THE LAW OF

COPYRIGHT IN DESIGNS,

TOGETHER WITH THE

PRACTICE RELATING TO PROCEEDINGS IN
THE COURTS AND IN THE COMPTROLLER'S OFFICE,

THE PATENTS AND DESIGNS ACT, 1907,

AND

THE REPEALED ACTS, 1883—1888, COMPARED,

THE STATUTORY RULES AND FORMS,

AND THE INTERNATIONAL CONVENTION.

WITH NOTES

AND

A FULL APPENDIX OF

STATUTES, FORMS AND PRECEDENTS, WITH ILLUSTRATIONS.

SECOND EDITION.

YALE LAW LIBRARY.

BY

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SIR JOHN FLETCHER MOULTON,

LORD JUSTICE OF APPEAL.

PREFACE.

The necessity for a re-statement of the English Law of Designs has been emphasized by the passing of the recent Patents and Designs Act, which has consolidated the various statutory provisions previously in force, while leaving the large mass of judge-made law which had grown up around them for the most part untouched.

The subject of Copyright in Designs is of much practical importance to the manufacturing and industrial undertakings of the country. Great commercial interests are now largely dependent on the protection afforded. The number of designs registered last year was over 26,000, and is likely to be now increased under the new Act, which extends the term of protection from five to an optional fifteen years, and gives enlarged rights and advantages to all registered owners.

The present work was commenced last year, when the growth of the decisions on the old Acts already seemed to justify the issue of a fresh edition of Mr. EDMUNDS' work, issued in 1895, but its progress was delayed by the

introduction of Mr. Lloyd George's Bills for the Amendment and Consolidation of the Law relating to Patents and Designs. The amending Act introduced a large number of modifications in the existing law, and these and the provisions of the Acts then in force were all incorporated in the Consolidating Statute.

The Patents and Designs Act, 1907, and the New Designs Rules and Orders made under that Act, together with the numerous decisions of the Courts, have necessitated great alterations in the text; indeed, in many parts a complete re-writing of the work. Mr. BENTWICH has undertaken the entire responsibility and very considerable labour involved in this, with the result that this volume, though following the general scheme and outline of the original book, is practically a new work.

Where available the cases on analogous questions in the general Copyright law as well as on Patents and Trade marks have been referred to. On many questions they may be safely followed as decisions which would be regarded by the Courts as conclusive on corresponding matters relating to Designs.

The text contains, it is believed, all cases directly or indirectly relating to Designs Copyright reported up to April of the present year. In the Table of Cases the references to all the series of reports are, as far as possible,

given, the pages where a full statement of the facts or the judgment in any case is to be found being marked by heavier type. In the text only one reference is given (with the date of the decision), the official Patent Office Reports being selected wherever available.

The main principles of the law and rules of practice have been distinguished by a different arrangement of types from the decisions on which they are based, or which illustrate them, and a special point has been made of setting out the actual words of important judgments to avoid the necessity of constant reference to the reports themselves.

The system of providing diagrams in reports of Patents and Designs cases which has been inaugurated in the official Reports, has been followed by the utilization of some of these diagrams as illustrations of important cases of alleged infringement, anticipation, or insufficient marking; and the thanks of the Authors are due to the Comptroller and to the parties concerned in cases where no diagrams had previously been published for the permission to make use of these illustrations.

Head-notes have been provided to the different chapters to facilitate reference to any particular point, and these head-notes are repeated in the Table of Contents, which in a few pages thus furnishes a complete analysis of the entire work.

Much care has been bestowed on the Index, and every effort has been made to render it an efficient and convenient guide to the contents.

The work has had the great advantage of perusal by Mr. Ralph Griffin, Barrister-at-Law, the Registrar of Designs and Trade Marks, who has made many valuable suggestions, for which the Authors are greatly indebted. Mr. E. W. Hulme, of the Patent Office Library, has also given kind assistance.

LEWIS EDMUNDS,

HERBERT BENTWICH.

The Temple,

May, 1908.

TABLE OF CONTENTS.

PAGE

PREFACE - - - - - - - v—viii

SUMMARY OF CONTENTS - - - - - ix—xix

COMPARATIVE TABLES—

I. The Act of 1907 and the Repealed Acts, 1883—1888 - xx—xxi
II. The Rules of 1908 and the Repealed Rules, 1890—1898 xxi—xxii

TABLE OF CASES - - - - - - xxiii—xxxv

TABLE OF STATUTES AND RULES - - - - xxxvii—xli

SUMMARY.

PART I.

THE LAW AND PRACTICE OF COPYRIGHT IN DESIGNS.

CHAPTER I.

HISTORY AND DEVELOPMENT OF THE LAW OF DESIGNS - 1—16

Sect. 1. The first Copyright Act (1709), 8 Anne, c. 19.
2. Development of Designs and demand for Legislation.
3. Act of 1787 (27 Geo. III. c. 38). Protection for Fabrics of Linen, Cotton, &c.
4. Act of 1839 (2 Vict. c. 13). Extension of Act to Wool, Silk, and Hair.
5. Further Act of 1839 (2 Vict. c. 17). Extension to Articles of Manufacture—Registration and Marking introduced.
6. Piracy defined and Penalties imposed.
7. Provisions for the Registration of Designs and Transfer of Copyright.
8. Consolidating Act of 1842 (5 & 6 Vict. c. 100). Definition of Design.

CHAPTER I.—*continued.*

PAGE

HISTORY AND DEVELOPMENT OF THE LAW OF DESIGNS - 1—16

Sect. 9. Term of Copyright made dependent upon class of Goods.
10. Action of Damages for Piracy. Provisions for Inspection of Register.
11. Act of 1843 (6 & 7 Vict. c. 65). Extensions to Designs of Utility.
12. Act of 1850 (13 & 14 Vict. c. 104). Extension to Designs within Sculpture Copyright Acts.
13. Provisional Registration. Extension of Term for Ornamental Designs.
14. Act of 1858 (21 & 22 Vict. c. 57). Extension of Term for Woven Fabrics. Penalties introduced for False Marking.
15. Act of 1861 (24 & 25 Vict. c. 73). Extension of Protection to Designs wherever published.
16. Act of 1865 (28 Vict. c. 3). Protection of Designs at Exhibitions.
17. Act of 1875 (38 & 39 Vict. c. 93). Powers of Board of Trade transferred to Commissioners of Patents. Association of Patents and Designs.
18. Act of 1883 (46 & 47 Vict. c. 47). Designs Laws consolidated and included in one Act with Patents and Trade Marks.
19. Alterations introduced by the new Act.
20. Amending Acts of 1885, 1886, 1888, and Designs Rules.
21. Amending and Consolidation Acts of 1907 (7 Edw. VII. c. 28 and c. 29). Alterations in the Law and Extensions of Term of Copyright.
22. The Designs Rules, 1908.
23. Analogy of Law of Patents, Trade Marks, and Art Copyright.
24. Provisions for International Copyright in Designs. The Convention.

CHAPTER II.

MEANING OF "DESIGN" - - - - - 17—29

Sect. 25. What is a Design?—Statutory Definition.
26. Limitations in the Statutes.
27. Dictionary Definitions.
28. Scope of the Act of 1907.
29. Judicial Decisions—Opinions of the Judges in *Harrison* v. *Taylor*, *Re Rollason's Design*, and *Re Bayer's Design*.

CHAPTER II.—*continued.* PAGE

MEANING OF "DESIGN" - - - - - 17—29

Sect. 30. No Distinction between Ornamental and Useful Designs (*Hecla Foundry Co.* v. *Walker*; *Moody* v. *Tree*).
31. Design is that which is applied (*Re Clarke's Design*).
32. Design may be Registered though also Subject-Matter for Patent or Trade Mark (*Werner Motors* v. *Gamage's*).
33. What is not a Design (*Nevill* v. *Bennett*).
34. Illustrative Cases—Corset Cases (*Cooper* v. *Symington* and *Re Bayer's Design*)—Fire-door Cases (*Walker* v. *Falkirk Iron Co.* and *Hecla Foundry Co.* v. *Walker*)—Spoon-handle Case (*Saunders* v. *Wiel*)—Coffin-plate Case (*Re Rollason's Design*).
35. Result of the Authorities.
36. Classification of Designs.

CHAPTER III.

NOVELTY - - - - - - - 30—45

Sect. 37. General Rules as to Novelty—Effect of Publication.
38. Distinction between "New" and 'Original" (*Sherwood* v. *Decorative Art Tile Co.*).
39. Differences from Patent Law.
40. Novelty in the application of the Design (*Saunders* v. *Wiel*).
41. New method of Appliance not a Novelty (*Cooper* v. *Symington*).
42. Utility immaterial as to Subject-Matter (*Tyler* v. *Sharpe*).
43. Novelty involves substantial difference from what has gone before—Tandem-collar Case (*Le May* v. *Welch*)—Lamp-shade Case (*Re Clarke's Design*).
44. Novelty arising from Combinations of Old Designs—Honeycomb Pattern Case (*Harrison* v. *Taylor*)—Card-basket Case (*Lazarus* v. *Charles*).
45. Test of the Eye—Motor-cycle Frame Case (*Werner Motors* v. *Gamage's*).
46. Application of Old Designs to New Substances—Lamp-shade Cases (*Re Buch's Design* and *Re Read and Greswell's Design*).
47. Application to New Purposes (*Walker* v. *Falkirk Iron Co.*).

CHAPTER IV.

PAGE

PUBLICATION - - - - - - - 46—70

Sect. 48. Different Modes of Publication.
49. Prior User. Exception in favour of Registered Proprietors.
50. Exhibition for sale (*Re Sherwood's Design*; *Harper* v. *Wright and Butler*).
51. User sufficient to acquaint Public (*Carpenter* v. *Smith*; *Stead* v. *Williams*).
52. Experimental User.
53. Manufacture in Workshop (*Humpherson* v. *Syer*).
54. Modifications introduced by Act of 1907.
55. Analogy of Copyright Cases (*Prince Albert* v. *Strange*, etc.).
56. Analogy with Works of Sculpture.
57. Summary of Copyright Authorities.
58. Publication in Books and Documents.
59. Differences from Publication by User—Romilly, M.R., in *Lang* v. *Gisborne*; Jessel, M.R., in *Plimpton* v. *Malcolmson*.
60. Sufficiency of Matter Published (*Philpott* v. *Hanbury*).
61. Publication to Individuals (*Blank* v. *Footman*)—Commercial dealing with Design (*Heinrichs* v. *Bastendorff*)—Provisions of the new Act.
62. Publication out of the United Kingdom.
63. Registration not Publication?
64. Publication at Public Exhibitions.
65. Notification required to secure Exemption.

CHAPTER V.

THE PRACTICE OF REGISTRATION - - - - 71—92

Sect. 66. Copyright before and after Publication—Statutory Provisions.
67. The Application for Registration—Regulations as to Time.
68. Application in Person or by Agent.
69. Description of the Design—Specification of Class.
70. Registration by Sample.
71. Filing of Representations—Effect of Explanatory Notes.
72. Sufficiency of Claim or Description—Illustrative Cases: *Norton* v. *Nicholls*; *Holdsworth* v. *McCrea*; *Barran* v. *Lomas*; *Re Rollason's Design*; *Re Bayer's Design*.
73. Deposit of Copies or Drawings.

CHAPTER V.—*continued.*

PAGE

THE PRACTICE OF REGISTRATION - - - - 71—92

Sect. 74. Effect of Non-deposit—Abandonment of Registration.
75. Sale of Articles to which Designs applied—Submission of Samples.
76. Classes—Distinction between Classes 13 and 14.
77. Registration of Sets of Designs.
78. Power of Comptroller to decide Class.
79. Protection limited to Class registered (*Re Read and Greswell's Design*).
80. Subsequent Registration by Third Person in another Class (*Re Buck's Design; Re Clarke's Design*).
81. Powers of Comptroller to refuse Registration.
82. Procedure before Comptroller.
83. Appeal to Board of Trade.
84. Procedure on Appeal—Costs.
85. Certificate of Registration—Copies where Original lost.
86. Amendments, and Extension of Time.
87. Correction of Entries—Omission of particular Goods.
88. Transmission of Copies of Entries to Scotland—Fees, &c.
89. Special Provisions as to Designs for Goods in Classes 13, 14 and 15.

CHAPTER VI.

THE REGISTER - - - - - - 93—114

Sect. 90. Entry of Proprietorship.
91. Provisions as to Equitable Interests.
92. Original Registration.
93. Entry of Transmission.
94. Registration of Assignments and other Interests.
95. Powers of Comptroller to dispense with Evidence.
96. Necessity of Writings to prove Title?
97. Death or Bankruptcy of Proprietor.
98. Inspection of the Register.
99. Rectification and Expunging of Entries.
100. Grounds for Expunging.
101. Rectification of Owners' Names—*Re Guiterman's Design—Re Grocott's Design.*
102. Change of Name of Owners.
103. Costs and Damages on Rectification.
104. Improper Use or Conduct as affecting Registration.
105. Persons entitled to apply for Rectification—*Re Powell's Trade-Mark—Apollinaris Case.*
106. Summary of Authorities as to "Person aggrieved."

CHAPTER VI.—*continued.*

PAGE

THE REGISTER - - - - - - 93—114

Sect. 107. Jurisdiction on Application for Rectification—Scotch and Irish Cases.
108. Procedure on Applications for Rectification—Motion or Summons.
109. Notices to be given—Appliation for leave.
110. The Order to Rectify and its Entry on the Register—Right of Appeal.
111. Application for Cancellation for Non-manufacture in United Kingdom.
112. Procedure on Application to Cancel.
113. Register *primâ facie* Evidence—Certificates of Entries by Comptroller.
114. Falsification of Documents.

CHAPTER VII.

THE PROPRIETOR - - - - - - 115—128

Sect. 115. Definition of "Proprietor."
116. Persons who may be Proprietors.
117. The Author of the Design.
118. Persons employing Authors—Commissioned Works.
119. Persons acquiring a Design—*Lazarus* v. *Charles*; *Re Guiterman's Design*.
120. Persons acquiring Right to Apply—*Nevill* v. *Bennett*.
121. Licensees—*Jewitt* v. *Eckhardt*.
122. Evidence of Title on Licenses and Assignments.
123. Remedies of Unregistered Proprietors—*Hole* v. *Bradbury*; *Ihlee* v. *Henshaw*.
124. Distinction between License and Written Consent.
125. Necessity of Registration to complete Title.
126. License or Assignment by part Proprietor—*Lauri* v. *Renad*.
127. Devolution on Death.
128. Equitable Proprietorship.
129. Effect of Bankruptcy.

CHAPTER VIII.

MARKING - - - - - - - 129—140

Sect. 130. Statutory Requirements as to Marking.
131. Application of the Rules.
132. Differences between the old and repealed Acts and the Act of 1907.
133. Mere Desire and Intention to Mark ineffectual—Proviso in favour of Proprietor taking proper Steps.

CHAPTER VIII.—*continued.*

PAGE

MARKING - - - - - - - 129—140

Sect. 134. Illustrative Cases—*Woolley* v. *Broad*; *Re Rollason's Design*, etc.

135. Failure of Co-proprietor to Mark—*Wedekind* v. *General Electric Co.*

136. Failure of Licensee to Mark.

137. Wearing out or Removal of Mark—*Fielding* v. *Hawley*.

138. Method of Marking—Paper-hangings (*Heywood* v. *Potter*) -Trimmings (*Blank* v. *Footman*)—Dusters (*Hothersall* v. *Moore*)—Cuff-links (*Re Morton's Design*).

139. Irregularities in Marking—Addition of other Marks (*Harper* v. *Wright and Butler*).

CHAPTER IX.

STATUTORY COPYRIGHT AND ITS INFRINGEMENT - - 141—159

Sect. 140. Effect of Registration—Term of Original Copyright and Conditions for Renewals.

141. Statutory Provisions as to Infringement.

142. Differences in position of Manufacturers and Vendors of Pirated Designs—*Smith* v. *Lewis*, *Roberts & Co.*; *Brittain* v. *Kennedy*.

143. Position under the old and repealed Acts and Act of 1907.

144. Notice required to affect a Vendor.

145. Liability of Agent as Infringer.

146. Rights of Buyers from a Licensee—*Cooper* v. *Stephens*.

147. Classes of Infringements—None unless Sale intended.

148. Imitation of Design—*Barran* v. *Lomas*; *Thom* v. *Sydall*.

149. Obvious Imitation—*Harper* v. *Wright and Butler*.

150. Fraudulent Imitation—*Grafton* v. *Watson*; *Sherwood* v. *Decorative Art Tile Co.*

151. Infringement a question of Fact—Test of the Eye—State of Knowledge—Star-chain Case (*Holdsworth* v. *McCrea*)—Lace Case (*Barran* v. *Lomas*; *Birkin* v. *Pratt*; *Oliver* v. *Thornley*)—Kitchen-range Door (*Walker* v. *Hecla Foundry Co.*)—Light-house (*Staples* v. *Warwick*).

152. Attempts to Imitate without Infringing—*Nevill* v. *Bennett*; *Holden* v. *Hopkinson*.

153. Intention Immaterial.

154. Imitation of Purpose or Utility no Infringement.

155. Novelty and Infringement.

CHAPTER X.

PAGE

REMEDIES FOR INFRINGEMENT - - - - 160—174

Sect. 156. The Statutory Penalties.
157. Separate Penalty incurred for each Offence—*Ex parte Beale; Rivett* v. *Grimshaw.*
158. Award of Lump Sum for Penalties.
159. Principles of Assessment—*Saunders* v. *Wiel.*
160. Alternative Remedy by way of Damages.
161. Assessment of Damages—*Davenport* v. *Rylands; British Motors* v. *Taylor.*
162. Equitable Relief granted in addition to Remedy under Statute.
163. Intention to Infringe sufficient for Injunction.
164. Grounds on which Injunction granted—*Geary* v. *Norton; Procter* v. *Bayley; Werner Motors* v. *Gamage's.*
165. Considerations affecting Applications for Interlocutory Injunction—*Mitchell* v. *Henry; Knowles* v. *Bennett.*
166. Plaintiff's Conduct affecting Right to Relief.
167. Delivery up of Pirated Articles—*Hole* v. *Bradbury; Boosey* v. *Whight; Knowles* v. *Bennett.*
168. Certificates of Validity—Costs.

CHAPTER XI.

THE ACTION FOR INFRINGEMENT - - - - 175—206

Sect. 169. Remedy now in High Court—Jurisdiction of County Courts—*Bow* v. *Hart.*
170. Jurisdiction in Scotch and Irish Cases—*Bayer* v. *Connell.*
171. Plaintiff's choice of Tribunal—Powers to Consolidate.
172. Parties—Who may sue—Licensees or Assignees—*Woolley* v. *Broad.*
173. Mortgagors and Equitable Owners—*Petty* v. *Taylor.*
174. Proceedings by Unregistered Owners.
175. Parties liable as Defendants—Agents and Principals—Several Infringers.
176. The Writ—Notice before Issue—Indorsement of Claim.
177. Pleadings—Necessary Allegations in Statement of Claim.
178. Defences to the Action—Estoppel of Licensee.
179. Particulars of Breaches and Objections—Application to Expunge.

CHAPTER XI.—*continued.*

PAGE

THE ACTION FOR INFRINGEMENT - - - - 175—206

Sect. 180. Amendment of Particulars—*Woolley* v. *Broad.*
181. Sufficiency of Particulars—Allegation of Common Knowledge.
182. Inspection and taking of Samples—Enforcing Order.
183. Notice of Motion or Summons for Inspection—Affidavit in support.
184. When Inspection refused—Disclosure of Trade Secrets.
185. Discovery of Documents and Interrogatories.
186. Limitations to Plaintiffs' and Defendants' Rights of Discovery.
187. Discovery in Actions for Penalties—*Titus Astle* v. *Mansfield.*
188. Extended right of Defendant to Interrogate.
189. Method of Trial—Right to Jury.
190. Issues for Judge and Jury.
191. Decision of Preliminary Questions of Law.
192. Costs—New Statutory Provisions—Certificate of Validity.
193. Costs of distinct Issues—*Winfield* v. *Snow; Blank* v. *Footman.*
194. Costs on Higher Scale in certain Cases.
195. Order when Defendant submits to Injunction—Illustrative Cases—*Cooper* v. *Whittingham; American Tobacco Co.* v. *Guest*, etc.

CHAPTER XII.

OFFENCES UNDER THE ACT AND OTHER PROCEEDINGS - 207—213

Sect. 196. Making False Entries or Copies a Misdemeanour.
197. Fines for False Descriptions—*Reg.* v. *Wallis; Sen Sen* v. *Britten.*
198. Misrepresentation by use of Registration Marks.
199. Unauthorized use of Royal Arms.
200. Prosecution of Offences in Scotland and Ireland.
201. Offences Abroad under Foreign Jurisdiction Acts.
202. Action for Threats of Legal Proceedings.
203. Circulars and Warning Letters—Burden of Proof.
204. Institution of Proceedings—Dissolution of Injunction.
205. Damages and Costs in Threats Actions or Common Law Proceedings.

PART II.

THE PATENTS AND DESIGNS ACT, 1907, AND THE REPEALED PATENTS, DESIGNS, AND TRADE MARKS ACTS, 1883 TO 1888 (SO FAR AS THEY RELATE TO DESIGNS),

COMPARED AND NOTED.

		PAGE
Index to the Act		215—217
Sects. 49—52.	Registration	217—228
53—58.	Copyright	229—241
59.	Exhibitions	242
60, 61.	Legal Proceedings	243—251
62—64.	Patent Office	252—253
65.	Fees	253
66—72.	Registers and other Documents	254—260
73—76.	Powers of Comptroller	261
77—83.	Evidence	262—266
84, 85.	Patent Agents	266—267
86—88.	Powers of Board of Trade	267—269
89, 90.	Offences	269—271
91.	International Arrangements	272—275
92, 93.	Definitions	275—281
94—96.	Scotland, Ireland and Isle of Man	282—284
97—99.	Repeal and Savings	285—287

THE DESIGNS RULES, 1908 (with Notes) 289—318

SCHEDULE OF FEES 318—320

THE INTERNATIONAL CONVENTION FOR THE PROTECTION OF INDUSTRIAL PROPERTY, AND THE BRUSSELS ACT (with Notes) 321—332

APPENDICES.

APPENDIX A.—STATUTES.

	PAGE
TABLE OF REPEALED ACTS - - - - -	333—334
ACT OF 1883 (46 & 47 Vict. c. 57) - - - -	334—348
ACT OF 1885 (48 & 49 Vict. c. 63) - - - -	348
ACT OF 1886 (49 & 50 Vict. c. 37) - - - -	349
ACT OF 1888 (51 & 52 Vict. c. 50) - - - -	350—351
ACT OF 1907 (7 Edw. VII. c. 29) - - - -	352—370
INTERPRETATION ACT, 1889 (52 & 53 Vict. c. 63) - -	371—372

APPENDIX B.—FORMS.

I. THOSE PRESCRIBED BY THE DESIGNS RULES, 1908 -	373—389
II. PLEADINGS AND OTHER PROCEEDINGS IN ACTIONS -	390—402
III. CONVEYANCING - - - - - -	403—405

APPENDIX C.

INSTRUCTIONS TO PERSONS WHO WISH TO REGISTER DESIGNS - 406—413

APPENDIX D.

LIST OF ORDERS IN COUNCIL APPLYING THE PROVISIONS OF THE ACTS TO FOREIGN STATES, ETC. - - - 414

APPENDIX E.

SELECT BIBLIOGRAPHY OF THE LITERATURE OF COPYRIGHT IN DESIGNS ARRANGED CHRONOLOGICALLY - - - 415—422

APPENDIX F.

ILLUSTRATIONS (Sheets I. to XII.) - - - - 423—434

INDEX - - - - - - - 435

COMPARATIVE TABLES.

I.—THE ACT OF 1907 AND THE REPEALED ACTS, 1883—1888.

Act of 1883.		Act of 1907.
Sect. 47.	Registration of Designs - - - -	Sect. 49
48.	Drawings, etc. to be furnished - - -	49 (1)
49.	Certificate of Registration - - - -	51
50.	Copyright on registration - - - -	53, 54 (1a)
51.	Marking of registered designs - - -	54 (1b)
52.	Inspection - - - - - -	56
53.	Information as to existence of copyright - -	57
54.	Cesser of copyright for non-manufacture - -	58
55.	The Designs Register - - - -	52 (1), (3)
56.	Fees on registration - - - - -	65
57.	Publication at exhibitions - - - -	59 (1)
58.	Penalty on piracy of registered design - -	60
59.	Action for damages - - - - -	60
60.	Definition of "design" and "copyright" - -	93
61.	Definition of "proprietor" - - - -	93
82.	The Patent Office - - - - -	62
83.	Officers and clerks - - - - -	63
84.	Seal - - - - - - -	64
85.	Trusts not to be entered on registers - -	66
86.	Power of Comptroller to refuse registration - -	75
87.	Entry of assignments, etc. on register - -	71
88.	Inspection of registers - - - -	67
89.	Sealed copies as evidence - - - -	79
90.	Rectification of registers by Court - - -	72
91.	Power for Comptroller to correct clerical errors -	70
93.	Falsification of entries in registers - - -	89
94.	Exercise of discretionary power by Comptroller -	73
95.	Power to take directions of law officers - -	74
96.	Certificate of Comptroller as evidence - -	78
97.	Applications and notices by post - - -	81
98.	Provision as to excluded days - - -	82
99.	Declarations by infant, lunatic, etc. - - -	83

Act of 1883.		Act of 1907.
Sect. 100.	Transmission of certified copies	Sect. 80
101.	Power for Board of Trade to make Rules	86
102.	Annual reports of Comptroller	76
103.	International arrangements for protection	91
104.	Provision for Colonies	88, 91
105.	Penalty for false representations as to registration, etc.	89
106.	Penalty on unauthorized use of Royal Arms	90
108.	Summary proceedings in Scotland	94 (2)
111.	Saving of general jurisdiction of Scotch and Irish Courts	94 (4), 95 (2)
112.	Provisions as to Isle of Man	96
113.	Repeal and saving as to repealed Statutes	98
114 (2).	Former registers to be deemed continued	28 (2), 52
115.	Saving for existing Rules	98 (1)
116.	Saving for prerogative	97
117.	General definitions	92 (1), 93
Act of 1885.		
Sect. 6.	Date of Convention—protection	91 (1)
Act of 1886.		
Sect. 3.	International exhibitions	59 (2)
Act of 1888.		
Sect. 1.	Register of patent agents	84
21.	Entry of assignments on register	71 (3)
22.	Inspection of register	67
23.	Rectification of register	72 (1)
24.	Correction of errors	70
25.	Proceedings of Board of Trade	87

II.—THE RULES OF 1908 AND THE REPEALED RULES, 1890—1898.

Rules of 1890.		Rules of 1908.
1.	Commencement	1
2.	Interpretations	2
3.	Fees	3
4 (amended by r. 3 of 1893).	Forms	4
5.	Classification of goods	6
6 (amended by r. 2 of 1898).	Applications by agents	12
7.	Lodging of application	2, 14
8.	Size of papers	7
9.	Sketches and drawings—description of design	18—20, 25
10.	Acceptance and certificate of registration	31
11.	Applications and notices by post	9
12.	Exercise of discretionary power by Comptroller	55, 56

Rules of 1800.		Rules of 1908.
13.	Hearing by Comptroller - - - -	57
14.	Notification of decision - - - - -	58
15.	Appeal to Board of Trade - - - - -	89
16.	Statement of grounds of appeal - - - -	90
17.	Notice to Secretary of Board of Trade - - -	91
18.	Directions of Board of Trade - - - -	92
19.	Notice of hearing - - - - -	93
20.	Entry of design on register - - - -	69
21, 22.	Application for entry of assignment - -	8, 44
23.	Particulars in request for entry - - -	45
24.	Statutory declaration with request - - -	46
25.	Proof of title - - - - - -	47
26.	Corporations as proprietors - - - -	8
27.	Notice of applications to the Court - - -	95
28.	Notice of order of Court - - - -	96
29.	Dispensing with evidence - - - -	62
30.	Amendments - - - - - -	63
31.	Enlargement of time - - - - -	64
32 (amended by r. 5 of 1893).	Marking of goods - -	68
33.	Hours of inspection - - - - -	61
34.	Certificate of legal proceedings - - - -	67
35.	Search for design - - - - -	60
36.	Notice of exhibition - - - - -	76
37.	Repeal - - - - - - -	98

TABLE OF CASES.

(*References, where the Judgments or facts of a case are set out, are* **in heavier type.**)

A.

Ace—Bat PAGE

Acetylene Illuminating Co. *v.* Midland Acetylene Syndicate (1900), 17 R. P. C. 534 - - - - - - 174, 251

Adair *v.* Young (1879), 12 Ch. Div. 13 - - - - 168

Adams *v.* Batley (1887), L. R. 18 Q. B. D. 625; 56 L. J. Q. B. 393; 56 L. T. 770; 35 W. R. 437 - - - - - 197

Adams *v.* Clementson (1879), 12 Ch. Div. 714; 27 W. R. 379 - **35** n.

Adamson's Patent, Re (1856), 25 L. J. Ch. 456 - - - **50**

American Braided Wire Co. *v.* Thompson (1890), 44 Ch. Div. 274; 59 L. J. Ch. 425; 62 L. T. N. S. 616; 7 R. P. C. 47 - - 164

American Tobacco Co. *v.* Guest, [1892] 1 Ch. 630; 61 L. J. Ch. 242; 66 L. T. 257; 40 W. R. 367; 9 R. P. C. 218 - - - **204**

Amos *v.* Chadwick (1878), 9 Ch. Div. 459; 47 L. J. Ch. 871; 39 L. T. N. S. 50; 26 W. R. 840 - - - - - - 180

Apollinaris Co.'s Trade Mark, Re, [1891] 2 Ch. 186; 61 L. J. Ch. 625; 65 L. T. N. S. 6; 8 R. P. C. 137 - - - 105, 259

Application, Re An, etc., 23 R. P. C. 288 - - - - 275

Astle (Titus) *v.* Mansfield (1905), 22 R. P. C. 356 - - **197**, 403

B.

Bach's Design, Re (1889), 42 Ch. Div. 661; 38 W. R. 174; 6 R. P. C. 376 - - - - **44**, 45, **87**, 107, 110, 222, 226

Bacon *v.* Jones (1839), 4 My. & Cr. 438; 48 R. R. 143 - - 170

Badische Anilin und Soda Fabrik *v.* Basle Chemical Works, [1898] A. C. 200; 14 R. P. C. 919; 77 L. T. N. S. 573; 14 T. L. R. 82; 46 W. R. 255 (*see* Badische Anilin, &c. *v.* Johnson, *infra*) - 186, 246

Badische Anilin und Soda Fabrik *v.* Hickson (1905), 22 R. P. C. 63, 275; L. R. [1905] 2 Ch. 495; 74 L. J. Ch. 669 - - 187, 246

Badische Anilin und Soda Fabrik *v.* Johnson, [1897] 2 Ch. 322; 14 R. P. C. 919; 45 W. R. 481; 66 L. J. Ch. 497; 76 L. T. N. S. 434 (*see* Badische Anilin, &c. *v.* Basle Chemical Works, *supra*) 186, 246

Badische Anilin, &c. *v.* Levinstein (1883), 24 Ch. Div. 146; 12 A. C. 710; 52 L. J. Ch. 704; 48 L. T. N. S. 822; 31 W. R. 913 - 192

Baker *v.* Rawson (1889), 45 Ch. Div. 519; 63 L. T. 306 - - 100

Barran *v.* Lomas (1880), 28 W. R. 973 - **78**, 149, 151, 246, 247

Batt's Trade Mark, [1898] 2 Ch. 432; 15 R. P. C. 262, 534; 16 R. P. C. 411; 78 L. T. N. S. 552; 14 T. L. R. 538; 46 W. R. 559 - - - - - - 100, 102, 256, 260

Bay—Cho PAGE

Bayer's Design, Re (Bayer *v.* Symington) (1906), 23 R. P. C. 553; (1907) 24 R. P. C. 65; (1908) 25 R. P. C. 86 - 20, 21, 23, 24, **26**, 33, 36, 37, 42, 43, 74, 75, 76, **81**, 88, **104**, 110, 112, 140, 159, 172, **190**, 196, 220, 222, 260, 268, 279, 280, 296, **426**

Bayer *v.* Connell (1897), 14 R. P. C. 275 - **108**, 111, **177**, 259, 283, 284

Beal, Ex parte (1868), L. R. 3 Q. B. 395; 37 L. J. Q. B. 161; 18 L. T. N. S. 285 - - - - - **161**, 208, 240, 271

Bentley *v.* Fleming (1844), 1 Car. & K. 587 - - - 31, **51**

Betts *v.* De Vitre (1868), 3 Ch. App. 429; L. R. 6 H. L. 319; 34 L. J. Ch. 289 - - - - - - - 183

Betts *v.* Neilson (1871), L. R. 3 Ch. 429; 5 H. L. 1; 40 L. J. Ch. 317; 19 W. R. 1121 - - - - - - 47

Betts *v.* Willmott (1871), L. R. 6 Ch. App. 239; 25 L. T. N. S. 188; 19 W. R. 369 - - - - - - - 281

Birkin *v.* Pratt (1895), 12 R. P. C. 375 - 43, **154**, 202, 223, **428**

Bishop *v.* Inman (1900), 17 R. P. C. 479, 759 - - 212, 251

Blank *v.* Footman (1888), 39 Ch. Div. 678; 57 L. J. Ch. 909; 59 L. T. N. S. 567; 36 W. R. 921; 5 R. P. C. 653 - **64**, 136, **137**, **202**, 223, 233, 234, 235

Boosey *v.* Whight, [1899] 1 Ch. 122; 81 L. T. N. S. 265; 69 L. J. Ch. 66; 16 T. L. R. 82; 48 W. R. 228 - - - - **173**

Bovill *v.* Crate (1865), L. R. 1 Eq. 388 - - - - 183

Bow *v.* Hart, [1905] 1 K. B. 592; 21 T. L. R. 251; 92 L. T. N. S. 181; 74 L. J. K. B. 341 - - - - **176**, 249, 276

Brereton *v.* Jackson (1884), 1 R. P. C. 165 - - - - **50**

Britain *v.* Hanks (1902), 86 L. T. 765 - - - - **56**

Britain *v.* Kennedy (1902), 19 T. L. R. 122 - - **144**, 169, 248

British Motors Syndicate *v.* Taylor (1900), 17 R. P. C. 189, 723; [1901] 1 Ch. 124; 82 L. T. N. S. 106; 83 L. T. N. S. 419; 17 T. L. R. 17 - - - - **164**, 186, 245, 246, 249

Brooke *v.* Milliken (1789), 3 T. R. 509 - - - - 161

Brookes *v.* Lycett (1903), 20 R. P. C. 392 - - - - 174

Browne *v.* Annandale (1842), 1 W. P. C. 433 - - - 67

Burge, Re (1887), 57 L. T. N. S. 364 - - - - 189

C.

Carez, Re (1889), 6 R. P. C. 552 - - - - - 274

Carpenter *v.* Smith (1841), 11 L. J. Ex. 213; 9 M. & W. 300; 1 W. P. C. 530 - - - - - - - **49**

Challender *v.* Royle (1887), L. R. 36 Ch. D. 425; 4 R. P. C. 363; 56 L. J. Ch. 995; 57 L. T. N. S. 734; 36 W. R. 357 - 213, 251

Chappell *v.* Purday (1845), 14 L. J. Ex. 258; 14 M. & W. 303; 9 Jur. 495 - - - - - - - - 107

Chard *v.* Cory (1892), 9 R. P. C. 423 - - - 153, 201

Cheavin *v.* Walker (1877), 5 Ch. Div. 850; 46 L. J. Ch. 686; 36 L. T. N. S. 938 - - - - 188, 208, **208**, 210, 271

Cheetham *v.* Oldham (1888), 5 R. P. C. 617, 622 - - 193, 194

Cla—Dun PAGE

Clarke's Design, Re (Clarke *v.* Saxo) (1896), 13 R. P. C. 351; [1896] 2 Ch. 38; 65 L. J. Ch. 620; 74 L. T. N. S. 631 - 20, 22, 32, **39**, 42, 44, **87**, 158, 187, 221, 222, 224, 225, 226, 247, 259, 280, 290, 296, 310

Colburn *v.* Simons (1843), 12 L. J. Ch. 388; 2 Haro, 543 - 172, 204

Colo *v.* Saqui (1888), 5 R. P. C. 489 - - - - - 158

Compagnie Générale d'Eaux Minérales Trade Mark, Re, [1891] 3 Ch. 402; 10 R. P. C. 446; 60 L. J. Ch. 728; 40 W. R. 89 - 111, 401

Cook *v.* Ingram, L. R. 35 Ch. D. 117 - - - - 200

Cooper *v.* Stephen, [1895] 1 Ch. 567; 72 L. T. N. S. 390; 11 T. L. R. 283; 64 L. J. Ch. 403; 43 W. R. 444 - - **146**, 188, 249

Cooper *v.* Symington (1893), 10 R. P. C. 264 - 22, 23, **25**, **36**, 43, 202, 223, 270

Cooper *v.* Whittingham (1880), 15 Ch. D. 501; 49 L. J. Ch. 752; 43 L. T. N. S. 16; 28 W. R. 720 - - 124, 166, 182, **204**, 248

Cornish *v.* Keene (1835), 6 L. J. C. P. 225; 1 W. P. C. 508; 43 R. R. 747 - - - - - - - 50, 58

Cowie Bros. *v.* Herbert (1896), 14 R. P. C. 436—443 - **108**, 177, 259, 263

Craig *v.* Dowding (1907), L. J. N. C. 654; (1908) L. J. N. C. 39 - 213, 251

Crossley *v.* Beverley (1829), 3 C. & P. 513; 9 B. & C. 63; 1 W. P. C. 119; 32 R. R. 57 - - - - - - 168, 245

Crossley *v.* Derby Gas Co. (1829), 4 L. J. Ch. 25; 41 R. R. 198 - 245

Crossley *v.* Dixon (1863), 32 L. J. Ch. 617; 8 L. T. N. S. 260; 11 W. R. 716; 9 Jur. N. S. 607; 10 H. L. C. 293 - 122, 189, 247

Crowther *v.* United Flexible Co. (1905), 23 R. P. C. 549 - 212, 251

Croysdale *v.* Fisher (1884), 1 R. P. C. 17 - - - 47, 58

D.

Dalgleish *v.* Jarvie (1850), 2 Mac. & G. 231; 20 L. J. Ch. 475 - 56, 223, 224

Davenport *v.* Rylands (1865), 1 Eq. 302; 35 L. J. Ch. 204; 14 L. T. N. S. 53; 14 W. R. 243 - - - - - - 164

Daw *v.* Eley (1865), 1 Eq. 38; 2 H. & M. 725; 13 L. T. N. S. 399; 14 W. R. 48 - - - - - - - **196**

De la Branchardière *v.* Elvery (1849), 18 L. J. Ex. 381; 4 Ex. 380 - **136**, 188, 223, 233, 248

De la Rue *v.* Dickinson (1857), 3 K. & J. 398 - - - **196**

Demartial *v.* Booth (1892), 9 R. P. C. 499 - - - 43, 153, 202

Dewars, Ltd. *v.* J. T. Dewar (1899), 17 R. P. C. 341; 2 F. C. (Scotch) 249; 7 S. L. J. 462 - - - - - 108, 282

Dilworth, Re (1833), 1 Deac. & C. 411 - - - 128, 257

Drake *v.* Muntz Metal Co. (1886), 3 R. P. C. 43 - - - 192

Dunlop *v.* Wapshare Tube Co. (1900), 17 R. P. C. 433 - - 203

E.

East—Gui PAGE

East India Co. *v.* Kynaston (1821), 3 Bligh, 153 - - - 193
Edison *v.* Holland (1888), 5 R. P. C. 213; W. N. (1888) 31 - - 197
Edison Telephone Co. *v.* India Rubber Co. (1880), 17 Ch. Div. 137; 29 W. R. 496 - - - - - - - 191
Electric Plating Co. *v.* Holland (1901), 18 R. P. C. 521 - - 50
Ellis *v.* Marshall (1895), 64 L. J. Q. B. 775; 15 R. 561; 11 Times L. R. 522 - - - - - - - - 162
Elmor *v.* Cronsy (1873), L. R. 9 Ch. 69; 43 L. J. Ch. 166; 29 L. T. N. S. 632; 22 W. R. 141 - - - - - - 190
Emperor of Austria *v.* Day and Kossuth, 3 D. F. & J. 217; 30 L. J. Ch. 690; 4 L. T. N. S. 274, 494; 9 W. R. 566, 712 - - 124
Engels *v.* Hubert Syndicate (1902), 19 R. P. C. 201 - - 212, 251
Eno *v.* Dunn (1890), 15 App. Ca. 252; 58 L. J. Ch. 604; 63 L. T. N. S. 6; 39 W. R. 161; 7 R. P. C. 311 - - - 88, 225

F.

Farina's Trade Mark, Re (1881), 44 L. T. N. S. 99; 29 W. R. 391 - 101
Fielding *v.* Hawley (1883), 48 L. T. N. S. 639 - **135, 136**, 232, 233, 279
Floworwoll *v.* Noweritton, 88 Fed. Rep. 698; 25 Rul. Cas. 265 - 24

G.

Geary *v.* Norton (1846), 3 My. & Cr. 338; 1 De G. & Sm. 9 - **168**, 204
Gorm Milling Co. *v.* Robinson (1884), 1 R. P. C. 217 - - 194
Gorm Milling Co. *v.* Robinson (1886), 3 R. P. C. 11, 254 - 51, 192, 193, 195
Gill *v.* Coutts (1896), 13 R. P. C. 137 - - 47, **49**
Gillard *v.* Worrall (1904), 22 R. P. C. 76 - - **158**, 247, 280, **417**
Gordon and Munro *v.* Patrick (1894), 12 R. P. C. 22 - **79**, 153, 154, 228, 247
Grace *v.* Newman (1875), 19 Eq. 623; 44 L. J. Ch. 298; 23 W. R. 517 - - - - - - - - 204
Grafton *v.* Watson (1884), 50 L. T. N. S. 420; 51 L. T. N. S. 141 - 24, 43, 149, **151**, 153, 154, **171**, 203, 223, 246, 247, 279
Graves, Re (1869), L. R. 4 Q. B. 724; 39 L. J. Q. B. 31; 20 L. T. N. S. 877; 17 W. R. 1018 - - - - - 107
Great Tower Tea Co. *v.* Smith (1889), 6 R. P. C. 165 - - 108
Green's Patent, Re (1857), 24 Beav. 145 - - - - **107**
Groenlees' Trade Mark, Re (1892), 9 R. P. C. 93 - - - 101
Griffith *v.* Hughes, [1892] 3 Ch. 105; 62 L. J. Ch. 135; 66 L. T. N. S. 760; 40 W. R. 524 - - - - - **125**, 248
Grocott's Design, Re (1899), 17 R. P. C. 139 - 91, 100, **101**, 118, 257, 259, 260, 280, 402
Guitermann's Design, Re (1886), 55 L. J. Ch. 309 (*and see* Ex parte Wild, 2 Times L. R. 174) - - - 100, **101**, **121**, 220, 260, 281

II.

Hab—Hol

PAGE

Habershon *v.* Gill (1875), W. N. 231 - - - - 193
Haggenbrucher *v.* Watson (1807), 14 R. P. C. 349, 621 - - 50
Hanfstaengl *v.* W. H. Smith & Sons, [1905] 1 Ch. 519; 21 T. L. R. 291; 74 L. J. Ch. 304; 92 L. T. N. S. 351 - 140, **206**, 240, 279
Hanfstaengl Art Publishing Co. *v.* Holloway, [1893] 2 Q. B. 1; 62 L. J. Q. B. 347; 5 R. 358; 68 L. T. N. S. 676; 57 J. P. 407 - 130
Hardtmuth *v.* Baker, 22 R. P. C. 66 - - - 174, 251
Harper *v.* Wright and Butler (1895), 12 R. P. C. 483; [1895] 2 Ch. 593; [1896] 1 Ch. 142; 12 T. L. R. 53; 65 L. J. Ch. 161; 63 L. T. N. S. 480 - **37**, **48**, 66, 75, 79, **103**, **139**, 149, 153, 199, 172, 220, 221, 222, 234, 247, 296, 400, **418**
Harris *v.* Rothwell (1887), 35 Ch. Div. 416; 56 L. J. Ch. 459; 56 L. T. N. S. 52; 35 W. R. 581; 4 R. P. C. 225 - - **61**, 62, 224
Harrison *v.* Taylor (1859), 29 L. J. Ex. 3; 4 H. & N. 815; 5 Jur. N. S. 1219 - - - 20, 33, 34, **41**, 42, 221, 222, 279
Haskell Golf Ball Co. *v.* Hutchison and Main (1904), 21 R. P. C. 497; 20 T. L. R. 606 - - - - - 213, 251
Haslam Co. *v.* Hall (1888), 5 R. P. C. 1 - - - - 197
Haslett *v.* Hutchinson (1891), 8 R. P. C. 457 - 94 (n.), 100, 254
Hatton *v.* Kean (1859), 29 L. J. C. P. 127; 8 W. R. 7; 7 C. B. N. S. 268; 6 Jur. N. S. 226; 1 L. T. 10 - - - 116, 281
Heap *v.* Hartley (1889), 42 Ch. Div. 461; 58 L. J. Ch. 790; 41 L. T. 538; 38 W. R. 136; 6 R. P. C. 49 - - - 179, 180
Heath *v.* Rollason. (*See* Re Rollason's Design.)
Heathfield *v.* Braby, Set. 561 - - - - - 195
Hecla Foundry Co. *v.* Walker, Hunter & Co. (1889), 14 App. Ca. 550; 59 L. J. P. C. 46; 6 R. P. C. 554 - - 22, 23, **27**, 43, 153, 247, 279, 280
Heinrich's Design, Re (1892), 9 R. P. C. 73 - **118**, 127, 280
Heinrichs *v.* Bastendorff (1893), 10 R. P. C. 160 - 42, **66**, 131, 222, 223, 309
Hennessy *v.* Bohmann (1877), W. N. 14 - - - - 192
Heurteloupe's Patent (1836), 1 W. P. C. 553 - - - 61
Heywood *v.* Potter (1853), 22 L. J. Q. B. 133; 20 L. T. N. S. 207; 1 E. & B. 439 - - - - - 135, 136, **137**, 232
Hildesheimer *v.* Dunn (1891), 64 L. T. N. S. 452 - - - 170
Hildesheimer *v.* Faulkners, [1901] 2 Ch. 552; 17 T. L. R. 757; 70 L. J. Ch. 800; 85 L. T. N. S. 322; 49 W. R. 708 - - **162**, 249
Hills *v.* Evans (1862), 31 L. J. Ch. 457; 4 De G. F. & J. 288; 8 Jur. N. S. 525; 6 L. T. N. S. 90 - - - - - 63
Hoffmann *v.* Postill (1869), L. R. 4 Ch. 673; 20 L. T. N. S. 893; 17 W. R. 901 - - - - - - 197, 198
Holden *v.* Hodgkinson (1904), 22 R. P. C. 102 - **157**, 246, 397
Holdsworth *v.* McCrea (1867) (*see* McCrea *v.* Holdsworth (No. 3), *infra*), L. R. 2 H. L. 380; 36 L. J. Q. B. 297; 16 W. R. 226 - 20, 75, **77**, **153**, 222, 247, 279
Holo *v.* Bradbury (1879), 12 Ch. Div. 886; 48 L. J. Ch. 673; 41 L. T. 250; 28 W. R. 39 - - - **123**, 166, **173**, 182, 248
Holliday *v.* Hoppenstall (1889), 6 R. P. C. 320; L. R. 41 Ch. D. 109; 61 L. T. N. S. 313; 58 L. J. Ch. 829; 37 W. R. 662 - 187, 192

Hor—Kur PAGE

Horsley and Knighton's Patent (1869), 8 Eq. 475; 39 L. J. Ch. 157; 21 L. T. N. S. 345; 17 W. R. 1054 - - 107, 250

Hothersall *v.* Moore (1892), 9 R. P. C. 27 - - 42, 84, 85, 127, 136, **138**, 153, 187, 224, 233, 234, 246, 279, 280

Household Coal Co. *v.* Neilson (1843), 1 W. P. C. 673 - 50, 50

Humphereon *v.* Syer (1887), 4 R. P. C. 407 - - **51**, 63, 64, 223, 235

Hunt *v.* Stevens (1878), W. N. 79 - - - 64, 131, 223, 232

Hutchisons Ltd. *v.* St. Mungo Co. (1907), 24 R. P. C. 205 - 33, **35**, 40, **149**

I.

Ihlee *v.* Honshaw (1886), 31 Ch. Div. 323; 55 L. J. Ch. 273; 53 L. T. 949; 34 W. R. 269 - - - - **124**, 182, 248, 280

Ingram and Komp *v.* Edwards (1904), 21 R. P. C. 463 - 136, **138**, 153, **166**, 223, 233, 247, 249, **420**

Isaacs *v.* Fiddemann (1880), 42 L. T. N. S. 395 - - - 182

J.

Jan *v.* Grossman (1895), 12 R. P. C. 537 - - - **206**, 248

Joffroys *v.* Boosey (1854), 4 H. L. C. 815; 24 L. J. Ex. 81; 3 C. L. R. 625; 1 Jur. N. S. 615 - - - - - - **54**

Jenkins *v.* Bushby, [1891] 1 Ch. 484; 60 L. J. Ch. 254; 64 L. T. N. S. 213; 39 W. R. 321 - - - - - - 200

Jewitt *v.* Eckhardt (1878), 8 Ch. Div. 404; 26 W. R. 415 - 97, **121**, 122, 125, 128, 180, 228, 233, 248, 257, 281

Johnson *v.* Bailey (1893), 11 R. P. C. 21 - **133**, 135, 137, 200, 232, 234

Johnson *v.* Edge (1891), 9 R. P. C. 142 - - - 212, 251

Jones *v.* Pearce (1832), 1 W. P. C. 122 - - - - 50

K.

Kelly *v.* Hodge (1870), cited 1 Seton, 668 - - - - 124

Kenrick *v.* Lawrence (1890), L. R. 25 Q. B. D. 99; 38 W. R. 79 - 117

Kinahan *v.* Kinahan (1890), L. R. 35 Ch. D. 78; 8 R. P. C. 18; 59 L. J. Ch. 705; 62 L. T. N. S. 718; 38 W. R. 655 - - 108

King & Co.'s Trade Mark, Re (1892), L. R. 2 Ch. 462; 62 L. J. Ch. 153; 67 L. T. N. S. 33; 40 W. R. 580; 9 R. P. C. 350 - 108, **109**, 111, 177, 259, 283, 401

Knowles *v.* Bennett (1895), 12 R. P. C. 137 - - - **171**, 173

Kurtz *v.* Spence (1888), L. R. 33 Ch. D. 579; 5 R. P. C. 161; 55 L. J. Ch. 919; 55 L. T. N. S. 317; 36 W. R. 357 - - 213

L.

Lan—Mag PAGE

Landoker and Brown *v.* Wolff (1908), Law Journal (1908), p. 37 - 281

Lang *v.* Gisborne (1862), 31 L. J. Ch. 709; 6 L. T. N. S. 771; 10 W. R. 638; 31 Beav. 133 - - - - - 58, 59, 224

Lang *v.* Whitecross Iron Co. (1890), 7 R. P. C. 380 - - - 191

Lauri *v.* Renad, [1892] 3 Ch. 402; 61 L. J. Ch. 580; 69 L. T. N. S. 275; 40 W. R. 679 - - - **126**, 188, 220, 248, 281, 302

Lazarus *v.* Charles (1873), 16 Eq. 117; 42 L. J. Ch. 507 - 33, 39, 41, 67, **119**, 222, 280, 281

Le May *v.* Welsh (1884), 28 Ch. Div. 24; 54 L. J. Ch. 279; 51 L. T. N. S. 867; 33 W. R. 33 - - - - **38**, 100, 159, 222

Lea *v.* Saxby (1875), 32 L. T. N. S. 731 - - - - 196

Lea and Perrins *v.* Price & Son, 22 R. P. C. 122 - 136, **139**, 233, **422**

Leather Cloth Co. *v.* American Leather Cloth Co. (1865), 11 H. L. C. 543; 35 L. J. Ch. 53; 11 Jur. N. S. 513; 12 L. T. N. S. 742; 13 W. R. 873; 6 N. R. 209 - - - - - 208

Leather Cloth Co. *v.* Hirschfeld, 1 H. & M. 295; 11 W. R. 933; 1 N. R. 551 - - - - - - - 167

Ledgard *v.* Bull (1886), 11 App. Ca. 648 (reported as Potman *v.* Bull, 3 R. P. C. 390) - - - - - - 192

Levi *v.* Champion (1887), 3 Times L. R. 286 - - - 119

Lewis *v.* Marling (1829), 1 W. P. C. 493; 10 B. & C. 22 - - 31

Lifeboat Co. *v.* Chambers (1891), 8 R. P. C. 418 - - - **50**

Lister *v.* Norton (1885), 2 R. P. C. 68 - - - - 196

Liverpool Brokers' Association *v.* Commercial Press, [1897] 2 Q. B. 1 - - - - - - - - 123

London Printing and Publishing Alliance *v.* Cox, [1891] 3 Ch. 291; 60 L. J. Ch. 707; 75 L. T. N. S. 545; 45 W. R. 299 - - 181

Longman *v.* Oxberry (1820), cited Godson on P. 314 - - 122

Longman *v.* Tripp (1805), 2 Bos. & P. 12 N. R. 67 - - - 128

Losh *v.* Hague (1837), 1 W. P. C. 200; 8 L. J. Ex. 251; 5 M. & W. 387 - - - - - - - - 168

Lowndes *v.* Browne (1848), 12 Ir. L. R. 293 - - - 187

Lycett *v.* Brooks (1904), 21 R. P. C. 656 - - - - 213

Lyon *v.* Mayor, &c. of Newcastle-upon-Tyne (1894), 11 R. P. C. 218 - - - - - - - - **204**

M.

McCrea *v.* Holdsworth (No. 1) (1848), 2 De G. & Sm. 496 - 168, 172, 399

McCrea *v.* Holdsworth (No. 2) (1866), L. R. 1 Q. B. 264 - - 201

McCrea *v.* Holdsworth (No. 3) (1870), 6 Ch. 418; 23 L. T. N. S. 444; 19 W. R. 36 - - - - - 39, 78, 247

Macdougal *v.* Partington (1890), 7 R. P. C. 357, 472 - - 193

Mackie *v.* Laundry Supply Co. (1891), 9 R. P. C. 465 - 212, 251

Macnamara *v.* Hulse (1842), Car. & M. 471 - - - 190

Magnolia Metal Co. *v.* Atlas Co., [1897] 2 Ch. 371; 14 R. P. C. 389; 66 L. J. Ch. 598; 76 L. T. N. S. 672 - - - 124, 182

Mak—Now PAGE

Makopoulos *v.* Jackson (1814), 4 Taunt. 770 - - - - 119
Mallott *v.* Howitt (1879), W. N. 107 - - - 183, 245
Mann's Patent, Re, 7 R. P. C. 13 - - - - - 274
Mansell *v.* Valley Printing Co., (1908) W. N. 41; 24 Times L. R. 311 - 52
Margetson *v.* Wright (1848), 2 De G. & S. 420 - - 23, 24
Marshall *v.* Bull (1900), 16 T. L. R. 501; 17 T. L. R. 684; 85 L. T. N. S. 77 - - - - - - - 147, 188, 249
Marshall *v.* Ross (1869), 8 Eq. 651 - - - - 208, 271
Meadows *v.* Kirkman (1860), 29 L. J. Ex. 205 - - - 194
Melville *v.* Mirror of Life Co., [1895] 2 Ch. 531; 65 L. J. Ch. 41; 13 R. 852; 73 L. T. N. S. 334 - - - - - 117
Moxborough *v.* Whitwood Urban District Council, [1897] 2 Q. B. 111; 66 L. J. Q. B. 637; 76 L. T. N. S. 765; 45 W. R. 564 - 198
Millingen *v.* Pickon (1845), 14 L. J. C. P. 254; 1 C. B. 808 - 23
Millington *v.* Fox (1846), 3 My. & Cr. 338 - - - 168, 204
Minter *v.* Williams (1835), 5 L. J. K. B. 60; 4 A. & E. 257; 5 N. & M. 647; 1 H. & W. 585; 1 W. Pat. C. 135 - - - 245
Mitchell *v.* Henry (1880), 15 Ch. Div. 181; 43 L. T. N. S. 186 - 153, 157, **170**, 247
Moot *v.* Cowston (1864), 33 Beav. 578; 10 L. T. N. S. 395 - - 146
Moody *v.* Tree (1892), 40 W. R. 559; 9 R. P. C. 333 - 22, 23, **25**, 26, 33, 36, 43, 176, 221, 222, 279
Moore *v.* Craven (1870), L. R. 7 Ch. 94, n. - - - - **196**
Morey's Patent (1858), 25 Beav. 581; 6 W. R. 612 - - **107**, 259
Morgan *v.* Seaward (1836), 1 W. P. C. 170; 2 M. & W. 544; 6 L. J. Ex. 153 - - - - - - - - 51
Morris *v.* Edwards (1890), 15 App. Ca. 309; 60 L. J. Q. B. 292; 63 L. T. N. S. 26 - - - - - - - 197
Morris, Wilson & Co. *v.* Coventry Machinist Co., [1891] 3 Ch. 418; 60 L. J. Ch. 524; 40 W. R. 152; 8 R. P. C. 353 - - - **191**
Morrison *v.* Asplin, 21 R. P. C. 557 - - - - 174, 251
Morton's Design, Re (Morton *v.* Emanuel) (1899), 17 R. P. C. 117 - 43, 136, **138**, 159, 176, 234, 259, 279, 398
Moul *v.* Groenings, [1891] 2 Q. B. 443; 60 L. J. Q. B. 715; 65 L. T. N. S. 327; 39 W. R. 691 - - - - - - 130
Mullooy *v.* Stevens (1864), 10 L. T. N. S. 190 - - 42, 44
Murray *v.* Clayton (1872), L. R. 15 Eq. 110; 7 Ch. 570; 20 W. R. 649 - - - - - - - - 167

N.

Nevill *v.* Bennett (1898), 15 R. P. C. 412 - **24**, 37, 42, **66**, 116, 118, **120**, **156**, 221, 222, 223, 235, 247, 281
New Inverted Gas Lamp Co. *v.* Cope and Timmins (1906), 23 R. P. C. 103 - - - - - - 174, 251
New Inverted Gas Lamp Co. *v.* Globe Light Co. (1906), 23 R. P. C. 157 - - - - - - 174, 251
New Ormonde Cycle Co.'s Trade Mark, Re (1896), 13 R. P. C. 475 - 100
Newall *v.* Elliott (1858), 27 L. J. C. P. 337; 4 C. B. N. S. 293 - 50

Nic—Pik PAGE

Nicholls *v.* Parker (1901), 18 T. L. R. 459 - - - - 162
Nicholson *v.* Botts, L. R. 4 H. L. 22 - - - - 167
Nobel's Explosives Co. *v.* Jones (1880), 17 Ch. Div. 721; 8 App. Ca. 5; 49 L. J. Ch. 720; 48 L. T. 490; 31 W. R. 388 - 146, 183, 186
Normal Trade Mark, Re (1886), 35 Ch. Div. 231; 56 L. J. Ch. 513; 56 L. T. N. S. 246; 35 W. R. 464; 4 R. P. C. 123 - 99, 225, 259
Norton *v.* Nicholls (1859), 28 L. J. Q. B. 225; 33 L. T. O. S. 131; 7 W. R. 720; 5 Jur. N. S. 1203; 1 E. & E. 761 - 24, 42, 76, **143**, 248
Nottage *v.* Jackson (1883), L. R. 11 Q. B. D. 627; 52 L. J. Q. B. 760; 49 L. T. N. S. 339; 32 W. R. 106 - - - - **117**
Nunn *v.* Albuquerque (1865), 34 Beav. 595 - - - 204

O.

Oliver *v.* Thornley (1896), 13 R. P. C. 490 - - - **154, 427**
Ormonde Cycle Co.'s Trade Mark, Re, 13 R. P. C. 475 - - 100
Otto *v.* Steel (1885-6), 31 Ch. Div. 241; 55 L. J. Ch. 196; 54 L. T. N. S. 157; 34 W. R. 289; 3 R. P. C. 109 - - **61**, 224
Ottos Kopje Diamond Mines, [1893] 1 Ch. 618; 62 L. J. Ch. 166; 68 L. T. N. S. 138; 41 W. R. 258 - - - - 103
Oxley *v.* Holden (1860), 30 L. J. C. P. 68; 2 L. T. N. S. 464; 8 W. R. 626; 8 C. B. N. S. 666 - - - - - 64

P.

Pascall *v.* Toupe (1890), 7 R. P. C. 125 - - - - 191
Patent Agents, Institute of *v.* Lockwood, [1894] A. C. 347 - - 268
Patent Marine Inventions Co. *v.* Chadburn (1873), L. R. 16 Eq. 447; 28 L. T. N. S. 614; 21 W. R. 745 - - - - 199
Patent Plumbago Crucible Co.'s Trade Mark (1890), 7 R. P. C. 282 - 102
Patent Type Founding Co. *v.* Walter (1860), Johns. 727; 29 L. J. Ex. 207 - - - - - - - - 193
Patterson *v.* Gas Light and Coke Co. (1875), 3 App. Ca. 239; 47 L. J. Ch. 402; 38 L. T. N. S. 303; 26 W. R. 482 - - 57
Pearson *v.* Wilkinson (1906), 23 R. P. C. 738 - **40**, 116, **117**, **202**, 221, 246, 281, **421**
Pelouze Scale Co. *v.* American Cutlery Co., 102 Fed. Rep. 916; 25 Rul. Cas. 266 - - - - - - - 19
Perrins *v.* Price (1904), 22 R. P. C. 122. (*See* Lea & Perrins *v.* Price.)
Petty *v.* Taylor, [1897] 1 Ch. 465; 75 L. T. N. S. 545; 66 L. J. Ch. 209 - - - - - - 117, **181**, 280
Philpott *v.* Hanbury (1885), 2 R. P. C. 33 - - - - **63**
Pickard *v.* Prescott, [1892] A. C. 263; 9 R. P. C. 195 - - 61
Pierce *v.* Worth (1868), 18 L. T. N. S. 710; W. N. (1868) 217 - 131, **132**, 137, 232
Piggott *v.* Anglo-American Telegraph Co. (1868), 19 L. T. N. S. 46 - 194
Pike *v.* Nicholas (1870), L. R. 5 Ch. 260; 39 L. J. Ch. 435; 18 W. R. 321 - - - - - - **164**, 249

Pin—Rob PAGE

Pinto *v.* Badman (1891), 8 R. P. C. 181 - - - - 109

Pitts *v.* George, [1890] 2 Ch. 866; 66 L. J. Ch. 1; 75 L. T. N. S. 320; 45 W. R. 164 - - - - - - 281

Plackett's Design (1891), 9 R. P. C. 436 - - - 42, 43, 221

Plating Co. *v.* Farquharson (1883), Griff. P. C. 187 - - 195

Plimpton *v.* Malcolmson (1876-6), 3 Ch. Div. 531; 44 L. J. Ch. 257; 45 L. J. Ch. 505; 34 L. T. N. S. 340 - - 58, **59**, 63, 224

Plimpton *v.* Spiller (1877), 6 Ch. Div. 412; 47 L. J. Ch. 212; 37 L. T. N. S. 56; 26 W. R. 285 - - - 58, 59, **60**, 224

Pneumatic Tyre Co.'s Design, Re (1894), 11 R. P. C. 636 - **102** (n.), 257, 260

Pneumatic Tyre Co., Ltd. *v.* Puncture Proof Pneumatic Tyre Co., Ltd. (1899), 16 R. P. C. 209 - - - - - **165**

Potter *v.* Braco do Prata Printing Co. (1891), 8 R. P. C. 218 - 146, 180, 224, 232, 233, 235, 246, 280

Poulton, Ex parte, 53 L. J. Q. B. 320; 32 W. R. 648 - - 107

Powell *v.* Head (1879), 12 Ch. Div. 686; 48 L. J. Ch. 731; 41 L. T. N. S. 70 - - - - - - - 126, 188, 248

Powell's Trade Mark, Re, 41 W. R. 627; 10 R. P. C. 195; 11 R. P. C. 4; [1893] 2 Ch. 388; [1894] A. C. 8; 63 L. J. Ch. 152; 69 L. T. N. S. 60 - - - - - - - **105**, 259

Prince Albert *v.* Strange (1849), 18 L. J. Ch. 120; 1 Mac. & G. 25; 1 H. & T. 1; 13 Jur. 109, 507; 2 De G. & Sm. 652 - **53**, 124

Proctor *v.* Bayley (1889), 42 Ch. Div. 390; 59 L. J. Ch. 12; 38 W. R. 100- - - - - - 168, **169**, 204

Proctor *v.* Sutton Lodge Chemical Co. (1888), 5 R. P. C. 184 - 276

R.

Read and Greswell's Design, Re (1889), 42 Ch. Div. 260; 58 L. J. Ch. 624; 61 L. T. N. S. 450; 6 R. P. C. 471 - **44**, 67, **86**, 100, 107, 110, 187, 222, 224, 226, 227

Read *v.* Richardson (1881), 45 L. T. N. S. 54 - - - 170

Reg. *v.* Bessell (1851), 20 L. J. M. C. 177; 16 Q. B. 810; 15 Jur. 773 - - - - - - - - - 24

Reg. *v.* County Court Judge of Halifax, [1891] 2 Q. B. 263; 60 L. J. Q. B. 550; 65 L. T. N. S. 104; 39 W. R. 545; 8 R. P. C. 338 - 176, 276

Reg. *v.* Crampton (1886), 3 R. P. C. 367 - - - 208, 271

Reg. *v.* Firmin (1851), 3 H. & N. 304; 15 J. P. 570 - **41**, 222

Reg. *v.* Wallis (1886), 3 R. P. C. 1 - - - - 208, 210

Reid *v.* Thompson (1905), 22 R. P. C. 376 - 103, 108, 109, 213, 283

Renard *v.* Levinstein (1864-5), 10 L. T. N. S. 95; 11 L. T. N. S. 505 - - - - - - - - - 194

Rivett *v.* Grimshaw (1894), 11 R. P. C. 351 - - 42, **161**, 191, 249

Rivière's Trade Mark, Re (No. 1) (1884), 26 Ch. Div. 48; 53 L. J. Ch. 455, 578; 50 L. T. N. S. 763; 32 W. R. 390 - - **105**, 112

Rivière's Trade Mark, Re (No. 2) (1885), 55 L. J. Ch. 545; 53 L. T. N. S. 237 - - - - - - - - **101**

Robertson, Sanderson & Co.'s Trade Mark, Re, 9 R. P. C. 215 - 111

Rog—Sod PAGE

Rogers *v.* Driver (1850), 20 L. J. Q. B. 31; 16 Q. B. 102 - 23, 24, 222

Rollason's Design (Heath *v.* Rollason) (1897), 14 R. P. C. 893, 909; 15 R. P. C. 441; [1898] 1 Ch. 237 (H. L.); App. Cas. 400; 77 L. T. N. S. 605; 67 L. J. Ch. 100; 14 T. L. R. 71, 478 - 14, 18, 20, 21, **28**, 33, **37**, 40, 73, 75, 80, 85, **133**, 150, 210, 221, 222, 234, 268, 279, 289, 296, 300, **420**

Rolls *v.* Isaacs (1878), 19 Ch. D. 268; 51 L. J. Ch. 170; 45 L. T. N. S. 704; 30 W. R. 243 - - - - - - 67

Rust & Co.'s Trade Mark, Re (1881), 44 L. T. N. S. 98; 29 W. R. 393 - - - - - - - - **101**

Rylands *v.* Ashley (1890), 7 R. P. C. 175 - - - - 198

S.

Saccharin Corporation *v.* Chemicals and Drug Co. (1900), 17 R. P. C. 28, 612, 743; 83 L. T. N. S. 206 - - - **167**, 249, 400, 401

Saccharin Corporation *v.* Reitmeyer, [1900] 2 Ch. 659; 17 R. P. C. 606; 69 L. J. Ch. 761 - - - - - - 187

Sarazin *v.* Hamel (No. 1) (1863), 32 L. J. Ch. 378 - - - 185

Sarazin *v.* Hamel (No. 2) (1863), 32 L. J. Ch. 380; 7 L. T. N. S. 6, 560; 32 Beav. 151 - - - - 131, 135, 232, 234

Saunders *v.* Wiel (No. 1), [1892] 2 Q. B. 321; 62 L. J. Q. B. 37; 67 L. T. 207; 40 W. R. 594; 9 R. P. C. 459 - 163, 185, 197, 249, 280

Saunders *v.* Wiel (No. 2) (1892), 9 R. P. C. 467; 10 R. P. C. 29; [1893] 1 Q. B. 470; 62 L. J. Q. B. 341; 68 L. T. N. S. 183; 41 W. R. 356 - - - - - **28**, **34**, 162, 221, 222, 246, 249, 279

Schauer *v.* Field (1893). 1 Ch. 35; 62 L. J. Ch. 72; 68 L. T. N. S. 81; 3 R. 78; 41 W. R. 201 - - - - - 130

Sen Sen Co. *v.* Britten (1899), 16 R. P. C. 137; 80 L. T. N. S. 278; 15 T. L. R. 238 - - - 103, **172**, 208, **209**, 210, 271

Shallenberger, Re (1889), 6 R. P. C. 550 - - - - 274

Shaw *v.* Bank of England (1852), 22 L. J. Ex. 26 - - - 194

Shepherd *v.* Conquest (1856), 17 C. B. 427; 25 L. J. C. P. 127; 2 Jur. N. S. 236; 4 W. R. 283 - - - - 116, 281

Sheriff *v.* Coates (1830), 1 Russ. & My. 159 - - - 168, 170

Sherwood *v.* Decorative Tile Co. (1887), 4 R. P. C. 207 - **32**, **42**, 149, **152**, 161, 201, 221, 222, 246, 247, 249

Sherwood's Design, Re (1892), 9 R. P. C. 268 - - **48**, **66**, 221

Sidebottom *v.* Fielden (1891), 8 R. P. C. 266 - - - 193

Singer Manufacturing Co. *v.* Wilson (1865), 13 W. R. 560 - - 194

Smith *v.* Chatto (1875), 31 L. T. N. S. 775 - - - - 170

Smith *v.* Hope (1889), 6 R. P. C. 200 - 39, 100, 107, 222, 235, 238, 263, 306

Smith *v.* Lewis Roberts & Co. (1888), 5 R. P. C. 611, 614 - 143, **144**, 204, 245, 248

Smout *v.* Sleymaker (1890), 7 R. P. C. 90 - - **47**, 100, 220, 246

Soda Fabrik *v.* Johnson, [1897] 2 Ch. 322; 14 R. P. C. 919; 66 L. J. Ch. 497; 76 L. T. N. S. 434; 45 W. R. 481 - 186, 246

Sodastream, Ltd. *v.* Davey (1907), 24 R. P. C. 763 - - - 174

Spo—Upm

PAGE

Spottiswoode *v.* Clark (1846), 2 Phil. 151 - - - - 170
Springfield *v.* Thame (1903), 19 T. L. R. 650 - - 116, 281
Stannard *v.* Harrison (1871), 24 L. T. 579; 19 W. R. 811 - - **117**
Staples *v.* Warwick (1906), 23 R. P. C. 609 - - **155**, 246, **425**
Stead *v.* Anderson (1846), 2 W. P. C. 147 - - - - 58
Stead *v.* Williams (1843), 2 W. P. C. 126; 7 M. & G. 818 - **49**, 58, 62, 224
Stead's Patent, Re (1847), 2 W. P. C. 123, 156 - - - 158
Stewart *v.* Casey, [1892] 1 Ch. 104; 61 L. J. Ch. 61; 66 L. T. N. S. 93; 40 W. R. 180; 9 R. P. C. 9 - - **94**, 127, 228, 254, 281
Sugg *v.* Bray (1885), 2 R. P. C. 223 - - - - - 213
Sugg *v.* Silber, L. R. 1 Q. B. D. 362; 45 L. J. Q. B. 460; 34 L. T. N. S. 682; 24 W. R. 640 - - - - - - 200
Swinborne *v.* Nelson (1852—53), 22 L. J. Ch. 331; 16 Beav. 416, 417 - - - - - - - - 196
Sykes *v.* Howarth (1879), 12 Ch. Div. 826; 48 L. J. Ch. 769; 41 L. T. 79; 28 W. R. 215 - - - - - **190**, 216

T.

Talbot's Trade Mark, Re (1894), 63 L. J. Ch. 264; 11 R. P. C. 77 - - - - - - - - 107, 259
Taylor's Patent, Re (1896), 13 R. P. C. 150 - - - - 49
Thom *v.* Sydall (1872), 26 L. T. N. S. 15; 20 W. R. 291 - 34, 78, 148, 221, 222, 246
Thomas *v.* Hunt (1864), 17 C. B. N. S. 183 - - - 146, 188
Thompson *v.* Macdonald (1890), 8 R. P. C. 5 - - - - 63
Tonge *v.* Ward (1869), 21 L. T. N. S. 480 - - - - 183
Trotter *v.* McLean (1879), 13 Ch. Div. 574; 49 L. J. Ch. 256; 42 L. T. 118; 28 W. R. 244 - - - - - - 265
Tuck & Sons *v.* Canton (1882), 51 L. J. Q. B. 363 - - 121, 179
Tuck & Sons *v.* Priester (1887), L. R. 19 Q. B. D. 48, 629; 56 L. J. Q. B. 553; 36 W. R. 93; 52 J. P. 213 - - - - 119
Turner *v.* Robinson (1860), 10 Ir. Ch. 374, 510 - - - **55**
Tyler *v.* Sharpe (1893), 11 R. P. C. 35 - - 36, 43, 221, 247

U.

