivalents as bearing upon the question of identity."

And where it appeared that all the elements of the combination claimed by the applicant had been previously patented, and there was no invention in combining them, a patent was refused. Nor where there is no invention.  
(*Bridge's Application*, 1901, 18 P. O. R. 257.)

Where it appears to the Comptroller-General or law officer that the applicant's specification is too general and calculated to deceive the public, or appears to overlap the invention of the opponent, the patent will only be granted on condition of the insertion of a disclaiming clause; such clause may be general or special, that is, either a general reference to common knowledge or a specific reference to the opponent's specification, with a disclaimer to the invention therein described.

The effect of a general disclaimer is somewhat different from that of a special reference. The former is inserted for the purpose of preventing the later patentee from alleging that his invention is wider than that which he is entitled to claim, both in his own interests, in order that his specification may not be considered General disclaimer.

(y) *Aire and Walker's Application*, 1888, 5 P. O. R. 344; *Wallis and Ratcliff's Application*, 1888, 5 P. O. R. 347; *Daniel's Application*, 1888, 5 P. O. R. 414; *Haythornthwaite's Patent*, 1890, 7 P. O. R. 71; *Wylie and Morton's Application*, 1896, 13 P. O. R. 98.



too wide, and in the interests of the public, on the ground that the public are entitled to know what a subsequent patentee may claim, and to have a fair description of the existing state of knowledge (s).

Special disclaimer where identity.

The specific reference, however, is intended as a warning to the public and to protect the prior patentee where there is practical identity of the inventions claimed, and will only be directed with reluctance.

Sir R. Webster, in *Re Stell's Patent* (1891, 8 P. O. R. 236), referring to an application for a specific reference, said: "The principles upon which the law officers have acted now for some years in allowing disclaiming clauses are, first, if it appears clear that upon the invention claimed by the prior patentee there will be a repetition of the claim to the earlier invention in the later patent; and secondly, if it is clear that the public would be misled by the later specification without disclaimer."

Sir R. Webster, in *Re Guest and Barrow* (1888, 5 P. O. R. 315), said: "I have never considered that a prior patentee has any right to be specially named, unless the applicants are willing to name him, and unless it is clear there is no other publication except the one that is mentioned." In *Re Welch's Patent* (1891, 8 P. O. R. 443), Sir R. Webster said: "I do not think that a later patentee ought to be compelled to insert a special reference to the earlier specification of the opponent, unless it is practically admitted by the later applicant that the governing principle was, for the first time, discovered or disclosed in the opponent's specification."

Difference in purpose and effect.

The difference between the two kinds of disclaimer was pointed out by Sir Richard in *Newton's Application* (1900, 17 P. O. R. 124): "I have often laid down the rule as to the cases in which I think specific references are right, viz., where there is substantial identity between the fundamental parts of the two inventions, but a difference which can only be justified upon the ground of improvement and it being right to protect in that case both the public and the prior patentee by a specific

(z) Per Sir R. Webster, in *Re Guest and Barrow*, 1888, 5 P. O. R. 315; see also *Re Sielaff*, 1888, 5 P. O. R. 484; *Re Hill*, 1888, 5 P. O. R. 599.

reference to his invention. In order to make up one's mind whether or not a specific reference or a general disclaimer is required, you must to a certain extent endeavour to grasp what is the invention in each case. . . . I do not consider that a statement of public knowledge in the terms of the claim has by any means the same effect as a specific reference. It seems to me that it then becomes a statement of general knowledge. It allows no inference that the ambit of the invention is the same in the one as the other; on the contrary, it leaves the question of invention to be determined from the consideration of that which the earlier patentee and the later patentee have respectively described."

In *Southwell and Head's Application* (1899, 16 P. O. R. 362), Sir R. Webster, A.-G., decided that in the absence of an agreement by the parties as to the state of the art at the time of the opponent's invention, the opponent must produce evidence thereof to support his claim to have discovered a new governing principle, *i.e.*, to have a "master patent," in order to entitle him to a specific reference. Now it was decided, in 1903 (unreported), by Sir E. Carson, S.-G., that the applicant may not refer to anything but prior specifications to disprove the opponent's claim to a "master patent," and he declined to look at a treatise or at a German specification published in this country for that purpose (a). It would seem, therefore, that the evidence required in such a case by the opponent would be a declaration of a search having been made at the Patent Office library through specifications of earlier date without discovering any anticipation.

Evidence of prior knowledge to support "master patent."

Where, however, the applicant shows only a minimum of invention beyond what is described in the opponent's specification, the question of whether the latter is a "master patent" or not will not be considered in any narrow spirit, and a specific reference will probably be inserted, if the opponent's patent is of great importance (*Sachse's Application*, 1901, 18 P. O. R. 221).

It frequently happens that the applicant's invention is shown to be anticipated to a great extent, and the question then arises as to whether he may be allowed to amend his specification and

(a) Sir E. Carson in a subsequent case (also unreported) disapproved of his own decision in this case, and the matter remains in considerable doubt.



claims so as to cut away the invalid part. The extent to which this is allowable depends on the circumstances of the case (*b*), and is by no means permitted as a matter of course (*c*). The true principle to be applied is to be found in the question, "Does the amended specification indicate an invention substantially different from that at first described?" Where this is so, even though the specification before amendment contained the elements of what is now set forward as the invention to be protected, the patent will be refused (*d*). In *Crist's Application* (1903, 20 P. O. R. 476), Sir E. Carson said: "Amendments must not be considered as a matter of course. They must be amendments in the real sense, and not the practical re-writing of the whole specification and the formation of some new claim. The truth of the matter in this case is that Mr. Crist desired to obtain something by his specification which clearly was never his, and if by framing his specification in that way he has lost something which was mingled up with a claim very much wider than anything he could possibly hope to have claimed, if he had taken the trouble to look into the previous specifications, it is not the fault of this department, but his own, that he did not originally frame his specification in the proper way."

**Sect. 103.**  
**Ante-dated**  
**specification.**

A question has arisen as to whether, when a patent is ante-dated, pursuant to the provisions of sect. 103, and when an application is made for letters patent for the same invention by another applicant, between the date to which such patent is ante-dated and the actual date of application, such antedated patent should, for the purpose of opposition, be treated as of the antedated date or the actual date. Sir R. Webster, on January 17th, 1888, held, in the matter of *Eccrill's Patent* and *L'Oiseau and Pierrard's* opposition (1886, Griff. L. O. C. 28), that although the opponent's patent would override the applicant's by reason of the antedating, still that for the purpose of opposition the opponents had no *locus standi*. Sir R. Webster had, on December 7th, 1887, allowed *L'Oiseau and Pierrard's*

(*b*) *Harrild and Parkins' Application*, 1900, 17 P. O. R. 619.

(*c*) *Thomas and Prevosts' Application*, 1899, 16 P. O. R. 70.

(*d*) *Thomas and Prevosts' Application*, 1899, 16 P. O. R. 70; *Mills' Application*, 1901, 18 P. O. R. 323.

patent to be amended by antedating it, pursuant to the 103rd section and to the Convention, notwithstanding that such antedating would have the effect of overriding *Everitt's Patent* (1886, Griff. L. O. C. 36).

The third ground of opposition was introduced by sect. 4 of the Act of 1883, for the purpose of preventing an applicant from claiming in his complete specification an improvement on his invention, which was contained in the provisional of the opponent filed after the date of the applicant's provisional specification and thereby depriving the opponent of the benefit of his invention; but an applicant is not thereby deprived of his old right to include fair developments of his patent in his complete specification (c). Third ground of opposition.

The Practice in oppositions is regulated by Rules 32 to 41 of the Patents Rules, 1903. And appeals to the law officer by the Law Officers' Rules. (See sect. 38 of the Act of 1883.) In these will be found all the rules relating to evidence and notices. Practice.

The notice of opposition must state the grounds upon which the opponent intends to oppose the grant and must be signed by him; a copy of such notice is delivered by the Comptroller to the applicant. Within 14 days after the expiration of two months from the date of the advertisement of the acceptance of the complete specification, the opponent may file statutory declarations in support of his opposition, and must deliver to the applicant a list thereof; within 14 days from the delivery of such list the applicant may leave statutory declarations in reply, a list of which must be sent to the opponent; the opponent may leave further declarations at the Patent Office, a list of which must be delivered to the applicant; such last-mentioned declarations must be confined to matters strictly in reply. No further evidence may be left on either side except by leave of the Comptroller.

The second sub-section provides:—“ *Where such notice is given, the Comptroller shall give notice of the opposition to the applicant,*

(c) *Edwards' Application*, 1894, 11 P. O. R. 461; *Millar's Application*, 1898, 15 P. O. R. 718.



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.

(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."

If the opponent die before the day fixed for hearing the opposition, the notice of opposition may be amended by inserting the name of another opponent (*f*).

In all cases save those where fraud is alleged the applicant opens his case first.

Notice of appeal must be filed within fourteen days from the date of the decision appealed against, and must state the nature of such decision. The evidence used on appeal to the law officer must be the same as that used at the hearing before the Comptroller, save as to matters that have occurred or come to the knowledge of either party in the meanwhile, except with the leave of the law officer. The law officer shall, at the request of either party, order the attendance at the hearing of the appeal, for the purpose of being cross-examined, of any person who has made a declaration in the matter in question, unless, in the opinion of the law officer, there is good ground for not making such an order.

The law officer will not allow the question of fraud to be raised for the first time on appeal (*g*).

The Comptroller has no power to award costs.

#### Costs.

The law officer may award costs, which will usually follow the event. But the amount awarded will be specifically named, and will not be a sum large enough to indemnify the successful party; "To do so would seriously discourage the appeals, and limit very much the usefulness which the law officers fill in these matters" (Sir E. Clarke, S.-G., in *Stuart's Application*, 1892, 9 P. O. R. 453).

The power which the law officer has, under sect. 10, sub-sect. 4, of obtaining the assistance of an expert, is seldom made use of.

(*f*) *Lake's Application*, 1886, Griff. L. O. C. 35.

(*g*) *Huth's Application*, 1884, Griff. P. C. 292.

## CHAPTER X.

## AMENDMENT OF SPECIFICATIONS.

IN previous chapters we have seen that the specification may be amended before publication as a result of the procedure on application and acceptance or on account of opposition to the grant. We now have to deal with cases in which the applicant or patentee desires to amend the specification after publication. The extent to which this may be done and the procedure are regulated by sects. 18—21 of the Act of 1883 and Rules 42—50 of 1903. Sects. 18—21,  
1883.

The history of the law on this matter however is instructive. There are several reported cases showing that at common law mere clerical errors in a specification might formerly be amended by the Master of the Rolls and the Lord Chancellor upon petition, but these amendments were strictly limited to verbal or clerical errors arising from mistake or inadvertence (a). History of  
the law. In *Re Gare's Patent* (1884, L. R. 26 C. D. 105), Brett, M.R., allowed amendments of clerical errors in a specification filed under sects. 27 and 28 of the Patents, &c. Act, 1852, and said: "The Master of the Rolls is of opinion that sect. 18 of the Patents, &c. Act, 1883, does not affect the power of the Master of the Rolls to allow amendments in a patent specification filed in pursuance of sects. 27 and 28 of the Patent Act, 1852, or which is otherwise to be considered as a record under the authority of the Master of the Rolls. So long as the specification is in the Patent Office, and before the patent is sealed, the Master of the Rolls considers that the proceedings of sect. 18 should be the only proceedings taken by anyone asking for amendment under that section."

(a) *In re Sharp's Patent*, 1840, 1 Web. P. C. 649; *In re Johnson's Patent*, 1877, L. R. 5 C. D. 503.



It would appear from the words printed in italics that the jurisdiction of the Master of the Rolls is still intact with reference to amendments after sealing.

In *Re Berdan's Patent* (1875, L. R. 20 Eq. 346), it was held that where a disclaimer had been filed without the consent of the patentee, the Master of the Rolls had jurisdiction without bill filed, to order it to be taken off the file.

Sect. 91 gives to the Comptroller power to correct any clerical error in or in connection with an application for a patent on payment of the prescribed fee.

We have seen that a patent for a very meritorious invention may be utterly vitiated by the patentee claiming something which is not new; so, also, a patent might be rendered void by reason of innocent misdescription or misrepresentation.

The common law power of amendment being found insufficient for the purposes of justice in such cases, the Act 5 & 6 Will. IV. c. 83, was passed, enabling "*any person who as grantee, assignee, or otherwise, hath obtained, or shall hereafter obtain, letters patent, &c.,*" with the leave of the law officer, to disclaim any part of the "title of the invention or of the specification, stating the reason for such disclaimer;" or to, with such leave as aforesaid, "enter a memorandum of any alteration in such title or specification (not being such disclaimer or such alteration as shall extend the exclusive right granted by the said letters patent), &c., &c." The case of *Spilsbury v. Clough* (1842, 2 Q. B. 466) having very much limited the meaning of the words of the statute, printed above in italics, the Act 7 & 8 Vict. c. 69, was passed, giving power to the original patentee, or his assignees, or both jointly, in the event of any interest in the patent remaining in the original patentee, to file a disclaimer or memorandum of alteration.

It will be observed that prior to the Act of 1883 any disclaimer or amendment made by the patentee was entirely at his own peril, and that in any subsequent action involving the validity of the patent objection might be taken to the disclaimer or amendment on the ground that it really extended the patent beyond its original limits.

The provisions of sect. 18 of the Act of 1883, as amended

so far as sub-sect. 10 is concerned by sect. 5 of the Patents, &c. Act, 1886, are as follows:—

(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.*” The present law.

When the Comptroller-general has not required an amendment, all amendments by the applicant or patentee from the date of lodging the complete specification must be made under sect. 18.

“The patentee,” as has been pointed out in a previous chapter, means the person for the time being entitled to the benefit of the patent, while “the applicant” means the person whose patent has not yet been sealed, but whose complete specification has been lodged.

Directly the specification is accepted it becomes open to public inspection (see sect. 10), and therefore the application to amend will have to be made under sect. 18. The case of *Jones' Patent* (Griff. P. C. 313), which is otherwise badly reported and ambiguous, makes this clear. The practice of the Patent Office is to allow amendments under sects. 7 and 9 before acceptance. We will deal firstly with the nature of permissible amendments and refer later to the practice.

(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.*” The extent of the amendment.

It will be observed that the amendments under the Act of 1883 are to be by disclaimer, correction or explanation, provided the amendment does not cause the specification to claim an invention substantially larger or different. The Act of Will. IV., after using the words “disclaimer” and “alteration,” provided that no extension should take place in the “exclusive right” granted by the letters patent.

It was always a question of great difficulty whether or not a disclaimer or alteration extended the “exclusive right” of the patentee. For instance, if in his original specification, after describing several improvements in a process of manufacture, he Under the Act of Will. IV.



proceeded to claim them all, and it should turn out that one of his improvements was old, the whole patent was bad and the patentee had no exclusive right at all; if he then disclaimed the objectionable portion, his patent became good as to all the rest. There was clearly, therefore, an extension of the exclusive right, notwithstanding that this was the very case the statute was passed to meet. In *R. v. Mill* (1850, 20 L. J. C. P. 24), Mr. Justice Maule's view of the Act of Will. IV. was: "Whereas there were previously many small and trifling objections by which, if they were sustained against any one of many important inventions, the whole was avoided. In such cases amendments may now be made by means of a disclaimer."

Romilly, M.R., in the same case at the Rolls (14 Beav. 315), said: "It is proper they (patentees) should be allowed to correct errors in their patents by removing from the specification parts which are not material or substantial, or which they have since discovered not to be new inventions; but this power ought to be exercised with great care and discretion." There is a case reported in Maorory's Patent Cases, at page 116, where Sir Richard Bethell, when Solicitor-General, allowed a patentee to enter a disclaimer, the effect of which was to enable him to claim for a combination, the original claim being for the several parts of the described invention. When afterwards he became Lord Westbury he described the words of this statute as vague and indefinite, and said: "Possibly they mean that the patent must not, by the operation of the disclaimer, be made to include or comprehend something which was not originally contained in the patent. The invention claimed may be reduced or diminished, but it must not be extended or enlarged." (*Foxwell v. Bostock*, 1864, 4 De G. J. & S. 306.)

The case of *Ralston v. Smith* (1860, 11 H. L. C. 223) shows the difficulty which the Courts had in reconciling a disclaimer which might make a patent valid which was void *ab initio*, with the prohibition against extending the exclusive right. The judgment of Lord Chelmsford, as reported, is remarkable for its cautious vagueness, and the care which seems to have been exercised not to lay down anything approaching to a general principle. Under the Act of 1883 it is not the exclusive right

which must not be extended, but the invention must not be substantially larger or different.

Disclaimers will not be allowed that tend to widen the claim. **Disclaimer.**  
A claim for a combination would necessarily be widened by disclaiming one of the elements of that combination. But where there is a general claim which would include A., B., C., D., E. or F., and you confine it to F., that is a narrower claim than the original, and it is not different, because it is included in the old claim (b).

The case of *Dellrick's Patent* (1898, 15 P. O. R. 686) is instructive on this point. The inventor had originally described improvements in incandescent mantles for gas lighting, in which he enumerated a long list of metallic oxides which might be used to coat the mantles, and he described an elaborate theory of the behaviour of the mantles so treated, attributing it partly to the relative conducting powers of the mantle and the coating. His claim was: "The herein-described process of treating incandescents which are non-conductors of heat, such as the oxides of calcium, magnesium, aluminium, zirconium, and similar metals of this group, or compounds of these oxides, by covering or saturating them with a coating of refractory oxide of a heavy metal or metals."

The proposed amendments were to cut out all the description of the theory, the words "non-conductors of heat" and "similar metals of this group" in the claim, and to substitute for the words "with a coating of refractory oxide of a heavy metal or metals" the words, "with a coating of chromium oxide," chromium oxide being one of the coatings in the list set out in the body of the specification.

Sir Robert Finlay, S.-G., held that the amendments were permissible, since an inventor is not bound to set forth an accurate theory, nor, indeed, any theory of the behaviour of his invention, and said: "It is perfectly true in this case that the patentee desires to throw a very large part of his cargo overboard, but I confess that I think for all that it is a case of disclaimer. It may be a case of disclaiming six-sevenths, or

(b) *Cochrane's Patent*, 1885, Griff. P. O. 305.



nine-tenths, or ninety-nine hundredths of what was contained in the original patent, but for all that he is not introducing anything new; he is merely retaining one of the elements which formed the subject of the alleged invention contained in the original patent.”

Disclaimer  
in combina-  
tions.

But where a claim is for a combination, an alteration of that combination will mean that the claim will be for a different invention.

The case of *Parkinson's Patent* (1896, 13 P. O. R. 513) is an instructive example of a disclaimer which would have made the claim not wider, but different from what it originally was. The claim originally was for the combination of A. and B. to operate on a new principle. It was found that the principle and the combination of A. and B. for effecting it were well known. The proposed amendment was to disclaim the mere combination of A. and B., and to claim A. and B. in combination with the other portions of the apparatus. Sir R. Finlay, S.-G., said: “To my mind the specification as amended, if this application were allowed, would be for something substantially different from what the patent originally claimed . . . the patentee claims the combination of the sieve with the side deposit surfaces, tapering or not tapering. . . . What would be the effect of the patent as amended? It would be really for a new combination: for the combination of the sieve and side deposit surfaces with the other parts of the apparatus indicated by the words in the proposed amendment: ‘Other portions of the apparatus substantially in the manner hereinbefore described, so as practically to free the escaping air from particles of dust.’ That may or may not be a good claim, but to my mind it is perfectly impossible to say that it is not substantially different from the naked claim . . . for the combination of the sieve with side deposit surfaces.”

Where there are in the original specification two claims for A. and for B. respectively, it is not permissible to amend by substituting for these claims, one for A. and B. in combination, since the combination is a different invention. The case of *Kelly v. Heathman* (1890, 45 C. D. 256; 7 P. O. R. 343 (c),

(c) And see *Bateman and Moore's Patent*, 1854, Macr. P. C. 116.

which seems to have been at one time considered an authority to the contrary, was explained by Sir E. Carson, S.-G., in his decision in *Hattersley and Hodgson's Patent* (1904, 21 P. O. R. 239). Mr. Justice North had held in the former case that there was no objection in that particular case to the amendment, but he so decided upon the ground that even before amendment there was a claim to a combination, though not happily expressed, and that the amendment amounted to nothing more than a correction or explanation, which is, of course, admissible.

In *Johnson's Patent* (1896, 13 P. O. R. 661), Sir R. Webster said: "Disclaimer is not to be used solely for the mere purpose of turning an insufficient description into a sufficient description. Of course, it is to be used for the purpose of turning an ambiguous specification into a clear specification, but not for the purpose of turning an insufficient description into a sufficient, especially if the amendment introduces subsequent knowledge."

"Correction or explanation" does not include amendment by the insertion of subsequently ascertained knowledge; it is only allowed for the purpose of explaining more clearly the meaning of the patentee at the time when he patented his invention, that is, to correct and explain the enunciation of his invention as he intended originally to give it. Correction or explanation.

In the case of *Beck and Justice's Patent* (Griff. L. O. C. 10), the specification described "improvements in nozzles for the escape of steam or gases under pressure," the proposed amendment included directions for modifying the invention for use in gas engines. Gas engines were not mentioned in the original specification, and it was admitted that the amendment was rendered necessary by the development of them, which had since taken place. The amendment was not allowed.

Sir R. Webster, A.-G., said: "My idea of the function of an explanation within sect. 18 is to explain more clearly what is necessary to understand the meaning of the patentee at the time he patented the invention. I do not think it is intended that he should put in subsequently ascertained knowledge."

