

(1934) 01 CAL CK 0006
In the Calcutta High Court

In Re.:National Carbon Co. Incorporated.

Date of Decision : 23-01-1934

Acts Referred:

Patents and Designs Act, 1911 — Section 118

Citation : AIR 1934 Cal 725 : 152 Ind. Cas. 914

Hon'ble Judges : Panckridge, J

Bench : Division Bench

Judgement

Panckridge, J.—The circumstances in which this Rule has been issued upon the National Carbon Company, Incorporated, and upon the Controller of Patents are as follows:

The National Carbon Company, Incorporated, carry on business in New York, where they manufacture and export dry cell batteries for flashlights and electric torches. They are the grantees of Indian Patent No. 17148 of 1930. In the specification, which was accepted on 8th December 1930, the invention is described as relating "to dry cells and particularly to improved means of closing and sealing such cells." I shall hereafter refer to the National Carbon Company, Incorporated, as "the patentees.

2. The Bright Star Battery Company are incorporated in the United States of America, and they also manufacture and export dry cell batteries for flashlights. They offer their goods for sale in India through Messrs. Brough & Co., a firm carrying on business in Bombay. In December 1931, the patentees instituted a suit on the original side of this Court against Messrs. Brough & Co., alleging that the batteries manufactured by the Bright Star Company were an infringement of their patent and claiming an injunction and damages. The defendants denied the infringement, and also put in issue the validity of the patent and raised certain objections to the specification and claim. The nature of the defendants' contentions is apparent from the following issues among those formulated in the course of the trial:

Issue 1.—Is the plaintiff company the true and first inventor of the annular metal cover?

Issue 2.?Is the patent in respect of the same invalid?

Issue 9 ?Is the alleged invention sufficiently ascertained or described in the specification?

Issue 10.?Does the claim contain a distinct statement of the invention? Is it ambiguous, misleading and wide?

3. On 17th January 1933, when the evidence had been closed, counsel for the patentees, who was then in the course of making his final reply on behalf of his clients, applied for leave to serve short notice for the following day of an application u/s 18, Indian Patents and Designs Act, 1911. Leave was refused by Buckland, J., for reasons given in a judgment delivered by him on that day. The concluding paragraph of the judgment is as follows:

I refuse leave to serve short notice of motion. This does not of course preclude the plaintiff company from making any application which it may be advised to make upon such notice as the rules require.

4. The patentees thereupon serve the defendants with notice that an application would be made on 23rd January 1933, that the patentees should be allowed to amend the specification in the suit, namely the specification in Indian latent No. 17148 of 1930, by correcting and explaining the printed Indian specification in terms of the prayer of the petition. On 23rd January 1933, as appears from the order of that day, counsel for the patentees, when the application was called on stated to the Court that he had no instructions to proceed with the application, which was accordingly dismissed with costs. On 3rd February 1933, Buckland, J., dismissed the suit with costs. The following is an extract from his judgment:

In my judgment neither the plaintiff company nor its assignor was the true and first inventor of the annular metal cover and the defendant company has not infringed the plaintiff company"s patent in the manner set forth in issue 3. I also hold that the invention is not new nor proper subject matter for a patent, and that the specification, and in particular the claim are ambiguous and too wide, and that the alleged invention was anticipated by the prior publication in India of the patent granted to Tarver in England in 1917.

5. On the same day immediately upon judgment being pronounced, the patentees through Messrs. Remfry & Sons, patent and trade mark attorneys, presented an application u/s 17 of the Act to the Controller of Patents for leave to amend the specification of their patent. The application is in the prescribed form, and contains a declaration that no suit for infringement or proceeding before a Court for revocation of the patent in question is pending. The proposed amendments are described as being by way of correction, explanation and limitation. A copy of the specification and claim is attached to the application showing the proposed amendments in red ink. They appear to me to be substantially the same as those which formed the subject matter of the application of which notice had been given on 19th January 1933. The application

was duly advertised u/s 17, Sub-section (3) of the Act. On 8th March 1933, the patentees filed an appeal against the decree of Buckland, J., dismissing their suit against Messrs. Brough & Co.

6. On 10th August 1933, the Bright Star Company filed a full statement of opposition to the patentees' application, wherein after calling attention to the pending appeal, they set out the fact that the application for amendment u/s 18 had been refused by the Court on 23rd January 1933. They also give their reasons for submitting that the proposed amendments will enlarge the scope of claim 1, and make it substantially different from the claim as it stood before amendment. They make a similar submission with respect to the other claims. The patentees' reply is dated 12th September 1933. In dealing with the application disposed of on 23rd January 1933, the patentees state:

It is admitted that during the hearing of the suit an application was made to the Court for applicants to be allowed to amend the specification, but such application was not allowed by the Court and the details of the application were not even considered by the Court, as the application was refused without any consideration being given to the wording or details of the amendment whatsoever, the Court having refused to even listen to the terms set forth in the application.