United Horseshoe & Nail Co. *v.* Stewart (1888), 13 App. Ca. 491; 5 R. P. C. 260 - - - - - - - - 164
United States Playing Cards Co.'s Application, Re (1907), [1908] 1 Ch. 197; 24 Times L. R. 140 - - - - - 34
United Telephone Co. *v.* Harrison (1882), 21 Ch. Div. 720; 51 L. J. Ch. 705; 46 L. T. N. S. 620; 30 W. R. 724 - **62**, 224
Upmann *v.* Elkan (1871), 7 Ch. App. 130; 41 L. J. Ch. 246; 25 L. T. N. S. 813; 20 W. R. 131 - - - - 146, 184, 204
Upmann *v.* Forrester (1883), 24 Ch. Div. 231; 52 L. J. Ch. 946; 49 L. T. N. S. 122; 32 W. R. 28 - - - - **184**, **204**

V.

Van—Wri PAGE

Van Golder *v.* Soworby Bridge Flour Society (1890), 44 Ch. Div. 374; 59 L. J. Ch. 583; 63 L. T. 132; 38 W. R. 625; 7 R. P. C. 41 - - - - - - - - - 180

Varley *v.* Keighley Ironworks Co. (1897), 14 R. P. C. 160 - 45, 430

W.

Walker *v.* Clarke (1887), 4 R. P. C. 111 - - - 212, 251

Walker, Hunter & Co. *v.* Falkirk Iron Co. (1887), 4 R. P. C. 390 - 22, 23 24, 26, 36, 45, 79, 222, 280

Walker, Hunter & Co. *v.* Hecla Foundry Co. (1887—88) (*see* Hecla Foundry Co. *v.* Walker, Hunter & Co., *supra*), 5 R. P. C. 71, 365; 14 A. C. 550 - - - - 154, 157, 188, 221, 222

Walker *v.* Scott (1892), 9 R. P. C. 482 - - - 155, 203

Wedekind *v.* General Electric Co. (1897), 14 R. P. C. 190 - 134, 135, 188, 233, 248

Welsbach Co. *v.* New Sunlight Co. (1900), 17 R. P. C. 401; 16 T. L. R. 205 - - - - - - - 197

Welsbach Incandescent Co. *v.* Krumm (1901), 18 R. P. C. 211 - 174, 251

Werner Motors *v.* Gamage's (1903), 21 R. P. C. 137, 627; 20 T. L. R. 144, 796; [1904] 1 Ch. 264; 2 Ch. 380; 73 L. J. 770; 91 L. T. N. S. 588 - 23, 33, 40, 43, 66, 154, 169, 206, 222, 223, 247, 279, 431

Westinghouse *v.* Midland Railway Co. (1883), 48 L. T. N. S. 98, 462 - 197

Westley, Richards & Co. *v.* Perkes (1893), 10 R. P. C. 181 - 51, 223

White *v.* Gerooch (1819), 2 B. & Ald. 298; 1 Chit. 24; 22 R. R. 786 - 57

Wild, Ex parte, 2 Times Rep. 174. (*See* Re Guitermann's Design.)

Wilkins *v.* Aikin, 17 Ves. 425 - - - - - 166

Wilson *v.* Wilson (1899), 16 R. P. C. 351 - - - - 191

Windover *v.* Smith (1863), 32 L. J. Ch. 561; 32 Beav. 200 - 39, 221, 222

Winfield *v.* Snow (1891), 8 R. P. C. 15 - - 64, 65, 201, 223, 235

Wittmann *v.* Oppenheim (1884), 27 Ch. Div. 260; 54 L. J. Ch. 56; 50 L. T. N. S. 713; 32 W. R. 767 - 133, 144, 145, 204, 234

Wooderson *v.* Tuck & Sons (1887), 4 T. L. R. 57 - - - 117

Woolley *v.* Broad (No. 1), [1892] 1 Q. B. 806; 61 L. J. Q. B. 259; 66 L. T. N. S. 680; 40 W. R. 511; 9 R. P. C. 208 - 97, 121, 122, 148, 166, 179, 185, 200, 228, 247, 249, 281

Woolley *v.* Broad (No. 2), [1892] 2 Q. B. 317; 61 L. J. Q. B. 808; 67 L. T. N. S. 67; 40 W. R. 596; 9 R. P. C. 429 - 132, 191, 232, 234

Wright, Crossley & Co.'s Trade Mark, Re (1898), 15 R. P. C. 131, 377 - - - - - - - 106, 259

TABLE OF STATUTES AND RULES.

[References, where the full effect of a statute or section is set out, are in **heavier type.**]

PAGE

21 Jac. I. c. 3 (1623), Statute of Monopolies - - - 277
8 Anne, c. 19 (1709), Literary Copyright Act - - - 1
8 Geo. II. c. 13 (1734), Hogarth Act (Engraving Copyright) - 2
7 Geo. III. c. 38 (1766), Engraving Copyright Act - - - 117
15 Geo. III. c. 53 (1775), Literary Copyright Act - - - 161
27 Geo. III. c. 38 (1787), first Designs Copyright Act - 2, **3**, 230
29 Geo. III. c. 19 (1789), Designs Copyright (Continuation Act) - 4
31 Geo. III. c. 23 (1794), Designs Copyright (Continuation Act) - 4
54 Geo. III. c. 56 (1814), Sculpture Copyright Act - 17, 55, 56, **144**, 277, **279**
2 Vict. c. 13 (1839), Designs Copyright (extension of) - - 4
2 Vict. c. 17 (1839), Designs Copyright (extension of) - - 4
s. 3, prevention of piracy - - - - 5
s. 4, limitation of actions - - - - 6
s. 6, registration - - - - - 6
5 & 6 Vict. c. 45 (1842), Literary Copyright Act - 7, 107, 123, 124, 146, 181, 182, 259
5 & 6 Vict. c. 100 (1842), Copyright of Designs Act (ornamental designs) - - - - - 7
s. 3, classification and terms - 7, 18, 230, 278
s. 4, marking - - 8, 56, 131, 135, 232, 233
s. 5, definition of "proprietor" - - - **280**
s. 6, transfer of proprietorship - 97, **122**, **126**, 228
s. 7, fraudulent imitations - 8, **143**, 148, 205, 245
s. 8, recovery of penalties - - - 161
s. 9, action for damages - - - - 8
s. 10, rectification of register - - - 8
s. 11, wrongful user of marks - - 210, 271
s. 12, limitation of actions - - - 189
s. 14, appointment of registrar - - - 219
s. 17, inspection of copies - - - 8, 77
6 & 7 Vict. c. 65 (1843), Copyright of Designs Act (useful designs) - 9, 18, 230, 232
s. 4, wrongful user of marks - - 210, 271
s. 7, appointment of registrar - - - 219
s. 9, appeal to Board of Trade - - - 9

PAGE
9 & 10 Vict. c. 95 (1846), County Courts Act - - - 176
13 & 14 Vict. c. 104 (1850), Copyright of Designs Act (sculptures) - 9, 230
s. 1, provisional registration - - - 9
s. 3, provisional protection and marking - 10
s. 9, extension of term - - - 10
21 & 22 Vict. c. 70 (1858), Copyright of Designs Act - 10, 75, 77
s. 7, penalty for false marking - - - 10
s. 8, proceedings in County Court - 11, 276
29 & 25 Vict. c. 73 (1861), Copyright of Designs Act - - 11
s. 1, foreign application of designs - 11, 220, 246
s. 2, extension of prior Acts - - - 11
25 & 26 Vict. c. 68 (1862), Art Copyright Act - 107, 117, 161, 181, 230, 234, 259
25 & 26 Vict. c. 89 (1862), Companies Act - - - - 112
28 Vict. c. 3 (1865), Copyright of Designs Amendment Act (industrial exhibitions) - - - - 11
36 & 37 Vict. c. 66 (1873), Judicature Act - - - 124, 176
38 & 39 Vict. c. 91 (1875), Trade Marks Act - - 109, 283
38 & 39 Vict. c. 93 (1875), Copyright of Designs Act - - 12
46 & 47 Vict. c. 17 (1883), Patents, Designs and Trade Marks Act - 12, 334—348
s. 32, threats actions in patent cases - - 212
s. 47, application for registration - 77, 79, 87, 99, 155, 218, 255, 295
s. 48, drawings, &c. to be furnished - 75, 81, 219
s. 49, certificate of registration - - - 227
s. 50, extension of term of Designs Copyright - 12, 71, 229, 231
s. 51, exemption from forfeiture for non-marking - 13, 134, 137, 231, 245
s. 52, inspection of registered designs - - 236
s. 53, information as to existence of copyright - 238
s. 54, manufacture abroad - 13, 188, 238, 245
s. 55, register of designs - - - 228
s. 56, fees - - - - - 253
s. 57, industrial exhibitions - - 68, 243
s. 58, penalty on piracy of design - 205, 233, 243
s. 59, action for damages - - - 244
s. 60, definition of "design" and extension of protection - - 13, 18, 27, 278
s. 61, definition of "proprietor" - 120, 278
s. 62, appeal from Comptroller - - - 225
s. 82, Patent Office - - - - 252
s. 83, officers and clerks - - - - 253
s. 84, seal - - - - - 253
s. 85, entries of trusts on register - 180, 254
s. 86, refusal to grant registration - - 261
s. 87, assignments and licenses - - - 257

46 & 47 Vict. c. 17 (1883), Patents, etc. Act—*continued*. PAGE
s. 88, inspection of register - - - 254
s. 90, power to expunge or vary entries - 13, 99, 257, 258
s. 91, correction of errors - - - 255
s. 94, exercise of discretionary powers - - 261
s. 97, applications and notices by post - 72, 264
s. 98, excluded days - - - 265, 308
s. 101, rules under the Act - - 14, 268
s. 103, international arrangements - 13, 274
s. 105, penalty on false description - 172, 270
s. 111, jurisdiction of the Courts - 108, 178, 282, 284
s. 113, repeal and savings - - 285, 287
s. 114, former registers continued - - - 228
s. 117, general definitions - - - - 276
46 & 47 Vict. c. 52 (1883), Bankruptcy Act - - - - - 128
48 & 49 Vict. c. 63 (1885), Patents, Designs and Trade Marks Act - 275, 348
49 & 50 Vict. c. 33 (1886), International Copyright Act - - 130
49 & 50 Vict. c. 37 (1886), Patents Act - - 13, 243, 349
51 & 52 Vict. c. 43 (1888), County Courts Act - - 176, 201
51 & 52 Vict. c. 50 (1888), Patents, Designs and Trade Marks Act - 13, 258, 286, 287, 350
s. 6, inspection of register - - 13, 226, 237
s. 7, limitation of penalties - - 13, 160
s. 24, amendment of application - - 256
s. 25, proceedings of Board of Trade - - 269
51 & 52 Vict. c. 59 (1888), Trustee Act - - - 125, 248
52 & 53 Vict. c. 63 (1889), Interpretation Act - - 220, 371
53 & 54 Vict. c. 35 (1890) - - - - - 176, 276
53 & 54 Vict. c. 37 (1890), Foreign Jurisdiction Act - - 211
3 Edw. VII. c. 42 (1903), County Courts Act - - - 177
7 Edw. VII. c. 28 (1907), Patents (Amendment) Act - 14, 225, 226, 234, 235, 237, 238, 248, 249, 252, 255, 256, 257, 259, 262, 267, 276
7 Edw. VII. c. 29 (1907), Patents and Designs Act - 14, 352—370
s. 3, appointment of Comptroller - - 219
s. 27, revocation of patents, etc. - - 113, 238
s. 35, certificates of validity - 173, 200, 250
s. 36, threats actions - - - 211, 250
s. 39, costs and security - - - 113, 241
s. 41, anticipation in patent cases - - 236
s. 49, application for registration - 30, 46, 57, 67, 72, 73, 74, 75, 83, 84, 85, 88, 89, 90, 95, 99, 115, 187, 209, 217, 227, 228, 233, 255, 299
s. 50, registration in new classes - 31, 44, 47, 68, 86, 221, 226
s. 51, certificates of registration - 90, 91, 95, 129, 227

7 Edw. VII. c. 29 (1907), Patents and Designs Act—*contd.* PAGE

s. 52, register of designs - **72**, 94, 114, 123, **227**, **231**, 254, 257

s. 53, terms of copyright on registration - **142**, 146, 188, **229**, 300

s. 54, marking and delivery on sale - **71**, 83, **130**, 135, **136**, 184, 275

s. 55, effect of disclosure - **52**, **64**, 223, **235**

s. 56, inspection of designs - **68**, 88, **98**, 132, 221, 224, 226, **236**

s. 57, information as to existence of copyright - 187, 188, **237**, 306

s. 58, designs used wholly or mainly abroad - **112**, 113, 186, 189, **238**, 259, 275, 293, 311

s. 59, provisions as to exhibitions - **68**, **242**, 312, 326

s. 60, piracy of registered designs - 85, 123, 125, **142**, **160**, 163, 177, 180, 185, 191, 197, 233, 234, **243**, 276

s. 61, application of sects. 35, 36 and 39 to designs - - **173**, 188, 201, 211, **250**

s. 62, Patent Office and branches - **92**, **252**, 315

s. 63, officers and clerks - - - - **253**

s. 64, seal - - - - - **253**

s. 65, fees - - - - **72**, **253**

s. 66, entries of trusts - **94**, 127, 180, 228, **254**

s. 67, inspection of registers - **97**, 114, 228, **254**

s. 69 (2), abandonment of applications - **98**, **255**

s. 70, correction of clerical errors, etc. - 86, **91**, 99, **220**, 225, **255**, 305, 307

s. 71, entry of assignments and transmissions - **94**, **95**, 122, 127, 228, 254, **256**, 281, 302

s. 72, rectification of registers by Court - **99**, **103**, 109, 111, 221, 225, 256, 257, **258**, 276, 280, 317

s. 73, exercise of discretionary powers - 84, **85**, **89**, **260**, 305

s. 74, directions of law officers - - **85**, 241, **261**

s. 75, designs contrary to law or morality - **88**, 221, 225, 237, **261**

s. 76, annual reports - - - - **261**

s. 77, evidence before Comptroller - **96**, **262**, 313

s. 78, certificate of Comptroller - 114, **263**, 306, 309

s. 79, evidence of documents - **114**, 229, **263**

s. 80, transmission of certified copies, etc. - **264**

s. 81, applications and notices by post - **72**, **264**, 292, 308

s. 82, excluded days - - **73**, **265**, 308

s. 83, declarations by infants, etc. - **265**, 307

s. 85, agents for patents, etc. - - **266**, 291

s. 86, power to make general rules - 219, **267**, 289

s. 87, proceedings of Board of Trade - 219, **269**, 316

7 Edw. VII. c. 29 (1907), Patents and Designs Act—*contd.* PAGE
s. 88, Orders in Council - - - - 269
s. 89, offences - - - 114, 269, 309
sub-s. (1), false entries - - 207, 269
sub-ss. (2), (3), false representation or description - - 207, 269, 270
sub-s. (4), expiry of copyright 208, 210, 270
s. 90, assumption of Royal arms - 210, 271
s. 91, international and colonial arrangements - 272, 321–331, 414
s. 92, provisions as to "the Court" - 108, 110, 176, 177, 198, 275
s. 93, definitions - - - - - 276
"prescribed" - - - 259, 276
"design" - - - 17, 277
"article" - - - 141, 277
"copyright" - - - 141, 277
"proprietor" - 32, 115, 128, 221, 233, 278
s. 94, application to Scotland - 108, 111, 177, 210, 264, 282
s. 95, application to Ireland - 108, 111, 177, 264, 283
s. 96, Isle of Man - - 207, 210, 284
s. 98, repeal and savings 114, 130, 211, 238, 285, 289, 311
s. 99, title and commencement - - - 287

DESIGNS RULES, 1908.

PAGE

Rule 1, title and commencement - - - - 268, 289
2, interpretation - - - - - 72, 289
3, fees - - - - - - 72, 254, 290
4, forms - - - - - - 75, 290
5, sets of articles - - - - 84, 224, 290
6, classification of goods - - - 84, 224, 291
7, size of documents - - - - 82, 291
8, signature of documents - - - 95, 96, 220, 291
9, service of documents - - - 72, 265, 292
10, 11, address - - - - - 220, 292
12, agents - - - - - 73, 96, 267, 293
13, 14, form and signature of application - 72, 73, 219
15, lace designs - - - - - 295
16, acknowledgment of application - - - 295
17, class - - - - - 72, 74, 84, 295
18, application of design - - 72, 74, 79, 229, 296
19, statement of novelty - - - 74, 78, 296
20—22, representations - - - 72, 75, 82, 296
23, drawings - - - - - 82, 297
24, 25, representations for a set, etc. - - 82, 297
26, 27, words and repeating patterns - - 297
28, 29, specimens, etc. of designs - - 298
30, representations of living persons - - 82, 298
31, acceptance of application - - 88, 227, 298
32, objections - - - - 89, 130, 261, 298
33, decision of Comptroller - - 89, 225, 298
34, date of appeal - - - - 89, 299
35, non-completion - - - 74, 83, 225, 227, 299
36, death of applicant - - - 300
37, 38, extension of period of copyright - 142, 230, 287, 300
39—41, second extension - - - 142, 301
42, advertisement of extension - - 301
43, entry of assignment on joint request - 95, 96, 302
44, application for entry by proprietor alone - 95, 96, 228, 302
45, case to accompany application - - 96, 302
46, 47, proof of title - - - - 96, 122, 228, 303
48, entry in register - - - 97, 122, 303
49, removal of name - - - 96, 122, 303
50, alteration of address - - - 293, 304
51, 52, corrections of clerical errors - - 91, 256, 304
53, 54, cancellation of registration - - 304
55, 56, exercise of discretionary powers - 85, 230, 261, 305
57, notice of hearing - - - - 89, 305

PAGE

Rule 58, notification of decision - - - - 89, 305
59, 60, searches - - - - - - 306
61, hours of inspection - - - - - 73, 97, 306
62, power to dispense with evidence - 74, 96, 97, 247, 262, 266, 307
63, amendments - - - - - 91, 256, 307
64, enlargement of time - - - - 83, 91, 308
65, excluded days - - - - - 73, 308
66, persons living at a distance - - - - 308
67, certificate by Comptroller - - - - 114, 309
68, marking of articles - - - - - 232, 309
69, entry in register—inspection - - 68, 97, 98, 237, 309
70, application for cancellation under sect. 58 - 114, 238, 310
71, reply to application for cancellation - - - 310
72—75, evidence and hearing - - - - 114, 311
76, notice of exhibitions - - - - 70, 312
77—79, statutory declarations - - - 263, 312, 313
80, registration of designs in Classes 13, 14 and 15 - 92, 313
81—84, Manchester Branch Office - - - 92, 252, 314
85, 86, Manchester Register - - 92, 94, 111, 257, 291, 314
87, notice of dispute in Manchester Classes - - - 315
88, procedure at Manchester Branch Office - - 92, 315
89—91, appeals to Board of Trade - - - 89, 316
92—94, procedure on and hearing of appeals - - 89, 90, 316
95, 96, applications to and orders of Court - 110, 111, 259, 317
97, advertisement of orders - - - - 111, 317
98, repeal of old Rules - - - - - 268, 317

THE LAW AND PRACTICE OF COPYRIGHT IN DESIGNS.

CHAPTER I.

HISTORY AND DEVELOPMENT OF LAW OF DESIGNS.

(*The full references to all Reports will be found in the Table of Cases ante.*)

§ 1. The first Copyright Act (1709), 8 Anne, c. 19.
§ 2. Development of Designs and demand for Legislation.
§ 3. Act of 1787 (27 Geo. III. c. 38). Protection for Fabrics of Linen, Cotton, &c.
§ 4. Act of 1839 (2 Vict. c. 13). Extension of Act to Wool, Silk, and Hair.
§ 5. Further Act of 1839 (2 Vict. c. 17). Extension to Articles of Manufacture—Registration and Marking introduced.
§ 6. Piracy defined and Penalties imposed.
§ 7. Provisions for the Registration of Designs and Transfer of Copyright.
§ 8. Consolidating Act of 1842 (5 & 6 Vict. c. 100). Definition of Design.
§ 9. Term of Copyright made dependent upon class of Goods.
§ 10. Action of Damages for Piracy. Provisions for Inspection of Register.
§ 11. Act of 1843 (6 & 7 Vict. c. 65). Extensions to Designs of Utility.
§ 12. Act of 1850 (13 & 14 Vict. c. 104). Extension to Designs within Sculpture Copyright Acts.
§ 13. Provisional Registration. Extension of Term for Ornamental Designs.
§ 14. Act of 1858 (21 & 22 Vict. c. 57). Extension of Term for Woven Fabrics. Penalties introduced for False Marking.
§ 15. Act of 1861 (24 & 25 Vict. c. 73). Extension of Protection to Designs wherever published.
§ 16. Act of 1865 (28 Vict. c. 3). Protection of Designs at Exhibitions.
§ 17. Act of 1875 (38 & 39 Vict. c. 93). Powers of Board of Trade transferred to Commissioners of Patents. Association of Patents and Designs.
§ 18. Act of 1883 (46 & 47 Vict. c. 47). Designs Laws consolidated and included in one Act with Patents and Trade Marks.
§ 19. Alterations introduced by the new Act.
§ 20. Amending Acts of 1885, 1886, 1888, and Designs Rules.
§ 21. Amending and Consolidation Acts of 1907 (7 Edw. VII. c. 28 and c. 29). Alterations in the Law and Extensions of Term of Copyright.
§ 22. The Designs Rules, 1908.
§ 23. Analogy of Law of Patents, Trade Marks, and Art Copyright.
§ 24. Provisions for International Copyright in Designs. The Convention.

§ 1. The first Copyright Act was a literary one, and was passed in 1709 (8 Anne, c. 19). This recognition

of property in the result of mental labour was followed at an interval of twenty-five years by the first statute for the protection of works of art, the Hogarth Act of 1734; but it was more than a quarter of a century later before the same principle was attempted to be applied to ornamental designs on articles of commerce, and it was not till the year 1787 that the first Designs Act (27 Geo. III. c. 38) was passed.

Before this time designers had no means of acquiring any property in their work or of preventing others from imitating it. Designs of a useful character might, as now, in some cases obtain protection by the grant of a patent as for an invention; but this was expensive to procure, and in most cases, such was the technical nature of the law at the time, very difficult to uphold.

§ **2.** As in other branches of copyright law, the development of the art led to the demand for legislation; and it is a notable fact that the first statute was confined in its operation to the designing of patterns for printing linens, cottons, calicoes, and muslins which had then become staple products of the English market. This Act of 1787 was of an experimental nature, and was limited in duration, as was frequently the custom at that period with new legislation; but the advantages of the protection soon became manifest, and seven years later the Act was made perpetual.

From this small beginning the protection of copyright in designs has been gradually extended; as regards subject matter, from linens first to all fabrics, then to articles of manufacture, and finally to all substances artificial or natural; as regards character, from mere ornament first to pattern, shape, or configuration, then to purposes of utility, and finally to designs in general without even this qualification; as regards duration, from the original term of two months first to three months,

then to twelve months, then (as to most objects) to three years, and finally, for all, to five, with optional extensions up to fifteen, years; as regards extent, from England and Scotland, to which the original Act was restricted, first to Ireland, then to any country in which a registered design had been applied, and whether by subjects or aliens, and finally to all designs within the protection of the International Union.

We propose in this introductory chapter to give a more detailed sketch of the steps by which the law as to copyright in designs has by successive stages reached its existing form.

§ **3.** The Act of 1787 (27 Geo. III. c. 38) was entitled "An Act for the encouragement of the Arts of Designing and Printing Linens, Cottons, Calicoes, and Muslins, by vesting the properties thereof in the Designers, Printers, and Proprietors, for a limited time." It recited that it was expedient for the encouragement of the arts of designing original patterns for printing linens, &c. to vest the property thereof in the designers, printers and proprietors for a limited time, and enacted that from the 1st June, 1787, every person who should design or cause to be designed any new and original pattern for printing linens, cottons, calicoes or muslins should have the sole right of reprinting the same for the term of two months, to commence from the day of the first publishing thereof. It was further provided that the name of the printer or proprietor should be printed at each end of every piece, and that anyone knowingly printing, working, or copying or publishing, or exposing for sale such original pattern without the consent of the proprietor in writing, should be liable to an action for damages. Actions were to be brought within six months of the offence.

The Act of 1787 was to remain in force only till the end of the next session of Parliament; but by 29 Geo. III.

c. 19, the Act was continued till 1794, and by 34 Geo. III. c. 23, the term of two months was extended to three months, and the Act was made perpetual. All these Acts extended only to England and Scotland.

§ 4. In the year 1839 the protection granted to linens, cottons, calicoes and muslins being found advantageous, and the printing of designs on fabrics and animal substances having developed, an Act (2 Vict. c. 13) was passed extending the provisions of the Act of 1787 to fabrics composed of wool, silk and hair, and to mixed fabrics composed of any of those materials with linen, cotton, or flax. The operation of the Acts was also extended to Ireland.

§ 5. In the same session of Parliament an even more important extension of copyright in designs was effected.

Hitherto the protection of the law had only been accorded to fabrics, and the designs to which copyright was given were ornamental in their nature. By the Act 2 Vict. c. 17, intituled "An Act to secure to Proprietors of Designs for *Articles of Manufacture* the Copyright of such Designs for a limited time," the scope of the law was greatly extended. This Act also introduced the system of registering designs, which, with modifications, is at the present day in force, and gave copyright for twelve months from the date of registration to the proprietor of original designs for the following new purposes:—

(1) For the pattern or print to be either worked into or worked on, or printed on or painted on, any article of manufacture, being a tissue or textile fabric, *except lace*.

(2) For the modelling, or the casting, or the embossment, or the chasing, or the engraving, or for any other kind of impression or ornament, on any article of manufacture, not being a tissue

or textile fabric. (For such designs, when applied to metals, the term was extended to three years instead of twelve months.)

(3) For the shape or configuration of any article of manufacture, *except lace*.

No person was to be entitled to the benefit of the Act unless the design had before publication been registered, and unless after publication of the design every article of manufacture published by him, on which such design was used, had thereon the name of the first registered proprietor, and the number of the design in the register, and the date of the registration.

§ **6.** For protection against piracy of registered designs, it was enacted (sect. 3) that during the existence of such exclusive or partial right no person should either do or cause to be done any of the following acts in regard to a registered design, without the licence or consent in writing of the registered proprietor (that is to say):—

(a) Use for the purposes aforesaid, or any of them, or print or work or copy, such registered design, or any original part thereof, on any article of manufacture, for sale:

(b) Publish, or sell or expose to sale or barter, or in any other manner dispose of for profit, any article whereon such registered design or any original part thereof had been used, knowing that the proprietor of such design had not given his consent to the use thereof upon such article:

(c) Adopt any such registered design on any article of manufacture for sale, either wholly or partially, by making any addition to any original part thereof, or by making any subtraction from any original part thereof.

The penalty for every offence against these provisions

was a sum not less than five pounds and not exceeding thirty pounds, payable to the proprietor of the design, which might be recovered either by an action of debt or on the case against the party offending, or by summary proceeding before two justices having jurisdiction where the party offending resided. No action or other proceeding for any offence under the Act was to be brought after the expiration of six calendar months from the commission of the offence; and in such action or other proceeding every plaintiff or prosecutor was to recover his full costs (sect. 4).

§ 7. With regard to the registration of designs, it was enacted (sect. 6) that the registrar should not register any design unless he was furnished with three copies or drawings of such design, accompanied with the name and place of abode of the proprietor thereof; and the registrar was to register all such copies successively, as they were received by him for that purpose, and on every such copy to affix a number corresponding to such succession, and to retain two copies, one of which he was to file in his office, and the other to hold at the disposition of the Board of Trade, and the remaining copy he was to return to the person by whom the same had been forwarded to him; and in order to give ready access to the copies of designs so registered, he was to keep a classified index of copies of designs. A certificate of registration of design was to be given to the proprietor by the registrar which was to be received in evidence without further proof.

It was also provided that every person purchasing a new and original design might enter his title in the register; that *any writing* purporting to be a transfer of such design, and signed by the proprietor thereof, should operate as an effectual transfer; and that the registrar should, on request, and the production of such

writing, insert the name of the new proprietor in the register.

§ 8. In the year 1842 (the same year which witnessed the passing after a long struggle of the great Literary Copyright Act which is still in force) the whole of the previous legislation on Designs was swept away, and an amending and consolidating Act passed. By this new Act (5 & 6 Vict. c. 100) copyright was granted (sect. 3) to any new and original design, whether such design were applicable to the *ornamenting* of any article of manufacture, or of any substance, artificial or natural, or partly artificial and partly natural, and whether such design were so applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means such design might be so applicable, whether by printing, or painting, or by embroidery, weaving, or sewing, or by modelling, casting, embossing, or engraving, or by staining, or by any other means whatsoever, manual, mechanical, or chemical, separate or combined. Sculpture and other things within the Sculpture Acts of George III. were excepted from the Act.

This definition of the subject matter of Designs Copyright, except that it was confined to *ornamental* designs, was very similar to that now in force under the Act of 1907, sect. 93, and it is important to observe that it was the ornamental design which was protected, and not the article of manufacture to which it was applied, the incorporeal copyright in the design being always considered a separate entity from the corporeal substance to which it was applied.

§ 9. The term of copyright given by this Act was dependent upon the class of goods to which the design was applied (sect. 3). The classes of goods were thirteen in number and to all of them the term of protection was

extended to three years, except lace, which was restricted to twelve months, and printed shawls and woven fabrics (other than furniture) or coloured yarns and the like, to which only nine months' protection was given.

The copyright was, as in the previous Act, conditional on registration before publication in respect of the application of the design to some or one of the classes of goods named in the Act, and on the proper marking of all goods to which the design was applied (sect. 4).

The remedies of the proprietor for piracy were also practically the same, but fraudulent imitation of designs was now forbidden in express terms (sects. 7 and 8).

§ **10.** A new provision was introduced, giving the proprietor his election to bring an action for any damages sustained by an infringement of his rights (sect. 9).

Power was also for the first time expressly given to a Court of Equity to rectify the register where it should appear that a person not the lawful proprietor had been registered as proprietor (sect. 10).

The public were not under the Act to be entitled to inspect the copies of designs at the Designs Office of which the copyright was still in force, except with the leave of the proprietor, or by special authorisation of the registrar, and under conditions preventing a copy being taken (sect. 17).

This provision was inserted in deference to the wishes of those interested in textile fabrics, it being alleged that if the designs were open to inspection the new designs would be copied or imitated, often in a way which would be difficult to prove to be a piracy. The substantial start in the market of the original designer might thus be lost.

§ **11.** The protection given to designs was still further extended in the following year by the Act 6 & 7 Vict. c. 65 giving copyright for three years (sect. 1) from the

date of registration to the proprietor of a new and original design for any article of manufacture (other than sculpture) having reference to some *purpose of utility*, so far as the design should be for the whole or part of the shape and configuration of such article. Protection was also given to ornamental designs for floorcloths and oil-cloths which had not been covered by the previous Act. The Act in other respects substantially incorporated the provisions of the Act of 1842, so far as applicable. The registrar was to exercise his discretion as to what were ornamental designs under the Act of 1842, and what useful designs under this Act. He might also refuse to register any design not intended to be applied to any article of manufacture, but only to a label, wrapper, or other covering; or designs contrary to public morality or order. But an appeal was provided from the registrar to the Board of Trade (sect. 9).

§ **12.** In the year 1850 the benefit of the Designs Act, 1842, was extended by the statute 13 & 14 Vict. c. 104, to designs within the Sculpture Copyright Acts, which had hitherto been excluded. On the registration of such designs with the Registrar of Designs, the proprietors were thenceforth to have the machinery of the Designs Act, 1842, for the recovery of penalties and the protection of their copyright. The extended term of copyright given by the Sculpture Acts was not altered, and the registration might be for the whole or any part of the term of such copyright (sects. 6 and 7).

§ **13.** But the more important object of the Act was to provide for the *provisional registration* of designs. It was provided that designs which might be registered under the Designs Act, 1842, or 1843, might be provisionally registered for the term of one year (sect. 1), which might be extended by the Board of Trade for a further six months (sect. 5). During this term the

proprietor of the design had the sole right and property in the design, and the penalties and provisions of the Acts for preventing piracy were available.

During the continuance of the provisional protection the publication of the design would not avoid subsequent registration of the copyright, except that the design was not to be sold or exhibited for sale under pain of nullifying the provisional registration and consequent loss of copyright. Articles to which the design might be applied were to be marked "provisionally registered," with the date of registration (sect. 3).

Another new provision of great importance was that contained in sect. 9, by which the copyright in ornamental designs under the Designs Act, 1842, might be extended by the Board of Trade for an additional term not exceeding three years.

Designs for the ornamenting of ivory, bone, papier maché, and other solid substances which were not already comprised in the enumeration of classes of protected articles in the Designs Act, 1842, were to be deemed and taken to be comprised within the class numbered 4 ("Articles of manufacture composed wholly or partially of earthenware") in that Act, and such designs were to be so registered.

§ **14.** A further amending Act was passed in 1858 (21 & 22 Vict. c. 70), to make additional provision against piracy, and to extend the term of copyright given to designs applied to printed woven fabrics from nine months to three years. Any person applying any "mark of registration" to any article to which a design was applied when the copyright had expired, or where there was no registration, or during the copyright, without the authority of the proprietor, was made liable to a penalty of ten pounds (sect. 7); proceedings for damages for piracy might be commenced in the County Court;

and the defendant in any such proceedings if he intended to rely as a defence on any objection to the copyright or to the title of the proprietor, was to give notice of such special defence, stating also the date and other particulars of the alleged anticipation or of any other objection (sect. 8).

§ 15. The previous Acts had all applied exclusively to designs to be applied to articles of manufacture or other substances made within the United Kingdom, but the extension of free-trade principles and the influence of the great exhibitions now called for the removal of these limitations, and by an Act of 1861 (24 & 25 Vict. c. 73), after reciting in the preamble that "*it is expedient that the provisions of the said recited Act* (the Act of 1842) *and of all Acts extending or amending the same should apply to designs and to the application of such designs, whether such application be within the United Kingdom or elsewhere*," it was enacted that the protection given by the Acts should be extended to all copyrightable designs whether the application thereof was done within the United Kingdom or elsewhere, and whether the inventor or proprietor of the design was a subject of the Queen or not (sect. 1).

It was also expressly provided that all the Acts then in force should not be construed to apply to the subjects of Her Majesty only (sect. 2).

§ 16. A further movement was made in the same direction by an amending Act of 1865 (28 Vict. c. 3), which provided for the protection of designs exhibited at industrial exhibitions certified by the Board of Trade. Exhibition at such industrial exhibitions, or publication during the period thereof, of a design, was not to prejudice any subsequent registration.

§ 17. In the year 1875 38 & 39 Vict. c. 93) the powers and duties of the Board of Trade under the Designs Acts were transferred to the Commissioners of Patents, who

were given power to make general rules for the regulation of the Designs Office, subject to the approval of Parliament. The office of registrar as a separate office was abolished, his duties and discretionary powers being transferred to the Commissioners.

The Designs Office having been removed to the Patent Office on the transfer of the registration of designs from the Board of Trade to the Commissioners of Patents under this Act, the regulation of the copyright in designs has since that time been closely connected with patents and trade marks; but this is a purely artificial arrangement, and it is doubtful whether the principles attaching to the protection of designs do not approximate more closely to those affecting copyright in works of art, than to inventions with which designs are, for administrative purposes only, now associated.

§ **18.** The new departure in administration thus inaugurated led to the inclusion of the law relating to copyright in designs in the Patents, Designs, and Trade Marks Act, 1883, which, with slight modifications, remained for the next quarter of a century the statutory law on the subject. By this Act (46 & 47 Vict. c. 17), the whole of the previous Acts relating to designs and trade marks were repealed, and new provisions consolidating and amending all previous statutory enactments were substituted. Substantially the same object was effected with patents, except that the Statute of Monopolies was left intact.

§ **19**. The principal alterations introduced by the new law were—(a) the extension of the term of copyright from three years to five years for all registrable designs, and the consequent abolition of the distinction between classes of designs except for registration and marking purposes (sect. 50); (b) exemption from for-

feiture of copyright for non-marking of articles where the proprietor could show that he had taken all proper steps (sect. 51); (c) a provision for cesser of the copyright in any design used in manufacture in any foreign country and not used in the United Kingdom within six months of its registration (sect. 54); (d) increase of the penalty for infringement to a sum not exceeding 50*l.* for each offence; (e) abolition of the distinction between ornamental and useful designs, and extension of the protection to designs (other than sculptures) of every kind, without regard to utility (sect. 60); (f) the introduction of a power to expunge or vary entries in the register at the instance of "any person aggrieved" (sect. 90); (g) power to make international arrangements, confirmed by Order in Council, for mutual protection of designs (sect. 103); and (h) omission of the old provisions for discretionary extension of the term of copyright, for the registration of works of sculpture, and for the provisional protection of designs.

§ **20.** Slight modifications were made in this Act by amending Acts of 1885, 1886 and 1888, which included provisions for the extension of the protection given to designs exhibited at industrial exhibitions to such exhibitors when held out of the United Kingdom (49 & 50 Vict. c. 37, s. 3); for the right to inspect the original entry of any registered design where registration was refused by the Comptroller on the ground of identity (51 & 52 Vict. c. 50, s. 6); and for the limitation of the penalties recoverable in any proceeding in respect of any one design to 100*l.* (*ibid.* sect. 7).

Statutory rules and scheduled forms, with official instructions, were issued under these Acts regulating the practice on the registration, marking, and dealing with designs; and these rules and forms were judicially recognised as "practically part of the Act of Parlia-

ment" (*a*). They included provisions for the description of the nature of the design for which copyright was claimed; for the hearing of appeals by the Board of Trade from refusal of registration by the Comptroller; for the proof of title on transfers or other dealings with the copyright; and for the examination of designs proposed to be registered, and the issue of certificates as to non-imitation of registered designs.

§ **21.** The decision of the Courts under these Acts and Rules were fairly numerous, owing principally to the very incomplete nature of the statutory provisions; but a large number of ambiguities and difficulties in practice still remained, and an attempt was made to remove these, with certain anomalies, by an Amendment Act for Patents and Designs (7 Edw. VII. c. 28), which, with a Consolidating Act (7 Edw. VII. c. 29), embodying all the statutory law, including these amendments, was passed, and received the Royal Assent on the 28th August, 1907, the new law coming into force on the 1st January, 1908.

The Patents and Designs Act, 1907, repealed, with a few temporary exceptions, the whole of the previous statutory provisions on the subject, including the provisions of the Amendment Act, which had thus practically no independent existence. It contains some important alterations of the old law relating to designs: (a) the term of copyright protection is extended to a possible fifteen years by optional renewals after the expiration of the first term of five years; (b) the penalty of loss of the entire copyright previously attached to the omission to mark articles bearing the registered design is reduced to stoppage of the remedy by way of penalties or damages

(*a*) Per the Lord Chancellor (Halsbury) in the House of Lords, *In re Rollason's Design* (1898), 15 R. P. C. 441. By sect. 101 (3) of the 1883 Act they were required to be judicially noticed.

in the absence of other notice to the infringer; (c) the failure to manufacture articles to which the registered design is applied exclusively or mainly within the United Kingdom will form ground for an application for cancellation or a good defence to an action for infringement; (d) the provisions, formerly applying only to patents, as to granting certificates of validity and for proceedings for the issue of threatening circulars or advertisements, are extended to designs; and (e) there are provisions for the creation of local branch offices for designs business, and other amendments in the practice on registration and on transfer of the copyright.

§ **22.** The principal provisions of the new Act are subject to rules to be made and forms and regulations to be prescribed by the Board of Trade from time to time; and a first set of rules has now been issued, dealing with all questions of practice. The Rules of 1908 create separate classes for hosiery and checks and striped goods, and distinguish the classes for textile goods from all the other classes; a branch office is established at Manchester to deal with these with a separate Register; foreign owners are required to register an address for service in the United Kingdom; power is given to the Comptroller to amend applications and correct clerical errors on the Register; greater latitude is allowed for the mode of marking; a code of procedure is fixed for applications for cancellation on the ground of manufacture abroad; and a very complete set of forms for assignments and other dealings with registered designs is scheduled, with new provisions as to declarations and other evidence in support.

§ **23.** Notwithstanding these alterations, most of the decisions under the previous Acts are of value, as many of the provisions of the new Acts of 1907, relating to

designs, are, with more or less modification, re-enactments of sections of the repealed Acts. As will appear in the course of this work, the analogy of patent and trade mark decisions will often help the elucidation of points which have not been directly decided with reference to designs; and the authorities as to originality, infringement, and remedies under the Art Copyright Acts will also frequently be found to be in point.

§ **24.** The provisions for international protection contained in the 1883 Act have been largely made use of, and immediately after its coming into force accession was given to the International Convention for the protection of industrial property which had been signed at Paris in the previous year on behalf of the principal European Governments. This Convention constituted a code for the mutual protection of patents, designs, and trade marks. The International Union has since been largely extended by the adhesion of other countries outside Europe (including the United States of America), and Orders in Council have been issued under sect. 103 of the old Act (continued by sect. 91 of the 1907 Act), applying its provisions to those countries which have extended similar protection to designs of British origin.

CHAPTER II.

MEANING OF "DESIGN."

(*The full references to all the Reports will be found in the Table of Cases ante.*)

§ 25. What is a Design?—Statutory Definition.
§ 26. Limitations in the Statutes.
§ 27. Dictionary Definitions.
§ 28. Scope of the Act of 1907.
§ 29. Judicial Decisions—Opinions of the Judges in *Harrison* v. *Taylor*, *Re Rollason's Design*, and *Re Bayer's Design*.
§ 30. No Distinction between Ornamental and Useful Designs (*Hecla Foundry Co.* v. *Walker*; *Moody* v. *Tree*).
§ 31. Design is that which is applied (*Re Clarke's Design*).
§ 32. Design may be Registered though also Subject Matter for Patent or Trade Mark (*Werner Motors* v. *Gamage's*).
§ 33. What is not a Design (*Nevill* v. *Bennett*).
§ 34. Illustrative Cases—Corset Cases (*Cooper* v. *Symington* and *Re Bayer's Design*)—Fire-door Cases (*Walker* v. *Falkirk Iron Co.* and *Hecla Foundry Co.* v. *Walker*)—Spoon-handle Case (*Saunders* v. *Wiel*)—Coffin-plate Case (*Re Rollason's Design*).
§ 35. Result of the Authorities.
§ 36. Classification of Designs.

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§ 25. The first question which arose under the Act of 1883, and which remains unsolved by the new Act of 1907 (*a*), was, What is a design? That question has never been definitely answered, and only an approximation to a settlement of it is to be derived from the different judicial decisions under these and the preceding Acts. The definition of "design" given in the new Act (sect. 93) is stated in the following terms:—

> "In this Act, unless the context otherwise requires, '*Design*' means any *design* applicable to any article not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (54 Geo. III. c. 56),

(*a*) Throughout this work whenever we speak of the old Act or the Act of 1883, the Patents, Designs and Trade Marks Act of 1883 (46 & 47 Vict. c. 57), is meant, and whenever we speak of the new Act or the Act of 1907, the Patents and Designs Act, 1907 (7 Edw. VII. c. 29), is referred to.

whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined."

§ **26.** This definition, which is practically a copy of that in the 1883 Act (sect. 60), is taken from the old Act of 1842 (5 & 6 Vict. c. 100), s. 3, save that the initial words there were "any design applicable to the ornamenting of any article of manufacture" (*b*). Except for the great generality of its character, which may, in some cases, be a matter of some importance (*c*), the definition as a definition is singularly valueless, for it begins "a *design* is a *design* applicable, &c." There is, in fact, no attempt to define the word "design," but only a statement as to how far, for the purposes of this Act, the word is to be taken in its ordinary meaning. It has been contended that the intention was to limit the Act to certain classes of designs, leaving the public to discover for themselves what a design capable of protection is; but a more generous view has been taken in recent cases, and in *Re Rollason's Design* (*d*) the House of Lords held that the object of the section was to make the word "design" "as extensive as it reasonably ought to be."

From the meaning given to the word in dictionaries, from the definition clause, and from the statements of various Judges in decided cases, it is possible to form a fairly definite notion of what designs the protection of the Act is extended to.

§ **27.** The following are some of the definitions of the word "design" given by the Dictionaries:—

(*b*) The Designs Act, 1843 (6 & 7 Vict. c. 65), extended the scope of the Designs Act, 1842, so as to make it embrace designs having reference to some purpose of utility.

(*c*) Per Lord Herschell in *Re Rollason's Design* (1898), 15 R. P. C. 441.

(*d*) *Supra*.

The Oxford Dictionary.

The combination of artistic details or architectural features which go to make up a picture, statue, building, &c.; the artistic idea as executed; a piece of decorative work, an artistic device.

Original work in a graphic or plastic art. Cf. Ruskin (Two Paths): "Design properly so called is human invention, consulting human capacity."

Webster, ed. 1900.

A preliminary sketch, an outline or pattern of the main features of something to be executed.

The realization of an inventive or decorative plan; especially a work of decorative art considered as a new creation, conception or plan shown in a completed work.

The Century Dictionary, 1889.

A plan or outline in general; any representation or statement of the main parts or features of a projected thing or act.

Artistic invention in drawing or sculpture.

The arrangement or combination of the details of a picture or statue in an edifice.

Ogilvie, ed. 1883.

1. A plan or representation of a thing by an outline; sketch; general view; first idea represented by visible lines, as in painting or architecture.
2. The realization of an artistic idea; specifically, the emblematic or decorative figuring upon embroidery, medals, fabrics, and the like.

Dr. Johnson, ed. by Latham, 1866.

1. Intention, purpose, scheme, plan of action.
2. Idea which an artist endeavours to execute.

An excellent definition of the meaning of "design" was given by Grosskup, J., in the recent American case of *Pelouze Scale Co.* v. *American Cutlery Co.* (102 Fed. Rep. 916). "Design is that characteristic of a physical substance which, by means of lines, images, configurations and the like, taken as a whole, makes an impression, through the eye, upon the mind of the observer. The essence of a design resides, not in the elements individually, nor in their method of arrangement, but in the *tout ensemble*—in that indefinable whole that awakens some sensation in the observer's eye. Impressions thus imparted may be complex or simple; in one is mingled impressions of gracefulness and strength, in another impressions of strength alone. But, whatever the impression, there is attached in the mind of the observer, to the object observed, a sense of impression and character" (*e*).

(*e*) Cited in Ruling Cases, Vol. XXV., p. 266.

§ 28. From the section, however, it appears that the only designs to which the Act of 1907 has reference are those designs which are applicable to some article, the word "article" being defined to mean, as respects designs, "any article of manufacture and any substance, artificial or natural, or partly artificial or partly natural." The following words as to designs being "applicable for the *pattern* . . . *shape* . . . *configuration* . . . *or ornament*" of such articles, do not introduce any further limitation. This, as we have said, restricts to some extent the classes of designs to which the Act is applicable, but it does not, and perhaps purposely does not, define design (*f*). But whether a satisfactory definition is found or not, the scope of the Act is clearly enough defined—protection is intended to be given to all industrial designs, whether for pattern, shape, configuration or ornament, and by whatever means they may be applicable.

§ 29. The following cases are illustrative of judicial views on the subject:—

> In *Harrison* v. *Taylor* (*g*), the Judges spoke of an ornamental design as "something in the nature of a drawing, picture, or diagram applicable to the ornamentation of some article of manufacture," and as "any diagram, drawing, or representation of something which a draughtsman has for the first time produced."
>
> In the more modern case of *Re Clarke's Design* (*h*), Lindley, L.J., after saying that for the purpose of interpretation the word "design" must be taken in its ordinary signification adopted the terse definition of "something marked out, a plan or representation of something" (*i*). And Lopes, L.J., in the same case gave a summary of the varieties of objects to which designs might be applied in the following terms: "A design within the Act may be some ornament printed or produced in the flat, such as woven or printed designs in textile fabrics, paper hangings, floorcloths, or the like, or

(*f*) *Holdsworth* v. *McCrea* (1867), L. R. 2 H. L. 380. But see *Re Rollason's Design* (1898), 15 R. P. C. 441.

(*g*) (1859) 29 L. J. Ex. 3.

(*h*) (1896) 13 R. P. C. 351.

(*i*) Adopted by Warrington, J., in *In re Bayer's Design* (1906), 23 R. P. C. 553.

patterns or designs etched or stamped, or cast or embossed or cut or otherwise produced in metal articles or glass or plastic material or furniture or tiles, or worked or woven as in lace; or it may be for artistic or beautiful shape in configuration as a lamp stand or lamp shade or iron railing or gate, or for shape in which no appeal is made to a sense of beauty, as in a new shape or configuration of a grate door or oil can or cravat; or the design may contain two or all of the foregoing elements, *i.e.*, ornament, pattern, shape and configuration."

In the later case of *Re Rollason's Design* (*j*), Lord Herschell, in pronouncing the judgment of the House of Lords, said: "The object of the Interpretation Clause (sect. 60 of the 1883 Act) is to make the word design in sect. 47 and the following sections *as extensive as it reasonably ought to be*. It was not intended to draw a sharp, hard and fast distinction between the design as being applicable for the 'pattern' or for the 'shape or configuration' or for the 'ornament.' The object in introducing the words, 'whether applicable for the pattern or for the shape or configuration or for the ornament thereof,' was to use words which would include everything which would ordinarily fall within the word 'design,' and to show that the word 'design' was not intended to be used in any technical sense as excluding anything that would ordinarily fall within it."

In the most recent case, *Re Bayer's Design* (*jj*), Fletcher Moulton, L.J., said: "Designs apply to nothing but that which the eye can tell entirely. Nothing in my opinion is a good design but that of which full knowledge is given when you have once shown to the eye what your design is. It may be shape, or configuration, that is given by a specimen, or by a proper drawing, and the eye can see it, and the eye can recognise whether it has been imitated. It may be by a pattern, to which the same applies. It may be by an ornament, to which the same applies. But in my opinion nothing beyond that can properly be called a 'design' within the meaning of this statute."

§ 30. The old distinction between ornamental and useful designs made in the earlier Designs Acts (*k*) is now done away with, and both classes of designs are now treated alike. Whether a design is or is not useful is, so far as subject matter is concerned, an entirely immaterial question under the 1907 (as it was under the 1883) Act.

(*j*) *Supra*.
(*jj*) On appeal (1907), 24 R. P. C. 65.
(*k*) 5 & 6 Vict. c. 100, and 6 & 7 Vict. c. 65.

More utility, in the absence of originality in shape, configuration, or pattern, will not suffice to support registration, though of course the fact that a useful purpose is served will not prevent the invention from being a design (*l*).

In *Hecla Foundry Co.* v. *Walker* (*m*), Lord Herschell said: "I quite agree with what was said by Lord Shand in *Walker* v. *Falkirk Iron Co.* (*n*), that 'the Act in this branch gives protection only to the shape or configuration or to the design for the shape or configuration, in such a case as the present. The result of such protection may be, however, to secure important advantages, such as attend a mechanical contrivance, if these advantages should be the result, directly or indirectly, of the shape or configuration adopted.' But this is a mere incident. If such advantages are obtained, it is only because no shape not substantially the same, and which is therefore not an infringement, will achieve the same end."

In *Moody* v. *Tree* (*o*), Baron Pollock expressed a similar view in the following terms: "Now there may be many things which might be said to answer both purposes. A man might register a design for a doorway made with bronze, and made with a figure of the Apollo Belvedere, that might or might not be better or worse than a doorway that had preceded it; but it would be foreign to the question altogether whether it was properly the subject-matter of a design, and whether it was new as a design under this Act, although it had none of those advantages."

So in *Re Clarke's Design* (*p*), Lindley, L.J., in giving judgment in the Court of Appeal, said: "The statute applies to all such designs as are within it, whether they add to the utility of the articles to which they are applied or whether they do not. The question of utility is wholly immaterial in considering this Act of Parliament."

§ 31. The design is not the article of manufacture, but that which is applied to the article of manufacture.

In the case of *Re Clarke's Design*, previously quoted, Lindley, L.J., said: "The Act does not apply to the things to which a design is applied; the Act applies to the design applied to

(*l*) *Cooper* v. *Symington* (1893), 10 R. P. C. 264; *In re Bayer's Design*, *supra*.
(*m*) (1889) 6 R. P. C. 554.
(*n*) (1887) 4 R. P. C. 90.
(*o*) (1892) 9 R. P. C. 333, 335; and see Lord McLaren's judgment in *Walker* v. *Falkirk Iron Co.*, *supra*.
(*p*) (1896) 13 R. P. C. 351.

them. The distinction is obvious enough when the design is for a pattern or ornament; but when, as in this case, the design is for the shape of a thing, the distinction is reduced to the difference between the shape of a thing and a thing of that shape. A design applicable to a thing for its shape can only be applied to a thing by making it in that shape. A design for the shape of something is what is meant by sect. 60 when shape is in question; and a registered design for a shape of a thing is infringed if that thing is made in the shape shown by the registered design."

§ 32. That a design is also good subject-matter for a patent is immaterial to the designer who desires to take advantage of the cheaper though more limited protection afforded by this branch of the Act (*q*). But he must remember that no mechanical contrivance or principle (*r*), no process of manufacture (*s*), can be a design (*t*). If any advantages such as attend a mechanical contrivance are obtained, the invention is a design only so far as the result is brought about by the shape (*u*).

Thus in *Werner Motors* v. *Gamage's, Ltd.* (*x*), where the plaintiffs had on the 18th November registered a design "for the pattern as shown of a motor cycle frame," and had already on the 8th November applied for a patent for a frame for motor cycles, the same as that shown in the design, and the patent was in due course granted, and it was contended that the registration was invalidated by reason of the grant of exclusive rights in the article, it was held by Byrne, J., that the registration of the design was not invalidated by the patent because, first, the design was registered before the actual grant of the patent; secondly, that the right of copyright in a design is not a grant but is statutory; and thirdly, that rights under a patent and in a design are separate and distinct and may co-exist. And in confirming this decision, the Court of Appeal (at p. 621) added that "the applicant for a patent for an article and for registration of a design for the

(*q*) *Rogers* v. *Driver* (1850), 16 Q. B. 102; *Hecla Foundry Co.* v. *Walker* (1889), 6 R. P. C. 554; *Millington* v. *Picken* (1845), 14 L. J. C. P. 254.

(*r*) *Marsetson* v. *Wright* (1848), 2 De G. & Sm. 420; *Hecla Foundry Co.* v. *Walker*, *supra*; *Cooper* v. *Symington* (1893), 10 R. P. C. 264.

(*s*) *Walker* v. *Falkirk Iron Co.* (1887), 4 R. P. C. 390; *In re Bayer's Design* (1907), 24 R. P. C. 65.

(*t*) *Moody* v. *Tree* (1892), 9 R. P. C. 333.

(*u*) See § 34, *infra*, for a full statement of the cases cited.

(*x*) (1904) 21 R. P. C. 137, 621. For illustration of the design in this case, see Appendix F., Sheet 9, *post*, p. 431.

shape of a similar article is not under the Patents Act put to an election, but may secure both" (*y*).

So in the recent case of *Re Bayer's Design* (*z*), which was an application for removal of a design applicable to corsets on the ground (*inter alia*) that the design as registered incidentally described a mode of manufacture, and was therefore not good subject-matter. Warrington, J., said: "In a case like this *design and manufacture* are really *inseparable*. You cannot picture a corset having upon it particular lines which represent the joining of the several pieces by which it is made up, without describing in a sense the mode in which the corset is made. It seems to me, however, that the fact that, in making a design you incidentally describe a mode of manufacture, does not make a design less a design if it is in itself a design." But in the Court of Appeal this judgment was reversed, and on a further appeal to the House of Lords, Lord Macnaghten, in delivering the judgment of the House of Lords, said: "Now, although a design, properly so called and duly registered, may incidentally protect a method of manufacture, it is clear that mere method of manufacture cannot be registered as a design under the Act."

§ 33. Again, it should be remembered that a colour is not a design, nor is an effect a design, but only the combination which produces the effect (*a*). On the other hand, a portion of an article may be a design (*b*), and a combination also may be a design (*c*).

Thus in *Nevill* v. *Bennett* (*d*), a case in the Chancery of the County Palatine relating to textile goods, printed with a design made up from old materials for the Persian market, Hall, V.-C., said: "The question is not whether or not each detail is old; the question is whether the design as a whole is old, or whether it is new . . . you may have all the details old but the combination, the rearrangement, may be such that the effect is new, that the design is new."

§ 34. The following cases illustrate the above rules (*e*):—

(*y*) So in America, where designs are made the subjects of patents, it has been held that one patent may be taken out for mechanical construction and another patent for the design of the same article: *Flowerwell* v. *Newcritten*, 88 Fed. Rep. 698, cited in Ruling Cases, Vol. XXV., p. 265.

(*z*) (1906) 23 R. P. C. 553; and on appeal (1907), 24 R. P. C. 65.

(*a*) *Grafton* v. *Watson* (1884), 50 L. T. (N. S.) 420; 51 L. T. (N. S.) 141.

(*b*) *Walker* v. *Falkirk Iron Co.*, *supra*.

(*c*) *Norton* v. *Nicholls*, 28 L. J. Q. B. 225; *Grafton* v. *Watson*, *supra*.

(*d*) (1898) 15 R. P. C. 412.

(*e*) For leading cases decided under the old utility statutes, see *Margetson* v. *Wright* (1848), 2 De G. & Sm. 420: *Rogers* v. *Driver* (1850), 16 Q. B. 102; and *Reg.* v. *Bessell* (1851), 16 Q. B. 810.

In *Moody* v. *Tree* (*f*), the design registered was for a picture of a basket, and underneath the basket was the statement "claim for pattern of a basket, consisting in the osiers being worked in singly, and all the but-ends being outside." The Divisional Court (Pollock and Vaughan Williams, JJ.) held that plaintiff had registered a process or mode of manufacture and not a design. Pollock, B., said: "It appears to me to come to this—that where you have a subject matter registered under the Designs Act as a design you have no right to enquire with reference to its utility, either *per se* or when compared with other designs which have preceded it; because it is not the subject matter of a patent that is being discussed, but it is the subject matter of a design, and the Designs Act was intended to add to the Patent Act by making that which was not patentable the subject of a design. . . . The only question then would be this—you must use your eye and say, looking at the figure or the design, whether it is new or it is not, and beyond that you cannot go." And Vaughan Williams, J., says: "In my view the design within the terms of that definition must be capable of an existence outside the article itself altogether. It must be something that one can apprehend and something which if one has it presented to one's eyes, one can see externally to the article to which it is to be applied or to which it is intended to be applied. If that view is right a mere mode of manufacture is not a design at all. It is not something which is capable of existence as a pattern, or as a shape or configuration, or as a piece of ornamentation to be applied to an article or class of articles."

In *Cooper* v. *Symington* (*g*) a laced corset was in question. The old laced corset had busks which were either sewn into the front of the corset or were laced in, so as to be easily removable by running lacing at the outer margin of the busks; in the former case the corset was sometimes fastened together by lacing the two inner margins of the busks, in the latter the means of fastening was by hooks and eyes. In the registered corset the busks were laced in and were thus easily removable, but the lacing was diagonal and was at the inner margin of the busks, and when closed this diagonal lacing gave the appearance of a corset being laced together, though the corset was really fastened by studs and clasps. The corsets when sold had placed on them a ticket with the words "new method for removing and re-fitting busks for repairs, &c." Chitty, J., held that there was here no subject matter for registration as a design.

The last two cases were attempted to be distinguished in

(*f*) (1892) 9 R. P. C. 333.

(*g*) (1893) 10 R. P. C. 264.

the recent case of *Re Bayer's Design* (*h*), which was also a corset case, the application for registration including the following passage under the heading, Statement of nature of design: "Shape or configuration of corset; the novelty consists in a corset having the gores or gussets cut horizontally and from the front of the busk towards the back of the corset, as shown in the representation." The registered sketch showed a straight-fronted corset; and in giving judgment upholding the registration Warrington, J., said: "In the basket case a man registered a picture of a basket, but what he really claimed was not the basket in accordance with that picture but all baskets made in a particular way. I think the distinction between that case and this is, that in the present case you cannot, in making the design and in marking out the image of the corset, avoid showing the person to whom that design is presented how to make the article—in other words, to describe the mode of manufacture. In the case of the basket you could do so. It seems to me, therefore, that although this design may incidentally describe a mode of manufacture, it is properly regarded a design." But in the Court of Appeal, *Moody* v. *Tree* was held to apply, and Buckley, L.J., in giving judgment, said: "In this case the design is either bad altogether, as having nothing new or original in it, or it is bad because it merely shows a picture of a single isolated article, and contains no design at all in the sense of suggestion of something which may be used to produce a particular form of corset, namely, a straight-fronted corset. If you read it as meaning that, then it appears to me plain to be a mode of manufacture and not a design."

Walker, Hunter & Co. v. *Falkirk Iron Co.* (*i*) was also an important case. The registered design was for a "range fire-door with moulding on top, moulding forming part of range, *shape* to be registered." The fire-door was intended to fit into the range and the moulding on the top corresponded to and ran flush with the moulding on the front of the hob when the door was closed; the useful purpose was thus accomplished of closing the space between the hob-plate and the top of the fire-box. It was objected (1) that the subject was one for a patent and not for registration as a design, and (2) that the design was for a part of an article and not for a complete article, but both objections were over-ruled by Lord McLaren, and on appeal Lord Shand, with the concurrence of the other Judges, said: "Now, it is quite true the subject of registration must not be an article of manufacture itself, but a design to be applied to an article of

(*h*) (1906) 23 R. P. C. 553, and on appeal (1907), 24 R. P. C. 65. For illustration of the design in this case, see Appendix F., Sheet 10, *post*, p. 432.

(*i*) (1887) 4 R. P. C. 391.

manufacture or substance for pattern, shape, or ornament, and also that the branch of the statute which relates to the registration of designs does not afford or profess to afford protection to any mechanical principle or contrivance directly. Thus, in the present case, the new shape of fire-range door with the moulding as part of it has the particular advantages over the old shape of door which I have already noticed. These are not directly the subject of protection, but, inasmuch as they are dependent on and inseparable from the shape or configuration, they are indirectly secured by the registration of the design. It may be quite true that in place of registering the design for its shape and so gaining protection for a period of five years, the pursuers might rather have applied for letters patent and protection for the longer period of fourteen years for improvements in the manufacture of fire-doors for convertible fire-ranges, and have made not the mere shape but the mechanical action or contrivance the subject of protection by letters patent. But, assuming that such letters patent might have been obtained, and that there was novelty, not only sufficient to validate the registration of the design, but to create an effectual patent, this would not, in my opinion, lead to the result that the design was not a proper subject for registration."

In *Hecla Foundry Co.* v. *Walker, Hunter & Co.* (*k*) the same subject came before the House of Lords; the same fire-door being again in question. Lord Herschell, quoting with approval the above quoted remarks of Lord Shand, also said: "By section 60 of the Patents and Designs Act of 1883, 'design' is defined as meaning any design applicable to any article of manufacture or to any substance, 'whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof.' In the present case the applicant declared that it was for 'the shape' that he desired registration. Under the designs part of the Act of 1883, I do not think the object which the designer has in view in adopting the particular shape, or the useful purpose which the shape is intended to serve, or does serve, ought to be regarded in considering what is the design protected. The scheme of this part of the Act is entirely different from that relating to patents for inventions, where the object attained by the invention for which the patent is granted is, of course, very material to the inquiry what is its subject matter, and whether there has been an infringement. I cannot agree, therefore, that the registration was claimed, or could be claimed, 'not for the particular moulding' but for the form given by placing 'any suitable moulding' upon a fire-door in the described position, or that a privilege was granted 'for putting a moulding upon a fire-door in such a

(*k*) (1889) 6 R. P. C. 554.

manner as to accomplish' a particular object. I think the protection was granted for the shape, and for that alone."

In *Saunders* v. *Wiel* (*l*), in which the design was one for the handles of spoons, and purported to represent a particular view of Westminster Abbey, it was contended that this was not a design which could be registered, but the contention was rejected by the Courts. Lindley, L.J., said (*m*): "What we have to consider is this: Whether this registered design—for a design of some sort, of course, it is—is a design applicable for the pattern and for the shape to things in Class 1, and in particular forks and spoons, and whether it is a new or original design not previously published in the United Kingdom. Now, why is it not? Has such a design applicable to metals ever been seen before? If you ask that question, you are told this:—Yes, if you mean by design public buildings or if you mean cathedrals and churches, they are common enough: therefore, there is no novelty in the idea. But if you ask a little closer whether anybody has previously taken this particular aspect of Westminster Abbey and used it as a design applicable to things in Class 1 or to any things like it, the answer is 'No, that is new and never has been published before.' That answer seems to me to bring the plaintiffs' case within the Act of Parliament."

In the more recent case of *Re Rollason's Design* (*n*), the design was for a set of coffin plates, and this was registered as applicable "for the pattern," and in giving judgment upholding the registration, Lindley, M.R., said: "The first question is to consider what is the design. This design was for coffin plates. The design is contained in the drawing which is registered with the Comptroller at the Patent Office. . . . That registered drawing is the design, and nothing else. It is no part of this Act of Parliament that the person registering a design should say and describe minutely, or at all, how it is to be made or how it is to be carried out, and it appears to me immaterial in considering this Act of Parliament whether a design can be copied in more ways than one or not. There may be various methods of producing a coffin plate of this particular design and this particular pattern. . . . We have nothing to do with the mode in which you are making the pattern; that has nothing to do with it at all. The thing is the pattern—the design which is shown here, and nothing else."

§ 35. The net result of all the cases is that (subject to the other provisions of the Act) protection is given

(*l*) (1893) 9 R. P. C. 467, and on appeal 10 R. P. C. 29.
(*m*) 10 R. P. C. 32.
(*n*) (1887) 14 R. P. C. 909, and, on appeal to the House of Lords, 15 R. P. C. 441. For illustration of the design in this case, see Appendix F., Sheet 7, *post*, p. 429.

under the name of "Design" to every combination of lines producing when applied to any substance or article of manufacture either pattern, shape, configuration, or ornament, by whatever means such pattern, etc., may be so produced.

§ **36.** The classification of substances and articles of manufacture for the application of designs to which copyright may be obtained under the Rules, shows the universality of subjects to which the Act applies (*o*). It is as follows:—

Class 1.—Articles composed wholly or chiefly of metal, not included in Class 2.
„ 2.—Jewellery.
„ 3.—Articles composed wholly of wood, bone, ivory, papier maché, or other solid substances not included in other classes, or of materials in which such substances predominate.
„ 4.—Articles composed wholly of glass, earthenware, or porcelain, bricks, tiles, or cement, or in which such materials predominate.
„ 5.—Articles composed wholly of paper (except paper hangings), card-board, mill-board or straw-board, or in which such materials predominate.
„ 6.—Articles composed wholly of leather or in which leather predominates and bookbinding of all materials.
„ 7.—Paper hangings.
„ 8.—Carpets and rugs in all materials, floorcloths, and oilcloths.
„ 9.—Lace.
„ 10.—Hosiery.
„ 11.—Millinery and wearing apparel, including boots and shoes.
„ 12.—Ornamental needlework on muslin or other textile fabrics.
„ 13.—Printed or woven designs on textile piece goods (other than checks or stripes).
„ 14.—Printed or woven designs on handkerchiefs and shawls (other than checks or stripes).
„ 15.—Printed or woven designs (on textile piece goods or on handkerchiefs or shawls) being checks or stripes.
„ 16.—Goods not included in other classes.

(*o*) Schedule IV. to the Rules of 1908. The classes agree generally with those under the old Act, except that Classes 9 and 10 were formerly in one class (9) and a new class (15) is formed for checks and stripes which were previously included in the old Classes 13 and 14 comprising textile piece goods and handkerchiefs and shawls respectively. Classes 11, 12 and 16 under the Rules of 1908 were numbered 10, 11 and 12 respectively under the old Rules.

CHAPTER III.

NOVELTY.

(*The full references to all the Reports will be found in the Table of Cases ante.*)

§ 37. General Rules as to Novelty—Effect of Publication.
§ 38. Distinction between "New" and "Original" (*Sherwood* v. *Decorative Art Tile Co.*).
§ 39. Differences from Patent Law.
§ 40. Novelty in the application of the Design (*Saunders* v. *Wiel*).
§ 41. New method of Appliance not a Novelty (*Cooper* v. *Symington*).
§ 42. Utility immaterial as to Subject Matter (*Tyler* v. *Sharpe*).
§ 43. Novelty involves substantial difference from what has gone before—Tandem-collar Case (*Le May* v. *Welch*)—Lamp-shade Case (*Re Clarke's Design*).
§ 44. Novelty arising from Combinations of Old Designs—Honeycomb Pattern Case (*Harrison* v. *Taylor*)—Card-basket Case (*Lazarus* v. *Charles*).
§ 45. Test of the Eye—Motor-cycle Frame Case (*Werner Motors* v. *Gamage's*).
§ 46. Application of Old Designs to New Substances—Lamp-shade Cases (*Re Bach's Design* and *Re Read and Greswell's Design*).
§ 47. Application to New Purposes (*Walker* v. *Falkirk Iron Co.*).

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§ 37. The Act of 1907 provides (as did the Act of 1883) that to qualify for registration a design must be "new or original and not previously published in the United Kingdom" (*a*). A design which has been published is no longer novel, and no copyright in such a design can be obtained even by an independent author. The words of the Act are "new or original," coupled with the phrase "not previously published"; but it is clear that the production of a design which has never been published does not act as a bar to the registration of the

(*a*) Sect. 49 (1).

same design by any subsequent independent author (*b*). What is requisite therefore to take a design out of the class of designs "new or original and not previously published" is that the same, or substantially the same, thing should have been produced previously in such manner as to become public property. Novelty is essential in every case. In every case also prior publication is fatal; previous production uncommunicated to the public is not.

But the new Act has introduced (*c*) two exceptions to these rules in favour of the proprietor of a design already on the register in respect of one or more classes of goods by providing that the application of such a proprietor to register in one or more other classes shall not be refused nor the registration invalidated (a) on the ground of the design not being a new and original design by reason only that it was so previously registered, (b) on the ground of the design having been previously published by reason only that it has been applied to goods of any class in which it was so previously registered.

These two exceptions apply only in the case of proprietors already on the register, and we shall therefore, in the first instance, treat generally of the subject of what is "new or original," which involves the consideration of how far a given design is the same or substantially the same as other existing designs; and in a separate chapter (*d*) of "publication," which involves the consideration of what amount of publicity is in law sufficient to amount to previous publication. In treating of these questions assistance can frequently be derived from the authorities on art copyright and patent

(*b*) See *Bentley* v. *Fleming* (1844), 1 Car. & K. 587; *Lewis* v. *Marling* (1829), 1 W. P. C. 493.

(*c*) Sect. 50.

(*d*) See p. 46, *infra*.

law in which similar considerations arise as the basis of title.

§ **38.** Whether any distinction was intended to be made between the terms "new" and "original" does not seem clear; but the Act does not require that the design shall be both new and original to entitle it to registration. It will apparently be sufficient to prove that a design is new without inquiring as to its originality (*e*).

> In the case of *Sherwood* v. *Decorative Art Tile Co.* (*f*), Manisty, J., used words which seemed to imply that he thought there was a difference in meaning between the two terms. Speaking of a new combination of well-known parts, he said: "It was not what I think the Act of Parliament means by an original design—that is to say, suppose there had never been any ornamental tiles, and a designer had designed this very design—that would have been original. But I am satisfied this is a new design; the arrangement and effect of it is new. It is really a combination of well-known parts; but so new as to be a new design."

On the other hand, it has always been recognised that the novelty which is required is something which falls considerably short of originality in the ordinary sense, and that a design need only be new in its application to the substances in the class in which it is registered, though possibly old for goods of a different description.

> In *Re Clarke's Design* (*g*), Lindley, L.J., said: "What, then, is the test to be applied to a case such as that before us? The design must be new or original with reference to the kind of article for which it is registered; meaning by kind of article not the class of article mentioned in the schedule to the rules, but the kind of article having regard to its general character and use. A design may be new for a coal scuttle, but not for a bonnet. On the other hand, a design for a shade of a gas lamp can hardly be new if it was old for an oil lamp. There must be some novelty or originality in the shape, as applied to sources of light, in order that a design for the shape of a lamp can be protected."

(*e*) See, however, sect. 93 (as to proprietorship) where the words used are "new *and* original."

(*f*) (1887) 4 R. P. C. 207, 209.

(*g*) (1896) 13 R. P. C. 351.

So in *Re Rollason's Design* (*h*), the point was discussed by Chitty, L.J., who said: "The principal question is whether Rollason's design as registered is a new or original design. I take it that there may be a distinction, and as the Act has used two different words, there is some distinction between 'new' and 'original.' It might be shown in this way: Every design which is original is new, but every design which is new is not necessarily original. There are very few designs which are entirely new. Hardly any could be produced. They are made up from the old, and several exhibits have been put before us to show what the old was. It is acknowledged in the argument for Mr. Rollason, that his is made up of several old designs which he has combined together. The result of the combination may be to make a novel design, and I think in this case there is sufficient material for us to decide that these old things in combination present to the eye a new design."

§ 39. In determining whether a given design is new or original, the cases on patents must not be followed too closely; there is no complete analogy in this respect between copyright in a design and the monopoly in a patentable invention, and the Act will not be construed as strictly as in the case of patents (*i*).