Where no reason was shown by the patentee for requiring the amendment, in the case of a specification which on the face of Must be a reason.



it was sufficient without it, the law officer refused the application (*d*). (See as to Practice in this matter, p. 195.)

In *Hampton and Fawcett*, 1887, Griff. L. O. C. 15) the applicants desired to insert a statement in their specification imputing disadvantage to former patents: the Solicitor-General refused the application on the ground that he was not at all satisfied that the faults imputed to those patents did in reality exist.

Re-writing  
not allowed.

An amendment which in effect amounts practically to the re-writing of the whole specification will not be allowed (*e*), nor an amendment which abandons the original substantive claim and limits the invention to a subordinate and unimportant alternative (*f*).

The law officer will allow an amendment which upon a fair interpretation tends to limit the scope of the original specification, and where a specification is clearly capable of two constructions the patentee by amendment can limit himself to one of them (*g*).

Cannot amend  
title nor  
provisional.

Under this section there is power neither to amend the title nor the provisional specification. When a complete specification is filed with a narrower title than the provisional, the proper course for the Comptroller-General to adopt is to amend the title of the provisional under sect. 7, or to give the applicant liberty to insert a disclaiming clause in the complete specification and assimilate the title of the complete to that of the provisional (*h*).

#### THE PRACTICE ON AN APPLICATION FOR LEAVE TO AMEND.

Reasons must  
be given.

Under the Act of Will. IV., when a patentee sought to disclaim, it was necessary that he should give his reasons for the

(*d*) *Re Morgan*, 1886, Griff. L. O. C. 17; *Re Nordenfelt*, 1887, Griff. L. O. C. 18. 1886, Griff. P. C. 311; *Crist's Application*, 1903, 20 P. O. R. 476.

(*e*) *Re Nairn*, 1891, 8 P. O. R. 444; *Garnett's Application*, 1899, 16 P. O. R. 156; *Crist's Application*, 1903, 20 P. O. R. 476 (see pp. 183, 184, ante). (*g*) *Re Rylands*, 1888, 5 P. O. R. 665; see also other instances, *R. v. Mill*, 1850, 10 C. B. 379; *Seed v. Higgins*, 1859, 8 H. L. C. 550.

(*f*) *Re Heath and Frost's Patent*, 307. (*h*) *Dart's Patent*, Griff. P. C. 307.

proposed disclaimer, but he was not compelled to state reasons for a proposed alteration. Under the present statute he must give his reasons for any amendment, whatever the form of the amendment may be. The reasons will, of course, vary with each case—either that the patentee has discovered that parts of the invention claimed are not new, or are useless, or are not sufficiently described, or that they will not work.

The reasons for an amendment form no part of the amendment itself (*i*).

If the reasons do not disclose any ground on which the amendment ought to be allowed, the application will be dismissed (*k*); but the amendment will not be refused merely on the ground that the reasons given for it are insufficient (*l*).

Sir E. Clarke, S.-G., in *Re Lang's Patent* (1890, 7 P. O. R. 469), summed up the jurisdiction of the L. O. under the 18th section in the following words: "I do not doubt that I have power to allow any amendments, whether of the letterpress of the specification, or of the drawings, or by way of adding drawings, if drawings have not in the first instance been appended to the specification, necessary to define the disclaimer which it is desired to make."

Prohibition will not lie to the law officer in the exercise of his discretion under this section: *Ex parte Simon*, "Times," Aug. 6, 1888, C. A. No prohibition to law officer.

(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.*" Advertisement of request.

In *Ashworth's Patent* (Griff. L. O. C. 7), Sir H. Davey, S.-G., said: "The sect. 18 (2) does not in terms say the reasons are to be advertised, but probably the reasons are a part of the request." It is not the practice, however, to advertise the reasons (*m*). The practice is regulated by rules 42 to 50, and 39 to 41 of 1903.

(*i*) *Cannington v. Nuttall*, 1871, L. R. 5 H. L. 205, 227, 228.

(*k*) *Re Nordenfelt's Patent*, 1887, Griff. L. O. C. 18.

(*l*) *Ashworth's Patent*, 1886, Griff. L. O. C. 6.

(*m*) See Rule 42.



Who may  
oppose  
amendments.

The section says that "any person" may oppose. This is, of course, limited in exactly the same manner as an opposition entered to a grant (see p. 176).

The hearing.

(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.*"

The Comptroller exercises the power to impose conditions given in express terms to the law officer under sub-sect. 4 (n). In *Codd's Patent* (1884, Griff. P. C. 307) he ordered as a condition of allowing an amendment, (1) that no proceedings be taken against opponent A. in respect of infringements committed prior to the 1st January, 1884; (2) that the applicant pay to opponent A. *ten guineas as and for his costs* of and incident to his opposition to the abortive application of 10th July, 1884. It is, however, clear that the Comptroller-General has no power to give costs as a condition of amendment (o).

In *Cochrane's Patent* (1885, Griff. P. C. 304) the opposition to the amendment and the opposition to the grant were fixed for hearing before the Comptroller-General on the same day; the Comptroller-General elected to hear the amendment case first, on the ground that if the application were successful, the sting would be taken out of the opposition to the grant.

(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.*"

The condi-  
tions (see  
p. 203).

In the case of applications for leave to amend patents granted under the Act of 1883, the law officer, on allowing the application, will not impose any conditions except under special circumstances.

In *Allen's Patent* (1887, Griff. L. O. C. 3), application was made to amend a specification dated 1885. The opponents asked that a condition should be imposed that Allen should not bring

(n) *Pietschmann's Patent*, Griff. 1892, 9 P. O. R. 168.  
P. C. 314; *Hearson's Patent*, 1884, (o) *Pietschmann's Patent*, Griff.  
Griff. P. C. 309; *Andrew v. Crossley*, P. C. 314, and see p. 186.

any action or bring any proceedings whatever against them or any of their customers, &c. in respect of any *pipes* which had been sold or contracted to be sold prior to the amendment. Sir E. Clarke, S.-G., having consulted Sir R. Webster, A.-G., gave the following decision: "I have carefully considered the question whether, in allowing this amendment, I ought to impose any condition as to the bringing of actions for infringement prior to the date of the amendment. This appears to be the first case in which that question has come up for decision in respect of patents issued since the passing of the Act of 1883. In several cases which came before the law officer shortly after the passing of this Act I find that they imposed, as a condition of the amendment, that no action should be brought for infringements prior to 1st January, 1884. An examination of these cases, as reported in Griffin's P. C., shows that the reason for their so doing, and in each case (whatever its date) referring back to the 1st January, 1884, was, that they doubted whether sect. 20 would avail to protect persons who were sued for infringements alleged to have been committed prior to the passing of the Act (*p*). No such question arises here. This patent was dated 20th October, 1885, and if after amendment an action is brought for a prior infringement, it is clear that the Court will have to decide whether the matters referred to in sect. 20 have been established to its satisfaction. I do not think that I am entitled to substitute my opinion for that of the Court. Again, I do not think that I could in strictness attach this as a condition to the allowance of this amendment. I could only require an undertaking from the applicant as was required by Sir H. James, A.-G., in the *Westinghouse Case*. If he were to refuse to give such an undertaking, I do not feel myself entitled by that refusal to deprive him of the opportunity of protecting the real invention described in his specification, by a disclaimer of that which I am satisfied he does not mean to claim. I therefore do not think I can properly impose this condition."

(*p*) *Re Hearson*, 1884, 1 P. O. R. Griff. P. C. 303; *Re Westinghouse*, 213; *Re Haddan*, 1885, Griff. L. 1885, Griff. P. C. 315; *Andrew v. O. C.* 12; *Re Cheesebrough*, 1884, *Crossley*, 1892, 9 P. O. R. 168.



In *Ashworth's Patent* (1886, Griff. L. O. C. 6), Sir H. Davey, S.-G., said: "If I saw, or if there was any evidence before me, that the patent had been used for the purpose of endeavouring to obtain a monopoly larger than that which the specification as amended claims, I should consider that a special circumstance. If, for example, the patentees had been threatening persons and endeavouring to prevent persons from making or selling wire hardened and tempered in a mode different from that which is claimed, I should consider that a special circumstance, and under those circumstances, as far as I am personally concerned, I should impose the condition that no action should be brought for anything done at any time before the amendment."

The decision of Sir E. Clarke, in *Allen's Patent*, was followed by Sir E. Carson, S.-G., in *Pitt's Patent* (1901, 18 P. O. R. 480). In this case the House of Lords had given leave to apply to amend on condition that no action should be brought as to infringements committed prior to the filing of the application. The opponents asked the law officer to extend this period until the date of the amendment being allowed. He refused to impose this condition.

As to the nature of the conditions which will be imposed, see p. 203.

**Undertaking  
required.**

The specification is considered to be amended from the moment that leave to amend is given, and the conditions imposed, if any, agreed to (*q*); no written undertaking by the applicant is necessary, although it is the practice in the Patent Office to require some such undertaking as conclusive evidence of the agreement (*r*), since the written assent precludes the patentee from alleging that he did not accept the condition (*s*).

**Costs.**

The power of the law officer to grant costs is expressly conferred by the 38th section of the Act of 1883 (*t*).

In *Re Ashworth's Patent* (1886, Griff. L. O. C. 9), the law officer refused to grant costs to the applicant although successful, on the ground that the specification was so loosely framed it was

(*q*) *Andrew v. Crossley*, 1892, 9 P. O. R. 165.

(*r*) *Ibid.* at p. 168.

(*s*) *Andrew v. Crossley*, 1892, 9 P. O. R. at p. 169; see also *Re Berdan*, 1875, L. R. 20 Eq. 346.

(*t*) See also L. O. R. r. xi.

natural that rival traders should oppose an application for leave to amend.

In *Re Lake's Patent* (1887, Griff. L. O. C. 17), which was an unopposed application for leave to amend, the applicants appealed to the law officer against the decision of the Comptroller-General. Sir R. Webster, A.-G., allowed the appeal on the ground that a doubtful amendment ought to be allowed, but refused to give costs against the Comptroller. "In fact," he said, "I may say that I think it would be better, as a matter of practice, that in the absence of very special circumstances the Comptroller-General should neither give nor receive costs."

In *Re Morgan's Patent* (1886, Griff. L. O. C. 18), which was a successful appeal to the law officer from the decision of the Comptroller-General, application was made for the return of the stamp on the notice of appeal. Sir R. Webster, A.-G., refused this application on the ground that he considered the case to be one in which the Comptroller-General was quite right in declining to allow the amendment in the first instance and to leave it to the law officer.

(5) "*When 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.*"

(6) "*When leave to amend is refused by the Comptroller, the person making the request may appeal from his decision to the law officer.*"

(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.*"

(9) "*Leave to amend shall be conclusive as to the right of the party to make the amendment allowed, except in the case of fraud (u), and the amendment shall in all Courts and for all purposes be deemed to form part of the specification.*"

Amendment  
conclusive.

The result of this enactment is that the amended specification stands in the place of the old specification and its validity must

*Moser v. Marsden.*

(u) *Re Berdan*, 1875, L. R. 20 Eq. 346; 44 L. J. Ch. 544.



be determined in the same way and on the same footing as though it were the original specification.

Until the decision of the House of Lords, in *Moser v. Marsden* (1896, 13 P. O. R. 31), there had been considerable doubt as to the effect of this sub-section, and numerous cases had been decided upon the question of whether, when a specification had been amended so as to include in the amended portion something that was itself invalid, the amendment only or the whole patent would be invalid (x). These cases are no longer of importance, and until further enactment the law on the point is definitely settled.

Lord Watson said: "In my opinion, the very object of the Act of 1883 was to make an amended claim, when admitted by the proper authorities, a complete substitute, to all effects and purposes, for the claim originally lodged by the patentee. The validity of the amended claim must therefore be determined in the same way, and on the same footing, as if it had formed part of the original specification; and the claim as it stood before amendment cannot be competently referred to, except as an aid in the construction of its language after amendment."

It has been decided, however, by the Court of Appeal, in *Hattersley v. Hodgson* (1904, 21 P. O. R. 524), and by Mr. Justice Kekewich, in *The Jandus Arc Lamp Co. v. Arc Lamp Co.* (1905, 22 P. O. R. 290), that the deleted portions may not be looked at for the purpose of construing the remaining words of the specification. (But see *Hattersley v. Hodgson*, in the House of Lords, Dec., 1905, and p. 131, ante.)

It must be noticed that the words of the sub-section expressly exclude cases in which it can be proved that the amendment has been obtained by fraud.

Effect of legal proceedings.

(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."

(x) See the 3rd edition of this book, and *Foxwell v. Bostock*, 1864, 4 De G. J. & S. 298; *Gaulard and Gibbs*, 1890, 7 P. O. R. 387;

*Furbenfabriken v. Bowker*, 1891, 8 P. O. R. 397; *Van Gelder's Patent*, 1889, 6 P. O. R. 22.

In *Cropper v. Smith* (1884, 1 P. O. R. 254; L. R. 28 C. D. 148) (y) the Comptroller having declined leave to amend a specification by reason of the 10th sub-sect. of sect. 18 on the ground that an appeal was pending to the House of Lords from a decision of the Court of Appeal, declaring the patent in question invalid, and that such appeal was "an action for infringement or other legal proceeding," application was made to the Court under sect. 19. Chitty, J., held that the words "other legal proceedings" applied to a petition for revocation, and that the words "action for infringement" referred to an action before judgment, and consequently that the appeal to the House of Lords did not deprive the Comptroller of the power of amending the specification under sect. 18.

In *Brooks v. Lycett's Saddle and Motor Co.* (1904, 21 P. O. R. 654), notice of trial in an action for infringement had been given. An order was obtained for the action to stand over generally, with liberty to either party to restore, in order for a settlement to be arrived at. The negotiations proved abortive, but nothing more was done for two years, when the plaintiffs applied to the Comptroller for leave to amend their specification under sect. 18, which leave was granted. The defendants afterwards applied to restore the infringement action to the list. On the trial of the action it was contended that this amendment was invalid, as the action had been "pending" at the time. Mr. Justice Farwell decided that this was so, and allowed the action to stand over with leave to the defendants to apply, under sect. 19.

In *Codd v. Bratby* (1884, 1 P. O. R. 209), liberty to amend under sect. 19 was given upon terms by the Court after a previous refusal by the Comptroller under sect. 18, but the applicant was ordered to pay the costs of the application to the Comptroller.

Where the application for leave to amend has been made under sect. 18 the subsequent institution of legal proceedings does not suspend the application pending before the Comptroller (z).

Legal proceedings do not affect prior application.

(y) See also *Lawrence v. Perry*, 1885, 2 P. O. R. 188.

(z) *Woolfe v. The Automatic Picture Gallery Co.*, 1903, 20 P. O. R. 182.



Leave granted by Court to apply to amend.

Sect. 19. "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 or 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."

Where more than one action is pending, the leave of the Court must be obtained under this section in each action, otherwise the amendment will not be allowed, and each order must be filed under rule 58 (*infra*) (a).

"The Court," as defined by sect. 117 of the Act, means the High Court of Justice, and so would not include the House of Lords (b). But in the case of *Deeley v. Perkes* (1896, 13 P. O. R. 590) the Court of Appeal had revoked the patent; the House of Lords found a way out of the difficulty and ordered "that the patent be revoked, unless within three months, or such further time as the Court may allow, the patentee obtain leave to amend his specification by disclaiming the first claim" . . . . and further ordered that "if the specification be amended, no action shall be brought for infringement of the patent in respect of any guns or parts of guns made prior to the date of the order." "A judge," of a Court, which, though not a High Court, has jurisdiction to try actions for infringement of a patent, can grant leave under this section; consequently the Vice-Chancellor of the Palatine Court can grant leave under this section while an action is pending within his jurisdiction (c).

Does this exclude jurisdiction of law officer?

In *Allison's Patent* (1900, 17 P. O. R. 516), Sir R. Webster, M.R., said: "I am not at all satisfied that it was intended that, where the Court is seised of the matter as in an action for infringement or a petition for revocation, the Attorney-General should have any—certainly no exclusive—jurisdiction to deal with the question of conditions."

Disclaimer only.

It is to be noticed that while an action is pending the amendments made with the sanction of the Court are limited to dis-

(a) *Codd's Patent*, 1884, Griff. P. C. 305.

(b) *Cropper v. Smith*, 1884, 1 P. O. R. 256.

(c) *Winter v. Baybut*, 1884, 1 P. O. R. 76. See also chapter on "Practice in Action for Infringement."

claimer. This is no mere slip in the wording of the Act, which is strictly applied, and amendment by way of correction or explanation is not allowed (*d*).

Sect. 19 acts as a limitation upon the general words of sub-sect. 10 of sect. 18, and when permission to apply has been granted under sect. 19 the provisions of sub-sect. 10 cease to have effect, and the procedure in such application is governed by the remaining provisions of sect. 18 (*e*).

Sect. 19 gives an absolute discretion to the Court or judge in imposing conditions upon which leave to apply to amend will be granted, and the Court of Appeal "will not interfere with the exercise of that discretion unless they can clearly come to the opinion that in their view that discretion was exercised absolutely wrongly" (*f*).

In *Bray v. Gardner* (1887, 4 F. O. R. 44), Lord Justice Lindley said :

"I do not understand that there is any form of order which is invariably to be followed in all cases when application is made under sect. 19. It appears to me that whenever leave is given to amend under sect. 19 of this Act, care ought to be taken that no injustice is done to the defendant by reason of the amendment, if amendment is made, or if leave to apply for it is granted. Adequate protection may be given to the defendant in various cases in various forms."

The order made in *The Ludington Cigarette Machine Co., Ltd. v. Baron Cigarette Machine Co., Ltd.* (1900, 17 P. O. R. 746), and supported by the House of Lords, has, however, been followed.

In *Corrigal v. Armstrong, Whitworth & Co.* (1903, 20 P. O. R. 524), the order was drawn up as follows: "The plaintiff by his counsel disclaiming any relief in respect of anything done by the defendants prior to the amendment hereinafter ordered, this Court doth order that the plaintiff be at liberty to apply at

(*d*) *Owen's Patent*, 1898, 15 P. O. R. 384; see also *Bray v. Gardner*, 1887, 4 P. O. R. 42; *Lang v. Whitecross Wire and Iron Co.*, 1890, 6 P. O. R. 570, 574; 7 P. O. R. 389, 394; *Ludington Cigarette Machine Co. v. Baron Cigarette Machine Co.*, 1900, 17 P. O. R. 747.

(*e*) *In re Hall*, 1888, 5 P. O. R. 310; *Lang v. The Whitecross Co.*, 1890, 7 P. O. R. 392.

(*f*) Per Lord Esher, M.R., in *Allen v. Douulton*, 1887, 4 P. O. R. 1900, 17 P. O. R. 747.

Conditions imposed depend on circumstances.

Frequent order.



the Patent Office for leave to amend the Specification No. of by way of disclaimer, and after such disclaimer to amend the statement of claim and the particulars of breaches within fourteen days. And it is ordered that the defendants do have liberty, if so advised, to put in an amended defence and particulars of objections within fourteen days from the delivery of the amended statement of claim. And it is ordered that the costs of this application, and the costs of and occasioned by the said amendment be the defendants' costs in any event. And it is ordered, that all further proceedings in this action be stayed until the amendment of the plaintiff's specification is allowed or until further order."

In *Chatwood's Patent* (1899, 16 P. O. R. 373), the Court followed the order made in *The Haslam Foundry Co. v. Goodfellow* (1888, L. R. 37 C. D. 118; 5 P. O. R. 28). In that case the pleadings had been delivered, and nothing remained to be done but to prepare the evidence for trial, when the plaintiffs asked for leave to apply to amend. The application was granted on the following terms:—"The plaintiffs to pay, in any event, the costs of the application, and the costs of the action up to and occasioned by the disclaimer, except only so far as the proceedings in the action might be utilised for the purpose of the trial. The plaintiffs and defendants to be allowed to make the necessary amendments in the pleadings after disclaimer. The plaintiffs to undertake forthwith to amend their pleadings in accordance with the amendment, or to consent to the action being dismissed with costs."

In *Armstrong's Patent* (1896, 13 P. O. R. 507), leave to apply to amend was refused on the ground that there would be nothing left to support a patent after the proposed amendment should have been made. The Court of Appeal (1897, 14 P. O. R. 753) refused to interfere with the judge's discretion, and, moreover, agreed with his view of the matter.

Liberty to apply under this section will not be given after judgment (g), since the patentee is then free to act under sect. 18.

No leave  
after  
judgment.

(g) *Lawrence v. Perry*, 1885, Griff. P. C. at p. 148; but see *Deeley v. Perkes*, p. 202, ante, and p. 260, post, on liberty to apply to amend in Petitions for Revocation.

Sect. 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."

No damages  
prior to  
amendment.

Under the Statute of Will. IV., no disclaimer or amendment could be given in evidence in any action or suit (save and except in any proceeding by *scire facias*) pending at the time the disclaimer or amendment was enrolled. The object of this was obvious. It would have been unjust that a defendant should be held guilty of infringing a patent when at the time the action was brought against him the patent was void. The saving clause relating to *scire facias* was always exercised subject to just provision as to costs, and was inserted with a view to prevent a patent being repealed on account of some trifling error which might have been cured by disclaimer or alteration. The entry of a disclaimer under the old Act did not make a void patent valid *ab initio*, "so as to make any person a wrongdoer by relation," and in *Perry v. Skinner* (Hindmarch, 207) it was held, that the words "from thenceforth" must be read into the specification. Proceedings by *scire facias* are abolished by sect. 26 of the Act of 1883, and a petition to the Court is substituted, the grounds for the petition being the same as heretofore in *scire facias*. Although we have seen that sub-sect. 10 of sect. 18 prohibits any amendment under that section pending legal proceedings (including proceedings by way of revocation), sect. 19 provides machinery for saving a patent in the event of the Court or judge being of opinion that a disclaimer should be allowed upon such terms as may appear just. It will be observed that the Court or judge have no power to permit amendment by "correction or explanation" under this section.

