

BETWEEN:

1939  
Jan. 5.  
—  
Jan. 11.  
—

THERMIONICS LIMITED ..... PLAINTIFF;  
AND  
PHILCO PRODUCTS LIMITED, }  
ET AL. .... } DEFENDANTS.

*Patent—Practice—Particulars—Order 53A, Rule 21A, of the Rules of the Supreme Court in England—Form of order.*

MOTION by plaintiff for directions. The action is one for a declaration that plaintiff's patent is valid and is infringed by the defendants.

The motion was argued before the Honourable Mr. Justice Maclean, President of the Court, at Ottawa.

*O. M. Biggar, K.C.* for the motion, contended that the order could be made under English Order 53A and Rule 21A of the Rules of the Supreme Court of England. He referred to *The Yearly Practice*, 1936, p. 1024, and cited the following authorities: *Fraser v. Simpsons* (1937) 54 R.P.C. 199; *Ultra Electric v. Barnes* (1937) 54 R.P.C. 269; *Eyres v. Grundy* (1938) 55 R.P.C. 149; *British Thomson-Houston v. Tungstalite* (1938) 55 R.P.C. 280; *Whatmough v. Morris* (1938) 4 All E. 584.

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*E. G. Gowling, contra*, contended that there was no equivalent to the English order in the Exchequer Court practice; that there is no authority under the Exchequer Court practice for making the directions asked for and that the English rule does not apply to this Court since the Exchequer Court Rules have certain provisions regarding particulars.

*Reporter's Note:* The form of order made in this case is reported as affecting the practice, and because it is the first made on these lines, but such will not necessarily be made in every patent case.

The President held that under the Exchequer Court Rules the Court could order the particulars, or the directions in the nature of further pleadings or particulars, and the inspection asked for in the draft order presented by the plaintiff. His Lordship remarked that in view of the highly technical character of this case and the difficulties it presented, this was an action in which an order as made was justified and proper, but that similar orders would not necessarily be made in all patent actions.

The following is part of the order as made:

Upon the application of counsel for plaintiff in presence of counsel for defendants, upon hearing read the notice of motion herein dated the 16th day of December, 1938, the affidavits of Melville B. Gordon, William Watson Richardson and Edward S. Peyton filed, and upon hearing what was alleged by counsel aforesaid,

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AND IT IS FURTHER ORDERED that the plaintiffs shall within three weeks from the date of this order deliver to the defendants a statement signed by counsel referring to each of the claims alleged to be infringed in each of the patents in question and

- (a) specifying the integers alleged to be comprised in such claim;
- (b) stating in the case of each integer whether the words in the claim denoting the same include every construction which, and only such constructions as, fall within the said words in their ordinary meaning when read apart from the body of the specification, or whether some, and if so what, limitation or extension is to be implied therein, and in such case stating the reasons for such implications;

(c) identifying the parts of each of the types of tubes referred to in the particulars of breaches with the corresponding integers specified in the claims.

2. The defendants shall within one month from the statement referred to in the last preceding clause deliver to the plaintiffs a statement signed by counsel specifying

- (a) The extent to which the defendants accept the contentions set forth in the plaintiffs' said statement, and in so far as the same are not accepted, stating the defendants' contentions in respect of each of the said matters;
- (b) in respect of each of the documents alleged in the particulars of objection to have been published prior to the date of each of the several inventions in the statement of claim mentioned, and relied upon by the defendants, the relevant integers alleged to be disclosed by each of the same, and in the case of each the part or parts thereof upon which the defendants rely;
- (c) the respects in which it is alleged that each of the several patents sued upon does not disclose any invention or that the construction disclosed was obvious and involved no inventive step;
- (d) the respects in which it is alleged that each of the several inventions described in the patent sued upon is not useful;
- (e) the respects in which it is alleged that the disclosure in each of the patents sued upon does not sufficiently or fairly describe the nature of the invention or the manner in which the same is to be performed, and the respects in which the directions contained in the said disclosure respectively are insufficient to show how an operable device may be constructed;
- (f) the respects in which it is alleged that each of the claims of each of the patents sued upon is incomplete, extends to more than was invented by the applicants for the said patents respectively or fails to state clearly and distinctly the scope of the monopoly asserted;
- (g) whether or not the defendants admit that the plaintiff was at the date of the filing of the statement of claim the legal owner of each of the several patents.

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3. The plaintiffs may within one month from the delivery of the defendants' statement in the last preceding clause referred to and at least fourteen days before the date fixed for the trial of this action deliver to the defendants a statement signed by counsel specifying the contentions upon which the plaintiffs intend to rely in rebuttal of the contentions made in the defendants' statement.

4. No amendment of any of the aforesaid statements shall be made except upon application to a judge and upon such terms as to costs and otherwise as may seem just.

5. Except by special leave of the judge at the trial
- (a) no models shall be put in evidence at the trial or evidence given of any experiment unless the party seeking to rely thereon shall have given notice thereof to the other party within four weeks from the date hereof and shall have offered to that party and his legal and technical advisers an opportunity of inspecting the said models and seeing the experiments or a repetition thereof performed;
  - (b) no evidence shall be given at the trial relating to any model or experiment made in answer to any models or experiments of the other party unless the party seeking to rely thereon shall have given notice thereof to the other party within seven weeks from the date hereof and shall have offered to that party and his legal and technical advisers an opportunity of inspecting any such models and seeing any such experiments or a repetition thereof performed;
  - (c) no evidence shall be adduced in support of any contention which is inconsistent with the statements directed to be made by the parties as aforesaid.

AND IT IS FURTHER ORDERED that the costs of this application be costs in the cause.