The distinction was very clearly brought out in the leading case of *Werner Motors* v. *Gamage's, Ltd.* (*k*), where the plaintiffs had registered a design "for the pattern as shown of a motor cycle frame," and had at the same time applied for the grant of a patent for the frame which had been duly granted. At the trial Byrne, J., said: "There is nothing inconsistent between a grant for a patent and a coincident right and existence of a statutory right to a design. The object of and privilege conferred by letters patent are wholly different from the object of and privileges conferred by statute to a design by registration. They may be co-existent, and the rights conferred do not clash. The patent rights may be infringed notwithstanding the design, and the design may be infringed though patent rights may not be touched. A design may be copied exactly without a patent for the subject being infringed, and a patent may be easily infringed without

(*h*) (1897) 14 R. P. C. 909. See also *Hutchisons Ltd.* v. *St. Mungo Co.* (1907), 24 R. P. C. 265.

(*i*) *Harrison* v. *Taylor* (1859), 29 L. J. Ex. 3; *Lazarus* v. *Charles* (1873), 16 Eq. 117; *Moody* v. *Tree* (1892), 9 R. P. C. 333. For the distinction between an invention and a design, see the judgment of Moulton, L.J., in *Re Bayer's Design* (1907), 24 R. P. C. at p. 76.

(*k*) (1904) 21 R. P. C. 137, and, in the Court of Appeal, *ibid.* 621.

touching rights to a design. The two rights are separate and distinct in title as well as in substance." This decision was confirmed by the Court of Appeal, where Romer, L.J., in the course of his judgment, said: "It was suggested, however, that though two independent persons might, under the circumstances I have indicated, have independent rights in the patent and the design, yet the same person could not hold both. I do not on consideration see sufficient reason for so deciding. . . . Consider the case of a patentee who files his provisional specification. He may be in doubt whether his patent will ultimately be held good, though he hopes and believes that it is good; but he is perfectly certain, at any rate that so far as the design of the article is concerned, it is perfectly novel, and that he is entitled to have that design registered. Therefore, after filing his provisional specification, he applies for the registration of the design, and the design is duly registered, and he acquires rights under that registration."

In *Re United States Playing Cards Co.'s Application* (*l*), Swinfen Eady, J., held that registration as a design and registration as a trade mark were not mutually exclusive, and that it was no objection to an application to register what was claimed to be a trade mark that the subject-matter of the application was also capable of being registered as a design.

Subject to these general observations, the rules relating to designs may be stated thus:—

§ 40. The novelty required is in the application of the design and not in the design itself, *i.e.*, novelty in the idea, or even in the combination of lines constituting the design, is not necessary if the application is novel.

The leading case upon this point is *Saunders* v. *Wiel* (No. 2) (*m*). The facts were these:—The plaintiffs registered a design as for a "pattern or shape of spoon or fork handle in metal." The registered design consisted of the shaft of a spoon, and on the top of it a representation of Westminster Abbey with its two towers and pinnacles, and the transept with buttresses. The design was copied from a photograph taken from a particular point of view. Cave, J., and the Court of Appeal decided in favour of the novelty of the design. Bowen, L.J., said: "The argument really comes to this, it seems to me, that what the Act requires is novelty in the idea itself. That is not the language of the section, in the first place. It is novelty or originality in the design: that is to say, in a combination calculated to pro-

(*l*) 77 L. J. Ch. 204; [1908] 1 Ch. 197.

(*m*) (1892) 9 R. P. C. 467, and on appeal, 10 R. P. C. 29. See also *Harrison* v. *Taylor*, *supra*, and *Thom* v. *Sydall* (1872), 26 L. T. (N. S.) 15.

duce a particular end—novelty in the way in which the idea is to be rendered applicable to some special subject-matter. . . . You must regard it and test its novelty throughout as a novelty which is expected and demanded from a design which is intended to be applicable to an article of manufacture. When you get thus far, it is obvious, in the first place, that Westminster Abbey is not a design. The photograph is not a design. The photograph is that from which the design is taken, just as, if the step of the process of photography had been omitted, and the artist had gone straight to the Abbey, he would have made his design from the Abbey, but he would not have converted the Abbey into the design. It seems to me that the novelty and originality in the design, within this section, is not destroyed by its being taken from a source common to mankind. The novelty may consist in the applicability to the article of manufacture of a drawing or design which is taken from a source to which all the world may resort. Otherwise it would be impossible to take any natural or artistic object and to reduce it into a design applicable to an article of manufacture, without also having this consequence following, that you could not do it at all, in the first place, unless you were to alter the design so as not to represent exactly the original; otherwise, there would be no novelty in it because, it would be said, the thing which was taken was not new. You could not take a tree and put it on a spoon, unless you drew the tree in some shape in which a tree never grew; nor an elephant, unless you drew it and carved it of a kind which had never been seen. An illustration, it seems to me, that may be taken about this is what we all know as the Apostles' spoons. The figures of the Apostles are figures which have been embodied in sacred art for centuries, and there is nothing new in taking the figures of the Apostles, but the novelty of applying the figures of the Apostles to spoons was in contriving to design the Apostles' figures so that they should be applicable to that particular subject-matter. The answer to the whole case of the appellant is that it is not the natural object which is the design; that it is not the photograph which is the design. The novelty of the design consists in contriving the copy or imitation of the figure, which itself may be common to the world, in such a manner as to render it applicable to an article of manufacture" (*n*).

In the recent case of *Hutchisons Ltd.* v. *St. Mungo Manufacturing Co.* (*o*), the plaintiffs had registered a design for a

(*n*) It is difficult to reconcile this with *Adams* v. *Clementson* (1879), 12 Ch. Div. 714, in which Malins, V.-C., held that a portrait of a well-known character, copied from a photograph, and applied as a design upon earthenware, was not a new and original design. This case was decided under 5 & 6 Vict. c. 100, and can hardly be regarded any longer as an authority.

(*o*) (1907) 24 R. P. C. 265.

golf ball showing a brambled ball having round each of its six poles a small circular smooth raised band having lettering incised on it; the brambles being arranged in concentric circles round the poles. Concentric brambling round six poles had been previously employed, but never in conjunction with same circles round the same six poles. Held, that the design was novel; that it was not necessary that it should be novel *and* original; and that it was validly registered.

§ 41. Where the claim is neither for pattern nor ornament a new method of appliance or manufacture will not entitle a design to registration. In the shape or configuration must be the novelty.

Cooper v. *Symington* (*p*) is the leading case. There it appeared that in corsets existent previous to the plaintiff's, busks were sewn in the front of the corset or were laced in, so as to be easily removable by running lacing at the outer margin of the busks. In the former case the corset was sometimes fastened by lacing together the two inner margins of the busks, in the latter the corset was fastened by hooks and eyes. In the plaintiff's corset the busks were laced in and thus easily removable, but the lacing was diagonal and was at the inner margin of the busks, and when closed this diagonal lacing gave the appearance of the corset being laced together, though the corset was really fastened by hooks and studs. Chitty, J., held that there was no difference in appearance and shape between the old and the plaintiff's corset, and that there was no novelty in the design sufficient to justify registration.

§ 42. The utility of the design is not to be regarded so far as subject-matter is concerned (*q*), though it may be some evidence of originality (*r*). The standard of originality to which a new design must attain in order to entitle it to protection as a novelty is in such cases not a high one (*s*), and the question of artistic merit is not material.

In *Tyler* v. *Sharpe* (*t*), the owner of a design for water-

(*p*) (1893) 10 R. P. C. 264; *Moody* v. *Tree* (1892), 9 R. P. C. 333. And see *In re Bayer's Design*, on appeal (1907), 24 R. P. C. 265.

(*q*) *Moody* v. *Tree*, *supra*.

(*r*) *Tyler* v. *Sharpe* (1893), 11 R. P. C. 35.

(*s*) See per Lord McLaren in *Walker* v. *Falkirk Iron Co.* (1887), 4 R. P. C. 391.

(*t*) (1893) 11 R. P. C. 35. See also *Nevill* v. *Bennett* (1898), 15 R. P. C. 412, and the observations of Vaughan Williams, L.J., in *Re Bayer's Design* (1907), 24 R. P. C. at p. 73, to the same effect.

closet basins claimed for infringement of his design by a competing pattern; and it was contended for him that the defendants, by adopting the same shape, had given evidence of its novelty. Romer, L.J., in giving judgment for the plaintiff, said: "I am much impressed, in considering that matter, by the undoubted fact, established before me, that directly this design was put on the market it at once acquired considerable popularity and a large sale, and that the so-called anticipations of that design, so far as proved before me, were never practically sold at all. The plaintiff's design has distinct advantages over the prior designs for similar articles put in evidence on behalf of the defendant—advantages of importance to a manufacturer on a question of utility; such advantages as cheapness of manufacture, strength of the article, and so forth."

So in *Harper* v. *Wright & Butler* (*u*), where the plaintiffs had registered two designs for stoves, the second being a modification of the first with some improvements, including an enlarged base; and it was contended by the defendants that this second design could not be supported as novel or original, having regard to the existence of the first, on which it was founded, and that it was not in the public interest that a person who had registered a design could, by insignificant variations from time to time, extend the term for which he obtained protection. Herschell, C., in dismissing this contention, said: "I cannot see that the public is in the slightest degree affected if those alterations and modifications are immaterial, slight, and unimportant, and do not make the thing, as a whole, a desirable thing which the public will seek to become the owners of. If they do, what better proof can you have that it was a new and original design, of which the person designing ought to be entitled to have the benefit?"

Again, in *Re Rollason's Design* (*x*), the question turned on differences between two coffin plates which, in the Court below, were held not to be sufficient to constitute novelty; but in the Court of Appeal and the House of Lords a different view was taken, and Lord Herschell, in giving the judgment of the House of Lords, said: "Having got at the design, and bearing in mind that it is not a design in the abstract but a design for coffin plates, the question, the simple question and the whole question, is whether it is new or original. If we take it that this design is for a coffin plate, with a sunk centre or a raised edge, the case is comparatively easy; because I

(*u*) (1895) 12 R. P. C. 483.
(*x*) (1897) 14 R. P. C. 893, 909.

think, from that point of view, it is not certainly anticipated by either the exhibit which has a depressed centre and has more or less of a shell pattern at the edges, or by S.'s, which has no depressed centre at all. You cannot analyse the difference. You might find many differences and yet come to the conclusion that the designs were the same; you might find but few differences and yet come to the conclusion that the designs were different. Very often a very successful design may be one in which the difference from previous designs can, on analysis, be shown to be very slight, where nevertheless the result is to make the one so much more pleasing than the other that it is a successful design."

§ 43. A design is not novel unless it be substantially different to what has been produced before, having in view the purpose to which it is to be applied. This has been laid down in many cases; and it is obvious that if a slight difference in design were sufficient to entitle the author to registration, the advantages of the Act would be to a considerable extent lost; for the same principle must be applied to cases of alleged infringement, where small differences would, in that case, be sufficient to protect from the charge of imitation (*y*).

In *Le May* v. *Welch* (*z*), for a design known as the "Tandem Collar," it was claimed that there were these advantages: the height of the collar above the stud, the absence of a band, and the cutting away of the corners in segment shape, thus giving the neck greater freedom. In other collars produced these characteristics were to be found, though there were differences in the proportions of the several parts. The design was declared unfit for registration. Bowen, L.J., said: "It is not every mere difference of cut, every change of outline, every change of length, or breadth, or configuration, in a simple and most familiar article of dress like this, which constitutes novelty of design. To hold that would be to paralyse industry and to make the Patents, Designs, and Trade Marks Act a trap to catch honest traders. It cannot be said that there is a new design every time a coat or

(*y*) See the cases as to infringement collected in Ch. VIII., *post*. And see *Hutchisons Ltd.* v. *St. Mungo Manufacturing Co.* (1907), 24 R. P. C. 265.

(*z*) (1884) 28 Ch. Div. 24, where diagrams of the collars will be found. But see *In re Morton's Design* (1899), 17 R. P. C. 117, and *Pearson* v. *Wilkinson* (1906), 23 R. P. C. 738.

waistcoat is made with a different slope or a different number of buttons. Tailoring would become impossible if such were the law, and it does not appear to me that such is the law. There must be, not a mere novelty of outline, but a substantial novelty in the design having regard to the nature of the article." And Fry, L.J., says: "It has been suggested that unless a design precisely similar, and in fact identical, has been used or been in existence prior to the Act, the design will be novel or original. Such a conclusion would be a very serious and alarming one, when it is borne in mind that the Act may be applied to every possible thing which is the subject of human industry, and not only to articles made by manufacturers, but to those made by families for their own use. It appears to me that such a mode of interpreting the Act would be highly unreasonable, and that the meaning of the words 'novel or original' is this: that the design must either be substantially novel or substantially original, having regard to the nature and character of the subject-matter to which it is to be applied."

This case has been followed in *Smith* v. *Hope* (*a*) (a case relating to a design for scarves), and it is in accordance with the principles laid down in the older cases of *Windover* v. *Smith* (*b*), *Lazarus* v. *Charles* (*c*), and *McCrea* v. *Holdsworth* (*d*).

In *Re Clarke's Design* (*e*), a design for a lamp for electric lighting, which consisted as to its lower part of a reflecting screen, old as applied to oil or gas lamps, and as to its upper part of a ventilating top not substantially differing from the top of an old lamp, was held not to have sufficient novelty to support the registration, and Lindley, L.J., in giving judgment, said: "If, when registered, the design was not new or original for all lamps, if the shape was common for such lamps as were used before electric lighting was invented, the design is one to which the Act does not apply, and the design ought to be expunged. Where a design is composed of old parts and is registered, the designing as one whole is what is protected, not the design for some or one of the component parts taken separately from any of the others; and it is not necessary to distinguish what is old from what is new. But treating the design as a design for the shape of the two parts in combination, the view which I take of the evidence brings this case within the principle expounded by this Court in *Le May* v. *Welch*. There is nothing really new or original in the shape of the kind of article to which the registered design is made

(*a*) (1889) 6 R. P. C. 200.
(*b*) (1863) 32 L. J. Ch. 561.
(*c*) (1873) 16 Eq. 117.
(*d*) (1870) L. R. 6 Ch. App. 418.
(*e*) (1896) 13 R. P. C. 351.

applicable. I have come to the conclusion that this design being for shape, and shape only, though now in its application to electric lamps, was old in its application to other lamps, and was not one to which the Act applied."

In *Re Rollason's Design* (*f*), where a design had been registered for the pattern of certain coffin plates, and it was contended that this pattern was not novel, having been anticipated by a design of S., another maker, the registration was upheld by the Court of Appeal on the ground of substantial difference from previously existing designs for the purpose.

In the recent case of *Pearson* v. *Wilkinson* (*g*), a registered design for the bodies of perambulators made with a rounded end turned over was challenged by the production of similar forms in cradles and bassinettes, but the novelty of the design was upheld by Kekewich, J., who said: "I have had produced before me two articles to which I must pay attention, one marked 'G' and the other 'A'. As regards 'A' . . . the evidence goes to show that it was not meant to be a perambulator, and was never used as a perambulator. It was made, one witness said, for a cradle, which I cannot help thinking is wrong. I have not looked it up in the dictionaries, but in common parlance a cradle is a receptacle for a child with rockers. Of course, this might be put on rockers without difficulty. It is more like what is known in modern terms as a bassinette. It is not a perambulator: though it might be converted into one. It might be put upon wheels with very little ingenuity, but it is not made for that. Therefore it seems to me, according to the authorities, into which I need not go, to be undoubtedly no anticipation. If that is true as regards 'A' it is certainly true as regards 'G,' except that here the article was made as a perambulator. Again, we have the bellied end. There is nothing in it, but it is not turned to advantage by turning over the end towards the child. Looking at it now as I see it, it slopes outwards, not inwards. So that there is no anticipation."

In *Hutchisons Ltd.* v. *St. Mungo Manufacturing Co.* (*gg*), a design for a golf ball, varying only in small but still distinctive features from previous patterns, was held to be novel as applied to those goods, and to be validly registered, although it did not require ingenuity to produce it, and was not really original.

§ 44. It is not necessary that every part of which the

(*f*) (1897) 14 R. P. C. 909. See also *Werner Motors* v. *Gamage's, Ltd.*, 21 R. P. C. 627. For illustrations, see Appendix F., Sheets 7 and 9, *post*, pp. 423, 425.

(*g*) (1906) 23 R. P. C. 738. For illustration, see Appendix F., Sheet 5, p. 427.

(*gg*) (1907) 24 R. P. C. 265.

design is made up shall be new; a combination of known things may produce a new and original design. But the combination itself must be new; two old designs may be combined, but if combined in the old way, there is no novelty.

R. v. *Firmin* (*h*). A button was made with the Royal Arms on it surrounded with a garter bearing the inscription "The Royal Mail Steam Packet Co."; the simultaneously applying two old and known designs to the ornamentation of a button was declared to be a novelty. Coleridge, J., suggested (by way of example) that if a button were made with a picture of a jockey upon it, and another with the picture of a horse, a third with the pictures of the horse and jockey combined would make a new design.

Harrison v. *Taylor* (*i*). In this case it appeared that a well-known pattern, called the honeycomb pattern, consisted of a certain cellular arrangement of the surface in cells of a uniform size, and the plaintiff designed a new pattern in which large and small honeycomb cells were arranged so that a border of the larger cells surrounded an enclosed portion of the smaller cells; the jury found that the design was new and original; the Court of Exchequer set aside the verdict, but the Exchequer Chamber restored it. Wightman, J., said: "It is true all the component parts of it were old, but as to the drawing itself, no one had produced such a pattern as that before. It was said by one of the learned judges of the Court below, that the constituent parts of it were old, and the novelty was only in the arrangement or combination. Why? A picture which contains within it a novel combination of old parts is a new drawing; and it seems to me, if no one else has ever combined them in the same manner, it would be a new design within the protection of this Act of Parliament. In my opinion, it was a question for the jury, whether substantially this was a new and original design."

These decisions were under consideration in *Lazarus* v. *Charles* (*k*). The design in that case consisted of a double card basket, formed of a combination of two baskets, admitted to be separately old in design; and Malins, V.-C., refused to allow that there was any novelty justifying registration. *Harrison* v. *Taylor* and *R.* v. *Firmin* were cited, but the Vice-Chancellor considered that the facts were distinguishable, and he expressed himself reluctant to follow those cases unless

(*h*) (1851) 3 H. & N. 304 (n.). (*i*) (1859) 29 L. J. Ex. 3.
(*k*) (1873) 16 Eq. 117.

"something novel were introduced in the combination." He preferred the decision in *Mullooly* v. *Stevens* (*l*), in which Wood, V.-C., refused an interlocutory injunction on the ground that it was too doubtful whether the mere union of old designs by a button was a new and original design.

But in *Sherwood* v. *Decorative Art Tile Co.* (*m*), where the design for a tile was made up of a floriated pattern surrounded by an old geometrical border, the novelty of the combination was upheld, Manisty, J., in giving judgment, saying: "It is clear to my mind, at all events, that the plaintiff's design which is now in question was a new combination—a new arrangement of old parts. . . . It is really a combination of old parts, but so new as to be a new design."

In the more recent case of *Nevill* v. *Bennett* (*n*), the design was of a pattern to be printed on textile goods, and its novelty was challenged by the defendants, who alleged anticipation; but, in upholding the validity of the design, Hall, V.-C., said: "That this was new and original is obvious from this, amongst other things, that the defendants themselves, as soon as a piece of this design came into their possession (on the instructions of a merchant trading in the same market), went to their designer and said, 'Design us a design of this kind.'"

So in *Re Bayer's Design* (*nn*), Vaughan Williams, L.J., in giving judgment, said: "I agree with what has been said that the conduct of the appellants themselves in their production of corsets, which are in accordance with the corset here represented, is itself some evidence to show that the nature of this corset was such that, not having themselves used a corset of that shape before, and seeing this corset, and being people engaged in the trade, they thought that there was sufficient in this corset to make it desirable that they also for the first time should make corsets in accordance with this pattern, and I think there is very considerable evidence in this case in support of the allegation of novelty" (*o*).

§ 45. Novelty is a question of fact (*p*), the ultimate

(*l*) (1864) 10 L. T. (N. S.) 190.

(*m*) (1887) 4 R. P. C. 207.

(*n*) (1898) 15 R. P. C. 412.

(*nn*) (1907) 24 R. P. C. 65.

(*o*) And see remarks of Chitty, J., in *In re Plackett's Design* (1891), 9 R. P. C. 436; of Day, J., in *Heinrichs* v. *Bastendorff* (1893), 10 R. P. C. 160; and in *Rivett* v. *Grimshaw* (1894), 11 R. P. C. 351. The cases *contra* are *Norton* v. *Nicholls* (1859), 28 L. J. Q. B. 225; *Hothersall* v. *Moore* (1892), 9 R. P. C. 27 (an important judgment of Bristowe, V.-C., in which all the cases are reviewed); and *Re Clarke's Design* (1896), 13 R. P. C. 351.

(*p*) *Harrison* v. *Taylor* (1859), 29 L. J. Ex. 3.

test being the appeal to the eye (*q*). The Court may receive assistance from experts in this matter; in fact, though the opinion is formed from the eyesight, it must be, if necessary, expert eyesight (*r*).

In the case of *Birkin* v. *Pratt* (*s*), which was for infringement of registered designs for lace, after the first witness had been called for the plaintiff, the judge (Romer, J.) suggested that two independent experts on each side should be called, and on plaintiff's counsel submitting that, in such a case, the question of infringement must depend on the trade and the judgment of experts, he said, "the judge will decide after hearing the experts."

In *Werner Motors* v. *Gamage's, Ltd.* (*t*), where the question of anticipation arose in respect of motor cycle frames, it was contended that expert evidence was only permissible in respect of matters requiring explanation from a scientific point of view, and that a witness could not be asked questions dealing with the functions of the machine, but Byrne, J., admitted the evidence and directed the expert to point out in the actual machine and also in the alleged infringement each of the parts shown in the registered drawings; and objection being raised to a further question whether the registered design had been applied to the motor cycle complained of, the judge suggested that the question should be whether the witness found all the parts represented in the design in the alleged infringement, and this was admitted as to shape and relative position, and the expert also gave evidence, without objection, that he saw no design referred to in the particulars of objections like the registered design in configuration and geometrical arrangement of parts one to another.

In *Re Bayer's Design* (*tt*), the judgment of the Court went on the question of subject-matter, and in dealing with this, Fletcher Moulton, L.J., said: "In the classic decision of

(*q*) This has been stated as a ground of decision over and over again, and reference may be made to the following authorities:—*Demartial* v. *Booth* (1892), 9 R. P. C. 499; *Tyler* v. *Sharpe* (1893), 11 R. P. C. 35; *Hecla Foundry Co.* v. *Walker* (1889), 14 A. C. 550; *Re Plackett's Design* (1892), 9 R. P. C. 436; *Moody* v. *Tree* (1892), 9 R. P. C. 333; *Re Morton's Design* (1891), 17 R. P. C. 117; *Re Bayer's Design* (1906), 23 R. P. C. 553.

(*r*) *Cooper* v. *Symington* (1893), 10 R. P. C. 264; *Grafton* v. *Watson* (1884), 50 L. T. (N. S.) 420.

(*s*) (1895) 12 R. P. C. 371. For illustrations of the designs in this case, see Appendix F., Sheet 12, *post*, p. 434.

(*t*) (1903) 21 R. P. C. 141.

(*tt*) (1907) 24 R. P. C. 65.

Lord Horsehell, in the *Heela Foundry case*, he pointed out that 'the eye is the judge of infringement,' and if the eye is the judge of infringement, it must be because the eye is the competent judge of that which is infringed. I am satisfied, therefore, that nothing but that which can be matter for the eye to see can be a good subject of design."

§ 46. If the design be old, its application to a new substance for a similar purpose to that for which the design was previously used, will not cause it to be a novelty. And if the design has already been registered in one class, it cannot generally be registered in another class as a novelty, even for an entirely different purpose.

(This is, however, subject to the two exceptions in favour of proprietors already on the register introduced by sect. 50 of the new Act, which declares that a registration in a new class or classes by such a proprietor of a design already registered in one or more other classes, shall not be invalidated by reason only that it was so previously registered or by reason only of its having been published by being applied to goods of any such other class.)

In *Re Bach's Design* (*u*) a lamp shade made of china in the shape of a rose was registered in one class; a design for a lamp shade made of linen, also in the shape of a rose, had previously been registered in another class, and Kekewich, J., decided that, though the materials were different, there was no novelty in the china design (*x*).

In *Re Read & Greswell's Design* (*y*) T. registered a design for the pattern and shape of a flower candle shade in imitation of a chrysanthemum in Class V. (articles composed of paper); subsequently R. & G. registered in Class XII. (general) a similar design. Chitty, J., said that R. & G.'s design was not new and original, and added: "The respondents' design is registered in Class XII., which is for goods not included in the other classes, and it is argued on their behalf that although their design may not by itself be new and original, yet that it

(*u*) (1889) 6 R. P. C. 376.

(*x*) And see *Mulloney* v. *Stevens* (1864), 10 L. T. (N. S.) 190.

(*y*) (1889) 6 R. P. C. 471. And see *In re Clarke's Design* (1896), 13 R. P. C. 351.

is so within the meaning of sect. 47 of the Act. That argument comes to this, that where a new and original design is registered in one class, a rival designer is at liberty to take the design and transfer it bodily to another class, and register it in that class, or, if it be on the register, may maintain it there. I do not think this argument can be sustained. To be capable of being registered a design must be 'new or original' in fact, and not, as is suggested, 'new or original' as to some particular class of goods. It cannot be said to be new and original if it is already being applied to articles of an analogous character."

§ 47. But these cases must be distinguished from cases where the design is not simply copied in a different material, but is applied, with other materials, to a different purpose, making of the whole a new article. For in such cases the registration of the design will not be invalidated by reason of its previous use.

In *Walker* v. *Falkirk Iron Co.* (z) a design was registered "for a fire-range door with moulding on the top, moulding forming part of range, shape to be registered." Lord Mure, expressing agreement with the other members of the Court who uphold the novelty of the design, said: "Now I think there is evidence to show that such a door as this was not unknown before in certain kinds of doors, but I am quite clear upon the evidence that it was new as applied to kitchen ranges." In *Bach's case* (zz) the old design was simply copied in a different material; in *Walker* v. *Falkirk Iron Co.* it was applied to a different purpose, making of the whole a new article.

So in *Varley* v. *Keighley Iron Works* (a), the plaintiffs, as owners of a registered design for a pressure bar for wringing and mangling machines, brought an action for infringement, which the defendants denied, alleging also that the plaintiffs' registered design was not good subject-matter for registration, and was anticipated by various prior publications. Judgment was given for the plaintiffs, Mathew, J., holding that although there was nothing novel about the mode in which the pressure was applied, which was the same in all the machines, the plaintiffs' "pattern" was novel, and had been exactly copied by the defendants, and he awarded a penalty of 50*l.*

(z) (1887) 4 R. P. C. 390.
(zz) (1889) 6 R. P. C. 376.
(a) (1897) 14 R. P. C. 169. For illustration of the design in this case, see Appendix F., Sheet 8, *post*, p. 430.

CHAPTER IV.

PUBLICATION.

(*The full references to all Reports will be found in the Table of Cases ante.*)

§ 48. Different Modes of Publication.
§ 49. Prior User. Exception in favour of Registered Proprietors.
§ 50. Exhibition for sale (*Re Sherwood's Design*; *Harper* v. *Wright and Butler*).
§ 51. User sufficient to acquaint Public (*Carpenter* v. *Smith*; *Stead* v. *Williams*).
§ 52. Experimental User.
§ 53. Manufacture in Workshop (*Humpherson* v. *Syer*).
§ 54. Modifications introduced by Act of 1907.
§ 55. Analogy of Copyright Cases (*Prince Albert* v. *Strange*, etc.).
§ 56. Analogy with Works of Sculpture.
§ 57. Summary of Copyright Authorities.
§ 58. Publication in Books and Documents.
§ 59. Differences from Publication by User—Romilly, M.R., in *Lang* v. *Gisborne*; Jessel, M.R., in *Plimpton* v. *Malcolmson*.
§ 60. Sufficiency of Matter Published (*Philpott* v. *Hanbury*).
§ 61. Publication to Individuals (*Blank* v. *Footman*)—Commercial dealing with Design (*Heinrichs* v. *Bustendorff*)—Provisions of the new Act.
§ 62. Publication out of the United Kingdom.
§ 63. Registration not Publication?
§ 64. Publication at Public Exhibitions.
§ 65. Notification required to secure Exemption.

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§ **48.** The second condition necessary to qualify a design for registration is that it shall not have been previously published in the United Kingdom (*a*). Publication for this purpose may have been either (a) by prior user, (b) in books or documents, (c) by communication to third persons, or (d) at public exhibitions.

§ **49.** When a design has been exhibited or publicly used, it is, as a general rule, no longer a subject for valid registration. Prior user means, not user by the public,

(*a*) Act of 1907, sect. 49 (1).

but user in public (*b*); and it means a user other than a mere experimental user.

The decisions upon this branch of the subject are to be found largely in cases dealing with patent disputes, but the principles laid down in these cases apply generally *mutatis mutandis* to designs. Where, however, the validity of a patent is in dispute, it may sometimes be argued, that though used in public, knowledge of the invention does not necessarily become public property, as the means whereby the results are produced are not discoverable by mere inspection; such an argument cannot from the nature of the subject be used in a case relating to designs, and public user will be found generally to disqualify for registration. The analogy of art copyright is perhaps a little nearer to copyright in designs, and the authorities on that subject will afford assistance in dealing with the questions of what constitutes "publication."

The exception introduced by sect. 50 (b) of the new Act in favour of proprietors of designs registered in one class, enabling them to effect registration of the same design in another class or classes subsequently without being prejudiced by the first registration or application of the design thereunder, is of general importance in considering questions arising under the head of "prior publication."

§ **50**. The general rule that prior user by exhibition for sale of goods bearing a design which is subsequently registered will invalidate such subsequent registration is illustrated in the following cases:—

Smout v. *Slaymaker* (*c*). On 26th April, 1887, the plaintiff registered a design being a pattern of a fire-screen, made of palm leaves, to hold a flower-pot; the design consisted of

(*b*) See, *e.g.*, *Croysdale* v. *Fischer* (1884), 1 R. P. C. 17; *Gill* v. *Coutts* (1896), 13 R. P. C. 137; and *Betts* v. *Neilson* (1871), 3 Ch. 429; 5 H. L. 1.

(*c*) (1890) 7 R. P. C. 90.

three palm leaves tied together in the form of the ace of clubs. It was proved that fire-screens identical with the plaintiff's design had been exhibited at an exhibition and also sold in Covent Garden before 1887; the design was ordered to be expunged from the register.

Re Sherwood's Design (*c*). On 10th November a firm of manufacturers exhibited to a customer a new globe for a lamp stove, and afterwards supplied two new globes, which the customer exhibited on the 17th November in his shop window; the globes had slip fittings. On the 20th November the firm registered the design of the globe, but substituted a flange at the base instead of the slip fittings. Chitty, J., held that the substitution of the flange for the slip fittings was not sufficient to constitute a new or original design, and that the publication before the 20th November was fatal to the registration on that date.

Harper v. *Wright and Butler* (*d*). The plaintiffs were the registered proprietors of two designs for stoves, one registered on the 25th April, 1891, and the other registered on the 20th June, 1892. The designs registered in each case represented upright hexagonal stoves, decorated with a cathedral window; the second being a modification in some details of the first and having an enlarged base. The defendants contended *inter alia* that the second design was, previously to registration, published by the registration of the first design and by the sale of stoves made according to that design, but the Court of Appeal held that the differences between the two designs were sufficient to constitute a new and original design and that the defence of prior publication failed. Lord Herschell, in giving judgment, said: "It is not a design identical with the design already registered. No doubt it is largely founded upon it. That is stated. It professes to be largely founded upon it, but you may have a new design, though the design is founded upon one which you have previously registered. Nothing has been produced which to my mind shows that there was such a common knowledge before the date of the second registration as to prevent that design, then registered, being a new and original design."

§ 51. The prior user is sufficient to avoid subsequent registration if it enabled the public to become acquainted with the design, a result which it seems must follow whenever a design is publicly used or exhibited; for with the exhibition of a design every detail of it, as a design, may become known even to an unskilled person.

(*c*) (1892) 9 R. P. C. 268.

(*d*) (1895) 12 R. P. C. 483.

On the analogy of the patent cases, whether the public have actually seen the invention or design or not seems unimportant; the point is, was it so used that it might have been publicly seen?

In *Carpenter* v. *Smith* (*e*), a patent had been taken out for a new lock; a similar lock had been used on a certain gate in a public place for over sixteen years, and Lord Abinger, C.B., laid it down to the jury that the use of a lock in such a situation that the public might see it was a public use and exercise of the invention sufficient to avoid registration of the alleged new lock.

This decision was adopted and followed in the more recent Scotch case of *Gill* v. *Coutts* (*f*), where the plaintiff, a paint manufacturer, obtained in 1891 a patent for a paint in which collodion was used combined with a metallic powder to form a lacquer for gilding purposes, and the Sheriff-substitute found it proved that prior to this a third person had used the combination as a paint and lacquer, but only for his own purposes, and held on this that it did not amount to a public user. But on appeal to the Court of Session his decision was reversed, the Court holding, in accordance with the English authorities, that "public use" means "a use in public and not by the public," and that the use made of the paint was of this character; so that the patent was void.

Stead v. *Williams* (*g*) further illustrates the rule that user in public is publication. In that case an invention for paving was in question, and it appeared that a pavement said to be similar to the one in question had been laid down in a small covered-in portico, a porch to the private house of Sir William Worsley. Cresswell, J., in directing the jury, said: "I should say, in point of law, that makes an end of the patent, because that appears to have been introduced by Sir William Worsley, or to have been used by him in public—not concealed, no secrecy about it—made known to all persons who came to his house, so far as ocular inspection could make them cognisant. It was intended to be public—not to be made a matter of merchandise, certainly, but merely for his own private use; but the knowledge of it exposed to the public an article in public use, and it continued to be used down to the time in question. Therefore, if you think that is the same thing in substance as that which the plaintiff claims, I think

(*e*) (1841) 11 L. J. Ex. 213.

(*f*) (1896) 13 R. P. C. 125.

(*g*) (1843) 2 W. P. C. 126, 136. See *Re Taylor's Patent* (1896), 13 R. P. C. 150, to the same effect.

that it was publicly used before, and that he cannot have his patent. Whether it had been used by one or used by five, I do not think it makes any difference."

In *Re Adamson's Patent* (*h*), a contractor, engaged in the erection of a pier, used certain newly-invented machinery on the works for several months before applying for a patent, and during such user it was open to the view of the public. The Lord Chancellor decided that the invention had been publicly used, and refused a patent.

The Lifeboat Co., Ltd. v. *Chambers Bros. & Co.* (*i*). Letters patent for a boat specially useful for lifeboat purposes were granted in November, 1887; it appeared that the boat had been exhibited before that date at one of the shipbuilding yards at Glasgow, at the Royal Albert Docks, London, and at Portsmouth; invitations to the exhibition had been issued, and accounts of the exhibition appeared in the public press; no precautions were taken to ensure secrecy. Held (in the Court of Session in Scotland) that the invention had been used in public, and that the patent was bad.

In *Brereton* v. *Jackson* (*k*), a patent had been taken out for an improved tricycle. One witness stated that prior to the date of the patent he had ridden an identical machine in the public thoroughfare as far as Cheam, Coombe, and Malden, and had used it by day and night. Field, J., decided that there had been prior publication by user.

§ 52. Use of an invention invalidates a subsequent patent, though the original user has been abandoned (*l*), and this applies equally to a design. On the other hand, experimental user, though made in the presence of others than the inventor, and though continued up to the date of the patent (or registration), does not ordinarily amount to publication (*m*). But the coincidence of experiment with actual immediate profit will ordinarily make the experimental user a publication (*n*).

(*h*) (1856) 25 L. J. Ch. 456.

(*i*) (1891) 8 R. P. C. 418.

(*k*) (1884) 1 R. P. C. 165.

(*l*) *Household Co.* v. *Neilson* (1843), 1 W. P. C. 700, 709; *Huggenbracher* v. *Watson* (1897), 14 R. P. C. 349, 621.

(*m*) See *Cornish* v. *Keene* (1835), 1 W. P. C. 508; *Jones* v. *Pearce*, 1 W. P. C. 122; *Household Co.* v. *Neilson*, *supra*; *Electric Plating Co.* v. *Holland* (1901), 18 R. P. C. 521; *Adamson's Patent* (1856), 25 L. J. Ch. 456.

(*n*) *Newall* v. *Elliott* (1858), 27 L. J. C. P. 337.

§ 53. *Use and manufacture in a workshop will or will not be publication, according to circumstances, depending mainly on whether the manufacture is carried on with secrecy or not.*

In *Bentley* v. *Fleming* (*o*), a machine was lent to a second person to have its quality tested, and that person used it for some weeks in a public work-room, and the Judge was of opinion that there had been no publication. The report, however, is very short, and the decision, it is submitted, cannot be much relied upon.

In *Westley, Richards & Co.* v. *Perkes* (*p*), it appeared that a gun was made in open shop, without any injunctions as to secrecy; it was known to many of the workmen, and was sold. On those facts, Kay, L.J., found that the invention had been published. *Morgan* v. *Seward* (*q*), where the contrary was held, was distinguished, on the ground that in that case the engineer who was instructed to make the wheels there in question had instructions to act secretly, and did so.

In *Humpherson* v. *Syer* (*r*), S., the patentee of an improved water-waste preventer, alleged infringement by the defendant, who pleaded anticipation, and alleged that some weeks before the date of the plaintiff's patent he (the plaintiff) had had a model of a waste preventer, similar to that in question, made by a person in his employ, and handed it to one Widmer, who was a tradesman making water-waste preventers, with instructions to make for him a thing to prevent the waste of water, in accordance with that model. The question was whether, having regard to the fact that Widmer received those instructions, and received the information to make the machine like that of the plaintiff which the defendant was now making, that could be considered as a publication, having regard to the fact that Widmer had what he did make made in his public warehouse and exposed in his shop. Widmer was not a servant of S.'s, but a tradesman. The patent was declared invalid, and in giving judgment Bowen, L.J., said: "I put aside questions of public use, and treat this as a question of whether there has been a prior publication; that is, in other words, had this information been communicated to any member of the public who was free in law or equity to use it as he pleased? Was Widmer a person to whom this communication had been made in a manner which left him free both in law

(*o*) 1 C. & K. 587; *Germ Milling Co.* v. *Robinson* (1886), 3 R. P. C. 254.
(*p*) (1893) 10 R. P. C. 181.
(*q*) (1836) 1 W. P. C. 170.
(*r*) (1887) 4 R. P. C. 407.

> and equity to do what he liked with the information? If so, the information, of course, had been given to a member of the public, and there was nothing further to serve as consideration for any patent." *Fry, L.J.*, after finding on the evidence that Widmer made the machine without any obligation to secrecy, said: "But supposing that I am wrong in that, and supposing that Widmer was under an obligation to secrecy, that obligation was broken by him, because he made the machine in the open shop. Now, I am at a loss to find any obligation of secrecy which it can be suggested was placed upon the workmen of Widmer, and upon all the persons who passed through the shop, and if that is so, though there may have been a breach of confidence in making it in the shop, nevertheless, if the public have become possessed of the invention by any means whatever, no such patent can be taken out."

§ 54. The effect of the above decisions is largely modified, as regards designs, by the provisions of the new Act of 1907, s. 55, which declares that "the disclosure of a design by the proprietor to any other person in such circumstances as would make it contrary to good faith for that other person to use or publish the design, and the disclosure of a design in breach of good faith by any person other than the proprietor of the design, shall not be deemed to be a publication of the design sufficient to invalidate the copyright thereof if registration is obtained subsequently to the disclosure."

§ 55. The leading copyright cases(*t*) are of importance in connection with the general question of what amounts to a publication as well as on the nature of authors' right before publication; and it is submitted that the principles laid down in them apply to copyright in designs equally with other branches of copyright property. They amount

(*t*) For a full discussion of the right before publication, see Scrutton on Copyright (Edit. 1903), p. 161 *et seq.* And see the considered judgment of Swinfen Eady, J., in *Mansell* v. *The Valley Printing Co.*, reported in the Times Law Report, 7th Feb., 1908, in which all the authorities were reviewed.

to this, that the author has a right, apart from statute, to prevent publication of his work; that an unlicensed use by a third person is no publication by the author; and that where the right arises (or is lost) on the first publication, the *terminus à quo* from which the statutory protection runs (or on which it fails) is "the moment the eye of the public is *allowed*, by the author, to rest on it."

In *Prince Albert* v. *Strange* (*u*), the plaintiff was the late Prince Consort, and it appeared that he and her late Majesty Queen Victoria had occasionally for their amusement made drawings and etchings, being principally of subjects of private and domestic interest to themselves, and that they had made impressions of those etchings for their own use and not for publication; that, for greater privacy, such impressions had been, for the most part, made by means of a private press kept for that purpose, and the plates themselves had been ordinarily kept by her Majesty under lock, and the impressions had been placed in some of the private apartments at Windsor, and in such apartments only; that the defendants had in some manner obtained some of such impressions, which had been surreptitiously taken from some of the plates, and had thereby been enabled to form a gallery or collection of such etchings, of which they intended to make a public exhibition without the permission of her Majesty or the plaintiff, and against their will. It was held that there had been no publication of the plaintiff's works, and an injunction was granted to restrain the acts complained of by Knight Bruce, V.-C., whose decision was subsequently confirmed on appeal. The Vice-Chancellor, in the course of his judgment, said:—"The author of manuscripts, whether he is famous or obscure, high or low, has a right to say of them, whether light or heavy, saleable or unsaleable, that they shall not, without his consent, be published; and, I think, to use a dishonest knowledge of them for the purpose of composing and publishing, and so to compose and publish a catalogue of them, amounts to a publication of them within the principle of the rule. Assuming the law to be so, what is its foundation in this respect? It has not reference to any considerations peculiarly literary. Those with whom our common law originated had not, probably, among their many merits, that of being patrons of letters, but they knew the duty and necessity of protecting property, and with that general object

(*u*) (1849) 18 L. J. (N. S.) Ch. 120.

laid down rules providently expansive—rules capable of adapting themselves to the various forms and modes of property that peace or cultivation might discover or introduce.

"Such being, as I believe, the nature and foundation of the common law as to manuscripts, independently of Parliamentary additions and subtractions, its operation cannot, of necessity, be confined to literary subjects; that would be to limit the rule by the example. Wherever the produce of labour is liable to invasion in an analogous manner, there must be, I suppose, a title to analogous protection or redress. Such I consider the case of mechanical works or works of art executed by a man for his private use; whatever protection those, or some of those, may have by the Act of Parliament, they are not, I apprehend, deserted by the common law. The principles and rules which it applies to literary compositions and manuscripts must, to a considerable extent, be applicable to these also."

In *Jefferys* v. *Boosey* (*v*) (a music case), the question of the continuance after publication of the common law right arose, and some of the judgments are of special value in this connection, because of the analogy drawn between the law as to inventions and copyrights. In particular Lord St. Leonards said:—

"I never could, in my own mind, distinguish between the right to an invention after the publication of that invention and the right to the description of that invention after the publication of that description. If a mechanical genius should invent a machine of the greatest importance to mankind, it is admitted—nobody attempts to insist or to argue otherwise, and it has always been considered as settled—that after he has disposed of even a single copy of it, it may, so far as the common law is concerned, be copied and made use of without restriction by the purchaser, or by any person who properly obtains possession of it. Now, I do not see how you are to estimate differently different kinds of genius, or how you can say that a man who invents a machine of the greatest importance to the State shall not have any right the moment he disposes of a single copy of that article, but that a man whose mind brings forth a certain collection of words shall be entitled to an absolute property in it for all time, even after he has published it and let the world at large have it. It appears to me, therefore, and always has so appeared, that there is no such common law right either in the one case or in the other; . . . . The common law does give a man who has composed a work a right to that composition, just as he has a right to any other part of his personal property; but the

(*v*) (1854) 4 H. L. C. 815.

question of the right of excluding all the world from copying, and of himself claiming the exclusive right of for ever copying his own composition, *after he has published it to the world*, is a totally different thing." Erle, J., dealt with the general question of authors' rights before publication in the following terms:—"The nature of the right of an author in his works is analogous to the rights of ownership in any other personal property, and is far more extensive than the control of copying after publication in print, which is the limited meaning of copyright in its common acceptation, and which is the right of an author, to which the statute of Anne relates. Thus, if after composition the author chooses to keep his writings private, he has the remedies for wrongful abstraction of copies analogous to those of an owner of personality in the like case. He may prevent publication; he may require back the copies wrongfully made; he may sue for damages if any are sustained; also if the wrongful copies were published abroad, and the books were imported for sale without knowledge of the wrong, still the author's right to his composition would be recognized against the importer and such sale would be stopped."

So in *Turner* v. *Robinson* (*x*) it was held that the exhibition of a picture at an exhibition where the taking of copies was forbidden did not amount to a publication; but in giving judgment the Lord Chancellor distinguished between such works and sculptures as to which the statutory copyright runs (*y*) from the "first putting forth or publishing the same," adding: "In the statutes bestowing protection upon works of sculpture, the *terminus a quo*, from which the protection commences, is the publication of the work, that is, from the moment the eye of the public is allowed to rest upon it. Many large works in this branch of art which decorate public squares and other places are of course so published, but there are others not designed for such purposes which could never be published in any other way than in exhibitions; therefore I apprehend that these works of sculpture must be considered as published by exhibition at such places as the Royal Academy and Manchester, so as to entitle them to the protection of the statutes from the date of publication."

§ 56. The analogy of designs with works of sculpture is particularly close, and it will be remembered that until the Act of 1883 sculptures might, at the option of

(*x*) (1860) 10 Ir. Ch. 374.
(*y*) 54 Geo. III. c. 14.

the proprietor, be registered under, and so secure the protection of, the Designs Act. There are similar provisions in the statutes affecting both classes of works as to marking before the putting forth or publishing, and the above-quoted dictum of the Lord Chancellor in *Turner* v. *Robinson*, as to what constitutes publication of sculptured works, found an application quite recently which may, in similar circumstances, be extended to designs cases.

> In *Britain* v. *Hanks* (*z*) the plaintiffs claimed as proprietors of original metal models of horses and soldiers used for toy purposes which, for the purposes of the Sculpture Copyright Act, 1814, had been stamped with the name of one of the proprietors and a date, which it transpired was a few days before the day when the articles were actually put in the plaintiffs' show-room for sale. It was held, however, that the protection of the Act attached on the date of stamping for the purpose of publication, and that the effect of the section (*a*) which required the date to be put on the protected article "before the same shall be put forth or published," was that the date must not be misleading.
>
> So in *Dalgleish* v. *Jarvie* (*b*) under the old Designs Act (5 & 6 Vict. c. 100), s. 4, it was considered doubtful whether the condition that the design should be registered before publication thereof was limited to publication of the design after its application to some article of manufacture, or whether the nine months' protection given by the Act dated from the publication of the design itself.

§ 57. The general result of the authorities on this question is summarised in Copinger's Law of Copyright (*c*) in the following terms: "The question of publication does not depend on the number of copies sold or given away, because the sale of one copy only is as clearly a publication as is the sale of ten thousand. Nor can it be essential that a single copy be disposed of before the work can be said to be published, for the work is

(*z*) (1902) 86 L. T. 765.
(*a*) 54 Geo. III. c. 56, s. 1.
(*b*) (1850) 20 L. J. Ch. 475.
(*c*) 4th ed. (1904), pp. 88, 89.

published when it is publicly offered for sale. The act of publication is the act of the author, and cannot be dependent upon the act of a purchaser. Printing does not amount to publication, for it is obvious that it may be withheld from the public long after it is in print. To constitute publication it is necessary that the work shall be exposed for sale or offered gratuitously to the general public, so that any person may have an opportunity of enjoying that for which copyright is intended to be secured."

To this has to be added the fact that in *White* v. *Geroch* (*d*), the Chief Justice (Abbott) declared that a sale of copies of a work in manuscript (that is, before any copies were offered to the public generally) amounted to a publication of the work, and it will be seen that the analogy with Designs Copyright is at least close if not complete.

§ 58. Whilst a design may be unfit for registration because it has been previously used, it does not follow that every original design can be registered merely because there has never yet been any public user. Publication in the United Kingdom, without user, is, as a general rule, sufficient to make it impossible that the design should afterwards be validly registered. In the analogous case of patents this has been held so on the construction of the statute (*e*); and with regard to designs, it is expressly provided by the words "not previously published" in sect. 49, sub-sect. (1), of the Act.

§ 59. Publication by prior user differs from publication in books, documents, etc., in that in the former case, user in public alone is publication; in the latter, the publication must not only be such that the public

(*d*) (1819) 2 B. & Ald. 298.
(*e*) *Patterson* v. *Gas Light and Coke Co.* (1875), 47 L. J. Ch. 402.

(*i.e.*, a sufficient portion of the public (*e*)) may acquire the knowledge, but such that the design actually becomes part of the public knowledge (*f*).

In the ordinary case of a description in a book published in England, it will be assumed that it comes to the public knowledge (*g*). Publication in a book, then, will be sufficient without further evidence to invalidate the registration of a design, but only where the description of the design has been in an English book open to the world (*h*).

> In *Stead* v. *Williams* (*i*), Tindal, C.J., said: "The publication, if it takes place in England, makes the patent bad, but in each case publication is a question of fact—the existence of a single copy of a work, though printed, brought from a depository, where it has long been kept in a state of obscurity, would afford a very different inference from the production of an encyclopædia or other work in general circulation. The question would be whether, upon the whole evidence, there has been such a publication as to make the description a part of the public stock of information."
>
> In *Lang* v. *Gisborne* (*k*) a book was written in French, and it appeared that in England four copies at least had been sold, one of them being to the librarian of the University Library, Cambridge. It was decided that the contents of that book had been published in England, so that the information contained in it had become common property. Sir John Romilly, M.R., said that "a publication, however, takes place when a person who is the inventor of any new discovery, either by himself or by his agents, makes a written description of that, prints it in a book, and sends it to a bookseller to be published in this country. It is not at all necessary to establish the fact that one volume of that book has been sold; as soon as an inventor informs the public of what his invention is and

(*e*) See the cases of *Plimpton* v. *Spiller* (1877), 47 L. J. Ch. 212; and *Plimpton* v. *Malcolmson* (1875), 44 L. J. Ch. 257, *infra*.

(*f*) Per Pollock, B., in *Croysdale* v. *Fisher*, 1 R. P. C. 17. And see *Plimpton* v. *Malcolmson*.

(*g*) *Plimpton* v. *Malcolmson*, *supra*.

(*h*) *Cornish* v. *Keene* (1835), 6 L. J. C. P. 225.

(*i*) (1843) 2 W. P. C. 126; and see *Stead* v. *Anderson* (1846), 2 W. P. C. 147.

(*k*) (1862) 31 L. J. Ch. 769.

publishes that in a book, which he sends to a publisher to sell, the moment that book is exposed in the shop for the purpose of purchase, then that becomes a complete publication in point of law (*l*). That would be the effect if it were the publication of a book in England by an English inventor, and there is no difference when the inventor is a Frenchman or any other foreigner who publishes a book in his own language, but sends it over to a bookseller in this country for the purpose of being sold. As soon as the book comes to this country to be sold, and is offered for sale in the public shop of a bookseller, then that becomes a publication of the invention, assuming it to be a clear and accurate description of the invention in question. It would be impossible to arrive at any other result without producing the most inextricable difficulties in law."

In *Plimpton* v. *Malcolmson* (*m*), a book was deposited in the Patent Office Library on 20th July, 1865, but in what part was unknown, and it was not catalogued nor entered in the list of donations. It was then taken to a private room and remained untouched, unread and unlooked at till 1875. Jessel, M.R., held that the contents had not been published up to 1875. He said: "The case goes to this, that a book must be made public to such an extent as to be generally known among persons practising in such matters. It is, therefore, not merely publication, though, as a general rule, according to the *Household Coal and Iron Co.* v. *Neilson* (*n*), when you say a book is published, and nobody contests it, you assume that several copies have been printed and circulated, unless somebody asserts the contrary. But, as regards the law, you must go a step further. Does that doctrine, therefore, apply to a case of this kind? There is one copy of the book which is all that has ever been printed or published, and that copy of the book was always kept in the back parlour of the bookseller's shop, and never was seen, as far as the evidence went. Would that satisfy the doctrine? Clearly not." Referring to *Lang* v. *Gisborne* (*o*), he said: "Suppose the bookseller had put one volume in his shop-window as exposed for sale for one day, and the next day, by direction of the author, destroyed all the volumes, that would not do, and I do not think that Lord Romilly intended that it would. These are general observations, not to be read in that strict literal sense, but in this sense: that, if a man publishes a book, that is, a large number of copies, and sends them to booksellers for

(*l*) *Sed query.* See observations of Jessel, M.R., in *Plimpton* v. *Malcolmson*, *infra*, and of James and Brett, L.JJ., in *Plimpton* v. *Spiller*, *infra*.

(*m*) (1876) 44 L. J. Ch. 257.

(*n*) 1 W. P. C. 673, 718 (n.).

(*o*) 31 L. J. Ch. 769.

sale, and they are, for a reasonable time, exposed in the window, so that you may infer the people have known and seen them, and may reasonably so infer, though you do not prove one has been sold—if the other side cannot prove that one has not been sold, you may reasonably infer that some of those books have been sold. If he means anything more than that, I humbly dissent from it; and I say that my decision is supported by the previous decisions to which I have referred, because I am clear that, if it were shown that no copy had ever got into the hands of the public, and the public knew no more about it than seeing the back of the book in the bookseller's window, and every copy could be accounted for, and that none had been sold though exposed for sale, that would not be a sufficient publication to avoid a subsequent patent."

Plimpton v. *Spiller* (*p*). The facts in this case were similar to those in the last-named; but in addition it was shown that a sub-librarian had seen the book in a corridor open to the public leading into the public room of the old Patent Library. When the new Patent Office Library was opened, the book was placed in a room upstairs, and not in the principal room. The Court of Appeal decided that the book had never been published in any sense in which it could be construed to be accessible to the public. James, L.J., said: "I should, if it were necessary, desire much further time to consider whether, even if it were proved that the book, one copy of which had been sent over as a present from a gentleman in America, was on the shelf in the library between the 20th of July and the 25th of August, that would be a sufficient publication, and would be such an addition to the stock of common knowledge in this country as would have prevented a man from being the first and true inventor of this patent; such an addition to the stock of common knowledge as a man was not entitled (to use the language of one of the cases) to deprive the public of." And Brett, L.J., said: "I cannot agree with Mr. Davey when he says that it is sufficient to show that the thing has been printed in a book, and that the book has been so placed that it might have been known to the public. It must be not only printed in a book, but that book must be placed in such a position and so used that you may fairly infer or assume that the contents of the book have become known to a sufficient number of people. Therefore, when you prove that this book was put in the Patent Library, I care not into what part, I do not say that is no evidence of its having become known to the public, but I say that when you have other facts which show that although it was put

(*p*) (1877) 47 L. J. Ch. 212.

into the Patent Library, the proper inference is that nobody ever did see it there or elsewhere, then, although it has been in one sense, if you please, published, or in one sense, if you please, intended to be dedicated to the public, all I can say is that the public have not been able to take advantage of the dedication or the publication, and therefore you do not show that it was known to the public."

Otto v. *Steel* (*q*). One copy of a French treatise was placed in the British Museum Library in 1863, and that one copy was the only one proved to be in England prior to 1876. The catalogue referred to it, and it was placed in its proper place in the library. Readers would find the book in the catalogue only under the author's name, and it was not placed in a part of the library where they could get at it without special assistance. Pearson, J., refused to find that the book had been published in such a manner that there was a reasonable probability that any person might have obtained knowledge from it, and, therefore, that the presence of the book in the Museum did not invalidate a patent granted in 1876 (*r*).

Harris v. *Rothwell* (*s*). Two specifications in German of German patents were deposited in the Patent Office library some two years before a patent for making the same article was granted in England. Entries of such specifications were duly published in the *Patents Journal* amongst German patents, and described, a footnote stating that they might be consulted at the Patent Office library. The Court of Appeal, affirming Chitty, J., held that the German patent had been published in England, and that the subsequent patent was therefore bad. Cotton and Lindley, L.JJ., were of opinion that had the existence of the description of the prior invention been unknown, the invention could not be said to have been previously published, and distinguished the present case from those above-named, as in the *Plimpton Cases* the book was not known to be in the Patent Office library, nor in the *Otto Case* was it known to be in the Museum library. Lopes, L.J., said: "Why should the public be precluded from the right of using the information of which they were then in possession? I think directly the German specifications were deposited in the library of the Patent Office, and became unreservedly accessible to the public, there was a complete publication of the invention in this country, and it became the property of the public. In my opinion the depositing the specifications in the library of the Patent Office in the way described was

(*q*) (1885-6) 3 R. P. C. 109. And see *Pickard* v. *Prescott* (1892), 9 R. P. C. 195.

(*r*) And see *Heurteloupe's Patent* (1836), 1 W. P. C. 553.

(*s*) (1887) 4 R. P. C. 225.

itself a publication of the invention contained in them, and I think that the invention was then dedicated to and became the property of the public."

In the *United Telephone Co.* v. *Harrison* (*t*), an invention was described in a paper, written in German, in a scientific journal, and was illustrated by figures. A copy of the journal was in the Patent Office library, and also in the library of the Institute of Civil Engineers, and there open to members and to certain others. It was catalogued only under the title "Journals." A telegraphic engineer saw this journal, and from the technical terms used, and the illustrations, was able to understand the invention. Fry, L.J., held, that the invention had been published.

The cases are difficult to reconcile, if the question be regarded as one of law. The true rule seems to be that in each case the question is one of fact; *i.e.*, in the words of Tindal, C.J., in the case first cited (*u*), "whether, upon the whole evidence, there has been such a publication as to make the description a part of the public stock of information." The *Plimpton Cases* and *Otto* v. *Steel* do not really conflict with *Lang* v. *Gisborne* or with *Harris* v. *Rothwell*. In the former cases the book, though in the libraries, was never consulted, because really not accessible; in the latter cases the books, if not consulted, were accessible and could have been. All that has to be determined is, whether the public had already the means of getting the information professed to be given for the first time by the claimant. This is really a question to be answered by the jury in each case (*x*).

§ 60. The prior publication of the description of a design will therefore, on the analogy of these cases, be a bar to any subsequent registration, if it substantially gave the information to the public necessary to constitute

(*t*) (1882) 51 L. J. Ch. 705.
(*u*) *Stead* v. *Williams*, *ante*, p. 58.
(*x*) See 1 W. P. C. 719 (n.).

the design. It is not necessary that the publication should be such as to guide any ordinary member of the public how to make the design; it suffices if the information given enables those conversant with the subject to follow the method (*y*). On the other hand, a mere barren suggestion in a book will not prevent registration of a practical application of the idea.

> In *Philpott* v. *Hanbury* (*z*), Grove, J., said: "I am willing to rest my definition or description of what anticipates a patent on this: that there must be a publication which, when read by persons versed in the trade, skilful and well acquainted with the trade (I might even limit it, perhaps, to those in the trade who are most skilled—the higher class of skilled workmen), would enable them to understand it. If it be such, it anticipates the patent. If it is a mere suggestion, if it is so erroneous in the description, that they cannot, by reasonable application of the mind, find out what it means, it does not anticipate the patent. But if it reasonably discloses what the invention is, so that a person skilled in the trade can practise the invention from it, then I am of opinion that there is anticipation."

§ **61.** Although a design has not been published in any book, it may still be incapable of registration, on the ground that it has been communicated orally or otherwise to some person who is not in a confidential relation to the inventor. The cases show that there is a publication whenever it is the fair conclusion from the evidence that some member or members of the general public in England, under no obligation to secrecy, arising from confidence or good faith towards the owner of the design, knew of it before any application was made for registration (*a*). If, however, the

(*y*) See remarks of Jessel, M.R., in *Plimpton* v. *Malcolmson*, 44 L. J. Ch. 257.

(*z*) (1885) 2 R. P. C. 33, 43; *Thompson* v. *Macdonald* (1890), 8 R. P. C. 5. But see *Hills* v. *Evans*, 31 L. J. Ch. 457.

(*a*) See Fry, L.J., in *Humpherson* v. *Syer* (1887), 4 R. P. C. 414.

person to whom the communication is made is under an obligation to secrecy, the statement to him will not be a bar to registration of the design. According to Fry, J., if such a person broke the confidence reposed in him the validity of the registration might be impeached (*b*); but any doubt on this point has now been removed by the new Act of 1907, which provides that the disclosure of a design in breach of good faith shall not invalidate the copyright (*c*).

In every case the fact of dealing commercially with a design amounts to a publication vitiating any subsequent registration; and this applies wherever the substance of the design has been published, notwithstanding alterations in details, unless these are of a material character (*d*). To this rule, however, a further exception has been introduced by a clause in sect. 55 of the new Act, which exempts *textile fabrics* from its general operation in the following words: "the acceptance of a first and confidential order for goods bearing a new or original textile design shall not be deemed to be a publication of the design sufficient to invalidate the copyright, if registration is obtained subsequently to the acceptance."

The general rule is exemplified in the following cases:—

In *Blank* v. *Footman* (*e*), the plaintiff, who was a foreign manufacturer, having invented a design, showed it to and consulted Hummel, his sole agent in England, and the agent consulted another person, and also showed it to two customers and asked them for orders. Kekewich, J., decided that the communication to the agent would not have affected subse-

(*b*) In *Humpherson* v. *Syer*, at p. 416.

(*c*) 7 Edw. VII. c. 29, s. 55.

(*d*) *Winfield* v. *Snow*, *infra*, and *Hunt* v. *Stevens*, W. N. (1878) p. 79. See also *Oxley* v. *Holden* (1860), 30 L. J. C. P. 68.

(*e*) (1888) 5 R. P. C. 653.

quent registration, but that a registration subsequent to the date when the design was shown to the customers was invalid. On the former point, after quoting Bowen, L.J. (in *Humphreson* v. *Syer*), he said: "The patentee, whether it be a chemical patent or a scientific patent or a machinery patent, frequently (generally, I might say) is unable to carry out the manufacture of the patented article in all its details himself personally. He must employ others, and for that purpose the Lord Justice says he is entitled to do so without in the slightest degree damaging his patented rights to claim protection, provided it is done confidentially. It is a step further to say that a man like Mr. Blank is entitled to take into his confidence a man like Mr. Hummel, who is only a commission agent, a man through whom the profits are to be made. He does not occupy, to my mind, a position at all similar to that of the shopman. But I think it is only a fair stretch of the same principle to say, as I have already said, that I think a man in Mr. Blank's position might consult with those through whom he would put goods on the market, particularly, as I say, having regard to the relation existing between them, and doing it confidentially, without avoiding his rights to be obtained by registration."

In *Winfield & Son* v. *Snow Brothers* (*f*), it appeared that Major, a buyer for Messrs. Olney & Sons, suggested to plaintiffs to produce lace of a certain pattern, and the plaintiffs had a design prepared, from which they manufactured a sample, and showed it to Major. He gave an order for 12,000 yards, and took away a piece as a sample; the design was registered, and subsequently the bulk of the lace was delivered. It was decided by Hawkins, J., that the registration was bad, the disclosure to Major being a publication. The judge said that the argument for the plaintiffs was "that that which took place between Mr. Winfield and Mr. Major was no publication, but a mere confidential communication with a view to ascertaining from Mr. Major himself whether his suggestion made at their first interview had been carried out by the designer, and whether the specimen of lace manufactured from that design was such as to be likely to suit the spring market, with a view to registration of the design if his opinion were favourable. Had such been the sole character and object of the communication I should undoubtedly have held that it did not amount to such a publication as to defeat the subsequent registration, for I should, under such circumstances, have looked upon the production of the specimen of lace to Mr. Major as an exhibition of it with a view to seeking the advice of an experienced friend without any reference to the

(*f*) (1891) 8 R. P. C. 15.

employment as buyer to the firm with which he was connected, and the more particularly should I have thought so had Mr. Major been made aware of the plaintiffs' intention to register the design."

In *Re Sherwood's Design* (*g*), the owners of an unregistered design for a globe for a lamp stove sold two of the globes to a customer, who exhibited them in his window and afterwards adapted the same globe to improved fittings which added stability to the design, and this altered design was duly registered. Chitty, J., held that there had been a publication of the material part of the design, and that, the alterations not being of a substantial character, the registration was invalid.

In *Heinrichs* v. *Bastendorff* (*h*), H., previously to registering his design, and whilst perfecting it, consulted D. (with whom H. had trade relations) and sent him samples for inspection. D. slightly altered the samples, and returned them; eventually, but after registration, D. bought some of the designed goods. Mr. Justice Day held, that there had been no publication under these circumstances.

In *Nevill* v. *Bennett* (*i*), the defendants alleged publication prior to registration in the following circumstances: In 1894 Foliadi (a dealer in Constantinople) sent a design to the plaintiffs as suitable for the Persian market. They submitted it to their designer, who put it into a suitable working form. Then, that being submitted to Foliadi, he approved it, and thereupon the plaintiffs gave it to their engraver, and that became the design which was ultimately registered. On this, when registered, Foliadi gave orders which the plaintiffs executed.

Hall, V.-C., upheld the registration, and in giving judgment, said: "In this case, where everything was private and there was mere collaboration between Foliadi and the plaintiffs, with a view to the design being put into a suitable and workable shape, which was to be the property of the plaintiffs, but to be engaged, as was said, for the use of Foliadi in the Persian market—to say that that private consultation, that private working together, amounted to prior publication seems to me to be entirely unfounded."

In *Werner Motors* v. *Gamage's, Ltd.* (*j*), a novel question of prior publication arose from the fact that the plaintiffs had before the registration of the design, which was for a motor-cycle frame, applied for a patent for the same article, but the

(*g*) (1892) 9 R. P. C. 268. But see *Harper* v. *Wright and Butler* (per Herschell, L.C.) (1895), 12 R. P. C. 483.

(*h*) (1893) 10 R. P. C. 160.

(*i*) (1898) 15 R. P. C. 412.

(*j*) (1903) 21 R. P. C. 137, and, on appeal, 637.

registration was uphold, Vaughan Williams, L.J., in giving judgment, saying: "It is suggested in this case that the grant of the letters patent, having regard to the date of application, and therefore of the sealing, prevents the design being new and original within the meaning of sect. 47 of the Act of 1883. In the case of a stranger to the letters patent, this clearly would not be the result. Can it be the result in the case of a patentee who registers the design between the date of the provisional specification, without drawings, and a complete specification with a drawing identical with the design? I think not, unless one can say that the patentee is in some way estopped from asserting the truth that the design at the date of the application to register was new, because he subsequently obtained letters patent having a statutory date prior to that of the application to register the design. I have some doubt on this point, but on the whole I regret to say I cannot find an estoppel or any ground for putting the plaintiffs to an election between the letters patent and the copyright of the design."

§ **62.** The publication of a design invalidates a subsequent registration only if the publication take place in the United Kingdom. This is an express provision of the Act which, in connection with designs, uses the words "not previously published *in the United Kingdom*" (*k*); but the same rule has always been applied to patents on the construction of the statutes (*l*). Publication abroad does not, therefore, necessarily invalidate a subsequent registration here if the work is still novel or original to the British public.

§ **63.** Does registration amount to publication? The question was raised in *Read and Greswell's Design* (*m*), but it became unnecessary to decide the point, and it was not decided. There is much to be said for the argument that registration, so far as designs are concerned, is not publication; until, at all events, the entry is thrown open to the public. The register in the case of trade marks

(*k*) (1907) Sect. 49 (1).

(*l*) See the patent cases, *Brown* v. *Annandale* (1842), 1 W. P. C. 433; *Rolls* v. *Isaacs* (1878), 51 L. J. Ch. 170; and *Lazarus* v. *Charles* (1873), 16 Eq. 117.

(*m*) (1889) 6 R. P. C. 471.

is always open; there is no such provision in the case of registered designs, which on the contrary are kept secret during the whole term of copyright or for such shorter period (not being less than two years) as may be prescribed by the general rules in each case (*n*), and registration of marks is expressly declared to be publication. From this it may be inferred that the law is different in the case of designs and of trade marks, and hence that registration of the former is not, *ipso facto*, publication.

On the other hand, a member of the public may, with the authorization of the Court, or of the Comptroller, and on payment of a fee, inspect, but not copy, the design (*o*), but this is only under limited conditions and for a special purpose, and it is submitted that in such cases the principles as to secrecy and confidence above considered would apply. It may be doubted therefore whether, if such a person does so see the design, there has been any such publication as would avoid a subsequent registration of a similar design.

The provisions of sect. 50 of the new Act exempting subsequent registration of a design by a proprietor who has already registered the design in another class, and declaring that no invalidity shall arise on the ground of such prior registration, are also to be borne in mind on this question.

§ **64** Publication at an industrial or international exhibition is provided for by sect. 59 (1) of the new Act (as it was by sect. 57 of the Act of 1883), thus:—

"The exhibition at an industrial or international exhibition certified as such by the Board of Trade, or the

(*n*) Act of 1907, s. 56 (1). The Rules of 1908 fix the period at five years for designs in Classes 13, 14 and 15, and two years for all other designs. (Rule 69.)

(*o*) *Ibid.*

exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof, provided that—

(a) "The exhibitor, before exhibiting the design or article, or publishing a description of the design, gives the comptroller the prescribed notice of his intention to do so; and

(b) "The application for registration is made before or within six months from the date of the opening of the exhibition."

And sub-sect. (2) of the same section provides for the extension of this protection to industrial and international exhibitions held out of the United Kingdom, by Order in Council, under the Act, exhibitors at such foreign exhibitions being thereupon relieved from the conditions, specified in the section, of giving notice to the Comptroller of intention to exhibit.

§ **65.** In order to have an exhibition certified under this section application must be made by the authorities controlling the exhibition or by some person interested, to the Board of Trade, and evidence produced to satisfy the Board that the exhibition is of sufficient importance, and, generally, a proper subject for the certificate. Upon being so satisfied a certificate is issued. The Board of Trade communicates the issue of the certificate to the Patent Office, where a list of such certified exhibitions is kept.

The Designs Rules provide that a notice of intention to exhibit any design or article to which a design has been applied at an international exhibition certified

under those Acts shall be given by the intending exhibitor to the Comptroller, and for the purpose of identifying the design in the event of an application to register being subsequently made the applicant is to furnish the Comptroller with a brief description of the nature of the design, accompanied by a sketch or drawing (*p*).

(*p*) Rules of 1908 (No. 76).

CHAPTER V.

THE PRACTICE OF REGISTRATION.

(For the full references to all the Reports see Table of Cases ante.)

§ 66. Copyright before and after Publication—Statutory Provisions.
§ 67. The Application for Registration—Regulations as to Time.
§ 68. Application in Person or by Agent.
§ 69. Description of the Design—Specification of Class.
§ 70. Registration by Sample.
§ 71. Filing of Representations—Effect of Explanatory Notes.
§ 72. Sufficiency of Claim or Description—Illustrative Cases: *Norton* v. *Nicholls*; *Holdsworth* v. *McCrea*; *Barran* v. *Lomas*; *Re Rollason's Design*; *Re Bayer's Design*.
§ 73. Deposit of Copies or Drawings.
§ 74. Effect of Non-deposit—Abandonment of Registration.
§ 75. Sale of Articles to which Designs applied—Submission of Samples.
§ 76. Classes—Distinction between Classes 13 and 14.
§ 77. Registration of Sets of Designs.
§ 78. Power of Comptroller to decide Class.
§ 79. Protection limited to Class registered (*Re Read and Greswell's Design*).
§ 80. Subsequent Registration by Third Person in another Class (*Re Bach's Design*; *Re Clarke's Design*).
§ 81. Powers of Comptroller to refuse Registration.
§ 82. Procedure before Comptroller.
§ 83. Appeal to Board of Trade.
§ 84. Procedure on Appeal—Costs.
§ 85. Certificate of Registration—Copies where Original lost.
§ 86. Amendments, and Extension of time.
§ 87. Correction of Entries—Omission of particular Goods.
§ 88. Transmission of Copies of Entries to Scotland—Fees, &c.
§ 89. Special Provisions as to Designs for Goods in Classes 13, 14 and 15.

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§ 66. On the analogy of other copyright property there may be said to be a copyright before publication in a design from the time of its invention or making (*a*), but registration of the design is necessary to give the protection of the statute to the proprietor. The matters

(*a*) See Copyright Cases, cited *supra*, pp. 53—55; and sect. 54 (1)(a) of the new Act corresponding with sect. 50 (2) of the Act of 1883.

to which attention must be directed with regard to registration are to be found in sects. 49 and 52 of the new Act and in the Designs Rules, whilst information as to the practical steps to be taken may be found in the pamphlet issued from the Comptroller's Office entitled "Instructions to Persons who wish to register Designs" (*b*).

§ 67. A person desiring to register a design must leave at or send to the Comptroller's Office (1) an application for registration in the prescribed form (*c*); (2) in such application a statement of the articles to which the design is to be applied, and the classes of goods in which the applicant desires that the design should be registered (*d*); (3) three (or in the case of a set or an application in Classes 13, 14, or 15, four) drawings, photographs, or tracings, or other representations of the design, or three (or four) specimens (*e*); (4) the prescribed fee, payable by impressed stamp on the form of application (*f*).

The documents must be left at or sent by post to the Comptroller's Office (*g*); or, in the case of goods in Classes 13, 14, or 15, either there or at the Manchester Branch Office (*gg*). If sent by post they must be included in a prepaid letter, and will be deemed to have been left or given at the time when the letter containing the same would be delivered in ordinary course of post (*h*). In proving such sending it will be sufficient to prove that the letter was properly addressed and put in the post (*i*).