Sects. 19 and 20 must be read together (*h*), and if an application under sect. 18 or 19 is granted without the imposition of terms, the amendment on being made will be retrospective only

(*h*) *Lang v. Whitecross*, 1890, 7 P. O. R. 391.



if the patentee can show that his original claim was framed in good faith and with reasonable skill and knowledge (i).

Only case where damages granted.

In *Hopkinson v. St. James and Pall Mall Electric Light Co.* (1893, 10 P. O. R. 62), judgment was given for plaintiff with the usual relief, the defendants referred to sect. 20, and asked that the account of profits should be kept only from the date of the amended specification; Romer, J., refused the application, and said that "he thought it was clear from the evidence which was before him, that the plaintiff's original claim was framed in good faith and with reasonable skill and knowledge."

This case, however, is the only one in which the relief contemplated by the Act has been given, and it is seldom asked for.

In *Lane and Pattison v. Boyle* (1901, 18 P. O. R. 338), Byrne, J., said: "I think that what the patentee has to establish is that in his original specification he meant and intended to claim that which he had invented and no more. . . . If the inventor has knowingly sought to include a field of subject matter beyond that which he knows he has invented, I think he cannot be regarded as having framed his claim in good faith within the meaning of this particular section, and I am of opinion, in the present case, that he meant and intended that which his original specification says, namely, to make a larger claim than that which he knew he was entitled to; and secondly, I think he has failed to establish, to my satisfaction, that his original claim was framed in good faith and with reasonable skill and knowledge within the meaning of that expression in the section. I believe that the power given by this section of the Act to award further damages has been exercised in one case only in the immense number of cases in which, since the passing of this section, amendments must have been allowed and actions have been brought upon the amended patents."

Summary of sects. 18—20.

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* (1888, 5 P. O. R. 312): "Sect. 18 gives power to a patentee, when he finds out the blunder in the specification himself, to seek leave

(i) *Wenham v. Carpenter*, 1888, 5 P. O. R. 68; see also *Lucas' Patent*, 1854, Macr. P. C. 235.

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

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

Advertise-  
ment of  
amendment.

P. R. 1903, r. 50, 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.



## CHAPTER XI.

## DEVOLUTION, ASSIGNMENT AND LICENSES.

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.

Devolution  
on death.

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). If one of two co-patentees dies intestate, his interest passes to the survivor, unless their relations have been modified by contract.

Some letters patent of the Crown (not for inventions) have a limitation to heirs or heirs male; such, for instance, as patents of nobility.

On bank-  
ruptcy.

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,

(a) See *Re Edmund's Patent*, 1886, B. & P. 565; see also *Bloxam v. Griff*, P. C. 282. *Elsec*, 9 D. & R. 215; *McAlpine v.*

(b) *Hesse v. Stevenson*, 1803, 3 *Mangnall*, 1846, 15 L. J. C. P. 298.

seems to have thought that it did (c). This, however, can hardly be quoted as an authority. The persons in whom the patent 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).

Letters patent may be seized by the sheriff under a writ of *fi. fa.*, and he may assign them (e).

Patent rights may be transferred by absolute assignment of *Inter vivos*. 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 licenses.

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.

An assignment must be by deed to convey the legal estate (f), but a parol agreement to assign will be specifically enforceable in equity. An agreement to assign will depend upon the ordinary rules relating to contract as to specific performance, and consideration, etc. It does not alter the proprietorship of a patent, but it gives the right in equity to have the proprietorship altered in law (g); and this is so even when the patent was not at the date of the contract actually taken out by the vendor, provided, at least, that he was then entitled to make an application for the same (h). The usual conditions of an equitable assignment will apply, and a legal assignee without notice may claim priority (i).

Agreement  
to assign.

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

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

(e) *Coleman v. Rawlinson*, 1 F. & F. 330; *Harley v. Harley*, 11 Ir. Ch. Rep. 451.

(f) Co. Lit. 9 b, 172 a; *Stewart v. Casey*, 1892, L. R. 1 Ch. 113; 9

P. O. R. 9.

(g) Bowen, L.J., in *Stewart v. Casey*, 1892, L. R. 1 Ch. 116.

(h) *Cogent v. Gibson*, 33 Beav. 557.

(i) E.g. as in *Wapshare Tube Co., Ltd. v. Hyde Imperial Rubber Co.*, 1901, 18 P. O. R. 377.



The assignment of patent rights to a company is usually preceded by an agreement between the patentee and the promoters, by which the latter agree to procure incorporation of the future company and the execution by the company of a scheduled form of contract with the patentee, by which the patentee shall agree to assign the letters patent to the company. The assignment of the patent to the company usually takes place after the payment of the purchase price.

Where the patent has not been granted at the date of the agreement to assign, a clause is inserted by which the vendor agrees to take all necessary steps to obtain it.

Future inventions of like nature.

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. And a covenant by the vendor not to make or sell the invention at all, nor the product obtained by the invented process, even though obtained in a different manner, is good. As Jessel, M.R., said in *Printing and Numerical Registering Co. v. Sampson* (1875, L. R. 19 Eq. 464) the purchasers are entitled to say: "We cannot buy on any other terms because otherwise we are exposed to the instantaneous, or almost instantaneous, competition with the inventor with the benefit of his previous experience." As in all contracts which involve the restraint of trade, their validity depends upon whether they extend further than is necessary to protect the reasonable rights of the other party under the particular circumstances in question.

Assignment.

An assignment must be by deed. The assignee then becomes "the patentee" within the definition of the Act, and his rights against the public, including the assignor unless specially limited by the terms of the assignment, are the same as those which the assignor had, and the latter may be restrained from infringing.

An assignee with notice of previous licenses takes subject to those licenses, otherwise he is not bound by them, and may restrain the persons purporting to manufacture under them.

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 (*k*); 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 (*l*).

Unless it be specially so provided the assignment does not *per se* cast on the assignor the obligation of maintaining the patent by paying the fees (*m*). By sect. 36 of the Act of 1883, "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." An assignment for a district is more advantageous than a license since an assignee, but not a licensee, may sue for infringement.

There may be an assignment of a distinct part of a patent, but now that patents are not issued for more than one invention this form is seldom required. An assignee of a part is entitled to sue for an infringement without joining the persons who are interested in the remaining part or parts (*n*). Assignment of part of patent.

A mortgagee, although an assignee, is not entitled to sue infringers. This right remains vested in the mortgagor as the "patentee." (*Van Gelder Apsimon & Co. v. The Sowerby Bridge Co.*, 1890, 7 P. O. R. 211.) Mortgages usually contain absolute recitals and covenants for validity (*o*). Mortgage.

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* (1893, 10 P. O. R. 251), Lord Herschell, in delivering the judgment of the House of Lords, said: "Letters patent do not give the patentee any right to use the invention; they do not confer a right to manufacture Co-owners.

(*k*) *Werdermann v. Société Générale d'Electricité*, 1881, L. R. 19 C. D. 246; *Appliance Co.*, 188, L. R. 38 C. D. 602.

*Co. v. Clipper Pneumatic Tyre Co.*, 1901, 1 Ch. 157. (*n*) *Dunncliffe v. Mallett*, 1859, 7 C. B. N. S. 209; 29 L. J. C. P. 70.

(*l*) *Hassall v. Wright*, 1866, L. R. 10 Eq. 509. (*o*) *Morris' Patents Conveyancing*, p. 128.

(*m*) *Re Railway and Electrical*



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."

The rights of co-owners *inter se* are summed up by Lindley, L.J., in his book on Partnerships (*p*): "In the case of a patent belonging to several persons in common, each co-owner can assign his share, and sue for an infringement (*q*); and can also work the patent himself, and give licenses to work it, and sue for royalties payable to him for its use (*r*); 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 licenses" (*s*).

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* (1861, 30 L. J. Ch. 496). 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

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

(*q*) *Dunncliffe v. Mallett*, 1859, 7 C. B. N. S. 209; *Dent v. Turpin*, 1861, 2 J. & H. 139; 30 L. J. Ch. 495; *Sheehan v. Great Eastern Railway*, 1881, L. R. 16 Ch. D. 59, 63.

(*r*) *Sheehan v. Great Eastern Railway*, 1881, L. R. 16 Ch. D. 59.

(*s*) *Mathers v. Green*, 1865, L. R. 1 Ch. 29; *Russell's Patent*, 1857, 2 De G. & J. 130.

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.* (1853, 8 El. & B. 74), 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 (*t*), but this would not be the case if it were a term of the partnership that the patent rights in the invention should belong exclusively to one of them (*u*). Partnership

Where a grant is made to more than one person it is usual to divide the interests, as the power which each grantee has to work the invention himself without accounting is highly inconvenient. Provision may thus be made for accounts, granting licenses, survivorship, and many other matters.

A patent may be vested in trustees, who may sue for infringement in their own names, subject to the power of the Court to order the *cestuis que trust* to be joined (*x*). Trustees.

#### 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 (*y*), 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* (1884, L. R. 26 Ch. D. 700), letters patent for improvements in lace machines were granted Estoppel.

(*t*) *Kenny's Patent Button-Holeing Co. v. Somervell*, 1878, 38 L. T. 878; 26 W. R. 786.

(*u*) *Axmann v. Lund*, 1874, L. R. 18 Eq. 336.

(*x*) R. S. C. O. 16, r. 8.

(*y*) *Bowman v. Taylor*, 1834, 2 A. & E. 278; and see this and many other cases mentioned in 1 Web. P. C. 290—295.



to H. in 1873, 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 (z), 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 not open to the assignee to challenge the validity of the patent (a).

**Warranty of validity.**

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 (b), and the question to be decided in each case is: "Did the defendants buy a good and indefeasible patent right, or was the contract merely to place the defendants in the same situation as the plaintiff was in, with reference to the alleged patent?" (c).

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 (d).

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

(a) *Smith v. Buckingham*, 1870, 21 L. T. 819; 18 W. R. 314; *Liardet v. Hammond Electric Light Co.*, 1883, 31 W. R. 710; *Hall v. Conder*, 1857, 26 L. J. C. P. 138; 3 Jur. N. S. 366; 2 C. B. N. S. 22.

(b) *Hall v. Conder*, 1857, 26 L. J.

C. P. 142; *Smith v. Buckingham*, 1870, 21 L. T. N. S. 819; *Smith v. Neale*, 1857, 26 L. J. C. P. 148 (and see pp. 220, 221, post).

(c) Per Creswell, J., in *Hall v. Conder*, 1857, 26 L. J. C. P. 143.

(d) *Chanter v. Leese*, 1838, 5 M. & W. 698; *Hall v. Conder*, 1857, 26 L. J. C. P. 143.

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. An express covenant for the validity of the patent will, of course, remove the estoppel, and the assignee may rely on this in answer to an action for the purchase-money (*e*).

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 (*f*). 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 (*g*). 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 (*h*).

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 (*i*). And he is at liberty to show that the ambit of the claims of the patent assigned is not as wide as the assignee alleges (*k*).

Assignor  
may give  
evidence  
and limit  
ambit of  
claims.

## LICENSES.

Licenses differ from assignments, in that the patentee granting a license 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 license could not be done except by violating the monopoly granted to and still vested in the licensor (*l*).

Licenses.

(*e*) *Nadel v. Martin*, 1903, 20 P. O. R. 735.

(*f*) *Chambers v. Critchley*, 1864, 33 Beav. 374.

(*g*) *Armann v. Lund*, 1874, L. R. 18 Eq. 330; 22 W. R. 789.

(*h*) *Heugh v. Chamberlain*, 1877, 25 W. R. 742.

(*i*) *London and Leicester Hosiery Co. v. Griswold*, 1886, 3 P. O. R.

251.

(*k*) *Hocking v. Hocking*, 1889, 6 P. O. R. 75.

(*l*) *Heap v. Hartley*, 1889, 6 P. O. R. 499.



Licenses may be voluntarily granted by the patentee, or they may be compulsory under an order of the Board of Trade. In this chapter we shall deal with voluntary licenses only.

Form  
immaterial.

It would appear from the words of the prohibition contained in the grant—"without the consent, license or agreement of the said patentee in writing under his hand and seal"—that licenses should be under seal; but at the end of the patent occur the words, "but nothing herein contained shall prevent the granting of licenses in such manner and for such consideration as they may by law be granted." Therefore, provided it can be proved that there is an agreement to grant a license, no matter how made, it will be acted upon, and neither party can be excused on the ground that it is not under seal (*m*). A mere license in writing does not require a stamp, but if it amounts to an agreement to pay by royalties or otherwise a stamp is required (*n*). A license by deed requires a ten shilling stamp and an *ad valorem* stamp on the consideration money, or the minimum royalty prescribed.

Stamps.

By the prohibition the public are to refrain from making, using or vending. A license to make does not imply a license to use or vend (*o*). But a license to make and vend will imply a license to the purchaser to use and vend (*p*). And an inventor selling the patented article abroad cannot restrain its importation and sale in this country (*q*), 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 (*r*). And if the assignment of the English patent were executed at a date later than the importation of articles sold abroad under the patentee's foreign patent, the assignee could not restrain their

(*m*) *Chanter v. Dewhurst*, 1844, 12 M. & W. 323; 13 L. J. Ex. 198; *Chanter v. Johnson*, 1845, 14 M. & W. 408; *Postcard Automatic Supply Co. v. Samuel*, 1889, 6 P. O. R. 560; *Tweeddale v. Howard*, 1896, 13 P. O. R. 531.

(*n*) *Wilson v. Union Oil Mills*, 1892, 9 P. O. R. 62.

(*o*) *Basset v. Graydon*, 1897, 14

P. O. R. 701.

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

(*q*) *Betts v. Wilmott*, 1870, L. R. 6 Ch. 239.

(*r*) *Société Anonyme des Manufactures de Glaces v. Tilghmann's Patent Sand Blast Co.*, 1883, L. R. 25 C. D. 9.

continued use, since the sale by the patentee would imply a license to use and sell as wide as his own right at the date of the sale.

LICENSES MAY BE EXCLUSIVE, GENERAL, OR LIMITED.

An exclusive license grants the sole right to put the invention into practice, and the licensor covenants not to grant licenses to any other person during the continuation of the license; and unless he reserves to himself a right to manufacture he may be restrained from doing so by his licensee. **Exclusive license.**

A general license leaves to the licensor the power to grant other licenses in respect of the same invention. **General.**

A limited license may contain restrictions as to time, place, or manner of use of the invention. **Limited.**

In the cases of *Incandescent Gas Light Co. v. Cantelo* (1895, 12 P. O. R. 262) and *The Same v. Brogden* (1899, 16 P. O. R. 179), the license to use the plaintiffs' invention was limited to its use in conjunction with another article manufactured by the plaintiffs. Inasmuch, however, as the sale of an article gives a presumptive right to use it in any manner, there must be distinct notice to the licensee or purchaser of the limitation, either as to the area or the manner. (*Heap v. Hartley*, 1889, 6 P. O. R. 499, and the two cases above.)

A licensee cannot sue infringers (*s*); the person in whom the legal interest in the patent is vested must be joined, and it is usual to insert covenants by which the licensor agrees to proceed against infringers or to allow his name to be joined. An exclusive licensee, however, may sue in the name of the licensor. (See Chapter XVI.) **Licensee no power to sue.**

Whether a licensee may sub-license depends upon the terms of the contract, but in the absence of such terms it would appear to be personal only (*t*). Should the patentee accept royalties from the person acting with the authority of the licensee, he will be estopped from denying that the license was assignable (*u*). **Sub-licenses.**

It is not an implied term of a license that the patentee will

(*s*) *Heap v. Hartley*, 1889, 6 P. O. R. 500.

(*t*) *Lawson v. Donald Macpherson & Co.*, 1897, 14 P. O. R. 697.

(*u*) *Ibid.*



**Covenant to maintain patent.**

maintain the patent in force by paying the fees; express covenants should be entered into on this point (*x*).

**Revocation.**

Licenses usually contain clauses which empower either party to revoke the arrangement after due notice; but, apart from such a clause, the question of the power of revocation by the licensor gives rise to some difficulty. It is quite clear that a mere license without a contract may be revoked at will. It is clear also that revocation of a license granted as the consideration in a contract will give a right to an action for damages for breach of that contract. But will the licensee be restrained from manufacturing after the revocation? It would appear from the judgment of Lindley, L.J., in *Guyot v. Thompson* (1894, 11 P. O. R. 552), that the general intention of the parties must be looked to, and that where there are mutual obligations to be fulfilled, or, in other words, where the granting of the license is part of a contract, that the licensor may not revoke. Moreover, it is to be noticed that an agreement to grant a license for a fixed term may be specifically enforced (*y*), but an agreement to grant a license at will could not be enforced.

**Agreement to grant license.**

**Estoppel.**

Unless the licensor has covenanted for the validity of the patent in express terms, the licensee will be estopped from alleging its invalidity in answer to an action for royalties, even though the patent has been declared void in other proceedings. (See p. 214, *supra*.)

In *Bozman v. Taylor and others* (1834, 2 A. & E. 278; 1 Web. P. C. 292), the plaintiff sued the defendants for the non-payment of certain royalties due from the defendants to the plaintiff under a license 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.

(*x*) *Mills v. Carson*, 1893, 10 P. O. R. 15.

(*y*) *E.g.*, as in *Brake v. Radermacher*, 1903, 20 P. O. R. 631.

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 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* (3 T. R. 438), 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.

In the case of *Lawes v. Purser* (1856, 6 E. & B. 930), the license was not under seal, and the licensee was held to be estopped from alleging the invalidity of the patent.

In *Adie v. Clark* (L. R. 3 C. D. 144), 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 (L. R. 2 A. C. 423). But it appears that if the license 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 license.

In *Redges v. Mulliner* (1893, 10 P. O. R. 26), following *Crossley v. Dixon* (1863, 10 H. L. C. 310), Collins, J., said: "It is, of course, elementary knowledge that a licensor can



revoke a license; and if the right be only a license, it is revocable when he chooses. But the difficulty is that when he does not choose, and when he says that license is continuing and says to the person whom he has licensed, 'Now pay me that which you would have been bound to pay if you did this thing under my license,' it seems a strong thing that the other party should be able to say, 'No, it is true you are willing that the license shall continue so far as in you lay; you permitted what I did; but I did it not by virtue of your permission, because I repudiated your permission, and therefore I will not pay you that which I would have paid you had I done it under your license.'” But in this case the license was for no specified term, the royalties having to be paid on each article as completed.

Even where  
patent held  
invalid.

Where, however, the license was for a specified term of four years, and the patent was revoked within that period, the licensees were nevertheless held liable for royalties on the patented process during the remainder of the term of the license. (*The African Gold Recovery Co. v. The Sheba Gold Mining Co.*, 1897, 14 P. O. R. 663.)

In *Cheetham v. Nuthall* (1893, 10 P. O. R. 321), it was provided that the license should determine if the patent should be 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 license, and it was held that he was still liable to pay royalties for the use of the invention.

The following cases have been decided uniformly, and show that parties to a deed of assignment or license 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* (z), *Smith v. Scott* (a), *Walton v. Lavater* (b), *Norton v. Brooks* (c), *Crossley v. Dixon* (d), and see p. 214.

(z) 1848, 11 Q. B. 973.

(a) 1859, 6 C. B. N. S. 771, and  
28 L. J. C. P. 325.

(b) 1860, 8 C. B. N. S. 162.

(c) 1861, 7 H. & N. 499.

(d) 1863, 10 H. L. Cas. 293.

If a patentee in granting a license 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 (e). Warranty of validity.

*Mills v. Carson* 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 license 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 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.

But where the defendant took a license 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 (f).

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 Licensee may limit interpretation of claim.

(e) *Wilson v. Union Oil Mills Co.*, 1892, 9 P. O. R. 57; *Mills v. Carson*, 1893, 10 P. O. R. 17.      (f) *Wilson v. Union Oil Mills Co.*, 1892, 9 P. O. R. 57.



ambit of the specification (*g*), and he may, following the analogy of lessor and lessee, show that the patent in question has in fact expired (*h*).

Fraud prevents estoppel.

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 (*i*); beyond that the only reply that is left to the licensee is that he has not worked the patent in question (*k*).

Where the plaintiff, fraudulently asserting that he had a right to a patent, induced the defendant to come to terms with him for a license 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 (*l*). But it would be 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 (*m*).

An assignee of a share of the profits is entitled to an account of the profits 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.

The licensee is not bound to account to the assignor and to each assignee of a share separately (*n*). As to licenses and assignments to a Government department, see p. 15.

#### THE REGISTER.

Sect. 23 of the Act of 1883 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*

(*g*) *Young v. Hermand*, 1892, 9 P. O. R. 373; see also *Crosthwaite v. Steel*, 1889, 6 P. O. R. 190; *Neil and Others v. Neil*, 1903, 20 P. O. R. 223; *Davies v. Curtis and Harvey*, 1903, 20 P. O. R. 561.

(*h*) *Muirhead v. Commercial Cable Co.*, 1894, 11 P. O. R. 317; 12 P. O. R. 39.

(*i*) *McDougall v. Partington*, 1890,

7 P. O. R. 223; *Ashworth v. Law*, 1890, 7 P. O. R. 234.

(*k*) *Clark v. Adie*, L. R. 2 App. Cas. 423, 435.

(*l*) *Hayne v. Maltby*, 3 T. R. 438; *Chanter v. Leese*, 4 M. & W. 295.

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

(*n*) *Bergmann v. Macmillan*, 1881, L. R. 17 Ch. D. 423.