7. When Mr. Clough draw my attention to this paragraph, I expressed my strong disapproval of it, and nothing that Mr. Barwell has said has caused me to modify the opinion I then formed. The language appears to me to be deliberately chosen to indicate a lack of respect for the Court, and is moreover calculated, and I feel compelled to add intended, to give a totally inaccurate picture of the incident to which it refers. From what has already been stated and from the record it is perfectly plain that the only reason why the patentees' application was not considered on the merits was that they saw fit to give no instructions to their counsel to proceed with it. This being so, for the patentees to describe the Court as refusing to listen to the terms set forth in the application, is, to my mind, highly reprehensible.

8. In December 1933, the parties appeared before the Controller who heard arguments both as to jurisdiction and on the merits. Before orders were passed, on 13th December 1933, the Bright Star Company presented a petition to this Court, setting out the facts and contending, first, that, inasmuch as a suit for infringement of the patent was pending, the Controller had no jurisdiction to entertain the patentees' application; secondly, that to entertain the application would be "a violation of the principles of law," as the period for appealing against the order of dismissal of 23rd January had expired and that the matter in issue had already been finally decided by this Court; and, thirdly, that the Controller had no jurisdiction to grant leave, as the amended specification would claim an invention substantially larger than or substantially different from, the invention claimed by the specification. The alternative reliefs sought are a writ of prohibition forbidding the Controller to continue the proceedings, an order of a

similar character u/s 45, Specific Relief Act, 1877, and a writ of certiorari requiring the Controller to bring up the record so that the proceedings may be quashed.

9. After hearing counsel, I directed that a rule should issue on the patentees and the Controller in terms of the prayer of the petition. This has, accordingly, been done, although the Rule as framed does not mention the writs by name. Exception has been taken to certain alleged formal defects in procedure. It is said that a copy of the petition should have been served with the Rule, and I have been referred to passages in the Yearly Practice, 1934. The objections are entirely technical, and it is not argued that the patentees have been prejudiced in any way. I do not feel called upon to give any weight to them, as this matter is not one like an application to commit for contempt of Court, where the party, whose personal liberty it is sought to affect, is entitled to insist on the strictest observance of the prescribed procedure.

10. A point of greater importance is raised by the contention that the Court has no power to issue a writ of prohibition. It is agreed that this writ, if the power exists to issue it, can be claimed as of right, and that for this reason various arguments, open to the patentees in opposing the prayer for as much of the relief sought as is merely discretionary, are inapplicable. I am of opinion that this power exists. By Clause 4 of the Charter of the Supreme Court of 1774, it was provided that the Court should have

such jurisdiction and authority as our justices of our Court of King's Bench have, and may lawfully exercise, within that part of Great Britain called England, by the common law thereof.

11. Undoubtedly, among the powers of the Court of king's Bench at the date of the Charter was that of issuing writs of prohibition. It is admitted that all the powers of the Supreme Court have been inherited by the High Court, except such as have been specifically taken away by statute. This is recognized in *Nundo Lal Bose v. Corporation for the Town of Calcutta* (1885) 11 Cal 275. as regards this Court, as also in *In re Mrs. Besant* 1918 Mad 1266 as regards the Madras High Court. The latter decision was affirmed by the Judicial Committee in *Besant v. Advocate-General of Madras* 1919 PC 31. It is however suggested that to issue a writ of prohibition was never among the powers of the Supreme Court, and that Clause 21 of the Charter has the effect of cutting down and curtailing the powers apparently conferred by Clause 4. Clause 21 makes the Courts and Magistrates already existing at the date of the Charter

subject to the order and control of the said Supreme Court of Judicature at Port William in Bengal, in such sort, manner, and form, as the inferior Courts and Magistrates of, and in that part of Great Britain called England are, by law, subject to the order and control of our Court of King's Bench.

12. The clause proceeds:

To which end the said Supreme Court is hereby empowered and authorised, to award and issue a writ or writs of mandamus, certiorari, procedendo, or error, to be prepared in manner before mentioned, and, directed to such Courts or Magistrates as the case may require.