(*b*) See *post*, Appendix C., p. 406.
(*c*) Rules of 1908, No. 13. For Forms, see Appendix B., *post*, p. 374.
(*d*) *Ibid.*, Nos. 17, 18.
(*e*) *Ibid.*, Nos. 20, 21.
(*f*) (1907) Sect. 65; and Rule 3, with Schedule I. (Nos. 1—5).
(*g*) (1907) Sect. 81; and Rules Nos. 2, 14.
(*gg*) Rule 80.
(*h*) Rule No. 9.
(*i*) This was formerly provided by the statute (Act of 1883, sect. 97 (2)), but it is now the accepted rule, and is part of the provisions of Rule 9.

Whenever the last day fixed by the Act, or by any Rule for the time being in force, for doing anything under the Act falls on any day specified in the Rules as an "excluded day" (*i.e.*, Christmas Day, Good Friday, the King's birthday, Saturdays and Sundays, days observed as holidays at the Bank of England, or days of public fast or thanksgiving, and other days which may from time to time be notified by a placard posted in a conspicuous place at the Comptroller's Office), it is lawful to do it on the day next following, not being an excluded day (*k*).

§ **68.** Communications with regard to the application must be made to the Comptroller by the proprietor of the design or by some agent duly authorised by him, to the Comptroller's satisfaction (*l*). The Comptroller is not bound to recognise as such agent or to receive further communications from any person whose name has been removed from the register of agents kept under the Act (*m*). The application must be made in the forms prescribed, as set out in Schedule III. to the new Rules (*n*).

These forms contain certain marginal notes specifying the nature of the information to be given; and as the forms are an integral part of the Rules the notes have, like the Rules themselves, the force of statutory requirements (*o*).

The applicant must give his full name and address and an indication of his trade or business. He must sign the application either in person or by an authorised agent, but this may be dispensed with by the Comptroller, if he is satisfied that from any reasonable cause such person

(*k*) (1907) Sect. 82; and Rules Nos. 61, 65.

(*l*) Rule 12.

(*m*) Act of 1907, sect. 85; Rule No. 12.

(*n*) (1907) Sect. 49 (1); and Rule 14. For Forms, see Appendix B., pp. 373 *et seq.*

(*o*) *In re Rollason's Design* (1898), 15 R. P. C. 441.

is unable to sign; and the Comptroller may in such case, upon the production of other evidence, and subject to such terms as he may think fit, dispense with the document (*p*).

Registration dates from the day upon which the application for registration is received by the Comptroller (*q*); but any application which owing to any default or neglect on the part of the applicant is not completed so as to enable registration to be effected within twelve months from the date of the application will be deemed, under the new Act, to be abandoned (*r*). Fourteen days' notice of the non-completion is to be given by the Comptroller before the abandonment becomes effective (*rr*).

§ **69.** The Act (*s*) provides that the application must be made in "the prescribed form and manner"; and by the statutory Rules (*t*) this is amplified by the requirement that it shall contain a statement of the article to which the design is to be applied, and of the class or classes of goods in which the applicant desires that the design should be registered. Where the Comptroller requires it, the applicant must also state for what purpose the design to be applied is used, and the material of which the article is made; and he must further, if required, indorse on the application a brief statement of the novelty he claims for his design (*u*). The description of purpose or novelty need not be elaborate as in the

(*p*) Rule 62. And see (1907) Sect. 83, which deals with declarations, &c., when the applicant is an infant, lunatic or under other disability.

(*q*) (1907) Sect. 49 (5).

(*r*) *Ibid.*, Sect. 49 (4).

(*rr*) Rule No. 35.

(*s*) (1907) Sect. 49 (1).

(*t*) Rules Nos. 17, 18.

(*u*) Rules 18, 19. The old Rules also required that the application should state whether the design was applicable "for the pattern, or for the shape, or for the configuration, or for any two or more of such purposes, as the case might be, and the means by which it was applicable"; but the new Rules and Forms do not require any such statement, and it is undesirable to volunteer it in any case. See *Re Bayer's Design* (1907), 24 R. P. C. 65.

case of specification of the patent (*v*), but it should state enough to enable the Comptroller to give such information as is required by sect. 57 of the Act, *i.e.*, to identify the design.

§ 70. Under the Acts of 1842 and 1843 an applicant was not allowed to register a design without accompanying the registration with a written description or some drawing or plan of it. By the amending statute 21 & 22 Vict. c. 70, the registration of a pattern or portion of an article of manufacture to which a design was applied, instead or in lieu of a drawing or description in writing, was made valid. The Act of 1883 provided that an applicant might furnish exact representations or specimens of the design (*w*), and these might take the place of drawings or photographs, though not, it seems, of a written description. The provision as to representations or specimens is continued by the new Statutory Rules (*x*); but it is to be remembered that if the registration be by sample only, there can ordinarily be no infringement unless the whole design be reproduced (*xx*). In view of the terms of sect. 49 (1) of the Act of 1907 and of the provisions of Rule 4 and the prescribed forms, it is submitted that now no description in writing can be required, and the registration is valid if the application contains only the several particulars above specified.

§ 71. It is, however, to be noted that where representations other than the prescribed drawings are furnished, the only "design" put on the register will be the representation, though the application will be filed as well as the design, and may be called in evidence to explain it.

(*v*) *Holdsworth* v. *McCrea* (1867), L. R. 2 H. L. 380; *Harper* v. *Wright and Butler* (1895), 12 R. P. C. 483; *In re Rollason's Design* (1897), 14 R. P. C. 909; and *In re Bayer's Design* (1906), 23 R. P. C. 355.

(*w*) Act of 1883, sect. 48 (1).

(*x*) Rules of 1908, No. 20.

(*xx*) A written description of the parts claimed as novel may be added; but, unless some further statement is called for by the Comptroller, it is generally better to leave the design to speak for itself.—See note (*u*), *supra*.

The effect of any explanatory note accompanying the representation will be to limit the claim to what the applicant says is novel, but such a "quasi-disclaimer" is not a statutory obligation, nor provided for in the Act or Rules (*y*).

§ **72.** The following cases may be referred to on the above points; but it is to be observed that, having regard to the altered requirements as to the statements to be furnished by applicants on registrations, many of the old decisions as to the effect of claims for "pattern, shape or configuration" will in future only apply to registrations already effected under the Act of 1883.

Norton v. *Nicholls* (*z*) (commenced before the stat. 21 & 22 Vict. c. 70, came into force). The plaintiff had attempted to register for a shawl a design consisting of a combination of five points, and had left a shawl with the registrar with an intimation that it was to be applied to a particular class, but with no other information as to the nature of his claim. Lord Campbell, C.J., said: "We are clearly of opinion that the registration is defective. This registration consisted in merely leaving with the registrar an entire shawl manufactured according to the combination relied upon, with an intimation that it was to be applied to Class 8. We by no means say that there may not be a good registration by simply leaving with the registrar a copy of the design to be registered. Take the example of paper-hanging, Class 5. A section of the paper having the design impressed upon it would clearly disclose the claim of the inventor, and would fully put the registrar in possession of all the information he ought to have to enable him to perform the duties imposed upon him. But the plaintiff, by leaving one of his shawls with the registrar, gives no information of the nature of his claim, and cannot, we think, be said to have registered his 'design.' He intended by this act to claim each of the five points or separate designs, and he was equally at liberty to claim any other parts of the shawl allowed to be old. The colours on both sides were essentially as much parts of the shawl, or of the *combination*, as any of the five points which he claimed at the trial. What shall be considered an infringement of the supposed combination? Is the defendants' shawl an infringement, although it

(*y*) See the statement of the Comptroller in *Re Bayer's Design* (1906), 23 R. P. C. 553.

(*z*) (1859) 28 L. J. Q. B. 225.

varies the colours on both sides? Would it be an infringement if it included only four of the five points, and would it be so if it included only one of them? With respect to copyright of designs, no specification is required as in the case of patents for inventions; but sect. 17 of the 5 & 6 Vict. c. 100, after empowering all the world to inspect the registered design when the copyright has expired, gives a right, under certain circumstances, before the copyright has expired, to an inspection of the registration, and requires the registrar, on the application of certain persons, to give to such persons 'a certificate stating whether there be any copyright existing of particular designs, and if there be in respect to what particular article of manufacture or substance such copyright exists.' If an application were made to a registrar by a shawl manufacturer respecting the five points of the plaintiff's shawl, separately or in combination, or the use of the colours of the Victoria Tartan, what answer could he make?"

Holdsworth v. *McCrea* (*a*) came before the House of Lords, and it was decided that, (1) the same nicety is not required in registering patterns or designs as in describing inventions sought to be protected under the patent laws; (2) that the provisions of 5 & 6 Vict. c. 100, and 21 & 22 Vict. c. 70, are complied with by a person who leaves with the registrar copies of his design, though without any written description specifying precisely what is the extent of his claim; but (3) if what is claimed as the design consists, according to the pattern, of different parts, any one of which might be deemed a design, the registration of the whole pattern amounts to a claim of the combination, and not of any of the parts thus combined, any one of which, therefore, taken separately, is not protected by the registration. In giving judgment, Lord Chelmsford said (*b*): "Now the designer is under this disadvantage, that when he registers a pattern of material, there is no infringement unless it is exactly copied." And Lord Westbury, speaking on the same matter, said (*c*): "The only thing which it is here necessary to point out, as well for warning to inventors as for the protection of the public, is this: that if a design, as exhibited in a pattern, is filed and registered by an inventor, without any farther limitation or description than that which is given by the design itself, it protects the entire

(*a*) (1867) L. R. 2 H. L. 380. The second proposition in this case was, it was thought, altered by sect. 47 (3) of the Act of 1883 and the Statutory Rules under it. The third proposition shows the desirability of making a written statement of what is claimed when registration is applied for by deposit of a sample or representation other than a drawing.

(*b*) Page 384.

(*c*) Page 388.

thing and the entire thing only; and the protection cannot, at pleasure, be made applicable one day to the entirety and another day to the separate integral parts or elements of the entire design. It must be considered that the protection of the statute is invoked for the entire thing that appears upon the register, and is applicable to nothing but the exact copy of the thing so registered." The meaning of those latter words was explained in the later case of *McCrea* v. *Holdsworth* (*d*) by Lord Hatherley, L.C., who said: "Their lordships seem to have meant that the designer is not bound, as in a patent case, to distinguish the new from the old, and is allowed to register his pattern without distinguishing what is new from what is old; but if he chooses to put it in that way, it will not be protected as against the public in case they choose to use any portion in any manner substantially differing from the registered design. If the designs are used in exactly the same manner, as I hold they are in this case, and have the same effect, or nearly the same effect, then of course the shifting or turning round of a star, as in this particular case, cannot be allowed to protect the defendants from the consequences of the piracy."

In *Thom* v. *Sydall* (*e*) it was argued that registration by sample enabled the proprietor to produce any number of varieties of the same pattern; but the Court would not accede to this, and laid down that if the whole is claimed as the design, and the registration is by sample, there can be no infringement unless the whole design be reproduced.

Barran v. *Lomas* (*f*) illustrates the care required in properly describing the design for which registration is claimed. An ornamental braid had been registered, and the designer had produced at time of registration a photo of a jacket with the braid upon it, and this, he said, was a copy of the design. The members of the Court, whilst upholding the claim in this particular case, said that a man may register his design with a particular thing, but he cannot afterwards be heard to say that he claims the design as distinct from the thing. Thus, when a new pottery design is registered as a new shape, it frequently is intended to be used with some new ornament, and the whole is registered together; but such registration will not protect the ornament. In the case of the braid, Jessel, M.R., said that the prudent course would be to state in words that the braid is the design claimed, and that the jacket is

(*d*) (1870) L. R. 6 Ch. 418, 420. See the new Rule, No. 19, as to requiring a statement of the novelty claimed.

(*e*) (1872) 26 L. T. (N. S.) 15. And see *Grafton* v. *Watson* (1884), 50 L. T. (N. S.) 420; and, on appeal, 51 L. T. (N. S.) 141.

(*f*) (1880) 28 W. R. 973.

plood in tho photo moroly by way of illustration, and is not intonded to bo part of tho rogistorod dosign. Such disclaimor must bo clearly expressed at tho timo of registration, as no part of tho dosoription of tho dosign as rogistorod can afterwards bo rojoctod (*g*).

In *Walker* v. *Falkirk Iron Co.* (*h*) it was laid down that no olaborato specification by tho author of tho dosign is oithor roquirod or allowed, and that tho *purpose* for which a dosign is rogistorod may bo provod by ovidonco (*hh*). Lord Shand, in giving judgment, said: "The statute (1883, sect. 47 (3)) providos that tho application for rogistration must contain a statomont of tho nature of tho dosign, as woll as of tho olass or olassos of goods in which the applicant desires tho dosign may bo registered. This infers that the applicant shall sottlo tho purpose or object for which the design is to be registered—pattern, shape, or ornament—and accordingly in the Board of Trade Rules, issued in reference to the statute, it is provided by Rule 9 that the applicant, in stating the nature of the design, shall state whether it is applicable for pattern, shape, or configuration of the design. I see no reason to doubt that when a controversy of this kind arises as to infringement of a design, and it becomes necessary to determine whether protection was given to the design for pattern, shape, or ornament, or for any two or more of these purposes, either party may refer to the application for registration for a definition or description of the purpose of registration, and the Court will, if necessary, order the evidence on this subject to be produced, and such evidence should go far to decide the controversy."

In *Gordon and Munro* v. *Patrick* (*i*) the plaintiffs' claim in their application was for ornamental design; and this being admittedly old, though a similar moulding had never been applied to a coffin-plate of the same shape, the defendants contended that the plaintiffs could not succeed, not having claimed for the ornament in combination with the shape; but Cave, J., dismissed this contention, and granted the injunction as prayed and an order for delivery up of the infringing plates.

In *Harper* v. *Wright and Butler* (*k*), in the course of the argument, it was urged that the plaintiffs, by the form of their application, viz., that the design was applicable for the

(*g*) See *Smout* v. *Slaymaker* (1890), 7 R. P. C. 90.

(*h*) (1887) 4 R. P. C. 390, 395.

(*hh*) The new Rules provide for the statement of "purpose" in the application, where required by the Comptroller (Rule 18).

(*i*) (1894) 12 R. P. C. 22.

(*k*) (1895) 12 R. P. C. 483.

"pattern, ornamentation, shape and configuration," must be taken to have claimed novelty or originality in each of these four particulars, and the registration was therefore bad if there was want of novelty or originality in any one of those respects; but Horsehell, L.C., said: "Whether each one of these things was claimed *per se* or in combination only with the others was not material, as the whole was claimed, and there was no other way, under the rules, of claiming the whole than the manner in which the plaintiffs had claimed." A. L. Smith, L.J., said, in giving judgment: "The next point which arises is this: they say to the plaintiffs, 'Your claim is bad, because what you claim in your registration is for pattern, ornament, shape and configuration: you claim for each of those separately, and do not claim for those collectively'; and they went on to say that, as regards shape, that would be a bad claim, because they said a similar shape for a hexagonal stove, standing upright, was known before. But, in my opinion, whatever this claim may embrace, it does embrace these matters collectively—it claims for the design, and it claims, as part and parcel of that design, the pattern, ornament, shape and configuration. The word 'totality' has been used more than once during this case. I adopt that word. The design is claimed—that is, the pattern, ornamentation, shape and configuration—that is, the totality of it."

In *Re Rollason's Design* (*l*), where the design (for coffin-plates) was registered "for the pattern," although the registration was upheld, some difference of opinion was shown by the judges in the Court of Appeal as to the effect of this claim. Lindley, M.R., said: "With reference to the word 'pattern,' I cannot help thinking that, in a case of this kind, the pattern includes the shape and ornamentation. The word 'ornamentation' is dropped out of the rule, although it is in sect. 60 of the Act; but when you talk of the pattern of a thing like this, I do not see that it is necessary or even proper to leave out the outline. The ornamentation not being dropped out, of course it is not for shape alone. It is, to my mind, for shape, plus ornamentation, in a case like this." Vaughan Williams, L.J., however, said: "I wish to make two propositions plain according to my view of the Act of Parliament. One of those propositions is, that the Act draws such a distinction between pattern and shape that when an applicant in his application chooses to base his application upon pattern, one must, in dealing with the question of originality or novelty, limit the right to registration to matters clearly falling within 'pattern' accord-

(*l*) (1897) 14 R. P. C. 909.

ing to the meaning of that word as used by the applicant in his application; and I wish further to say that, according to my view of the construction of this Act, if the result of the registered design, whether defined by paper, plan, or otherwise, is to leave it in ambiguity whether a particular matter is included in it or is not included in it, you ought to make the turn of the scale against the person registering, whose duty it is, according to my view, to make it perfectly clear what design it is in respect of which he seeks to become the proprietor to the exclusion of the general public."

In *Re Bayer's Design* (*m*), on the trial before Warrington, J., some discussion arose as to the effect of the explanatory note attached by the claimants to their deposited drawing, and, in giving judgment, Warrington, J., said: "Something turns upon the mode in which the respondent has complied, or purported to comply, with one of these rules—I mean the 9th rule of the Designs Rules of 1890. . . . Now, it will be observed that, in that rule, there is nothing which requires the applicant to state what it is in the design that he is registering that he claims as novel; all that he is required to do is to state the particular quality of the subject to which the design is applicable, and the means by which it is so applicable. The next thing is, what is the object of that note 'The novelty consists in a corset having the gores or gussets out horizontally . . . as shown in the representation'? Obviously, the object of that note is to point out in a picture, the whole of which cannot be novel, that part which the applicant says is novel; in other words, to restrict that which, without the note, might be a wider claim than it is with the note." But on the hearing of the appeal, Fletcher Moulton, L.J., said on this: "The fair construction, as between the public and the owner of the registered design, of these words is that he claimed a corset with horizontal gores or gussets, and the reference to the representation is not by way of limitation but by way of illustration. His 'as shown in the representation' does not mean the particular length or breadth of the gores or gussets that you find there shown in that particular corset, but it means that he claims the method of making corsets with horizontal gores."

§ **73.** The Act of 1883 provided (sect. 48) that in addition to the application there should be sent to the Comptroller the prescribed number of copies of drawings, photographs, or tracings of the design, sufficient, in the opinion of the Comptroller, for enabling him to identify

(*m*) (1906) 23 R. P. C. 552, and, on appeal (1907), 24 R. P. C. 65.

the design, but that instead of such copies the applicant might furnish exact representations or specimens of the design. Those provisions are now incorporated in the new Statutory Rules which prescribe that every application for the registration of a design shall be accompanied by three exactly similar drawings, photographs, tracings or other representations of the design, or by three specimens; and where the design is for a set, or for goods in the Manchester Classes, an additional drawing or specimen is to be supplied (*mm*).

Further Rules provide (*inter alia*) "that all applications, notices, papers having representations affixed and other documents sent to the Comptroller shall be upon strong paper (on one side only), of the size of 13 inches by 8 inches, with a margin of two inches on the left-hand part (*n*); that when representations of designs are lodged they must be upon paper of the prescribed size and not on cardboard, the figures being placed in an upright position on the sheet (*nn*); that when drawings or tracings are furnished they must be in ink, and if upon tracing-cloth, mounted on paper of the prescribed size (*o*); that when the design is to be applied to a set, each of the representations should show all the various arrangements in which it is proposed to apply the design to the articles included in the set (*oo*); and that when specimens are lodged, if they are not of a kind which can be pasted into books, representations of the designs must be furnished for insertion in the Register (*p*).

Where the names or representations of living persons or of persons recently dead appear on the design, the Comptroller may require to be furnished with the consents of such persons or their legal representatives before proceeding to register the design (*q*).

(*mm*) Rules of 1908, Nos. 20, 21. (*n*) Rule 7. (*nn*) Rule 22.
(*o*) Rule 23. (*oo*) Rule 24. (*p*) Rule 25. (*q*) Rule 30.

§ **74.** If the three sets of drawings, &c. are not sent with the application, it does not follow that the registration will be refused. It is indeed contemplated that sometimes but one drawing, &c. may be sent, and the Official Instructions state that if it be desired to secure a date of registration at once, one sketch of the design (sufficient to identify the same) may be sent with the application form, but no certificate can be issued until the proper number of correct representations has been sent in substitution for the sketch. If these are not sent within the prescribed time, so as to enable the registration to be completed, the registration will be deemed to be abandoned (*r*). But the Comptroller has power to extend the time in a proper case (*s*).

§ **75.** The Act further provides (*t*): "Before delivery on sale of any articles to which a registered design has been applied, the proprietor shall (if exact representations or specimens were not furnished on the application for registration) furnish to the Comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the Comptroller may erase his name from the register, and thereupon his copyright in the design shall *cease*." From this it may be inferred that the statutory copyright (with all its remedies) dates from the time the application, accompanied by a single sketch, is received by the Comptroller and it is provided by sect. 49 (5) that the registration is to be of that date.

The proprietor may not sell articles to which the design has been applied until the prescribed number of drawings or sketches have been supplied. But the only thing forbidden is the actual delivery on sale of the completed article, so that a person who has obtained a

(*r*) Instructions, § 9; Act of 1907, sect. 49 (4), and Rule 35.
(*s*) Rule No. 64.
(*t*) (1907) Sect. 54 (1) (a).

date of registration by sending in an application accompanied by a single sketch may freely exhibit his design, obtain orders, or even send out patterns, provided he does not sell them. He may also, it would seem, sell and assign his rights or give licenses.

The proprietor of a design, if he fails to comply with the requirements of this sub-section, does not lose his rights absolutely, but only if the matter is brought to the attention of the Comptroller *and he decides to erase the entry*.

As this is the exercise of a discretionary power, the Comptroller is bound to give the applicant a preliminary notice of his intention to erase, and by sect. 73 of the Act he must give the applicant an opportunity of being heard before exercising the power adversely.

§ 76. On application the applicant must state the class or classes of goods in which he desires that the design may be registered (*u*). For the purpose of the registration of designs, goods are classified in sixteen classes, which are set out in the Third Schedule to the Rules (*x*).

> In *Hothersall* v. *Moore* the difference between Classes 13 and 14 under the old Rules was considered, and Bristowe, V.-C., said that he had come to the conclusion that there was a substantial difference between the two classes, and that piece goods are "intended to denote goods commonly known as piece goods, measured by the piece and sold by the piece, and should be classified under No. 13; and that goods which, though woven in the piece, are subdivided in pattern by cross lines or other demarcations, showing that they would be sold not by measurement but by number, as per dozen, fall within the class of handkerchiefs and shawls, and ought to be registered under Class 14" (*y*).

§ 77. The registration may be of single designs or may be of a set, *i.e.*, of any number of articles of the same

(*u*) (1907) Sect. 49 (2); Rule No. 17.
(*x*) Rule 6, and Sch. III. to the Rules. See *ante*, § 36.
(*y*) (1892) 9 R. P. C. 27, 38.

general character ordinarily on sale together or intended to be used together, all bearing the same design with or without modifications not sufficient to alter the character or not substantially affecting the identity thereof (*z*). This is irrespective of the varieties of size and arrangement in which the particular design may be shown on each separate article (*zz*).

§ 78. In any case of doubt as to the class in which a design ought to be registered, or as to the given articles constituting a set or not, the Comptroller may decide the question (*a*); but if the decision be adverse to the applicant, the Comptroller must, at the applicant's request, hear him (*b*). In case of doubt or difficulty, the Comptroller may apply to either of the law officers for directions in the matter (*c*); but on such a question there is no appeal from the Comptroller's decision to the Board of Trade (*d*).

§ 79. The protection granted by the Act to any design is limited to a prohibition of any imitation thereof in the class or classes in which it is registered (*e*); *e.g.*, the registration of a design in Class 13 is not infringed if the alleged imitation is applied to goods in Class 14 (*f*). If, then, there be any doubt in which class the design should be registered, it will be advisable for the proprietor to exercise the power given by the Act, and register it in more classes than one (*g*). A separate application, together with three representations, is necessary for each class. Conversely he may, by application in writing to the Comptroller (accompanied by the prescribed fee), obtain permission to amend his

(*z*) Rule No. 5.
(*zz*) See *In re Rollason's Design* (1897), 14 R. P. C. 909.
(*a*) (1907) Sect. 49 (2), and Rule 5.
(*b*) *Ibid.*, Sect. 73, and Rule 55.
(*c*) *Ibid.*, Sect. 74.
(*d*) *Ibid.*, Sect. 49 (3).
(*e*) *Ibid.*, Sect. 60 (1).
(*f*) *Hothersall* v. *Moore*, *supra*.
(*g*) (1907) Sect. 49 (2).

application by omitting any particular goods or classes of goods in connection with which he has desired the design to be registered (*h*).

In *Re Read & Greswell's Design* (*i*), Chitty, J., said that the copyright in a design conferred by the Act is "limited to the goods in the class or classes in which the design is registered, and this is clearly the case, for under sect. 58 (of the Act of 1883), which gives a special remedy by penalty for the infringement of a registered design, the registered proprietor cannot proceed against the infringer in respect of goods outside the class in which the design is registered, and for this reason, that the person registering having knowingly confined the registration to one class of goods, has by so doing impliedly given notice to all the world that they are at liberty to use the design for goods not included in the class or classes, for a person may register a design in more than one class." This decision must now be read in conjunction with the new provisions made by sect. 50 of the 1907 Act, by which a registered proprietor, in any one or more classes, may obtain registration of the design subsequently in some one or more other classes, and thus deprive any other persons of the "liberty to use the design for goods not included in the class or classes" for which the registration was originally effected.

§ **80.** Though the protection does not extend beyond the particular class in which the design is registered, yet it is not open to a person to register a similar design for a like purpose in another class. The registered proprietor may not proceed for infringement if the imitator uses the design for a class of goods in connection with which the proprietor has not registered; but the imitator cannot have registration allowed to him, as his design is not new and original.

In *Re Read & Greswell's Design* (*i*), T. registered a design in Class 5 in Schedule III. to the old Rules, viz., "Articles composed wholly or partly of paper," for the pattern and shape of a flower candle shade in imitation of a chrysanthemum. Afterwards R. & G. registered an identical design in Class 12, viz., "Goods not included in other classes." It was argued for R. & G. that where a new and original design is registered

(*h*) (1907) Sect. 70 (a).

(*i*) (1889) 6 R. P. C. 471.

in one class, a rival designer is at liberty to take the design and transfer it bodily to another class, and register it in that class. Chitty, J., said that such an argument could not be sustained, and that though T.'s copyright doubtless was limited to goods in Class 5, nevertheless R. & G. could not register the design in any other class. In the course of his judgment he said: "I suggested the case of a design registered for jewellery, and another trader finding this to be so, and that articles marked with such design were being put on the market, and people were becoming generally acquainted with the design, taking this design and registering it in some other class of goods, such as glass (Class 4) or lace (Class 9), a thing which in the case of many designs might easily be done. I am satisfied that it was not the intention of the Legislature to allow this to be done. The answer to the argument is to be found really in sect. 47 of the Act, where the words used are: 'Any new or original design not previously published in the United Kingdom.' To be capable of being registered a design must be 'new or original' in fact, and not, as is suggested, 'new or original' as to some particular class of goods. It cannot be said to be new and original if it is already being applied to *articles of an analogous character*."

In *Re Bach's Design* (*j*), Kekewich, J., decided that a design already on the register may be registered in another class for an article applied to a different purpose, but not for an article merely of a different material. A design for a lamp shade in the shape of a rose made of linen had been previously registered in one class, and the Judge ordered removal from the register of a design for a lamp shade of a similar shape made of china afterwards registered in another class. The Judge said: "There are many cases in the books in which the Court has upheld registration, as for cotton goods in one class, of a design which had already been applied to goods of a different character altogether in another class, and I do not think it necessary to hold or even to intimate that possibly the design of a rose may not be registered for some other entirely different purpose, that is to say, with reference to some other quality of goods in a different class. But the Act does not say, and I think cannot have intended to say, that by selecting a different class a man may register, as applied to the same things, say lamp shades, what has been already registered with reference to that thing, lamp shades, merely varying the material in which the lamp shades have been made."

In *Re Clarke's Design* (*k*), the same principles were applied

(*j*) (1889) 6 R. P. C. 376.
(*k*) (1896) 13 R. P. C. 351, and see *ante*, Chap. III., "Novelty."

by the Court of Appeal to a design for a lamp for electric lighting registered as applicable for its shape, which consisted as to its lower part of a reflecting screen (old as applied to oil or gas lamps), and as to its upper part of a ventilating top, not identical with, but still not substantially differing in shape from, the ventilating top of an old lamp; and this was held not to have sufficient novelty to be entitled to registration as a whole, nor to be infringed by a lamp having a similarly shaped screen, but surmounted by a top differing from the registered design.

§ **81.** As regards application to register, design cases differ from patent and trade-mark cases. When a patent is applied for, an opportunity for opposition is provided; so when the registration of a trade-mark is asked for. This is not the case with designs; there is no provision for public advertisement or opposition (*m*).

The Comptroller considers the application, and may refuse to register any design presented to him for registration (*n*). There are no special directions given by the Acts as to the grounds upon which he must refuse to register, save that sect. 75 provides that he may refuse to register a design of which the use would, in his opinion, be contrary to law or morality; and the terms of sect. 56 (1) contemplate that a design identical with another already registered will be refused. Hence it may be inferred that the refusal to register a design is a matter in the discretion of the Comptroller, subject to the right of appeal provided by the Act. Of course the discretion must be judicially exercised, but assuming this is so, there is no restriction as to the grounds upon which the refusal may be based (*o*).

§ **82.** Before exercising his discretionary power adversely to the applicant for registration, the Comptroller is bound to give the applicant who requires it an

(*m*) See the observations of Fletcher Moulton, L.J., in *Re Bayer's Design* (1907), 24 R. P. C. at p. 76.

(*n*) (1907) Sect. 49 (3), and Rule 31.

(*o*) See *Eno* v. *Dunn* (1890), 7 R. P. C. 311—a trade-mark case.

opportunity of being heard personally or by agent (*p*). A statement of the objection is sent to the applicant in writing (*q*); and the applicant has one month from the date of the Comptroller's objection within which he may apply for a hearing on these objections. The matter then proceeds as follows (*r*): (1) The Comptroller sends to the applicant ten days' notice of a time when the hearing will take place; (2) within five days from the date when such notice would be delivered in the ordinary course of post, the applicant must notify to the Comptroller whether or not he intends to be heard upon the matter; (3) the case is heard on the appointed day, and the decision of the Comptroller is then notified to the applicant.

§ **83.** Any person aggrieved by the refusal of the Comptroller to register may appeal to the Board of Trade, and the Board of Trade will, if required, hear the applicant and the Comptroller, and may make any order determining whether, and subject to what conditions, if any, registration is to be permitted (*s*). By the 62nd section of the Act the Board of Trade has conferred upon it a general superintendence over the Comptroller, and he is bound to obey the Board's directions.

§ **84.** The steps in the appeal procedure are these (*t*): (1) The applicant may, within one month from the date of the decision appealed against, require the Comptroller to state in writing the grounds of his decision and the materials used by him in arriving at the same; (2) within one month from the sending of this statement, or, if it is not applied for, then from the date of the decision the applicant must lodge notice of intention to appeal, stamped with a fee of 5*s*. in respect of each decision

(*p*) (1907) Sect. 73.
(*q*) Rule 32.
(*r*) Rules of 1908, Nos. 57, 58.
(*s*) (1907) Sect. 49 (3).
(*t*) Rules of 1908, Nos. 33, 34, and Nos. 89—94.

appealed against (*u*); (3) the notice must be accompanied by a copy of the form of application and six representations of the design applied for, a copy of the grounds of the Comptroller's decision (if applied for), a statement of the grounds of appeal, and of the applicant's case in support thereof; (4) a copy of the notice and of all the accompanying documents must also be sent by the applicant forthwith to the Secretary of the Board of Trade at Whitehall.

The Board of Trade may, upon receipt of the notice, give such directions (if any) as they may think fit for the purpose of hearing the appeal; and they will give seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for hearing the appeal. The notice will be given to the Comptroller and to the applicant (*x*).

No appeal will be entertained of which notice is not given within the prescribed time, or such further time as the Comptroller may allow, except by special leave of the Board of Trade.

There are no costs of the appeal, as they are not provided for by the Acts or Rules, and it may be taken that the applicant pays his own, whether successful or not.

§ **85.** When it has been determined, either by the Comptroller or the Board of Trade on appeal, to register a design, the applicant is entitled to a certificate of such registration in the prescribed form, sealed with the seal of the Patent Office (*y*). The registration dates from the day of application, but actual registration does not take place until the certificate is sealed (*z*).

(*u*) See Form 25, *post*, p. 386.

(*x*) Rules of 1908, No. 93.

(*y*) Act of 1907, sect. 51 (1). For form of Certificate, see Form D.O., No. 1, *post*, p. 377.

(*z*) Act of 1907, sect. 49 (5).

In case of loss of the original certificate, or in any other case in which he may deem it expedient, the Comptroller may grant copies of the certificate. The fee for each copy is one shilling, and the application should be made in the form prescribed by the Rules (*a*).

§ 86. The Comptroller may allow any document or drawing or other representation of a design to be amended, and any irregularity in procedure to be corrected, if in his opinion this can be done without detriment to the interests of any person (*b*). He may extend the time prescribed by the Rules for doing any act or taking any proceeding thereunder (*c*). Any such amendment or extension will be in the discretion of the Comptroller, and subject to such terms as he may think fit.

§ 87. The Comptroller may also, on request in writing, accompanied by the prescribed fee, (a) correct any clerical error in an application or in the representation of a design (*d*); or (b) any clerical error in the representation of a design or in the name or address of the registered proprietor of a design, or in any other matter which is entered in the register (*e*); or (c) permit a registered owner of a design to amend the registration by omitting any particular goods or classes of goods in connexion with which he has desired the design to be registered (*f*).

§ 88. Special provision for applications on behalf of persons under disability, *e.g.*, for infants or lunatics, is made by sect. 83 of the Act.

Power to prescribe fees on registration is given by

(*a*) (1907) Sect. 51 (2); and Form 27, *post*, p. 389.
(*b*) Rules of 1908, No. 63.
(*c*) Rule No. 64.
(*d*) Rule No. 51; Form No. 17, *post*, p. 382.
(*e*) (1907) Sect. 70 (c). See *In re Grocott's Design* (1899), 17 R. P. C. 139.
(*f*) (1907) Sect. 70 (b).

sect. 95 of the Act; and the Board of Trade, with the sanction of the Treasury, have fixed the Table of Fees as set forth in Schedule I. to the Rules.

Provisions are also made (sect. 80) for the transmission of certified copies of all specifications, drawings, and amendments left at the Comptroller's Office to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man.

§ **89.** The new Act also provides (*h*) for the establishment, by Rules under the Act, of branch offices for designs at Manchester and elsewhere, and for any document or thing required by the Act to be sent to or done at the Patent Office being sent to or done at any branch office which may be established; and the Rules of 1908 (*i*) have accordingly established such offices at Manchester (the office of the Keeper of Cotton Marks, 48, Royal Exchange), where applications for registration of designs in Classes 13, 14 and 15 may be lodged at the option of the applicant instead of at the Patent Office.

All applications for registration of designs in these three classes, and other documents relating to such designs must be in duplicate, one of the documents being stamped and the other unstamped. A separate register of all designs in these classes is to be kept at the Manchester office; and when any alteration or addition is made at the office of an entry in the register relating to such a design, the Comptroller must forthwith give notice to the Keeper, who will make a corresponding alteration in the Manchester Register.

(*h*) (1907) Sect. 62 (4).
(*i*) See Rules of 1908, Nos. 80—88.

CHAPTER VI.

THE REGISTER.

(*The full references to all the Reports will be found in the Table of Cases ante.*)

§ 90. Entry of Proprietorship.
§ 91. Provisions as to Equitable Interests.
§ 92. Original Registration.
§ 93. Entry of Transmission.
§ 94. Registration of Assignments and other Interests.
§ 95. Powers of Comptroller to dispense with Evidence.
§ 96. Necessity of Writings to prove Title?
§ 97. Death or Bankruptcy of Proprietor.
§ 98. Inspection of the Register.
§ 99. Rectification and Expunging of Entries.
§ 100. Grounds for Expunging.
§ 101. Rectification of Owners' Names—*Re Guiterman's Design*—*Re Grucott's Design.*
§ 102. Change of Name of Owners.
§ 103. Costs and Damages on Rectification.
§ 104. Improper Use or Conduct as affecting Registration.
§ 105. Persons entitled to apply for Rectification—*Re Powell's Trade-Mark*—*Apollinaris Case.*
§ 106. Summary of Authorities as to "Person aggrieved."
§ 107. Jurisdiction on Application for Rectification—Scotch and Irish Cases.
§ 108. Procedure on Applications for Rectification—Motion or Summons.
§ 109. Notices to be given—Application for leave.
§ 110. The Order to Rectify and its Entry on the Register—Right of Appeal.
§ 111. Application for Cancellation for Non-manufacture in United Kingdom.
§ 112. Procedure on Application to Cancel.
§ 113. Register *primâ facie* Evidence—Certificates of Entries by Comptroller.
§ 114. Falsification of Documents.

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§ 90. The Act provides that there shall be kept at the Patent Office a book called the Register of Designs, wherein shall be entered the names and addresses of the proprietors (*a*) of registered designs, notifications of

(*a*) As to Proprietorship, see Chapter VII., *post.*

assignments and of transmissions of registered designs, and such other matters as may from time to time be prescribed (*b*). The old register of designs formed under the 1883 Act is incorporated with and forms part of the register under the new Act (*c*).

§ **91.** No notice of any trust, express, implied or constructive, can be entered upon the register or be received by the Comptroller (*d*). The new Act, however, contains an express provision (*e*) that where any person becomes entitled as mortgagee, licensee or otherwise to any interest in a design the Comptroller shall, on request and proof of title to his satisfaction, cause notice of the interest to be entered on the register.

This will not materially alter the old practice, for it was long ago decided, on sect. 23 of the Act of 1883 (the corresponding section of that portion of the Act which related to patents), that equitable assignments might be entered on the register, not as in themselves legal assignments, but as documents which affected the proprietorship. And deeds containing declarations of trust have been commonly filed in the Comptroller's Office though no notice was taken of the trust in the entry on the register.

The Act (*f*), moreover, provides for the enforcement of any equities in respect of a design in the same way as in respect of any other personal property.

> In *Stewart* v. *Casey* (*g*), A. and B., joint owners of certain patents, wrote to C., "In consideration of your services as . . . . we hereby agree to give you one-third share of the patent, the same to take effect as from this date." A. and B. then deposited the letters patent with C., and C. registered the

(*b*) (1907) Sect. 52 (1). As to Classes 13, 14 and 15, see Rule 85.
(*c*) (1907) Sect. 52 (2). (*d*) *Ibid.*, Sect. 66.
(*e*) Sect. 71 (2). (*f*) Sect. 71 (3).
(*g*) (1892) 9 R. P. C. 9. The point was queried by Kekewich, J., in *Haslett* v. *Hutchinson* (1891), 8 R. P. C. 457, but *Stewart* v. *Casey* is a direct decision on the question and has since been followed.

letter above set out; and the Court of Appeal held that the letter was an immediate equitable assignment of an interest in the patent, and was properly entered on the register.

§ **92.** The registration of the name of the original proprietor is effected upon the sealing of the certificate of registration, though the date of application is the day from which the registration will date (*h*). The Comptroller must enter on the register the name (*i*), address, and description of the registered proprietor, and the date upon which the application for registration was received by the Comptroller.

§ **93.** Subsequent proprietors are entitled to be placed upon the register, on compliance with the provisions of sect. 71 (1) of the Act, which runs as follows:—

"Where a person becomes entitled by assignment, transmission, or other operation of law, to the copyright in a registered design, the Comptroller shall on request, and on proof of title to his satisfaction, register him as the proprietor of a design."

§ **94.** Where a person becomes entitled to the copyright in a registered design, or to any share or interest therein, as assignee, mortgagee, licensee, or otherwise, or acquires any right to apply the design either exclusively or otherwise, a request for the entry of his name in the register as such proprietor of the design, or as having acquired such right, as the case may be, is to be addressed to the Comptroller (*k*).

Every such request must, in the case of an individual, be made and signed by the person requiring to be registered as proprietor; and in the case of a firm or partnership, by some one or more members of such firm or partnership, or, in either case, by his or their agent respectively duly authorised to the satisfaction of the Comptroller; and in the case of a body corporate, by a director, or by the secretary or other proper officer, or

(*h*) Sects. 49 (5) and 51 (1).
(*i*) A body corporate may be registered by its corporate name: see Rule 8.
(*k*) Rules 43, 44. And see Forms Nos. 11, 13, *post*, pp. 379, 380.

their agent authorised in like manner(*l*). It may be made jointly with the registered proprietor, in which case the Comptroller may forthwith, on receipt of the joint request, make a note in the Register of such interest (*m*). Where no such joint application is made the request must state the name, address and description of the claimant, and the particulars of the assignment, mortgage, license, or other mode of transfer by virtue of which the request is made, so as to show the manner in which and the person or persons through whom the interest in the design has been acquired (*mm*).

The request must be supported, if the Comptroller requires it, by a statutory declaration verifying the several statements in the case, and declaring that the particulars given comprise every material fact and document affecting the matter (*n*). The claimant must also furnish to the Comptroller such other proof of title as he may require for his satisfaction (*nn*). Where the name of a person is entered on the Register as mortgagee or licensee, the entry may be vacated on lodgment of an acknowledgment of the determination of the interest, signed by him or his agent (*o*).

§ **95.** In any case in which the Comptroller thinks it right he may take evidence *viva voce* in lieu of or in addition to evidence by declaration, or allow any declarant to be cross-examined on his declaration (*p*). He may also dispense with compliance with any of the above provisions, and accept other evidence of transmission of title (subject to such conditions as he may think fit) wherever he is satisfied that from any reasonable cause the person entitled cannot sign the request or make the statutory declaration or produce the documents or other evidence of title (*pp*).

(*l*) Rules 8, 12.
(*m*) Rule 43, Form No. 11, *post*, p. 379.
(*mm*) Rules 44, 45, Form No. 13, *post*, p. 380.
(*n*) Rule 46, Form No. 14, *post*, p. 381.
(*nn*) Rule 47.
(*o*) Rule 49, Form No. 15, *post*, p. 381.
(*p*) (1907) Sect. 77 (1).
(*pp*) Rule 62.

§ **96.** It may be considered doubtful whether an assignment must be in writing. This was assumed to be the case under the older Acts (*q*), but the Rules of 1900 (which are repeated in the new Rules above quoted) seem to have contemplated cases where a written assignment could not be produced. In *Woolley* v. *Broad* (*r*), where unregistered verbal licensees joined with the proprietor in an action for infringement, judgment was given against them on the ground that there was no written evidence of their title; but this is scarcely a direct decision on the point. The effect of the new Rules is that the Comptroller may accept less than legal evidence, and that whenever he is satisfied that the claimant is entitled to the entry of his name, he may make a note on the register of such interest (*rr*).

§ **97.** It will be necessary, in all cases, to complete the original registration before an assignment can be registered (*s*).

On the death of the proprietor his executor or administrator is entitled to be registered; on bankruptcy the right devolves upon the trustee in bankruptcy.

§ **98.** The register kept under the Act is required to be open to the inspection of the public at all convenient times, subject to the provisions of the Act and to such regulations as may be prescribed (*t*).

During the existence of the copyright in a design, or (under the Act of 1907) such shorter period, not being less than two years from the registration of the design, as may be prescribed, the design itself cannot be inspected except (1) by the registered proprietor; or (2) by a

(*q*) *Jewitt* v. *Eckhardt* (1878), 8 Ch. D. 404 (a license case). And see Act of 1842, sect. 6.

(*r*) (1892) 9 R. P. C. 208.

(*rr*) See Rules 48, 62. The question is more fully dealt with in Chap. VII. on "Proprietor," *post*, p. 122.

(*s*) *Jewitt* v. *Eckhardt*, *supra*.

(*t*) (1907) Sect. 67; Rules 61, 69.

person authorised in writing by him; or (3) by a person authorised by the Comptroller or by the Court (*u*). And any of these persons must furnish such information as may enable the Comptroller to identify the design; must inspect in the presence of the Comptroller or of an officer acting under him; must pay the prescribed fee, viz., one shilling for every quarter of an hour (*x*); and must not take any copy of the design, or of any part of it (*y*).

But where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration is entitled to inspect the design so registered (*z*), and this, it is said, affords in practice an easy means of obtaining inspection of almost any design.

The new Act has given power to throw designs open to inspection before the expiration of the copyright, and by sub-section 3 of the 56th section different periods may be prescribed for different classes of goods. The Rules of 1908 have fixed two years from the date of registration as the period after which inspection may be obtained as of right for all classes (*a*), except Classes 13, 14 and 15.

When the copyright in a design has ceased, the design is open to inspection by any member of the public, and copies thereof may be taken by any person on payment of the prescribed fee (*b*).

Where an application for a design has been refused or not been duly proceeded with so that it becomes liable to be treated as abandoned under the new provisions of sect. 49 (4) of the 1907 Act, the application, and any drawings or specimens left in connection with the application, is not at any time to be open to public inspection or published by the Comptroller (*c*).

(*u*) (1907) Sect. 56 (1).
(*x*) Rules of 1908, Sched. I. (No. 26).
(*y*) (1907) Sect. 56 (1).
(*z*) Proviso to Sect. 56 (1).
(*a*) Rules of 1908, No. 69.
(*b*) (1907) Sect. 56 (2).
(*c*) (1907) Sect. 69 (2).

§ **99.** It is provided by sect. 72 of the new Act (corresponding with sect. 90 of the Act of 1883) that—

> "The Court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of designs of any entry, or by any entry in such register made without sufficient cause, or by any entry wrongly remaining on, or by any error or defect in any entry in such register, make such order for making, expunging, or varying such entry, as it may think fit."

This provision is much wider in its wording than that of the corresponding section in the old Act, under which it was held that the words "omission without sufficient cause of the name of any person" would not enable a person whose design had been refused by the Comptroller to appeal to the Court, and that as an appeal of such a kind was required to be to the Board of Trade (*d*), this provision could not be evaded under cover of an application to rectify the register (*e*). The new Act has added the words "non-insertion in . . . . the register of designs of any entry," and although an appeal is given as before (*f*) to the Board of Trade against any refusal of the Comptroller to register, it may be questioned whether this excludes the express power given to the Court by this provision.

Other new grounds for an application for rectification introduced by the 1907 Act are: (a) any entry wrongly remaining on the register; (b) any error or defect in any entry; and in all these cases, although the Comptroller may sometimes have a concurrent power (*g*), full jurisdiction is given to the Court itself.

§ **100.** The grounds upon which an entry will be varied or expunged by the Court are, in general, similar

(*d*) (1883) Sect. 47.

(*e*) *Re the Trade Mark Normal* (1886), 4 R. P. C. 123. Sect. 90 of the Act of 1883 applied to patents, designs and trade marks alike, and assistance in construing it was to be obtained from cases on all three subjects.

(*f*) See Act of 1907, sect. 49 (3).

(*g*) See sect. 70 (b) and (c).

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to those upon which the Comptroller ought, in the first instance, to refuse registration. Thus the Court has expunged entries on the ground—(1) that the person registered had no title enabling him to register (*h*); (2) that the design was not novel or had been previously published (*i*); (3) that the entries in the register had been caused by misrepresentation (*k*); (4) that the entry was not *bonâ fide*, and had been made without sufficient cause (*l*).

§ **101.** The Court may expunge any entry or may rectify by varying the entry (*m*). An improper entry should be expunged, and not rectified (*n*). And although at one time it was doubted, there seems to be power to substitute one name as registered proprietor for another, which may be exercised by the Court (*p*), or even by the Comptroller (without application to the Court), in proper circumstances.

The trade mark authorities on the point apply generally in the case of designs (*q*), but it is to be noted that the reasons which have led the Court to refuse to substitute the name of the proper proprietor for that of the person improperly registered, in the case of trade marks, are not as strong in the case of the register of designs, upon which names are placed by the Comptroller without preliminary notice or other opportunity for opposition.

(*h*) *Re Guiterman's Design* (1886), 55 L. J. Ch. 309.

(*i*) *Le May* v. *Welch* (1884), 28 Ch. D. 24; *Smith* v. *Hope* (1889), 6 R. P. C. 200; *Re Read and Greswell's Design* (1889), 6 R. P. C. 471; *Smout* v. *Slaymaker* (1890), 7 R. P. C. 90.

(*k*) *Baker* v. *Rawson* (1889), 45 Ch. Div. 519.

(*l*) *Re Batt's Trade Mark* (1899), 16 R. P. C. 411.

(*m*) An example of this is to be found in the trade mark case, *Baker* v. *Rawson*, cited above. See also *Re Grocott's Design* (1899), 17 R. P. C. 139.

(*n*) Per Kekewich, J., in *Haslett* v. *Hutchinson* (1891), 8 R. P. C. 457.

(*p*) *Re Grocott's Design, supra.*

(*q*) Per North, J., in *Re Ormonde Cycle Co.'s Trade Mark* (1896), 13 R. P. C. 475.

In *Re Rivière's Trade Mark* (*r*), Cotton, L.J., said: "In my opinion, whatever might be the result of striking off the name of Rivière & Co., yet the application to substitute that of the applicants could not be acceded to. Because, in my opinion, even without going so far as to say that in no case where the name of a person improperly on the register as owner of a mark is struck off may the name of the person properly entitled to the mark be substituted, yet in my view, *as a rule* (and I do not know a case where there would be an exception), where anyone applies in the first instance to be publicly registered as the proprietor of a trade mark, the prescribed formalities should be adopted."

In *Rust & Co.'s Trade Mark* (*s*), Arthur Rust, by mistake, registered a trade mark of his firm in the name of "Arthur Rust, trading as T. W. Rust & Co.," and the firm of T. W. Rust & Co. moved successfully to rectify the register by cancelling the name of A. Rust and inserting in the register the names of all the partners trading under the firm's name. (Here, it will be observed, the registered proprietor had applied in the firm's name as well as his own.)

In *Re Farina's Trade Mark* (*t*) the partner applied in his own name only, and substitution, by way of rectification, of the firm's name, was refused; and in *Re Greenlees' Trade Marks* (*u*) this case was followed; and Stirling, J., stated that the right course would be for the partner whose name was upon the register to assign to the firm.

In *Re Guiterman's Design* (*x*) an agent for a company owning designs was wrongfully registered as proprietor. The Court expunged the agent's name from the register, but refused to substitute the name of the company for that of the agent. It is to be observed, however, that the application was made by counsel for the agent, and not by the real proprietor, and no reasons for his refusal were given by the judge.

In Re Grocott's Design (*y*) is an instructive case on this point. In this case a design had been registered by the instructions of H., the author, but was inadvertently registered by the agent, G., who was employed by him to manufacture the articles in his own name. H. moved to vary the register by removing G.'s name and substituting his own name as the proprietor of the design. G. did not appear; and it appearing by the evidence that it was a case of mistake and not fraud on the part of the agent, who had offered to assign the registration to H., the application was not opposed

(*r*) (1885) 55 L. J. Ch. 545.
(*s*) (1880) 29 W. R. 393.
(*t*) (1881) 29 W. R. 391.
(*u*) (1892) 9 R. P. C. 93.
(*x*) (1886) 55 L. J. Ch. 309.
(*y*) (1899) 17 R. P. C. 139.

by the Comptroller. Counsel for the applicant said G. could not make a title by assignment, as he was not the author or the proprietor within sect. 61; and if the name of the true author and proprietor could not be substituted, the design would become common property. Kekewich, J., said there was reasonably clear evidence of a mistake, and he would make the order to vary the register, putting on the face of it the reason: "It appearing to the satisfaction of the Court that the registration by G., in his own name, was made inadvertently and by mistake in lieu of the name of H."

§ 102. Where there is a change, not of ownership, but of the name of the owners, variation by way of addition of the new name has been allowed even in the case of a trade mark (*z*). And where the name of a company or firm has been altered, it is not necessary to apply to the Court to make an order to vary under sect. 72 of the Act, but the Comptroller may do it under sect. 71 (*a*).

§ 103. The costs of such an application were declared by the old section (90 (1)) to be in the discretion of the Court; but there seems to have been no fixed rule as to the orders made in this regard (*b*). In contested cases the party who was unsuccessful generally had to pay them, and the Comptroller was usually allowed his costs of appearance.

Power was also given to the Court by sect. 90 (2) of the 1883 Act to award damages to the party aggrieved by any false entry in the register. Judging from the reported cases on designs, this was seldom, if ever, done, although it might be in a proper case. Under a similar

(*z*) *Re Patent Plumbago Crucible Co.'s Trade Mark* (1890), 7 R. P. C. 282.

(*a*) See, however, *In re Pneumatic Tyre Co.'s Design* (1894), 11 R. P. C. 636, where the Comptroller declined in similar circumstances to change the name of the proprietor on the register from that of an old to that of a new company without an order of the Court, and the order was made (by consent) on payment of his costs.

(*b*) See *e.g.*, *Re Batt & Co.'s Trade Mark* (1898), 15 R. P. C. 262, 534, where no order was made for the Comptroller's costs, while in *Re Pneumatic Tyre Co.'s Design*, *supra*, they were ordered to be paid. And see *infra*, § 113.

section of the Companies Act, 1862 (*c*), Lindley, L.J., said that it appeared to him that the Court had no jurisdiction to make the company pay damages under the section, *except in cases where an order for rectification was made.*

The Act contains a general provision (sect. 72 (3)) that the Court may, in any proceeding under the section, decide any question that it may be necessary or expedient to decide in connection with the rectification of a register, and this would probably be held to include any question of costs, and even of damages in a proper case.

§ 104. Although the Court has power under its general jurisdiction to refuse relief to a registered proprietor of a design on the ground of improper conduct disentitling him to assistance in support of his rights against an alleged infringer (*d*), this will not be carried to the extent of removing his registered design from the register unless there are good legal grounds under the Act.

> In *Harper* v. *Wright & Butler* (*e*), Herschell, L.J., in giving judgment for the plaintiff, said: "Then, it is said that the plaintiffs are disentitled from recovering because they have misled the public. It is said that they have obtained registration for their handles to the stove and for a cover to the stove—a particular pattern or ornament of the cover—and they have, first of all, on stoves which they have sold, put the registered number of the original design, and also put the registered number of the designs which they registered subsequently as applicable to particular parts of the stove. It is said that that was misleading, and that the public would not know to what those numbers referred; and, if the lid was a new-registered lid, then they ought not to have put on the number of the original design, because that was a different design. Now, there is nothing in the Act of Parliament which deprives a person who has registered a design of his right to protection, and to prevent infringement of it if he puts on articles that he sells registered numbers which ought

(*c*) Sect. 35; *Ottos Kopje Diamond Mines* (1893), 62 L. J. Ch. 166. In *Reid* v. *Thomson* (1905), 22 R. P. C. 376 (a Scotch case), it was held that damages for an illegal registration could not be recovered either at common law or under the statute.

(*d*) Per Stirling, J., in *Sen Sen Co.* v. *Britten* (1899), 16 R. P. C. 137.

(*e*) (1895) 12 R. P. C. 483.

not to be there. If he sells without putting on the registered number of a design which is within his registration, then no doubt he loses his protection; and it may sometimes be a difficult question to know exactly what numbers he ought to put on, and on what parts of the articles sold, and it is only natural that a person who has registered designs should err on the side of caution, because if he does not put the number on, he certainly loses his rights. But there is no clause in the Act of Parliament which deprives him of his rights if he, even mistakenly, puts numbers on the articles which he sells which have no business there."

So, in *Re Bayer's Design* (*f*), it was held that the facts that the owner had sold articles differing, but not substantially, from the registered design marked with the registered number, and that he had, after registration, made statements in his catalogue and otherwise as to the extent of his protection and monopoly, ought not to affect the construction of the application or the validity of the registration. Warrington, J., in giving judgment, said: "It is said that the respondent has misrepresented the nature of his design; that is to say, that he has in his advertisements represented as covered by his design a number of articles which vary. They vary in this way: they vary both in number and in the shape of the pieces of which the stays are composed. Now, in the first place, no authority has been produced to me for the rectification of the register on that ground, and I am not prepared to say that in the case of a design it ought to be struck off the register because the applicant for the design has been guilty of misconduct in selling as registered something which is not covered by the registered design. That, of course, would be an answer to the objection. I do not think that the register ought to be rectified or the design struck out from it because subsequently the proprietor of the design has made a statement which would lead people to believe that he has a greater protection than he has."

And on the hearing in the Court of Appeal, where the registration was invalidated on other grounds, it being urged that the owner of a design might in his advertisements anticipate the construction to be put on his design, and perhaps err on the side of safety, Vaughan Williams, L.J., said: "The advertisements are quite immaterial. I agree with you there."

§ 105. The persons entitled to demand rectification, if there be due cause, must come under the description of "person aggrieved." There has been at different times

(*f*) (1906) 23 R. P. C. 553; and (on appeal) (1907), 24 R. P. C. 65.

much discussion as to who may fall within this description (*g*).

In the case of *Rivière's Trade Mark* (*gg*), Selborne, L.C., said: "The first observation which I have to make is, that I do not find on the face of the Act of Parliament itself any particular limitation of the sense in which the word 'aggrieved' is to be understood, when a person alleging himself to be aggrieved undertakes to bring the case within any one of the conditions on which a right to apply to rectify the register is given to a person aggrieved. Of course, if it could be shown *à priori* that, in point of law, persons in a certain situation could not be aggrieved, then the conclusion would be right, that the Court must refuse to hear them on the merits; but, unless that can be demonstrated, I find nothing in the Act of Parliament which limits and defines the kind of grievance which may entitle a man to apply. I entirely agree with what has been said, that it must be a legal grievance; it must not be a '*stet pro ratione voluntas*'; the applicant must not come merely saying, 'I do not like this thing to be done'; it must be shown that it tends to his injury or to his damage in the legal sense of that word." And Cotton, L.J., said: "Now undoubtedly the grievance must be a grievance which the law recognises as one in respect of which a party can complain in a Court of justice, and not a merely sentimental grievance; but is it possible for us to say *à priori* that, assuming (though I by no means decide) the applicant to be a person who, having regard to the business which he carries on and the place where he carries it on, cannot register that which the respondents have registered, he cannot be aggrieved?"

In *Re Apollinaris Co.'s Trade Marks* (*h*) the Court of Appeal (per Fry, L.J.) laid down that the object of limiting the power of application to the Court to a person aggrieved is to exclude the common informer, and those desiring to interfere from sentimental motives only; and whilst a grievance in the sense intended by the Act does not mean mere annoyance, yet it is not necessary that the applicant should prove that he is suffering serious damage.

In *Re Powell's Trade Mark* (*i*), Bowen, L.J., said: "Persons who are aggrieved are persons who are in some way or other substantially interested in having the mark removed from the

(*g*) For survey of the decisions, see § 106, *post*, p. 107.

(*gg*) (1884) 53 L. J. Ch. 455, 578.

(*h*) (1891) 8 R. P. C. 137.

(*i*) (1893) 10 R. P. C. 195. Affirmed by the House of Lords (1894), 11 R. P. C. 4.

registor, or persons who would be substantially damaged if the mark remained. It is very difficult to frame a nearer definition than that. In the *Apollinaris Case* it was pointed out not as a complete or exhaustive definition that people would be aggrieved if they were in the same trade and dealt in the same article. To my mind, it is equally true that persons would be aggrieved if they are in the same trade, and might reasonably be expected to deal in the same article, though not prepared to prove at the moment that they had formed a clear determination to do so. Supposing that this mark ought not to be on the register, it hampers those who are in the trade and who might wish to consider the question of embarking in another branch of the trade if lawfully entitled to do so. It would be, to my mind, an unbusiness-like construction to place on the term 'aggrieved,' to say that it could only be applicable to those who actually had formed a fixed and crystallized intention of dealing in the particular article if permitted to do so. If a man is hampered in his arrangements of business matters in the future by the fact that a trade mark is on the register which ought not to be there, he is a person who, to my mind, is sufficiently aggrieved to come within the section." And in the House of Lords, Herschell, L.C., said: "Wherever it can be shown that the applicant is in the same trade as the person who first registered the trade mark, and wherever the trade mark if remaining on the register would or might limit the legal rights of the applicant, so that by reason of the existence of the entry upon the register he could not lawfully do that which, but for the appearance of the mark upon the register he could lawfully do, it appears to me that he has a *locus standi* to be heard as a person aggrieved."

In *Re Wright, Crossley & Co.'s Trade Mark* (*k*), an application to expunge was made by the Royal Baking Powder Co., who had had other litigation with the respondents but were unable to show that they had any *bonâ fide* intention to trade in the goods covered by the mark; and it was held, that the applicants were not persons aggrieved, as they had not shown any practically possible way in which they might be damaged by the presence of the trade mark on the register, and that the trade mark was not in itself illegal or improper. Rigby, L.J., said: "So far from assenting to the statement that *In re Powell* (11 R. P. C. 4) is an authority that the mere fact that a man is engaged in the same trade is sufficient to make him a person aggrieved, I think it is carefully guarded against, and that statement is contrary to the principles of the case as stated in the House of Lords."

(*k*) (1898) 15 R. P. C. 131.

The same view has been upheld under the Literary and Art Copyright Acts (*l*), where similar powers of expunging entries are given; and in the leading case of *Re Graves* (*m*), Hannen, J., said: "A person to be 'aggrieved,' within the meaning of the statute, must show that the entry is inconsistent with some right that he sets up in himself or in some other person, or that the entry would really interfere with some intended action on the part of the person making the application."

So in patent cases in *Horsley & Knighton's Patent* (*n*), one of two joint patentees was enabled as an aggrieved party to move to expunge an entry prejudicial to him and entered on the initiative of his co-patentee (*o*).

In *Re Green's Patent* (*o*), a patentee having assigned his patent to persons who omitted to register the assignment, afterwards *fraudulently* assigned the patent to another person, who registered it on the same day. The first assignees registered their assignment a week afterwards. The Court, on the motion of the first assignees, ordered the register of the second assignment to be expunged, and with costs.

And in *Re Morey's Patent* (*p*), a patentee assigned half his patent to A., and afterwards he assigned the whole to B. by deed, reciting that he had already granted a licence to work and use to A. B.'s assignment was first registered. It was held that B. had constructive notice of A.'s rights, and an entry was ordered to be made in the register that the licence referred to in B.'s assignment was the deed of assignment to A. subsequently entered.

§ 106. Thus the following are persons aggrieved—(a) those who are engaged in a business and who desire to deal in a design covering goods in that business, which they allege to be improperly on the register (*q*); (b) proprietors of designs registered before the design which it is desired to remove, and who allege some prejudice to their rights through the subsequent registration (*r*); (c) persons attacked in an action for infringe-

(*l*) 5 & 6 Vict. c. 45, s. 14, and 25 & 26 Vict. c. 68, s. 5.

(*m*) (1869) L. R. 4 Q. B. 724. See *Chappell* v. *Purday*, 14 M. & W. 303, and *Ex parte Poulton*, 53 L. J. Q. B. 320.

(*n*) (1869) 39 L. J. Ch. 157.

(*o*) (1857) 24 Beav. 145.

(*p*) (1858) 25 Beav. 581.

(*q*) See *Smith* v. *Hope* (1889), 6 R. P. C. 200; *Re Bach's Design* (1889), 6 R. P. C. 376; and *Re Talbot's Trade Mark* (1894), 11 R. P. C. 77, in addition to the cases above cited.

(*r*) *E.g.*, *Re Read and Greswell's Design*, 42 Ch. Div. 260.

ment (*s*); and (d) persons setting up some right or title which is interfered with by the registration.

§ **107**. To expunge or rectify it is necessary to make application to the Court, *i.e.*, to the High Court of Justice in England, and preferably to the Chancery Division (*t*). This will be so even when the registered proprietor is domiciled in Scotland or Ireland (*u*); but there have been conflicting decisions in the two countries on this point.

In Scotland there is the authority of *Cowie Brothers* v. *Herbert* (*x*). This was an action in the sheriff Court of Lanarkshire for infringement of a trade mark of a Glasgow firm, during the dependence of which the defender presented a petition to the Lord Ordinary in the Court of Session (Outer House) to have the trade mark expunged under sect. 90. Held, by the Lord Ordinary, that the petition to him for rectification of the register was a competent application, and that the petitioner was an aggrieved person in the sense of the Act. The Lord Ordinary, however, said: "I have been informed that there is no report in our books of any petition for rectification of the register of trade marks, but no objection has been taken to my jurisdiction, and I suppose there is no doubt about it."

In Ireland, however, the contrary opinion was expressed, after full argument, in the case of *Charles Bayer* v. *Connell* (*y*). This was an action for infringement of the trade mark of a London firm of corset makers, the defendant, who traded in Dublin, denying infringement. By an interlocutory motion the defendants applied for an order that the registration should be set aside and expunged, and the register rectified; but this was opposed by the plaintiff, on the point that the High Court of Justice in Ireland had no jurisdiction to order any alteration in the register. Held, that the Irish Court had no jurisdiction under the Patents Act, 1883, to order any alteration or rectification of the register of trade marks, which was a special jurisdiction conferred on the High Court of Justice in England.

In giving judgment the Master of the Rolls (Porter) said: "The sole question at present to be decided is whether the Patents, Designs, and Trade Marks Act of 1883 (46 & 47

(*s*) *Great Tower Tea Co.* v. *Smith* (1889), 6 R. P. C. 165.
(*t*) (1907) Sect. 92 (1). See also sects. 94 (4) and 95 (2) of the Act.
(*u*) *Re King & Co.'s Trade Mark* (1892), 10 R. P. C. 350; and *Kinahan* v. *Kinahan*, 8 R. P. C. 18.
(*x*) (1896) 14 R. P. C. 426. See also *Dewars, Ltd.* v. *J. T. Dewar* (1899), 17 R. P. C. 341, where an order to expunge was made; and *Reid* v. *Thomson* (1905), 22 R. P. C. 376, where the claim was not resisted.
(*y*) (1897) 14 R. P. C. 275.

Vict. c. 57) confers upon the Irish Courts any power to order the register to be altered, by expunging a trade mark or otherwise rectifying it. The question is one apart from the ordinary jurisdiction of the Court. The power, if it exists, is the creature of the statute, and must be found in it. That which is sought in this motion is plainly an exercise of a special jurisdiction under the Act, and that alone. There can be no inherent or general authority in an Irish Court to correct a register of trade marks in England . . . . It is important to note that in the first Trade Mark Act, properly so called, the Act of 1875 (38 & 39 Vict. c. 91), the only Court which could possibly touch the register directly was 'any of Her Majesty's Courts of law or equity at Westminster.' That appears to me to have a very important bearing upon the question. It is an Act to establish a register of trade marks. Of course it has been repealed, but that does not affect the importance of it in considering the question now before me. . . . There is thus no decision upon the point; and although the Trade Marks Act, 1875, is mentioned in some of the judgments in the last-mentioned case (*King & Co.'s Trade Mark*), its bearing upon this question does not seem to have been considered. I regard that Act as of very great importance. Some departure from the phraseology of a statute dealing only with trade marks was necessary, when the Legislature came to embody in one Act provisions relating to trade marks, designs, and patents; but if so grave a departure was intended as the depriving of the English Courts of an exclusive jurisdiction in reference to trade marks (which undoubtedly they had under the Act of 1875), and the conferring of a co-ordinate jurisdiction upon the Irish and Scotch Courts, it would certainly have been expressed in direct language, and we should not have been left to spell it out of doubtful and ambiguous expressions, such as are to be found in the 111th section. I need not dwell upon the inconvenience which might result from conflicting decisions as to the registration of the same trade mark in the Courts of the three countries. The question is one of the construction of the statute, and on that alone I decide it" (*yy*).

§ **108.** It would ordinarily be an abuse of the process of the Court to bring an action for rectification; nor will the Court grant the relief on a counterclaim (*z*). The

(*yy*) The new Act provides for such applications being made in "the prescribed manner" (sect. 72 (1)), and for the attendance of the Comptroller on the hearing (sect. 72 (3)), and it is difficult to see how these provisions can be deemed to apply to Scotch or Irish Courts.

(*z*) Per Bowen, L.J., in *Pinto* v. *Badman* (1891), 8 R. P. C. 181, 187. See, however, *Reid* v. *Thomson*, *supra*, where an action for a declaration and damages was brought, and costs were awarded.

proper method of procedure is either by motion or by summons. The latter is not always the cheaper, and if it be obvious that the case must eventually be adjourned into Court, it will often be better to proceed by motion (*a*). As the application is not by petition, the provisions of sect. 92 (2) of the new Act creating a special Court for the hearing of certain specified classes of cases under the Act will not apply, and the application need not therefore be made to any particular judge.

If the application to rectify be the answer to an action for infringement, the course is to take out a summons in the action, or to move to rectify. The application is often not heard as a motion, but is ordered to be placed in the list of witness actions (*b*). If there be no action pending, the application, if made by summons, must be made by originating summons (*c*).

Particulars of objections will generally be ordered and interrogatories will also be allowed, and that against either party, in a proper case (*d*).

§ **109.** Notice of any application under the section is required to be given to the Comptroller, who has the right to appear and be heard thereon.

Four clear days' notice of every application is required to be given to the Comptroller (*e*). As a rule, all persons who are affected should be served in the ordinary way prescribed for a motion or summons; but as no special procedure is prescribed by the Acts or rules as to service on parties of notices of application to expunge a design, it has been said that if such notice of the intended application be given "as natural justice requires" it will

(*a*) Forms of notice of motion are given in Appendix B., *post*, p. 401.

(*b*) This was done in (*e.g.*) *Re Read & Greswell's Design*, *supra*, and in *Re Bach's Design*, *supra*.

(*c*) (1893) Ord. LIV. r. 4 (b), (c), (d).

(*d*) *In re Buyer's Design* (1906), 23 R. P. C. 553.

(*e*) Rule 95.

suffice (*f*). It is not necessary to obtain preliminary leave of the Court; but leave may, if desired, be obtained on an *ex parte* application (*g*).

In *Re King & Co.'s Trade Mark* (*h*), where the registered proprietor of a trade mark was domiciled in Ireland, and could not be served with notice of motion, it was held sufficient to send him a copy of the notice, with a letter informing him that proceedings had been commenced which might affect his interest. Kay, L.J., said: "The Act has left, and I think designedly left, as free a hand as possible to the Courts which have to entertain these applications under the Act in respect of procedure."

§ 110. The order for rectification (*i*) must direct that due notice of the order be given to the Comptroller (*k*). And the person in whose favour the rectification is made must forthwith leave at the Comptroller's Office an office copy of the order (*l*). The register must thereupon be rectified, or the purport of such order otherwise duly entered in the register, as the case may be (*m*). When the rectification is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree or other authority for the rectification is to be served on the Comptroller, and he must rectify the register accordingly (*n*). If a name is to be removed, the register is rectified by striking out the name and adding, "By order of the Court of , dated, &c., this name has been erased." Whenever such an order is made the Comptroller, if he thinks that the effect of the order should be made public, may advertise a notice of it in the official journal (*nn*).

There is an appeal from the decision of the High Court

(*f*) *Re King & Co.'s Trade Mark* (1892), 9 R. P. C. 350; and see *Re Compagnie Générale d'Eaux Minerales Trade Mark*, 10 R. P. C. 446.

(*g*) *In re Robertson, Sanderson & Co.'s Trade Mark*, 9 R. P. C. 215.

(*h*) See note (*f*) above.

(*i*) See Forms, *post*, p. 401.

(*k*) (1907) Sect. 72 (4).

(*l*) Rule 96.

(*m*) *Ibid.* In the case of goods in the Manchester Classes, the entry in the Manchester Register must also be altered. (Rule 86.)

(*n*) (1907) Sects. 94 (7) and 95 (3). As to the meaning of "required," and generally as to the effect of these provisions, see *Charles Bayer* v. *Connell* (1897), 14 R. P. C. 275.

(*nn*) Rule 97.

to the Court of Appeal on any application ur the section; and for purposes of procedure it is treat an appeal from a final order (*o*).

In *Re Bayer's Design* (*p*), rectification being refused, the applicants appealed and applied to the Court of Appeal for leave to adduce fresh evidence on the hearing of the appeal, on the ground of surprise at the trial. Leave was given to adduce such evidence by affidavit, with answering evidence by the respondent; with liberty to cross-examine witnesses on the hearing of the appeal.

§ **111.** The new Act contains a further provision (*q*) for cancellation of the registration of a design at any time on the ground that the design is used for manufacture exclusively or mainly outside the United Kingdom. This modifies the law under the old Act (sect. 54) by which the copyright *ceased* if the design was used in any foreign country and not used in the United Kingdom within six months of its registration. The application for cancellation may be made by any person; but it is provided that where such an application is made the provisions of the Act with respect to the revocation of patents worked outside the United Kingdom (*including those relating to costs*) shall apply with the necessary modifications.

These incorporated provisions are contained in sects. 27 and 39 of the Act, which provide that—

(1) On an application for revocation the Comptroller shall make inquiry, and if satisfied that the allegations contained in the application are correct, he may (unless the registered owner proves that the article is manufactured *to an adequate extent* in the United Kingdom, or gives satisfactory reasons why it is not) make an order of revocation either forthwith or after such reasonable interval as may be specified in

(*o*) See *Re Rivière's Trade Mark*, 26 Ch. Div. 48. For other matters relating to rectification, cf. sect. 35 of the Companies Act, 1862, and the notes thereon in Buckley on the Companies Acts.

(*p*) (1906) 23 R. P. C. 553.