*of grantees of patents, notifications of assignments and of transmissions of patents, of licenses 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, licenses and any other documents affecting the proprietorship in any letters patent or in any license thereunder, must be supplied to the Comptroller in the prescribed manner for filing in the Patent Office."*

The practice of the Patent Office with regard to registration is regulated by Rules 51 to 65 of 1903.

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.*" Equities may be enforced.

Lindley, M.R., in *New Irion Tyre Co. v. Spilsbury* (1898, 15 P. O. R. 571), said, referring to this proviso: "That lets in the whole doctrine of notice and the equitable consequences of it. That proviso cannot be cut down. When it says, 'any equities in respect of such patent,' it cannot mean registered equities. You do not want a proviso for that, because you have got that before. It means that any equitable rights in any person in respect of such patent may be enforced in like manner as in respect of any other personal property. What are they? Those rights are that they can be enforced in equity against all persons who have taken with notice."

Sect. 88, as amended by sect. 22 of the Patents, &c. Act, 1888, deals with the inspection of registers, and the 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 Effect as



regards  
trusts.

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 (o); 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 sect. 23 (p), 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 (q).

Amendment  
of register.

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 (r).

Sect. 25 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 licenses and privileges thereby given or granted."

It will be observed that the Act of 1883, quoted above, materially differs from this enactment. Hence *Chollett v. Hoffman* (s), and *Hassall v. Wright* (t), will not now apply.

(o) *Stewart v. Casey*, 1892, 9 P. O. R. 9, 11, 15.

(p) *Ibid.*, p. 15; see also *In re Fletcher's Patent*, 1893, 10 P. O. R. 252.

(q) *In re Fletcher's Patent*, 1893, 10 P. O. R. 252, 255; *Haslett v.*

*Hutchinson*, 1891, 8 P. O. R. 457, 466.

(r) *In re Parnell's Patent*, 1888, 5 P. O. R. 126.

(s) 1857, 7 Ell. & B. 686.

(t) 1870, L. R. 10 Eq. 509; 40 L. J. Ch. 145.

The High Court of Justice exercised jurisdiction to alter and amend the register of patents prior to the Act of 1883 (*u*).

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 license 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 license referred to in B.'s assignment was the deed of assignment to A. subsequently entered (*x*).

The procedure is by motion in the Chancery Division. **Procedure.** Notice should be given to the Comptroller, and to any other person who may be affected.

Registration does not amount to notice to the whole world, so **Notice.** where the grant of an exclusive license 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 (*y*).

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 (*z*).

(*u*) *In re Morgan's Patent*, 1876, 24 W. R. 245.

(*x*) *In re Mosey's Patent*, 25 Beav. 581.

(*y*) *Heap v. Hartley*, 1888, 5 P. O. R. 603; 6 P. O. R. 495.

(*z*) *In re Horsley & Knighton's Patent*, 1869, L. R. 8 Eq. 475.



## CHAPTER XII.

## EXTENSION OF TERM OF PATENT.

The statute. 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 Privy Council have no power to extend the time for lodging the petition (a).

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

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

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

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

(a) *In re Adams' Patent*, 1899, 16 P. O. R. 1.

It is the practice to grant a new patent in place of the one about to expire.

(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.*"

The practice under this enactment is regulated by the Privy Council Rules, 1897.

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 the Privy Council and obtaining an extension.

History of  
the law.

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* (1843, 1 W. P. C. 733), Lord Brougham 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 Parlia-



ment 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."

Attitude of  
the tribunal.

The true construction is, however, not so severe as that, although still sufficiently severe. In *Re Morgan's Patent* (1843, 1 W. P. C. 739), Lord Brougham said: "It is by no means their (the Privy Council's) 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.

Matters con-  
sidered on  
petition.

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* (1835, 1 W. P. C. 559), 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* (supra) 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 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 with the

grounds of extension as given by Lord Brougham in *Re Derosne's Patent* (1844, 2 W. P. C. 1): "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 (b), and this even though the Crown through the Attorney-General consents (c).

Grounds  
must be  
strictly  
proved.

The utmost good faith is required to be observed in framing the petition for prolongation. In addition to setting forth the accounts, the nature of which we shall consider later, the petition should state the whole history of the case and everything bearing on the matter (d).

"Uberrima  
fides"  
required.

The conduct of the petitioner in placing the invention before the public is one of the circumstances which will be considered; and so where false statements were made as to profits in the prospectus of a company floated for the purpose of manufacturing under the patent, this was a ground for refusing prolongation (e).

"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 deserving manner, and yet have produced an improvement of the most trifling nature—the merit of the person in this case will not be considered.

Merit of the  
invention.

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

(b) *In re Perkin's Patent*, 1845, 2 W. P. C. 6; *Horsey's Patent*, 1884, 1 P. O. R. 226; *Stundfield's Patent*, 1898, 15 P. O. R. 17; *Ferranti's Patent*, 1901, 18 P. O. R. 518.

(c) *In re Cardwell's Patent*, 1856, 10 Moo. P. C. C. 488.

(e) *Lawrence's Patent*, 1892, 9

(d) *Clark's Patent*, 1870, L. R. 3 P. O. R. 89.



one of merit—simplicity of an invention being an element of its value (*f*).

In *Bailey's Patent* (1884, 1 P. O. R. 3), 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."

Must be more than sufficient to support patent.

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 (*g*).

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.

But otherwise novelty and utility not examined.

In *Re Saxby's Patent* (1870, L. R. 3 P. C. 294), Lord Cairns said: "In point of fact, it is not the practice of this tribunal to decide upon the novelty or utility of a patent; and although they would, of course, abstain in any case from prolonging a patent which was manifestly bad, yet, in one point of view, they are in the habit, in taking into account that which may be termed the question of utility, to consider not that amount of utility which would be necessary to support a patent, but that kind of utility which might more properly be described as merit. Upon that question it is the habit of this tribunal to consider whether the invention brought before them is one of that high degree of merit which, if everything else were satisfactory, would entitle the patentee to a prolongation."

In *Re Stewart's Patent* (1886, 3 P. O. R. 10), Lord Monkswell said: "Their lordships do not propose to determine the

(*f*) *In re Muntz's Patent*, 1846, 2 Web. P. C. 113.

*Stoney's Patent*, 1888, 5 P. O. R. 520; see also *Saxby's Patent*, 1870,

(*g*) Per Sir W. Grove, *In re* L. R. 3 P. C. 292, 294.

validity or invalidity of the patent on this occasion; but they are satisfied that the invention, whether or not it may have sufficient novelty to sustain the patent, upon which they give no opinion, has been so far anticipated by previous patents and by actual user of machines in this country as to deprive the invention of that degree of novelty which would be necessary in order to justify their lordships in advising her Majesty to prolong its term" (h).

Nor will the validity of the patent be inquired into, except- Nor validity.  
ing in cases where it is obvious the patent is invalid. In *Re Hill's Patent* (1863, 1 Moo. P. C. N. S. 258; 9 L. T. N. S. 101), 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."

In *Re Lane Fox's Patent* (1892, 9 P. O. R. 412), 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 (i).

(h) And see *In re Stoney's Patent*, 1888, 5 P. O. R. 522.

(i) See also *In re Kay's Patent*, 1839, 1 Web. P. C. 568; 3 Moo. P. C. C. 24.



In *Burlingham's Patent* (1898, 15 P. O. R. 195), counsel admitted at the hearing that one of the claims in the patent was invalid; the Committee did not decide upon the effect of this admission and dismissed the petition upon other grounds.

And the Committee will not hear an objection to the validity of the patent on the ground of non-payment of fees (*k*).

Non-user gives presumption against merit; unless explained.

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 (*l*). But the same objection being raised in *Re Hughes' Patent* (1879, L. R. 4 A. C. 174), the application was granted after strong and unanswered evidence of merit, though the patent had not been used in England during the whole term (*m*).

In *Re Semet and Solvay's Patent* (1895, 12 P. O. R. 16), the invention consisted in an improved apparatus for coking and distilling coal. For some time it was found impossible to obtain any practical introduction of the invention into the country, partly by reason of expense and partly owing to the prejudices of the manufacturers. Lord Watson said: "The invention appears to their lordships to be one which from its very nature cannot reasonably be expected to come at once, or within a short period, into general use. Its adoption necessitates the destruction of existing and the erection of new apparatus, and will therefore, in all probability, be gradual, as the old-fashioned apparatus wears out." The prolongation was granted (*n*).

In *Re Pieper's Patent* (1895, 12 P. O. R. 295), the invention consisted in an improved expansion gear for steam engines. Prolongation was refused on several grounds, one being that no steps were taken to push the invention for two and a-half years after the date of the patent. Lord Watson, dealing with this

(*k*) *Dolbear's Patent*, 1896, 13 P. O. R. 205.

(*l*) *In re Allan's Patent*, 1867, L. R. 1 P. C. 507; 4 Moo. P. C. N. S. 443; *Dolbear's Patent*, 1896, 13 P. O. R. 203; *Henderson's Patent*, 1901, 18 P. O. R. 453.

(*m*) See also *In re Wright's Patent*, 1839, 1 Web. P. C. 575; *In re Herbert's Patent*, 1867, L. R. 1 P. C. 399; 4 Moo. P. C. N. S. 300; *Southby's Patent*, 1891, 8 P. O. R. 433.

(*n*) And see *Thompson's Patent*, 1902, 19 P. O. R. 568.

as a reason for the refusal, said: "Looking at the progressive amounts obtained from year to year under the English patent, it is by no means clear that if due activity had been shown in making the invention known to persons who were likely to use it in this country, there might not have been, during the last year or two's currency, a sum which, added to those which have actually been obtained, might have amounted to adequate remuneration."

In *Re Roper's Patent* (1887, 4 P. O. R. 201), an extension was granted although the invention had not been pushed during a period of eight years, the reason for the delay being the serious ill-health of the patentee produced by a railway accident. And in *Downton's Patent* (1839, 1 Web. P. C. 566), an extension was granted where the patentee had been prevented by lack of means and hostility of the trade from pushing the invention on the market.

In *Re Betts' Patent* (7 L. T. N. S. 577), 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" (o).

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 (p). Meritorious part may be prolonged.

The mere fact that the invention has been considerably improved upon since it was patented is not a reason for refusing prolongation (q). Effect of improvements.

(o) See also *In re Hill's Patent*, 1863, 1 Moo. P. C. N. S. 258, at p. 265. *Patent*, 1886, 3 P. O. R. 95; *Joy's Patent*, 1893, 10 P. O. R. 89.

(p) *Bodmer's Patent*, 1849, 8 Moo. P. C. C. 282; *Lee's Patent*, 1856, 10 Moo. P. C. C. 226; *Church's Patent*, 1843, 1 Web. P. C. 727; *Soame's Patent*, 1843, 1 Web. P. C. 735.



But where a patent had been taken out for the subsequent improvements, and remuneration had been derived therefrom, this was held to be a reason amongst others for refusing a prolongation (*r*). If, however, the invention in its original form was useless, it would be a ground for refusal.

Who may  
petition.

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 (*s*). So might the assignee of a patent, even though a public company (*t*). So might the executor of an assignee (*u*); so also any person having merely an equitable interest in the patent (*x*); an unpaid mortgagee should be joined as a party (*y*).

Merit of  
petitioner  
considered.

The Privy Council, in addition to considering the merits of the invention, consider those of the petitioner who is not necessarily the true and first inventor.

"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" (*z*).

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 (*a*).

Assignees.

Extension of the term will be granted to assignees, as they

(*r*) *Nussey and Leachman's Patent*, 1890, 7 P. O. R. 22.

(*s*) *In re Heath's Patent*, 1853, 8 Moo. P. C. C. 217; 2 Web. P. C. 247.

(*t*) *In re Norton's Patent*, 1863, 1 Moo. P. C. N. S. 339.

(*u*) *In re Bodmer's Patent*, 1849, 6 Moo. P. C. C. 469.

(*x*) *In re Noble's Patent*, 1850, 7 Moo. P. C. C. 191.

(*y*) *In re Church's Patent*, 1886, 3 P. O. R. 95.

(*z*) Per Lord Brougham, *In re Soame's Patent*, 1843, 1 Web. P. C. 729.

(*a*) *Berry's Patent*, 1850, 7 Moo. P. C. C. 187.

have, so to speak, purchased the merit of the original inventor, but the argument against importers will apply with equal force against assignees (b).

In *Herbert's Patent* (1867, L. R. 1 P. C. 399), 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 representative 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 widow of the patentee.

In *Whitehouse's Patent* (1838, 1 Web. P. C. 473) (c), 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.

In *Re Norton's Patent* (1863, 1 Moo. P. C. N. S. 339), 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 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" (d).

And in *Re Pitman's Patent* (1871, 8 Moo. P. C. N. S. 293),

(b) See *In re Napier's Patent*, P. C. N. S. 293.  
1861, 13 Moo. P. C. C. 543. See  
also *Norton's Patent*, 1863, 1 Moo.  
P. C. N. S. 339; *Pitman's Patent*,  
1871, L. R. 4 P. C. 84; 8 Moo.  
(c) See also *Hardy's Patent*, 1849,  
6 Moo. P. C. C. 441.  
(d) And see *In re Finch's Patent*,  
1898, 15 P. O. R. 674.



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* (1843, 1 Web. P. C. 737), that by so doing 'they are, though not directly, yet mediately and consequentially, as it were, giving 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 damnified. For this reason consideration has been given to the claims of the assignee who has an interest in the patent.' "

Where  
assignee is a  
company.

These principles are strictly applied when the assignees 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 in such a case, where an extension of the term of the patent would confer no benefit upon the latter at all, the application will be refused.

In *Re Hopkinson's Patent* (1897, 14 P. O. R. 9), the petitioners were the inventor and a company who had purchased the patents from an assignee of the inventor. It appeared that the inventor himself had been well remunerated in the course of the transactions. Lord Hobhouse dealt with the questions of principle involved and the authorities which illustrate them, and said: "Their lordships consider that they would be departing both from authority and from sound principle if they were to hold that this company occupies the position of an inventor who has been inadequately remunerated. The company entered upon a purely commercial speculation which, unluckily for them, has, up to the present time, proved unremunerative. They did not assist to perfect or bring out the invention. They purchased it out and out from a prior assignee of the inventor, who has, in

one way or another, been well paid, and has now no claim or interest to ask for an extension" (e).

In *Re Houghton's Patent* (1871, L. R. 3 P. C. 461), however, where the petitioning company had spent large sums in trying to make the invention known and in bringing it into public use, and the patentee was a holder of a considerable number of shares, the patent was prolonged.

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 to the prolongation (f); 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 (g), and in *Shone's Patent* (1892, 9 P. O. R. 438), an extension was granted subject to the condition that the exclusive licensee abandoned all right and benefit under the license.

Effect of  
granting  
exclusive  
license.

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.*"

Assignment  
for district.

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?

(e) And see *Barff and Bower's Patent*, 1895, 12 P. O. R. 363; *Henderson's Patent*, 1901, 18 P. O. R. 453.

(f) *Cardwell's Patent*, 1856, 10 Moo. P. C. C. 438.

(g) *In re Darby's Patent*, 1891, 8 P. O. R. 380.



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.

Remuneration—

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 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.

depends on circumstances.

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 (*h*).

Accounts must be clear.

The account of profit and loss ought to be clear and precise (*i*). The application will be refused if the petitioner's accounts are unsatisfactory (*k*). 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 (*l*).

(*h*) *In re Derosne's Patent*, 1844, 227; *Henderson's Patent*, 18 P. O. R. 2 Wob. P. C. 1; *In re Newton's Patent*, 1861, 14 Moo. P. C. C. 156. 449; but see *In re Deacon's Patent*, 1887, 4 P. O. R. 119, 122.

(*i*) *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*, 1891, 8 P. O. R. (*k*) *In re Trotman's Patent*, 1866, L. R. 1 P. C. 118; 3 Moo. P. C. N. S. 488.

(*l*) *In re Clark's Patent*, 1870,

In *Hughes' Patent* (1898, 15 P. O. R. 371), the petitioner had kept no books, but shortly before the presentation of the petition he had marked upon certain cheques drawn upon his private account approximately the amounts expended by him in working the patent. Upon these materials the accounts accompanying the petition were made up by the accountant. There were no vouchers or other corroboration. Prolongation was refused.

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 (*m*). And where the accounts were *prima facie* satisfactory, the petitioners were allowed to prove the merits of the invention before going into the accounts (*n*). 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 (*o*). This was an exception to the general rule, which is, that evidence will not be received from the petitioner; but in the absence of the books, without reasonable excuse, everything will be taken most strongly against the petitioner (*p*).

In *Wutterick's Patent* (1903, 20 P. O. R. 286), Lord Macnaghten said: "That the accounts presented to them have been honestly kept, and have been honestly made out by the accountant, their lordships do not doubt, nor do they doubt that the accountant has done his best to present the accounts to them in an intelligible form; but still the fact remains that their lordships are unable to discover from the accounts put before the committee what is the remuneration that the patentee has actually received. What a patentee intending to come for prolongation of his patent ought to do is stated very plainly in a judgment of Lord Chelmsford in *Betts' Patent*. It was

L. R. 3 P. C. 421; 7 Moo. P. C. N. S. 255.

(*m*) *In re Wield's Patent*, 1871, L. R. 4 P. C. 89.

(*n*) *In re Houghton's Patent*, 1870, L. R. 3 P. C. 461; 7 Moo. P. C. N. S. 309.

(*o*) *In re Hutchinson's Patent*, 1861, 14 Moo. P. C. C. 364.

(*p*) *In re Lawrence's Patent*, 1892, 9 P. O. R. 85; see also *Yates and Kellett's Patent*, 1887, L. R. 12 App. Cas. 147; 4 P. O. R. 150.



repeated by Lord Cairns in perhaps stronger language in *Sarby's Patent*, and it has been recently repeated in a judgment delivered by Lord Davey in the matter of *Henderson's Patent*" (see note (i)).

Strict accounts sometimes excused.

But in exceptional cases, the filing of perfect accounts may be excused (q). 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 (r).

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 (s).

Amendment of accounts.

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 (t), but good reason must be disclosed, as otherwise the petition will be dismissed (u).

Manufacturer's and patentee's profits distinguished;

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; and the profits that he would in any case have made in his capacity of a manufacturer will not be taken as patentee's profits (x). But in some cases the very fact of the ownership of the patent will be sufficient to greatly increase the number of orders he will receive as a manufacturer, and such matters will be taken into account in considering the remuneration. In *Sarby's Patent* (1870, L. R. 3 P. C. 295), Lord Cairns said: "It has been decided more than once by this committee (y) that where the patentee is also the manufacturer, the

(q) *In re Lowe's Patent*, 1846, 10 Jur. 363.

(r) *In re Heath's Patent*, 1853, 8 Moo. P. C. C. 217; 2 Web. P. C. 247.

(s) *In re Darby's Patent*, 1891, 8 P. O. R. 380, 384.

(t) *Johnson and Atkinson's Patents*, 1873, L. R. 5 P. C. 87.

(u) *Newton's Patent*, 1884, L. R.

9 A. C. 592; 1 P. O. R. 177; *Yates and Kellett's Patent*, 1887, L. R. 12 A. C. 147; 4 P. O. R. 150.

(x) See Lord Brougham's remarks in *Galloway's Patent*, 1843, 1 Web. P. C. 729.

(y) See *In re Betts' Patent*, 1862, 1 Moo. P. C. N. S. 49; *Willans and Robinson's Patent*, 1896, 13 P. O. R. 550.

profits which he makes as manufacturer, although they may not be in a strict point of view profits of the patent, must undoubtedly be taken into consideration upon a question of this kind. It is obvious that in different manufactures there will be different degrees of connection between the business of the applicant as a manufacturer and his business or his position as the owner of a patent. There may be patents of some kind which have little or no connection with the business of the manufacturer, and there may be patents of a different kind, where there is an intimate connection with the business of the manufacturer; that the possession of the patent virtually secures to the patentee his power of commanding orders as a manufacturer."

The same remarks apply to the reckoning of losses. In *Also losses.* *Thornycroft's Patent* (1899, 16 P. O. R. 202), the owners of the patent, which was granted for a new form of marine boiler, had constructed boilers for ships built by other firms, and on these there had been a profit. They also built a vessel (the "Speedy") themselves, and equipped her with boilers. On this vessel the firm made a great loss, and in estimating the loss they divided the total loss between the boilers and the vessel without the boilers in proportion to their relative cost; thus obtained the loss attributable to the boilers was about £5,000. Lord Davey said: "It appears, however, on cross-examination, that the tenders for the 'Speedy' . . . . contained separate prices for the boilers and for the boat, and the difference between the contract price and the actual cost of the boilers of the 'Speedy' was £688 only. Their lordships think that the proportion of loss attributed to the boilers is ascertained on a fallacious principle . . . . No explanation whatever has been offered why this large loss was incurred in building boats fitted with the patent boilers for themselves, while a handsome profit was made on supplying the boilers for boats built by other builders. In the absence of any explanation, the facts proved are consistent with the existence of some error of judgment, miscalculation, or other defect in the petitioners' mode of carrying on their business of boat-building."

In estimating profits, a deduction will be allowed for the Deductions.



expenses of experiments in bringing the invention to perfection (z).

The expenses of taking out the patent will be allowed as deduction (a). So also will the expenses incurred in bringing the invention in general public use (b). 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 (c). The amount allowed will depend on the circumstances of the case (d), but it must be quite clear to what extent the patentee has given his time (e). 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 (f). And deductions will also be allowed in respect of the costs of litigation necessary to maintain the validity of the patent, and to restrain infringers (g). But not where actions have been compromised improvidently, and costs abandoned without sufficient reason (h).

The petitioner must show the profits which have been made by any other persons interested in the patent, such as his licensees (i) or the assignees of a part, with free right to use the invention (k).

