

FORM OF DEFENCE IN A PATENT ACTION.

Mr. Christopher C. Robinson, K.C., in the course of his interesting and valuable article entitled "Defences in Infringement Actions under the Patent Act of 1923," in the February issue of THE CANADIAN BAR REVIEW, suggests the following as a proper form of statement of defence:

1. The defendant has not infringed the Letters Patent mentioned in the Statement of Claim.

2. The said Letters Patent are invalid for the reasons stated in the Particulars of Objections delivered herewith.

This form leaves all of the grounds upon which the contention of invalidity is based for inclusion in the particulars of objections. While there is, no doubt, authority for this form and it is frequently met with in practice, may I venture to suggest that it is, nevertheless, not, strictly speaking, good pleading. The general principle of pleading under the Judicature Act is, I think, well stated by Mr. Holmsted in the Fourth Edition of "The Ontario Judicature Act" at page 590:

"The system of pleading introduced by the Judicature Act, 1881, requires not the legal result of the facts, but the facts themselves, to be stated. A statement of claim, therefore, which merely alleged that a good and valid donatio mortis causa had been made to the plaintiff, without stating the facts which constituted it, was formerly held to be demurrable; so a statement that 'there was contributory negligence on the part of the plaintiff' is a statement of a conclusion of the law on a state of facts not set out."

Similarly, at page 591:

"All facts which are material to the plaintiff's claim should be stated in the claim and all the matters whether of law or fact relied on by way of defence should be stated in the defence or the omission of some material allegation by way of claim or defence may ultimately prove fatal to the litigant. There is no difference in the rules governing pleadings in actions respecting patents for inventions and other cases. The material facts are those which the party must prove to be fully and completely successful."

And, Halsbury says (Vol 22, p. 422):—

"It is and indeed always was bad pleading to state an inference or conclusion of law, without setting out the facts by which the conclusion or inference is to be supported."

It may be answered that, so long as the facts are given, it makes no material difference whether they are included in the statement of defence or in the particulars of objections; but while that is no doubt true, it does not, I submit, affect the question of what constitutes a

good pleading. The particulars of objections do not, as it seems to me, constitute a portion of the statement of defence, nor are they indeed a pleading at all. They are, on the contrary, something quite extraneous to, though supplemental of, the pleading.

Let us test the suggested form of pleading by applying it to other classes of actions. A plea in any action that the plaintiff was not entitled to sue, for the reasons stated in the particulars delivered therewith, would be obviously a bad plea. Yet is that not what the suggested plea amounts to? Let us take a more specific case. Suppose a plea in an action on a promissory note to the effect that the note was invalid, without alleging the grounds of invalidity. These grounds might be infancy, fraud, want of consideration, absence of stamps, etc. Could it be successfully contended that such a pleading complied with the rules, even though the words "for the reasons stated in the particulars delivered herewith" were added? Suppose these words were omitted and no particular served, would not the plaintiff's proper course be to move against the pleading, rather than to move for particulars?

With great respect, therefore, it seems to me that a better form of statement of defence, in so far as the question of the invalidity of the patent is concerned, would be as follows:

1. The defendant says that the Letters Patent mentioned in the plaintiff's statement of claim are and always have been void and of no effect for the reasons hereinafter set forth.

2. The said Letters Patent are not for any invention.

3. The said was not the first inventor of the invention covered by the said Letters Patent.

4. The alleged invention purporting to be covered by the said Letters Patent was not new at the time of the alleged invention thereof, etc., etc.

The particulars of objections under the above paragraphs might read somewhat as follows:

1. Under paragraph 2 of the statement of defence the defendant will show, in respect of the patent in suit,

- (a) that no new mental conception and no new application of any old conception, involving the exercise of inventive faculties on the part of the alleged inventor, was involved in the alleged invention;
- (b) that the alleged invention was a matter of common knowledge;
- (c) that there was no invention in view of the prior state of the art, as disclosed in the letters patent and other publications mentioned in the schedule hereto and as actually practised by the persons referred to in the schedule hereto.

2. Under paragraph 3 of the statement of defence the defendant will show, in respect of the patent in suit,

- (a) that the alleged invention was a matter of general common knowledge before the time when the alleged inventor claims to have made it;

- (b) that if there was an invention (which is not admitted) and if it was not a matter of general common knowledge, it was the invention of one or more of the various alleged inventors and other persons mentioned in the schedule hereto and in the letters patent and other publications in the said schedule set forth.

3. Under paragraph 4 of the statement of defence the defendant will show, in respect of the patent sued on, that the subject matter of the same was

- (a) described in the letters patent set forth in the schedule hereto and/or in the applications or petitions therefore and/or in the publications set forth in the schedule hereto;
- (b) known by and/or used by the persons whose names are set forth in the schedule hereto, as well as various other persons whose names and addresses are not at present known to the defendant, but of which the defendant craves leave to furnish particulars by proper amendment, when such names and addresses become known to it, etc., etc.

I am not basing any argument on the substance of these suggested paragraphs of the defence and particulars. They are merely given as illustrations of what I conceive to be satisfactory forms.

This form of defence is the one given in Odger (9th Edition, p. 459, Form 82), and in Fetherstonhaugh & Fox (p. 585). On the other hand, Terrell (5th Edition, p. 631) and Fisher & Smart (p. 252), give Mr. Robinson's form and Bullen & Leak (8th Edition, p. 925), and Frost (3rd Edition, pp. 391-392), give both forms.

I do not for a moment suggest that in this untechnical age and supported as it is by the authority of standard text books, Mr. Robinson's form could be successfully attacked. What I do say is that from an academic and scientific point of view, the longer form is preferable. I say this with more confidence fortified by the knowledge that this longer form is widely used by practitioners who are very extensively engaged in patent litigation.

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