(*q*) (1907) Sect. 58 (1).

the order, unless again it is shown to his satisfaction that in the meantime the article has been manufactured within the United Kingdom to an adequate extent, or the owner gives satisfactory reasons why it is not so manufactured, in which case the Comptroller may extend the period mentioned in the previous order for a further period not exceeding twelve months. (Sect. 27.)

(2) The Comptroller shall in such proceedings have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the Court; and if the applicant neither resides nor carries on business in the United Kingdom he may be required to give security for costs of the proceedings, and in default of such security the proceedings may be treated as abandoned. (Sect. 39.)

Every case arising under these provisions will have to be considered on its own merits, and particular circumstances by the Comptroller, to whom an almost unlimited discretion is given in the case of designs, as no appeal is given from his decision (*r*).

§ 112. The Rules provide that an application for cancellation under this section is to be commenced by lodgment of a request, bearing a 1*l.* stamp, asking that the registration may be cancelled on the ground stated in the section and giving an address for service in the United Kingdom. A copy is to be served on the proprietor, who must, within fourteen days, or such further time as the Comptroller may allow, leave at the Patent Office, and also deliver to the applicant, evidence by way of statutory declaration stating whether the allegations contained in the application are correct, and if incorrect to what extent, and in what place the design is used for manufacture

(*r*) Sect. 58 (1). See notes to this section in Part II., *post*, p. 238 *et seq.*

in the United Kingdom. The applicant may file evidence in answer to this, and no further evidence is then to be filed except by leave, and subject to such conditions as the Comptroller may think fit. The Comptroller will thereupon appoint a time for the hearing of the case, and give the parties ten days' notice of the appointment; and in the event of his deciding to take evidence *viva voce*, or to allow cross-examination on the declarations, he may require the attendance of any declarant or other person whose evidence he may consider desirable (*rr*).

Any person may apparently make the application, and the provision applies to all designs now on the register as well as to any which may be registered under the new Act (*s*).

§ **113.** Sect. 52 (3) of the Act provides that the register of designs shall be *primâ facie* evidence of any matters by the Act directed or authorised to be entered therein.

Sect. 79 makes sealed copies purporting to be certified by the Comptroller evidence in all Courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals. Such certified copies, sealed with the seal of the Patent Office, are to be given to any person who requires them, on payment of the prescribed fee (*t*). And a certificate purporting to be under the hand of the Comptroller as to any entry, matter, or thing which he is authorised by this Act or by any general rules made thereunder to make or do, is *primâ facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone (*u*).

§ **114.** Falsification of the register, or of documents purporting to be copies of the register, or using any such documents, is made a misdemeanour (*v*).

(*rr*) Rules of 1908, Nos. 70—75.
(*s*) See sect. 98 (2) and notes thereon, *post*, p. 285.
(*t*) (1907) Sect. 67. For fee, see Schedule I. to the Rules, No. 19, *post*, p. 319.
(*u*) (1907) Sect. 78, Rule 67. For application for certificate, see Form No. 22, *post*, p. 385.
(*v*) (1907) Sect. 89 (1).

CHAPTER VII.

THE PROPRIETOR.

(*The full references to all the Reports will be found in the Table of Cases ante.*)

§ 115. Definition of "Proprietor."
§ 116. Persons who may be Proprietors.
§ 117. The Author of the Design.
§ 118. Persons employing Authors—Commissioned Works.
§ 119. Persons acquiring a Design—*Lazarus* v. *Charles*; *Re Guiterman's Design*.
§ 120. Persons acquiring Right to Apply—*Nevill* v. *Bennett*.
§ 121. Licensees—*Jewitt* v. *Eckhardt*.
§ 122. Evidence of Title on Licenses and Assignments.
§ 123. Remedies of Unregistered Proprietors—*Hole* v. *Bradbury*; *Ihlee* v. *Henshaw*.
§ 124. Distinction between License and Written Consent.
§ 125. Necessity of Registration to complete Title.
§ 126. License or Assignment by part Proprietor—*Lauri* v. *Renad*.
§ 127. Devolution on Death.
§ 128. Equitable Proprietorship.
§ 129. Effect of Bankruptcy.

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§ 115. The registration is to be made on the application of any person claiming to be the "proprietor of any new or original design" (*a*), and in sect. 93 a definition of these words is given. It runs as follows:—

> "Proprietor of a new and original design,"—
>
> (a) Where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed; and
>
> (b) Where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and

(*a*) (1907) Sect. 49 (1).

(o) In any other case, means the author of the design: And where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

§ 116. There are, therefore, five classes of persons who may be considered proprietors: (1) the author of the design; (2) any person who employs the author to execute the work for good consideration; (3) any person acquiring the design either exclusively of any other person or otherwise; (4) any person acquiring the right either exclusively or otherwise to apply the design to any article; (5) any person on whom the design or these rights may devolve.

§ 117. As to who is the "author" of a design no definition is given by the Act, and there is little direct judicial authority on the subject (*b*). The analogy of other copyright productions, where design or invention is the principal factor in the creation of a work, will here be of considerable assistance. If a person merely suggests the idea of the work to another, he can scarcely claim to be the "author" (*c*); but the case is different where he not only suggests the idea, but has a share in or actually superintends the execution of the work (*d*).

"The term 'design,'" says Mr. Curtis (*e*), dealing with the question of engraving copyright, "means the visible form given to the conception of the mind, and must be done by the inventor himself." But the inventor of the subject of an artistic design, although himself unable to draw, may nevertheless be properly

(*b*) See, however, the cases of *Nevill* v. *Bennett* (1898), 15 R. P. C. 412, and *Pearson* v. *Wilkinson* (1906), 23 R. P. C. 738, cited *infra*.

(*c*) *Shepherd* v. *Conquest* (1856), 17 C. B. 427.

(*d*) *Hatton* v. *Kean* (1859), 8 W. R. 7; *Springfield* v. *Thame* (1903), 19 Times L. R. 650.

(*e*) Curtis on Copyright, p. 145.

regarded as the "author" if he supplies all the material from which the design is produced and only has the drawing done by another person.

Thus, in *Stannard* v. *Harrison* (*f*), where a war map was in question, the ideas and material for which had been provided by the plaintiff, the Vice-Chancellor said: "That the plaintiff cannot draw himself is a matter wholly important if he has caused other persons to draw for him. He invents the subject of the design beyond all question. He prescribes the proportions and the contents of the design; he furnishes a part of the materials from which the drawing has to be made in the first instance, and afterwards collects daily from the proper sources accounts of the different phases of the war. These he communicates to the man whom he has employed to make a drawing for him. . . . Can there be anything more plainly within the words of the Act of Parliament (*g*) than that Mr. Stannard did himself invent, that he did procure another person to design and draw for him and do that which he himself could not do?"

In *Nottage* v. *Jackson* (1883) (*h*), the question arose as to who was the "author" of a photograph within the meaning of the Art Copyright Act (*i*), and the definition of the Master of the Rolls (Lord Esher) was: "It is the person who effectively is, as near as he can be, the cause of the picture which is produced"; Cotton, L.J., said: "In my opinion 'author' involves originating, making, producing as the inventive or master mind, the thing which is to be protected whether it be a drawing or a painting or a photograph"; and Bowen, L.J.: "The 'author' is the man who really represents or creates, or gives to the ideas or fancy, or imagination, the local habitation —the man, in fact, who is most nearly the effective cause of the representation" (*k*).

In the matter of designs, the only case bearing directly on this question is the recent one of *Pearson* v. *Wilkinson* (*l*), in which a question arose as to the authorship of a design for the shape of a new body for perambulators, and it was held that the person who drew the original rough sketch of

(*f*) (1871) 24 L. T. 570. See *Kenrick* v. *Laurence* (1890), L. R. 25 Q. B. D. 99; and *Petty* v. *Taylor*, [1897] 1 Ch. 465.

(*g*) 7 Geo. III. c. 38.

(*h*) L. R. 11 Q. B. D. 627.

(*i*) 25 & 26 Vict. c. 68.

(*k*) And see *Wooderson* v. *Tuck & Sons* (1887), 4 Times L. R. 57; *Melville* v. *Mirror of Life Co.*, [1895] 2 Ch. 531.

(*l*) (1906) 23 R. P. C. 738.

the shape desired, which, coupled with the verbal instructions, proved sufficient for the workman to work by, was the "author" of the design. In giving judgment for the plaintiff Kekewich, J., said: "Then is Mr. Pearson the original designer; is the novelty his? That was questioned in the opening of the motion, but on the evidence it seems to be quite clear that Mr. Pearson made the rough sketch which I hold in my hand, and on which he made some remarks. He gave the size of it in inches and he gave some rough instructions. Then he sent for Mr. Harry Eaton and told him to make a perambulator according to that sketch. . . . What is important is that Eaton with the sketch and the verbal instructions produced the very thing that Mr. Pearson intended to be produced. He took it back to Mr. Pearson and he at once approved it. There was no alteration, no going backwards and forwards; once the article was produced it was also approved as being the thing Mr. Pearson wanted. Eaton may have slightly improved on Mr. Pearson's instructions; that is quite possible; but the article which he made was the article which Mr. Pearson wanted to be made. So that I have every condition fulfilled, and the article here is really the invention, as regards design, of Mr. Pearson."

This case runs on all fours with the copyright case of *Stannard* v. *Harrison*, before quoted, and the result may therefore be taken to be that the originator of a design will be regarded as the "author" whether he actually draws it or not, provided he not only gives the ideas, but actually furnishes the materials for, or superintends the execution of, the work (*m*).

§ **118.** For practical purposes the question is partly, but only partly, covered by cases coming within (2), *i.e.*, where the author is employed "for good consideration," but in such cases the consideration must, of course, be proved. It is, in fact, frequently disputed, and then the question of authorship is of primary importance.

In *Re Heinrich's Design* (*n*), the applicant, D., moved to rectify the register by striking out the name of H. as the registered owner of a design for a writing table, and for the insertion of his own name as proprietor, on the ground that

(*m*) See also *Nevill* v. *Bennett* (1898), 15 R. P. C. 412.

(*n*) (1891) 9 R. P. C. 73. See *In re Grocott's Design* (1899), 17 R. P. C. 139, where in similar circumstances, variation of the entry of proprietorship was ordered, there being, however, no opposition.

ho, D., had in the previous year invented the design, and in order to have it carried out had employed H., whom his firm had been in the habit of employing in making similar articles of furniture. He told H. what he wanted him to do, and H. carried out that design, but not in a way which D. approved, and therefore there were several alterations and various modifications till it was at last approved. Subsequently, without any consent on D.'s part, H. registered the design in his own name, and the question was whether, under the circumstances, he ever was the proprietor, as D. was either the author of the design or was entitled as proprietor, having paid H. for the work he did in carrying it out. It was contended on the part of H. that he was an independent author, and that he supplied things of his own design, and conducted an independent business. Romer, J., in giving judgment, said: "This is a mere question of fact. It is a case where clearly the respondent H. made this desk and sold the desk in the ordinary way of business as a desk; but *prima facie* he was the maker for D. of the desk, and by selling the desk, of course, he did not sell any right to the design. I think H. was the inventor of this design for all substantial purposes, though it is quite possible that the nature or kind of article that was wanted by D. was indicated by him."

§ 119. The normal case to which (2) applies is that referred to by Malins, V.-C., in *Luzurus* v. *Charles* (*o*), where he said: "I take it that where a person is engaged in any ornamental business, and has a workman in his employ under him who makes a design which is new and original, that design would become the property of his master by virtue of the relations that exist between them." The same case shows the limits within which the claims of persons demanding registration under (3), *i.e.*, as having acquired the design for good consideration, will be allowed.

The plaintiffs had seen a design in a shop in Frankfort, and they entered into a contract with the designer and manu-

(*o*) (1873) 42 L. J. Ch. 507. As regards the rights of a master to the book in which his servant has entered his inventions, see *Makepeace* v. *Jackson* (1814), 4 Taunt. 770. And for similar questions arising under the Art Copyright Acts, see *Levi* v. *Champion* (1887), 3 Times L. R. 286; and *R. Tuck & Sons* v. *Priester* (1887), L. R. 19 Q. B. D. 48 and (on appeal) 629.

> facturer at Frankfort, to purchase from him baskets of the design in question, which they imported into this country. The Vice-Chancellor decided that they were not proprietors. He said: "Here it is admitted that the plaintiffs are not the designers of the article, and though they stated in the original bill that they were the designers, a different version is given of the plaintiffs' right in their subsequent affidavit, and it now turns out that they saw the design in a shop at Frankfort, and that they brought it over to this country; but they state that they entered into an agreement with the manufacturer at Frankfort that they would purchase these baskets from him. This shows at once that the plaintiffs are not entitled to any merit of invention; they only did as anyone else might do, that is, they purchased the articles, but they gave no consideration to entitle them to be the proprietors of the design under the terms of the Act, for the agreement to purchase the articles from the manufacturer can form no consideration within the meaning of the statute. Therefore they are not the designers of the article, nor are they entitled to be the proprietors by virtue of having purchased the design for valuable consideration. That is, in my opinion, a fatal objection to the plaintiffs' title."

§ 120. As to (4) a person acquiring the right to apply the design is a proprietor, whether he uses the right exclusively of any other person or otherwise.

In *Neill* v. *Bennett* (*p*), the plaintiffs had prepared a design for textile goods suitable to the Persian market on materials supplied to them by one Foliadi, a dealer in Constantinople, who, having approved the design, gave the plaintiffs orders which they executed, and they limited the use of that design to Foliadi for the Persian market, although it was their property, and for their sole use as they pleased in any other market. In giving judgment, Hall, V.-C., said: "The defendants say that under these circumstances the plaintiffs are not the proprietors. Now, assuming that Foliadi was the author of the design, it seems to me that for a good and valuable consideration the plaintiffs acquired the right in that design. The design actually printed was the result of the collaboration of Foliadi and the plaintiffs, which resulted in that suitable working practical design, and under those circumstances the plaintiffs did become proprietors of the design under sect. 61 (of the Act of 1883)."

(*p*) (1898) 15 R. P. C. 412.

§ 121. Licensees also may be registered as proprietors (*q*), and unless they are so registered they cannot proceed under the Act against infringers (*r*). But a person engaged as exclusive agent for sale with power to register the designs in his own name for protection, is not entitled to registration as proprietor, when there is given no right to manufacture in accordance with the design, or to apply the design to goods manufactured elsewhere.

In *Re Guiterman's Design* (*s*), the sole agent of a foreign firm for the sale of articles of a novel design, who was authorised to apply for registration of the design in his own name, but to whom an assignment of the design or the right to apply the design to goods had not been given, was held not to be the proprietor of the design.

In *Jewitt* v. *Eckhardt* (*t*), by a verbal contract made in July, 1877, C., an American manufacturer, purported to sell to the plaintiff the exclusive right to sell in England an article newly designed and then about to be manufactured, and also to obtain such protection for the same as he could do under English law, it being stipulated that the plaintiff should obtain the article exclusively from C.: by the same contract C. agreed to sell to the plaintiff the first twenty cases of the article for the price agreed upon, which was to cover both the right and the goods. In September, 1877, the cases were delivered in England to the plaintiff, who paid the money due under the contract. Meanwhile, in August, 1877, the plaintiff had obtained registration of the design under 5 & 6 Vict. c. 100, and the copyright therein was granted to him for the term of three years. In an action to restrain the alleged infringement by the defendant of the plaintiff's copyright: held, on the evidence, that the plaintiff had not acquired under the contract the right to apply the design to a manufactured article, so as to entitle him to register it in his own name under the Act: held, also, that the plaintiff's right (if any) to protection could not have accrued till the completion of the purchase.

(*q*) *Jewitt* v. *Eckhardt* (1878), 8 Ch. Div. 404.

(*r*) *Woolley* v. *Broad* (1892), 9 R. P. C. 208. But see *Raphael Tuck & Sons* v. *Canton* (1882), 51 L. J. Q. B. 363, an Art copyright case.

(*s*) (1886) 55 L. J. Ch. 309.

(*t*) (1878) L. R. 8 Ch. Div. 404.

§ 122. Under the old Acts it was generally held to be necessary to registration of assignees or licensees that the assignment or license should be in writing (*u*). But the Act of 1883 contained no similar provision to that in the 1842 Act (*v*), which referred in terms to "any writing purporting to be a transfer of such design and signed by the proprietor thereof," as operating as an "effectual transfer," and provided a statutory form of transfer for such operations. The rules of 1890 did not insist on the production of a written assignment, and, on the contrary, they contained provisions (*w*) which appear to have contemplated cases where registration of proprietorship might be claimed and effected on other evidence, without the production of any such document. The same observations apply to the new Act and the rules thereunder, which repeat these provisions (*x*).

It may, therefore, be doubted whether the old authorities on this point have any longer any binding effect (*y*), and whether the general rule of the common law, that a parol assignment is sufficient to pass personal property, does not apply in the case of designs (*z*) in the absence of any statutory provision making a writing essential (*a*). It is submitted that a person who has obtained an unregistered design, by gift or otherwise, is not prevented, by the absence of a written transfer, from

(*u*) *Jewitt* v. *Eckhardt*, *supra*.

(*v*) Act of 1842, sect. 6.

(*w*) Rules of 1900, Nos. 23 and 29.

(*x*) Rules of 1908, Nos. 46, 48 and 62.

(*y*) The observation of Wright, J., in *Woolley* v. *Broad* (1892), 9 R. P. C. 208, to the contrary was only *obiter*, and there is no direct decision on the point.

(*z*) Designs are expressly referred to as "personal property," and they are transmitted and devolve accordingly (Act of 1907, sect. 71 (3)).

(*a*) See Copinger on Copyright (Edit. 1905), p. 142, and the case of *Longman* v. *Oxberry* (1820) (a patent case) cited in Godson on Patents, p. 314. In *Crossley* v. *Dixon* (1863), 10 H. L. Cas. 293, it was held that a license to use a patent may be verbal.

applying, under sect. 40, as a person "claiming to be proprietor" for registration of the design.

§ 123. The remedies for infringement given by the Act(*b*) are expressly conferred on "registered proprietors," and a person who is not registered cannot therefore proceed under the Act(*c*). But it may be doubted whether this would exclude an unregistered proprietor (*e.g.*, an assignee who had not registered his assignment under sect. 52) from obtaining relief other than that specially given by the Act.

> Thus, in *Hole* v. *Bradbury* (*d*), it was held that the plaintiffs, not having been the registered proprietors of the copyright claimed on at the time when the copies complained of as infringements were printed, were not entitled to have them delivered up for their benefit under the 23rd section of the Literary Copyright Act, 1842; but that the Court had power, under its general jurisdiction, to order delivery up for destruction of all articles created in violation of the plaintiffs' rights. Fry, J., in giving judgment, said: "It must be observed that the words of the section seem to be clear to show that the only person who is entitled to maintain the action of detinue or trover for the copies is a person who is the registered proprietor. That appears from several passages in the section. The very first words which introduce it, 'all copies of any book wherein there shall be copyright, and of which entry shall have been made in the registry book,' appear to me, on the face of them, to refer to an entry made in the registry book at the time of the creation of the copies; and then the section goes on throughout to speak of the registered proprietor as the person who is entitled to the right . . . . In my judgment the plaintiffs, not having been the registered proprietors at the time of printing this book, are unable to maintain their right to have these copies delivered up to them for their own benefit under the 23rd section. There remains this question: whether there is any authority in the Court, independently of the statute, to cause to be delivered up any copies which may have been printed even to a person who is not the registered proprietor at the time they were printed, simply from the general jurisdiction of the Court to order delivery up for destruction of all articles which have been

(*b*) (1907) Sect. 60.
(*c*) See *Liverpool Brokers' Assn.* v. *Commercial Press*, [1897] 2 Q. B. 1.
(*d*) (1879) L. R. 12 Ch. Div. 886.

created in violation of the plaintiffs' rights. It appears to me that there is distinct authority in favour of that view. I find that in the case of *Prince Albert* v. *Strange* (*e*), the Court ordered the delivery up of the copies which had been there piratically printed to the Record and Writ clerks for the purpose of destruction; and I find that in the case of *Kelly* v. *Hodge* (*f*), which was before Vice-Chancellor James in 1870, before the passing of the Judicature Acts, the Court ordered delivery up to the plaintiffs for the purpose of destruction—a delivery up which could not have been under the 23rd section of the Act, because that section gave an express action at law, and did not enlarge the jurisdiction of the Court at all. I bear in mind, further, the analogy to the numerous cases which have arisen where the defendant has violated either the patent rights of the plaintiff, or the right to the trade mark of the plaintiff, or, as in the case of *Emperor of Austria* v. *Day* (*g*), the sovereign rights of the plaintiff. In all those cases the Court has delivered up the copies for destruction."

In *Cooper* v. *Whittingham* (*h*), where the action was brought under the Literary Copyright Act, 1842, for "importing for sale," contrary to the provisions of the Act, and an injunction was claimed, Jessel, M.R., said: "There was a point not insisted upon, but mentioned during the course of the argument. It was said that the 17th section of the Act created a new offence of importation, and enacted a particular penalty; and it was argued that where a new offence and a penalty for it had been created by statute, a person proceeding under the statute was confined to the recovery of the penalty, and that nothing else could be asked for. That is true as a general rule, but there are two exceptions. The first of the exceptions is the ancillary remedy in equity by injunction to protect a right . . . . The second exception is that created by the Judicature Act, s. 25, sub-s. 8, which enables the Court to grant an injunction in all cases in which it shall appear to the Court to be just or convenient. This section may be said to be a general supplement to all Acts of Parliament."

In *Ihlee* v. *Henshaw* (*i*), where a trade mark had been registered by H. & Co., and had subsequently been assigned to I. and then to I. and S., who brought an action to prevent the use of the trade mark without having registered either of the assignments, North, J., said: "I think

(*e*) 2 De G. & Sm. 652.

(*f*) (1870) cited Seton, Vol. I. p. 668.

(*g*) 3 D. F. & J. 217.

(*h*) (1880) L. R. 15 Ch. Div. 501.

(*i*) (1886) L. R. 31 Ch. D. 323. And see *Magnolia Metal Co.* v. *Atlas Co.* (1897), 14 R. P. C. 389.

that the Act contemplated registration from time to time where an assignment took place; but I do not find anything in the words of the Act making such registration of the assignment a condition precedent to the right to sue . . . . I cannot, in the absence of a statutory provision to that effect, say that an assignee is not entitled to sue unless not only the trade mark but the assignment also is registered."

§ 124. The above observations and authorities apply equally to licensees, who come within the definition of "proprietors" under sect. 93 of the Act. But there is an additional doubt as to the necessity of a writing in the case of licenses, which is introduced by the wording of sect. 60, which prohibits the application of a design "without the license or *written consent* of the registered proprietor." •

In *Griffith* v. *Hughes* (*j*) it was held that the words "in writing" in sect. 6 of the Trustee Act, 1888, providing for indemnity to a trustee who has committed a breach of trust, "at the instigation or request or with the consent in writing of a beneficiary," apply only to "consent" and not to "instigation" or "request," and that a trustee who had acted at the instigation of a life tenant, though without any written consent, was entitled to indemnity. Kekewich, J., said: "It is common ground that there is nothing here in writing. It is equally common ground that the payment was made at the request of the married woman who is the beneficiary. Is that request, which was presumably by parol only, no writing having been proved, sufficient to bring the case within the statute? . . . . There may be good ground for the distinction between a consent, which is to be given in writing, and an instigation or request which need not be in writing; and seeing that, grammatically, the section will bear the construction which I think ought to be given to it, I hold that the words 'in writing' apply only to consent, and are not applicable to instigation or request."

§ 125. An assignment or license cannot be registered until the original proprietorship has been registered.

In *Jewitt* v. *Eckhardt* (*k*), Jessel, M.R., said: "It would have this very singular consequence if you could. If a license by the author or the sole proprietor of a design be granted before

(*j*) [1892] 3 Ch. 105. (*k*) (1878) L. R. 8 Ch. Div. 404.

registration, and the licensees had a right to register and to publish, nobody else could register it afterwards, and the original proprietor would lose his right, which would be a singular result. Wherens, if the provision of the Act is, as I think it is, to have registration on the part of the author and proprietor before he grants out the partial interests, then there is no difficulty, because every man who gets a partial interest registers under the 6th section (of the Act of 1842), and that grant must be in writing."

§ **126**. Where the proprietorship is vested in more than one person a license by one will not affect the rights of the others(*l*); but any one or more of the co proprietors may assign his or their interests in the copyright, and the assignee may register such transfer and maintain an action for infringement of the entire copyright.

In *Lauri* v. *Renad* (*m*), in March, 1879, the brothers L. acquired the dramatic copyright in a French play, and in 1886 two of the brothers died. Subsequently the plaintiff took an assignment from the three surviving brothers L. of all their rights in the play, and in February, 1902, he registered himself as the proprietor of all such rights. The defendants contended, *inter alia*, that the plaintiff had no right to sue, no title having been acquired from all the owners, and the ownership of a copyright in several persons, being a tenancy in common and not a joint tenancy. In giving judgment, Kekewich, J., said: "The title might be good if there was a joint tenancy, in which case the right would survive to the others. But it is not a joint tenancy: that has been finally decided, I think, once for all in the case of *Powell* v. *Head* before Sir G. Jessel, and it must be considered as now settled law. Registered owners of a copyright are tenants in common, and they are tenants in common of a peculiar kind. It is impossible for us English lawyers dealing with the English language to express our views, except in the technical language of our law; but it is not perhaps accurate even to call such owners tenants in common, and the Master of the Rolls took care not to call them simply tenants in common; he calls them 'tenants in common or part owners.' And there are or may be many differences and distinctions between tenants in common and part owners as regards their

(*l*) *Powell* v. *Head* (1879), 12 Ch. D. 686.
(*m*) [1892] 3 Ch. 402.

rights *inter se* and in respect of strangers. He not only decided that, but he also expressed a strong opinion 'that one part owner could not either lend or deal with the entirety of the property without the authority of the other part owner.' That at first sight seems to be a blot on the plaintiff's title, but Mr. Warmington's answer to it is, I think, sound. He says: 'We may not have the complete title to the whole property, but we are as part owners, entitled to, at any rate, the three-fourths, taking the assignment as being that of three out of four (and the argument is equally applicable if there were two out of four, or the same number out of five or more), in that character we are entitled to sue as for trespass, to prevent a stranger interfering with our rights—the rights which belong to us, it may be in common with others, for which we may be accountable to others, and which may be possibly to some extent defeated if that stranger can set up a title through others. But so long as we are suing a stranger so long as we are preventing interference with that, of which we are part-owners, we are right and can maintain our action.' That argument proceeds strictly on the analogy of the law from which tenancies in common and part ownership came, and I think it would be departing from an analogy, which is perhaps more strictly applicable than analogies often are, to say that the plaintiff fails on that ground. So far, therefore, I do not think the objection to the plaintiff's motion prevails."

§ **127.** On the death of the proprietor, the property in the design, being personal property, goes to his personal representatives, and they become the proprietors. In disputed cases the burden of proving proprietorship is on those who claim it (*n*).

§ **128.** It is also to be noted that, though notices of trusts affecting the proprietorship cannot be received by the Comptroller (sect. 66), any document which creates an equitable proprietorship, though not amounting to a legal assignment, may be entered on the register, and will entitle the equitable owner to all the rights (qualified or absolute, as the case may be) of a registered proprietor (*o*); and, by a proviso to sect. 71, it is declared

(*n*) *Hothersall* v. *Moore* (1892), 9 R. P. C. 27. And see *Re Heinrich's Design* (1891), 9 R. P. C. 73.

(*o*) *Stewart* v. *Casey* (1892), 9 R. P. C. 9. See also sect. 71.

that any equities in respect of the design may be enforced in like manner as in respect of any personal property.

§ 129. In case of bankruptcy of a registered proprietor, the property in the design passes to his trustee(*p*), and this would probably be the case notwithstanding a transfer of the copyright if the registration were still allowed to stand in the name of the original proprietor(*q*), unless some steps had been taken to take the property out of the "order and disposition" of the bankrupt (*r*). If the design has not been registered, the right to register it also devolves on the trustee, who becomes proprietor under the Act (*s*).

(*p*) Act of 1907, sect. 93 (definition of "Proprietor").

(*q*) *In re Dilworth* (1833), 1 Deac. & C. 411; *Longman* v. *Tripp* (1805), 12 N. R. 67.

(*r*) See Bankruptcy Act, 1883, s. 44.

(*s*) Act of 1907, sect. 71. Per Jessel, M.R., in *Jewitt* v. *Eckhardt*, *supra*.

CHAPTER VIII.

MARKING.

(*The full references to all the Reports will be found in the Table of Cases ante.*)

§ 130. Statutory Requirements as to Marking.
§ 131. Application of the Rules.
§ 132. Differences between the old and repealed Acts and the Act of 1907.
§ 133. Mere Desire and Intention to Mark ineffectual—Proviso in favour of Proprietor taking proper Steps.
§ 134. Illustrative Cases—*Woolley* v. *Broad*; *Re Rollason's Design*, &c.
§ 135. Failure of Co-proprietor to Mark—*Welekind* v. *General Electric Co.*
§ 136. Failure of Licensee to Mark.
§ 137. Wearing out or Removal of Mark—*Fielding* v. *Hawley*.
§ 138. Method of Marking—Paper-hangings (*Heywood* v. *Potter*)—Trimmings (*Blank* v. *Footman*)—Dusters (*Hothersall* v. *Moore*)—Cuff-links (*Re Morton's Design*).
§ 139. Irregularities in Marking—Addition of other Marks (*Harper* v. *Wright & Butler*).

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§ 130. Before the Act of 1907, every protected design must not only have been registered, but every article to which it was applied must have been marked in order to secure the statutory copyright. By sect. 51 of the Act of 1883 it was provided that—

> "Before delivery on sale of any article to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words or figures, denoting that the design is registered; *and if he fails to do so the copyright in the design shall cease*, unless the proprietor shows that he took all proper steps to ensure the marking of the article."

This provision still applies to all designs published before the coming into operation of the new Act, as if a copyright has once ceased through neglect of the statutory provisions it cannot afterwards be renewed by any

retrospective operation of the Act (*a*). The Act of 1907, however, modifies the law by providing (*b*) that the only effect of failure to mark copies shall be that—

> The proprietor shall *not be entitled to recover any penalty or damages* in respect of any infringement of his copyright in the design unless he shows that he took all proper steps to ensure the marking of the article, or unless he shows that the infringement took place *after the person guilty thereof knew or had received notice* of the existence of the copyright in the design.

This assimilates the law affecting designs to that applicable to patents, except that the onus of proving knowledge (in the absence of marking) is thrown on the plaintiff. The result of non-marking of copies is no longer forfeiture of the copyright, but only inability to claim the special remedies given by the Act, unless actual knowledge of the existence of the copyright can be proved against the infringer.

The new Act further provides (*c*) that the Board of Trade may, by rules under the Act, dispense with or modify any of the requirements as to marking as regards any class or description of articles, subject to such conditions as they think fit.

§ 131. The old rules (*d*) prescribed that the proprietor should, if the article was included in any of the Classes 1 to 12, cause the article to be marked with the abbreviation "R.," and if the article was included in Classes 13 or 14 (*e*), cause each such article to be marked with the abbreviation "REG^{D}." On any article in Classes 1 to 12 other than lace the number appearing on the certificate

(*a*) See Act of 1907, sect. 98 (2); and the Copyright cases *Moul* v. *Groenings*, [1891] 2 Q. B. 443; *Hanfstaengl Art Publishing Co.* v. *Holloway*, [1893] 2 Q. B. 1; and *Schauer* v. *Field*, [1893] 1 Ch. 35, decided on the retrospective provisions in the International Copyright Act, 1886.

(*b*) Sect. 54 (1) (b).

(*c*) Sect. 54 (2). The only special provision in this respect in the Rules of 1908 is Rule 68, exempting lace and goods in the Manchester Classes from the general obligation to affix the number as well as the registration mark.

(*d*) Rules of 1893, No. 32.

(*e*) For details of the classes under the new Rules, see *ante*, p. 20.

of registration must also be placed. The Act had to be construed strictly (*f*). But it was decided under it that if an article in Classes 1 to 12 was marked "REG^D.," the copyright in the design was not lost, inasmuch as the greater included the less (*g*). These provisions have been modified by the new Rules (*gg*), which require that the proprietor of the design shall cause each article to be marked with the word "REGISTERED," or with the abbreviations "REG^D.," or "R^D.," as he may choose; but this of course only applies to goods first delivered on sale after the coming into operation of the new Act.

Under the 1883 Act the copyright would be lost, and now the statutory remedies will be stopped for want of marking, even though the sale be made abroad, and though, apparently, the article be also made abroad (*h*). And though but one article be sold without a mark, the same results will follow (*i*). The fact that the proprietor is a foreigner trading abroad, as well as in England, will make no difference (*j*).

§ **132.** Under 5 & 6 Vict. c. 100, it was provided that the mark must be upon every article to which the design was applied "after publication" of the design (*jj*). This was modified by the 1883 Act, which provided that the mark must be upon the articles only "before delivery or sale," and the same wording has been preserved in the present Act. The difference would seem to be that whereas exhibiting a design without a mark (*e.g.*, exhibition by travellers with a view to getting orders) would have caused a forfeiture of copyright under the earlier Acts, under the present law that action or even the distribution of samples without sale will not cause forfeiture.

(*f*) Per Giffard, V.-C., in *Pierce* v. *Worth* (1868), 18 L. T. N. S. 710.
(*g*) *Heinrichs* v. *Bastendorff* (1893), 10 R. P. C. 160.
(*gg*) Rules of 1908, No. 68.
(*h*) *Saruzin* v. *Hamel* (1863), 32 L. J. Ch. 380.
(*i*) *Hunt* v. *Stevens* (1878), W. N. 79.
(*j*) *Saruzin* v. *Hamel*, *supra*. (*jj*) Sect. 4.

The Act of 1907 further provides expressly (*d*) that the disclosure of a design by the proprietor to any other person in such circumstances as would make it contrary to good faith for that other person to use or publish the design (which would be the case on a more submission of samples), and, as regards textile designs, even the acceptance of a first and confidential order on goods bearing a new design intended for registration shall not be deemed a publication of the design so as to invalidate the copyright.

§ **133.** But mere desire and intention to comply with the Act will not avail, if as a fact the article is delivered on sale unmarked. Nor will the proviso "unless the proprietor shows that he took all proper steps to ensure the marking of the goods" protect, unless proper precautions are taken to secure the order for marking being carried out.

§ **134.** The above rules are illustrated by the following cases:—

In *Pierce* v. *Worth* (*e*), under the old Acts, it was decided that a proprietor who had ordered from a maker plates with the proper words and numbers, but who had sold an article before the plates had arrived, had lost his copyright (*e*). Even the proviso would not protect in such a case.

In *Woolley* v. *Broad* (*f*), W., the registered proprietor of a lace design, agreed to sell to W. & Co., and did sell, lace manufactured by him according to the design, in the brown or unfinished state; W. & Co. were to have the exclusive right to sell the lace manufactured according to the design in the finished state. W. & Co. agreed to register the design in W.'s name, and to mark the lace before putting it on the market. Lord Coleridge held that the transaction between W. and W. & Co. amounted to a "delivery on sale," and that the lace being unmarked, the copyright in the design had been lost. It further appeared that the lace was never sold retail in the brown state, that on finishing the lace goes through several processes, and that if a ticket with the registration made were put on the brown lace, it would have to be taken off during

(*d*) (1907) Sect. 55.
(*e*) (1868) 18 L. T. N. S. 810.
(*f*) (1892) 9 R. P. C. 429.

the finishing operation, otherwise it would be destroyed. And it was proved that the agreement was that W. & Co. should see to the proper marking before putting the lace on the open market. Nevertheless it was decided that the plaintiff had not brought his case within the proviso.

In *Wittman* v. *Oppenheim* (*g*), the proprietor instructed the manufacturer to stamp the proper mark upon the articles, and furnished him with a die, but the manufacturer by inadvertence stamped them with another die, and the proprietor sold some of the articles without observing the error; Pearson, J., decided that the copyright was not lost, and that the proprietor was protected by the proviso, the letters "R^{D}." being stamped on the article, though the numbers were incorrect.

In *Johnson* v. *Bailey* (*h*), two designs for earthenware teapots were registered; on the bottom of each teapot was a raised parallelogram with some marks thereon which could not be deciphered, but which were said by the proprietor of the design to be "R^{D}." and the number. It further appeared that the teapots were made in moulds which had at the bottom a hollow parallelogram with "R^{D}." and the figures embossed. The mould was liable to wear out. The proprietor had given precise instructions to his workmen that each teapot should bear the prescribed mark, and he believed that his instructions had been carried out. It was decided that the proprietor had not done sufficient to bring his case within the proviso; it was not sufficient to prove general instructions; he should have seen that his instructions were carried out, either by inspection of each teapot, or in some other manner. The Court of Session added that it was not possible to give any definition of general application of the meaning of the words of the statute, "all proper steps to ensure the marking of the article." "Every case," said the Lord Ordinary, "must be judged according to its own special circumstances, and it is in such case a jury question whether the proper steps have been taken."

In *Re Rollason's Design* (*i*), it was proved that a considerable number of articles to which the design had been applied had been marked with the No. 252,908, instead of No. 232,908, the mistake having originated in a stamping die; but the plaintiff gave evidence to show that he had taken all proper steps to ensure the correct marking of the articles. Held by Kekewich, J., on the hearing of the motion, that the design must be expunged for want of novelty; but, on the other point, that R. had established that he had taken all steps that

(*g*) (1884) 54 L. J. Ch. 56.
(*h*) (1893) 11 R. P. C. 21.
(*i*) (1897) 14 R. P. C. 893, 909; and on appeal to the House of Lords, 15 R. P. C. 44.

could reasonably be required of him to ensure proper marking. Held, on appeal, that the design, being limited to pattern, was novel, and that the decision of the Court below as to the marking was correct; and the order to expunge was therefore reversed. In giving judgment in the Court of Appeal, Lindley, M.R., said: "Then there is the other point about the 51st section, which I had forgotten for a moment. It turns upon a mistake which was made by the die-sinker in putting a 5 for a 3. . . . The learned judge in the Court below thought Mr. Rollason brought himself within the last part of that section. I think so, too. . . . I think his instructions to the die-sinker were quite right. He gave him the proper number and he did not observe the slip. The slip was made in one plate only, out of a great many, and it was corrected as soon as it was discovered. I think it would be very lamentable if we were to hold that sect. 51 did not cure a defect by an unintentional slip such as that." And in the House of Lords a similar view was expressed by Lord Herschell.

§ 135. It is the duty of the proprietor to put the mark upon the article, and this applies, of course, where there are co-proprietors, so that any sale by one of the proprietors of the article without the registration mark would formerly cause forfeiture of the entire copyright and now affect the right to either penalty or damages.

In *Wedekind* v. *General Electric Co.* (*k*), the defendants pleaded that A. and K., by whom the design was originally registered, had, before the assignment of the design to the plaintiff, sold to the defendants a number of telephones of the plaintiff's design and patterns for the purpose of resale by the defendants, which were not marked as prescribed by the Act. They also alleged that the A. Company, of which A. and K. were directors, granted to the defendants a license to manufacture and sell telephones, which were in part made of the plaintiff's patterns and designs, without any stipulation that such telephones should be marked with a mark or figure denoting that the design was registered, and the defendants had, to the knowledge of A. and K., manufactured and sold telephones of such design under this license without any such mark. The defendants contended that, on these facts, the copyright in the design had ceased. Held, by Charles, J., that at least one case was proved of a sale by A. to the defendants of a telephone which was not marked (and pro-

(*k*) (1897) 14 R. P. C. 190.

bably others by A. and K.), and that in any event this was an act of one of the partners which affected the firm; that it was clear there was acquiescence by both A. and K. in sales by the defendant under the license of unmarked articles; that by such conduct A. and K. had lost their copyright under sect. 51 of the Act, unless they could show that they had taken all proper steps to ensure the marking of the article; that A. and K. had certainly failed to show that; and the action was accordingly dismissed.

§ 136. Under the old Acts the interest of the person who published without the mark was alone affected by the want of marks (*l*). But the Act of 1883 and the present statute contain no such provision, and it is doubtful whether a forfeiture may not be created through the omission of the mark by a licensee who, under sect. 93, comes under the description of "proprietor" within that Act. The better opinion, however, seems to be that the proprietor of the full copyright may claim protection under sect. 54 if he can show that he has taken reasonable steps to secure marking by the licensee notwithstanding any default by the latter (*m*).

§ 137. If the mark be properly placed on an article, the copyright will not be affected though the mark be removed by any person, *e.g.*, a purchaser, not being the proprietor (*n*); nor though the mark has become illegible.

In *Fielding* v. *Hawley* (*o*) it was decided that if during the process of manufacture, *e.g.*, by firing and glazing, the mark becomes in some cases illegible, it having been properly there originally, the protection is not lost. But if the mark has never been properly applied the case is different (*p*).

§ 138. The manner in which the mark should be applied sometimes raises difficult questions. The provisions of

(*l*) Act of 1842, sect. 4.

(*m*) Per Charles, J., in *Wedekind* v. *General Electric Co.*, *supra*.

(*n*) Per Coleridge, J., in *Heywood* v. *Potter* (1853), 22 L. J. Q. B. 133; *Surazin* v. *Hamel* (1863), 32 L. J. Ch. 380.

(*o*) (1883) 48 L. T. N. S. 639.

(*p*) See *Johnson* v. *Bailey* (1893), 11 R. P. C. 21.

sect. 54 (2) of the new Act enabling the Board of Trade to modify, as regards any class or description of articles, the requirements as to marking may meet some of these difficulties, but, subject to any special regulations which may be issued under this section, the following rules represent the law as it now stands on the subject:—

(1) The marks may be put on by making the same in or upon the material itself, or, where this is not practicable, by attaching thereto a label with the marks upon it (*q*). (2) The article sold is alone the thing to be marked (*r*). (3) If the article is sold in long strips, each strip must be marked; if it be sold in small pieces (even though the pieces be used only as samples) each piece must be marked (*s*). (4) The mark must be on that part of the article to which the design is applied, and not on any part of it which is not registered, unless the two are so attached as to be practically inseparable parts of the same article (*t*).

The cases cited as illustrative of the above rules are—

Fielding v. *Hawley* (*r*). A design was registered for a butter-dish and cover, the cover being separate from the dish, and the entire design being upon it; the dish was marked. It was held that this was sufficient, inasmuch as the dish and cover together formed the article sold (*u*).

De la Branchardière v. *Elvery* (*r*). The plaintiff, the registered proprietor of a registered design for lace collars, published a book containing copies of the design. It was decided that the non-marking of the copies in the book was not a breach of the requirements of the statute, which made marking of the "articles" compulsory.

(*q*) *Blank* v. *Footman* (1888), 5 R. P. C. 653. This was expressly provided by sect. 4 of the Act of 1842.

(*r*) *Fielding* v. *Hawley* (1883), 48 L. T. N. S. 639; *De la Branchardière* v. *Elvery* (1849), 18 L. J. Ex. 381.

(*s*) *Heywood* v. *Potter* (1855), 22 L. J. Q. B. 133; *Hothersall* v. *Moore* (1892), 9 R. P. C. 27; *Ingram* v. *Edwards* (1904), 21 R. P. C. 463.

(*t*) *In re Morton's Design* (1899), 17 R. P. C. 117; *Lea & Perrins* v. *Price* (1904), 22 R. P. C. 122.

(*u*) But see Farwell, J., in *Re Morton's Design*, *supra*, on this case, and *Lea & Perrins* v. *Price*, *supra*.

Heywood v. *Potter* (*v*). The designs in question were applicable to paper-hangings, and the plaintiff had sold unmarked patterns. The ordinary custom was to sell paper-hanging in pieces of twelve yards each, and the plaintiff had caused the proper mark to be placed upon each piece of twelve yards, but not upon the patterns which had been cut off from the twelve yards pieces. The patterns were sold. Lord Campbell, C.J., and Wightman, J., considered that the plaintiff had not complied with the Act as regards marking; Coleridge, J., was of a contrary opinion, though he admitted that the patterns were articles of manufacture within the literal sense of the Act, and that the Designs Acts are to be construed strictly (*x*). The view of the majority of the Court agrees with the judgment in *Fielding* v. *Hawley* (*y*), where Field, J., said: "If a manufacturer takes a large piece and cuts it up into smaller pieces as samples or otherwise, then of course each must be marked." Under the present Act this would be so only if the samples were sold.

Blank v. *Footman* (*z*). The design was one for trimmings; there was no mark upon the trimmings, but they were sold in pieces of 144 yards in length, and round each piece was a label bearing the proper mark. This was held to suffice. Kekewich, J., said: "It has not been argued that the trimming itself ought to be marked, and it would be impossible, and it is admitted that it would be impossible, to say where and how often it should be marked. It is obvious that you could not mark every quarter of an inch, and that even if you could do it, you could not in lace work like this preserve the thing if you were to stamp it with marks. Therefore it is not suggested that this ought to be done, but it is said that every article, however small, ought in some way to show that it is a registered design. That to my mind is entirely a misconstruction of the 51st section. The Act may or may not go far enough, but the Act says that a mark is to be placed before delivery on sale of any articles to which a registered design is to be applied. The marking is to be caused to be done by the proprietor of the design. If the proprietor of this design does not sell those articles of dress to which the trimmings are affixed, the section lays no liability upon him to mark those articles of dress. What is to be marked by him is the article to which a registered design has been applied—that is the trimming. If he sells it in pieces of 144 yards he must mark the pieces of 144 yards. If, on the other hand, he

(*v*) (1855) 22 L. J. Q. B. 133.

(*x*) *Pierce* v. *Worth* (1868), 18 L. T. N. S. 710; and see *Johnson* v. *Bailey* (1893), 11 R. P. C. 21.

(*y*) *Supra*.

(*z*) (1888) 5 R. P. C. 653.

sell small pieces, whether for patterns or for use, he must mark each small pattern in some manner in which those things can be conveniently marked, as, for instance, by tying on a label or by printing something on the packet in which it is. But he is not bound to mark any thing but that which he sells."

Hothersall v. *Moore* (*a*) was a case relating to a design for dusters. The dusters were made up into pieces which could be cut up into twelve dusters, and a gummed label, having upon it the proper mark, was attached to each piece. As it was proved that the piece was intended to be cut up into twelve dusters, Bristowe, V.-C., came to the conclusion that there were twelve articles in each piece and not one, and that the marking was defective. There might be some difficulty in following the decision so far, for the registration was of the piece, the goods were sold by the piece, and the piece was marked. It might, therefore, well be argued that the article sold had the mark upon it. But it seems that the piece was made with the intention that it should be cut into twelve pieces and so sold, and the Court found as a fact that the proprietor himself was actually cutting up these pieces into individual dusters, and was having them hemmed and prepared for sale. The decision amounted to a finding of fact that the so-called pieces were in reality twelve articles.

In *Re Morton's Design* (*b*) the design was for the shank of a cuff link, and the mark was put on the link and not on the shank itself, and this was held to be insufficient within the section, Farwell, J., saying: "You really have a double misleading if you put your stamp of registration on that part of the article which you sell which is not registered. You not only do not represent to the public that the portion which is registered is protected, but you invite the public to believe that that which is not protected is protected. There is no doubt some little difficulty, because I feel, to some extent, the force of the case referred to against this contention (*Fielding* v. *Hawley*), but that was under a different Act; and I think probably the distinction turns on the wording of the Act of Parliament."

In *Ingram and Kemp* v. *Edwards* (*c*) the plaintiffs had registered two designs for gas brackets and pendants, and claimed against the defendants, as manufacturers, for alleged infringements of the designs. The defendants denied infringement, and pleaded anticipation and defective marking, the regis-

(*a*) (1892) 9 R. P. C. 27. (*b*) (1895) 12 R. P. C. 283.

(*c*) (1904) 21 R. P. C. 463. For illustration of the design herein showing mode of marking, see Appendix F., Sheet 4, p. 426.

tration mark being on the cup attached to the bracket, which was not a novel part of the design. The jury found infringement of the design for the pendant but not of the bracket, and that the bracket "would not have been a complete article without the cup"; and judgment was given for the plaintiffs accordingly, with an injunction.

Lea and Perrins v. *Price* (*d*). In 1902 the plaintiffs registered a design in Class 1 for a lamp head to be attached to arc gas lamps, the design being for shape and configuration. The registration mark had not been affixed to the lamp head, but to a metal ring at the base of the glass globe which was fitted into it, which was common to the trade and formed no part of the registered design, and it was admitted that the plaintiffs' lamp head might be made up without this ring by using a different globe. Held, that the mark prescribed by sect. 31 was intended to show what part of the article it was that was protected, and that the marking applied by the plaintiffs failed therefore to comply with these requirements and the copyright had ceased.

In directing the jury Channell, J., said: "So far as the question of marking is a question of law for me, I am going to hold that it is not sufficient to mark the ring. The marking of the ring might very possibly do where the design was claimed for the whole article, or where the design was claimed for the pattern of the ring; but when you are claiming only for the pattern of the head, which is a different part, nobody would understand, by your putting the mark on the ring, that you intended to claim the registration of the design of the head."

The jury were unable to agree on the other points submitted, and on this Channell, J., gave judgment for the defendants.

§ 139. If the requisite mark is properly applied the addition of other marks which do not strictly refer to the portion of the article on which they appear will not affect the validity of the marking, or deprive the owner of the benefit of the registration, on the ground of misrepresentation.

In *Harper* v. *Wright and Butler* (*e*) the defendants contended that the plaintiffs had sold their stoves with registration

(*d*) (1904) 22 R. P. C. 122. For illustration of the design herein showing mode of marking, see Appendix F., Sheet 6, p. 428.

(*e*) (1895) 12 R. P. C. 483.

marks referring to other designs not applicable to the stoves, and that this was calculated to mislead and deprived the plaintiffs of their remedy.

In concurring with the other judges in dismissing this contention, Rigby, L.J., said: "Even if he put a reference to the register upon a thing which it was impossible to suppose that he thought to be covered by that registration, it may be provided for (I have not referred to the Act) in some way by penalties or otherwise; but the Act does not say that, even in a strong case like this, he should forfeit his protection for the design actually registered, and I cannot find that we have—even if we wish to introduce any such clause—any jurisdiction to do so" (*f*).

(*f*) See also the judgment of Lord Herschell, C., in the same case as to excessive claim generally; and see *Re Bayer's Design* (1906), 23 R. P. C. 553, per Warrington, J., on the same point, confirmed by Vaughan Williams, L.J., in the Court of Appeal (1907), 24 R. P. C. 65.

CHAPTER IX.

STATUTORY COPYRIGHT AND ITS INFRINGEMENT.

(The full references to all the Reports will be found in the Table of Cases ante.)

§ 140. Effect of Registration—Term of Original Copyright and Conditions for Renewals.
§ 141. Statutory Provisions as to Infringement.
§ 142. Differences in position of Manufacturers and Vendors of Pirated Designs—*Smith* v. *Lewis, Roberts & Co.*; *Brittain* v. *Kennedy*.
§ 143. Position under the old and repealed Acts and Act of 1907.
§ 144. Notice required to affect a Vendor.
§ 145. Liability of Agent as Infringer.
§ 146. Rights of Buyers from a Licensee—*Cooper* v. *Stephens*.
§ 147. Classes of Infringements—None unless Sale intended.
§ 148. Imitation of Design—*Barran* v. *Lomas*; *Thom* v. *Sydall*.
§ 149. Obvious Imitation—*Harper* v. *Wright and Butler*.
§ 150. Fraudulent Imitation—*Grafton* v. *Watson*; *Sherwood* v. *Decorative Art Tile Co.*
§ 151. Infringement a question of Fact—Test of the Eye—State of Knowledge—Star-chain Case (*Holdsworth* v. *McCrea*)—Lace Cases (*Barran* v. *Lomas*; *Birkin* v. *Pratt*; *Oliver* v. *Thornley*)—Kitchen-range Door (*Walker* v. *Hecla Foundry Co.*)—Light-house (*Staples* v. *Warwick*).
§ 152. Attempts to Imitate without Infringing—*Nevill* v. *Bennett*; *Holden* v. *Hopkinson*.
§ 153. Intention Immaterial.
§ 154. Imitation of Purpose or Utility no Infringement.
§ 155. Novelty and Infringement.

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§ 140. The registered proprietor has "the exclusive right to apply the design to any article in any class in which the design is registered" (*a*). And this extends to "any article of manufacture and any substance artificial or natural, or partly artificial and partly natural" (*b*). During the existence of the copyright, therefore, the registered proprietor is entitled to the statutory remedies for every infringement of his rights.

(*a*) (1907) Sect. 93, definition of "Copyright."
(*b*) *Ibid.*, definition of "Article."

The statutory copyright is given (*c*) (1) for an absolute term of five years from the date of registration; (2) for a second period of five years from the expiration of the original term if, within the prescribed time (*i.e.*, one week at least) before such expiration, application for an extension is made to the Comptroller and the prescribed fee (1*l.*) paid (*d*); (3) for a third period of five years from the expiration of the second term if, within the prescribed time (*i.e.*, not less than six, nor more than twelve, months) before such expiration, application for an extension is made to the Comptroller and the Comptroller allows the extension subject to payment of the prescribed fee (1*l.* 10*s.*) (*e*). Upon an extension of the term of copyright, it is to be advertised in the official Journal.

§ **141.** To determine what is infringement, reference must be made to the terms of the Act, which run as follows (*f*):—

> During the existence of copyright in any design it shall not be lawful for any person—
>
> (a) For the purposes of sale to apply or cause to be applied to any article in any class of goods in which the design is registered the design or any fraudulent or obvious imitation thereof, except with the license or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or
>
> (b) Knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article without the consent of the registered proprietor to publish or expose or cause to be published or exposed for sale that article.

§ **142.** These provisions make a very considerable dis-

(*c*) (1907) Sect. 53. See notes to this section, *post*, p. 229.

(*d*) See Rules of 1908, Nos. 37 and 38, as to the time and manner of application and the fees payable, and Form 8 in Appendix B., *post*, p. 378.

(*e*) This second extension will only be granted subject to the provisions of the new Rules Nos. 39 and 40. See Forms 9, 10 in Appendix L, *post*, p. 379.

(*f*) (1907) Sect. 60 (1).

tinction between infringers dependent upon whether they be manufacturers of the article or merely vendors. In the former case innocence or want of knowledge is not an excuse, in the latter case it is.

§ **143.** Under the Act of 1842 it was forbidden to publish, sell, or expose for sale, "after having received, either verbally or in writing, or otherwise from any source other than the proprietor of such design, knowledge that his consent had not been given, or after having been served with a written notice, signed by such proprietor or his agent to the same effect" (*g*).

In *Norton* v. *Nicholls* (*h*), it was decided under this that a notice from the proprietor was not sufficient unless it expressly stated that the proprietor of the design had not given his consent to the application of the design, and whether the proprietor intended to sue in respect of the application of the design to an article of manufacture, or for the sale of such article with the design applied; and it was held that the notice should have specified the real claim intended to be made.

Under the Act of 1883 and the present Act an express notice is not required; it is sufficient to constitute a piracy by a vendor if the vendor can be in any way shown to be aware that the proprietor has not given his consent to the use of the design in question. But the case just mentioned is valuable as an example of the kind of knowledge that must be proved to exist.

The sub-section (b) is intended to protect a retail dealer, or dealer selling goods and not being himself the manufacturer of them, so that if he sell goods of which he has no knowledge that they are registered he does no wrong; but if he sells them after knowledge is brought home to him that the designs are registered and that the proprietor is not an assenting party to their sale by him he may become liable (*i*).

(*g*) 5 & 6 Vict. c. 100, s. 7.
(*h*) (1859) 28 L. J. Q. B. 225.
(*i*) *Smith* v. *Lewis, Roberts & Co.* (1888), 5 R. P. C. 611, 614.

In *Smith* v. *Lewis, Roberts & Co.* (*h*), the facts were these: On 17th May, 1887, the plaintiff's solicitors wrote to the defendants, "Mr. Robert Smith informs us that it has come to his knowledge that you have in your warehouse exposed for sale, and have been in the habit of selling, Leno canvas striped goods, the patterns of which have been registered by our client. On his behalf we have to request you, within seven days from this date, to supply us with a full statement showing the quantity of goods which you have sold, the quantity you have in stock and the name of the manufacturer. If this information is not given within the time mentioned, our instructions are to commence an action against you forthwith." Some of the goods were sold for the defendant on 21st May, he being then away from business, but on his return he stopped the sale; it was, however, not till 6th June, after the commencement of the action, when an inspection of the designs claimed on took place, that the defendant became convinced that he had been dealing in goods of the plaintiff's registered design, and he at once returned the goods to the manufacturers. Bristowe, V.-C., found for the defendant, on the ground that the notice was too vague, as it did not contain any pattern of the design, nor state any detail of what was claimed. He said: "In this case the retail dealer is selling goods for a considerable period of time, and he had no claim made against him on the ground that the goods were registered goods at all. In order to bring the case within the Act of Parliament, I think it must be necessarily shown that the retail dealer knew at the time of the exposition for sale that the design applied to the goods exposed for sale was applied without the consent of the registered proprietor. Now, surely it is necessary that the person giving the first notice should give such a notice, if it is in writing at all, as to be intelligible to the person charged, so that he may know what is alleged against him. . . . . He must have the particular thing explained to him which it is claimed has the right of registration."

Brittain v. *Kennedy* (*i*) was a somewhat similar case, which arose under the Sculpture Copyright Act, 1814 (54 Geo. III. c. 56). The plaintiff was the owner of copyright under the Act in a brass model bust, and sued the defendant for infringement by "exposing for sale" a specimen which he had shown to a wholesale importer for toys, asking for orders to supply him with model busts of the same character. On behalf of the

(*h*) *Supra*. The case of *Wittmann* v. *Oppenheim*, *contra* (1884), 27 Ch. Div. 260, was referred to and distinguished.

(*i*) (1902) 19 Times L. R. 122.

defendant it was contended that there was no "sale" or "exposure for sale" within sect. 3 of the Act, and that the Court would not grant an injunction under sect. 1, where only a single instance of an infringement of a right was proved and there was no threat to repeat it, or where damages were an adequate remedy.

Wright, J., in giving judgment for the defendant, said it appeared to him that the evidence did not amount to any overt act under sect. 3. There was not the slightest evidence that the defendant made any other attempt to sell beyond showing the sample and asking for orders, or that he knew that the copy was an infringement. It was clear that the defendant had not "caused to be exposed." The only model which had been proved to have been shown was a sample, and the words "exposed for sale" referred to the exposure of particular articles; therefore sect. 3 did not apply. Under sect. 1 all the defendant did was to make a single offer to manufacture articles for sale, and after being warned he desisted. It was not a case in which an injunction could be properly granted.

§ **144.** The result seems to be that a vendor who has not actually applied the design to goods, but who is a mere seller of such goods, will not be liable to the penalties for piracy unless it can be shown that he was publishing or selling with knowledge of the facts; and knowledge will not be imputed to him on the strength of the receipt of a complaint unless it clearly specifies the design alleged to be infringed. On the other hand, there is no statutory requirement of a written notice, and a seller will certainly not be allowed to escape, even if he received no direct notice at all, if the Court is of opinion that he had other knowledge that the goods he is selling are infringements of a registered design.

The above observations apply only to the statutory right, and the right to restrain further infringements under the equitable jurisdiction of the Courts will not be affected by these considerations (*k*).

§ **145**. A person acting as agent for another may be liable as an infringer for publishing or exposing for sale

(*k*) *Wittmann* v. *Oppenheim* (1884), L. R. 27 Ch. D. 260. As to the cases in which an injunction will be granted, see *post*, § 162 *et seq.*

goods to which the design has been applied, if he is aware that the proprietor has not given his consent (*l*). And the new Act introduces a special provision making persons who "do anything with a view to enable the design to be so applied" liable to the penalties for infringement; this provision meets the case of a person preparing dies or moulds of a registered design in this country for manufacturing abroad, which, under the old Act, was held not to be an infringement (*m*).

§ 146. If the proprietor grants a license to make goods to which the registered design has been applied, vendees from the licensee do not infringe if they in turn sell the articles, though they know that the registered proprietor has not given his consent to their so doing. The licence involves consent to sale by vendees of the licensee (*n*). But this will not be extended so as to cover any user of the registered design which was not contemplated by the license.

In *Cooper* v. *Stephens* (*o*) the plaintiffs were designers of designs for carriages and were the registered owners of the copyright under the Act 5 & 6 Vict. c. 42, in the catalogues in which they published their designs. Their course of business usually consisted in supplying copies of their designs to coach-builders, ready printed on sheets for inclusion in their catalogues for advertising purposes. But if the coach-builders desired to print these designs themselves, they sold electros of their designs to the coach-builders for this purpose. Having sold electros of two of their designs in this way to L., the latter afterwards allowed the defendants to use them for printing advertisements in their own business.

Held, that there was no assignment of the copyright in the two designs to L., but only a limited license for use in his own business, and that L. had no power, by disposing of the electros, to authorise the defendants to make use of them in another business, and so affect the plaintiffs' copyright. In

(*l*) *Moet* v. *Couston*, 33 Beav. 578; *Upmann* v. *Elkan*, 7 Ch. 130; *Nobel's Explosives Co.* v. *Jones* (1880), 17 Ch. D. 721, 742 (affd. 8 App. Cas. 4).

(*m*) *Potter* v. *Braco de Prata Printing Co.* (1891), 8 R. P. C. 218. See the concluding words of sect. 53, sub-sect. (a), which are new.

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

(*o*) (1895) 77 L. T. 390.

giving judgment, Romer, J., said: "The effect of the sale of the blocks to Lilley was, in my judgment, to authorise him personally to print therefrom and use the copies for the purposes of his advertisement and trade. It did not authorise anyone else to print or publish copies and, in my judgment, certainly did not enable Lilley to authorise the defendants, as against the plaintiffs, to print and publish the two drawings in question. Lilley, in fact, had a license from the plaintiffs, which was not assignable by him. The defendants try to make out that the sale of the blocks had the effect of conferring on Lilley the copyright in the blocks, and not merely a license to use them. But I cannot see how that is established. The copyright was previously existing in the plaintiffs, and the sale of the blocks could not have had the effect of an assignment of copyright; and, indeed, I am satisfied that the meaning and intent of the transaction, as between the plaintiffs and Lilley, was that the sale of the blocks should authorise Lilley personally to print therefrom for the purposes of his advertisement and trade, and should confer no other rights upon him, and have no other operation or effect."

In *Marshall* v. *Bull* (*p*) the plaintiffs were wholesale mantle makers, and having published a catalogue of their designs for the winter season 1898, supplied and sold to E. & W., who were their customers, nine electro blocks of the illustrations for reproduction in their catalogue. E. & W. disposed of them to P. & Sons, who printed the catalogue for another customer containing the same designs. The plaintiffs thereupon registered their catalogue under the Copyright Act, 1842, and claimed an injunction and delivery up of the blocks. In giving judgment, Byrne, J., said another point taken was that the purchasers of the blocks might use them as they pleased. That depended entirely upon the bargain made when the sale took place; and it did not appear to him that, in point of law, under circumstances such as the present, the bargain was to be construed otherwise than as a licence to use for a particular purpose, merely because, in order to allow that licence of user to be made use of, a block, or means of copying, was supplied to the person to whom the licence was granted. The plaintiffs were entitled to an injunction and delivery up of the blocks.

§ 147. The section points to six classes of infringement, all subject to the general condition imported by the words "for the purposes of sale," and they are: (a) application of the design; (b) application of any fraudulent imitation of the design; (c) application of

(*p*) (1900) 16 T. L. R. 501; and on appeal, 17 T. L. R. 684.

any obvious imitation of the design (*q*); (d) causing any of the three preceding acts to be done; (e) doing anything with a view to enable any of such acts to be done; and (f) knowingly publishing or exposing any article to which the design has been improperly applied.

The Act forming a complete code as to actions for infringement(*r*), it follows that unless the application of the design falls in one of these classes, there is no infringement within the statute. Hence there seems to be nothing to prevent an imitation of a design unless the purpose for which the imitation is made be the sale of the article to which the design is applied.

But where the design is applied to goods for purposes of sale, it does not matter that they are not intended to be sold until after the term of copyright protection has expired, and goods so manufactured will be ordered to be given up to the owner of the copyright for destruction(*r*). And the Courts will sometimes interfere by way of injunction on the ground of breach of a right of property, even where no sale is threatened or intended.

§ 148. "Imitation" is a word used in different senses. Taken in the sense of an actual copying of the design, every imitation is undoubtedly an infringement. But there may be a fair imitation where the original design is used as a basis, but it is accompanied by original work of such character and extent as to create a new design, so that the old design and the new design are different substantially, and in such a case there is no infringement.

In *Thom* v. *Sydall* (*s*) it was said by Wickens, V.-C., that the mere fact that defendants had worked upon the plaintiff's

(*q*) This was a new provision in the Act of 1883; "obvious" imitation was not mentioned in the old Act, 5 & 6 Vict. c. 100, s. 7.

(*r*) *Woolley* v. *Broad* (1892), 9 R. P. C. 208.

(*s*) (1872) 26 L. T. N. S. 15.

design constituted no case to show that patterns registered by sample had been infringed by the defendants.

In *Barran* v. *Lomas* (*t*), Jessel, M.R., said that a fair imitation of an original kind is not an infringement.

§ **149**. An "obvious imitation" is such an imitation as would strike the eye in such a way as to produce the impression (which may be corrected, if need be, by expert evidence) of having been clearly taken from the original design (*u*). To test this, the designs need not be put side by side (though that is one element of comparison); it is permissible to look first at one and then at the other, *i.e.*, to consider what would be the effect supposing they were seen at different times, or to look at them both a little distance off. If, then, they seem the same, so much so that from memory they are indistinguishable, there is an obvious imitation and therefore an infringement.

So there is an obvious imitation if when the designs are used on dress or on furniture, they would, without minute inspection, be taken to be identical. If, on the other hand, on inspection the designs are found to be identical, there would not be an "obvious imitation" but an actual copy (*x*).

In *Harper* v. *Wright & Butler* (*y*), the plaintiff's designs showed an upright stove, hexagonal, with an ornamental window of cathedral type, with tracery above and below, and with a cover of special form with a knob. The defendants' stove was similar in general characteristics, but the window, although of cathedral type, was of a different style, and the tracery was not the same. Kekewich, J., at the trial held, without going into the defendants' case, that there was no infringement, as, though the defendants might have imitated the plaintiff's general idea, they had not taken his registered design. On the hearing of the appeal the de-

(*t*) (1880) 28 W. R. 973.

(*u*) Per Chitty, J., in *Grafton* v. *Watson* (1884), 50 L. T. N. S. 420.

(*x*) *Grafton* v. *Watson*, *supra*; and see *Sherwood* v. *Decorative Tile Co.* (1887), 4 R. P. C. 207.

(*y*) (1895) 12 R. P. C. 283. See the observations of Kekewich, J., in *Hanfstaengl* v. *W. H. Smith & Sons* (1905), 21 T. L. R. 291, in which the previous decisions on what are "copies or colourable imitations" are discussed.

fendants' case was gone into to save a reference back to the Court below; and the Court then held that the defendants had infringed, as they had copied the plaintiff's designs with immaterial differences.

In giving judgment, Horsehell, L.C., said: "Here the two designs have been placed side by side, the eye has been left to judge, and the impression produced upon all the members of the Court has been this, that the one design is an obvious imitation of the other; that in all their essential features they are alike, and that in those essential features they differ, both of them, from anything that has been previously known. Now, better proof than that, that the one design is an obvious imitation of the other, it seems to me, it would be impossible to give. On what ground do the defendants say that the one is not an obvious imitation of the other? They point to the different details—the different parts of the design—and they show in each of the designs differences of detail. They undoubtedly show that, but, to my mind, that has no bearing upon the question whether the one is or is not an obvious imitation of the other. You may produce precisely the same design in all its essential features, though you make differences in all, or almost all, its details.

"The defendants employ a designer, and after putting him in possession of the plaintiff's stove, instructions are given to him to make an original design for a similar article. What was the meaning of giving him the plaintiff's stove, and telling him to make a similar article? Why, it was to be similar in its essential features in that which made it attractive to the public, and in that which made it a good article of commerce; but it was to be original in design, that is to say, although producing a similar article which would appear to the public to be alike, they were to be able to point to originality in all its details. A clearer direction to a designer to make an obvious imitation, it seems to me, it would be difficult to find. I can entertain no doubt, therefore, that in this case one of these stoves is an obvious imitation of the other. I think the learned judge in the Court below erred in considering too much the details as essentials of the design—the designs may be the same, although the details largely differ. The truth is that the defendants took all the essential elements of the plaintiff's design" (z).

A. L. Smith, L.J., said: "If I went into a shop and saw the plaintiff's stove, this cathedral stove, and ordered it, and they

(z) In the recent case of *Hutchisons Ltd.* v. *St. Mungo Manufacturing Co.* (1907), 24 R. P. C. 265, it was held that a design for a golf ball which, though similar in its details to a registered design, would always be readily distinguished from it from all points of view, did not infringe.

sent me home the defendants', I should not have had the slightest idea that I had not got what I had ordered. At a distance, they are entirely similar. One is an obvious imitation of the other. But there is this, I agree: that if they are brought into close proximity, and the tracery and so on is pointed out to us—when the two are together—of course, one can see a dissimilarity between them; but it is such a dissimilarity that, in my judgment, if they were not together, no one could carry it in his head, and, therefore, to say that one is not an infringement of the other is to say what, in my judgment, in the face of the facts in this case, is not, in reality, the truth."

Rigby, L.J., said: "We have simply got to trust to the eye, and looking at the two stoves I am not only satisfied that one is an imitation of the other, but I feel satisfied, quite independently of the evidence—though that, of course, assists the conclusion—that the design of the defendants' would never have come into existence if it had not been for the design of the plaintiff's."

§ 150. A "fraudulent imitation" is imitation with knowledge that the pattern is a registered design, and without any sufficient invention on the part of the imitator (*a*).

In *Baran* v. *Lomas* (*b*), Jessel, M.R., said: "Fraudulent imitation is imitation with knowledge—conscious imitation—the man who imitates having the design before him, and knowingly and wilfully imitating, and his imitation not being sufficiently original to be protected as a fair imitation."

In *Grafton* v. *Watson* (*bb*), where the plaintiffs registered a design producing on calico a particular effect familiar in silk velvet, and the defendant prepared a design which in general arrangement resembled the plaintiffs', and produced a similar effect though there were variations in detail (*e.g.*, where the plaintiffs' design had acorns and sprays the defendant's substituted mangosteens and sprays closely resembling the plaintiffs' in contour), it was held by Chitty, J., that the resemblance being so close as to make it impossible to distinguish the one from the other by memory alone, and there being coincidences between the two designs which would have been strange but for the fact that the defendant's designer had had the plaintiffs' before him, the defendant's design was an obvious imitation. On the defendant's appeal against the injunction, Cotton, L.J., said: "These designs obviously

(*a*) Cotton, L.J., in *Grafton* v. *Watson*, on appeal (1884), 51 L. T. N. S. 141.
(*b*) (1880) 28 W. R. 973.
(*bb*) *Supra*.

were seen by the defendants before they gave instructions for preparing their designs; and it is remarkable that, though there is undoubtedly a certain dissimilarity, yet to the eye there is, as is admitted, such a general similarity as to produce the appearance of imitation, when you hold it at a certain distance. Undoubtedly there are differences, but when one looks at the designs one sees that the places where the light ground is covered with the dark colour in the intervals of what is called the dominant ornament, they are very much the same both in those patterns of the plaintiffs', which are said to be imitated by the defendants, and in the defendants' patterns; and the subordinate arrangement, although entirely old, is so arranged with reference to the dominant as in substance to produce something like a similarity, and that I think upon the evidence is a *primâ facie* case on behalf of the plaintiffs that it is fraudulent. Fraudulent imitation, to my mind, must mean this: if a man, knowing that the pattern is a registered design, goes and imitates it, and does that without any sufficient invention on his own part, that would be a fraudulent imitation, if in fact it is an imitation. There may be an imitation which is unconscious, that is to say, not an imitation in the sense of copying—a producing of the same effects without knowing of the registered design; but when the registered design is known, then, if there is imitation, the burden of proving that the registered design was not copied is, to my mind, thrown on the person who produces the pattern like that which is imitated."

In *Sherwood* v. *Decorative Tile Co.* (*c*), Manisty, J., said: "The conclusion I have arrived at is that it is not an obvious imitation. If so, it resolves itself into the single remaining question whether it is a 'fraudulent' imitation. It may not be easy—I do not say it is impossible—to define in words exactly what is meant by a fraudulent imitation. I think the word was introduced for the very purpose of meeting the case of an imitation—not an obvious imitation, but an imitation varied for the purpose really of perpetrating what is a legal fraud. For instance, having before your mind and before your eye the design of another, and introducing into your design some differences in order, if possible, to avoid coming within the Act of Parliament. . . ." Adopting as part of his judgment the words used by Cotton, L.J., in the previously-quoted case, he added: "Where you find these minor differences alluded to by the Lord Justice, and find what he points out, and which really exist in this case, then there is a *primâ facie* case"; and he found that the defendants' design, though not an obvious imitation, was a fraudulent one and should be restrained.

(*c*) (1884) 4 R. P. C. 207.

§ 151. Infringement is a question of fact and is a matter to be left to the jury (*cc*). Though witnesses may be examined, and should be heard if desired by the parties (*d*), the point is one to be determined by the eye (*e*). It is necessary to prove, not that the imitating article is identical in all respects with the registered article, but that it is to all appearance the same.

The rule is, however, subject to the qualification that the state of knowledge in the particular trade must be taken into account in deciding whether any variations are so substantial as to exclude the charge of infringement.