And in *Re Johnson's Patent* (1871, L. R. 4 P. C. 75), 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 considera-

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| (z) <i>Bate's Patent</i> , 1836, 1 Web. P. C. 1739; <i>Kay's Patent</i> , 1839, 1 Web. P. C. 572. | Moo. P. C. N. S. 452; L. R. 1 P. C. 514.   |
| (a) <i>In re Roberts' Patent</i> , 1839, 1 Web. P. C. 575.  | (g) <i>Kay's Patent</i> , 1839, 1 Web. P. C. 572; <i>Galloway's Patent</i> , 1843, 1 Web. P. C. 729; <i>Betts' Patent</i> , 1862, 1 Moo. N. S. 62. |
| (b) <i>In re Galloway's Patent</i> , <i>supra</i> .   | (h) <i>Hill's Patent</i> , 1863, 1 Moo. N. S. 258.   |
| (c) <i>In re Carr's Patent</i> , 1873, L. R. 4 P. C. 539.   | (i) <i>In re Trotman's Patent</i> , 1866, L. R. 1 P. C. 118; 3 Moo. P. C. N. S. 488; but see <i>Thomas' Patents</i> , 1892, 9 P. O. R. 367, 373.   |
| (d) <i>Bailey's Patent</i> , 1884, 1 P. O. R. 2.  | (k) <i>Thomas' Patents</i> , 1892, 9 P. O. R. 367.   |
| (e) <i>Turner's Patent</i> , 1885, 2 P. O. R. 177.  |  |
| (f) <i>In re Poole's Patent</i> , 1867, 4   |  |

tion 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 to the patentee, *whether it be in one country or another*" (l).

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 (m). 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 (n).

Foreign patents—  
how considered.

This Act, however, is specifically repealed, and by sect. 45, sub-sects. 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.”*

Dealing with this repeal and its effect, Lord Watson, in *Semet and Solvay's Patent* (1895, 12 P. O. R. 17) said: “But the lapse or expiry of foreign patents remains, as it always has been, one of the circumstances which must necessarily be considered. . . . In cases where the prolongation of a patent

(l) See also *Hardy's Patent*, 1849, 6 Moo. P. C. C. 441.

(m) *In re Bodmer's Patent*, 1849, 8 Moo. P. C. C. 282; *In re Newton's Patent*, 1862, 15 Moo. P. C. C. 176; *In re Betts' Patent*, 1862, 1 Moo. P. C. N. S. 49; *In re Johnson's Patent*, 1871, 8 Moo. P. C. N. S. 262; L. R. 4 C. P. 75; *supra*.

(n) *In re Betts' Patent*, 1862, 1 Moo. P. C. N. S. 49; *In re Poole's Patent*, 1867, 4 Moo. P. C. N. S. 452; *In re Adair's Patent*, 1881, L. R. 6 App. Cas. 176; 50 L. J. P. C. 68; but see *In re Blake's Patent*, 1873, L. R. 4 P. C. 535; 9 Moo. P. C. N. S. 373.



would place the inhabitants of Great Britain and Ireland at a disadvantage in competition with the subjects of a foreign State, that circumstance must militate strongly against its extension. Whether the disadvantage, either certain or probable, ought to outweigh the right of the patentee to obtain a renewal upon other grounds, must always be a question of degree, to be decided according to the special circumstances of each case (o). But the profits derived from foreign patents must be set out clearly, as they are considered with 'all the circumstances of the case' (p)."

Practice  
rules.

The practice is regulated by the Privy Council Rules, 1897, made under sect. 25 of the Act of 1883 (see Appendix).

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

Any person may enter a caveat against the extension, and may be heard at the bar in support of their opposition (r). The caveat must be lodged within the time prescribed, and no extension of this time will be granted without good reason shown (s); and where unreasonable opposition is offered, the opponent will be ordered to pay the petitioner's costs (t). But where the opposition is well founded and successful, costs will be allowed to the opposing party (u). 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 (x). 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

(o) And see *Pieper's Patent*, 1895, 12 P. O. R. 292; also *Standfield's Patent*, 1898, 15 P. O. R. 17.

(p) *Newton's Patent*, 1884, 1 P. O. R. 177; *Barff and Bower's Patent*, 1895, 12 P. O. R. 385.

(q) *In re Clark's Patent*, 1870, L. R. 3 P. C. 421; *In re Johnson's & Atkinson's Patent*, 1873, L. R. 5 P. C. 87; *In re Church's Patent*, 1886, 3 P. O. R. 95.

(r) *In re Lowe's Patent*, 1852, 8 Moo. P. C. C. 1; *In re Schlum-*

*berger's Patent*, 1853, 2 Eq. R. 1; 9 Moo. P. C. C. 1.

(s) *Hopkinson's Patent*, 1896, 13 P. O. R. 114.

(t) *In re Downton's Patent*, 1839, 1 Web. P. C. 565; *In re Honiball's Patent*, 1855, 9 Moo. P. C. C. 394.

(u) *In re Westrupp & Gibbins' Patent*, 1836, 1 Web. P. C. 554.

(x) *In re Bridson's Patent*, 1852, 7 Moo. P. C. C. 499. See, however, *In re Milner's Patent*, 1854, 9 Moo. P. C. C. 39.

opposition were refused, although the petition had been dismissed on the ground of sufficient remuneration (*y*).

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 (*z*). 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 (*a*).

The Attorney-General always appears in the interest of the Crown (*b*); his duty is as much to instruct the Lords of the Council, and to assist them as to oppose, and, indeed, only to oppose the patent where, in his judgment, he considers that it is not one that ought to be prolonged (*c*). 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 (*d*), 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 (*e*).

(*y*) *In re Muntz's Patent*, 1846, 2 Web. P. C. 122.

(*z*) *In re Jones' Patent*, 1854, 9 Moo. P. C. C. 41; also *In re Hill's Patent*, 1863, 1 Moo. P. C. N. S. 258; *In re Wiold's Patent*, 1871, 8 Moo. P. C. N. S. 300; L. R. 4 P. C. 89; *Newton's Patent*, 1884, L. R. 9 App. Cas. 592; *Dolbear's Patent*, 1896, 13 P. O. R. 205; *Hopkinson's Patent*, 1897, 14 P. O. R. 10; *Ferranti's Patent*, 1901, 18 P. O. R. 520.

(*a*) *Westrupp & Gibbins' Patent*, 1836, 1 Web. P. C. 554; *In re Jones'*

*Patent*, 1854, 9 Moo. P. C. C. 41; *In re Wiold's Patent*, 1871, L. R. 4 P. C. 89; 8 Moo. P. C. C. N. S. 300.

(*b*) *In re Erard's Patent*, 1835, 1 Web. P. C. 557; *In re Smith's Patent*, 1850, 7 Moo. P. C. C. 133.

(*c*) Per Sir W. Grove in *Stoney's Patent*, 1888, 5 P. O. R. 522.

(*d*) *In re Ball's Patent*, 1879, L. R. 4 App. Cas. 171; *In re Stewart's Patent*, 1886, 3 P. O. R. 9; *In re Livet's Patent*, 1892, 9 P. O. R. 327.

(*e*) *Ibid.*



Whether the petition be opposed or not, the petitioner must formally prove his case (*f*).

Council  
cannot grant  
second  
extension.

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 (*g*).

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.

(*f*) *Darby's Patent*, 1891, 8 P  
O. R. 383.

(*g*) *In re Goucher's Patent*, 1865,  
2 Moo. P. C. N. S. 532.

## CHAPTER XIII.

### 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) 1891, 8 P. O. R. 281, 284; see also remarks of Bowen, L.J., in *Singer v. Stassen*, 1884, 1 P. O. R. at p. 125.



## CHAPTER XIV.

THE REMEDY OF THE PUBLIC AGAINST THE PATENTEE.—  
COMPULSORY LICENSE AND REVOCATION.

Under the  
Act of 1883.

THE Act of 1883 gave two remedies against the patentee. Where he abused his monopoly in such a manner that (1) The patent was not being worked in the United Kingdom; or (2) The reasonable requirements of the public with respect to the invention were not satisfied; or (3) Any person was prevented from working or using an invention of which he was possessed, the Board of Trade might be petitioned to order the patentee to grant a compulsory license upon such terms as the Board might deem reasonable.

The second remedy is a petition to the High Court to revoke the patent, on any ground which would have been available to the petitioner on *scire facias* (such as invalidity).

The Act of  
1902.

By sect. 3 of the Act of 1902 the provisions of the Act of 1883 with respect to compulsory licenses are repealed and a wider jurisdiction substituted therefor. The petition will now be referred to the Judicial Committee of the Privy Council, who may order a compulsory license, or in cases where the Committee are of opinion that the granting of licenses will be an inadequate remedy they may revoke the patent.

Section 3 is as follows:—

3. *Section twenty-two of the principal Act (relating to the grant of compulsory licenses by the Board of Trade) is hereby repealed, and the following provisions shall be substituted therefor:—*

- (1) *Any person interested may present a petition to the Board of Trade alleging that the reasonable requirements of the public with respect to a patented invention have not been satisfied, and praying for the grant of a com-*

*pulsory license, or, in the alternative, for the revocation of the patent ;*

- (2) *The Board of Trade shall consider the petition, and if the parties do not come to an arrangement between themselves, the Board of Trade, if satisfied that a *prima facie* case has been made out, shall refer the petition to the Judicial Committee of the Privy Council, and, if the Board are not so satisfied, they may dismiss the petition.*

The practice on presenting petitions is regulated by Rules 69 to 75 of the Patents Rules, 1903.

The petition to the Board of Trade.

The petition, which must be left at the Patent Office, must show all the circumstances of the case, and the terms of the proposed order, and must be accompanied by affidavits or statutory declarations in proof of the allegations. Copies must be delivered to the patentee "and any other person who is alleged in the petition to have made default."

These have fourteen days after the Board have invited them to do so to deliver affidavits in answer, and the petitioner has a further period of fourteen days for reply. The Board then consider the petition on its merits, and if they consider that there is a reasonable probability of an arrangement between the parties they will defer referring the petition to the Judicial Committee.

If the Board consider that there is no reasonable probability of such an arrangement, and that a *prima facie* case has been made out, the petition will be referred to the Judicial Committee of the Privy Council.

The reference.

The practice before the Committee is regulated by the Privy Council Rules, 1903 (*q.v.*).

Practice in the Privy Council.

Rule 2 (a) begins :—"No application to fix a time for hearing shall be made unless the petitioner shall have previously given notice to the patentee, to the opponents, and to any other person claiming an interest in the patent as exclusive licensee or otherwise." It is submitted that who these people are, must be ascertained from the register.

Any person claiming an interest in the patent may lodge a caveat whether he have received notice or not. The rules do not



say whether such a person must have a registered interest, but it would appear that this would not be necessary.

(3) *Where any such petition is referred by the Board of Trade to the Judicial Committee, and it is proved to the satisfaction of the Judicial Committee that the reasonable requirements of the public with reference to the patented invention have not been satisfied, the patentee may be ordered by an Order in Council to grant licenses on such terms as the said Committee may think just, or, if the Judicial Committee are of opinion that the reasonable requirements of the public will not be satisfied by the grant of licenses, the patent may be revoked by Order in Council;*

*Provided that no order of revocation shall be made before the expiration of three years from the date of the patent, or if the patentee gives satisfactory reasons for his default;*

(4) *At the hearing of any petition under this section the patentee and any person claiming an interest in the patent as exclusive licensee or otherwise, shall be made parties to the proceeding, and the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.*

It is not possible as yet to say what will be the policy of the Judicial Committee as to the terms on which the license will be ordered. Under the Act of 1883 discussion on the terms of the license usually took place privately as the result of offers, and the amount of royalties, etc., when agreed, were embodied in the order by consent.

The griev-  
ance.

We now come to the grievance which must be proved by the petitioner in order to make out his case for a compulsory license or revocation. The words of the statute are wide. The ground for ordering a license is as in the earlier Act, that the reasonable requirements of the public have not been supplied. But if the petitioner can prove that the patent is worked exclusively or mainly outside the United Kingdom, then the onus is on the patentee to show that the reasonable require-

ments of the public have been satisfied ; otherwise the petitioner is entitled to a license or revocation.

(5) *If it is proved to the satisfaction of the Judicial Committee that the patent is worked or that the patented article is manufactured exclusively or mainly outside the United Kingdom, then, unless the patentee can show that the reasonable requirements of the public have been satisfied, the petitioner shall be entitled either to an order for a compulsory license, or, subject to the above proviso, to an order for the revocation of the patent ;*

(6) *For the purposes of this section the reasonable requirements of the public shall not be deemed to have been satisfied if, by reason of the default of the patentee to work his patent or to manufacture the patented article in the United Kingdom to an adequate extent, or to grant licenses on reasonable terms, (a) any existing industry or the establishment of any new industry is unfairly prejudiced, or (b) the demand for the patented article is not reasonably met.*

The require-  
ments of the  
public.

The provision in this enactment for revocation of the patent marks a change in the attitude of the law towards the privileges conferred by letters patent, and probably a reversion to the earlier policy of the Crown. In Mr. J. W. Gordon's learned work on "Compulsory Licenses," published in 1899, the history of the law is discussed in a most interesting manner. The author points out that it is only in comparatively recent times that the Courts have adopted the view that the abuse of his privileges by the patentee has been deemed no ground for invalidating the patent.

It is not easy to see how a case of such abuse could be so serious as to be incurable by a compulsory license ; but perhaps revocation would be justified as a punishment for misfeasance in the past. One might suppose, for example, a case in which the invention consisted in the artificial manufacture of what had previously been obtained from nature, such as indigo. The patentee might put the artificial product on the market at such a price as to cause all the natural sources to be abandoned and their industries to be ruined ; and then when there was no

When will  
revocation  
be decreed ?



further competition he might raise the price of his own product to an oppressive degree. Such an abuse (*i.e.*, in raising the price) might justify revocation.

**Enforcement  
of the order.**

The enforcement of the order for a compulsory license is no longer effected by mandamus as under the Act of 1883.

- (7) *An Order in Council directing the grant of any license under this section shall, without prejudice to any other method of enforcement, operate as if it were embodied in a deed granting a license and made between the parties to the proceeding ;*
- (8) *His Majesty in Council may make rules of procedure and practice for regulating proceedings before the Judicial Committee under this section, and, subject thereto, such proceedings shall be regulated according to the existing procedure and practice in patent matters. Any Order in Council or any order made by the Judicial Committee under this Act may be enforced by the High Court as if it were an order of the High Court.*

It was a moot point whether on the earlier proceedings for enforcing an order of the Board of Trade by mandamus the Court could enter into the circumstances of the case. Now that the order of the Judicial Committee operates as a license it is clear that the matter cannot be re-opened in this way.

**Costs.**

- (9) *The costs of and incidental to all proceedings under this section shall be in the discretion of the Judicial Committee, but in awarding costs on any application for the grant of a license the Judicial Committee may have regard to any previous request for, or offer of, a license made either before or after the application to the Committee ;*
- (10) *For the purposes of this section three members of the Judicial Committee shall constitute a quorum ;*
- (11) *This section shall apply to patents granted before as well as after the commencement of this Act.*

**Revocation  
by the High  
Court.**

In cases where it is desired to obtain the revocation of the patent on grounds other than abuse of the monopoly by the patentee, the public may petition the High Court.

Sect. 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 persons 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 was presumed, however, that this new procedure would find more favour, being simpler, more speedy, and more similar to the ordinary action for infringement than the old action of *scire facias*.

Grounds of  
revocation.

The grounds upon which a patent may be revoked are similar to those upon which it might have been cancelled by *scire facias*. These are in the Fourth Institute (p. 88) said to be: "*Firstly*, when the king by his letters patent doth grant by several letters patent one and the self-same thing to several persons, the former patentee shall have a *scire facias* to repeal the second patent; *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* (about 1680, 2 Vent. 344), that "where a 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."

Proceedings  
in Scotland.

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.

Petitioners  
entitled as of  
right.

*In re Avery's Patent* (1887, L. R. 36 C. D. 307; 4 P. O. R. 322) 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).

Petition must  
be properly  
framed.

If the patent be revoked on the ground of fraud the first and true inventor may apply to the Comptroller under sub-sect. 8 for a patent to be granted to him in lieu thereof, but the Comptroller is not bound to accede to the application, and retains his

Where fraud  
found, new  
patent issued.



discretion as in any ordinary application (a). This right will not apply where the petition is under clause (d) only.

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 (b).

Interested persons must be parties.

All persons beneficially interested in the patent must be made parties to the petition (c).

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 (d).

Where Att.-Gen.'s fiat required.

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 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.

(a) *Norwood's Patents*, 1895, 12 P. O. R. 219.

(b) *In re Morgan's Patent*, 1888, 5 P. O. R. 186.

(c) *In re Avery's Patent*, 1887, 4 P. O. R. 159.

(d) 46 & 47 Vict. c. 57, s. 44, sub-s. 9.

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 (*e*).

The fees payable on lodging these documents amount to £2 13s. 4d.

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 petitioner for revocation, to enable him to carry on his business in security (*f*), 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 case of *Weir v. Denny* (1894, 11 P. O. R. 657), and the validity of the patent would be decided once and for all.

A previous judgment in an action for infringement either for **No estoppel.** or against the validity of a patent does not create an estoppel

(*e*) For forms of these documents see Appendix.

(*f*) This occurred in *Re Deeley's Patent*; for report of the infringement action see *Westley Richards v. Perkes*, 1893, 10 P. O. R. 181, 382; for proceedings on application for

leave to amend the patent, *Deeley's Patent*, 1894, 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, 1895, 12 P. O. R. 65.



in a petition for revocation. In *The Shoe Machinery Co., Ltd. v. Cutlan* (1895, 12 P. O. R. 533), Smith. L.J., said: "We held in *Deeley's Patent* (1895, 12 P. O. R. 199) that in a petition for revocation of a patent there was no estoppel, because the person petitioning . . . stands as one of the public, and not as an individual; and although the person petitioning for revocation may be the same person against whom judgment has been given in a patent suit, there is no estoppel against him when he petitions, because he appears as one of the public" (g).

Att.-Gen. has  
absolute  
discretion.

The Attorney-General has absolute discretion in granting or refusing his fiat; but cases are unlikely to arise in which the fiat will be refused (h). If the applicant shows sufficient interest, and makes out a good case, the Attorney-General will grant his fiat without hearing the patentee (i), 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 (k). Sir H. James, A.-G., decided that he had no power under sect. 38 to give costs in these cases (l).

The form of the fiat of the Attorney-General will be found in the Appendix of Forms.

Procedure on  
petition.

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 (m). The order for revocation will, however, only be made in open court and not in chambers, even though the respondent consent (n); but the usual course is for the judge to give

(g) And see *Re Lewis' Patent*, 1897, 14 P. O. R. 35; *Jameson's Patent*, 1902, 19 P. O. R. 252.

(h) Per A. L. Smith, L. J., in *The Shoe Machinery Co. v. Cutlan*, 1895, 12 P. O. R. 533.

(i) *Gaulard and Gibbs' Patent*, Griff. P. C. 320; *Rothwell's Patent*, Griff. P. C. 320.

(k) *Bell and Coleman's Patent*,

Griff. P. C. 320; *Martin's Patent*, Griff. P. C. 320; *Siddell's Patent*, Griff. P. C. 320; *Walling's Patent*, Griff. P. C. 320.

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

(m) *Vaisey's Patent*, 1894, 11 P. O. R. 591.

(n) *Clifton's Patent*, 1904, 21 P. O. R. 515.

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 the petition has been presented (*o*), 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 (*p*).

A respondent residing out of the jurisdiction will not be ordered to give security for costs (*q*).

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.*"

Sect. 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

(*o*) *Drummond's Patent*, 1889, 6 P. O. R. 576; L. R. 43 Ch. D. 80; *La Compagnie Générale d'Eaux Minérales Trade Marks*, 1891, 8 P. O. R. 446; 1891, L. R. 3 Ch. 451; *F. King & Co.'s Trade Mark*, 1892, 9 P. O. R. 350; 1892, L. R. 2 Ch. 462; *Kay's Patent*, 1893, 11 P. O. R. 279; *Goerz and Hoegh's Patent*, 1895, 12 P. O. R. 370; *Cerckel's Patent*, 1898, 15 P. O. R. 500.  
 (*p*) *Ibid.*  
 (*q*) *La Société Anonyme Trade Mark*, 1893, 10 P. O. R. 290; *Miller's Patent*, 1894, 11 P. O. R. 55.



just to permit the petitioner to examine the respondent. The rules as to interrogatories will be similar to those in an action for infringement.

Sect. 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.

The petition may, therefore, be tried at the assizes if convenient (*r*), and before a jury on an issue of fraud.

And the parties are entitled to have the petition heard with *virá voce* 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 of reply that the respondent is made practically plaintiff at the trial.

The order in  
*Deeley v.*  
*Perkes.*

In cases where the patent is invalid on the ground of want of novelty in part, which defect might be cured by amendment, the Court usually follows the order made in *Deeley v. Perkes* (1896, 13 P. O. R. 581; 1896, L. R. A. C. 496), by which the patent is ordered to be revoked unless within a given time the patentee apply at the Patent Office to amend by a specified disclaimer and unless such disclaimer be allowed. (See pp. 202 and 204, and *Scott's Patent* (1903, 20 P. O. R. 263).)

If the order to revoke were not conditional, the Comptroller would be unable to amend the specification of a patent which did not exist. This difficulty arose in *Deeley v. Perkes* (*supra*), and was thus surmounted.

(*r*) *Edmond's Patent*, 1889, 6 P. O. R. 355.

(*s*) *Gaulard and Gibbs' Patent*, 1887, L. R. 34 C. D. 396; 56 L. J. Ch. 606; 56 L. T. 284.