13. It is rightly pointed out that there is no mention of any authority to issue a writ of prohibition, and also that there is no record of such a writ ever having in fact issued from the Supreme Court or the High Court. Nonetheless, I cannot accept the argument. As has been pointed out by learned commentators, including Sir Fitzjames Stephen, the draftsmanship of the Charter is open to criticism, and it may be that there is here an instance of omission through oversight. In any case, I do not think that the language of Clause 21 can be used to control the language of Clause 4 in the manner suggested. It would need far more direct language to convince me that it was intended by Clause 21 to exclude from the powers of the Court of King's Bench conferred on the new Court by Clause 4, the power to issue a writ of prohibition. Moreover, I have no doubt that the writ can issue on the Controller. He is not technically a Court, or a tribunal exercising judicial functions in the legal acceptation of the terms, but that does not make it untrue to say that, so far as he has a duty imposed upon him to hear and determine objections to applications for leave to amend, there is a fair analogy between his position and the position of a Court. The principle has been many times affirmed that when a person or body of persons, is clothed with power to determine questions, and decide issues affecting the rights of the private citizen or the public, the King's Bench Division will interfere by prohibition or certiorari to prevent the illegal exercise of such power. It is unnecessary to multiply cases. I need only refer to the judgments of Lord Hewart, C.J., in *King v. North Worcestershire Assessment Committee Ex parte Hadley* (1929) 2 KB 297 and of Venkatasubba Rao, J., in *Penugonda Venkataratnam v. Secy. of State* 1930 Mad 896.

14. Since I have held that this Court has power to issue a writ of prohibition if the case is a fit one for its exercise, I need not consider whether the circumstances of this particular case would make it right for me to refuse the discretionary reliefs asked for, namely a writ of certiorari, and an order u/s 45, Specific Relief Act. With regard to the latter order the patentees rely on Section 17, Sub-section (6), Patents and Designs Act, which provides for an appeal to the Governor-General in Council against the decision of the Controller. It is argued that this fast prevents proviso (d), Section 45, Specific Relief Act, from being fulfilled, since the appeal is a specific and adequate legal remedy open to the applicant. It is also argued that the conduct of the Bright Star Battery Company in taking part in the proceedings before the Controller, until the stage when it only remains for him to promulgate his decision, disentitles them to relief. As I have already observed it is not necessary in the circumstances to consider the weight that ought to be given to these contentions.

15. By far the most important point urged in support of the Rule is that which is

concerned with Section 17, Sub-section (9), Patents and Designs Act, which makes the whole section inapplicable, when and so long as any suit for infringement or proceeding before a Court for the revocation of a patent is pending, and it will, I think, be convenient if I postpone consideration of it until I have disposed of the other objections-to the Controller's jurisdiction. It is said that the Controller ought not to entertain the patentees' application, because the amendments, which he is asked to sanction, are in substance the same as those which formed the subject matter of the application to the Court, which was dismissed on 23rd January.

16. It is admitted that as the dismissal was due to the patentees' failure to appear in support of the application, and as there was no decision on the merits, the matter cannot be regarded as *res judicata*; but the principle embodied in Order 23, Rule 1, Civil P. C., is invoked. It is said that in effect the patentees withdrew their application to the Court without either asking for, or obtaining, leave to make the same application at a future date.

17. I think the answer to this is that the CPC is not applicable to proceedings before the Controller. The principles underlying the Code, in so far as they are principles of natural justice, must of course be observed by him, as they must be observed by all authorities exercising judicial or quasi-judicial functions. How far, if at all, according to those principles the patentees have prejudiced their rights by their conduct in respect of the proposed application to the Court is for the Controller to decide.

18. Next, it is argued that the amendments sought would so clearly make the specification claim an invention larger than and substantially different from that claimed in the unamended specification, that the Controller is bound to decide adversely to the patentees. The answer again is that the scheme of Section 17 of the Act, shows that this question is one of those that the legislature intended that the Controller should decide, subject to the right of appeal as provided by Sub-section. (6). It is quite impossible for the Court to investigate the matter, and then by anticipation prohibit the Controller from proceeding, on the assumption that his decision, when given, will be erroneous. To do so, would, in my opinion, be a usurpation on the part of the Court of the jurisdiction which the law has given to the Controller.

19. Finally, we come to the question whether Sub-section (9) has in the circumstances the effect of depriving the Controller of all jurisdiction u/s 17. I do not think it can be plausibly argued that on 3rd February, when the application was presented to the Controller any suit for infringement was pending. Judgment dismissing the patentees' suit against Messrs. Brough & Co., had already been pronounced. The fact that the formal decree does not appear to have been signed by the Master or a Judge before 13th February, or to have been filed before 21st March, does not, in my opinion, affect the matter. Such steps may be regarded as machinery for formally recording the result of the suit, or as necessary preliminaries for execution. In other words, in my opinion, the suit, for

the purposes of Sub-section (9), terminated the moment the Court pronounced its judicial decision, and could not thereafter be said to be pending.