In *Holdsworth* v. *McCrea* (*f*), Lord Westbury said that, "In the case of those things as to which the merit of the invention lies in the drawing or in forms that can be copied, the appeal is to the eye, and the eye alone is the judge of identity of the two things; whether, therefore, there be piracy or not is referred at once to an unerring judge, namely, the eye, which takes the one figure and the other figure and ascertains whether they are or are not the same." He added that when a pattern is registered as a whole, anything which is a facsimile is an infringement, anything which produces it in its integrity; but that which is different in shape or form, or in the relative positions of the different parts—which is not a reproduction of it—would not be an infringement. The question whether there was any difference in the effect was to be left to the jury.

Dealing with the same case on a subsequent application for damages, Lord Hatherley said (*g*) that what was meant by these words was that "the designer is not bound, as in a patent case, to distinguish the new from the old, and is allowed to register his pattern without distinguishing what is new

(*cc*) As in *Chard* v. *Cory* (1892), 9 R. P. C. 423; *Gordon & Munro* v. *Patrick* (1894), 12 R. P. C. 22; *Ingram & Kemp* v. *Edwards* (1904), 21 R. P. C. 463.

(*d*) In *Mitchell* v. *Henry* (1880), 15 Ch. D. 181, Jessel, M.R., using his own eyes, declined the assistance of outside evidence, but was overruled on that point by the Court of Appeal, who declared the evidence admissible and heard it. But see *Gordon & Munro* v. *Patrick*, *supra*.

(*e*) *Holdsworth* v. *McCrea* (1867), L. R. 2 H. L. 380; *Grafton* v. *Watson* (1884), 50 L. T. N. S. 420; 51 L. T. N. S. 141; *Hecla Foundry Co.* v. *Walker* (1889), 6 R. P. C. 554; *Hothersall* v. *Moore* (1892), 9 R. P. C. 27; *Demartial* v. *Booth* (1892), 9 R. P. C. 499; *Harper* v. *Wright & Butler* (1895), 12 R. P. C. 483.

(*f*) (1867) L. R. 2 H. L. 380, 386.

(*g*) (1870) 6 Ch. 418.

from what is old; but if he chooses to put it in that way, it will not be protected against the public in case they choose to use any portion in any manner substantially differing from the registered design. If the designs are used in exactly the same manner and have the same effect, or nearly the same effect, then, of course, the shifting or turning round of a star, as in this particular case, cannot be allowed to protect the defendants from the consequences of their piracy."

In *Barran* v. *Lomas* (*h*), Jessel, M.R., said: "It is a fair observation to make that when you come to try a case of piracy the first point to be considered is whether the similarity or dissimilarity strikes the eye," and he held that the production of an article containing an alteration which does not substantially change the design is still an infringement; thus, if one register lace worked in the shape of animals and trees with dots between, another designer cannot escape the penalties of infringement if he vend the same design, though with the omission of the dots. But in *Grafton* v. *Watson*, Chitty, J., said: "'Obvious' does not mean that which is obvious at a glance to the uneducated or unskilled eye; it means obvious to the judge or a jury with the assistance of experts—persons conversant with the particular trade" (*i*).

So in *Birkin* v. *Pratt* (*j*), where competing patterns for lace were concerned, Romer, J., held, after hearing expert evidence, that there was no infringement, the difference between the two patterns being so considerable that the one could not be mistaken for the other.

But in *Oliver* v. *Thornley* (*k*), the same judge granted an injunction to restrain a competing lace design which varied in several particulars from the plaintiff's design, "the essential features being taken, and the differences, which were differences in detail, not preventing the two designs from being essentially the same."

In *Walker* v. *Hecla Foundry Co.* (*l*), a further qualifi-

(*h*) (1880) 28 W. R. 973.

(*i*) (1884) 50 L. T. N. S. 422. See *Werner Motors* v. *Gamage's, Ltd.* (1903), 21 R. P. C. 137, as to the nature and extent of the expert evidence which may be admitted. In *Gordon & Munro* v. *Patrick*, *supra*, Cave, J., in directing the jury, said: "It seems to me that no evidence can affect the matter; it is for a plain common-sense man to say, when he looks at these things, whether they are substantially the same or substantially different."

(*j*) (1895) 12 R. P. C. 371. For illustrations of the designs in this case, see Appendix F., Sheet 12, p. 434.

(*k*) (1896) 13 R. P. C. 391. For illustrations of the designs in this case, see Appendix F., Sheet 11, p. 433.

(*l*) (1887) 5 R. P. C. 365; and in the House of Lords (1889), 6 R. P. C. 554.

cation—state of previous knowledge—was added. There the design in question was one for a door for a convertible kitchen-range—a rectangular door with a moulding cast on the top of it. The alleged infringement was a rectangular door surrounded by a moulding, and except that the moulding had a different section from the moulding of the former door, if the doors were represented in a drawing there would be nothing to distinguish the designs; but there was a difference when the doors were looked at in section. It was decided that there was an infringement, and on appeal this was confirmed by the Court of Appeal and again by the House of Lords, where Lord Herschell said: "In such a case (where the protection is granted for the shape and for that alone) the only question is whether the shape of what is impeached is the same, or whether the one is an obvious imitation of the other, without reference to whether it does or does not accomplish the same useful end. . . . It seems to me, therefore, that the eye must be the judge in such a case, and that the question must be determined by placing the designs side by side and asking whether they are the same, or whether the one is an obvious imitation of the other. I ought, perhaps, to qualify this by saying that, as a design to be registered must, by sect. 47, be a 'new or original design, not previously published in the United Kingdom,' one may be entitled to take into account the state of knowledge at the time of registration, and in what respects the design was new or original, when considering whether any variations from the registered design which appear in the alleged infringement are substantial or immaterial. Applying the test which I have laid down, I have come to the conclusion that there has been a violation of the respondents' rights."

This qualification was applied in *Walker* v. *Scott* (*m*), where the plaintiff had registered a tin oil-can for cyclists, rounded at the edges, and the defendant sold an oil-can similar to the plaintiff's save that the edges were sharp. It was decided that since the only novelty in the plaintiff's can was the rounded edges, and as the defendant had not copied these, there had been no piracy.

In *Staples* v. *Warwick* (*n*), S. registered a design consisting of a *conical tower* in the form of a lighthouse, with a spiral slide round it, the design being intended to be applied to a means of popular amusement called a "Helter-Skelter." An interlocutory injunction was obtained against W. for an alleged infringement, and W. afterwards made alterations in

(*m*) (1892) 9 R. P. C. 482.

(*n*) (1906) 23 R. P. C. 609. For illustrations of the designs in this case, see Appendix F., Sheet 3, p. 425.

his tower, making the top castellated. A conical tower with slide round it was old for the purpose. The plaintiff contended that the defendant's tower as altered was still an infringement of his registered design, and obtained an order to commit for breach of the injunction. It was held, by the Court of Appeal, that the defendant's tower as altered had not the only novel feature of the plaintiff's design, viz., the lighthouse, and did not infringe the plaintiff's design, and the appeal was allowed.

In giving judgment, Collins, M.R., said: "Now we come to the question of infringement, which is simply a question of fact upon which one has to be guided by the eye; and when I look at the form, instead of finding a lighthouse I find apparently an ancient machicolated tower, which might be taken from some mediæval fortress, the very last object of which could be to light anybody, and not designed apparently to serve any such purpose at all. Therefore, looking at it as a juryman, I say the essence of the plaintiff's design is a lighthouse, and that is absolutely wanting in the defendant's. Therefore I cannot say that they correspond so exactly as for the defendant's to be an obvious imitation, and an imitation of that part which gives a special peculiarity and originality to the protected design. I find that the two differ in the most essential part, and therefore I am not going to suggest that the appellant has subjected himself to imprisonment by producing a design or executing or building a tower which is not, in point of fact, an obvious imitation of the plaintiff's. For these reasons, I think this appeal must be allowed."

§ 152. It sometimes happens that a trader orders his designer to produce a design after the style of one already registered by a rival trader, but so that it may not infringe that design. If the designer can accomplish this, there is of course no piracy, but if the Court discovers an attempt such as this to sail as near as possible, it will narrowly look into the result, and the burden of proving that there has been no infringement will be heavy upon the defendant (*q*).

In *Nevill* v. *Bennett* (*r*), the plaintiffs were owners of a registered design to be printed or woven on textile goods, and brought an action for infringement, which was denied by the defendants. It was said that all the defendants had done was

(*q*) *Grafton* v. *Watson* (per Cotton, L.J.), 51 L. T. N. S. 141.
(*r*) (1898) 15 R. P. C. 413.

to take the plaintiffs' effect, and there were a number of alleged anticipations which could be developed to produce the same effect.

In giving judgment, Hall, V.-C., said: "The question is, in this case, whether the defendants have taken the plaintiffs' combination or whether they have merely copied the effect. Looking at what was done, that they had the plaintiffs' design before them, that the intention was to imitate as far as they safely could, that the same effect has been produced (one of the defendants himself said, 'ours could not have been produced if the plaintiffs' had not been before the designer'), and that, to the eyes of skilled men and to my own judgment, they have essentially reproduced the plaintiffs' combination, I am of opinion that the defendants have gone inside the line to the extent that they have produced an infringement of the combination, which was the essence of the plaintiffs' design."

Holden v. *Hodgkinson Bros.* (*s*) was an action for infringement of a registered design for tombstones. The plaintiff's design showed a stone 2 ft. 5 in. in height, having on either side an octagonal pinnacle supported by a black porcelain pillar with moulded bases and caps and three black studs; while the defendants' stone was 1 ft. $6\frac{3}{4}$ in. higher, there was a pinnacle on each side of the head-piece supported by a black porcelain pillar, but these were oblong two-sided pinnacles instead of being octagonal. Held, on the trial, that there was no infringement, and that though the defendants might have imitated the plaintiff's general idea, they had not taken his registered design.

In giving judgment, Lawrence, A. T., said: "I quite agree that mere differences of detail will not make the plaintiff fail at all because his design is for the shape and configuration. But to my mind the shape and configuration of these two stones is, from my point of view of art, or beauty, or design, quite different. The relations of one set of lines to the other are all, to my eye, quite different. . . . The two designs seem to me to make totally different looking objects. . . . It is quite possible the plaintiff may be right in supposing that the defendants made their tombstone from an idea suggested by seeing the tombstone of the plaintiff, but it is not sufficient to say that. He must be able to say that the defendants have made something which is an obvious imitation of it."

§ 153. If there be an infringement, *bonâ fide* intention not to infringe will not protect (*t*), though fraudulent

(*s*) (1904) 22 R. P. C. 10. For illustrations of the designs in this case, see Appendix F., Sheet 2, p. 424.

(*t*) Lord Shand in *Walker* v. *Hecla Foundry Co.* (1888), 5 R. P. C. 365, 367; *Mitchell* v. *Henry* (1880), 15 Ch. Div. 181.

imitation will in such case be rebutted. The question of infringement depends upon what a man does, not on what he intends (*u*). The sale of a single article without permission is sufficient to found the action (*x*).

§ 154. The Act does not apply to the things to which a design is applied, but only to the design itself as so applied (*y*), and an imitation of the "utility" contained in a new shape or pattern is no infringement unless the design itself is copied.

> In *Gillard* v. *Worrall* (*z*), the plaintiff was owner of a registered design for gas jets for bakers' ovens, and alleged infringement against the defendants, which they denied.
>
> In giving judgment, Hall, V.-C., said: "It is said that the plaintiff's design has many advantages, that it has the advantage of being out of the way when tins are being put into the oven and being arranged and pushed about inside the oven. I am not trying a patent action, an action of utility; the action is one for infringement of design, and although upon inspection of that design it is evident that advantages follow, and those advantages are not to be overlooked . . . I am of opinion that this is not a new or original design. But even if it is a new and original design, looking at it not as a patent and not as a contrivance for economising the tube required or anything of that sort . . . looking at it as a design, looking at what the plaintiff has done and what he holds out, it seems to me there is a marked difference between the two, to judge by the eye . . . and the defendant's is not an infringement."

§ 155. So far as similarity or identity of designs is concerned, the question of novelty (apart from questions of priority) and the question of infringement raise almost precisely the same kind of considerations, and the decisions dealt with in the chapter on "Novelty" may be referred to here (*a*). Hence an action for infringement

(*u*) *Stead's Patent* (1847), 2 W. P. C. 123, 156.

(*x*) *Cole* v. *Saqui* (1888), 5 R. P. C. 491, 493.

(*y*) Per Lindley, L.J., in *Clarke* v. *Saxe* (*Re Clarke's Design*) (1896), 13 R. P. C. 351.

(*z*) (1904) 22 R. P. C. 76. For illustrations of the designs in this case, see Appendix F., Sheet 1, p. 423. See the observations as to "utility" as an element in deciding as to novelty or infringement in § 42, *ante*.

(*a*) See Chap. III., "Novelty," *ante*, p. 30 *et seq.*

is often met with a motion to expunge from the register for want of novelty the design alleged to have been infringed, and much of the evidence and arguments will apply to action and motion alike (*b*).

In *Re Bayer's Design* (*c*), the difference between the two proceedings was put by Fletcher Moulton, L.J., in the following terms:—"In an action for infringement of a design the counsel for the plaintiff is in the dilemma that if he puts too narrow an interpretation on his claim the defendant is not an infringer, but if he puts too broad an interpretation on his claim it may be held invalid. But when the application is to strike the design off the register the counsel for the respondent is in no such difficulty. It is to his interest to represent the claim as narrow as possible, narrow even to the limit of absolute worthlessness; because, if by any interpretation, however narrow, he can bring it within the limit of a valid registration, he succeeds in the litigation, and when he has succeeded he then may use his design as a valid design, and the exact limit of interpretation by which alone he succeeded in supporting its validity can be known to but few of the public. It is therefore a very different claim when used offensively from what it is when used defensively."

(*b*) *E.g.*, *Le May* v. *Welch* (1884), 28 Ch. Div. 24; *Clarke* v. *Saxe* (*In re Clarke's Design*) (1896), 13 R. P. C. 351; *Morton* v. *Emanuel* (*Re Morton's Design*) (1899), 17 R. P. C. 117; *Rollason* v. *Heath* (*Re Rollason's Design*) (1897), 14 R. P. C. 893–909.

(*c*) (1907) 24 R. P. C. at p. 75.

CHAPTER X.

REMEDIES FOR INFRINGEMENT.

(The full references to all the Reports will be found in the Table of Cases ante.)

§ 156. The Statutory Penalties.
§ 157. Separate Penalty incurred for each offence—*Ex parte Beale; Rivett* v. *Grimshaw.*
§ 158. Award of Lump Sum for Penalties.
§ 159. Principles of Assessment—*Saunders* v. *Wiel.*
§ 160. Alternative Remedy by way of Damages.
§ 161. Assessment of Damages—*Davenport* v. *Rylands; British Motors* v. *Taylor.*
§ 162. Equitable Relief granted in addition to Remedy under Statute.
§ 163. Intention to Infringe sufficient for Injunction.
§ 164. Grounds on which Injunction granted—*Geary* v. *Norton; Procter* v. *Bayley; Werner Motors* v. *Gamage's.*
§ 165. Considerations affecting Applications for Interlocutory Injunction—*Mitchell* v. *Henry; Knowles* v. *Bennett.*
§ 166. Plaintiff's conduct affecting Right to Relief.
§ 167. Delivery up of Pirated Articles—*Hole* v. *Bradbury; Boosey* v. *Wright; Knowles* v. *Bennett.*
§ 168. Certificates of Validity—Costs.

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§ 156. The Act provides (*a*) that any person who infringes shall "be liable for every contravention to pay to the registered proprietor of the design a sum not exceeding fifty pounds, recoverable as a simple contract debt. . . . Provided that the total sum in respect of any one design recoverable as a simple contract debt shall not exceed one hundred pounds."

The power to determine the amount of the penalty rests with the Court, save that a maximum is fixed.

Before the Act of 1888, which introduced this limitation (*aa*), Manisty, J., had a case before him, *Sherwood* v. *Decorative*

(*a*) Act of 1907, sect. 60 (2).

(*aa*) Sect. 7 (2).

Art Tile Co. (*b*), in which the infringers had sold 100 tiles, wrongful imitations of the plaintiff's designs, and he fixed the penalty at 50*l.*, saying that it could not have been meant by the Legislature that on a sale of 100 tiles the penalty should be 5,000*l.*

§ 157. The Act provides that the sum forfeited in respect of any one design shall not exceed 100*l.*; but it is submitted that this does not mean more than that the amount shall not exceed 100*l.* in respect of each design, the infringement of which the accused is found guilty of in the one action, and does not import a license to pirate generally, subject to the liability to pay the maximum penalty.

The old Act of 1842 had an express provision to this effect—"but the aggregate amount of penalties for offences in respect of any one design committed by any one person *up to the time at which any of the proceedings herein mentioned shall be instituted*, shall not exceed the sum of 100*l.*" (*bb*); and under the Copyright Act of George III. (*c*) it was decided, in respect of books, that two penalties might be recovered for infringement on the same day, if the facts of sale were independent and distinct (*cc*).

So in *Rivett* v. *Grimshaw* (*d*), which was an action for infringement of a registered design of a bassinette, evidence was given of the exposure of one copy on the 10th June and sale of another on the 14th October following, and on the direction of the judge the jury awarded the full penalty of 100*l.*, being 50*l.* for each offence.

In *Ex parte Beale* (*e*), where the words of the statute (*f*) were "such person for every such offence shall forfeit to the proprietor of the copyright a sum not exceeding 10*l.*," Blackburn, J., said: "It is quite clear that this imposes a penalty for every copy sold; a different construction would result in an absurdity and defeat the intention of the Legisture. The penalty is imposed also for importation, and it

(*b*) (1887) 4 R. P. C. 207.
(*c*) 15 Geo. III. c. 53.
(*d*) (1894) 11 R. P. C. 351.
(*e*) (1868) L. R. 3 Q. B. 395.
(*bb*) Sect. 8.
(*cc*) *Brooke* v. *Milliken* (1789), 3 T. R. 509.
(*f*) 25 & 26 Vict. c. 68, s. 6.

would be monstrous that if a man had consigned from abroad a cargo of imitations the utmost penalty that could be imposed on him would be the sum of 10*l*. It would be well worth his while to run the risk of paying that small sum and to import and distribute for sale elsewhere a quantity worth many thousands."

§ 158. The statute does not prescribe any minimum penalty, but the sum awarded in respect of each offence should be one which is recognizable and would form the proper subject of execution; though where there are a large number a lump sum may be given to cover the whole (*g*).

In *Hildesheimer* v. *Faulkner, Ltd.* (*h*), it was laid down that the Court is not bound in an action to recover penalties to award for each offence the sum of one farthing. It may award a sum which, if divided by the number of offences, will give for each offence something which is not recognised as a coin of the realm. Collins, L.J., in giving judgment, said: "The action was brought not in respect of one infringement, but in respect of a million; there was one judgment and one sum recovered, though it was assessed with reference to each offence. There was no question of levying more than one sum, and there was no necessity for the purpose of levying execution to assess any particular sum in respect of each offence. The only reason for fixing a farthing as the minimum of damages was because execution cannot be issued for less. . . . *Ex parte Beale* could not be overruled now, even if it were not, as he thought it was, a right decision; but the Court was not bound to fix a penalty at a farthing, for it was not limited by the standard of coinage existing from time to time."

§ 159. Where the piracy results from accident or mistake, or where there are no aggravating circumstances, the penalty will be light.

In *Saunders* v. *Wiel* (No. 2) (*i*), Cave, J., said: "The next question is what sum of money ought I to give by way of judgment. This is a penalty. That has been decided in this very case (*k*). It is an action for a penalty, and the maximum sum is 50*l*. for each occasion. Now a penalty is punishment, and punishment is to be awarded in proportion to what it is that the offender has done, and no doubt if he has done it

(*g*) See, *e.g.*, *Ellis* v. *Marshall* (1895), 64 L. J. Q. B. 775.
(*h*) [1901] 2 Ch. 552, followed in *Nicholls* v. *Parker*, 18 T. L. R. 459.
(*i*) (1892) 9 R. P. C. 467, 470.
(*k*) *Saunders* v. *Wiel* (No. 1), 9 R. P. C. 459.

under circumstances of aggravation the punishment ought to be heavier. If he has done it under circumstances of mitigation, the punishment ought to be lighter, and in one of the cases which has been already decided on this statute, the Court has drawn attention to that circumstance, and said that where the piracy results from accident or from mistake, then the judge may reduce the penalty: the judge has the power of reducing the penalty to a merely nominal one, and in that way of not confounding the innocent with the guilty. In this case no circumstances of aggravation have been brought before me at all. I am left by both parties entirely in the dark as to how I should limit this penalty. . . . Under the circumstances, I think I must give a nominal penalty which, if further piracy goes on, would, of course, be a very good ground for increasing it in a subsequent case. Two cases have been proved. I do not know that there are any more, and in respect of those two cases I think it is sufficient if I give the nominal penalty of 20*s.* in each case, making 40*s.* altogether."

§ 160. The penalty provided by the statute may not be sufficient to recoup the proprietor for the damage done to him by the infringement, and the Act therefore provides him with an alternative remedy in the shape of an action for damages. It is enacted by the same section of the Act (sect. 60 (2) of 1907) as follows:—

> "Or if the proprietor elects to bring an action for the recovery of damages for such contravention and for an injunction against the repetition thereof, he (the infringer) shall be liable to pay such damages as may be awarded and to be restrained by injunction accordingly."

§ 161. The plaintiff may be called upon to elect whether he proceeds for penalties or for damages under the section (*l*), and he cannot pursue both remedies together. Where the proceedings are for damages, the damages suffered must be proved; but if a case of infringement is made out an inquiry as to the amount of the damages to be awarded may be ordered.

Apart from special circumstances, the basis on which

(*l*) *Saunders* v. *Wiel* (No. 1) (1892), 9 R. P. C. 459.

damages are to be awarded will be the profit which the proprietor of the design would have made if he had granted a license for sale of, or himself sold, the copies improperly made and issued by the infringer.

In *Pike* v. *Nicholas* (*m*), which was a literary copyright case, James, V.-C., said: "The defendant is to account for every copy of his book sold as if it had been a copy of the plaintiff's, and to pay to the plaintiff the profit which he would have received from the sale of so many additional copies"; but this, of course, will only apply in designs cases, where the two articles may be said strictly to compete.

In *Davenport* v. *Rylands* (*n*) (a patent case) Vice-Chancellor Page Wood said: "The inquiry will be in the form, 'what damage the plaintiff has sustained,' and not 'what damage, if any,' he has sustained, as it would be in the case of a trade mark. There is this difference between the case of a trade mark and that of a patent: in the former case the article sold is open to the whole world to manufacture, and the only right the plaintiff seeks is that of being able to say, 'Don't sell any goods under my mark.' He may find his customers fall off in consequence of the defendant's manufacture; but it does not necessarily follow that the plaintiff can claim damages for every article manufactured by the defendant, even though it be under that mark. On the other hand, every sale without license of a patented article must be a damage to the patentee."

In *British Motor Syndicate* v. *Taylor* (*o*) the owners of a patent for an invention of a starting apparatus for motor gas engines having commenced an action for infringement of the patent, an order was made in chambers by consent for an inquiry as to damages. The defendants contended that the damages should be assessed at 3*l.* 10*s.* per starter, being the royalty of 3*l.* usually required by the plaintiffs, together with 10*s.* for the average profit of manufacture. The plaintiffs alleged that the royalty of 3*l.* was only charged to licensees who guaranteed a yearly minimum, and that no user had been charged less than 10*l.* The master assessed the damages at 218*l.*, being 8*l.* for each of the twenty-seven starters, and the defendants thereupon applied to vary his certificate.

Held, that the defendants were liable in respect of each of the twenty-seven articles, and that the damages must be assessed at 5*l.* per article. In giving judgment Stirling, J., said:

(*m*) (1870) L. R. 5 Ch. 260.

(*n*) (1865) L. R. 1 Eq. 302, 308. And see *United Horseshoe and Nail Co.* v. *Stewart* (1888), 5 R. P. C. 260; *American Braided Wire Co.* v. *Thompson* (1890), 7 R. P. C. 47.

(*o*) (1900) 17 R. P. C. 189.

"The remaining question is as to the amount of damages. The principles on which these are to be assessed were much discussed in the recent case of the *Pneumatic Tyre Co., Ltd.* v. *Puncture Proof Pneumatic Tyre Co., Ltd.* (*oo*). There the Lord Chief Justice, in giving judgment, says this: 'I will first consider what is the true principle upon which, in such a case, the damage is to be assessed. No doubt the defendants are to be treated as wrong-doers. They have done something which they are not entitled to do; but before the plaintiffs are entitled to recover, even as against a wrong-doer, they have to prove damage to themselves. All that can be said in the case of a man who is a wrong-doer is, that when the damages come to be considered, juries and Courts, where they are performing the functions of juries, deal with them, and commonly and usually deal with them, with a more or less liberal hand; but still the question that must be proposed to a jury or to a judge is, what is the damage which, in such a case as this, the plaintiffs have sustained? It seems to me that, applying that principle to the facts of this case, the plaintiffs are entitled to be compensated for the injury that they have suffered by reason of what the defendants have done, and wrongfully done; and in such a case as this, or a case somewhat like this, the damages would be properly divisible under these two heads: what injury has been done to the plaintiffs by reason of their article being shoved out of the market, or, to use the expression, I think, of Lord Watson, "shouldered" out of the market; to what extent has their trade been injured? And if the case were one in which the infringing articles were put forward under circumstances in which it might affect the reputation and character of the plaintiffs' business, that would also, in my opinion, be a proper subject to be considered. It has been said that the principle ought to be the principle of what the defendants would have had to pay for permission to do the thing which, unauthorised and wrongfully, they did. In cases where there is a commercial known standard of license for the manufacture of a particular article—and particularly in the case where the patentee is not himself a manufacturer, but makes his profit simply by the granting of licenses—the measure of damage may, in such cases, be the cost of the license. It may be, but I think, upon an examination of all these cases, it will be found that, underlying the measure of damage, there is the assumption that if it had not been that the particular defendant manufactured the particular things, then that those particular things would have been manufactured by the plaintiff or his licensees. . . .' I think that, having regard to the prices actually paid by the defendants themselves, the amount suggested by them is too little; and remembering that I am dealing with wrongdoers and entitled to fix the damages on a liberal scale,

(*oo*) (1899) 16 R. P. C. 209.

I have come to the conclusion that the amount to be assessed for each article ought to be 5*l*." On appeal (*p*) Lord Alverstone, C.J., said: "I see no materials upon which we can properly come to the conclusion that the learned judge, adopting, as in my opinion he has rightly adopted, the true principle, namely, of what the defendants would have had to pay for the permission to do that which they wrongfully did, which is the test he lays down, was wrong in assessing the figure at 5*l*."

In *Ingram & Kemp* v. *Edwards* (*pp*), where infringement was found of a design for gas pendants, Wills, J., in directing the jury, said: "What are the damages up to the present time? The sales of the pendants amount to fifteen guineas . . . on that sale the plaintiffs are entitled to the profit which the defendants have made, which would be five guineas. You are urged to give something more. I cannot quite see that. The sale of the very small number of these things is not likely to have damaged the plaintiffs in any other way. Nor, as far as I know, has it ever been held that because the imitating article is an inferior looking article, therefore if it is supposed to be the original one it would damage it in that way. I never heard of there being damages for a sort of libel on the respectability and honour of the original design. If you think that what I have suggested ought to be increased by what I may call general damages, then you will increase them. It is not a case in which, so far as I can see, there is anything like evil conduct which would *make* one *incline* to swell the damages beyond what is quite reasonable."

§ 162. As the right of ownership in a design exists apart from the statute (*q*), though methods by which it is to be protected are named in the statute, the proprietor is not excluded from other remedies, which are provided by the general equitable jurisdiction of the Courts. Thus, an account of profits may be ordered in lieu of the statutory damages, and if the legal right cannot be made otherwise effectual the Court will, in the exercise of its discretion, grant an injunction restraining either an actual or intended infringement (*r*). The principles

(*p*) (1900) 17 R. P. C. 723.

(*pp*) (1904) 21 R. P. C. 463.

(*q*) See observation on this question, *ante*, p. 53 *et seq*. But see *Woolley* v. *Broad* (1892), 9 R. P. C. 208.

(*r*) *Wilkins* v. *Aikin*, 17 Ves. 425. The statutory remedy does not prevent the granting of an injunction as additional relief. *Cooper* v. *Whittingham* (1880), 15 Ch. Div. 501; and see *Hole* v. *Bradbury*, 12 Ch. D. 886.

on which an account of profits will be ordered are the same as in patent cases, and full discovery will be ordered, in a proper case, in aid of this form of relief.

In *Saccharin Corporation* v. *Chemicals and Drugs Co.* (*s*), which was an action for infringement of patent, judgment was entered for the plaintiffs and an account of profits ordered. The defendants were willing to allow the plaintiffs, for the purpose of ascertaining such profits, inspection of the books, but with the names and addresses of customers sealed up. The plaintiffs claimed the right to inspection without such sealing up, and, on the refusal of the judge (Cozens-Hardy, J.) to order it, appealed, alleging that the disclosure was necessary to enable them to investigate the amount of profits. On the appeal it was held that the plaintiffs had the right to the disclosure of the names and addresses, and the appeal was allowed.

In giving judgment, Alverstone, M.R., said: "In nothing that I shall say do I wish to throw any doubt on the distinction between a patentee who elects to take an account of profits and a patentee who takes an inquiry as to damages. As was pointed out in the House of Lords in *Nicholson* v. *Betts* (*ss*), and to my knowledge it has been recognised for many years, the patentee who elects to take profits stands in the shoes of the infringer, and condones, so to speak, his wrong, and is entitled only to those profits. It is not disputed that, in the case of an inquiry as to damages, there is no right to cover up the names. That was decided in *Murray* v. *Clayton* (*t*) in the year 1872, and it has been followed in the *Braided Wire Case* and in more than one other case. The same principle was applied in the case of the *Leather Cloth Co.* v. *Hirschfeld* (*tt*), where, although it is quite true that the form of the inquiry was as to damages, the actual inquiry was as to the number of articles which the defendant had disposed of, and the objection was taken as to the names of the customers being disclosed. But I think that, upon principle, the rule laid down in *Murray* v. *Clayton*, was the right rule; and that when you are dealing with the case of a wrong-doer you must not be very astute to prevent him from giving full discovery, because some consequences may flow from the fact that discovery has been occasioned by his own wrongful act."

§ 163. In determining whether an injunction should be granted, the Court acts upon the general principles

(*s*) (1900) 17 R. P. C. 612.
(*t*) (1872) L. R. 15 Eq. 110.
(*ss*) L. R. 4 H. L. 22.
(*tt*) 1 H. & M. 295.

applicable to the granting of injunctions. Thus, if a design has been infringed there is a *prima facie* right to an injunction (*t*), the reason being that it is to be presumed that the infringer intends to go on infringing. Also, if there has been no actual infringement, but an intention to infringe is shown, an injunction will be granted (*u*); and it is not necessary to show that damage has been caused by the piracy to the proprietor (*x*).

§ 164. The proprietor is entitled to an injunction restraining not only sale, but manufacture of articles to which the design is applied with intent to sell at the expiration of the copyright (*y*). So an injunction has been granted in a patent case though the patent was about to expire in a few days, the object being to prevent the manufacture of pirated goods with a view to throwing them on the market the moment the patent should expire (*z*).

If the person who infringes undertakes not to repeat his infringement, or if there is reason to suppose on any other ground that the defendant will not infringe in future, the Court will or will not make an order for injunction, according to the other circumstances of the case.

In *Geary* v. *Norton* (*a*), an injunction was given against tradesmen selling articles which infringed the plaintiff's design, though the defendants promised to commit no infringement in future. In *Millington* v. *Fox* (*b*), the defendant innocently used the plaintiff's trade mark, and did not intend to use it again, but the Court granted an injunction.

(*t*) *Proctor* v. *Bayley* (1889), L. R. 42 Ch. Div. 390.

(*u*) Per Jessel, M.R., in *Cooper* v. *Whittingham* (1880), 15 Ch. D. 501.

(*x*) See, *e.g.*, *Adair* v. *Young* (1879), 12 Ch. Div. 13 (a patent case).

(*y*) *McCrea* v. *Holdsworth* (1848), 2 De G. & Sm. 496.

(*z*) *Crossley* v. *Beverley* (1829), 1 W. P. C. 119; *Sheriff* v. *Coates*, 1 Russ. & My. 159.

(*a*) (1838) 1 De G. & Sm. 9.

(*b*) (1838) 1 De G. & Sm. 9. And see *Losh* v. *Hague* (1837), 1 W. P. C. 200.

In *Proctor* v. *Bayley* (*c*), these two last-named cases were explained by Cotton, L.J., who said that the injunctions were granted because there was some reason to fear at the date of the filing of the bills that the plaintiffs were not safe, and that "where a patent is infringed the patentee has a *primâ facie* right to an injunction, for it is to be presumed that an infringer intends to go on infringing, and that the patentee has a right to an injunction to prevent his doing so"; but in the case before him he came to the conclusion that though the defendants had infringed the patent, the plaintiff was not justified in believing that they had any intention to infringe again, and that with proper inquiry he might have known this; and upon this finding an injunction was refused. Fry, L.J., added that a "foolish attempt to justify a past act does not raise any presumption that they intend to repeat it."

In *Werner Motors* v. *Gamage's, Ltd.* (*d*), the plaintiffs registered a design "for the pattern as shown of a motor-cycle frame," and in August, 1902, commenced this action for alleged infringement by sales made by the defendants. The defendants denied infringement, and alleged that the sales made by them before action were without knowledge of the registration, and although they had made a few sales after action they had never threatened to do any wrongful act. It was held by Byrne, J., that the fact of the registration was unknown to the defendants before action and their acts until then were protected as far as penalties and damages were concerned, but that, having regard to the subsequent sales and the position taken up by the defendants on the motion and subsequently, the plaintiffs were entitled to the injunction.

In giving judgment for the plaintiffs, Byrne, J., said: "The defendants have not themselves applied the design, and their acts, so far as penalty or damages are concerned, appear to be protected up to the date of the service of the writ. This, however, will not protect them against an injunction unless they can bring themselves within the exception from the general rule mentioned in *Proctor* v. *Bayley*. I have no doubt at all but that the defendants were threatening and intending at and after the date of the service of the writ to sell machines to which the registered design had been applied. If on service of the writ they had written and said that they had been in ignorance of the registration, and that they did not mean to sell any more machines, or if on the motion they had offered an undertaking not to sell any more, the matter would have stood on an entirely different footing. . . ."

(*c*) (1889) 42 Ch. Div. 390, 400.

(*d*) (1903) 21 R. P. C. 137; and on appeal, *Ibid.* 621. See *Britain* v. *Kennedy* (1902), 19 T. L. R. 122.

§ 165. When an interlocutory injunction is asked for, and a *prima facie* case is made out by the proprietor of the design, the Court will either grant the injunction or will order the application to stand over until the trial. If the former course be adopted, the plaintiff will be required to give the usual undertaking as to damages; if the latter, the defendant will be ordered to keep an account. The balance of convenience determines what ought to be done (*e*). "It must be seen what way the rights of the parties may best be protected and the least loss to any party caused" (*f*).

An injunction has this advantage, that it may have an effect in preventing third parties infringing. But where there is grave doubt as to the title (*g*), or where there is a serious conflict as to the originality of the design (*h*), or where the plaintiff has delayed his application, the Court will not willingly interfere by way of interlocutory injunction.

In *Mitchell* v. *Henry* (*i*), the plaintiffs alleged that the defendants had imitated their trade mark, and the Court of Appeal, finding that there was a serious conflict of evidence, refused an interlocutory injunction, but ordered the defendant to keep an account. James, L.J., said: "Then with regard to the balance of convenience and inconvenience, it seems to me by far the most convenient course that no injunction should be granted, and that the motion should stand over to the hearing, the defendants undertaking to keep an account. The plaintiffs can protect themselves, as they have to a great extent already done, by circular. Moreover, the pendency of these proceedings will be perfectly well known. Every large purchaser in Bradford or elsewhere will know of them, and will know that he will incur liability if he makes himself a party to any continued infringement of the plaintiffs' rights, should those rights be established at the hearing. If that should be the result of the action, the defendants who under-

(*e*) *Smith* v. *Chatto* (1875), 31 L. T. N. S. 775; *Hildesheimer* v. *Dunn* (1891), 64 L. T. N. S. 452.

(*f*) Per Lord Cottenham in *Bacon* v. *Jones* (1839), 4 My. & Cr. 438.

(*g*) *Spottiswoode* v. *Clark* (1846), 2 Phil. 154.

(*h*) *Sheriff* v. *Coates* (1830), 1 Russ. & My. 159. And see *Read* v. *Richardson* (1881), 45 L. T. 54 (a trade mark case); *Mitchell* v. *Henry*, *infra*.

(*i*) (1880) L. R. 15 Ch. Div. 181.

take to keep an account will be liable to pay to the plaintiffs every farthing of the profits they make by the sale of goods by which the plaintiffs' mark is infringed, and will find themselves in this position, that they will have been using a trade mark which they will be prevented from using afterwards, and so will lose all the reputation they have been acquiring in the meantime. Then, again, the plaintiffs will be relieved from the necessity of giving an undertaking to abide by any order as to damages if the defendants should prove successful at the hearing. Therefore, on the balance of convenience and inconvenience, and having regard to the fact that the decision of the Master of the Rolls was in favour of the defendants, which ought not to be overlooked on an interlocutory application, I am of opinion that the better way will be to let the motion stand till the hearing, the defendants keeping an account."

In *Grafton* v. *Watson* (*k*) an interlocutory injunction was granted. The defendant admitted having copied the plaintiff's design so far as he legitimately could do so without infringing, and Chitty, J. (affirmed by the Court of Appeal), thought that probably the infringement had not been avoided. Moreover, it appeared that the season was short, and an injunction would alone prove a real remedy to the plaintiff if his contention should eventually turn out to be correct.

In *Knowles* v. *Bennett* (*l*), the plaintiffs, the owners of a registered design for shawls, which were sold in Eastern markets, discovered that B. & Sons were printing and B. was shipping to the same markets shawls which were infringements of the registered design, and issued a writ and gave notice of motion for an injunction to restrain the defendants from infringing and to stay the delivery of goods already shipped. On the hearing of the motion an injunction was granted till the trial of the action, which was subsequently settled, the defendants consenting to an order making the injunction perpetual and requiring the delivery of the infringing goods. Robinson, V.-C., held, on the question of balance of convenience and inconvenience in granting the injunction, that the fact that the alleged infringing goods were being sold at a lower price was a material consideration, for, said the Vice-Chancellor, "it is difficult to say what the exact loss might be which the plaintiffs might sustain if the injunction were not granted. They might be supplanted in a trade which they had to a certain extent established in the East by the sale of goods of a cheaper class—the result might possibly be that the plaintiffs' trade might be taken away from them."

(*k*) (1884) 50 L. T. N. S. 420; and, on appeal, 51 L. T. N. S. 141.
(*l*) (1895) 12 R. P. C. 137.

§ 166. Misrepresentation of his right may deprive the proprietor of a design of the equitable relief by injunction, but it must be directly connected with the registration, and a mere excess of claim or misdescription, if *bonâ fide*, will not affect his rights (*m*).

In *Sen Sen* v. *Britten* (*n*), the plaintiffs had, since 1896, imported into the United Kingdom and sold cachous in distinctive boxes and packets with the mark "Sen Sen" on them and the words "Trade mark" below, and they brought this action against B. to restrain him from passing off his goods as the plaintiffs', and moved for an interlocutory injunction. In addition to other defences, it was contended for the defendant that since the words "Sen Sen" were not registered as a trade mark, the plaintiffs were making a misrepresentation that disentitled them to relief.

Stirling, J., after referring to sect. 105 of the Act, said: "Of course, if the plaintiffs are brought within the terms of that section they must be denied relief, and I go further and say, that without committing an offence under this section the plaintiffs might undoubtedly be guilty of such misrepresentation as not to entitle them to relief in a court of equity. . . . But the offence consists not in applying to any article sold a trade mark, but in representing that that trade mark is registered. The contrast is very strong between what is enacted in that respect and what is enacted with respect to a patent. If he represents that any article sold is a patented article when no patent has been granted, then he commits an offence; but it is not said if he represents that he has a trade mark and that trade mark is not registered then he commits an offence."

§ 167. There is no express provision for delivery-up of pirated articles, and there is probably no such right at common law (*o*), but this further remedy is part of the relief included in the equitable jurisdiction of the Courts, and will now be granted in every proper case in addition to the statutory remedies.

Thus, in the case of *McCrea* v. *Holdsworth* (*p*), Knight-

(*m*) *Harper* v. *Wright & Butler* (1895), 12 R. P. C. 483; *In re Bayer's Design* (1906), 23 R. P. C. 553; and on appeal, per Vaughan Williams, L.J., 24 R. P. C. at p. 70.

(*n*) (1899) 16 R. P. C. 137.

(*o*) *Colburn* v. *Simons* (1843), 12 L. J. Ch. 388.

(*p*) (1848) 2 De G. & Sm. 497.

Bruce, L.J., ordered the delivery-up of the infringing articles to the plaintiff for destruction.

In *Hole* v. *Bradbury* (*q*), Fry, J., said that the Court could, under its general jurisdiction, order the delivery-up for destruction of all the articles manufactured contrary to the plaintiff's copyright. In making the order, the judge did not proceed under the Copyright Act, which gives this power, but under the general equitable jurisdiction of the Court, and the decision is therefore clearly applicable to infringements of designs.

In *Boosey* v. *Whight* (*r*) the plaintiff, having partially succeeded in an action for the infringement of his copyright (in this case the words of direction as to time and expression in sheets of music reproduced on perforated rolls forming part of a mechanical instrument), it was held that he was entitled to an order for delivery-up; but it was laid down that where the infringing parts can be severed the order will be for the delivery-up of such parts of the defendant's article as constitute an infringement of the copyright.

In *Knowles* v. *Bennett* (*s*), where goods infringing a registered design had been shipped for Eastern markets and a perpetual injunction had been granted against the defendants, the owner of the ships on which the goods had been shipped appearing and asking for the direction of the Court, Robinson, V.-C., held that they could not be ordered to deliver up the goods to the plaintiffs, but directed that they might be added as defendants with a view to his making an order restraining them from parting with the possession of the goods except to the plaintiffs.

§ 168. An addition to the old remedies is introduced by sect. 61 of the new Act, which declares that the provisions of the Act with regard to certificates of validity of a patent shall apply in the case of registered designs in like manner as they apply in the case of a patent. The provisions referred to are contained in sect. 35, which provides as follows:—

"In an action for infringement of a patent, the Court may certify that the validity of the patent came in question; and if the Court so certifies, then in any subsequent action for infringement, the plaintiff in that action on obtaining a final

(*q*) L. R. 12 Ch. Div. 886.
(*r*) (1889) 81 L. T. N. S. 265.
(*s*) (1895) 12 R. P. C. 137.

> order or judgment in his favour shall, unless the Court trying the action otherwise directs, have his full costs, charges and expenses as between solicitor and client."

The effect of this is to give the registered proprietor a right to a full indemnity for his costs and expenses when his copyright has once been challenged and established. And he may be entitled to the certificate of validity if it has been challenged, even though the defendant does not appear at the trial to support his objections (*t*). But where the Court has pronounced no decision upon validity or invalidity a certificate will not be granted (*u*).

The question of copyright being a separate issue to that of infringement, the registered proprietor may be entitled to a certificate of validity if he succeeds on that issue, even though he may fail in his action on the ground of non-infringement (*x*). The practice as to granting certificates of validity already established in connection with patents will be followed in all these cases (*y*).

(*t*) *Welsbach Incandescent Co.* v. *Krumm*, 18 R. P. C. 211; *Brookes* v. *Lycett*, 20 R. P. C. 392; *Sodastream, Ltd.* v. *Davey* (1907), 24 R. P. C. 763.

(*u*) *New Inverted Incandescent Gas Lamp Co.* v. *Cope and Timmins* (1906), 23 R. P. C. 103; *Same* v. *Globe Light Co.* (1906), *Ibid.*, p. 157.

(*x*) *Morrison* v. *Asplin*, 21 R. P. C. 557. And see *Hardtmuth* v. *Baker*, 22 R. P. C. 66.

(*y*) For the practice generally, see *Acetylene Illuminating Co.* v. *Midland Acetylene Syndicate*, 17 R. P. C. 534, and the notes to sect. 61, *post*, p. 251.

CHAPTER XI.

THE ACTION FOR INFRINGEMENT.

(*The full references to all the Reports will be found in the Table of Cases ante.*)

§ 169. Remedy now in High Court—Jurisdiction of County Courts—*Bow* v. *Hart.*
§ 170. Jurisdiction in Scotch and Irish Cases—*Bayer* v. *Connell.*
§ 171. Plaintiff's choice of Tribunal—Powers to Consolidate.
§ 172. Parties—Who may sue—Licensees or Assignees—*Woolley* v. *Broad.*
§ 173. Mortgagors and Equitable Owners—*Petty* v. *Taylor.*
§ 174. Proceedings by Unregistered Owners.
§ 175. Parties liable as Defendants—Agents and Principals—Several Infringers.
§ 176. The Writ—Notice before Issue—Indorsement of Claim.
§ 177. Pleadings—Necessary Allegations in Statement of Claim.
§ 178. Defences to the Action—Estoppel of Licensee.
§ 179. Particulars of Breaches and Objections—Application to Expunge.
§ 180. Amendment of Particulars—*Woolley* v. *Broad.*
§ 181. Sufficiency of Particulars—Allegation of Common Knowledge.
§ 182. Inspection and taking of Samples—Enforcing Order.
§ 183. Notice of Motion or Summons for Inspection—Affidavit in support.
§ 184. When Inspection refused—Disclosure of Trade Secrets.
§ 185. Discovery of Documents and Interrogatories.
§ 186. Limitations to Plaintiffs' and Defendants' Rights of Discovery.
§ 187. Discovery in Actions for Penalties—*Titus Astle* v. *Mansfield.*
§ 188. Extended right of Defendant to Interrogate.
§ 189. Method of Trial—Right to Jury.
§ 190. Issues for Judge and Jury.
§ 191. Decision of Preliminary Questions of Law.
§ 192. Costs—New Statutory Provisions—Certificate of Validity.
§ 193. Costs of distinct Issues—*Winfield* v. *Snow*; *Blank* v. *Footman.*
§ 194. Costs on Higher Scale in certain Cases.
§ 195. Order when Defendant submits to Injunction—Illustrative Cases—*Cooper* v. *Whittingham*; *American Tobacco Co.* v. *Guest*, etc.

IT is proposed in this chapter to deal with those particulars only in which actions for the infringement of

designs differ from other actions. The rules for an action of this class must be taken to be the same as those of any other action save where otherwise stated.

§ 169. By sect. 92 (1) of the Act "the Court" is defined as meaning (subject to the special provisions for Scotland, Ireland, and the Isle of Man) the High Court of Justice in England. The proper Court, then, for all proceedings in England would be the High Court, and this includes, by statute (53 & 54 Vict. c. 35) the Court of Chancery of the County Palatine of Lancaster so far as regards persons and property within its jurisdiction; but there is no such jurisdiction in the County Courts (*a*) except by consent (*b*).

> In *Bow* v. *Hart* Vaughan Williams, L.J., in giving the considered judgment of the Court of Appeal, after referring to the argument based on the definition clause of the Act, said: "Then it is said that the jurisdiction is given by the Judicature Act, 1873, which gives, by sect. 24, to the High Court, whether in the King's Bench Division or the Chancery Division, all the power and authority exercised by the Chancery Division; and it is said that the County Court, having the jurisdiction to entertain a personal action, where the debt, demand, or damage is not more than 50*l.*, can, by sect. 56 of the Act of 1888, entertain the present action and grant an injunction to restrain the defendant from infringing the plaintiff's trade mark. I cannot agree. Such an action would not have been a personal action within the meaning of that word in sect. 58 of the Act of 1846 (*bb*), nor do I think that it comes within the meaning of the same word in sect. 56 of the Act of 1888. I think,

(*a*) *Bow* v. *Hart* (1905), 21 T. L. R. 251. And see the judgment of Kay, L.J., in *Reg.* v. *The County Court Judge of Halifax* (1891), 8 R. P. C. 338. In *Morton* v. *Emanuel* (*Re Morton's Design*) (1899), 17 R. P. C. 117, the action was commenced in the Birmingham County Court, but on notice of motion being given in Chancery to expunge the registration, the action was stayed by order pending this motion. The case of *Moody* v. *Tree*, 9 R. P. C. 333, was tried in the County Court, but without the question of jurisdiction being raised.

(*b*) County Courts Act, 1888, s. 61. The consent must be in writing, and no evidence of title will arise on the judgment even as between the parties. As to claims for penalties only, see *infra*.

(*bb*) 9 & 10 Vict. c. 95.

therefore, that the County Court judge had no jurisdiction, and rightly refused to make any order in this action; and it follows that the decision of the King's Bench Division must be reversed. This is the judgment of the Court, and the appeal will be allowed, with costs."

Under the older Acts the penalties might be recovered before justices of the peace or a police magistrate. It is now provided that the registered proprietor may recover "such sum as a simple contract debt" (*c*). In cases where no question of title is raised, and the claim does not exceed 100*l.* (*cc*), it may still be open to question whether the proceedings cannot be taken in the County Court as for a "simple contract debt."

§ 170. In Scotland and Ireland and the Isle of Man the jurisdiction of the Courts in any proceedings relating to designs is preserved, and the special jurisdiction conferred on "the Court," as defined by the Act, does not affect such proceedings (*d*). But these provisions only give a concurrent jurisdiction, and do not exclude proceedings in the High Court, even where the proprietor is resident in Scotland or Ireland (*e*).

The concurrent jurisdiction conferred by the Act on the Scotch and Irish Courts does not extend to proceedings for expunging entries from the register which is kept at the Patents Office in England, and all applications for rectification fall within the exclusive jurisdiction of "the Court," as defined by the Act (*f*).

In *Bayer* v. *Connell*, where the defendants met a claim for infringement by a cross motion in the Irish Chancery to

(*c*) (1907) Sect. 60 (2).

(*cc*) County Courts Act, 1903 (3 Edw. VII. c. 42).

(*d*) Sects. 94 and 95.

(*e*) *Re King & Co.'s Trade Mark* (1892), 9 R. P. C. 350.

(*f*) *Bayer* v. *Connell Bros.* (1897), 14 R. P. C. 275. But see *Cowie Bros.* v. *Herbert* (1896), 14 R. P. C. 436; and observations at p. 108, *ante*.

expunge the plaintiff's registration, the Master of the Rolls, referring to the provisions of the section (sect. 111 of 1883) which reserved the jurisdiction of the Irish Courts, said: "This is a very peculiar section. Usually, where a concurrent or co-ordinate jurisdiction is conferred upon the Courts in London and Dublin, 'the Court' is defined as meaning, in England, the High Court of Justice in England, and in Ireland the High Court of Justice in Ireland; and, if the defendant's contention in the present case is correct, sect. 117 (defining 'the Court' under the Act), taken in connection with sect. 111, must mean simply that. But the language of sect. 111 precludes that construction. Some distinction is plainly meant to be drawn between the special jurisdiction conferred by the Act and a jurisdiction not so conferred. . . . 'Required' (the word used in sect. 111) is an ambiguous expression, and may be 'necessitated.' The alteration or rectification is not spoken of as 'directed by' or 'ordered by' the Court, but 'required in pursuance of' an Irish order or decree. In the case of patents this would, no doubt, be strictly correct in any view. In the case of trade marks it would be strictly accurate if, in the course and exercise of its general jurisdiction, an Irish Court decided some question affecting the right to the registration; if, for instance, the ownership of the trade mark was decided to have been wrongly registered, on the ground of fraud or the like. The present action is itself an appeal to this general jurisdiction. In such a case the rectification of the register would be 'required in pursuance of' the decree in order to make the register correct, though it would not be 'required' in the sense of being ordered by the judgment."

§ 171. Design actions are not assigned to any particular division of the High Court, and the plaintiff is therefore free to choose. The Act provides (*g*) for certain cases being referred to a selected judge of the High Court whose decisions shall be final, but this does not apply to ordinary actions for infringement nor to motions to rectify, etc.

Should the plaintiff desire to try his action locally at the assizes, or should he desire a trial by jury, the King's Bench Division will be chosen. In other cases, and especially where an application to rectify

(*g*) (1907) Sect. 92 (2).

the register is to be made in connection with the same matter, the Chancery Division will be found the more convenient.

Where there are cross actions or motions, the powers of the Court to consolidate and transfer can be used to bring the whole matter to an issue (*h*). There are now no rules as to local venue, and the place of trial is determined as in other actions (*i*).

§ 172. The plaintiff, or one of the plaintiffs, in any proceedings for infringement must be a registered proprietor, and generally if any person other than the registered proprietor be made plaintiff, the action fails as regards him (*k*), subject to the exercise of the powers of amendment possessed by the Court (*l*).

The meaning of "proprietor" is to be found in sect. 93 of the Act (*m*), and from this it appears that, in addition to the original author, a licensee, assignee, or partial assignee from him may all be regarded as proprietors.

Supposing that A. is the author of a design, and he licenses B. to use it, and assigns half his rights to C., according to the section A., B., and C. would all be proprietors, and might be registered. If D. infringes, A., B., and C. would each be entitled to sue him. And it would seem that as each person has the right of property, he would be entitled to bring his action without joining his co-proprietors, and could obtain

(*h*) R. S. C. Ord. XLIX.

(*i*) R. S. C. Ord. XXXVI. rr. 1, 1a.

(*k*) *Woolley* v. *Broad* (1892), 9 R. P. C. 208. But see *Heap* v. *Hartley* (1889), 6 R. P. C. 495, where a distinction was raised in favour of licensees in cases of infringement with notice of an exclusive license. And see *Tuck* v. *Canton* (1882), 51 L. J. Q. B. 363, a copyright case.

(*l*) R. S. C. Ord. XVI. rr. 1—13.

(*m*) And see *ante*, Chap. VII., "Proprietor."

whatever damages he may have suffered. The hardship on D. is not so great as may at first glance appear. He would have to pay such damage to each party as each had suffered in respect of his limited interest; and if the suits were for penalties, the *maximum* amount would be 100*l.* (*n*), the exact amount being in the discretion of the Court. Moreover, application could be made to consolidate the actions (*o*), or to hear them together, or to treat one as a test action (*p*).

§ 173. Under the patents part of the old Act it was decided that an owner who had mortgaged by assignment could sue without joining his mortgagee (*q*), but that a licensee of a patentee could not sue without joining the patentee (*r*). A licensee of the proprietor of a design, however, being himself a proprietor, as defined by sect. 93 of the Act, can sue alone (*s*); in *Woolley* v. *Broad* (*t*) he was not allowed to do so, but in that case he was a mere licensee for sale and had no right to apply the design, and he had not been registered as proprietor.

The register does not contain notice of any trust, express, implied, or constructive (*u*), but equitable assignments may be registered, and if the registered proprietor is only a bare trustee he should be added as plaintiff. If, however, the wrong person is entered as proprietor on the register, this does not constitute him a trustee for the persons legally entitled, and the action may fail through

(*n*) (1907) Sect. 60 (2).
(*o*) R. S. C. Ord. XLIX. r. 8.
(*p*) *Amos* v. *Chadwick* (1878), L. R. 9 Ch. D. 459.
(*q*) *Van Gelder* v. *Sowerby* (1890), 7 R. P. C. 41.
(*r*) *Heap* v. *Hartley*, *supra*.
(*s*) See *Jewitt* v. *Eckhardt*, 8 Ch. D. 434.
(*t*) (1892) 9 R. P. C. 208.
(*u*) (1883) Sect. 85; (1907) Sect. 66; and see *ante*, Chap. VI., p. 94.

the defect in registration, even though these persons be co-plaintiffs in the action.

In *Petty & Sons* v. *Taylor* (*x*), drawings contained in a trade catalogue were made by T. and W. for a limited company, who paid for and used them. The drawings were made by T. and W. by the direction of the managing director of the company, who himself prepared the letterpress of the catalogue. The managing director, and not the company, was registered as proprietor of the copyright under the Fine Arts Copyright Act, 1862, s. 4, and as proprietor of the copyright in the catalogue under the Copyright Act, 1842, s. 13. There was no entry of any agreement in writing vesting the copyright in him. Upon an action being brought by the company and the managing director, as co-plaintiffs, for alleged infringement of the copyright, it was held, that the director had acted as representative of the company and not in his personal character, and as agent of and not as trustee for the company, and that he was not the proprietor of the copyrights under either Act, and that the registrations were therefore bad.

In giving judgment, Kekewich, J., said: "The action is brought by Mr. W. P. and P. & Sons, Ltd., as co-plaintiffs, and it is, in my opinion, the fact that P. & Sons, Ltd., are the proprietors, but they are not registered. Now, it seems to me decided, and it is perfectly clear, if I may venture to say so, with respect to a judgment of a learned Lord Justice, even without decision, that you cannot make a combination of two persons neither of whom is entitled to sue, and so make a person who is entitled to sue. In the case of the *London Printing and Publishing Alliance* v. *Cox* (*xx*), Fry, L.J., puts it in this way: 'I have no doubt whatever that a trustee in whom a copyright is vested may be registered as the owner, and may sue in that character; but it is impossible for one person to be the owner and another person to be on the register and for those two persons successfully to sue.' . . . If the thing was done for W. P. in his own personal character, he never purported to give directions, or to pay a bill, or in any way throughout to do anything of any kind connected with this business except in his character of representative of the incorporated company P. & Sons, Ltd. Then it is said he is trustee for the company. It is more easy sometimes to say that a man is a trustee than to explain how he is a trustee, or why, and this is an instance. In one sense he is a trustee for the company. I have no doubt that, if he can properly be held to be the proprietor of this copyright, he is a trustee

(*x*) (1896) 75 L. T. N. S. 545.
(*xx*) [1891] 3 Ch. 291.

> of his proprietorship for the company. He cannot set up his own title against his principals, and in that sense he is a trustee, but he is not a trustee in the sense that any legal ownership ever became vested in him. Copyright is a thing known to the law as capable of assignment, capable of acquisition by proper ways, different, of course, from those connected with real estate, but still a property to be acquired in a particular way, and there is nothing to show here that W. P. ever acquired anything at all. He acted simply as the agent of others, namely, the incorporated company. . . . W. P. never assigned, and, in my judgment, for a very good reason—there was nothing for him to assign. He did not acquire the copyright for himself; he acquired it merely as an agent. The result is, in my opinion, W. P. has been wrongly entered as proprietor of this copyright, and on that ground the registration of the Art copyright fails. . . . The distinction between trustee and nominee is one which I have already noticed in giving judgment. I have only to say here, it seems to me, a trustee may be registered and can sue with or without the concurrence of the *cestui que trust*. A nominee, it seems to me, cannot be properly registered, and, if registered, cannot sue, notwithstanding that the person by whom he has been nominated, on whose behalf he purports to have a copyright, is a co-plaintiff."

§ **174.** Relief other than that specially provided by the Act may in some cases be given, even to an unregistered proprietor (*y*). Thus, it has been decided under the Copyright Act, 1842, that books could be ordered to be delivered up to the registered proprietor, though he was not registered until after the commencement of the action (*z*). And in a trade mark case an assignee of the registered proprietor was allowed to bring an action in his own name, without having registered the assignment (*a*).

§ **175.** The defendant must be the infringer; if the

(*y*) Per Jessel, M.R., in *Cooper* v. *Whittingham* (1880), L. R. 15 Ch. D. 501; and see observations in Chap. VII., *ante*.

(*z*) *Isaacs* v. *Fiddemann* (1880), 42 L. T. N. S. 395; *Hole* v. *Bradbury* (1879), L. R. 12 Ch. D. 886.

(*a*) *Ihlee* v. *Henshaw* (1886), L. R. 31 Ch. D. 323; and see *Magnolia Metal Co.* v. *Atlas Co.* (1897), 14 R. P. C. 389.

infringer be an agent, his principal (*b*) will be liable also, though the agent will not escape (*c*).

In *Betts* v. *De Vitre* (*d*) directors were declared personally liable for the infringement of a patent by a workman.

In *Tonge* v. *Ward* (*e*) a principal was made liable for the infringement of the agent, though ignorant of what his agent was doing.

The patent cases throw light upon this point, though they do not always apply as to the facts which constitute a person an infringer, *e.g.*, user may be an infringement in patent cases, in design cases there is generally infringement only if there be application of the design to any article for the purposes of sale, or sale with knowledge of such application (*f*).

Where there is an extensive course of infringement by various persons, the proprietor of the design may either proceed by separate actions against each, or, and this is the better course, select that case which he thinks the best in order to try the question fairly, and proceed in that case to obtain his interlocutory injunction, writing at the same time to all the other infringers who are *in simili casu*, with notice of the proceedings, and inviting them to concur in the decision in the pending case as determining any claim against them. In the absence of such concurrence proceedings might properly be taken against the other infringers, and this should be done forthwith to avoid any objection on the ground of delay (*g*).

(*b*) *Mallett* v. *Howitt*, W. N. (1879) 107.

(*c*) And see *Nobel Explosives Co.* v. *Jones & Co.* (1880), 17 Ch. Div. 721, and (on appeal) 8 App. Cas. 4.

(*d*) (1868) 3 Ch. 429.

(*e*) (1869) 21 L. T. N. S. 480.

(*f*) For the full treatment of this subject, see Chap. X. on "Infringement."

(*g*) Per Wood, V.-C., in *Bovill* v. *Crate* (1885), L. R. 1 Eq. 391. And see Edmunds on Patents.

§ **176.** When a cause of action has arisen, it is not necessary to give notice before issuing the writ; and, as speed is often very desirable in matters relating to the infringement of copyright in designs, immediate issue of a writ will often be justifiable (*h*). But when it is intended to proceed against an infringer for publishing or exposing for sale a substance to which a protected design has been applied, "knowing that the same has been so applied without the consent of the registered proprietor," notice should, if possible, be given before issue of the writ in view of the defence of *bonâ fide* want of knowledge. The new Act contemplates (*i*) proceedings without direct notice from the proprietor where the infringer has had knowledge of the copyright from some other source.

The writ should be indorsed with claim for an injunction if one be required; and if time be of importance, leave to serve the notice of motion with the writ should be asked for. Damages or penalties (but not both) should be claimed, and if delivery up or an account of profits is required, this also should be asked for (*j*).

§ **177.** On the question of pleadings the provisions of Orders XIX. to XXV. of the Supreme Court Rules apply. The Forms in the Appendices to the Rules do not contain any form strictly applicable to actions for the infringement of designs; but in Appendix C. forms are given of a Statement of claim for relief from infringement of a patent and copyright respectively, and in Appendix D. will be found the forms of Defence corresponding to these. The forms of pleading intended to

(*h*) See *Upmann* v. *Elkan* (1871), 5 R. P. C. 131; *Upmann* v. *Forester* (1883), L. R. 24 C. D. 231, and decisions below in § 195 as to "Costs."

(*i*) See sect. 54 (1 b).

(*j*) For forms of Writ, see Appendix B., *post*, p. 390.

apply to actions in relation to designs may be deduced from those (*k*).

It will be enough to say in this place that the Statement of claim should in general contain allegations—

(1) That the plaintiff is the registered proprietor of a duly registered design.

(2) That the defendant has infringed his right (a) by applying the design or an obvious or fraudulent imitation of it to an article for the purposes of sale; or (b) by publishing or exposing for sale an article to which the design or an obvious or fraudulent imitation of it has been applied; or (c) by doing some act with a view to enable the design to be so applied.

(3) That the consent of the proprietor has not been obtained; and if the action be for publishing or exposing for sale only, then

(4) That the defendant knew that the consent of the proprietor had not been obtained (*l*).

There seems to be no reason to plead compliance with the statute otherwise than by alleging that the design and proprietorship have been duly registered. It is for the defendant to plead non-compliance with any of the requirements if he desires to have these questions raised (*m*).

The plaintiff must state clearly the nature of his claim and whether he is proceeding for a penalty or damages. If there is any doubt about this, the defendant may, by an application in chambers, require the plaintiff to elect under which part of the section (1907, sect. 60) (*n*) he will proceed; and if he declines to make an election he will be deemed to be proceeding for penalties.

(*k*) Forms of Statement of Claim are given in Appendix B., *post*, pp. 390—392; forms of Defence, *post*, pp. 393, 394.

(*l*) *Woolley* v. *Broad* (1892), 9 R. P. C. 209, 212.

(*m*) *Sarazin* v. *Hamel* (1863), 32 L. J. Ch. 378.

(*n*) *Saunders* v. *Wiel* (No. 1) (1892), 9 R. P. C. 459.

§ 178. A defendant may (*a*) deny infringement; or (*b*) attack the design; or (*c*) allege that the Act has not been complied with.

The defence should traverse all statements in the claim which it is desired not to admit, and if a defence of consent to the use of the design be intended to be put in, this should be pleaded. If the case for the defendant be that there is no subject-matter for a design, or that there is any other reason why the design ought not to have been registered, it would be well to apply by summons or cross-motion to expunge or rectify the register (*o*).

Stated more fully, the main defences specially applicable to an action for infringement of a design are:—

(1) No infringement (*p*). This defence involves that the alleged imitation is in substance different to the design registered by the plaintiff.

(2) That the infringement (if any) took place abroad. This is really the same as a denial of any infringement, as infringement consists in the production for purposes of sale of the article in this country or the sale here of articles so produced (*q*). But if the article be made abroad and be imported for sale, there would be an infringement (*r*). If the sale and delivery both take place abroad there is no infringement (*s*), and this is so even

(*o*) For procedure on Applications to expunge or rectify, see *ante*, p. 108 *et seq.* Application may now be made to the Comptroller for cancellation on the ground of non-manufacture in the United Kingdom, but as this is also a ground of statutory defence, such an application would probably not be entertained during the pendency of an action. See sect. 58, and notes thereon, *post*, p. 238.

(*p*) See *ante*, Chap. VIII., "Infringement."

(*q*) *Potter* v. *Braco de Prata Printing Co.* (1891), 8 R. P. C. 218.

(*r*) See, *e.g.*, *Nobel Explosives Co.* v. *Jones* (1880), 17 C. D. 721; 8 App. Cas. 4; *British Motors* v. *Taylor* (1900), 16 R. P. C. 189; and on appeal, *Ibid.* 723.

(*s*) *Badische Anilin und Soda Fabrik* v. *Johnson* (1897), 14 R. P. C. 719.

though the contract for sale be made in this country, if it is for articles made abroad and delivered there (*t*).

(3) That the design is not proper subject-matter for registration within the meaning of the Act (*u*).

(4) That the design is not new and original (*x*).

(5) Prior publication (*y*). Particulars should generally be given; but if common knowledge is relied on it should be expressly pleaded, and in such cases particulars of prior publication or user need not be furnished (*z*).

(6) That the design was never properly registered. Under the old Acts it was held that it was no defence to an action for infringement that the design was registered in the wrong class (*a*); but, having regard to the provisions of sect. 49 (2) of the Act of 1907, it is doubtful whether this decision can now apply (*b*). It is certainly a good defence to show that the design was not registered in the class or classes of goods to which the alleged infringer's goods belong (*c*).

(7) That articles to which the design has been applied are not properly marked (*d*).

(8) That the plaintiff is not a registered proprietor (*e*).

(9) That the defendant did not apply the design, and sold the articles without knowledge of the plaintiff's rights.

(*t*) *Saccharin Corporation* v. *Reitmeyer* (1900), 17 R. P. C. 601; *Badische Anilin und Soda Fabrik* v. *Hickson* (1905), 22 R. P. C. 63, and on appeal, *Ibid.* 575.

(*u*) See *ante*, Chap. II., "Design."

(*x*) See *ante*, Chap. III., "Novelty."

(*y*) See *ante*, Chap. IV., "Publication."

(*z*) *Holliday* v. *Heppenstall* (1889), 6 R. P. C. 320.

(*a*) *Lowndes* v. *Browne* (1848), 12 Ir. L. R. 293.

(*b*) See *Hothersall* v. *Moore* (1892), 9 R. P. C. 27. See also sect. 57 of the Act.

(*c*) *Re Read and Greswell's Design* (1889), 6 R. P. C. 471. See also *Re Clarke's Design* (1896), 13 R. P. C. 351.

(*d*) See *ante*, Chap. VIII. on "Marking."

(*e*) See *ante*, Chap. VII. on "Proprietor," and *ante*, §§ 172, 173.

(10) Res judicata. But it must be noted that (subject to the provisions of the new Act as to certificates of validity which, by sect. 61, now apply to designs) a decision does not determine the validity or invalidity of the design or its registration except as between the parties to the action (*f*).

(11) Leave and license. A license to one to manufacture an article with the design applied to it is a license to his vendees to sell it (*g*). But the publication of a book of designs by the owner of the copyright does not license the purchaser of the book to apply the designs to articles for the purpose of sale (*h*). And a license by one of two joint owners will furnish no defence (*i*), though any one of the co-owners may maintain an action for infringement (*k*).

(12) Lapse of the copyright. The registered proprietor is entitled to copyright during five years from the date of registration with optional extensions up to fifteen years (*l*), and it would be a defence that the alleged infringement was committed after the lapse of the copyright (*m*).

(13) Manufacture wholly or mainly abroad. Sect. 54 of the Act of 1883 provided for the cesser of the copyright in a design in another case, viz., "if a registered design is used in manufacture in any foreign country,

(*f*) *Walker* v. *Hecla Foundry Co.* (1887), 5 R. P. C. 71, 365.

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

(*h*) *De la Branchardière* v. *Elvery* (1849), 18 L. J. Ex. 381; *Cooper* v. *Stephen* (1895), 77 L. T. N. S. 390; *Marshall* v. *Bull* (1900), 16 T. L. R. 501.

(*i*) *Powell* v. *Head* (1879), L. R. 12 Ch. Div. 686. But see *Wedekind* v. *General Electric Co.* (1897), 14 R. P. C. 190.

(*k*) *Lauri* v. *Renad*, [1892] 3 Ch. 402.

(*l*) (1907) Sect. 53. Sect. 57 of the Act enables any person interested to obtain information as to the continuance or cesser of the copyright.

(*m*) As to attempts to get the advantage of copyright after expiration of the term by claiming the trade name of a design, see *Cheavin* v. *Walker* (1877), L. R. 5 Ch. Div. 850.

and is not used in this country within six months of its registration in this country"; and this would still apply in respect of designs registered more than six months before the coming into operation of the 1907 Act, notwithstanding the retrospective provisions of the Act.

This provision has now been superseded by sect. 58 (2) of the new Act, which enables the objection of use of the design for manufacture wholly or mainly abroad to be raised *at any time* as a special ground of defence to an action for infringement, though there is no cesser of the copyright.

(14) The Statute of Limitations. There is no provision in the present Act that proceedings for infringement must be instituted within any given period; but the Statute of Limitations applies as in ordinary cases (*n*).

A licensee cannot always avail himself of all the above defences. So long as the license continues, he is estopped from contesting the validity of the design he is licensed to use, whether the license be by deed, or not (*o*).

§ **179**. There are no special statutory provisions relating either to particulars of breaches or to particulars of objections in cases of designs infringements, as there are in actions relating to the infringement of patents (*p*). But under the general rules particulars may be ordered (*q*). If the particulars be given, and they go beyond the

(*n*) See *Re Burge* (1887), 57 L. T. N. S. 364. The Designs Act, 1842, limited the time to twelve months from the commission of the offence (sect. 12).

(*o*) See *Crossley* v. *Dixon* (1863), 32 L. J. Ch. 617. And see Edmunds on Patents, 269 *et seq.*, where the exceptions may be found stated.

(*p*) New Court Rules dealing with this subject have been prepared by Mr. Justice Parker, the selected judge under the 1907 Act, which are to constitute a new Order numbered LIIIA., to which reference should be made.

(*q*) R. S. C. Ord. XIX. r. 7. See notes to the rule in the Annual Practice. For forms of Particulars, see Appendix of Forms, B., *post*, p. 396.

defence or claim, as the case may be, the party giving the particulars is bound by his pleading (*r*).

On applications to expunge or rectify the registor, particulars cannot be required from the respondents of the points on which they rely in support of the registration, but it is for the applicant to make out his case. Interrogatories may, however, be allowed.

In *Sykes* v. *Howarth* (*s*), a patent case, the plaintiff's particulars of breaches alleged divers sales between certain dates, and "in particular" to two named persons; the statement of defence admitted sales to a third person. Fry, J., held that notwithstanding the form of the plaintiff's particulars he must admit the evidence relating to the sale to this third person, as the case of the third person was within the literal meaning of the particulars, and if they tended to embarrass, the defendant could have avoided any difficulty on this head by applying for further and better particulars.

In *Re Bayer's Design* (*t*) the ground of the application for particulars was that the respondent had not filed any affidavits giving particulars of the grounds on which he proposed to support the registration, and that it was necessary to define the issues; but Warrington, J., refused the application, adding: "He will say he relies on the design being in accordance with the requirements of the Act, and that the onus is on the applicants to make out their case. I will, however, give you leave to interrogate."

§ 180. A party will ordinarily be allowed to amend his particulars at any time upon such terms as may be just. In patent practice there is a well-settled rule that a defendant, on being allowed to amend his particulars of objections, will be put upon terms to allow the plaintiff time to elect to discontinue the action, and if it be so discontinued, the plaintiff will ordinarily be allowed any costs incurred by him from the date of the delivery of

(*r*) *Macnamara* v. *Hulse* (1842), 2 W. P. C. 128, n.
(*s*) (1879) L. R. 12 Ch. Div. 826.
(*t*) (1906) 23 R. P. C. 553.

the first particulars to the delivery of the amended particulars (*u*).