## CHAPTER XV.

## 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.*"

The statutory right of action.

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).

The earlier law.

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 by the defendant amounted to a "malicious attempt to injure the plaintiffs by asserting a claim of right against his own knowledge that it was without any foundation" (c).

(b) *Halsey v. Brotherhood*, 1880, L. R. 15 Ch. D. 514, 517; *Wren v. Weild*, 1869, L. R. 4 Q. B. 730.

(b) *Halsey v. Brotherhood*, 1880, L. R. 15 Ch. D. 520.

(c) Per Blackburn, J., in *Wren*



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).

Principle of  
the new  
right.

The threat.

The words "by circulars, advertisements, or otherwise" have given rise to a number of cases in which an interpretation has been put upon them, and in which the principle of the enactment is clearly illustrated. The cause of action is not similar to libel, and there is no question of publication; therefore the manner in which the threat is made is immaterial. In *Skinner v. Perry* (1893, 10 P. O. R. 7), the plaintiffs complained of two threats—one in the form of a letter to a third party, who had enquired of the defendants whether they thought that the plaintiffs' article of manufacture infringed the defendants' patent; the other contained in a letter from the defendants to the plaintiffs themselves in reply to similar enquiries. In giving judgment for the plaintiffs, Bowen, L.J., said: "Using language in its ordinary sense, it is difficult to see that an intimation ceases to be a threat because it is addressed to a third person in answer to an enquiry, or because it is addressed to the person himself. We are not dealing with libel or questions of publication—we are dealing with threats. If I threaten a man that I will bring an action against him, I threaten him none the less because I address that intimation to himself, and I threaten him none the less because I address the intimation to a third person" (e). And verbal statements will therefore

*v. Weild*, 1869, L. R. 4 Q. B. at p. 737; *Halsey v. Brotherhood*, 1880, L. R. 15 Ch. D. 519.

(d) Per North, J., in *Day v. Foster*, 1890, 7 P. O. R. 60; see also *Challender v. Royle*, 1887, L. R. 36 Ch. D. 439, 440; *Skinner v. Perry*,

1893, 10 P. O. R. 5, 6.

(e) And see *Driffield v. Waterloo*, 1886, 3 P. O. R. 47; L. R. 31 C. D. 638; *The Combined Weighing Machine Co. v. The Automatic Weighing Machine Co.*, 1889, 6 P. O. R. 506.

probably be threats (*f*), and the use of the words "without prejudice" will not affect the matter (*g*).

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 (*h*). *Bona fides*  
immaterial.

In usual practice the defendant in a threats action has issued the threats in a solicitor's letter, or by circular to purchasers from the plaintiffs who are the defendant's rivals in trade.

The publication of a general warning to the whole world—such as, "I have a patent for such and such a machine, proceedings will be taken against any person who infringes it"—will not be actionable, since this is no more than the patent itself says (*i*); 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. General  
warning is  
not threat.

In *Challender v. Royle* (1887, L. R. 36 C. D. 441), 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."

In the same case the same Lord Justice, in his judgment, Threats  
against

(*f*) See *Kurtz v. Spence*, 1888, 5 P. O. R. 161; and *Dowson v. Drosophore Co.*, 1894, 11 P. O. R. 536.

(*g*) *Kurtz v. Spence*, 1888, 5 P. O. R. 173.

(*h*) *Day v. Foster*, 1890, 7 P. O. R. 58; *Skinner v. Perry*, 1893, 10 P. O. R. 8.

(*i*) *Johnson v. Edge*, 1892, 9 P. O. R. 148; also *Challender v. Royle*, 1887, L. R. 36 Ch. D. 441; *Ungar v. Sugg*, 1881, 8 P. O. R. 388; *The Fusee Vesta Co. v. Bryant & May*, 1887, 4 P. O. R. 191; *Douglas v. Pintsch's Patent Lighting Co.*, 1896, 13 P. O. R. 680.



future  
infringement.

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* (1892, 9 P. O. R. 148), 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." 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 (k)?"

The plaintiff.

"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 (l).

The validity  
of the patent  
may be  
disputed.

"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

(k) See also *Kurtz v. Spence*, 5 P. O. R. 277, 279; see also *Burt v. Morgan*, 1887, 4 P. O. R. 279, 280;

(l) *Kensington, &c. Electric Lighting Co. v. Lane-Fox Co.*, 1891, 8 P. O. R. 142, 145.

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" (m).

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.* (1891, 8 P. O. R. 277), 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 entering into the consideration of the validity or invalidity of the patent. The defence.

*Prima facie* the burden of proof is on the plaintiff that what he has done is not an infringement of the defendant's patent, but the onus may easily be shifted on to the defendant, and the issues including validity will be tried as in an action for infringement (n).

"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 The proviso.

(m) 4 P. O. R. at p. 371; L. R. 430; *Herrburger v. Squire*, 1888, 5 36 Ch. D. at p. 435; see also *Kurtz v. Spence*, 1887, 4 P. O. R. 427, P. O. R. 581, 589.  
(n) *Challender v. Royle*, 1887, 4 P. O. R. 371.



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 (o). The action must be in respect of infringements which were alleged in the threats circulated by the patentee. But it need not necessarily be against the person aggrieved by the threats (p), since in many cases an action could not be brought against him—where, for instance, the person aggrieved is a rival patentee who does not manufacture at all. But it must be an action honestly brought on account of an infringement substantially similar to that which is the subject-matter of the threat, and it is immaterial whether the issue of validity is raised in the infringement action.

The parties to the infringement action.

Validity need not be disputed in infringement action.

In *Day v. Foster* (1890, 7 P. O. R. 60) 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 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 sect. 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 conse-

(o) *Kensington and Knightsbridge Electric Co. v. Lane-Fox Co.*, 1891, 8 P. O. R. 277. P. O. R. 373; and see *Combined Weighing Machine Co. v. Automatic*

(p) *Challender v. Royle*, 1887, 4 Co., 1889, L. R. 42 C. D. 670.

quence held that the action for threats 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* (q), and the onus of proof rests on the other party to show that the action was not in fact an honest one (r), and so to bring the action for threats under the old common law rule requiring malice.

*Bona fides*—  
onus of proof.

“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 (s), and it is immaterial whether the action is brought before or after the commencement of the threats action (t).

Diligence.

The Courts have refused to consider threats made after an action has been commenced for infringement, as contempt of court (u).

Contempt of  
court.

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 (x).

The section does not require that the action should be prosecuted to a successful termination, and the extent to which the action must be prosecuted will depend largely on the circumstances of the case.

Successful  
termination  
not required.

In *Colley v. Hart* (1890, 7 P. O. R. 111), the facts were as follows:—On the 15th September, 1888, the defendant issued a

(q) *Challender v. Royle*, 1887, L. R. 36 Ch. D. 438, 439; 4 P. O. R. 373, 375; *Day v. Foster*, 1899, 7 P. O. R. 60; *Colley v. Hart*, 1890, 7 P. O. R. 112.

P. O. R. 502; *Berliner v. The Edison-Bell Phonograph Co.*, 1899, 16 P. O. R. 336; *Haskell Golf Ball Co. v. Hutchison*, 1904, 21 P. O. R. 497; *Challender v. Royle*, supra.

(r) *Colley v. Hart*, 1890, 7 P. O. R. 112.

(u) *Dunlop Pneumatic Tyre Co. v. Clifton Rubber Co.*, 1902, 19 P. O. R. 527; *Haskell Golf Ball Co. v. Hutchison*, 1904, 21 P. O. R. 497.

(s) *Challender v. Royle*, L. R. 36 Ch. D. 425, 437; *Day v. Foster*, 1899, 7 P. O. R. 60.

(t) *Combined Weighing-Machine Co. v. Automatic, &c. Co.*, 1889, 6

(x) *Edlin v. Pneumatic Tyre, &c. Agency*, 1893, 10 P. O. R. 311.



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 sect. 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."

In *The English and American Machinery Co. v. The Gare Machine Co.* (1894, 11 P. O. R. 627), 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.

**Diligence in prosecution.**

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 *bonâ fide*, and with due diligence, a very slight amount of prosecution, probably, would take the case out of the operation of the section (y).

(y) See on *prosecution* as opposed to *institution*, *Bishop v. Tuman*, 1900, 17 P. O. R. 759.

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 (z).

The question of "due diligence" is therefore one of fact.

The action for infringement may be raised by way of counter-claim, and it will be a question of fact whether such a claim is brought with sufficient diligence (a). Infringement may be raised by counter-claim.

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.

In *The Fusee Vesta Co. v. Bryant & May* (1887, 4 P. O. R. 191), the action, which was one for infringement of the plaintiffs' 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. 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 Effect of infringement action.

(z) *Johnson v. Edge*, 1892, 9 P. O. R. 142, 146; see also *Herrburger v. Squire*, 1888, 5 P. O. R. 581, 594.

(a) *Appleby Twin Roller Chain Co. v. Albert Eadie Chain Co.*, 1899, 16 P. O. R. 330.



whether the threats were *bonâ fide* or not (b), 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* (c), the abandonment of the proceedings for infringement would imply, of necessity, that those threats would not be continued, and 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 sect. 32 would be at once revived.

Stay of the threats action.

Where an action for infringement has been commenced after the institution of proceedings under sect. 32 the proper course for the parties to pursue in the threats action was indicated by Kekewich, J. (d). 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."

Subject-matter of two actions must be the same.

But on a motion to stay an action for threats, on the ground that an action for infringement is being prosecuted, it must be shewn that the letters patent, which are the subject-matter of the two actions, must be the same. So where the threats action was in respect of four patents on which the defendant threatened,

(b) *Challender v. Royle*, 1887, L. R. 36 Ch. D. at p. 439.

*Gas Lamp Co.*, 1897, 14 P. O. R. 188.

(c) See *Dredge v. Parnell*, 1896, 13 P. O. R. 393; *Incandescent Gas Light Co. v. Sunlight Incandescent*

(d) *Combined Weighing, &c. Co. v. Automatic, &c. Co.*, 1889, L. R. 42 Ch. D. 665.

and the infringement action was in respect of one only of these four, the motion to stay the threats action was dismissed (*e*). But where the defendant has threatened, on the strength of several patents, he is not compelled to use all of them in the infringement action (*f*).

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 (*g*), 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 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* (1887, L. R. 36 C. D. 435), 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 plaintiff's 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

Interlocutory  
injunction.

(*e*) *Dowson-Taylor Co., Ltd. v. Co. v. Brooks*, 1904, 21 P. O. R. 663.  
*The Drosophore Co., Ltd.*, 1895, 12 P. O. R. 95.

(*f*) *Temler v. Stevenson and Sons*, 1898, 15 P. O. R. 31; *Lycett Saddle* (*g*) Per Jessel, M. R., in *Halsey v. Brotherhood*, 1880, L. R. 15 Ch. D. at p. 517.



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 points the plaintiff in the action has made out a *prima facie* case, and unless the Court is so satisfied it would be wrong to grant an injunction merely on the ground that it cannot do the defendant any harm.”

Where there was a conflict of testimony as to the fact of infringement, the Court refused to grant an interlocutory injunction (*h*).

In *Colley v. Hart* (1889, 6 P. O. R. 173), 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.”

Form of  
injunction  
(see Appen-  
dix).

The injunction being by far the more important remedy, it seldom occurs that a substantial sum in damages is asked for or granted. The form of injunction granted in *Mountain v. Parker and Smith* (1903, 20 P. O. R. 774) is given in the Appendix.

Damages.

The best course is for the judge to assess the damages at the trial. They are usually problematical, and depend upon a general impression of the case rather than upon a close examination of figures, and the cost of a reference for inquiry would be as a rule quite out of proportion to the amount that could be awarded. See, for example, *Ungar v. Sugg* (1892, 9 P. O. R. 116) (*i*).

(*h*) *Barney v. United Telephone Co.*, 1885, 2 P. O. R. 173. 1894, 18 P. O. R. 416; *Hoffnung v. Salisbury*, 1899, 16 P. O. R. 382.

(*i*) But see *Skinner v. Perry*,

The defendant in an action under this section is entitled to Particulars. particulars of the threats upon which the plaintiff relies (*k*), and if the validity of the patent is put in question the general rules relating to particulars of objections will apply (*l*). 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 (*m*).

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 (*n*).

(*k*) *Law v. Ashworth*, 1890, 7 P. O. R. 86.

(*l*) *Union Electrical Power Co. v. Electrical Power Storage Co.*, 1888, 5 P. O. R. 329; *Law v. Ashworth*, 1890, 7 P. O. R. 86.

(*m*) *Union Electrical Power Co. v. Electrical Storage Co.*, 1888, 5 P. O. R. 329.

(*n*) *Dowson-Taylor v. The Drosophore Co.*, 1894, 11 P. O. R. 536.



## CHAPTER XVI.

## THE CAUSE OF ACTION—INFRINGEMENT.

What is  
infringe-  
ment?

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*).

A question  
of fact.

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* (1843, 2 Web. P. C. 99), 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

(*a*) *Walton v. Bateman*, 1842, 1 Web. P. C. 615.

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

(*c*) *Walton v. Potter*, 1841, 1 Web. P. C. 586; *De la Rue v. Dickenson*, 1857, 7 E. & B. 738.

patent, that no objection arises either to the nature of the grant or the specification which has been enrolled by the plaintiff."

If the patent be 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* (1866, L. R. 1 H. L. 337; 35 L. J. Ch. 852), in the House of Lords. The question of infringement was there taken as involving the validity of the patent.)

No infringement of invalid patent.

It is equally an infringement whether the defendant acted in ignorance of the plaintiff's patent or not. In *Heath v. Unwin* (1845, 14 L. J. Ex. 156; 2 Web. P. C. 227), 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 subsequently, when *Heath v. Unwin* (1854, 25 L. J. C. P. 19; 5 H. L. 505) came before the House of Lords, the opinion of the judges being taken, Parke, B., acknowledged the error into which the Court had fallen, and approved of *Stevens v. Keating* (2 Ex. R. 772).

Intention immaterial.

In *Stead v. Anderson* (1847, 2 Web. P. C. 156), 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 is taken to have notice of a patent in the same way that he is taken to be aware of the law (*d*).

Patent is notice to whole world.

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 (*e*).

In *M'Cormick v. Gray* (1862, 31 L. J. Ex. 42) the specification, after describing several parts of reaping machines,

(*d*) And see *Wright v. Hitchcock*, Jur. N. S. 954; 13 W. R. 18; 1870, L. R. 5 Ex. 48; *Young v. Saccharin Corporation v. Reitmeyer Rosenthal*, 1884, 1 P. O. R. 39.

(*e*) *Newall v. Elliott*, 1864, 10

& Co., 1900, 17 P. O. R. 612.



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

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.

To prove infringement, it must be shown that there is a substantial resemblance. The infringement must be of a part for which the patent was granted, and not merely of a part described in the specification. (See *infra*.)

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.

(*f*) See p. 294, post.

(*g*) See, however, *Bancroft v.*

*Warden*, Romilly's Notes of Cases, 103.

In *Nobel's Explosives Co. v. Anderson* (1894, 11 P. O. R. 127), Romer, J., said: "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 (1894, 11 P. O. R. 527), Kay, L.J., in his judgment, said: "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* (1837, 1 Web. P. C. 145), 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 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* (1841, 1 Web. P. C. 355; 8 M. & W. 820), 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

Two main  
classes of  
invention.



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* (1885, 2 P. O. R. 91), 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* (1889, 6 P. O. R. 304). 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* (1887, 4 P. O. R. 333). 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 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" (*h*).

(*h*) And see *The Ticket Punch Register v. Colley's Patents, Ltd.*, 1895, 13 P. O. R. 9.

In *Curtis v. Platt* (1863, L. R. 3 C. D. 136, n.), 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 (*i*), and that when the invention is merely for an improved mode of attaining an old object the pith of his invention is that particular improved method, and only by making use of that particular method will a man be held to have infringed; 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 (*k*); 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.

(*i*) *Clark v. Adie*, 1877, L. R. 2 App. Cas. 320; *Nordenfeldt v. Gardner*, 1834, 1 P. O. R. 65; *Proctor v. Bennis*, 1887, 4 P. O. R. 345; *Wenham Gas Co. v. Champion Gas Co.*, 9 P. O. R. 55, 56; and see note (*h*).  
 (*k*) *Proctor v. Bennis*, 1887, 4 P. O. R. 359.



A question  
of subject-  
matter.

There is no distinction whatever in principle between the two classes of cases. The question is invariably: "What is the subject-matter of the invention?" (1). If the invention is the new result, it is not for the means of producing it only; on the other hand, if the invention is a new means of producing an old result, only substantial imitation of those means will infringe. (See Chapter IV. "Subject-matter.")

The kinds of invention which fall within the class of which *Proctor v. Bennis* is a type, sometimes called "pioneer" or master patents, and to which a wide construction will be given, are—

- (1) A new principle coupled with a method of application.
- (2) A new machine, material, or process for a new purpose.

The *Curtis v. Platt* type, in which a narrow construction will be given, are—

- (1) The novel application of an old principle.
- (2) A new machine, material, or process for an old purpose.
- (3) An old machine for a new purpose.

"Combination" patents will be considered later. Whether they fall within the wide construction or the narrow construction class depends on the circumstances of each case, and the fact that they are combinations is immaterial on the question of principle. In order to ascertain what the subject-matter of the invention is, it is necessary to construe the specification having regard to the state of knowledge in the trade at the time of the

(1) *Curtis v. Platt*, 1863, L. R. 3 Ch. D. 135, 136; *Wenham Gas Lamp Co. v. Champion Gas Lamp Co.*, 1884, 1 P. O. R. 53; *Proctor v. Bennis*, 1887, 4 P. O. R. 354; *Ehrlich v. Ihlee*, 1888, 5 P. O. R. 453; *Automatic Weighing Machine Co. v. Knight*, 1889, 6 P. O. R. 304; *Thompson v. Moore*, 1889, 6 P. O. R. 455; *Tweedale v. Ashworth*, 1890-92, 7 P. O. R. 434; 8 P. O. R. 57; 9 P. O. R. 126; *Automatic Weighing Machine Co. v. National Exhibitions Association*, 1891, 8 P. O. R. 350; 9 P. O. R. 44; *Miller v.*

*Clyde Bridge Steel Co.*, 1892, 9 P. O. R. 478; *Ashworth v. Roberts*, 1892, 9 P. O. R. 311; *Nettlefolds v. Reynolds*, 1892, 9 P. O. R. 284; *The Incandescent Light Co. v. De Mare*, 1896, 13 P. O. R. 331; *Consolidated Car Heating Co. v. Carne*, L. R. 1903, A. C. 516; 20 P. O. R. 765; *Ashworth v. English Card Clothing Co.*, 1903, 20 P. O. R. 794; *British Vacuum Cleaners v. Suction Cleaners, Ltd.*, 1904, 21 P. O. R. 312; *Brown v. Hastie & Co.*, 1905, 22 P. O. R. 99; and many other cases.

invention. (See p. 283, post; and Chap. VII., on the specifications, p. 130.)

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

The principles that underlie the question of infringement, by taking a part only of the invention, were very fully and clearly considered by Mr. Justice Wills in *The Incandescent Gas Light Co. v. The De Mare Incandescent Gas Light System* (1896, 13 P. O. R. 330). In his judgment the learned judge deals with the means by which the relative importance of different parts of the invention, and consequently in what part the substance lies, is to be ascertained, as follows:—"In dealing with the question of construction, I have carefully avoided any reference to the relative importance of different parts of the invention. In dealing with the question of infringement, it is impossible not to consider them. Infringement is a question of fact for the jury, if there be one; and the question is not whether the substantial part of the process, said to be an infringement, has been taken from the specification; but the very different one, whether what is done, or proposed to be done, takes from the patentee the substance of his invention. What the thing invented is must be gathered from the specification alone, and the patentee cannot escape from the thing he has claimed as the standard, and the only standard with which to compare the alleged infringement, so as to see if it constitutes substantially the appropriation of the thing claimed. When, however, you come to make that comparison, how can you escape from considering the relative magnitude and value of the things taken and of those left or varied? It is seldom that the infringer does the thing, the whole thing, and nothing but the thing claimed by the specification. He always varies, adds, omits; and the only protection the patentee has in such a case lies, as has often been pointed out by

Improvement  
in infringe-  
ment im-  
material.

Infringement  
by taking a  
part only.

How relative  
importance is  
ascertained.

(*m*) *Neilson v. Harford*, 1841, 1 Web. P. C. 310; *Ehrlich v. Ihlee*, 1888, 5 P. O. R. 454; *Thomson v. Moore*, 1889, 6 P. O. R. 436; *Wenham Gas Co. v. Champion Gas Co.*, 1892, 9 P. O. R. 55; *Birmingham*

*Tyre Syndicate v. Reliance Tyre Co.*, 1902, 19 P. O. R. 316; *Pilkington v. Massey*, 1904, 21 P. O. R. 437; *United Telephone Co. v. Harrison*, 1882, 21 C. D. 741.



every Court, from the House of Lords downwards, in the good sense of the tribunal which has to decide whether the substance of the invention has been pirated. It is contended by the defendants that what is important, and what is of subsidiary consequence, can only be gathered from the specification itself. I am satisfied that that neither is nor can be the law. . . . There are no means of ascertaining whether, notwithstanding additions or subtractions, the invention has been taken, except by seeing what they are worth as compared with the things which have been taken bodily from the invention." The earlier authorities of *Clark v. Adie* and *Proctor v. Bennis* were then analysed in detail. In saying that the relative importance of parts of the invention is to be ascertained as a question of fact and by means outside a direct reference to the specification, the learned judge was clearly referring to cases in which the patentee has not given any indication of what he considers essential. But where the patentee has expressly claimed some specific means of accomplishing an object, he will be tied down to that means (n).