20. What however is the position from the date of the filing of the appeal? Counsel has argued that, for the purposes of the Sub-section, "suit" must include appeal and he points out, with considerable force, that, whatever were the reasons that induced the legislature to deprive the Controller of jurisdiction during the pendency of a suit, those reasons must apply, with equal force, during the pendency of an appeal. In this connexion, he has referred to the Transfer of Property Act, 1882, Section 52, as unamended, and my attention has been drawn to the observations of C.M. Ghose, J., in *Gobind Chunder Roy v. Guru Churn Kurmoker* (1887) 15 Cal 94. It is true that, at p. 99, the learned Judge speaks of the proceedings of the appellate Court as being "but a continuation of the proceeding in the suit," but the question he was considering was quite different from the one before me, since what he had to decide was whether the appellate decree was a decree "made therein" within the meaning of the section. *Dinonath Ghose v. Shama Bibi* (1900) 28 Cal 23 is rather more favourable to counsel's contentions, since there the alienation was effected before the filing of what is described as the "inevitable" appeal. I cannot say I find *Harris v. Quine* (1869) 4 QB 653 particularly helpful. That decision is merely to the effect that the contract between an attorney and his client covers the conduct of possible appellate proceedings, as-well as the conduct of the original suit, although the attorney is entitled, if he sees fit, to decline to act after the determination of the suit in the lower Court. If however he does act, limitation does not begin to run with respect to his claim for remuneration, until he has completed his work with regard to the appeal. The case is certainly no authority for holding that, in a statute, the word "suit" must be construed as including appeal.

21. What however finally prevents me from accepting Mr. Clough's very able argument as to the construction of Sub-section (9) is the decision of Chitty, J., in *Cropper v. Smith* (1884) 28 ChD 148. There the Controller-General refused to proceed with an application to amend, presented to him under the Patents, Designs, and Trade Marks Act, 1883, Section 18, considering that the leave of the Court u/s 19 of that Act, was necessary, because, since the presentation of the application, an appeal had been lodged in the House of Lords against the decision of the Court of Appeal affirming in part the judgment of the High Court. Chitty, J., held that "action for infringement" in Section 18, Sub-section (10) of the Act, meant action before judgment, and that, in the circumstances, there was no action for infringement pending. I appreciate the fact that the provisions of the English statute differ from those of the Patents and Designs Act, 1911. In particular, under the English statute, there was no power given to the Court similar to that conferred by Section 18 of the Act, to allow a patentee to amend his specification. Instead of this power, the English Court, u/s 19 of the Patents, Designs and Trade Marks Act, 1883, had the power, in an action for infringement of a patent, to give the patentee liberty to apply to the Controller for leave to amend his specification.

22. Owing to this difference, some of the arguments, which influenced Chitty, J., are inapplicable in this case. However I cannot lose sight of the fact that the Act was passed 27 years after the decision in *Cropper v. Smith* (1884) 28 ChD 148 and the legislature saw fit to employ language, in essentials the same as the language, which had on that occasion been judicially interpreted. Moreover, since the Patents and Designs Act 1919 C. 80 the law in England has been the same as in India in this respect, for u/s 22 of that Act, the Court has power to allow amendments. I have however been unable to find any suggestion in the standard work "Terrell on Patents," Edn 7, published in 1927, that, since the Act of 1919, *Cropper v. Smith* (1884) 28 ChD 148 is no longer good law.

23. In the circumstances, I feel constrained to come to the conclusion that it was the intention of the legislature to exclude pending appeals against decrees in suits for infringement from the purview of Section 17, Sub-section (9) of the Act. I may add that quite apart from the opinion I have formed as to the construction, I should have considerable doubt whether the filing of an appeal deprives the Controller of jurisdiction to deal with an application already presented u/s 17, Sub-section (1) of that Act.

24. I notice that in *Woolfe v. Automatic Picture Gallery, Ltd* (1903) 1 Ch 18 the Court of appeal upheld the decision of Kekewich, J., that the jurisdiction of the Controller to deal with an application for leave to amend, made u/s 18 of the Patents, Designs and Trade Marks Act, 1883, was not suspended by the subsequent presentation of a petition for revocation. I am inclined to think that, even if Mr. Clough's contention be adopted, the filing of the appeal on 8th March does not affect the power of the Controller to deal with the application made to him on 3rd February. It is not however necessary to decide this question. For the reasons I have given, I hold that the application fails and must be dismissed with costs.