Even in patent actions, however, this rule, though all but invariably followed, is not binding on the Court (*x*). And with regard to designs, the Court of Appeal has expressly stated that the discretion of the Court is unfettered (*y*).

In *Morris, Wilson & Co.* v. *Coventry Machinists' Co.* (*z*), North, J., declared that he would adopt this practice in designs cases, adding, "What reason is there why the same course of practice should not be followed where the action is one for infringement of a registered design as that settled and adopted in the case of the infringement of a patent? No reason has been suggested that seems to me to be a good one. . . . It seems to me that the practice which would be followed if this were a patent action should also be followed, though it is not an action on infringement of a patent, but a registered design."

In *Woolley* v. *Broad* the action was ready for trial at assizes to be held at Nottingham, and about a week before the date of the assizes the defendant discovered certain facts and gave information of them to the plaintiff. The plaintiff objecting to evidence of these, the defendant took out a summons for leave to give further particulars, and the judge at the assizes, to whom the summons was referred, gave leave unconditionally; on appeal, his decision was affirmed by the Divisional Court and ultimately by the Court of Appeal.

In *Rivett* v. *Grimshaw* (*a*), another case at assizes, the defendants gave notice only six days before the trial of their intention to adduce evidence of prior publication of two additional alleged anticipations, and objection being raised by the plaintiffs, Day, J., held that sufficient notice had been given.

§ 181. Such particulars should be given as with the pleadings give the opposite party a fair idea of the case

(*u*) *Edison Telephone Co.* v. *India Rubber Co.* (1880), L. R. 17 Ch. Div. 137.

(*x*) *Pascall* v. *Toupe* (1890), 7 R. P. C. 129. And see *Lang* v. *Whitecross Iron Co.* (1890), 7 R. P. C. 389.

(*y*) *Woolley* v. *Broad* (1892), 9 R. P. C. 429; *Wilson* v. *Wilson* (1899), 16 R. P. C. 315.

(*z*) (1891) 8 R. P. C. 353.

(*a*) (1894) 11 R. P. C. 351.

intended to be made against him (*b*). Particulars of want of novelty or of prior publication must be drawn with greater detail and accuracy than particulars of infringement (*b*). In cases where common knowledge is alleged, particulars of prior publication or user cannot be insisted on (*c*).

Infringements may be fairly presumed to be within an infringer's knowledge, but particulars may also be ordered of these as in patent cases, where particulars of alleged breaches are usually given.

§ **182.** Under the Rules of the Supreme Court, 1883, Ord. L., the widest powers of ordering an inspection are conferred on the various divisions of the High Court. The only practical limit to the discretion of the Court in designs, as in patent cases (*d*), is the necessity of the information claimed for the purposes of the trial (*e*).

Where the right to inspection appears to depend on the determination of any issue or question in the cause, the Court may, if it thinks fit, order that such issue shall be determined first, and reserve the question as to the inspection.

Samples may now be taken, observations made, and preliminary experiments conducted (*f*) where necessary for the purposes of the trial.

An application for inspection may be made either by plaintiff or defendant, and in exceptional cases will be granted *ex parte* (*g*). It may be made against a defendant at any time during the progress of an action, even before the delivery of claim (*h*); and, on the other

(*b*) *Ledgard* v. *Bull* (1886), 11 A. C. 648.

(*c*) *Holliday* v. *Heppenstall* (1889), 6 R. P. C. 320.

(*d*) For the practice as to patent cases, which applies generally to designs, see Edmunds on Patents.

(*e*) R. S. C. Ord. XXXI. r. 20.

(*f*) Ord. L. r. 3; cp. *Badische Anilin, &c.* v. *Levinstein*, L. R. 24 Ch. D. 146; *Germ Milling Co.* v. *Robinson* (1886), 3 R. P. C. 11.

(*g*) *Hennessy* v. *Bohmann*, W. N. (1877) 14.

(*h*) See R. S. C. Ord. L. r. 6; *Drake* v. *Muntz Metal Co.* (1886), 3 R. P. C. 43.

hand the express terms of Ord. L. r. 6, leave no doubt that an adverse order for inspection may also be made against the plaintiff (*i*). But more suspicion will not justify inspection against a defendant (*i*), nor will the Court order a roving inspection (*k*); nor will it make an order where the inspection might be injurious, and is not really essential for preparing for the trial of the action, and the right depends on a question which has yet to be determined (*l*).

Under Ord. L. r. 3, the Court may now authorise any person for the purpose of inspection to enter any land or building in the possession of any party. Obedience to an order for inspection may, therefore, be asserted forcibly, and not simply as before by process of contempt (*m*). The power to do this may be usefully employed in cases arising under the new provisions of sect. 60 (1a), which make it an infringement "to do anything with a view to enable the design to be applied."

§ **183.** The application, if in the Chancery Division, should be made by motion to the Court, and the ordinary notice of motion should be given (*n*). In the King's Bench Division the application is by summons to a judge in chambers (*o*).

Laches or delay sufficient to defeat the plaintiff's right to an interlocutory injunction are no bar to an order on the same or a subsequent motion for inspection and samples (*p*).

In order to succeed on an application for inspection the applicant must show by affidavit—

(*i*) *Germ Milling Co.* v. *Robinson*, *supra*; *Cheetham* v. *Oldham* (1888), 5 R. P. C. at p. 623; *Sidebottom* v. *Fielden* (1891), 8 R. P. C. 266.

(*k*) *Cheetham* v. *Oldham*, *supra*.

(*l*) *MacDougal* v. *Partington* (1890), 7 R. P. C. 472.

(*m*) *East India Co.* v. *Kynaston* (1821), 3 Bligh, 153, 163, 166.

(*n*) *Habershon* v. *Gill*, W. N. (1875) 231.

(*o*) Ord. LIV. r. 12.

(*p*) *Patent Type Founding Co.* v. *Walter* (1860), 29 L. J. Ex. 207.

1. That he is the registered proprietor of a design, and what it is (*q*).

2. That the defendant has probably infringed.

Primâ facie evidence of infringement will be sufficient (*r*); and if the *primâ facie* evidence is satisfactory, an order for inspection will be made, almost as of course (*s*).

3. That the inspection sought for is material to his case (*t*).

§ **184.** The Court will not grant an order for the inspection of a machine upon a mere statement "that the machine used by the defendants is the same for which the plaintiff has obtained a patent"; and the same rule applies to inspection of alleged infringements of registered designs. The affidavit ought, at least, to state that there is such a machine (or design), and that the plaintiff has reason to believe it is an infringement (*u*), and should set forth the grounds of such belief (*x*); and inspection will be refused where, in the opinion of the Court—(a) there is no case to try at the hearing (*y*), or (b) the effect of an order would be to oppress the defendant, or make him disclose more than was necessary for the purposes of the cause (*z*).

An objection that an order for inspection would lead to the disclosure of trade secrets will not generally prevail if the case for inspection is otherwise satisfactory (*a*). The Court will, however, protect the defendant from an

(*q*) *Meadows* v. *Kirkman* (1860), 29 L. J. Exch. 205.

(*r*) *Shaw* v. *Bank of England* (1852), 22 L. J. Ex. 26; *Cheetham* v. *Oldham* (1888), 5 R. P. C. 617.

(*s*) *Singer Manufacturing Co.* v. *Wilson* (1865), 13 W. R. 560.

(*t*) *Piggott* v. *Anglo-American Telegraph Co.* (1868), 19 L. T. N. S. 46.

(*u*) *Shaw* v. *Bank of England, supra.*

(*x*) *Germ Milling Co.* v. *Robinson* (1884), 1 R. P. C. 217.

(*y*) *Piggott* v. *Anglo-American Telegraph Co., ubi supra.*

(*z*) *Singer Manufacturing Co.* v. *Wilson, supra; Cheetham* v. *Oldham, supra.*

(*a*) *Renard* v. *Levinstein* (1864—65), per Wood, V.-C., 10 L. T. N. S. 95; *Cheetham* v. *Oldham, supra.*

improper disclosure; and where the party against whom inspection is ordered avers that it might disclose trade secrets, precautions may be taken by having the inspection made by some independent person, who will be required to report to the Court (*b*).

The order for inspection (*c*) usually specifies the number of inspections allowed, the names of the inspectors, and the notice to which the person against whom the order is made shall be entitled (*d*).

§ 185. The existing law as to discovery is contained in Ord. XXXI. of the Rules of the Supreme Court, 1883, as altered by the Rules of November, 1893, as to which reference should be made to the text and notes in the Annual Practice.

The chief provisions of the Order, so far as relate to actions of infringement, are as follows:—

The plaintiff or defendant in a designs action may, by leave of the Court or a judge, deliver interrogatories in writing for the examination of the opposite parties, or any one or more of such parties (*e*). Interrogatories which do not relate to any matters in question will be deemed irrelevant, notwithstanding that they might have been admitted on cross-examination (*f*).

On an application for leave to deliver interrogatories, the particular interrogatory proposed to be delivered must be submitted to the Court or judge. In deciding upon such an application, the Court or judge will take into account any offer which may be made by the party sought to be interrogated, to deliver particulars, or to make admissions, or to produce documents relating to

(*b*) *Plating Co.* v. *Farquharson* (1883), Griff. P. C. 187.

(*c*) For form of order for inspection, see Appendix B., *post*, p. 397.

(*d*) *Heathfield* v. *Braby*, cited Seton, 561. But see *Germ Milling Co.* v. *Robinson*, *supra*.

(*e*) Ord. XXXI. r. 1.

(*f*) *Ibid.*

the matters in question, or any of them, and leave will be given as to such only of the interrogatories submitted as the Court or judge shall consider necessary either for disposing fairly of the cause or matter or for saving costs (*h*).

§ 186. The Court or a judge has the same power to prevent premature discovery as to prevent premature inspection (*i*). But where an order for discovery is made against a defendant he must answer, technically and categorically, every question which can assist the plaintiff in making out his title to relief (*k*).

The following illustrations will show at once the application and the limits of this rule:—

In *De la Rue* v. *Dickinson* (*l*), Wood, V.-C., said that a defendant denying infringement must answer everything tending to show the fact of infringement, but not questions which assume that infringement has taken place, and answers to which will be obtained at the hearing if infringement be then established.

In *Moore* v. *Craven* (*m*), it was laid down that, although, when discovery is a matter of indifference to the defendant, the Court does not weigh in golden scales the question of materiality or immateriality, still, when the nature of the discovery required is such that the giving of it may be prejudicial to the defendant, the Court takes into consideration the special circumstances of the case, and whilst, on the one hand, it takes care that the plaintiff obtains all the discovery which can be of use to him, on the other it is bound to protect the defendant against undue inquisition into his affairs.

In *Daw* v. *Eley* (*n*), it was held that a plaintiff has no right

(*h*) Ord. XXXI. r. 2. In *Re Bayer's Design* (1906), 23 R. P. C. 553, an order for particulars was refused against the respondent, but interrogatories were allowed.

(*i*) Ord. XXXI. r. 20.

(*k*) *Swinborne* v. *Nelson* (1852—53), per Romilly, M.R., 22 L. J. Ch. 331; *Elmer* v. *Creasy* (1873), L. R. 9 Ch. 69.

(*l*) (1857) 3 K. & J. 398; *Lister* v. *Norton* (1885), 2 R. P. C. 68; *Lea* v. *Saxby* (1875), 32 L. T. N. S. 731.

(*m*) (1870) L. R. 7 Ch. 94, 96 n.

(*n*) (1865) 1 Eq. 38. But see *Lister* v. *Norton*, *supra*.

to inquire by interrogatories into the defendant's case, or to ask for the names of the witnesses whom he intends to produce, or the names of persons to whom he has sold articles similar to the articles alleged to be an infringement (*o*).

A corporation or company may be interrogated through any of its members or officers; but no person so interrogated can be compelled to answer as to matters of which he has obtained information in any other capacity than that of such member or officer (*p*).

Reports and letters obtained from their officers by a company which had been warned, but not threatened, with actual litigation, in respect of an alleged infringement of a patent, have been held not to be privileged from production (*q*).

§ 187. When an action for infringement of a design is brought claiming penalties under sect. 60 (2), the defendant cannot be compelled to answer interrogatories (*r*). It has been suggested that the law is the same if the action is brought for damages (*s*); but this seems to be contrary to the principle on which interrogatories are refused in penal actions, for the election of the plaintiff to proceed for damages excludes any liability to penal consequences under the Act.

This rule applies though other relief is claimed in the action, if the penalty claim is the substantial one or the information asked for would assist it.

In *Titus Astle, Ltd.* v. *Mansfield* (*t*) the registered proprietors of a design commenced an action for infringement, claiming

(*o*) As to administering interrogatories to a plaintiff, see *Hoffmann* v. *Postill* (1869), L. R. 4 Ch. 673; *Edison, &c. Co.* v. *Holland* (1888), 5 R. P. C. 213; *Morris* v. *Edwards* (1890), 15 App. Cas. 309.

(*p*) *Welsbach Co.* v. *New Sunlight Co.* (1900), 17 R. P. C. 401.

(*q*) *Westinghouse* v. *Midland Rail. Co.* (1883), 48 L. T. N. S. 98, 462; and cp. *Haslam Co.* v. *Hall* (1888), 5 R. P. C. 1.

(*r*) *Saunders* v. *Wiel* (1892), 9 R. P. C. 459.

(*s*) *Ibid.*, per Day, J., at p. 460, but the Court of Appeal refused to express any opinion on the point. Cf. *Adams* v. *Batley* (1887), L. R. 18 Q. B. D. 625.

(*t*) (1905) 22 R. P. C. 356.

an injunction, damages, or alternatively *penalties* and delivery up, and subsequently under an order elected to claim penalties and not damages, and amended their claim accordingly. The defendant denied infringement, and alleged the invalidity of the design. The plaintiffs then applied for leave to deliver interrogatories, some of them relating to the acts complained of and others to the issue of novelty. Held, that the action was substantially an action to recover penalties, and leave to deliver interrogatories refused.

In giving judgment, Swinfen Eady, J., after referring to the fact that there was no allegation in the statement of claim that there were any infringing goods in the possession or control of the defendant, or that he threatened or intended to continue the use of the design, said: "I look upon this action as substantially an action for penalties, although in form it also claims an injunction. The answer to these interrogatories might certainly assist in making the defendant liable for the penalties to recover which the action is brought; and, having regard not only to *Saunders* v. *Wiel*, but also to *Marborough* v. *Whitwood Urban District Council* (*u*), I look upon it substantially as an action for penalties in which the interrogatories ought not to be delivered."

§ 188. In answering interrogatories filed by a defendant for the examination of the plaintiff, the general rule applies, that he who is bound to answer must answer fully. There is, however, this difference: A plaintiff is not entitled to discovery of the defendant's case, whereas a defendant may ask any question tending to destroy the plaintiff's claim (*v*).

§ 189. On the question of method of trial there is no rule specially applicable to design actions, and the provisions of sect. 92 (1) of the new Act for referring certain appeals and petitions to a selected judge of the High Court do not affect ordinary cases of infringement or motions to expunge entries, etc. The parties to an action of infringement are therefore

(*u*) (1897) 2 Q. B. 11.

(*v*) *Hoffmann* v. *Postill* (1869), L. R. 4 Ch. 673. See *Rylands* v. *Ashley* (1890), 7 R. P. C. 175.

placed as litigants in any other action as regards right to a jury.

> In *The Patent Marine Inventions Co.* v. *Chadburn* (*x*), Lord Selborne, in speaking of trial of patent cases by jury, said: "It is to be observed that such cases almost always involve questions of law and fact, not only mixed, but mixed in such a way as to render the extrication of them extremely difficult; secondly, that very often much must depend upon the construction of documents, as to which a jury must take their direction entirely from the judge; thirdly, that much of the evidence, or that which is to be permitted to be given as evidence, in such cases is argumentative and relative to matters of opinion, so as to make it extremely hard, even for the judge himself, to keep it under proper control; and, lastly, that even the questions of fact are often, to a very great extent, questions of science, which, to say the least, are as likely to be as well decided by a judge as by any jury. It very rarely happens, if it ever does, when the thing is not reduced to a narrow question of fact, that the jury do not simply follow, after a very elaborate discussion of the case by the judge, the direction of the judge."

These remarks are applicable to design cases, though their force is somewhat lessened. Often the sole question to be determined is whether the one design is an imitation of the other, a matter to be settled by reference to the eye. In view of the considerable divergence of opinion which frequently manifests itself in imitation cases, many may prefer to take the decision of the twelve in preference to that of one, who must act as judge as well as jury. The opinion of the judge applying the test of the eye to an alleged infringement will sometimes be overruled by a Court of Appeal: thus in *Harper* v. *Wright & Butler* (*y*), the judge held, without going into the defendant's case, that there was no infringement, but on the hearing of the appeal the defendant's case was gone into to save a reference back to the Court below, and the appeal judges then held that the defendant had infringed.

(*x*) (1873) L. R. 16 Eq. 447.

(*y*) (1895) 12 R. P. C. 483.

There is no absolute right to a jury, but on application the Court will often order a trial by jury (*z*), and this may be done even in cases commenced in the Chancery Division, where there are issues of fact to be decided (*a*). The onus is on the party applying for trial by jury to show that the action is one which ought to be so tried (*b*).

§ 190. Where the case is tried by a judge and jury it is for the judge to say whether the requirements of the statute as to registration and otherwise have been complied with; but the question whether the registered proprietor has taken "all proper steps to ensure marking" is a question for the jury (*c*). So, of course, are the questions of novelty, as well as infringement (*d*).

§ 191. If the pleadings raise questions of law in the nature of a demurrer, these questions may be ordered to be decided as a preliminary before entering into any of the issues of fact (*e*). In such cases all allegations in the pleadings will be taken as admitted for the purpose of the argument, but this will, of course, be without prejudice to the subsequent trial of the issues of fact (*f*).

§ 192. Subject to the special provisions contained in the new Act (*g*), by which, after a certificate of validity has been granted, solicitor and client costs may be awarded to a registered proprietor in any subsequent action for infringement of his rights (these provisions

(*z*) R. S. C. Ord. XXXVI. rr. 4—6.

(*a*) *Jenkins* v. *Bushby*, [1891] 1 Ch. 484; *Sugg* v. *Silber*, L. R. 1 Q. B. D. 362.

(*b*) *Cook* v. *Ingram*, L. R. 35 Ch. D. 117.

(*c*) *Johnson* v. *Bailey* (1894), 11 R. P. C. 21.

(*d*) *McCrea* v. *Holdsworth* (No. 2) (1866), L. R. 1 Q. B. 264.

(*e*) See, *e.g.*, *Woolley* v. *Broad* (No. 1) (1892), 9 R. P. C. 208.

(*f*) Ord. XXV. rr. 1—3.

(*g*) Act of 1907, sect. 35.

being extended to designs by sect. 61), the ordinary rules as to costs will apply (*h*). When any action, cause, matter or issue is tried with a jury, the costs follow the event, unless the judge for good cause otherwise orders (*i*). In other cases the costs are awarded in the discretion of the Court (*k*).

Generally whether the action be on contract or in tort, a judge of the High Court may certify that there was sufficient reason for bringing the action in the High Court, or may otherwise by order allow costs on the High Court scale (*l*); and in one case where the validity of the design was attacked, but only 20*l.* was awarded, application was made for such a certificate, which was granted by the Court (*m*). But as, apparently, all actions for infringement should now properly be brought in the High Court, it is submitted that there is no occasion for such a certificate, and the costs (subject, of course, to the judge's discretion in a proper case) will always be on the High Court scale, whatever amount may be recovered (*n*).

§ 193. When there are distinct issues to be decided, the costs of each may be dealt with separately, and the costs of any issue awarded to the generally unsuccessful party, if the Court thinks fit.

In *Winfield* v. *Snow* (*o*) one of the pleas was "prior publication," and this was decided favourably to the defendant. The judge gave the general costs of the action and of the issue disposed of to the defendant, reserving the costs of the other issues.

(*h*) R. S. C. Ord. LXV.
(*i*) Ord. LXV. r. 1.
(*k*) *Ibid.* See *Sherwood* v. *Decorative Tile Co.* (1887), 4 R. P. C. 207, where only two-thirds of the costs were allowed on the ground of the inclusion of improper evidence.
(*l*) The County Courts Act (51 & 52 Vict. c. 43), s. 116.
(*m*) *Churd* v. *Cory* (1892), 9 R. P. C. 423.
(*n*) See *ante*, p. 176 *et seq.*
(*o*) (1891) 8 R. P. C. 15.

In *Blank* v. *Footman & Co.* (*p*) the defendant raised several defences, and upon one of them, which practically decided the action (prior publication), the judge found for the defendant, on another (marking) for the plaintiff; other defences were simply pleaded and were not argued out. Kekewich, J., said: "The defendant is entitled to put his back against the wall and to fight from every available point of advantage. I think that it would be extremely hard on defendants if as a rule they were told at the end of the trial, 'You have beaten the plaintiff, but because you have raised some points on which you have not succeeded you shall not have all the costs of the action.' And it is obvious that it might lead to lengthening trials if counsel understood that unless they fought out every point the clients would not be allowed their costs even in a successful case. On the other hand, it is a useful rule that where there is a distinct issue on which the generally successful party has failed and that issue has really no immediate connection with those upon which the party has succeeded, then he ought not to have the costs of that issue which presumptively ought never to have been raised. As regards the fifth and sixth defences, though perhaps they might as well have been left out, still they were fair points to raise, and on the principle I have mentioned I do not think that the defendants ought to be mulcted in costs, because succeeding on the whole they have not succeeded on them. But as regards the marking, that issue has been argued out, and there has been evidence directed to it, and I have held distinctly in favour of the plaintiff on that point. I think that the plaintiff ought to have the costs of that issue as against the general costs of the action."

Birkin v. *Pratt* (*q*) was an action for infringement of a registered design for lace, and it was held at the trial that there was no infringement, the differences between the two patterns being so considerable that the one could not be mistaken for the other. The defendants further alleged that the plaintiffs' design was not novel or original; but this was not proved at the trial, and the costs of this issue were, therefore, given to the plaintiffs, though the defendants were awarded the general costs of the action.

In *Pearson* v. *Wilkinson* (*r*) the plaintiff was the owner of registered designs for the bodies of perambulators, and brought an action against W. & Co. for infringement of the shape and pattern; the defendants thereupon moving to expunge on the ground of anticipation and want of title. It was established at the trial that the pattern was old and had

(*p*) (1888) 5 R. P. C. 653. (*q*) (1895) 12 R. P. C. 371.
(*r*) (1906) 23 R. P. C. 738.

not been infringed, but that the shape of the sides and top of the body was now for perambulators and had been taken.

The motion was dismissed with costs on the ground that the designs were novel. In the action an injunction was awarded, but without costs, plaintiff having failed to prove infringement in regard to pattern as alleged.

In giving judgment Kekewich, J., said: "Though I hold the plaintiffs to be entitled to an injunction on the matter of shape, I hold them to have failed as regards pattern, and my way of dealing with the costs of the action is that I give them no costs."

In *Demartial* v. *Booth* (*s*), where the plaintiff moved for an injunction, and defendant moved to rectify the register, and both motions failed, each was dismissed with costs.

In *Cooper* v. *Symington* (*t*) the plaintiffs moved for an injunction, but failed to obtain it, for the reason that their invention was not subject-matter for registration as a design; the defendants denied infringing, but could not sustain this defence, and the motion for an injunction was refused without costs; but the motion of the defendants to rectify the register was allowed with costs.

§ 194. Costs on the higher scale may be allowed in a fit case (*u*); but on application for an interlocutory injunction costs on the higher scale will not ordinarily be allowed, though the points raised be important (*x*). The costs of a motion, unless by agreement it is treated as the trial of the action, will usually be reserved; though if it is clear that the whole question is before the Court, and that the party defeated on the motion cannot succeed at the trial, costs will be given (*y*).

§ 195. If the defendant offers to submit to an injunction or promises no longer to infringe, it will depend upon circumstances whether he will be ordered to pay the costs incurred subsequently to his submission. The real point for determination is, whether the plaintiff

(*s*) *Demartial* v. *Booth* (1892), 9 R. P. C. 499.

(*t*) (1893) 10 R. P. C. 264.

(*u*) R. S. C. Ord. LXV. r. 9. See *Dunlop* v. *Wapshare Tube Co.* (1900), 17 R. P. C. 433.

(*x*) *Grafton* v. *Watson* (1884), 51 L. T. N. S. 141.

(*y*) *Walker* v. *Scott* (1892), 9 R. P. C. 482.

must go on with his proceedings to secure his rights or whether he is already sufficiently protected by the surrender of his opponent. This is practically the same question as arises when the acts of the defendant are claimed to have disentitled the plaintiff to an injunction (*z*). The plaintiff is generally entitled to go on if there be any doubt, at any rate until he has obtained his injunction (*a*), but the Court will use its discretion on the facts of each case.

The following cases are illustrative of these rules:—

Cooper v. *Whittingham* (*b*). The defendants were sued for infringement under the Copyright Act, 1842, and an injunction was asked for to restrain a sale; they pleaded that when they received the copies they at once recognised the piracy, and determined not to sell. Jessel, M.R., however, ordered them to pay the costs of the motion, saying: "As I understand the law as to costs it is this, that where the plaintiff comes to enforce a legal right, and there has been no misconduct on his part—no omission or neglect which would induce the Court to deprive him of costs—the Court has no discretion, and cannot take away the plaintiff's right to costs."

Upmann v. *Forester* (*c*). The defendant (a china merchant) purchased abroad, for his own private use, some cigars, which were consigned to him at the docks; they bore a spurious brand, purporting to be that of the plaintiffs. When plaintiffs issued their writ and served a notice of motion for an injunction, the defendant stated to them that he had no intention of selling the cigars, offered all relief asked for by the writ, and, when the motion came on, agreed to an undertaking in the terms of the writ. Chitty, J., decided that the defendant must pay the costs, but added: "The result of my decision, however, will not be, as the defendant has suggested, that every purchaser of a small parcel of spurious goods incurs a liability to pay the costs of an action in the Chancery Division for infringing a patent or trade mark. I cannot pass over the fact that there is in the present case a large consignment of

(*z*) See *Proctor* v. *Baily* (1889), 42 Ch. Div. 390; *Upmann* v. *Elkan* (1871), 7 Ch. 130; *Millington* v. *Fox* (1838), 3 My. & Cr. 338.

(*a*) *Colbourne* v. *Simons* (1843), 12 L. J. Ch. 338; *Nunn* v. *Albruquerque* (1865), 34 Beav. 595; *Geary* v. *Norton* (1846), 1 De G. & Sm. 9.

(*b*) (1880) L. R. 15 Ch. Div. 501.

(*c*) (1883) L. R. 24 Ch. Div. 231. And see *Grace* v. *Newman*, 19 Eq. 623; 44 L. J. Ch. 298.

goods—5,000 cigars is rather a large order for personal consumption—and the plaintiffs were justified in suspecting that so large a consignment was intended for distribution."

Wittmann v. *Oppenheim* (*d*). This was an action to restrain infringement of copyright in a registered design, and plaintiffs moved for an injunction. Defendant stated that he sold the lamps complained of innocently, and that he received no notice that he was infringing until issue of the writ. Pearson, J., ordered the defendant to pay the costs. He said: "I should be very willing to make no order as to costs, but, looking at the decision in *Upmann* v. *Forester* (*e*), and to the rule there stated by Chitty, J., with which I entirely agree, I am afraid I have no choice. It is said that the plaintiffs issued their writ without notice to the defendant, and that the defendant, as soon as he had notice of the plaintiff's title, did his best to undo what he had done. But, at the same time, I cannot say that the plaintiffs were wrong in issuing their writ without notice, and after that the only offer which the defendant could properly make was to submit to an injunction and to pay the costs."

American Tobacco Co. v. *Guest* (*f*). In this case the owner of a registered trade mark moved for an injunction to restrain infringement. The defendant, who had at one time made purchases from the plaintiff, bought a few articles from another firm, believing them to be the plaintiff's, and he offered to abide by any order made by the Court. Stirling, J., granted the injunction, but refused the plaintiff his costs. He said (referring to *Upmann* v. *Forester*) (*g*): "In that case, there being that large amount of goods, Mr. Justice Chitty made an order for payment of the costs. Here there are only 500 cigarettes, valued at 17*s.* 6*d.*, and I think that under those circumstances I am justified in excepting, as I think Mr. Justice Chitty would have excepted, this case from the operation of the rule which he laid down in *Upmann* v. *Forester*, by saying that there ought to be no costs."

In *Lyon* v. *Mayor, &c. of Newcastle-upon-Tyne* (*h*) plaintiff discovered that the Corporation of Newcastle were in possession of a machine made in infringement of his patent; the

(*d*) (1884) 27 Ch. Div. 260. But as the defendant was merely the vendor, *semble* he ought not to have been put under an injunction, in the absence of knowledge that the plaintiff's design was registered. See sect. 58 (b) of the Act of 1883, also sect. 7 of the Act of 1842. And see *Smith* v. *Lewis, Roberts & Co.* (1888), 5 R. P. C. 611, 617.

(*e*) *Supra.*

(*f*) (1892) 9 R. P. C. 218.

(*g*) *Supra.*

(*h*) (1894) 11 R. P. C. 218.

town clerk stated to the plaintiff that the Corporation did not dispute the patent, had never used the machine, and did not intend to use it, and undertook not to use it. The plaintiff's solicitors would not accept this nor any other undertaking, and moved for an injunction. On the undertaking being given to the Court, the motion was dismissed with costs.

Jan v. *Grossmann* (*i*). This was an action for infringement of a registered design for powder puffs. The defendant admitted that he had purchased three powder puffs infringing the design, one of which he had sold to an unknown customer, and another to the plaintiff, on which occasion he first was informed that the puffs were an infringement. The defendant then at once promised to sell no more, and removed the third puff from his shop window, but the defendant declined to give a formal undertaking demanded by the plaintiff's solicitor not to sell any more. The plaintiff then commenced an action, and, on admissions in the defence, took out a summons for judgment under Ord. XXXII. r. 6, contending that, as the defendant admitted that he had still an infringing article in his possession, he ought to have given the undertaking, and that the plaintiff was therefore entitled to an injunction.

In giving his judgment dismissing the action with costs as a useless and trumpery action, Kekewich, J., after referring to *Smith* v. *Lewis, Roberts & Co.*, said: "The defendant has really been guilty of no offence under the statute, looking at it in the most technical way. He never has sold, offered for sale, or threatened to sell or offer for sale, any of these puffs since he knew they were an infringement of a registered design."

In *Hanfstaengl* v. *W. H. Smith & Sons* (*k*), however, which was an action for infringement of copyright in a valuable painting, the same judge, while awarding nominal damages, allowed the plaintiff his full costs, adding: "There is no occasion to grant an injunction, as the infringement was promptly suppressed; but I adopt the plaintiff's argument that, if he desires to protect his copyright, he is bound to take action even in a case which is, on the face of it, of a trumpery character, or run the risk of encouraging more serious infringements."

(*i*) (1895) 12 R. P. C. 537.

(*k*) (1905) 21 T. L. R. 291. And see *Werner Motors* v. *Gamage's* (1904), 21 R. P. C. 137.

CHAPTER XII.

OFFENCES UNDER THE ACT AND OTHER PROCEEDINGS.

(*The full references to all the Reports will be found in the Table of Cases ante.*)

§ 196. Making False Entries or Copies a Misdemeanour.
§ 197. Fines for False Descriptions—*Reg.* v. *Wallis*; *Sen Sen* v. *Britten*.
§ 198. Misrepresentation by use of Registration Marks.
§ 199. Unauthorized use of Royal Arms.
§ 200. Prosecution of Offences in Scotland and Ireland.
§ 201. Offences Abroad under Foreign Jurisdiction Acts.
§ 202. Action for Threats of Legal Proceedings.
§ 203. Circulars and Warning Letters—Burden of Proof.
§ 204. Institution of Proceedings—Dissolution of Injunction.
§ 205. Damages and Costs in Threats Actions or Common Law Proceedings.

THE Act of 1883 created various new offences which were punishable by criminal process, and these provisions are maintained and extended by the new Act.

§ 196. Any person who makes or causes to be made a false entry in the register kept under the Act, or a writing falsely purporting to be a copy of an entry in the register, or who produces or tenders in evidence any such writing, knowing it to be false, is guilty of a misdemeanour (*a*).

It is specially provided that the punishment for a misdemeanour under the Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding 100*l.*, at the discretion of the Court (*b*).

§ 197. If any person falsely describes any design applied to any article sold by him as registered, he is liable, on summary conviction, to a fine not exceeding 5*l.* for every offence (*c*).

(*a*) (1907) Sect. 89 (1). (*b*) (1907) Sect. 96 (2).
(*c*) (1907) Sect. 89 (2).

The fine is "for every offence," and this involves a separate fine for each copy sold (*d*). The offence is equally committed whether the registration mark is used before registration has been effected (*e*) or after the period of copyright protection has expired (*f*). The burden is on the defendant in such a case to justify the use of the mark, and he may do this by showing there is no misrepresentation in fact (*g*).

The following cases are illustrative:—

> In *Reg.* v. *Wallis* (*e*) the defendant was selling a lamp as a patented article when no patent had been granted for it, although a provisional specification had been filed to which caveats had been entered, and it was held that the burden was on the defendant to prove the patent under which he justified the use of the word "patent"; that he was not entitled to use that term because a provisional specification had been filed; and that, not having justified his use of the term, a fine must be imposed under the section.
>
> In *Leather Cloth Co.* v. *American Leather Cloth Co.* (*h*) Lord Kingsdown said: "If a trade mark represents an article as protected by a patent when, in fact, it is not so protected, it seems to me that such a statement *primâ facie* amounts to a misrepresentation of an important fact, which would disentitle the owner of the trade mark to relief in a Court of equity against any one who pirated it. . . . If the word 'patent' be not so used as to indicate the co-existing protection of a patent, but merely as part of the designation of an article known in the market by that term, nobody is meant to be deceived or is deceived. A patent may have expired and be known to have expired fifty years ago, and yet the name 'patent' may have become attached to the article and be used in the trade as designating it; but if the trade mark represents

(*d*) *Reg.* v. *Crampton* (1886), 3 R. P. C. 367, where the full fine of 5*l.* was imposed on one summons, the application for twelve other summonses in respect of other sales to the same prosecutors being withdrawn. Cf. *Ex parte Beale* (1868), L. R. 3 Q. B. 387, and the other cases cited on penalties claims, *ante*, p. 161 *et seq.*

(*e*) *Reg.* v. *Wallis* (1886), 3 R. P. C. 1; *Reg.* v. *Crampton*, *supra*.

(*f*) Sect. 89 (4). And see *Cheavin* v. *Walker* (1877), L. R. 5 Ch. Div. 850.

(*g*) *Sen Sen Co.* v. *Britten* (1899), 16 R. P. C. 137; *Marshall* v. *Ross* (1869), L. R. 8 Eq. 637.

(*h*) 11 H. L. C. 543.

the article as protected by patent, when in fact it is not so protected, I cannot think that it can make any difference whether the protection never existed or has ceased to exist."

In *Cheavin* v. *Walker* (*i*) the label containing the description of the plaintiff's filters as patented (the patent having, in fact, lapsed) was surmounted by a medallion containing the Royal Arms, with the words "By Her Majesty's Royal Letters Patent," and it was held that this constituted a false representation, which disentitled the plaintiff to relief, although apparently (per Baggallay, L.J.) there would have been no misrepresentation in the use of the description, including the word "patent," by itself, without the medallion and added words. In giving judgment Jessel, M.R., said: "No doubt a man may use the word 'patent' so as to deceive no one. It may be used so as to mean that which was a patent but is not so now. In other words, you may state, in so many words, or by implication, that the article is manufactured in accordance with a patent which has expired. But if you suggest that it is protected by an existing patent, you cannot obtain the protection of that representation as a trade mark."

In *Sen-Sen Co.* v. *Britten* (*j*), the plaintiff had for several years imported and sold cachous in distinctive packets, with the mark "Sen-Sen" on them, and the words "trade mark" below, but the mark was not registered. Held, that the plaintiffs had not made such a misrepresentation as to deprive them of the right to an injunction, and that the use of the words "trade mark" do not necessarily represent that it is registered.

§ 198. The statute further provides (*k*) that a person is to be deemed to represent that the design applied to an article is a registered design if he sells the article with the word "registered," or any word expressing or implying that there is a subsisting copyright in the design, stamped on or otherwise applied to it.

Registration dates from the day on which the application is handed in to the Comptroller's Office (*l*), but the registration is not complete until the sealing of the certificate of registration by the Comptroller; and on the analogy of patents it would not be safe or proper to

(*i*) (1877) L. R. 5 Ch. Div. 850.
(*j*) (1899) 16 R. P. C. 137.
(*k*) (1907) Sect. 89 (3).
(*l*) Act of 1907, sect. 49 (5).

issue articles with the registration mark affixed until the certificate has been obtained (*m*).

The old Acts (*n*) contained express provisions prohibiting the use of the registration marks either before registration of the design or "after the copyright of such design shall have expired," and these latter words, which were omitted from the statute of 1883, have now been re-enacted (*o*); but the penalty was only imposed on persons unlawfully applying the registration marks or selling articles with knowledge of such unlawful application, and it is submitted that the present section would have only the same effect, so that a *bonâ fide* sale after expiry of the copyright would be exempted (*p*).

§ **199.** Any person who, without Royal authority, uses, in connection with any business or profession, the Royal Arms or arms resembling them in such a manner as to be calculated to deceive, by leading other persons to believe that he is duly authorised to use the arms, is made liable, on summary conviction, to a fine not exceeding 20*l.* (*q*).

§ **200.** In Scotland offences may be prosecuted in the Sheriff Court (*r*); in Ireland, in the Courts prescribed by the Summary Jurisdiction Acts (*s*); and in the Isle of Man, in the manner in which offences punishable on summary conviction may be prosecuted (*t*).

§ **201.** Under the provisions of the Foreign Jurisdiction Acts various Orders in Council have been issued,

(*m*) *Reg.* v. *Wallis* (1886), 3 R. P. C. 1.

(*n*) (1842) Sect. 11; (1843) Sect. 4.

(*o*) (1907) Sect. 89 (4).

(*p*) See *Cheavin* v. *Walker* and *Sen-Sen Co.* v. *Britten*, *supra*.

(*q*) (1907) Sect. 90 (2).

(*r*) (1907) Sect. 94 (2).

(*s*) The Act of 1883 contained a special provision (sect. 117) to this effect, but this is not repeated in the present Act.

(*t*) (1907) Sect. 96 (3).

extending to certain parts of Africa (*u*), to Morocco (*x*), to Persia, its coast and islands (*y*), and to the Somali Coast (*z*), the penalties for offences under the 1883 Act, in the same way as if such offences had been committed in the United Kingdom or a British possession.

The Foreign Jurisdiction Act, 1890 (*a*), repealed all the previous Acts extending from 1843 to 1878, and consolidated their provisions; but all the Orders in Council made under the old Acts were preserved in force, and were declared to have the same effect as if made under the new Act (*b*). These Orders in Council continue in force under the 1907 Act, notwithstanding the repeal (for other purposes) of the Act of 1883, to which they applied (*c*).

§ 202. The Act of 1907 creates a new action in the nature of malicious libel for the protection of persons interested in designs who are subjected to groundless threats of legal proceedings. It is declared (*d*) that the provisions of the Act with regard to the remedy in cases of groundless threats of proceedings by a patentee shall apply in the case of registered designs in the same manner as they apply in the case of patents. The provisions referred to are contained in sect. 36 of the Act, which enacts—

> 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 infringement of the patent, any person aggrieved thereby may bring an action against him, and may obtain an injunction against the continuance of such threats, and may

(*u*) Order of 15th October, 1889.
(*x*) Order of 28th November, 1889.
(*y*) Order of 13th December, 1889.
(*z*) *Ibid.*

(*a*) 53 & 54 Vict. c. 37, s. 18.
(*b*) *Ibid.* sect. 118 (1)
(*c*) (1907) Sect. 98 (1), proviso.
(*d*) Act of 1907, sect. 61.

recover such damage (if any) as he has sustained thereby, if the alleged infringement 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.

§ 203. This enactment continues the old law applying to patents (*f*), and under this it was held that a circular may be a threat sufficient to support proceedings under the section, though addressed to no one in particular (*g*). Where, however, the circular amounts only to a general warning, and no threat is held out, an action under the section cannot be maintained (*h*). The plaintiff must prove that he is not in fact infringing; and the Court has in any case a discretion as to granting an injunction (*i*).

§ 204. The proviso exempts any person making the threats if he with due diligence commences and prosecutes an action for infringement, and it has been held under this that an owner is not bound to start actions against every person whom he threatens, but it is sufficient if he has brought one *bonâ fide* action against any alleged infringer. If he undertakes to prosecute proceedings for the alleged infringement with due diligence an injunction will not usually be granted (*k*). And an injunction already granted may in some cases be dissolved on the action for infringement being brought (*l*). The proceedings must, however, be *bonâ fide* and prosecuted with due diligence, or an injunction against the continuance

(*f*) Act of 1883, sect. 32. See the notes to sect. 98 (1), *post*.

(*g*) *Johnson* v. *Edge* (1891), 9 R. P. C. 142.

(*h*) *Bishop* v. *Inman* (1900), 17 R. P. C. 479. And see *Crowther* v. *United Flexible Co.* (1905), 22 R. P. C. 549.

(*i*) *Walker* v. *Clarke* (1887), 4 R. P. C. 111.

(*k*) *Mackie* v. *Laundry Supply Co.* (1891), 9 R. P. C. 465.

(*l*) *Engels* v. *Hubert Syndicate* (1902), 19 R. P. C. 201.

of threats or advertisements will be granted, notwithstanding their institution (*m*).

§ 205 Damages representing the solicitor and client costs incurred in defending proceedings which were not *bonâ fide* and have not been prosecuted with due diligence may be granted in such cases (*n*).

In addition to the remedies under the statute, damages may be claimed at common law for injurious statements affecting the plaintiff's right to sell his goods; and on such a claim the fact that an action for infringement has been brought would be no answer if there is substantial evidence of actual *mala fides* (*o*).

(*m*) *Challender* v. *Royle* (1887), 4 R. P. C. 363; *Haskell Golf Ball Co.* v. *Hutchison and Main* (1904), 21 R. P. C. 497. But see the recent case of *Craig* v. *Dowding* (1907), reported in L. J. N. C. (1907) p. 654; and on appeal, *Ibid.* (1908) p. 39.

(*n*) *Bishop* v. *Inman* (1900), 17 R. P. C. 479; *Craig* v. *Dowding*, *supra*. See also *Kurtz* v. *Spence* (1888), 5 R. P. C. 161; and *Lycett* v. *Brooks* (1904), 21 R. P. C. 656.

(*o*) *Sugg* v. *Bray*, 2 R. P. C. 223. But see *Reid* v. *Thomson* (1905), 22 R. P. C. 376.

PART II.

THE
PATENTS & DESIGNS ACT, 1907,

AND THE REPEALED

PATENTS, DESIGNS & TRADE MARKS ACTS, 1883 to 1888

(So far as they relate to Designs),

Compared and Noted.

(The text of the Act of 1907 *is set out in large type. The corresponding sections in the repealed Acts are printed in* italics, *and the notes in smaller type.)*

ARRANGEMENT OF SECTIONS.

PART I.—PATENTS.

Sections 1 to 48.

PART II.—DESIGNS.

Registration of Designs.

SECT.
49. Application for registration of designs.
50. Registration of designs in new classes.
51. Certificate of registration.
52. Register of designs.

Copyright in registered Designs.

53. Copyright on registration.
54. Requirements before delivery on sale.
55. Effect of disclosure on copyright.
56. Inspection of registered designs.
57. Information as to existence of copyright.
58. Cancellation of registration of designs used wholly or mainly abroad.

Industrial and International Exhibitions.

59. Provisions as to exhibitions.

Legal Proceedings.

60. Piracy of registered design.
61. Application of certain provisions of the Act as to patents to designs.

PART III.—GENERAL.

Patent Office, and Proceedings thereat.

SECT.
62. Patent Office.
63. Officers and clerks.
64. Seal of Patent Office.

Fees.

65. Fees.

Provisions as to Registers and other Documents in Patent Office.

66. Trust not to be entered in registers.
67. Inspection of and extracts from registers.
68. Privilege of reports of examiners.
69. Prohibition of publication of specification, drawings, &c. where application abandoned, &c.
70. Power for comptroller to correct clerical errors.
71. Entry of assignments and transmissions in registers.
72. Rectification of registers by court.

Powers and Duties of Comptroller.

73. Exercise of discretionary power by comptroller.
74. Power of comptroller to take directions of law officers.
75. Refusal to grant patent, &c. in certain cases.
76. Annual reports of comptroller.

Evidence.

77. Evidence before comptroller.
78. Certificate of comptroller to be evidence.
79. Evidence of documents in Patent Office.
80. Transmission of certified printed copies of specifications, &c.
81. Applications and notices by post.
82. Excluded days.
83. Declaration by infant, lunatic, &c.

Register of Patent Agents.

84. Register of patent agents.
85. Agents for patents.

Powers, &c. of Board of Trade.

86. Power for Board of Trade to make general rules.
87. Proceedings of the Board of Trade.
88. Provision as to Order in Council.

Offences.

89. Offences.
90. Unauthorised assumption of Royal Arms.

International and Colonial Arrangements.

91. International and Colonial arrangements.

Definitions.

SECT.
92. Provisions as to "the court."
93. Definitions.

Application to Scotland, Ireland, and the Isle of Man.

94. Application to Scotland.
95. Application to Ireland.
96. Isle of Man.

Repeal, Savings, and Short Title.

97. Savings for prerogative.
98. Repeal and savings.
99. Short title and commencement.
SCHEDULES.

PATENTS AND DESIGNS ACT, 1907.

(7 EDW. VII. CH. 29.)

An Act to consolidate the enactments relating to Patents for Inventions and the Registration of Designs and certain enactments relating to Trade Marks.

[28th August 1907.]

BE it enacted by the King's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

PART I.—PATENTS.

(Sects. 1—48 relate exclusively to *patents* except sects. 27, 39 and 35, 36, which are incorporated in the law of designs by sects. 58 and 61 respectively, and are set out in full under those sections, *post*, pp. 239, 241, and 250, 251.)

PART II.—DESIGNS.

Registration of Designs.

Application for registration of designs.

49.—(1.) The comptroller[1] may, on the application made in the prescribed form and manner[2] of any person[3] claiming[4] to be the proprietor[5] of any new or original[6] design not previously published[7] in the United Kingdom,[8] register[9] the design under this Part of this Act.

Sect. 49.

(2.) The same design may be registered in more than one class,[10] and, in case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.

(3.) The comptroller may, if he thinks fit, refuse to registor[11] any design presented to him for registration, but any person aggrieved by any such refusal may appeal[12] to the Board of Trade, and the Board[13] shall, after hearing the applicant and the comptroller, if so required, make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(4.) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within the prescribed time[14] shall be deemed to be abandoned.[15]

(5.) A design when registered shall be registered as of the date of the application[16] for registration.

[Act of 1883, sect. 47.]

47.—(1.) *The comptroller may, on application by or on behalf of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this part of this Act.*

(2.) *The application must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the Patent Office in the prescribed manner.*

(3.) *The application must contain a statement of the nature of the design, and the class or classes of goods in which the applicant desires that the design be registered.*

(4.) *The same design may be registered in more than one class.*

(5.) *In case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.*

(6.) *The comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal therefrom to the Board of Trade.*

(7.) *The Board of Trade shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.*

Sect. 49.

48.—(1.) *On application for registration of a design the applicant shall furnish to the comptroller the prescribed number of copies of drawings, photographs, or tracings of the design sufficient, in the opinion of the comptroller, for enabling him to identify the design; or the applicant may, instead of such copies, furnish exact representations or specimens of the design.*

[Act of 1883, sect. 48.]

(2.) *The comptroller may, if he thinks fit, refuse any drawing, photograph, tracing, representation, or specimen which is not, in his opinion, suitable for the official records.*

[1] *The comptroller.*—An official appointed under the Act of 1883 (sects. 82 and 83), and continued by this Act (sects. 62 (2) and 63), with, so far as designs are concerned, similar powers and duties to the former Registrar of designs (5 & 6 Vict. c. 100, s. 14; 6 & 7 Vict. c. 65, s. 7).

His full title is the Comptroller-General of Patents, Designs and Trade Marks (Act of 1907, sect. 3 (1)), and he acts under the superintendence and direction of the Board of Trade. (See sect. 62 (2), *post*.) The Registrar of Designs and Trade Marks is appointed by the Board to act for the Comptroller-General in all matters relating to designs. (See sect. 87.)

[2] *Application in the prescribed form.*—See definition of "prescribed" in sect. 93, *post*. The Act provides (sect. 86) for the issue of general rules (a) for regulating the practice of registration; (b) for classifying goods; (c) for making drawings and other instruments. The provisions as to drawings, &c. to be supplied, and as to other particulars to be included in the application, are now comprised in Rules 13—30, *post*, p. 295 *et seq*.

The former provisions were contained in the Act itself, sect. 47 (2) and (3), *above*, and sect. 48, as set out above.

In the Schedule to the 1883 Act, Sched. E., which contained the form of application in which the section prescribed that the application was to be made, nothing was said about the design being applicable for one matter or the other; all that the applicant was required to state was the nature of the design. In the Rules the form was accompanied by a note which interpreted the "nature of the design" as including such matters as "whether applicable to pattern, shape, or configuration"; but it was held that this did not import a condition which would limit the effect of the design when registered, and, there being no such condition, the person registering was not limited to some part or to some effect of his design: *Re Rollason's Design* (1898), 15 R. P. C. at p. 446.

An application must now be made in Form 2 or (for a set) Form 3

Sect. 49.

or (for lace) Forms 4 or 5 (Rules of 1908, Rules 14, 15), and must be signed by the applicant or his agent (Rule 13).

The form must be stamped with the proper fee (Rule 3 and sect. 65). The fees are set out in 1st Schedule to the Rules (*post*, p. 318). Properly stamped forms can be obtained through any Money Order Office in the United Kingdom. (See Instructions to Persons who wish to Register, *post*, p. 400.)

An application may be amended (Rule 63). See form for correction of clerical error, Form 17, *post*, p. 382. (See also sect. 70, *post*.)

Power is given to the Comptroller to dispense with the signature to an application, and to make other relaxations of the Rules upon good cause shown (Rule 62).

The applicant must state in the form of application the class in which the design is to be registered, and the article or articles to which it is to be applied, and where required by the Comptroller he must also state for what purpose the article to which the design is to be applied is used, and further endorse on the application a brief statement of the novelty he claims for his design (Rules 18, 19).

The description of a design for the register must be of the exact form in which it is intended to sell it, for no portion of the design claimed can be rejected and protection be still retained for the rest: *semble*, Wills, J., *Smout* v. *Slaymaker* (1890), 7 R. P. C. 90.

But there may be a registration of a design as a whole ("for the totality") which will be good though some of the parts—*e.g.*, shape or configuration—could not be supported alone. (Per Lord Herschell in *Harper* v. *Wright and Butler* (1895), 12 R. P. C. at p. 490.) And a registration will not be invalidated because the applicant for the design has sold as registered something which is not covered by the registered design: per Warrington, J., *In re Bayer's Design* (1906), 23 R. P. C. 553.

[3] *Any person.*—This clearly includes a foreigner: *Guiterman's Design* (1886), 55 L. J. Ch. 309. There was an express enactment in the Act of 1861 (24 & 25 Vict. c. 73, s. 1) that the privileges of the Designs Acts should extend to any proprietor, whether a British subject or not. The rights of a foreigner registered under the Act of 1883 were subject to the provision in sect. 54 that he manufactured in this country within six months; and sect. 58 of the present Act provides that the registration may be cancelled *at any time* if the design is manufactured exclusively or mainly outside the United Kingdom.

Where an applicant lives abroad he must furnish the Comptroller with an address for service in the United Kingdom, and until he does so the Comptroller need not proceed with the examination of his application. And where a registered proprietor lives out of the United Kingdom and has not furnished such address for service, the Comptroller need not send to him any notice which under the Rules he is required to send (Rule 11).

"Person" includes a body corporate, and the singular includes the plural (52 & 53 Vict. c. 63, s. 1, *post*, p. 371), so that joint owners may register; and an application may be signed by any member of a firm or partnership on its behalf, or by a director or other officer on behalf of a body corporate (Rule 8).

Sect. 49.

[4] *Claiming.*—It is no part of the Comptroller's duty to adjudicate on the rights of rival claimants to the proprietorship of a design. Each claimant may register the design, and their respective rights can be settled by an application to the Court to expunge under sect. 72.

The Comptroller has, however, power to refuse to register any design presented to him for registration (see note [11] on sub-sect. 3, *infra*); and the Act contemplates that such refusal may be made on the ground of identity of the design sought to be registered with a design already on the register. (See the proviso in sect. 56.) For other grounds of refusal, see sect. 75 and notes thereon, *infra*.

[5] *Proprietor.*—For the definition of "proprietor," see sect. 93 and notes thereon, *infra*.

[6] *New or original.*—These qualifying words in the disjunctive form appear in the Act of 1843 (designs for articles of utility), but the corresponding words in the earlier Act of 1842 (ornamental designs) are new *and* original. The same form was used in sect. 61 of the 1883 Act, and appears in the definition of "proprietor" in the present Act (see sect. 93, *infra*), so that the decisions as to novelty or originality under the previous Acts will still apply. (See Chap. III. on "Novelty," *ante*.)

A distinction between "new" and "original" was drawn in *Sherwood* v. *Decorative Art Tile Co.* (1887), 4 R. P. C. 207; and the point was also discussed in the subsequent cases of *Re Clarke's Design* (1896), 13 R. P. C. 351, and *Re Rollason's Design* (1897), 14 R. P. C. 909.

The novelty required by the Act is not novelty in the idea, but novelty in the design, that is, novelty in the way in which the idea is to be rendered applicable to some special subject-matter: *Saunders* v. *Wiel* (1893), 10 R. P. C. 29; see also *Harrison* v. *Taylor* (1859), 29 L. J. Ex. 3; *Thom* v. *Sydall* (1872), 26 L. T. N. S. 15. So that the mere fact that what is applied to an article of manufacture is common property does not render the design as thus applied bad for want of novelty: *Ibid.*; and see *Pearson* v. *Wilkinson* (1906), 23 R. P. C. 738.

The Act contains special provisions as to registrations of designs in new classes not being invalidated by reason of previous registrations in other classes. (See sect. 50 and note thereon, *post*.)

The useful purpose which the shape or configuration of the design is intended to serve is not to be considered so far as subject-matter is concerned: *Walker* v. *Hecla Foundry Co.* (1887), 5 R. P. C. 71, 365, and in the House of Lords (1889), 6 R. P. C. 554; *Windover* v. *Smith* (1863), 32 L. J. Ch. 561; *Sherwood's Design* (1892), 9 R. P. C. 268; *Moody* v. *Tree* (1892), 9 R. P. C. 233.

Nor are the novelty of the means or instruments by which the design is produced: *Plackett's Design* (1892), 9 R. P. C. 436.

But the utility of a design may be some evidence of originality: *Tyler* v. *Sharpe* (1893), 11 R. P. C. 351; *Harper* v. *Wright and Butler* (1895), 12 R. P. C. 483; *Nevill* v. *Bennett* (1898), 15 R. P. C. 412.

The pattern, shape, configuration or ornament are alone to be con-

Sect. 49.

sidered: *Walker* v. *Hecla Foundry Co.*, *supra*; *Rogers* v. *Driver* (1850), 16 Q. B. 102.

A design may also be the subject of a patent: *Werner Motors* v. *Gamage's* (1904), 21 R. P. C. 137, 621. But there is no complete analogy between patents and designs in the matter of novelty: *Harrison* v. *Taylor* (1859), 29 L. J. Ex. 3; *Moody* v. *Tree* (1892), 9 R. P. C. 233; *Lazarus* v. *Charles*, 16 Eq. 117. The combination of two old patterns in the same manner as that in which other patterns have been previously combined, may, if the application is new, form a new and original design: *Ibid.*; *Saunders* v. *Wiel*, *supra*; *Thom* v. *Sydall*, *supra*.

But articles manufactured with only a slight alteration in form from articles already on the market will not be considered new or original (*Lazarus* v. *Charles*, *supra*; *Le May* v. *Welch* (1884), 28 Ch. D. 24; *Re Clarke's Design* (1896), 13 R. P. C. 351), although a high standard of originality is not expected: *Walker* v. *Falkirk Iron Co.* (1887), 4 R. P. C. 391; *Harper* v. *Wright and Butler*, *supra*; *Re Rollason's Design* (1897), 14 R. P. C. 909.

A design must be either substantially new or substantially original, having regard to the subject-matter to which it is to be applied: *Le May* v. *Welch*, *supra*; *Smith* v. *Hope* (1889), 6 R. P. C. 201. "Subject-matter" in this connection means purpose to which it is to be applied: *Re Bach's Design* (1889), 6 R. P. C. 376.

So that it follows that a design which has been registered in one class is not new or original when applied to articles of analogous character and registered in another class: *Read and Greswell's Design* (1889), 6 R. P. C. 471; *Re Clarke's Design*, *supra*. But see the new provisions in sect. 50, *infra*, as to the rights of registered proprietors to secure protection for the application of the design in other classes.

A difference in material does not constitute novelty. But an old design may be new or original for the purposes of the Act if it is applied to a different kind of article: *Walker* v. *Falkirk Iron Co.* (1887), 4 R. P. C. 390.

The application of the same thing to the same purpose, although in an enlarged size, is not new and original: *Windover* v. *Smith* (1863), 32 L. J. Ch. 561. But an alteration of the proportions of an old design may produce a new design: *Harrison* v. *Taylor* (1859), *supra*; *Holdsworth* v. *McCrea* (1867), L. R. 2 H. L. 380; *Re Rollason's Design* (1897), *supra*.

And a new and original combination formed by simultaneously applying old and known designs, previously used separately, to the same article is a new and original design: *Reg.* v. *Firmin* (1851), 3 H. & N. 304; *Harrison* v. *Taylor* (1859), *supra*; *Sherwood* v. *Decorative Art Tile Co.* (1887), 4 R. P. C. 211; *Heinrichs* v. *Bastendorff*, 10 R. P. C. 160; *Nevill* v. *Bennett* (1898), 15 R. P. C. 812.

Whether a design is novel or original is a question of fact: *Harrison* v. *Taylor*, *supra*; *Re Bayer's Design* (1906), 23 R. P. C. 553.

In considering whether one design is an anticipation of another, as in considering whether one design is an infringement of another—for the rules which guide the Court are similar in both cases (*Le May* v. *Welch* (1884), *supra*)—the eye alone is the judge of the identity of the two things: *Holdsworth* v. *McCrea* (1867), L. R. 2

H. L. 380; *Walker* v. *Hoola Foundry Co.* (1889), 6 R. P. C. 554; *Gordon* v. *Patrick Munro & Co.* (1894), 12 R. P. C. 22; *Ingram* v. *Edwards* (1904), 21 R. P. C. 463. Sect. 49.

The test is not merely to look at the two designs side by side, but consideration should be given to what would be the effect supposing they were seen at different times or supposing they were looked at a little distance off: *Grafton* v. *Watson* (1884), 50 L. T. 420.

In deciding this question of fact, viz., whether one design is an anticipation of another, the Court may have the assistance of experts —persons conversant with the particular trade: *Grafton* v. *Watson* (1884), 50 L. T. 420; *Cooper* v. *Symington*, 10 R. P. C. 264; *Birkin* v. *Pratt* (1895), 12 R. P. C. 371; *Werner Motors* v. *Gamage's* (1903), 21 R. P. C. 137.

[1] *Not previously published.*—See Chap. IV. on "Publication," *ante*. For the purpose of seeing whether there has been any prior publication the design is treated as original, and, under the old Acts, it was held that the question to be determined was whether the particular design had, prior to registration, been disclosed to any person not in a confidential relation to the proprietor: *Blank* v. *Footman* (1888), 5 R. P. C. 653; *Winfield* v. *Snow* (1891), 8 R. P. C. 15. The question was, is it a fair conclusion from the evidence that some member or members of the general public in the United Kingdom, under no obligation to secrecy arising from good faith or confidence, knew of the design prior to the registration? See *Humpherson* v. *Syer* (1887), 4 R. P. C. 414; *Hunt* v. *Stevens* (1878), W. N. 79; *Westley Richards* v. *Perkes* (1893), 10 R. P. C. 181.

Showing a design to an expert or friend to get advice was not publication: see *Nevill* v. *Bennett* (1898), 15 R. P. C. 412; *Heinrichs* v. *Bastendorff* (1893), 10 R. P. C. 160. But if the person who was consulted confidentially changed his character from that of adviser to that of buyer, the character of the communication changed and was no longer confidential: *Winfield* v. *Snow*, *supra*.

The present Act contains express provisions that the disclosure of a design by the proprietor to any other person in such circumstances as would make it contrary to good faith for that person to use or publish the design, and the disclosure of a design in breach of good faith by any person other than the proprietor, shall not be deemed a publication sufficient to invalidate a subsequent registration; and as regards textile designs (but those only) there is a special provision that the acceptance of a first and confidential order for such goods shall not be deemed publication. (See sect. 55 and notes thereon, *post*.)

Disclosure of the design to persons who are engaged to work out or manufacture the design is not publication. (See the definition of "proprietor" in sect. 93, *infra*, and *Blank* v. *Footman*, *supra*.)

Under the old Acts it was doubted whether the condition, that the design should be registered before publication, was not limited to publication of the design after it had been embodied and introduced into some fabric: *Dalglish* v. *Jarvie* (1850), 20 L. J. Ch. 475; cf. *De la Branchardière* v. *Elvery* (1849), 4 Ex. 381.

Following the analogy of patent cases, the publication of the design in any picture or book, or the use or sale or public exhibition of an article to which the design has been applied, will be publication within

Sect. 49.

the meaning of this section. This will generally be a question of fact: *Stead* v. *Williams* (1843), 2 W. P. C. 126.

For the effect of publication in foreign books see *Lang* v. *Gisborne* (1862), 31 L. J. Ch. 769; *Harris* v. *Rothwell* (1886), 4 R. P. C. 225; and *United Telephone Co.* v. *Harrison* (1883), 21 Ch. Div. 720.

As to publication in libraries, see *Plimpton* v. *Malcolmson* (1876), 3 Ch. D. 531; *Plimpton* v. *Spiller* (1877), 6 Ch. D. 412; *Otto* v. *Steel* (1885), 3 R. P. C. 109; and *Harris* v. *Rothwell*, *supra*.

The question whether registration is publication was raised in *Read and Greswell's Design* (1889), 6 R. P. C. 473, but not decided. The point is an open one, but it is submitted that it is not; registered designs are kept secret (sect. 56), thus differing from trade marks, registration in which is publication. (See also *Dalglish* v. *Jarvie*, *supra*.) The Act also contains express provisions for the application of registered designs to goods in other classes without invalidation on the ground of the previous registration. (See sect. 50 (a), *infra*.)

For publication at exhibitions, see sect. 59 and notes thereto, *post*.

[8] *United Kingdom.*—Prior publication abroad is no anticipation, the right secured by registration being limited to this country: *Potter* v. *Braco de Prata Co.* (1891), 8 R. P. C. 218. As to protection of foreign designs under international arrangements, see sect. 91 and notes thereon, *post*; and the International Convention and notes thereon, *post*, p. 321.

[9] *Register.*—As to particulars to be entered in the register, see sect. 52. For effect of registration, see sect. 53 (1). As to the procedure after filing of the application, see Rules 31—34 and 69.

[10] *More than one class.*—Power is given to the Board of Trade to make general rules for (*inter alia*) classifying goods for the purpose of designs. (See sect. 86 (1) (b).) The various classes are given in the 3rd schedule, *ante*, p. 29; and see Rule 6.

It is important for proprietors to register the design in every class of goods to which they may wish to apply it; for, though no other person would be able to make a valid registration for similar goods in any other class (*Read and Greswell's Design* (1889), 6 R. P. C. 471; and *Re Clarke's Design*, *supra*), a registered design is only protected from infringement in the class in which it is registered; and if the proprietor of a design registered in one class applies it to goods which fall within another class, the registration does not protect him for such goods: *Hothersall* v. *Moore* (1892), 9 R. P. C. 27, 38. (See also sect. 60.) Under the new Act a registration for goods in another class may be made at any time without being invalidated on the ground of the previous registration (sect. 50).

A design may be registered to be applied to a single article in a class or to a set of articles in a class; the term "set" includes any number of articles ordinarily on sale together, or intended to be used together, all bearing the same design, with or without modifications, not sufficient to alter the character of the design (Rule 5). The fees payable vary in different classes. (Schedule I., *post*, p. 318.) In cases of doubt the Comptroller must decide as to the class (Rule 6).

Sect. 49.

[11] *May refuse to register.*—Before exercising this power the Comptroller must give the applicant an opportunity of being heard personally or by his agent, if he desires to be so heard (sect. 73 and Rules 32 *et seq.*). Power is given to the Comptroller to cancel the registration of a design on the written request of the proprietor, and also to correct any clerical error in the representation of a design or in the name or address of the proprietor, or in any other matter which is entered on the register (sect. 70 (b) and (c)). He is also given power to correct irregularities in procedure, and to enlarge the times prescribed in the Rules, upon terms, as he thinks fit. (See Rules 63 and 64.)

The only direction given to the Comptroller as to what designs he shall or shall not register is contained in sect. 75, which empowers him to refuse any design which, in his opinion, is contrary to law or morality. But sect. 56 (1) of the Act (*post*, p. 236) contemplates a design being refused on the ground of identity with a design already on the register.

Under the corresponding section in the trade marks portion of the 1883 Act (sect. 62 (4)), it was held that the discretion of the Comptroller was limited by the sections which specified what trade marks should not be registered (sects. 69, 72, 73). (See *Eno* v. *Dunn* (1890), 7 R. P. C. 3—11.) There is, however, no provision (as in the case of trade marks) for notice to the public of an application to register a design, and no opportunity is given for any opposition by the public to the registration. The Comptroller, therefore, is given a wide discretion in the matter, and he can apparently refuse the application on any reasonable grounds, subject to appeal to the Board of Trade, whose decision is final. (See per Lindley, L.J., in *Re Clarke's Design* (1896), 13 R. P. C. at p. 357.)

[12] *Appeal.*—See Rules 89—94 and sect. 87, *infra*.

Under sect. 11 of the 1883 Act, by which an appeal to the law officer from the Comptroller in the case of an opposition to the granting of a patent was given, it was decided that there was no appeal to the Court. Under sect. 62, the corresponding section with reference to trade marks, the appeal was decided by the Court if the Board of Trade referred the matter; but it was held, in a case where the Board of Trade refused to refer, that the Court had no power to deal with an application refused by the Comptroller: *In re Trade Mark "Normal"* (1887), 4 R. P. C. 123. Therefore it would seem that, under the present provisions, there is no appeal from a decision of the Board of Trade.

There being no provision as to costs, the applicant will in any event have to pay his own.

[13] *Board of Trade.*—All proceedings under this Act by and before the Board of Trade are regulated by sect. 87, and Rules 89—94.

[14] *Prescribed time.*—This means prescribed by the general Rules (sect. 93). The time prescribed is twelve months from the date of application, at the expiration of which time the Comptroller will give notice to the applicant or his agent. (See Rule 35.)

[15] *Deemed to be abandoned.*—This is a new provision. As to the effect of abandonment, see sect. 69, *infra*.

[16] *Registered . . . . as of the date of application.*—This is also a new provision, introduced by the Amendment Act of 1907, s. 29. Under

Sect. 49. the old Rule (Rules of 1890, No. 20), the registration dated from "the day upon which the application was received" by the Comptroller, and the present provision in the Act itself is probably intended to have the same effect.

Registration of designs in new classes.

50. Where a design has been registered in one or more classes of goods the application of the proprietor of the design to register it in some one or more other classes shall not be refused,[1] nor shall the registration thereof be invalidated—

(a) on the ground of the design not being a new and original design, by reason only[2] that it was so previously registered; or

(b) on the ground of the design having been previously published in the United Kingdom, by reason only that it has been applied to goods[3] of any class in which it was so previously registered.

[1] *Shall not be refused.*—The whole of this section is new, and was introduced by the Amendment Act, 1907, s. 33. Under the old Act it was held that a design already on the register might be registered in another class for an article applied to a different purpose, but not for an article merely of a different material; *e.g.*, for lamp shades, either of linen or china: *Re Bach's Design* (1889), 6 R. P. C. 376; and see *Re Clarke's Design* (1896), 13 R. P. C. 351, and *Re Read and Greswell's Design* (1889), 6 R. P. C. 471.

The Comptroller has the power (expressly recognised by sect. 6 of the Act of 1888) to refuse to register any design on the ground of identity with a design already registered, and this is continued by sect. 56 (1) of the present Act (*post*, p. 236); but the exercise of this power is now made subject to the right of the proprietor of a design already on the register to register it in other classes, and by this means practically to secure a new and extended copyright for the design. This limitation of the Comptroller's power of refusal to register on the ground of identity does not, however, apply in the case of persons other than a registered proprietor.

[2] *By reason only.*—The exemption is restricted to the two cases stated in (a) and (b), viz., previous registration of the design in another class and the application of the design to goods in that class, and it is limited to the proprietor of the original design. But as regards all other cases and persons, the old authorities as to invalidity on the ground of prior publication or want of novelty will still apply. (See *ante*, p. 46 *et seq.*)

[3] *Applied to goods.*—This exemption only covers the application to goods in any class in which the design has been previously registered, and the application to any goods not in that class (which is open

to third persons as well as the original proprietor) will, of course, invalidate. (See *Re Read and Groswell's Design, supra.*) Sect. 50.

51.—(1.) The comptroller shall grant a certificate[1] of registration to the proprietor of the design when registered.[2] Certificate of registration.

(2.) The comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, furnish one or more copies[3] of the certificate.

(*This repeats sect.* 49 *of the* 1883 *Act.*)

[1] *Certificate.*—For form of certificate, see Form D. O., No. 1, *post*, p. 377. The certificate is *primâ facie* evidence of the entry on the register and the contents thereof (sect. 79). It is supplied in the first instance without an extra fee. It will be sent when the Comptroller "accepts" the application (Rule 31). But according to the practice of the Comptroller's Office, if a date of registration merely has been secured by an application accompanied by a single sketch, no certificate will be issued until three exact drawings, photographs or specimens have been sent in substitution for the sketch. (See Instructions, *post*, p. 406.) If the application is not completed by delivery of the drawings, &c. within the prescribed time, it is deemed to be abandoned, and no certificate can then be issued (sect. 49 (4)). (See also sect. 54 (1) (a) and Rule 35.)

[2] *When registered.*—The entry is not made in the register until the certificate of registration is sealed, but registration dates from the day on which the application is received by the Comptroller. (See sect. 49 (5).)

[3] *Copies.*—A copy will be given if application be made on a properly stamped request. (Form No. 27, *post*, p. 389.) The fee is one shilling.

52.—(1.) There shall be kept at the Patent Office a book called the Register of Designs[1] wherein shall be entered the names[2] and addresses of proprietors[3] of registered designs, notifications of assignments[4] and of transmissions[5] of registered designs, and such other matters[6] as may be prescribed. Register of designs.

(2.) The register of designs existing[7] at the commencement of this Act shall be incorporated with and form part of the register of designs under this Act.

Sect. 52.

(3.) The register of designs shall be primâ facie evidence of any matters[3] by this Act directed or authorised to be entered therein.

(*Sub-sects.* 1 *and* 3 *repeat sect.* 55, *and sub-sect.* 2 *repeats sect.* 114 (2) *of the* 1883 *Act.*)

[1] *Register of designs.*—See sect. 71 and Rules 43 to 49. The register is open to the inspection of the public, subject to the regulations (sect. 67 and Rule 69, *post*).

Entries in the register may be corrected (sect. 70) and expunged or rectified (sect. 72). A separate register is kept at the Manchester office for goods in Classes 13, 14 and 15 (Rules 85, 86).

[2] *Names.*—The person whose name is on the register as proprietor of a design is the legal owner of that design (sect. 71); no notice of any trust can be entered in the register (sect. 66); but any equities in respect of any design can be enforced in like manner as in respect of any other personal property (sect. 71). (And see *Stewart* v. *Casey* (1892), 9 R. P. C. 9.)

[3] *Proprietors.*—See the definition in sect. 93 and notes thereon, *post*, p. 278 *et seq.* A partial assignee or a licensee may be a proprietor: *Jewitt* v. *Eckhardt*, *infra*. In any case, whether licensees and partial assignees are "proprietors" or not, they can have their names put on the register (sect. 71 (2)), and may become thereby "registered proprietors" for the purposes of the Act.

[4] *Assignments.*—See sect. 71, *post*, and notes thereon, and Rules 43—48. No transfer can be registered before the design is registered, nor can any licensee or partial assignee register before the author or sole proprietor of the design. This was a decision, given with some doubt by Jessel, M.R., upon the words of sects. 3, 5 and 6 of the Act of 1842, which in substance correspond with sects. 52 (1), 53 (1), and the definitions of "copyright" and "proprietor" in sect. 93, of the present Act. (See also *Jewitt* v. *Eckhardt* (1878), 8 Ch. D. 404.) But it is submitted that a person, who has obtained an unregistered design by assignment or otherwise, is not prevented from applying, under sect. 49, as a "person claiming to be proprietor," to register the design. Whether an assignment of an unregistered design is publication is another question. (See sect. 49, note [7], *ante*, p. 224.)

Sect. 6 of the Act of 1842, which is the corresponding section to this, contained the words "any writing . . . shall operate as an effectual transfer"; but there is no similar provision anywhere in this Act or in the Rules. It is doubtful, therefore, whether the decision (*Jewitt* v. *Eckhardt*, under the old Act) that an assignment or license must be in writing is any longer law. (See *Woolley* v. *Broad* (1892), 9 R. P. C. 208, and the cases on this in Chap. VIII. on "Proprietors," §§ 122—124, *ante*.)