The question of relative importance, therefore, remains one of fact to be decided on evidence.

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" (o).

Any one  
claim may  
be infringed.

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* (1839, 9 C. & P. 336; 1 Web. P. C. 270), 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

(n) See *Bunge v. Higginbotham*, 1901, 18 P. O. R. 206; 1902, 19 P. O. R. 199; see p. 283, *infra*.

(o) Per Turner, V.-C., in *Cald-*

*well v. Vanvlissengen*, 1851, 9 Haro, 428; *Newton v. Grand Junction Railway Co.*, 1846, 5 Exch. 331; 20 L. J. Ex. 427, n.

them all.” But it must be remembered that what is protected is what is claimed, and not all that is described. As Lord Justice Romer said, in *Nobel's Explosives Co. v. Anderson* (1894, P. O. R. 128): “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.” Only claims to be infringed.

Lord Alverstone, L.C.J., in *The Presto Gear Case and Components Co. v. Orme, Evans & Co.* (1901, 18 P. O. R. 23), said: “In patent cases I have always felt that there is a line of thought which is most likely to lead you to the right result in the speediest way. The first thing, assuming you understand the alphabet of the science or art, is to clearly understand what was the previous state of knowledge. Having got, either by agreement or deduction from the evidence, a clear view as to what was the previous state of knowledge, you must then construe the specification with reference to that, disregarding issues of novelty or subject-matter which may arise in the particular case, and you then have to consider whether or not the infringement comes within the fair meaning of the claims—not anything else, but the claims read in the light of the previous state of knowledge, and without altering the words unduly in favour of the patentee or infringer” (*p*).

The cases in which a claim for a combination is alleged to be infringed do not differ in general principles from any other kind of infringement. But they are liable to give rise to difficulty under either of the following circumstances:—(a) A part only of the combination may be taken; or (b) A mechanical or chemical equivalent may be substituted for a portion of the combination. Here, again, the questions to be asked are, “What is the subject-matter? *i.e.*, Is it the attainment of a new result, or is it the particular method described of obtaining an old Combination on same principle.

(*p*) And see *Jackson v. Wolstenhulmes*, 1884, 1 P. O. R. 108; and p. 287, *infra*.



Patentee  
bound to his  
invention as  
described.

result?" And further, "What is the substance of the combination as expressly limited?" The answer to the first question will determine the latitude that is to be shown the inventor in respect of the means employed to carry out his idea, and is a question of fact (q). The answer to the second is to be found in the specification and claims, applying the rules of construction sketched by Lord Alverstone in *The Presto Gear Case and Components Co. v. Orme, Evans & Co.* (supra). In *Bunge v. Higginbotham* (1901, 18 P. O. R. 206; 1902, 19 P. O. R. 199), Kekewich, J., said on this point of the substance of the combination: "But in order to ascertain whether any part of the combination, which is absent in the alleged infringement, can be dispensed with so as still to hold the latter to be an infringement, one must go back to the specification, and one must hear what the patentee himself has said about it. . . . You must find whether he considers the one part which has not been taken to be an integral part of his invention, or perhaps it would be better to say an essential part of his invention."

In *Sellers v. Dickenson* (1850, 5 Ex. 324), Pollock, C.B., 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."

There may be  
an essence  
underlying  
form.

In *Clark v. Adie* (1875, 10 Ch. 675), Lord Justice James said: "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 sub-

(q) See *Lister v. Leather*, 1858, 27 L. J. Q. B. 296.

stance and effect, or is a substantially new or different combination." And when the same case reached the House of Lords (1877, 2 A. C. 320), Lord Cairns, L.C., said: "The infringer might not take the whole of the instrument here described . . . . And it might well be, that if the instrument patented consisted of twelve different steps, producing in the result the improved clipper, an infringer who took eight or nine or ten of those steps might be held by the tribunal judging of the patent to have taken in substance the pith and marrow of the invention, although there were one, two, three, four, or five steps which he might not actually have taken and represented on his machine."

In *Nordenfjelt v. Gardner* (1884, 1 P. O. R. 65), 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 infringement (r). 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

Analysis of infringement of combination.

Addition.

Subtraction.

(r) See also *Murray v. Clayton*, 1872, L. R. 7 Ch. 585; *Badische Anilin und Soda Fabrik v. Levinstein*, 1885, L. R. 24 Ch. D. 156, 175; 2 P. O. R. 93; *Kaye v. Chubb*, 1888, 5 P. O. R. 651; *Thomeon v. Moore*, 1889, 6 P. O. R. 426; and see note (b), p. 290, post.



Substitution. 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 (*s*). Since there can be no patent for the external form or design of an element of mechanism apart from the use to which it is applied, although an inventor is not bound to give out a complete list of the advantages which his invention may possess. 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 (*t*).

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 which it was applied in the patent, does not infringe the patent (*u*).

Invention  
must be  
claimed.

We have seen that sect. 5, sub-sect. 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

(*s*) *Newton v. Vaucher*, 1852, 6 Exch. 859; 21 L. J. Ex. 308; see also *Morewood v. Tupper*, 3 C. L. Rep. 718; *Preston Davies v. Black*, 1894, 11 P. O. R. 574.

(*t*) *Cannington v. Nuttall*, 1871, L. R. 5 H. L. 205, 230.

(*u*) *Lister v. Eastwood*, 1855, 9 L. T. N. S. 766.

have infringed, directly or indirectly, a part or parts of the claim. Bowen, L.J., in *Jackson v. Wolstenhulmes* (1884, 1 P. O. R. 108), said: "It must be remembered that claims are for the security of patentees, to prevent it being said that the patentee has claimed more than can be really supported as his invention."

An interesting case of an inventor limiting himself by his claim to something narrower than he had actually invented, and thereby failing to catch an infringer, is to be found in *The Incandescent Gas Light Co. v. The Sunlight Incandescent Gas Lamp Co.* (1896, 13 P. O. R. 345). The real nature of the discovery was that a skeleton of earthy oxides could be produced, which, when suspended in a Bunsen flame, formed an illuminant. The claim, however, was limited to the manufacture of such a skeleton of certain specified materials, and in a certain specified manner. The defendant skilfully avoided the patent by making use of the principle, but producing the skeleton of different substances, and manufacturing in a different manner.

The jury will always have to consider whether the infringing machine, process, or combination is a substantial imitation. No fine lines can be drawn as to what amounts to substantial imitation. In *Clark v. Adie* (1873, L. R. 2 A. C. 335), 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* (1858, 8 E. & B. 1004; 27 L. J. Q. B. 296), 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*, 1864, 12 W. R. 723), 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."

Substantial  
imitation.



In *Parke v. Stevens* (1869, L. R. 8 Eq. 366), 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 startling proposition: that a patent for a combination or arrangement would be a distinct patent for everything that was new 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?" (x). This judgment was affirmed on appeal (y).

Combination  
for old  
object.

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 (z).

Fraudulent  
evasion.

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.

(x) See also *Wright v. Hitchcock*, 1870, L. R. 5 Ex. 49; *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*, 1889, 6 P. O. R. 563.

(y) L. R. 5 Ch. 36.

(z) *Curtis v. Platt*, in the House of Lords, 35 L. J. Ch. 852; L. R. 1 H. L. 337. See also the judgment of Vaughan Williams, J., in *Automatic Weighing Machine Co. v. National Exhibition Co.*, 1891, 8 P. O. R. 350.

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; and therefore the question will be, whether the mode of working by the defendant has or has not been essentially or substantially different?" (a).

In *Dudgeon v. Thompson* (1877, L. R. 3 A. C. 44), 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 of 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

(a) Per Dallas, J., in *Hill v. Thompson*, 1818, 1 Web. P. C. 242.



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

**Equivalents.**

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. A great deal of confusion has been caused by misunderstanding the term “mechanical equivalent.” As has been pointed out many times, the question is always, “What is the invention?” And the use of a mechanical equivalent for that which the plaintiff has invented, which at the time of the act complained of is known as an equivalent, is always an infringement (*c*). It is not true to say that “the doctrine of mechanical equivalents does not apply in the *Curtis v. Platt* type of cases.” A patent which did not cover all known mechanical equivalents would be void for want of invention. The narrowest claim for a particular means of attaining an old ultimate result may be infringed by the use of a mechanical or chemical equivalent, *i.e.*, an obvious method of carrying out the same invention, a method which a skilled mechanic or chemist, having once seen the original invention, could at once suggest and apply without the necessity for any inventive power whatever. The confusion has arisen partly because the word “result” has been loosely applied, sometimes to the ultimate result, and sometimes to the new effect immediately produced by the invention. In

**Confusion on this point.**

(*b*) *Thorn v. The Worthing Skating Rink Co.*, 1876, L. R. 6 Ch. D. 415. And the older cases, *Bovill v. Moore*, 1815, Dav. P. C. 405; *Morgan v. Seaward*, 1836, per Alderson, B., 1 Web. P. C. 171; *Walton v. Potter*, 1841, 1 Web. P. C. 586; *Walton v. Bateman*, 1842, per Cresswell, J., 1 Web. P. C. 616;

*Muntz v. Foster*, 1844, per Tindal, C. J., 2 Web. P. C. 101; *Gamble v. Kurtz*, 1846, 3 C. B. 434; *Unwin v. Heath*, 1854, 25 L. J. C. P. 11; *Murray v. Clayton*, 1872, L. R. 7 Ch. App. Cas. 585.

(*c*) See *Bunge v. Higginbotham*, 1902, 19 P. O. R. 196.

this latter sense all inventions must produce a new result, or they would fail for want of utility. Another cause of confusion has been the often overlooked fact that things may be mechanical equivalents for many purposes, and yet not for the purpose immediately at hand. A fire-tongs is in many aspects the mechanical equivalent of a dental forceps, but not for the purpose of extracting teeth. Sulphuric acid is a chemical equivalent for nitric acid as far as the reddening of litmus is concerned, but is far from an equivalent in the manufacture of explosives. Another reason is that in patents which are for the special construction described, infringement is rarely disputed, and the main question to be decided is validity. Equivalents may be substituted for parts as well as for the whole invention, so that it may happen that a patent may be taken out which consists of three parts, and 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* (1847, 2 Web. P. C. 181). 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 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* (1834, 1 Web. P. C. 462) 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.

Unknown  
equivalents.

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* (1894, 11 P. O. R. 115), the object of the invention was the production of an explosive suitable for propelling projectiles, in the use of which explosive perfect combustion might be obtained. The patentee in his specification confined his claim to 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 and the House of Lords, 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 (at p. 127): "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 in *Unwin v. Heath* (1855, 2 Web. P. C. 314).)

Taking out a patent for a process or machine that infringes a prior patent does not in itself amount to infringement (*d*); 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.

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. In *Sykes v. Howarth* (1879, L. R. 12 Ch. D. 826) the invention consisted in 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.”

Infringement  
by agents  
and servants.

But actions against mere workmen who innocently help in an infringement, and are not the really guilty persons, will not be encouraged (*e*).

We have seen that it is an infringement to colourably imitate an invention. It is no infringement to make, use, or vend the

(*d*) *Tweedale v. Ashworth*, 1890,  
7 P. O. R. 431.

(*e*) See *Savage v. Brindle*, 1896,  
13 P. O. R. 267.



elements which afterwards enter into the combination. In *Townsend v. Haworth* (1875, L. R. 12 Ch. D. 831, n.) (*f*), 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."

In *The Dunlop Pneumatic Tyre Co. v. Moseley* (1904, 21 P. O. R. 278), the patent was for a pneumatic tyre cover, held on to the rim of the wheel by wires passed through circumferential pockets in the edges of the cover. The defendants made and sold covers only, fitted with pockets, but without wires, and advertised them as "ready for wires." There was no other evidence to connect the defendants with the persons who purchased the covers and fitted the wires. It was held, following *Townsend v. Haworth*, and after an elaborate review of the authorities, that this did not constitute infringement.

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

But ALL  
constituent  
parts.

Repairs.

These points are of material importance when it is alleged that the patent has been infringed by what amounts to the

(*f*) See also *McCormick v. Gray*, 1884, L. R. 25 Ch. D. 782; and see 1861, 7 H. & N. 25; 31 L. J. Ex. 46; *Sykes v. Howarth*, supra. *Dunlop Pneumatic Tyre Co. v. Moseley*, 1904, 21 P. O. R. at

(*g*) *United Telephone Co. v. Dale*, p. 278.

manufacture of a new article under the guise of repairing an old article which has been made under the patent. The tests by which such cases may be decided was enunciated by Kekewich, J., in *The Dunlop Pneumatic Tyre Co. v. The Holborn Tyre Co.* (1901, 18 P. O. R. 226): "There are two tests which might equally well be applied to this question on the evidence. The first test would be this: In the alleged repair, has the workman so employed the patent as that in doing it he has taken an essential part of the patent and infringed it? . . . . . But there is another test which, but for the existence of the patent, one would employ, and which I think is the real and most satisfactory test to employ now, and that is this: Is it substantially, in common parlance, honestly, a new article or is it an old article repaired?" And for a case on the facts alone, see *The Dunlop Pneumatic Tyre Co. v. Excelsior Tyre Co.* (1901, 18 P. O. R. 226).

In *Kelly v. Batchelar* (1893, 10 P. O. R. 289) 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 (*h*).

Instructions  
of plaintiff  
negative  
infringe-  
ment.

In *The Dunlop Pneumatic Tyre Co. v. Neal* (1899, 16 P. O. R. 250), the agent of the plaintiffs was sent to the defendant to ask him to repair an old tyre, the subject of the plaintiffs' patent, with a view to ascertaining whether the defendant was infringing the patent by purporting merely to repair tyres.

(*h*) Also *Henser v. Hardie*, 1894, 11 P. O. R. 427.



The agent gave no express instructions as to what was to be done to the worn tyres beyond saying that they were to be repaired. It was held that what was done by the defendant amounted to infringement, and that he could not shelter himself behind any instructions from the plaintiffs' agent.

Experiments  
do not  
infringe.

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* (1832, 1 Web. P. C. 132), Patteson, J., 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 *Frearson v. Loe* (1878, 9 C. D. 66), 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 *bonâ 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 a 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" (i).

To purchase infringing articles for the purpose of instructing pupils and to enable them to pull them to pieces and put them

(i) See also *Mantz v. Foster*, 1844, 2 Web. P. C. 101; *Proctor v. Bayley*, 1889, 6 P. O. R. 109.

together again, is not mere experimental user, and amounts to infringement (*k*).

The grant confers the sole right to “make, use, exercise, and vend” the invention, and by the words of the prohibition the subject is commanded to refrain from “making use of or putting in practice” the said invention. There are a number of cases which have been decided upon the meaning of these words, and they are principally concerned with instances where the defendant has certainly derived advantage from the invention, and yet it would be difficult to say that he had been guilty of making or vending.

In *Gibson v. Brand* (1842, 4 M. & G. 196), 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 *The Saccharin Corporation v. Reitmeier & Co.* (1900, 17 P. O. R. 611), the facts were as follows: The defendant, while in England, contracted with persons in England for the delivery to them at a foreign port of goods manufactured on the continent by a process similar to that protected by the plaintiff’s English patent. Cozens-Hardy, J., said: “Now it is plain that a patent is of local force . . . . it is admitted that the defendant has not ‘made’ or ‘used,’ and I think it is clear that he has not ‘vended’ within the jurisdiction (see *Budische Anilin Co. v. Basle Chemical Works*, 1898, A. C. 200). It is said, however, that he has ‘exercised’ the invention within the jurisdiction. It is remarkable that this word, which has been found in letters patent at least since 1621, so far as I am aware, has never been construed. I think, however, that it can only mean ‘put in practice.’ I do not think it can be taken to cover a transaction such as I have to deal with. The defendant, as a commission agent, contracted for delivery to the purchasers at a

(*k*) *United Telephone Co. v. Sharpley*, 1885, L. R. 29 Ch. D. 164; 2 P. O. R. 28.



German port. He had no interest whatever in the case when delivered at the foreign port to the purchasers. He had no right to control its destination. I assume that he knew or suspected that the greater part of the stuff would find its way into this country, but I cannot regard that as material."

It does not appear, as far as the report goes, that the attention of the learned judge was called to the case of *Gibson v. Brand* (supra).

In *The United Telephone Co. v. Sharples* (1885, 2 P. O. R. 31), 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."

In *The British Motor Syndicate v. Taylor* (1900, 17 P. O. R. 192, 727), the defendants bought in England twenty-seven infringing articles; they sold seven of them and used another in England. As regards the remaining nineteen, they sent them abroad to their French house in Paris, where they sold them to various foreign firms. The question was whether there had been an infringement in respect of these nineteen. Stirling, J., decided that this was "making use of" the invention, and that the words "make use of" have a wider significance than the words "put in practice." The learned judge said: "In the present case the patented articles, when being transported from place to place in this country, were not serving the purpose for which they were patented, and in my opinion the defendants did not, during that transporting, exercise or put in practice the patented invention. What the defendants did was to carry these articles out of the kingdom with a view to selling them; that is, with the object of turning them to profitable account." He then refers to the doubt expressed by Lord Herschell in *The Badische Anilin und Soda Fabrik v. Johnson & Co.* (L. R. 1898, A. C. 200), as to whether the mere transporting of articles was

"Use" wider  
than  
"exercise."

an infringement; quotes Lord Justice James in *Von Heyden v. Neustadt* (L. R. 14 C. D. 230), and Kay, J., in *United Telephone Co. v. Sharples* (L. R. 29 C. D. 164), and then says: "Now the first meaning which is assigned to the word 'use' in Johnson's Dictionary is 'to employ to any purpose.' It is, therefore, a word of wide signification. It seems to me that the terms 'use,' 'make use of,' are intended to have a wider application than the words 'exercise,' or 'put in practice'; and without saying that no limit is to be placed on the two former expressions in the patent, I think, on the best consideration that I can give, that they are not confined to the use of the patented article for the purpose for which it is patented."

When this case went to the Court of Appeal, however, Lord Alverstone, L.C.J., while upholding the judgment, said, in referring to the remarks of Lord Herschell in *Badische Anilin Case*: "In my opinion, the question of whether there is infringement by transporting from place to place depends entirely upon what is protected by the letters patent and what is the nature of the invention which has been used; and, speaking for myself, I should equally wish to reserve consideration of that point. There may be transportation which would be no infringement; there may be transportation, as in *Neilson v. Betts*, which undoubtedly would involve infringement."

The mere possession of a patented article may amount to user, if the defendant has put the invention to the purpose for which it was intended. User by possession.

In the case of *Neilson v. Betts* (1871, L. R. 5 H. L. 1), 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. Neilson 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 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.* (1881, 17 C. D. 732) 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 (1).

(1) See also *The Universities of Oxford and Cambridge v. Richardson*, 6 Ves. 689; *The Dunlop Pneumatic Tyre Co. v. British and Colonial Motor Car Co.*, 1901, 18 P. O. R. 315.

In the case of *Caldwell v. Vanlissengen* (1852, 21 L. J. Ships. Ch. 97), 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 merely affixed to the bottles, and the other when merely in possession. Subject to the applicability of the arguments adduced in the case of the capsules and dynamite, it is submitted that mere possession, unaccompanied with user, does not constitute an infringement of letters patent. But in *The United Telephone Co. v. The London Globe Telephone Co.* (1884, L. R. 26 C. D. 766), Bacon, V.-C., said: "That the defendants are in possession of instruments made in infringement of the plaintiffs' 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 this case, however, the evidence pointed strongly to an intention to use, and the injunction was granted on that account.

Threat to use  
justifies  
injunction.

In the case of *Adair v. Young* (1877, 12 C. D. 13), 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 (*m*).

Use for  
different  
purpose.

The use of an invention for a different purpose from that disclosed in the specification will amount to an infringement of the patent which has been granted for that invention (*n*); 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 (*o*).

Foreign  
vessels.

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 (*p*).

(*m*) *Proctor v. Bayley*, 6 P. O. R. 538; and see further on this point of injunction, Ch. XVIII.

(*n*) *Edison v. Holland*, 1888, 5 P. O. R. 459, 482; also *Cannington v. Nuttall*, 1871, L. R. 5 H. L. 205, 230.

(*o*) *Fletcher v. Glasgow Gas Commissioners*, 1887, 4 P. O. R. 386; *Preston Davies v. Black*, 1894, 11 P. O. R. 299, 574.

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

In the case of *Nobel's Explosives Co. v. Jones and Scott* (L. R. 8 A. C. 5), mentioned above at p. 300, 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 person infringes a patent by aiding or abetting, so to speak, another to do so. There must be some actual infringement on the part of the defendant (*q*).

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 (*r*).

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. Sale—

Lending is not selling (*s*).

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.

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. (See p. 299, *supra*.)

The possession of the patented article, combined with exposure for sale, even if no sale is in fact effected, may be an infringement, as a form of user (*t*).

(*q*) See also *Townsend v. Haworth*, 1875, L. R. 12 Ch. D. 831, n.; *Sykes v. Howarth*, 1879, L. R. 12 Ch. D. 826; *Badische Anilin und Soda Fabrik v. Johnson*, 1897, 14 P. O. R. 413.

(*r*) *Washburn and Moen Manufacturing Co. v. Cunard Steamship*

*Co.*, 1889, 6 P. O. R. 398, 403; see also *Upmann v. Elkan*, 1869, L. R. 7 Ch. 130.

(*s*) *United Telephone Co. v. Henry*, 1885, 2 P. O. R. 11; Griff. P. C. 228.

(*t*) *The British Motor Syndicate v. Taylor*, 1900, 17 P. O. R. 729;



of article  
when process  
is patented.

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* (1869, L. R. 9 Eq. 222) Sir W. M. James, V.-C., 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 distinguished from rolled tinfoil without a license 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" (u).

Onus of proof  
in this case.

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 (x).

In the various *Saccharin Cases* (x), the plaintiffs were the owners of patents which covered all known processes of making saccharin. They were able to produce evidence to the effect that

disapproving *Minter v. Williams*,  
1 Web. P. C. 135.

(u) See also *Wright v. Hitchcock*,  
1870, L. R. 5 Ex. 37; 39 L. J. Ex.  
97; also *Von Heyden v. Neustadt*,  
1878, L. R. 14 Ch. D. 230; *The  
Cartsburn Sugar Refining Co. v.  
Sharp*, 1884, 1 P. O. R. 181, 186;  
*Saccharin Corporation v. Anglo-*

*Continental Chemical Works, Ltd.*,  
1900, 17 P. O. R. 318.

(x) *Neilson v. Betts*, 1871, L. R.  
5 H. L. 1, 11; *Saccharin Corpora-  
tion v. Dawson*, 1902, 19 P. O. R.  
169; *Saccharin Corporation v. Jack-  
son*, 1903, 20 P. O. R. 616; and see  
p. 320, *infra*.

although it might be conceivable to make saccharin in some other way, no other processes were known to the scientific world. The defendants, who imported saccharin, could never give any satisfactory account of the way in which the imported substance was actually made. It was held that infringement had been made out.

But, in *The Cartsburn Sugar Refining Co. v. Sharp* (1884, 1 P. O. R. 186), 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 plaintiff's 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 (*y*).

(*y*) *Townsend v. Haworth*, 1875, L. R. 12 Ch. D. 831; *Sykes v. Howarth*, 1879, L. R. 12 Ch. D. 826; and see pp. 293, 294, ante.



Effect of sale  
by patentee.

A patentee selling the patented article without limitation 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 Hatherley, in *Betts v. Willmott* (1871, L. R. 6 Ch. 245), said: "Unless it can be shown, not that there is some clear injunction to his agents, but that there is some clear communication to the party to whom the article is sold, I apprehend that 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 license 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 license 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 license to the plaintiffs to manufacture under their invention in Belgium but not elsewhere, and the plaintiffs under this license 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 license to use the patent in Belgium did not imply permission to sell the manufactured article in England in violation of the defendants' English patent (z).

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 (a). In this case the sale of the article can only imply such license 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

(z) *Société Anonyme des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.*, 1883, L. R. 25 Ch. D. 1, 7.

(a) See the rule laid down in *Caldwell v. Vanvlissengen*, 1851, 9 Hare, 415.

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 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 (*b*).

A patentee may attach conditions to the user of a patented article, and, provided that his attention is called to the conditions, as by a conspicuous label or otherwise, any purchaser is bound by them. In *The Incandescent Light Co. v. Cantelo* (1895, 12 P. O. R. 264), and *The Same v. Brogden* (1899, 16 P. O. R. 183), the plaintiffs were the owners of patents for incandescent mantles. Every mantle sold by them was inclosed in a box, and on this box was printed a warning that the mantle was only licensed to be used on special gas burners of the plaintiffs' manufacture, and that use on any other burner would be an infringement. The defendants bought, used, and sold mantles in connection with burners other than those specified. In the first mentioned case it was held that if the defendant had known of the conditions there would have been infringement, but that the plaintiffs had newly started their system, and that at the time of the purchase he was not aware of the conditions. In the second case it was shown that at the time of purchasing the defendant knew of the conditions, and that, therefore, there was infringement.

Limited  
license.

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 (*c*), and where the licensee is restricted in his use of the patented article, 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* (1888, 5 P. O. R. 603; 6 P. O. R. 495), the patentee granted to the plaintiff an exclusive license

(*b*) *Betts v. Willmott*, 1871, L. R. 6 Ch. 239.

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



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 license for that district, since they had no notice of its existence.

In the course of his judgment Bristowe, V.-C., said (5 P. O. R. 610) : “ 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.”

In *Monforts v. Marsden* (1895, 12 P. O. R. 268), it was decided that the sale of an article does not imply any warranty that the article sold is not an infringement of an existing patent.

But ignorance in the absence of an implied license, as in the cases 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.

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.

The Crown  
bound.

When the persons using the invention were servants of the 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 (*d*).

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 (see p. 15, ante).

(*d*) *Dixon v. The London Small Arms Co.*, 1875, L. R. 10 Q. B. 130, and L. R. 1 App. Cas. 632, reversing decision of the Court of Appeal, L. R. 1 Q. B. D. 384 ; also *Feather v. R.*, 1865, 6 B. & S. 257.

## CHAPTER XVII.

## THE PARTIES TO AN 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.

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 have acquired the right by assignment of two separate moieties, and the party sued be the original grantee (*b*). Plaintiffs.

The assignee of a portion of a patent may sue for an infringement of that part. Erle, C.J., in giving judgment in *Dannicliff v. Mallett* (7 C. B. N. S. 209), 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 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

(*a*) *Electric Telegraph Co. v. Brett*, 1850, 10 C. B. 838; 20 L. J. C. P. 123.      (*b*) *Walton v. Lavater*, 1842, 8 C. B. N. S. 162; 29 L. J. C. P. 275.



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.

Whether the assignment must be registered before the assignee can sue is a question which has not been settled (c). But as there is no difficulty in effecting registration at any time this point need not give trouble.

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* (1835, 1 Web. P. C. 155) (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).

(c) See on the Act of 1852, *Chollett v. Hoffman*, 1857, 7 E. & B. 686; *Hassall v. Wright*, 1870, L. R. 10 Eq. 509.

(d) *Sheehan v. Great Eastern Railway Co.*, 1881, L. R. 16 Ch. D.

59; *Dent v. Turpin*, 2 J. & H. 139.

(e) See also *Heap v. Hartley*, 1889, 6 P. O. R. 495.

(f) *Renard v. Levinstein*, 1864, 11 L. T. N. S. 505.

A person having an equitable interest only is not "the patentee," and cannot sue without joining the legal owner (*g*).

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 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.

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, any person infringing is liable. When a **Defendants.** 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 (*m*). The directors of a company whose servants infringe an invention are personally liable (*n*).

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

(*g*) *Bowden's Syndicate v. Smith & Co.*, 1904, 21 P. O. R. 441.

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

(*i*) *Van Gelder v. Sowerby Bridge Flour Co.*, 1890, 7 P. O. R. 208.

(*k*) *Church's Patent*, 1886, 3 P. O. R. 95.

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

(*m*) *Betts v. De Vitre*, 1865, L. R. 3 Ch. 429; *Sykes v. Howarth*, 1871, L. R. 12 Ch. D. 826; *Whatman v. Pearson*, 1868, L. R. 3 C. P. 422.

(*n*) *Betts v. De Vitre*, 1865, L. R. 3 Ch. 429, 441; *Spencer v. Ancoats Rubber Co.*, 1889, 6 P. O. R. 46.

(*o*) *Denley v. Blore*, 1851, 3S Lond. Jour. 224.



Aliens infringing a patent in this country by vending or otherwise are liable if they come within the jurisdiction of the courts (*p*). 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. (*q*).

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 (*r*).

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 (*s*), 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 (*t*).

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 (*u*).

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 (*w*).

(*p*) *Caldwell v. Vanclissengen*, 1852, 9 Hare, 415; and see *Badische Anilin und Soda Fabrik v. Johnson*, 1897, 14 P. O. R. 413.

(*q*) *Gibson v. Brand*, 11 L. J. C. P. 177, 183; and see p. 297.

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

(*s*) *Edison v. Holland*, 1886, 3 P. O. R. 395.

(*t*) *Edison v. Holland*, 1889, 6 P. O. R. 243, 286.

(*u*) *Washburn and Moen Manufacturing Co. v. Cunard Steamship Co.*, 1889, 6 P. O. R. 398, 403.

(*w*) *Moser v. Marsden*, 1892, 9 P. O. R. 214.

## CHAPTER XVIII.

## THE REMEDY.

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 were made for the governing of the practice of the Courts 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. Injunction.

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 Infringement  
evidence of  
intention.



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 *Frearson v. Loe* (1878, L. R. 9 C. D. 65), 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* (1890, 7 P. O. R. 201), 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 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 *Frearson v. Loe* (supra).

But unless to support a claim for an injunction and for the purpose of showing that the defendant has an intention of infringing in the future, evidence of acts after action brought is inadmissible. In *The Welsbach Incandescent Gas Light Co. v. Dowle* (1899, 16 P.O.R. 395) the plaintiffs attempted to supplement their evidence of an actual infringement having taken place by means of evidence of such acts since the issue of the writ. Bruce, J., refused to admit the supplementary evidence.

Where what has been done since action brought is different in any way from what was done before, and is relied on as evidence of the intention to infringe, the defendant must have clear notice of the nature of the infringement which he is alleged to be contemplating. (See *Shoe Machinery Co. v. Cutlan*, 1895, 12 P. O. R. 357.)

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* (1837, 1 W. P. C. 200) 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* (M. Dig. 506) 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 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 (a).

(a) *Betts v. Willmott*, 1871, L. R. 6 Ch. 239.



In the case of *Adair v. Young* (1879, L. R. 12 C. D. 13), 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, 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* (1889, 6 P. O. R. 541). 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.-C., 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: "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 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?" (b)

Principle on which injunction granted.

On the same principle an action for an injunction may be brought against innocent carriers of infringing articles. In *Upmann v. Elkan* (1871, L. R. 7 Ch. 132) (c), 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

Injunction against carriers.

(b) Note also *Millington v. Fox*, 1838, 3 M. & Cr. 338; *Geary v. Norton*, 1846, 1 D. & S. 9; *Hudson v. Chatteris Engineering Co.*, 1898, 15 P. O. R. 438. (c) And see *Washburn and Moen Manufacturing Co. v. Cunard Steamship Co.*, 1889, 6 P. O. R. 398, 403.



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 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 (*d*).

Laches  
considered.

No injunction will be granted where the patentee has not proceeded with reasonable speed to prosecute infringers (*e*). 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 (*f*). 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

(*d*) *Washburn and Moen Manufacturing Co. v. Cunard Steamship Co.*, 1889, 6 P. O. R. 398, 403.

(*e*) *Losh v. Hague*, 1837, 1 Web. P. C. 201; *Bacon v. Jones*, 1839, 4 My. & Cr. 438, 439; *Bridson v.*

*Benecke*, 1849, 12 Beav. 1; *Barter v. Combe*, 1850, 1 Ir. Ch. R. 284; *Hancock v. Moulton*, 1852, M. Dig. 506.

(*f*) *Foxwell v. Webster*, 1863, 3 N. R. 103.

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" (g).

A question has arisen as to what should be done if, on an action against two defendants for the same infringement, one of them fails to appear. The defendant who appeared might succeed in establishing the invalidity of the patent, and the difficulty arises as to the position of the other defendant, since judgment for the defendant on the ground of invalidity is *inter partes* only, and does not affect the status of the patent.

On the whole, however, it may be said that injunction is an equitable remedy, and that it would be contrary to principle for the same tribunal which had pronounced a patent to be invalid to restrain a member of the public from doing what could not be an infringement.

In *Action Gesellschaft für Cartonagen Industrie v. Remus & Burgon* (1895, 12 P. O. R. 94), Chitty, J., refused to set down on motion for judgment against the defendant who had not delivered a defence, asking what would happen if the other defendant succeeded in upsetting the patent.

In *Savage v. Brindle and Another* (1900, 17 P. O. R. 233), a motion for judgment against one defendant stood over until the trial; after the hearing he consented to an injunction, but the other defendant succeeded in upsetting the patent. Farwell, J., granted the injunction asked for.

The general balance of convenience will be looked to in granting an injunction.

In *Hopkinson v. St. James and Pall Mall Electric Light Co.* (1893, 10 P. O. R. 62), 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.

In *The Leeds Forge Co. v. Deighton's Patent Flue Co.* (1901, 18 P. O. R. 240), the injunction was suspended pending an

(g) Per Sir W. Page-Wood, *v. Moulton*, 1852, M. Dig. 506; V.-C., *Bovill v. Crate*, 1865, L. R. *Smith v. L. & S. W. Rail. Co.*, 1854, 1 Eq. at p. 391. See also *Hancock Kay*, 408.

One defendant  
of two  
appearing.

General  
convenience  
considered.



appeal on the ground that to put it into force at once would throw a large number of workmen out of employment.

Expiry of injunction.

The injunction falls with the expiration of the patent (*h*), 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 (*i*).

In *Saccharin Corporation v. Dawson* (1902, 19 P. O. R. 172) and *The Same v. Jackson* (1903, 20 P. O. R. 616) the actions were brought upon several patents (see p. 304). It was impossible to say which patent had been infringed, but it was clear that one of them must have been. The injunction was granted for the life of the patent which would earliest expire.

Contempt.

A person against whom an injunction has been granted or who has given an undertaking in Court is liable to be committed should he be guilty of a breach of such injunction, or undertaking, and a person aiding and abetting such a person and with knowledge of the injunction is also guilty of contempt (*k*), but an application for committal, involving as it does the liberty of the subject, will require the strictest proof in its support (*l*).

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 (*m*).

Interlocutory injunction.

The interlocutory injunction stands very much upon the same footing, and will be granted for similar reasons upon the same conditions that an injunction was formerly awarded by the Court of Chancery when an action was directed to be tried at common law.

Where ex parte.

An interlocutory injunction may be granted *ex parte*, after the issue of the writ, and before service. An *ex parte* injunction

(*h*) *Daw v. Eley*, 1867, L. R. 3 Eq. 496.

(*i*) *Crossley v. Beverley*, 1829, 1 Web. P. C. 119; *Crossley v. The Derby Gas Light Co.*, 1834, 4 L. J. Ch. 25; see also *Price's Patent Candle Co. v. Bauwen's Patent*

*Candle Co.*, 1858, 4 K. & J. 727.

(*k*) *Incandescent Gas Light Co. v. Sluce*, 1900, 17 P. O. R. 175.

(*l*) *Dick v. Haslam*, 1891, 8 P. O. R. 196.

(*m*) *United Telephone Co. v. Dale*, 1884, L. R. 25 Ch. D. 778.

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 (*n*); and the Court will usually require the plaintiff to give a satisfactory undertaking that he will pay any damage that the defendant may suffer in the event of the latter being successful at the trial (*o*).

Notice of motion having been given, an interlocutory injunction will be granted after appearance, or leave may be given to serve notice of motion 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.”

The Judicature Act.

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.

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,

(*n*) *Gardner v. Broadbent*, 1856, 2 Jur. N. S. 1041.

(*o*) See *Moser v. Jones*, 1893, 10 P. O. R. 368.



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 subsect. 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.)

Only where patent is *prima facie* valid.

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.

What is *prima facie* validity.

Lord Eldon, in the case of the *Universities of Oxford and Cambridge v. Richardson* (1802, 6 Ves. 706), 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* (1856, 2 Jur. N. S. 1041), 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*."

Previous trial.

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 (*p*); and where the patentee has worked and enjoyed the patent for many years without dispute, an interlocutory in-

(*p*) *Dudgeon v. Thompson*, 1874, 30 L. T. N. S. 244; 22 W. R. 464; *Russell v. Crowley*, 1834, 2 Coop. Ch. Ca. 59, n.; *United Telephone Co. v. St. George*, 1886, 3 P. O. R. 33; *Moser v. Sewell*, 1893, 10 P. O. R. 365.

junction will be granted (*q*); so also where the defendant has admitted the validity of the patent (*r*), or is so placed in his relationship to the patentee as to be estopped from denying its validity (*s*).

In *Dudgeon v. Thompson* (1874, 30 L. T. N. S. 244), 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* (1857, 3 Jur. N. S. 358), 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 (*t*); 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 (*u*).

An interlocutory injunction is seldom granted in the case of a new patent (*r*), unless very strong evidence in support of the motion be adduced (*y*).

(*q*) *Dudgeon v. Thompson*, 1874, 30 L. T. N. S. 244; *Curtis v. Cutts*, 1839, 2 Coop. Ch. Ca. 60, n.; *Davenport v. Goldberg*, 1865, 2 H. & M. 282; *Muntz v. Foster*, 1843, 2 Web. P. C. 95; *Rothwell v. King*, 1886, 3 P. O. R. 379; *Huyward v. Pavement Light Co.*, 1886, Griff. P. C. 124.

(*r*) *Dircks v. Mellor*, 1845, 26 Lon. Journ. 268.

(*s*) *Dudgeon v. Thompson*, 1874, 30 L. T. N. S. 244; *Clarke v. Fergusson*, 1859, 1 Giff. 184.

(*t*) *Bickford v. Skewes*, 1837, 1 Web. P. C. 211; *Rothwell v. King*, 1886, 3 P. O. R. 379.

(*u*) *Plimpton v. Malcolmson*, 1875, 44 L. J. Ch. 257; L. R. 20 Eq. 38.

(*x*) *Caldwell v. Vanclissengen*, 1851, 9 Hare, 415, 424; *Renard v. Levinstein*, 1864, 10 L. T. N. S. 177; *Lister v. Norton*, 1884, 1 P. O. R. 114; *Jackson v. Needle*, 1884, 1 P. O. R. 174; *British Tanning Co. v. Groth*, 1890, 7 P. O. R. 1.

(*y*) *Gardner v. Broadbent*, 2 Jur.



In *Clarke v. Nichols* (1895, 12 P. O. R. 311) the patent was less than a year old. Notice of motion was served with the writ, but the defendant did not appear. The affidavit by the plaintiff stated that prior to the purchase of the patent he had caused a full investigation to be made into its validity by his patent agents, and that he was advised that it was valid, and to the best of his knowledge, information and belief, it was valid now. The injunction was granted.

In *Holophane, Ltd. v. Berend & Co.* (1898, 15 P. O. R. 19), Kekewich, J., said: "During the forty years over which my experience extends, and I think for a considerably longer period, the Court has acted on one uniform rule, subject, of course, to exceptions, in dealing with applications of this character. The rule, as I understand, is this: that where the proprietor of recently granted letters patent, the validity of which has not been established by legal process, seeks an injunction against an alleged infringer, the Court declines to interfere by interlocutory injunction and leaves the patentee to establish the validity by formal proceedings. Of course, forty years ago, the motion for injunction had to stand over while the validity of the patent was established at law. Fortunately we have got rid of that, and the injunction and the validity can all be determined and disposed of in one and the same action in one and the same Court; but the rule holds still. Of course, there are exceptions; it will not do for a defendant coming here as against the proprietors of letters patent simply to say, 'I challenge the validity.' There must be something more than that. The Court must be satisfied that there is an honest intention of trying the question; and not only an honest intention of trying the question, but that there is something to be tried."

If a certificate of validity has been granted in a previous action, it will not avail the defendant on an application for an interlocutory injunction to allege fresh grounds for invalidity (z).

Laches.

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

N. S. 1041; *Clarke v. Nichols*, 1895, 1904, 21 P. O. R. 513.  
 12 P. O. R. 310. (a) *Bovill v. Crate*, 1866, L. R. 1  
 (z) *Heine Solly & Co. v. Norden*, Eq. 388; *Greer v. Bristol Tanning*

In *The North British Rubber Co. v. The Gormully and Jeffery Co.* (1895, 12 P. O. R. 20), Chitty, J., said: "Now I am not aware, having regard to patents, that there is any substantial ground of distinction between an interlocutory injunction upon a patent right and upon any other. The principles appear to me to be substantially the same; and the general rule of the Court is that a person who comes to ask for that remedy, which is granted with despatch and for the purpose of protecting rights until the trial, should come promptly."

The amount of delay which will prevent the granting of an interlocutory injunction will, of course, vary with the nature of the patent and the circumstances of the trade.

The delay may, in some cases, be satisfactorily explained, and will not therefore be fatal (*b*).

Delay in proceeding against persons who are not parties to the application in question is no ground for refusing an injunction, if there has been no delay in proceeding against the defendant (*c*). Delay in proceeding against third parties.

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 (*d*). Balance of convenience.

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 (*e*), and the converse would equally appear.

The Court will not infrequently grant or refuse the injunction until the hearing upon terms; the terms on the plaintiff being Terms.

*Co.*, 1885, 2 P. O. R. 268, *Dunlop Pneumatic Tyre Co. v. Pneumatic Tyre Co.*, 1897, 14 P. O. R. 263; *The Aluminium Co. v. Domeiere*, 1898, 15 P. O. R. 32.

(*b*) *United Telephone Co. v. Equitable Telephone Co.*, 1888, 5 P. O. R. 233.

(*c*) *The Pneumatic Tyre Co. v. Warrilow*, 1896, 13 P. O. R. 286.

(*d*) *Walker v. Clarke*, 1887, 4 P.

O. R. 111; *Challender v. Royle*, 1887, 4 P. O. R. 563; *Thomson v. Hughes*, 1890, 7 P. O. R. 71; *Bracher v. Bracher*, 1890, 7 P. O. R. 420; *Kensington, &c. Electric Lighting Co. v. Lane Fox*, 1891, 8 P. O. R. 277; *Moser v. Sewell*, 1893, 10 P. O. R. 365, 367; *North British Rubber Co. v. Gormully and Jeffery Co.*, 1895, 12 P. O. R. 17.

(*e*) *Neilson v. Forman*, 1841, 2 Coop. Ch. Ca. 61, n.



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 (*f*). 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.

A very usual practice on these applications is for the motion to be ordered to stand over until the hearing, the defendant undertaking to keep an account.

In *Plimpton v. Spiller* (1876, L. R. 4 C. D. 289), 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

(*f*) *Newall v. Wilson*, 1852, 2 De G. M. & G. 282; *Bracher v. Bracher*, 1890, 7 P. O. R. 420.