[5] *Transmissions.*—A design is transmitted and devolves like any other personal property. (See sect. 71 (1).)

Any one or more of the co-proprietors may assign his interest without the concurrence of the others, and the right to restrain infringe-

ment will attach to all such partial interests: *Lauri* v. *Renad*, [1892] 3 Ch. 402.

[6] *Such other matters.*—The date of application must be entered on the register, and the registration runs from that date (sect. 49 (5)).

[7] *Register of designs existing.*—The old register of designs was regulated by sect. 87 of the Act of 1883, corresponding with sect. 71 of the present Act. As regards designs for goods in Classes 13, 14 and 15, a duplicate of the entries of such designs registered under the old Act in which there is subsisting copyright is to be kept at the Manchester office (Rule 85).

[8] *Evidence.*—Sealed copies of entries in the register are received in evidence without any further proof or production of the registers (sect. 79).

Copyright in registered Designs.

Copyright on registration.

53.—(1.) When a design is registered,[1] the registered proprietor[2] of the design shall, subject to the provisions of this Act, have copyright[3] in the design during five years[4] from the date of registration.[5]

(2.) If within the prescribed time before the expiration of the said five years application for the extension of the period of copyright is made to the comptroller in the prescribed manner, the comptroller shall[6] on payment of the prescribed fee extend the period of copyright for a second period of five years from the expiration of the original period of five years.

(3.) If within the prescribed time before the expiration of such second period of five years application for the extension of the period of copyright is made to the comptroller in the prescribed manner, the comptroller may, subject to any rules under this Act,[7] on payment of the prescribed fee, extend the period of copyright for a third period of five years from the expiration of the second period of five years.

(*Sub-sect.* 1 *repeats sect.* 50 (1) *of the Act of* 1883; *sub-sects.* 2 *and* 3 *are new.*)

[1] *When a design is registered.*—The statutory copyright in designs depends on due registration; but, as in the case of books, paintings, etc., there is a right of property in an unpublished design which will receive protection from the Courts (see *ante*, §§ 56 to 59), and regis-

Sect. 53.

tration really only affects the *remedies* given to the proprietor of the copyright against infringers.

Under the old Designs Acts a distinction was made between useful and ornamental designs, but by the Act of 1883, which is followed by this Act, all designs were put on the same footing. (See sects. 49, 50 and 51 and the notes thereon, *ante*.)

[2] *Proprietor.*—For definition, see sect. 93 and notes thereon, *post*. As to partial assignees or licensees, see note [3] to sect. 52, *ante*, p. 228.

[3] *Copyright.*—For definition, see sect. 93 and notes thereon, *post*.

Copyright in designs is of statutory creation; but it may be doubted whether the recital in the preamble of the first Designs Act of 1787 (27 Geo. III. c. 38), as to there being then no property in designs, meant anything more than the similar recital as to copyright in the first Art Copyright Act of 1862 (25 & 26 Vict. c. 68), which has been explained as referring only to statutory copyright, and as "not being intended to abolish the common law principles as to unpublished works." (See Scrutton on Copyright (1903), p. 161 *et seq*.)

[4] *Five years.*—Under the old Designs Acts varying terms of protection in the different classes were granted, the longest of which was three years, though the Board of Trade had power to extend this term by another three years in the case of ornamental designs. (5 & 6 Vict. c. 100, s. 3; 6 & 7 Vict. c. 65, s. 2; 13 & 14 Vict. c. 104, s. 9.) By the Act of 1883, one fixed term of five years was adopted for all designs; but the present Act reverts, with some modifications, to the old method of extensions, which are partly optional at the instance of the proprietor (sub-sect. 2), and partly within the discretion of the Comptroller (sub-sect. 3).

[5] *The date of registration.*—Registration is deemed to date from the date on which the Comptroller received the application (sect. 49 (5)).

[6] *The Comptroller shall.*—This provision, which is new, gives an absolute right to an extension of five years beyond the first term of copyright, the only conditions being (a) that application shall be made within the prescribed time before the expiration of the first term of five years; (b) that it shall be made in the manner prescribed by the Rules (see sect. 93, definition of "prescribed"); and (c) that the prescribed fee shall be paid (see sect. 65, *post*). As to the time and manner of the respective applications for the first and second extensions, see Rules 37—41, and Forms 8, 9 and 10, *post*, p. 378.

It would appear that application for the extension may be made by any person entitled as proprietor, which term includes partial assignees and licensees (see note [3] to sect. 52, *ante*, p. 228), and presumably any extension will enure for the benefit of all the proprietors.

[7] *The Comptroller may, subject to any Rules.*—The provisions for the second extension of the term gives a discretion to the Comptroller, and this discretionary power will practically be regulated by sect. 73, which gives an applicant the right of being heard in support of his application, and Rules 55—58, dealing with the exercise of discretionary powers, though apparently there will be no right of appeal as in the case of an original registration. (See sect. 49 (3), *supra*.)

Sect. 54.

Requirements before delivery on sale.

54. — (1.) Before delivery on sale[1] of any[2] articles to which a registered design has been applied,[3] the proprietor[4] shall—

(a) (if exact representations or specimens were not furnished on the application for registration[5]), furnish to the comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the comptroller may erase[6] his name from the register, and thereupon the copyright in the design shall cease; and

(b) cause each such article[7] to be marked with the prescribed mark,[8] or with the prescribed words or figures, denoting that the design is registered; and if he fails to do so the proprietor shall not be entitled to recover any penalty or damages[9] in respect of any infringement of his copyright in the design unless he shows that he took all proper steps to ensure the marking of the article,[10] or unless he shows that the infringement took place after the person guilty thereof knew or had received notice[11] of the existence of the copyright in the design.

(2.) Where a representation is made to the Board of Trade by or on behalf of any trade or industry that in the interests of the trade or industry it is expedient to dispense with or modify as regards any class or description of articles any of the requirements of this section as to marking, the Board may, if they think fit, by rule under this Act dispense[12] with or modify such requirements as regards any such class or description of articles to such extent and subject to such conditions[13] as they think fit.

[Act of 1883, sect. 50 (2).]

50.—(2.) *Before delivery on sale of any articles to which a registered design has been applied, the proprietor must (if exact*

Sect. 54.

representations or specimens were not furnished on the application for registration) furnish to the comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the comptroller may erase his name from the register, and thereupon his copyright in the design shall cease.

[Act of 1883, sect. 51.]

51. *Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words or figures, denoting that the design is registered; and if he fails to do so, the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article.*

The corresponding sections of the Acts of 1842 and 1843 (5 & 6 Vict. c. 100, s. 4, and 6 & 7 Vict. c. 65, s. 3) provided that no person should be entitled to the benefit of the Acts unless every article published by him to which a registered design was applied bore the prescribed mark; but this did not involve forfeiture of the copyright, as in the 1883 Act, and the present provisions are somewhat of a reversion to the old position, the penalty of forfeiture for non-marking being abolished.

[1] *Delivery on sale.*—See Chap. VIII. on "Marking," and cases cited therein (*ante*, p. 129), and Rule 68, *post*. The proprietor of the design must mark every article that he delivers on sale; no liability under this section will attach to him if the person to whom he sells takes off the mark and sells again: *Sarazin* v. *Hamel* (1863), 32 L. J. Ch. 380. Nor will the proprietor suffer if by process of time or manufacture the mark becomes illegible: *Fielding* v. *Hawley* (1883), 48 L. T. N. S. 639; but see *Johnson* v. *Bailey* (1893), 11 R. P. C. 21. Under the old Acts it was held that the proprietor of a design registered in this country must put the prescribed marks on articles sold abroad, even though they were manufactured abroad; and the reasoning on which the decision was founded appears equally applicable to the present Act: *Sarazin* v. *Hamel*, *ubi supra*; cf. *Potter* v. *Braco de Prata Printing Co.* (1891), 8 R. P. C. 218.

Articles need only be marked before "delivery on sale," and not before "publication," as under the old Acts. It is submitted, therefore, that patterns, provided they are not sold, do not require to be marked: cf. *Heywood* v. *Potter* (1853), 22 L. J. Q. B. 133.

If goods are delivered on sale and the design is applied to them, they must be marked though unfinished, and this apparently though the finishing will destroy the mark: *Woolley* v. *Broad* (1892), 9 R. P. C. 429. But this will, of course, now be subject to the provisions of sub-sect. 2 of this section, which will enable exemption to be made in appropriate cases.

[2] *Any.*—The words of the old statutes were "every article shall bear . . .;" and it was decided that these terms must be interpreted strictly, and that a failure to mark even one article was fatal to the copyright: *Pierce* v. *Worth* (1868), 18 L. T. N. S. 710; *Hunt* v. *Stevens*,

W. N. (1878) 79. The words of this section must be interpreted equally strictly, and a single instance proved against the proprietor will be sufficient to deprive him of his right to penalties or damages unless he is helped by the saving clauses.

[3] *Articles to which a registered design applied.*—To print a copy of a design in a book is not to apply the design to an article of manufacture: 5 & 6 Vict. c. 100, s. 4. So that diagrams and copies of designs need not bear the registration marks: *De la Branchardière* v. *Elvery* (1840), 4 Ex. 380.

Under sect. 58 of the 1883 Act (see sect. 60, *infra*) it was held that preparing rollers or dies to print a registered design was not an application of such design to an article within the section: *Potter* v. *Braco de Prata Printing Co.* (1891), 8 R. P. C. 218.

[4] *Proprietor* (see Chapter VII. on "Proprietor" and cases cited therein, *ante*, p. 115).—Under the corresponding sections of the old Acts, the penalty for the non-performance of the conditions of copyright fell only on the person who neglected to comply with them: "No person shall have the benefit of this Act, unless every article published by him hath thereon . . . ." (5 & 6 Vict. c. 100, s. 4.)

If the decision in *Jewitt* v. *Eckhardt*, 8 Ch. D. 404, be correct, namely, that every assignee, whether absolute or limited, and every licensee is a proprietor to the extent of his interest (see sect 93, definition of "proprietor," and notes thereon), such limited proprietor might be held to be within the words "the proprietor of the design," for the singular includes the plural, and the failure of a limited proprietor to mark might cause loss of the right to sue for penalties or damages.

The better opinion seems, however, to be that the proprietor of the full copyright can claim protection under the proviso if he can show that he has taken reasonable steps to secure marking by the persons claiming under him (per Charles, J., in *Wedekind* v. *General Electric Co.* (1897), 14 R. P. C. 190).

[5] *On the application for registration.*—It is assumed throughout this sub-section that a design is registered from the time an application, accompanied by a single sketch, is received by the Comptroller. (See sect. 49 (5) and the Instructions issued by the office, *post*, p. 406.)

[6] *May erase.*—The exercise of this power is discretionary, and would depend on the circumstances. Any owner affected by an adverse decision has a right of being heard before the Comptroller (Rules 55—58); and this right is also preserved by sect. 73 of the Act. But whether there is any right of appeal to the Board of Trade in such a case, *query*.

[7] *Each such article.*—These words include every piece of an article bearing a registered design, whether that piece be large or small (*e.g.* a pattern), if sold or intended to be sold separately: *Blank* v. *Footman* (1888), 5 R. P. C. 653. The fact that the article is capable of separation into parts does not make it necessary to place the mark on each, if all the parts together constitute but one complete article: *Fielding* v. *Hawley* (1883), 48 L. T. N. S. 639; *Ingram and Kemp* v. *Edwards* (1904), 21 R. P. C. 463. But *aliter* if each part constitutes a separate article: *Hothersall* v. *Moore* (1892), 9 R. P. C. 27; *Lea and Perrins* v. *Price* (1904), 22 R. P. C. 122.

Sect. 54.

Articles which, though manufactured in the piece (*e.g.* in pieces containing a dozen articles), properly fall within Class 14 (handkerchiefs and shawls), are not sufficiently marked by having the prescribed mark on each piece, and not on each article: per Bristowe, V.-C., *Hothersall* v. *Moore* (1892), 9 R. P. C. pp. 27, 30.

[8] *Marked with the prescribed mark.*—Each article must be marked in some convenient manner; it is not necessary to put the mark on the article itself, but tying on a label or printing on the packet in which it is sold is sufficient: *Blank* v. *Footman, ubi supra.*

The object of this provision as to marking is that the public should be warned against copying designs that are registered: *Sarazin* v. *Hamel, ubi supra.*

But the mark must be affixed or attached to that part of the article to which the registered design applies, and not to some part which is not copyright: *In re Morton's Design* (1899), 17 R. P. C. 117.

It is no objection that marks are also attached or impressed which do not apply to the design for which protection is claimed: *Harper* v. *Wright and Butler* (1895), 12 R. P. C. 483.

As to the marks to be put on the different classes of goods, see Rule 68, *post*, p. 309.

[9] *Not entitled to recover.*—Under the old law the copyright was forfeited by non-marking even of a single copy, but this hardship was abolished by the Amendment Act of 1907 (sect. 32 (1)), which is incorporated by this section. The alteration is a vital one, and it approximates the conditions of designs copyright to those affecting works of art. (See 25 & 26 Vict. c. 68, s. 4.)

[10] *Unless the proprietor shows that he took proper steps.*—This exception was first introduced by the Act of 1883.

Where the plaintiff ordered his manufacturers to affix the proper mark, but they by some blunder affixed the mark of another design, the registration of which had expired, but which contained the important letters Rd., it was held that the plaintiff was protected by this provision: *Wittman* v. *Oppenheim* (1884), 27 Ch. D. 260.

But whether the proprietor would be protected if he gave orders to his manufacturer to put on the proper mark, and the manufacturer omitted to put on any mark at all, is doubtful. A *bonâ fide* mistake in the number of the registration mark impressed will be excused under this proviso: *In re Rollason's Design* (1887), 14 R. P. C. 893—909.

Woolley v. *Broad* (1892), 9 R. P. C. 429, and *Johnson* v. *Bailey* (1894), 11 R. P. C. 21, are examples of cases in which the proviso has been decided to be inapplicable.

[11] *After the person guilty thereof knew.*—This is a new provision, introduced by the present Act, and it affects considerably the arrangements for strict marking which prevailed under the old Acts. Even intentional non-marking, which may become common under the new Act, will not deprive a proprietor of his rights or substantially affect his remedies, as both penalties and damages will become recoverable in respect of subsequent dealings with infringing goods as soon as the necessary notice has been given under this section. (See sect. 60 and notes thereon, *post*.)

Sect. 55.

The only protection to an intending producer of a design, apart from his general knowledge of other productions in the particular trade, which appears to be presumed, is the right given to him to require the Comptroller to search and inform him whether his design has been anticipated by any antecedent registration (see sect. 57 and notes thereon, *post*, and Rules 59, 60); but this is not absolute, as the Comptroller's certificate will not prevent an action for infringement, nor is it admissible as evidence on the defendant's behalf: *Smith* v. *Hope*, 6 R. P. C. 204.

[12] *Dispense with . . . any of the requirements.*—This seems to contemplate the abolition of marking altogether in respect of certain classes of goods, *e.g.*, lace or possibly textile fabrics, but it will have to be done by general rules under the Act, and no discretionary power of exemption is vested in the Comptroller. The Rules of 1908 do not contain any such exemption, but the requirements as to marking are modified in the case of lace and goods in Classes 13, 14 and 15.

[13] *Subject to such conditions.*—These conditions are set out in the Rules. (See Rule 68, and notes thereon, *post*.)

Effect of disclosure on copyright.

55. The disclosure of a design by the proprietor to any other person, in such circumstances as would make it contrary to good faith for that other person to use or publish the design, and the disclosure of a design in breach of good faith by any person other than the proprietor of the design, and the acceptance of a first and confidential order for goods bearing a new or original textile design intended for registration, shall not be deemed to be a publication[1] of the design sufficient to invalidate the copyright thereof if registration thereof is obtained subsequently[2] to the disclosure or acceptance.

[1] *Shall not be deemed to be a publication.*—This is an entirely new provision introduced by the Amendment Act, 1907 (sect. 31 (2)), as an addition to sect. 50 of the old Act. It provides for three cases of publication which were already partly covered by judicial authority but now receive statutory exemption:—

(a) Disclosure by the proprietor to a person in circumstances creating a confidential relation (*bona fides*): *Blank* v. *Footman* (1888), 5 R. P. C. 653; *Nevill* v. *Bennett* (1898), 15 R. P. C. 412.

(b) Disclosure by any other person in breach of good faith: *Humpherson* v. *Syer* (1887), 4 R. P. C. 407.

(c) Acceptance of a confidential order. Hitherto offer on sale and acceptance of orders before registration have always been regarded as publication invalidating the copyright. (See *Winfield* v. *Snow* (1891), 8 R. P. C. 15.) The limitation of this exemption to textile fabrics seems rather arbitrary, and the effect is to leave the old law on this point applicable to all other classes of goods.

[2] *If registration is obtained subsequently.*—A similar exemption is given

Sect. 55. to patentees by sect. 41 (2), but the requirement that legal protection shall be obtained *as soon as* publication comes to the knowledge of the proprietor is not repeated in the case of designs. No public notice is required before the granting of an application for registration, and no opportunity given for opposition by parties interested; so that it may be possible, under this provision, to effect registration even after an infringement arising from a confidential disclosure, etc. and to recover penalties or damages for any subsequent dealing with goods antecedently produced. (See note [11] to sect. 54, *ante*.)

Inspection of registered designs.

56.—(1.) During the existence of copyright in a design, or such shorter period not being less than two years[1] from the registration of the design as may be prescribed, the design shall not be open to inspection except by the proprietor or a person authorised in writing by him, or a person authorised by the comptroller or by the Court,[2] and furnishing such information as may enable the comptroller to identify the design, and shall not be open to the inspection of any person except in the presence of the comptroller, or of an officer acting under him, and on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof:

Provided that where registration of a design is refused on the ground of identity[3] with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.

(2.) After the expiration of the copyright in a design, or such shorter period as aforesaid, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.[4]

(3.) Different periods may be prescribed[5] under this section for different classes of goods.

[Act of 1883, sect. 52.]

52.—(1.) *During the existence of copyright in a design, the design shall not be open to inspection except by the proprietor, or a person authorised in writing by the proprietor, or a person authorised by the Comptroller or by the Court, and furnishing such information as may enable the Comptroller to identify the*

design, nor except in the presence of the Comptroller, or of an officer acting under him, nor except on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof. Sect. 56.

Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered. [Act of 1888, sect. 6.]

(2.) *When the copyright in a design has ceased, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.*

[1] *Such shorter period as may be prescribed.*—This is a new provision introduced by sect. 34 of the Amendment Act, 1907. The ground for prohibition of inspection of registered designs being that reasonable time should be allowed to originators of new designs to secure the benefit of the novelties introduced by them, without running the risk of outside competition, and the term of copyright having been extended from five to an optional fifteen years, it was necessary to provide some such limitation as this, which has been amplified by the new Rules. (See Rule 69 and note [5] below.)

[2] *By the Court.*—The power given to the Court to make an order for inspection of a design of which the copyright is still in existence was first introduced by the Act of 1883.

[3] *On the ground of identity.*—These words indicate a special ground for exercise of the Comptroller's discretionary powers not specifically mentioned in the sections relating to refusal of registration. But actual identity does not appear to be absolutely necessary to justify exercise of the discretionary powers, and an obvious copy may suffice. (See sect. 49 (3), *ante*, and sect. 75, *post*.)

[4] *Prescribed fee.*—See 1st Schedule to the Rules, *post*, p. 318. As to the regulations for inspection, see sect. 67 and notes thereon, *post*, and Rules 60, 61.

[5] *Different periods may be prescribed.*—The object of the prohibition being to prevent unfair competition, the periods of exclusion from inspection may vary in different trades. The Rules of 1908 provide the minimum period of two years for all classes, except Classes 13, 14 and 15 (textile goods), for which the period is five years.

57. On the request[1] of any person furnishing such information as may enable the comptroller to identify the design, and on payment of the prescribed fee,[2] the comptroller shall inform such person whether the registration still exists in respect of the design,[3] and if so, in respect of what classes of goods, and shall state the date Information as to existence of copyright.

Sect. 57. of registration, and the name and address of the registered proprietor.

(*This section is substantially the same as sect.* 53 *of the* 1883 *Act.*)

[1] *Request.*—See Rule 59 and Forms 19, 20, *post*, pp. 383—4.

[2] *Prescribed fee.*—See 1st Schedule to the Rules, *post*, p. 318.

[3] *Comptroller shall inform.*—The Comptroller is also authorised by Rule 60 to inform any person whether a particular design produced by that person, and to be applied to goods in any particular class, is or is not identical or an obvious imitation of any registered design applied to such goods of which the copyright is still existing. But the information given is not evidence: *Smith* v. *Hope*, 6 R. P. C. 204; nor, it is submitted, would any reply given to an inquiry under this section be.

Cancellation of registration of designs used wholly or mainly abroad.

58.—(1.) At any time after the registration of a design any person may apply to the comptroller[1] for the cancellation of the registration on the ground that the design is used for manufacture exclusively or mainly outside the United Kingdom,[2] and where such an application is made the provisions of this Act with respect to the revocation of patents[3] worked outside the United Kingdom (including those relating to costs[4]) shall apply with the necessary modifications, except that there shall be no appeal from the decision of the comptroller.[5]

(2.) Such ground as aforesaid shall be available by way of a defence[6] to an action for infringement of the copyright in the design.

[Act of 1883, sect. 54.]

54. *If a registered design is used in manufacture in any foreign country and is not used in this country within six months of its registration in this country, the copyright in the design shall cease.*

[1] *Any person may apply to the Comptroller.*—This is a new provision, introduced by sect. 35 of the Amendment Act, 1907, and it goes much further than the original Bill (which gave a period of one year before an application for cancellation could be made), and further than the similar provision as to patents (which gives four years from the date of the patent, sect. 27 (1)). It is to be observed that the application can be made "at any time," and that the right to apply for cancellation is not restricted to "persons aggrieved," as in the similar provision relating to applications for rectification of the register (sect. 72 (1)), and it is open, therefore, to any outsider at any time to make the

Sect. 58.

application. The draft Bill restricted those applications to "persons interested," but those words were left out in committee, and the only protection against vexatious use of the opportunity thus given to harass proprietors of designs seems to be in the provision of sect. 39 (1), which gives power to the Comptroller to order security or award costs to any party; a power which may, of course, be exercised against an applicant, notwithstanding that some order under the section may be made. (See Note [4], *post*, p. 241.)

The provision also extends, apparently, to existing registered designs, any of which may, at any time, be called in question by any person. (See sect. 98 (2), and notes thereon.) The new Rules provide a code of procedure on applications for cancellation under this section (Rules 70—75). The form of application (Form No. 23, *post*, p. 385) is required to have a 1*l.* stamp impressed on it.

[2] *Used for manufacture exclusively or mainly outside the United Kingdom.*—This provision introduces a new principle into the law affecting designs, and requires that the manufacture of the article to which the design is applied must be mainly within the United Kingdom. Difficulties may arise under this section in respect of British designs used for manufactures in foreign countries, where the output may be out of all proportion to the home manufacture; and these difficulties are increased in the case of foreign designs, for the use of which, in the United Kingdom, licenses or assignments of the British rights may have been obtained by an English manufacturer.

It is assumed that in all these cases the Comptroller will have regard mainly to the intention of the Act, and if the supply of goods for the English market is not manufactured exclusively or mainly outside the United Kingdom (or, *query*, if the design is applied here even though the goods bearing it may be manufactured abroad), he will reject any application for cancellation. (See note [3] below.)

The provisions as to marking as a condition of preserving the remedies against infringements apply even though the goods to which the design is applied may be manufactured abroad; and (apart from any international rights) there is no remedy in this country for foreign infringements: *Potter* v. *Braco de Prata, Ltd.* (1891), 8 R. P. C. 216.

[3] *The provisions with respect to the revocation of patents worked outside.*—These provisions are contained in **Sect. 27** of the Act, which runs as follows:—

Sect. 27. Revocation of patents worked outside the United Kingdom.

(1.) At any time not less than four years after the date of a patent and not less than one year after the passing of this Act, any person may apply to the comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.

(2.) The comptroller shall consider the application, and, if after enquiry he is satisfied that the allegations contained therein are correct, then, subject to the provi-

Sect. 58. sions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the comptroller may make an order revoking the patent either—

(a) forthwith; or

(b) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom to an adequate extent:

Provided that no such order shall be made which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession.

(3.) If within the time limited in the order the patented article or process is not manufactured or carried on within the United Kingdom to an adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured or carried on, the comptroller may extend the period mentioned in the previous order for such period not exceeding twelve months as may be specified in the subsequent order.

(4.) Any decision of the comptroller under this section shall be subject to appeal to the Court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

It is to be observed that sub-sect. 2 of this incorporated section introduces an important exception to the general words of the principal section "used for manufacture exclusively or mainly outside the United Kingdom," for if the proprietor of the design proves that the design is used for manufacture "to an adequate extent in the United Kingdom or gives satisfactory reasons" why the design is not so used, no order for cancellation may be made.

The words used in this exception are very vague, and give the Comptroller the widest possible discretion in dealing with different classes of designs. He must have regard to all the facts in each particular

case. Some idea of the considerations which he may be called on to take into account may be derived from the decisions under the German provisions for compulsory working of patents (Patent Act of 1891, s. 11), which authorise revocation after three years "if the patentee omits to utilise the invention in Germany to an adequate extent, or if he omits at least to do everything that is requisite to secure such utilisation." The Supreme Court of Appeal has held on this that "since the Patent Office has full discretion in matters of revocation, it may have regard also to the fact that the cost of production in Germany would have been much higher than that abroad; it may also take into consideration other disproportionate difficulties with which the development of a new industry in Germany has to contend; and such considerations as these, in conjunction with others, may justify the Patent Office in refusing the revocation." Sect. 58.

[4] *Including those relating to costs.*—This refers to **Sect. 39** of the Act, which is to the following effect:—

Sect. 39. Costs and security for costs.

(1.) The comptroller shall, in proceedings relating to an opposition to the grant of a patent or to an application for the amendment of a specification or the revocation of a patent, have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the Court.

(2.) If a party giving notice of opposition to the grant of a patent or to the amendment of a specification, or applying to the comptroller for the revocation of a patent, or giving notice of appeal from any decision of the comptroller, neither resides nor carries on business in the United Kingdom or the Isle of Man, the comptroller, or, in case of appeal to the law officer, the law officer, may require such party to give security for costs of the proceedings or appeal, and in default of such security being given may treat the proceedings or appeal as abandoned.

As to requiring security for costs from foreign firms or companies "carrying on business" in the United Kingdom, see Rules of the Supreme Court, Ord. XLVIIIA. r. 1.

[5] *No appeal from the decision of the Comptroller.*—A large distinction is made by these words between patents and designs; but it is to be observed that under sect. 74, in any cases of doubt or difficulty, the Comptroller may apply to a law officer for directions in the matter, and this power will probably be used in the event of any important

Sect. 58.

legal question arising on the consideration of applications for cancellation, on which no appeal to the Court is given by the Act.

[6] *Shall be available by way of a defence.*—This introduces a new ground of defence, which will presumably become common form in actions for infringement. But the Court will, it is assumed, take into account all the considerations which could have been placed before the Comptroller under sect. 27, sub-sect. 2, on an application for cancellation, and if no such application has been made before action, an attempted defence on this ground alone will, in ordinary circumstances, not be of much worth.

No power is given to the Court itself to order cancellation or to make a conditional order under clause (a) of the sub-section, and there can, therefore, be no counterclaim on the grounds stated in the section.

Industrial and International Exhibitions.

Provisions as to exhibitions.

59.—(1.) The exhibition at an industrial or international exhibition certified as such by the Board of Trade,[1] or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof: Provided that—

(a) The exhibitor, before exhibiting the design or article, or publishing a description of the design, gives the comptroller the prescribed notice of his intention to do so[2]; and

(b) The application for registration is made before or within six months from the date of the opening of the exhibition.

(2.) His Majesty may, by Order in Council, apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition[3] of giving notice to the comptroller of his intention to exhibit, and shall be so

relieved either absolutely or upon such terms and conditions as may be stated in the Order. Sect. 59.

(*Sub-sect.* 1 *of this section repeats sect.* 57 *of the Act of* 1883. *Sub-sect.* 2 *incorporates the provisions of sect.* 3 *of the* 1886 *Act.*)

[1] *Certified by the Board of Trade.*—A list of exhibitions certified under this section is kept at the Patent Office.

[2] *Prescribed notice.*—As to the requirements to be complied with on giving notice, see Rule 76, and Form No. 24, *post*, p. 386.

[3] *Relieved from the conditions.*—The Order in Council usually issued grants temporary protection to designs, or articles to which a design is applied, which may be exhibited at any of those international exhibitions, relieved from the conditions as to notice of intention to exhibit, set out in sect. 59 (1) (a).

Legal Proceedings.

60.—(1.) During the existence of copyright[1] in any design it shall not be lawful for any person— Piracy of registered design.

(a) For the purposes of sale[2] to apply or cause to be applied[3] to any article in any class of goods[4] in which the design is registered the design or any fraudulent or obvious imitation thereof,[5] except with the license or written consent[6] of the registered proprietor,[7] or to do anything with a view to enable the design to be so applied;[8] or

(b) Knowing[9] that the design or any fraudulent or obvious imitation thereof has been applied to any article without the consent[10] of the registered proprietor to publish or expose or cause to be published or exposed[11] for sale that article.

(2.) If any person acts in contravention of this section he shall be liable for every contravention[12] to pay to the registered proprietor of the design a sum not exceeding fifty pounds, recoverable as a simple contract debt,[13] or if the proprietor elects[14] to bring an action for the recovery of damages[15] for such contravention, and for

Sect. 60.

an injunction against the repetition thereof,[16] he shall be liable to pay such damages as may be awarded and to be restrained by injunction accordingly:

Provided that the total sum recoverable as a simple contract debt in respect of any one design shall not exceed one hundred pounds.

[Act of 1883, sect. 58.]

[Act of 1888, sect. 7.]

58. *During the existence of copyright in any design—*

(a) *It shall not be lawful for any person without the license or written consent of the registered proprietor to apply* **or cause to be applied** *such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale to any article of manufacture or to any substance artificial or natural or partly artificial and partly natural; and*

(b) *It shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.*

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by an action in any Court of competent jurisdiction: **Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds.**

[Act of 1883, sect. 59.]

59. *Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture or substance, or from the publication, sale or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor had not given his consent to such application.*

Sect. 60.

[1] *The existence of copyright.*—This depends for the purposes of the statute—

(1) On the alleged design being a design within the meaning of this Act (sect. 93 (definition of "Design")).
(2) On due registration of the design (sect. 53).
(3) On the design being, at the date of application for registration, new or original (sect. 49 (1)).
(4) On the design not having been published before registration (sect. 49 (1)).

Under the previous statutes there were two further conditions on which the existence of the copyright depended, viz. :—

(a) On the articles to which the design was applied being properly marked before delivery on sale (Act of 1883, s. 51);
(b) On the design, if used in manufacture abroad, being also used on articles manufactured in this country within six months of registration (Act of 1883, s. 54);

but the new Act removes those conditions and makes (a) a ground for withholding any remedy though the copyright subsists, and (b) a ground for an application to cancel the registration, or of defence to any action for infringement.

In any action for the infringement of a design, if the defendant can show that the plaintiff has failed to comply with any one of those conditions, the action may be dismissed. But the Court may, under its general equitable jurisdiction, restrain an intended infringement even of an unregistered design on other than the strictly legal grounds. (See Chap. X. on "Remedies for Infringement," §§ 162—165, *ante*.)

A distinction is drawn by the sub-sects. (a) and (b) between the manufacturers of articles of registered design for purposes of sale, and all other persons who publish or expose such articles: the former are liable for every infringement, however innocently made, but the latter only if they know that the consent of the proprietor of the design has not been given: see *Smith* v. *Lewis, Roberts & Co.* (1881), 5 R. P. C. 611.

[2] *For purposes of sale.*—It was held by Knight-Bruce, V.-C., in *McRae* v. *Holdsworth* (1848), 2 De G. & Sm. 496, that manufacturing a registered design, with the intention of selling after the period of protection had expired, was piracy within the meaning of the corresponding words of the Act of 1842, s. 7. (Cf. patent cases: *Crossley* v. *Beverley* (1829), 1 Web. P. C. 119; *Crossley* v. *Derby Gas Co.*, 4 L. J. Ch. 25.)

These words, which govern the whole clause, make it unnecessary to prove an actual selling. See *Minter* v. *Williams*, 4 A. & E. 257, a patent case decided in 1835, in which it was held that exposure for sale is not the same as selling, although it might be an infringement as a user of the patent. And see observations of Alverstone, C.J., on this case in *British Motors Syndicate* v. *Taylor* (1900), 17 R. P. C. at p. 729.

[3] *Apply or cause to be applied.*—The effect of these words is to make liable, not only the actual manufacturer, but also the person who employed him to manufacture the pirated design: *Mallett* v. *Howitt* (1879), W. N. 107. In every case in which it can be made out that the actual infringer was the agent for that purpose of another person,

Sect. 60.

that other person is also liable: *Sykes* v. *Howarth* (1879), 12 Ch. D. 832.

In a case of a manufacturer it is immaterial how the defendant arrived at the production of the infringing design, whether by independent invention or by copying the registered design: *Saunders* v. *Wiel* (No. 2) (1893), 9 R. P. C. 467; *Mallett* v. *Howitt*, *supra*; *Smout* v. *Slaymaker* (1890), 7 R. P. C. 90.

The unauthorised application of a registered design abroad by a British subject is not unlawful under this provision of the Act: *Potter* v. *Braco de Prata Printing Co.* (1891), 8 R. P. C. 218; though it was apparently under the old Act of 1861 (24 & 25 Vict. c. 73), s. 1; and it may become so as regards any person doing anything within the jurisdiction "to enable the design to be so applied" under the wording of the new provision added at the end of this clause (see sect. 93, definition of "Copyright"); and the delivery of such goods to a buyer in England, under a contract for sale not completed outside the jurisdiction, would be an infringement. Per Lord Herschell in *Badische Anilin und Soda Fabrik* v. *Johnson* (1897), 14 R. P. C. 919. (See *British Motors Syndicate* v. *Taylor* (1900), 17 R. P. C. 189, and *Badische Anilin und Soda Fabrik* v. *Hickson* (1905), 22 R. P. C. 575.)

[4] *In any class of goods.*—The application of a registered design to dies or rollers for the purpose of reproducing from them the registered design is not an application of the design in the class in which it is registered, so as to constitute an infringement: *Potter* v. *Braco de Prata Printing Co.* (1891), 8 R. P. C. 218.

The protection extends to all articles in the class in which the design has been registered, and a design which may be lawfully used for other classes of goods may not be applied to any such articles so long as the copyright exists: *Pearson* v. *Wilkinson* (1906), 23 R. P. C. 738.

If the proprietor of a design registered in one class applies it to goods in another class, the registration does not protect the application to such goods: *Hothersall* v. *Moore* (1892), 9 R. P. C. 27.

[5] *The design or any fraudulent or obvious imitation.*—As to the test of infringement generally, see sect. 49, note [c], "new or original," and Chap. IX. on "Infringement," *ante*.

The word "obvious" was introduced for the first time by the Act of 1883, and there is a distinction between this and actual copying or "fraudulent" imitation. (See *Sherwood* v. *Decorative Art Tile Co.* (1887), 4 R. P. C. 207.)

Imitation is not entirely forbidden by the Act; *e.g.*, fair imitation—that is to say, the application of an original idea in such a way as to create a new and original design—is not prohibited: *Barran* v. *Lomas* (1880), 28 W. R. 973; *Thom* v. *Sydall* (1872), 56 L. T. N. S. 15. (See judgment of Cotton, L.J., in *Grafton* v. *Watson* (1884), 51 L. T. 141; *Saunders* v. *Wiel* (No. 2) (1892), 9 R. P. C. 467; and for recent cases of what has been considered "fair use," see *Holden* v. *Hodgkinson* (1904), 22 R. P. C. 102, and *Staples* v. *Warwick* (1906), 23 R. P. C. 609.)

The Act prohibits the use of anything which is substantially the same design. Although there may be variations, there is infringement if the Court is of opinion that the design itself has been applied. (Cf. *Hanfstaengl* v. *W. H. Smith & Son* (1905), 21 T. L. R. 291.)

Sect. 60.

"Fraudulent imitation" is imitation with knowledge; conscious imitation, the man having the design before him, and knowingly and wilfully imitating, and not producing anything sufficiently original to be protected as a fair imitation: per Jessel, M.R., in *Barran* v. *Lomas* (1880), 28 W. R. 973.

Deliberate imitation, if the result is, in fact, the production of an imitation of the design, is fraudulent imitation: *Grafton* v. *Watson* (C. A.), 51 L. T. 141.

Fraudulent imitation means, not an obvious imitation, but an imitation varied for the purpose really of perpetrating what is a legal fraud: *Sherwood* v. *Decorative Art Tile Co.* (1887), 4 R. P. C. 207.

Obvious imitation does not mean exact copy: *Holdsworth* v. *McCrea* (1867), L. R. 2 H. L. 380, as interpreted in *McCrea* v. *Holdsworth* (1871), L. R. 6 Ch. App. 418; *Hecla Foundry Co.* v. *Walker* (1889), 6 R. P. C. 554.

Nor does obvious imitation mean obvious at a glance to the uneducated or unskilled eye; it means obvious to the judge or a jury with the assistance of experts—persons conversant with the particular trade: *Grafton* v. *Watson* (1884), 50 L. T. 420, confirmed 51 L. T. 141, following the principle laid down in *Mitchell* v. *Henry*, 15 Ch. D. 181. See also *Werner Motors* v. *Gamage's* (1903), 21 R. P. C. 137. But in an ordinary case, where expert evidence cannot assist, the decision will be left entirely to the jury. In *Gordon and Munro* v. *Patrick* (1894), 12 R. P. C. 22, Cave, J., in directing the jury, said: "It seems to me that no evidence can affect the matter . . . . it is for a plain, commonsense man to say, when he looks at these things, whether they are substantially the same or substantially different." (See also *Ingram and Kemp* v. *Edwards* (1904), 21 R. P. C. 463.)

The eye must be the judge whether the one article is an obvious imitation of the other. But there should be also taken in account, when considering whether any variations from the registered design which appear in the alleged infringement are substantial or immaterial, the state of knowledge at the time of registration and in what respect the design was new and original: *Hecla Foundry Co.* v. *Walker* (1889), 6 R. P. C. 544; *Re Clarke's Design* (1896), 13 R. P. C. 351; *Gillard* v. *Worrall* (1904), 21 R. P. C. 76.

The test is not merely to look at the two designs side by side; but consideration should also be given to what would be the effect supposing they were seen at different times, or supposing they were looked at a little distance off: *Grafton* v. *Watson*, *supra*, *Nevill* v. *Bennett* (1898), 15 R. P. C. 412; *Harper* v. *Wright and Butler* (1895), 12 R. P. C. 485.

The purpose of the design must not be considered in deciding as to subject-matter; but its usefulness, when applied to articles of utility, may be taken into account in considering the question of infringement: *Tyler* v. *Sharpe* (1893), 14 R. P. C. 35; *Gillard* v. *Worrall* (1904), *supra*. And see Chap. III. on "Novelty," *ante*, p. 30.

[6] *License or written consent.*—A license to use a patent may be verbal: *Crossley* v. *Dixon* (1863), 10 H. of L. Cas. 293. And it is submitted that on the same grounds a parol license to use a design may be sufficient. (See *ante*, § 122, and cases there cited.)

A licensee can be registered as proprietor, and Rules 45, 47 and 62

Sect. 60.

contemplate registration without the production of any written document. Under the old law it was held that a licensee could not sue for damages unless the license was in writing (*Jewitt* v. *Eckhardt*, L. R. 8 C. D. 404), but the wording of the present section is different. (See, however, *Wooley* v. *Broad* (1892), 9 R. P. C. 208.)

The peculiar position of the word "written" in this section makes the requirement of a writing in all cases still more uncertain. (See *Griffiths* v. *Hughes* (1892), L. R. 3 Ch. 105, a decision on a somewhat similarly worded phrase in the Trustee Act, 1888.)

The introduction of the words "written consent" leads to the inference that if the license is not a valid agreement, but only in that case, then to be of any effect as a defence under this section, the consent of the proprietor must be in writing.

[7] *Registered proprietor.*—As to what persons are included under the term proprietor, see sect. 93 (Definition of "Proprietor") and sect. 52, and the notes thereon, *ante*.

In an action for penalties for infringement of dramatic copyright, it was held that the license of one of two proprietors, not being in any sense agent for the other, was not a legal license: *Powell* v. *Head* (1879), 12 Ch. D. 686; but see *Lauri* v. *Renad* (1892), L. R. 3 Ch. 492, and *Wedekind* v. *General Electric Co.* (1897), 14 R. P. C. 190.

A proprietor who is not registered cannot proceed under this section. (See *Woolley* v. *Broad* (1892), 9 R. P. C. 208.)

But a proprietor, *e.g.*, an assignee who has not registered his assignment, might be able to obtain relief other than that given by these sections under the ordinary jurisdiction of the Courts: *Ihlee* v. *Henshaw* (1886), 31 Ch. D. 323; *Cooper* v. *Whittingham* (1880), 15 Ch. D. 501; *Hole* v. *Bradbury*, 12 Ch. D. 806. (See *ante*, Chap. X. "Remedies for Infringement," § 162.)

[8] *Or to do anything with a view to enable.*—This is a new provision introduced by sect. 36 (1) of the Amendment Act, 1907, and it will meet many cases not covered by the wording of the old Acts. (See note [3], *supra*.)

[9] *Knowing that the design has been applied.*—Under the Act of 1842, proof of knowledge from some source other than the proprietor, or express written notice from the proprietor, was required: *Norton* v. *Nicholls* (1859), 28 L. J. Q. B. 225.

It was held under the Act of 1883, which contained similar words, that a letter before action, informing a retail dealer that he had registered designs on sale, but which did not specify what those designs were, was insufficient to render him liable: *Smith* v. *Lewis Roberts & Co.* (1888), 5 R. P. C. 611. So an immediate submission and withdrawal of the infringing articles on the giving of notice will deprive the proprietor of the design of any right of action which he might otherwise have had against a mere seller, unless there are special circumstances which would justify the granting of an injunction: *Jan* v. *Grossman* (1895), 12 R. P. C. 537; and see *Brittain* v. *Kennedy* (1902), 19 T. L. R. 122.

[10] *Without the consent*—The publication of a book of registered designs was said not to be a license to persons to copy the designs for purposes of sale: *De la Branchardière* v. *Elvery* (1849), 18 L. J. Ex.

381; 4 Ex. 380. Nor is the sale of blocks for a specific purpose equivalent to the grant of a license to any third person who may acquire the blocks: *Cooper* v. *Stephens* (1895), 77 L. T. N. S. 300; *Marshall* v. *Bull* (1900), 16 T. L. R. 501.

[11] *Cause to be published or exposed.*—These words were introduced by sect. 36 (2) of the Amendment Act, 1907, and enable the provider of infringing goods to be proceeded against as well as the mere seller. (See note [3], *supra*.)

[12] *Shall be liable on every contravention.*—The words in the old section were "shall forfeit," but the effect is the same, and proceedings under this part of the section will be regarded as of a penal character, so that interrogatories cannot be allowed: *Saunders* v. *Wiel* (No. 1) (1892), 9 R. P. C. 459.

The sum recovered under this part of the section is a penalty. A penalty is a punishment, and punishment is to be awarded with due regard to what the offender has actually done. The penalty should be heavier or lighter as there may be circumstances of aggravation or mitigation: *Saunders* v. *Wiel* (No. 2) (1892), 9 R. P. C. 467. (See also *Sherwood* v. *Decorative Art Tile Co.*, 4 R. P. C. 207; *Rivett* v. *Grimshaw* (1894), 11 R. P. C. 351.)

The sale of each copy is a separate offence: *Ex parte Beale* (1868), L. R. 3 Q. B. 387. But the Court is not bound, in awarding penalties, to award for each offence even the minimum sum of one farthing; it may award a lump sum, not exceeding in the one action the maximum penalty fixed by the Act: *Hildesheimer* v. *Faulkners, Ltd.* (1901), 17 T. L. R. 737.

[13] *As a simple contract debt.*—The proceedings should ordinarily be taken in the High Court; and no jurisdiction is conferred on County Courts to deal with infringements under the Act. But *query* whether claims for mere penalties not exceeding 100*l.*, in which no question of title is raised, may not be brought in the County Courts as simple contract debts: *Bow* v. *Hart*, 21 T. L. R. 281, and notes thereon, *ante* § 169. As to the practice generally in actions for infringement, see *ante*, Chap. XI.; as to costs, §§ 192, 193; and as to other proceedings, §§ 160—168.

[14] *If the proprietor elects.*—A plaintiff may be compelled to state whether, in bringing an action for infringement, he is proceeding for a penalty or for damages, and he cannot have both remedies: *Saunders* v. *Wiel*, 9 R. P. C. 459. The plaintiff should follow the wording of the section in his pleadings: *Woolley* v. *Broad*, 9 R. P. C. 210—212.

[15] *Damages.*—The measure of damages is ordinarily the profit which the plaintiff would have made through the sale of so many additional copies of his own article to which the design is applied as the defendant has sold copies of his infringement: *Pike* v. *Nicholas* (1869), 38 L. J. Ch. 529. But where licenses have been granted or the articles do not compete other considerations may apply: *Ingram* v. *Edwards* (1904), 21 R. P. C. 463; *British Motors Syndicate* v. *Taylor* (1900), 17 R. P. C. 189; and *Saccharin Co.* v. *Chemicals and Drugs Co.* (1900), 17 R. P. C. 612. And cases cited *ante*, § 161.

[16] *And for an injunction.*—These words were introduced by sect. 36 (3) of the Amendment Act, 1907; but they only express the existing practice under the general equitable jurisdiction of the Courts.

Sect. 60. An injunction may sometimes be granted where no damages or other relief would be awarded. (See *ante*, §§ 102, 103.)

Application of certain provisions of the Act as to patents to designs.

61. The provisions of this Act[1] with regard to certificates of the validity[2] of a patent, and to the remedy in case of groundless threats of legal proceedings[3] by a patentee shall apply in the case of registered designs in like manner as they apply in the case of patents,[4] with the substitution of references to the copyright in a design for references to a patent, and of references to the proprietor of a design[5] for references to the patentee, and of references to the design for references to the invention.

[1] *The provisions of this Act shall apply.*—This is an entirely new provision in favour of designs introduced by sect. 37 of the Amendment Act, 1907, and it affords a much-needed extension of the law hitherto obtaining only in the case of patents. The incorporated sections are:—(a) **Sect. 35** and (b) **Sect. 36** of the Act:—

Sect. 35. Certificate of validity questioned and costs thereon.

(a) In an action for infringement of a patent, the Court may certify that the validity of the patent came in question; and, if the Court so certifies, then in any subsequent action for infringement the plaintiff in that action on obtaining a final order or judgment in his favour shall, unless the Court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client.

Sect. 36. Remedy in case of groundless threats of legal proceedings.

(b) 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 infringement of the patent, any person 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 he has sustained thereby, if the alleged infringement 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. Sect. 61.

[2] *With regard to certificates of validity.*—For detailed consideration of the subject, see Chap. X. "Remedies for Infringement," *ante*, § 168.

A certificate may be granted, even though the plaintiff fails in his action on the ground of non-infringement: *Morrison* v. *Asplin* (1904), 21 R. P. C. 557; and see *Hardtmuth* v. *Baker* (1904), 22 R. P. C. 66. Where the validity of the plaintiff's patent was challenged on the pleadings, a certificate was granted, though the defendant did not appear at the trial: *Welsbach Incandescent Gas Co.* v. *Krumm* (1900), 18 R. P. C. 211. But where the Court has pronounced no decision upon validity or invalidity, a certificate will not be granted: *New Inverted Incandescent Gas Lamp Co.* v. *Timmins* (1906), 23 R. P. C. 103; *Same* v. *Globe Light Co.* (1906), *Ibid.* 157.

[3] *In case of groundless threats of legal proceedings.*—A circular may be a threat, though addressed to no one in particular: *Johnson* v. *Edge* (1891), 9 R. P. C. 142. But see *Bishop* v. *Inman* (1900), 17 R. P. C. 479, where the question whether a circular amounted to a threat or only to a general warning was discussed. And see *Crowther* v. *United Flexible Tubing Co.* (1905), 22 R. P. C. 549.

The plaintiff must prove that he is not, in fact, infringing, and the Court has, in any case, a discretion as to granting the injunction: *Walker* v. *Clarke* (1887), 4 R. P. C. 111. If the defendant undertakes to take and pursue proceedings for the alleged infringement with due diligence an injunction will not usually be granted: *Mackie* v. *Laundry Supply Co.* (1891), 9 R. P. C. 465. And an injunction already granted may, in some cases, be dissolved on the action for infringement being brought: *Engels* v. *Hubert Syndicate* (1902), 19 R. P. C. 201.

[4] *As they apply in case of patents.*—For the practice as to granting certificates of validity in patent cases, see *Acetylene Illuminating Co.* v. *Midland Acetylene Syndicate* (1900), 17 R. P. C. 534. As to the granting of injunctions on the ground of failure to proceed with due diligence after threatening circulars or advertisements, see Chap. XII. §§ 202—205; *Challender* v. *Royle* (1887), 4 R. P. C. 363, and *Haskell Golf Ball Co.* v. *Hutchison and Main* (1904), 21 R. P. C. 497. As to the effect of the proviso to the section, see the recent case of *Craig* v. *Dowding* (noted L. J. N. C. 1908, p. 39), in which it was held by the Court of Appeal (reversing Kekewich, J.) that even admissions of alleged anticipation by the patentee's agent afforded no ground for impugning an action for infringement brought after the institution of a threats action, and discontinued after delivery of defence, and that as the effect of the proviso was to take away the statutory right of action where a *bonâ fide* action was brought, the threats action must be dismissed.

Damages representing the solicitor and client costs incurred in defending proceedings may be granted in a proper case: *Bishop* v. *Inman*, *supra*, and *Craig* v. *Dowding*, *supra*.

[5] *References to the proprietor of a design.*—For definition of "proprietor," see sect. 93 and notes thereon. As to the granting of a certificate of validity to a part proprietor, *query*.

Sect. 62.

PART III.—GENERAL.

Patent Office and Proceedings thereat.

Patent Office. 5 Edw. 7, c. 16.

62.—(1.) The Treasury may continue to provide for the purposes of this Act and the Trade Marks Act, 1905, an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.[1]

(2.) The Patent Office shall be under the immediate control of the comptroller,[2] who shall act under the superintendence and direction[3] of the Board of Trade.

(3.) Any act or thing directed to be done by or to the comptroller may be done by or to any officer authorised by the Board of Trade.

(4.) Rules under this Act may provide for the establishment of branch offices for designs at Manchester or elsewhere,[4] and for any document or thing required by this Act to be sent to or done at the Patent Office being sent to or done at any branch office which may be established.[5]

(*Sub-sects.* 1, 2 *and* 3 *of this section repeat substantially sect.* 82 *of the* 1883 *Act.* *Sub-sect.* 4 *is new.*)

[1] *The Patent Office.*—The former "Great Seal Patent Office" is still under the name of the "Patent Office," the building in which the official patent business is carried on.

[2] *The Comptroller-General.*—The Comptroller has the general superintendence of the Patent Office under the Board of Trade. The Registrar of Designs and Trade Marks acts for him in all matters relating to designs.

[3] *Who shall act under, etc.*—The Comptroller is further enabled by sect. 74 to apply to either of the law officers for directions in any case of doubt or difficulty.

[4] *Branch offices for designs.*—This is a new provision, introduced by sect. 38 of the Amendment Act of 1907. The Rules relating to the establishment of a branch office for designs for goods in Classes 13, 14 and 15 (which is the only branch office established under the Rules of 1908) are Nos. 80—88.

[5] *Being sent to or done at any branch office.*—The new Rules 81, 82 and 88 deal with this. The powers of local officers are regulated by the sub-sect. 3 to this section.

Sect. 63. Officers and clerks.

63.—(1.) There shall continue to be a comptroller-general of patents, designs, and trade marks, and the Board of Trade may, subject to the approval of the Treasury, appoint the comptroller,[1] and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may remove any of those officers and clerks.

(2.) The salaries[2] of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and those salaries and the other expenses of the execution of this Act and the Trade Marks Act, 1905, shall continue to be paid out of money provided by Parliament.

(*This section repeats sect.* 83 *of the* 1883 *Act.*)

[1] *Appointment of Comptroller.*—Sir H. Leader Lack was appointed Comptroller-General on the Act of 1883 coming into force, and he was succeeded in the office by the present Comptroller, C. N. Dalton, C.B. The Designs department is superintended by the Registrar of Designs and Trade Marks.

[2] *The Salaries.*—Particulars of the salaries of such officers and clerks are required to be laid annually before Parliament. (Sect. 76.)

Seal of Patent Office.

64. Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence.

(*This section repeats sect.* 84 *of the* 1883 *Act.*)

Fees.

Fees.

65. There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the Board of Trade,[1] so however that the fees prescribed in respect of the instruments and matters mentioned in the First Schedule to this Act[2] shall not exceed those specified in that Schedule.

(*This section repeats substantially sect.* 56 *of the* 1883 *Act.*)

Sect. 65.

[1] *Fees prescribed by the Board of Trade.*—See Rule 3, and the Schedule of Fees, *post*, p. 318.

[2] *Matters in First Schedule to this Act.*—Those relate only to instruments for obtaining patents and renewals thereof.

Provisions as to Registers and other Documents in Patent Office.

Trust not to be entered in registers.

66. There shall not be entered in any register kept under this Act,[1] or be receivable by the comptroller, any notice of any trust[2] expressed implied or constructive.

(*This section repeats sect.* 85 *of the* 1883 *Act.*)

[1] *Any register kept under this Act.*—As to entries in the register of designs, see sect. 52, and generally on this subject, Chap. V. on "The Register," *ante.*

[2] *Notice of any trust.*—See the proviso to sect. 71 (1), *infra*, and the provisions as to entries of mortgagees' and other interests in sect. 71 (2).

As a matter of fact, many deeds which are now filed in the Comptroller's Office contain declarations of trust in favour of other parties. But in the notification of the deed in the register itself, no notice is taken of the trust.

As regards patents, it has been decided that an equitable assignment of a patent, or share in it, may be put upon the register, and the practice is now extended to designs by sect. 71 (2): *Stewart* v. *Casey* (1892), 9 R. P. C. 9. And see *Haslett* v. *Hutchinson* (1891), 8 R. P. C. 457.

Inspection of and extracts from registers.

67. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed[1]; and certified copies,[2] sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.[3]

(*This section repeats sect.* 88 *of the* 1883 *Act.*)

[1] *As may be prescribed.*—See sect. 52 and Rule 61. The times when inspection may take place are notified by a placard posted at the Patent Office.

[2] *And certified copies.*—See sect. 78 and Rule 67.

[3] *Prescribed fee.*—The fee for a copy is 4*d.* per folio, but not less than 1*s.* in all. A certified copy is necessary when it is proposed to put a copy in evidence: Kekewich, J., in *Haslett* v. *Hutchinson* (1891), 8 R. P. C. 457. An additional fee of 1*s.* is charged for certifying; see Schedule of Fees, *post*, p. 319.

68. (*Refers to patents.*) Sect. 68.

69.—(1.) (*Refers to patents.*)

(2.) Where an application for a design has been abandoned[1] or refused[2] the application and any drawings, photographs, tracings, representations, or specimens left in connexion with the application shall not at any time be open to public inspection[3] or be published by the comptroller. Where application abandoned, &c.

[1] *Application for design abandoned.*—The whole of this sub-section is new, and was introduced as an addition to sect. 47 of the 1883 Act (which related to applications for registration) by sect. 29 of the Amendment Act, 1907. The reference to abandonment of an application for a design is to sect. 49 (4), as to which see *ante*, p. 218.

[2] *Or refused.*—The Comptroller has a general power to refuse registration under sect. 49 (3), as to which see *ante*, p. 218; and sect. 75 provides for refusal of designs which are contrary to law or morality. (See also sect. 56 (*ante*, p. 236) as to refusal of registration on the ground of identity with a design already on the register.)

[3] *Open to public inspection.*—The provisions as to inspection of designs are contained in sect. 56 (*ante*, p. 236) and Rule 61.

70. The comptroller may, on request in writing[1] accompanied by the prescribed fee,[2] Power for comptroller to correct clerical errors.

(a) correct any clerical error in or in connexion with an application for a patent or in any patent or any specification;

(b) cancel the registration of a design either wholly or in respect of any particular goods[3] in connexion with which the design is registered:

(c) correct any clerical error[4] in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register of designs.

91. *The comptroller may, on request in writing accompanied by the prescribed fee—* [Act of 1883, sect. 91.]

(*a*) *Correct any clerical error in or in connexion with an application for a patent, or for registration of a design or trade mark; or*

(*b*) *Correct any clerical error in the name, style, or address of*

Sect. 70.

the registered proprietor of a patent, design, or trade mark.

(c) [*This sub-section relates only to trade marks.*]

[Act of 1888, sect. 24.]

(d) **Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connexion with which he has desired the trade mark to be registered.**

[1] *Request in writing.*—The altered form of this section was introduced by sect. 41 of the Amendment Act, 1907. As to the persons to make the application and the evidence to be provided, see Rules 51—54; and as to the form of request, see Forms 17, 18, *post*, p. 382.

[2] *Prescribed fee.*—See First Schedule to the Rules, fees Nos. 14, 15, *post*, p. 319.

[3] *Cancel in respect of any particular goods.*—A mark (and, *semble*, a design) cannot properly be registered for goods in which the applicant does not deal, and does not intend to deal: *Re Butt's Trade Mark* (1899), 16 R. P. C. 411. But the procedure provided by this section is open only to persons whose names appear on the register as registered proprietors or by a trustee in bankruptcy, liquidator or other person entitled to act in the name of a registered proprietor. (See Rules 53, 54.)

Any application for cancellation by third parties must be made under the expunging provisions (sect. 72, *post*).

[4] *Correct any clerical error on the . . . register of designs.*—The new wording of this provision apparently excludes applicants for registration who were covered by the old Acts. Power is, however, given to amend any document or drawing or correct any irregularity in procedure generally by Rule 63.

Entry of assignments and transmissions in registers.

71.—(1.) Where a person becomes entitled by assignment,[1] transmission, or other operation of law to a patent, or to the copyright in a registered design, the comptroller shall, on request and on proof of title to his satisfaction,[2] register him as the proprietor of a patent or design.

(2.) Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest[3] in a patent or design, the comptroller shall, on request and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner[4] in the register of patents or designs, as the case may be.

(3.) The person registered as the proprietor of a patent or design shall, subject to the provisions of this

Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the patent or design [5] and to give effectual receipts for any consideration for any such assignment, license, or dealing: Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property.[6] Sect. 71.

(*Sub-sects.* (1) *and* (3) *of this section repeal substantially sect.* 87 *of the* 1883 *Act; sub-sect.* (2) *is new.*)

[1] *Assignment, etc.*—As to assignments and licenses generally, see Chap. VII. on "Proprietor," *ante*, and sect. 52 and Rules 43—48.

For form of assignment, see *post*, p. 403, and Forms 11, 12 and 13 to the Rules.

The stamp on registration of an assignment where the registered proprietor joins in the request is the same as for an original registration, but where the application is made by the assignee alone there is a fixed fee of 10*s*. (See Schedule of Fees, *post*, p. 319.)

Whether assignments should be in writing, see *Jewitt* v. *Eckhardt* (1878), 8 Ch. D. 404, and the cases cited in Chap. VII. on "The Proprietor," § 122—4, and notes to sect. 52, *ante*.

An assignee can, of course, take no greater right by an assignment than was vested in his assignor; and where the title of the person on the register is defective, it should be varied under the provisions of sect. 72 (sect. 90 of the old Act), and not by way of assignment to the person really entitled: *In re Grocott's Design* (1899), 17 R. P. C. 139.

[2] *Proof of title to his satisfaction.*—The Rules 45—48 and 62 seem to contemplate proof of title otherwise than by written assignment. Where there is a change, not of ownership but of the name of the owners, the Comptroller may act under this section without requiring any order of the Court. But see *In re Pneumatic Tyre Co.'s Design* (1894), 11 R. P. C. 636.

[3] *Entitled as mortgagee or otherwise.*—This is a new provision introduced by sect. 39 of the Amendment Act, 1907. It is subject, of course, to the provision as to the entry of trusts in sect. 66, as to which see *ante*, p. 254. A licensee is entitled to registration as a proprietor. (See *Jewitt* v. *Eckhardt*, *supra*, and sect. 93, definition of "Proprietor.")

[4] *In the prescribed manner.*—As to the steps to be taken and particulars required to secure registration, see Rules 43—45, and as to goods in the Manchester Classes, Rule 85.

[5] *Absolutely to assign . . . or otherwise deal.*—Whether this would operate so as to place a design which had been assigned but not registered in the name of the new proprietor in the "order and disposition" of the original proprietor, and thus vest it in his trustee in case of bankruptcy, see *ante*, p. 128, and *In re Dilworth* (1833), 1 Deac. & C. 411.

Sect. 71.

[6] *Any equities . . . may be enforced.*—Trusts are not entered on the register as such, though deeds containing them are commonly filed. (See sect. 66, and notes thereto, *ante*.)

Rectification of registers by Court.

72.—(1.) The Court[1] may, on the application in the prescribed[2] manner of any person aggrieved[3] by the non-insertion in or omission from the register[4] of patents or designs of any entry, or by any entry made in either such register without sufficient cause,[5] or by any entry wrongly remaining on either such register, or by an error or defect in any entry in either such register, make such order for making, expunging, or varying such entry[6] as it may think fit.

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of a register.[7]

(3.) The prescribed notice of any application[8] under this section shall be given to the comptroller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the Court.

(4.) Any order of the Court rectifying a register shall direct that notice of the rectification be served on the comptroller in the prescribed manner,[9] who shall upon the receipt of such notice rectify the register accordingly.

[Act of 1883, sect. 90.]

[Act of 1888, sect. 23.]

90.—(1.) *The Court may, on the application of any person aggrieved by the omission without sufficient cause of the name of any person* **or of any other particulars** *from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.*

(2.) *The Court may, in any proceeding under this section, decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.*

(3.) *Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller.* Sect. 72.

This section is an extension of the old sect. 90, provided for by sect. 40 of the Amendment Act, 1907. It applies to all the subjects comprised in the present Act, and much information may be obtained from the cases on Patents and Trade Marks. Similar provisions for rectification of the register are contained in the Copyright Acts (5 & 6 Vict. c. 45 (literary) and 25 & 26 Vict. c. 68 (artistic)), and the authorities thereunder also apply.

[1] *The Court.*—The High Court of Justice in England has jurisdiction (see sect. 92, *post*), even though the registered proprietor be domiciled in Scotland or Ireland: *Re King & Co.'s Trade Mark* (1892), 10 R. P. C. 350. Whether the Scotch or Irish Courts have a concurrent jurisdiction has been disputed; but the better opinion on the old sect. 90, to which the present section corresponds, was that, in the matter of applications for rectification, the jurisdiction is a special one, and is vested exclusively in the High Court of Justice in England: *Bayer* v. *Connell* (1897), 14 R. P. C. 275; see *Cowie* v. *Herbert* (1896), 14 R. P. C. 436 (a Scotch case). Applications under this section are by original motion, and any orders thereon can be appealed against like any other orders of Court. Such orders are, for the purpose of notice of appeal, final orders.

[2] *In the prescribed manner.*—No particular mode of application is prescribed by the Rules of 1908, so that the old practice will prevail until the issue of further Rules. (See Rule 95, and sect. 93, definition of "prescribed," *post*.)

[3] *Any person aggrieved.*—For those falling under the class of "persons aggrieved," see *Re Apollinaris Co.'s Trade Marks* (1891), 8 R. P. C. 137; *Re Talbot's Trade Marks* (1894), 11 R. P. C. 77; *Re Powell's Trade Mark* (1893) and (1894), 10 R. P. C. 195; 11 R. P. C. 4; and *Re Wright and Crossley's Trade Mark* (1898), 15 R. P. C. 131. The whole subject is dealt with under the heading "Rectification" in Chap. VI., §§ 99—106, *ante*.

In *Re Morey's Patent* (1858), 25 Beav. 81; 6 W. R. 612, decided under the Patent Law Amendment Act, 1852, it was held that the Court could, on such a motion, direct any *facts* relating to the proprietorship to be inserted on the register, but not the legal inference to be drawn from them. (See also *In re Horsley and Knighton's Patent* (1869), L. R. 8 Eq. 475.)

For the practice in designs cases, see, in addition, *In re Clarke's Design* (1896), 13 R. P. C. 357; *In re Morton's Design* (1899), 17 R. P. C. 117; and *In re Grocott's Design* (1899), 17 R. P. C. 139.

[4] *Non-insertion or omission from any register.*—Under the old Act, it was held that the provisions of sect. 90 would not enable a person to appeal to the Court from the refusal of the Comptroller or of the Board of Trade to register a design tendered (*Re The Trade Mark "Normal"* (1886), 4 R. P. C. 123); but the wording of the present section is much wider, and the application of this decision may now be questioned. The Comptroller's decision in questions of cancellation under sect. 58 is, however, made final by the Act, and it may be assumed

Sect. 72.

that any applications which amount to an indirect appeal against such a decision will not be entertained.

[5] *Entry made without sufficient cause.*—Where there has been no real user of a registered mark in a particular class, and registration has been effected without any *bonâ fide* intention to use the mark in that class, it may be expunged under this provision. A mark cannot properly be registered for goods in which the applicant does not deal or intend to deal: *Re Batt's Trade Mark* (1899), 16 R. P. C. 411.

Whether a design can be struck off the register because the applicant has been guilty of misconduct in selling as registered something which is not covered by the registered design, *query*. (See *In re Bayer's Design* (1906), 23 R. P. C. 553.)

[6] *Varying the entry.*—Under the old Act it was held that the Court had no power under the section to substitute the name of a true proprietor for the name of the person improperly on the register: *Re Guiterman's Design* (1886), 55 L. J. Ch. 309. But where the variation was only one of name and not of ownership (*Re Pneumatic Tyre Co.'s Design* (1894), 11 R. P. C. 636), or where the erroneous entry was made by mistake and not under some claim of right (*In re Grocott's Design*, *supra*), an order to vary might be made. (See note [2] to sect. 71, *ante*, p. 257.) But the extended wording of the present section is intended apparently to cover all cases of wrong entry, whether arising from mistake or otherwise.

[7] *In connexion with the rectification.*—This would include award of costs incidental to the application. The costs would ordinarily have to be paid by the unsuccessful party, unless that party is the Comptroller, but the matter is discretionary: *Re Guiterman's Design*, *supra*; but see *Re Pneumatic Tyre Co.'s Design*, *supra*.

The old section provided for damages being awarded to the party aggrieved, but there is no recorded instance of this having been done in a designs case, and the omission of the words from the new section would suggest that it was not intended to continue the power to make such orders on mere applications to expunge, although the wording of the section would permit of an award of damages in a proper case.

[8] *The prescribed notice.*—This refers to Rule 95, *post*, which prescribes a four day notice.

[9] *Notice of rectification in the prescribed manner.*—An office copy of the order together with a request for rectification is to be served on the Comptroller. (See Rule 96, and Form 26, *post*, p. 389.) As to designs for goods in the Manchester Classes, see also Rule 86.

Powers and Duties of Comptroller.

Exercise of discretionary power by comptroller.

73. Where any discretionary power[1] is by or under this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a design, without (if so required within the prescribed

time[2] by the applicant) giving the applicant an opportunity of being heard. Sect. 73.

(*This section repeats sect.* 94 *of the* 1883 *Act.*)

[1] *Discretionary power.*—For the cases in which the discretionary powers arise, see sects. 47, 53 (3), 54 (1), 56 (1), 58 (1), 70 and 75, and the notes thereto. For the practice on applications for registration, see Rules 31—34, and in other cases, Rules 55—58, *post.*

[2] *Prescribed time.*—This is within one month from the date of the Comptroller's objection on applications for registration (Rule 32), and in other cases one month from the date when the matter on which the Comptroller exercises the discretionary power has arisen (Rule 56). As to computation of time, see sect. 82, *infra.*

Power of comptroller to take directions of law officers.

74. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to a law officer[1] for directions in the matter.

(*This section repeats sect.* 95 *of the* 1883 *Act.*)

[1] *Apply to law officers.*—By sect. 62, sub-sect. (2), the Comptroller acts under the superintendence of the Board of Trade.

Applications to the law officers were not infrequently made under the corresponding section in the old Act, especially in cases of legal questions arising as to the construction of provisions of the Act in the course of practice, and there will now be greater occasion for such applications in view of the largely extended duties and powers of the Comptroller under this Act.

Refusal to grant patent, &c. in certain cases.

75. The comptroller may refuse[1] to grant a patent for an invention, or to register a design, of which the use would, in his opinion, be contrary to law or morality.[2]

(*This section repeats sect.* 86 *of the* 1883 *Act.*)

[1] *Comptroller may refuse.*—As to exercise of discretionary power by the Comptroller, see sect. 49 (3), and sect. 73, *supra*, and Rules 55—58.

Any refusal of the Comptroller under this section may be appealed against to the Board of Trade. (See notes [12] and [13] to sect. 49, *ante.*)

[2] *Contrary to law or morality.*—Under the corresponding section in the old Act a patent has been refused for an apparatus for a lottery: Griffin, P. C. p. 30.

Annual reports of comptroller.

76. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which the report relates all general rules made in that

Sect. 76.

year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

(*This section repeats sect.* 102 *of the Act of* 1883.)

Evidence, &c.

Evidence before comptroller.

77.—(1.) Subject to rules under this Act[1] in any proceeding under this Act before the comptroller the evidence shall be given by statutory declaration[2] in the absence of directions to the contrary; but in any case in which the comptroller thinks it right so to do, he may take evidence *vivâ voce*[3] in lieu of or in addition to evidence by declaration or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence by affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit.

(2.) In case any part of the evidence is taken *vivâ voce*, the comptroller shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as an official referee of the Supreme Court.[4]

[1] *Subject to Rules under this Act.*—The whole of the provisions of this section are new, and were introduced by sect. 45 of the Amendment Act, 1907. The Rules under the old Act (Rules of 1890, r. 24) required statutory declarations to be used on applications for entry of assignments on the register, but Rule 25 allowed the Comptroller to require further proof. The new section extends this power to all proceedings before the Comptroller under the Act.

The Rules of 1908 leave a large discretion to the Comptroller as to the nature of evidence to be furnished, and statutory declarations are not required on applications for entry of assignments, unless called for by the Comptroller (Rule 46). The only cases in which they are compulsory under the Rules are in answer to applications for cancellation on the ground of non-manufacture (Rules 71 and 73). A general power to dispense with any particular mode of proof is given to the Comptroller in all cases (Rule 62).

[2] *Statutory declaration.*—The declaration must be made before a justice of the peace or commissioner or other officer authorized to take oaths, if made anywhere in the United Kingdom, or before a

British minister or consular officer, notary public, judge, or magistrate abroad (Rule 78). Sect. 77.

[3] *Evidence* vivâ voce.—If the evidence is taken *vivâ voce* it will be on oath, and a note in writing must be taken of it which, it is presumed, will be available for the purposes of appeal in the same way as the statutory declaration for which it is substituted. (See sub-sect. 2, *supra*.) In appeals to the Board of Trade the Board will itself give directions as to the mode in which evidence is to be taken (Rule 92).

[4] *In the same position as an Official Referee.*—An Official Referee, and apparently therefore the Comptroller, is bound to conduct the taking of evidence in the same manner as nearly as circumstances will admit as on trials before a judge of the Supreme Court; and the attendance of witnesses before him may be enforced by subpœna issued as of course. (See Rules of Supreme Court, Ord. XXXVI. r. 49.)

Certificate of comptroller to be evidence.

78. A certificate[1] purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *primâ facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

(*This section repeats sect.* 96 *of the* 1883 *Act.*)

[1] *Certificate of the Comptroller.*—The certificate must state the purpose for which it is required. See Rule 67, and Form No. 22, *post*, p. 385.

A certificate as to identity with, or imitation of, a registered design given under Rule 60, is, however, not evidence: *Smith* v. *Hope* (1889), 6 R. P. C. 204.

Evidence of documents in Patent Office.

79. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence[1] in all Courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals.

(*This section repeats sect.* 89 *of the* 1883 *Act.*)

[1] *Admitted in evidence.*—The register is *primâ facie* evidence of any matters by this Act directed or authorised to be inserted therein. (See sect. 52 (3), *ante*.)

Sect. 80.

Transmission of certified printed copies of specifications, &c.

80.—(1.) Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted[1] to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after they have been accepted or allowed at the Patent Office.

(2.) Certified copies of or extracts from any such documents and of any documents so transmitted in pursuance of any enactment repealed by this Act shall be given to any person on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

(*This section repeats substantially sect.* 100 *of the* 1883 *Act.*)

[1] *Shall be transmitted.*—This section re-enacts, with modifications, sect. 5 of the old Patents Act of 1853 (16 & 17 Vict. c. 115).

For the corresponding provisions for registration of the decrees or orders of the Scotch and Irish Courts at the Patent Office, see sects. 94, 95. For the provisions as to designs in the Manchester Classes, see Rules 82 and 88.

Applications and notices by post.

81. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by post.[1]

97.—(1.) *Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.*

(2.) *In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.*

[1] *Sent by post.*—The rules contain similar provisions. (See Rule 9.) In *Trotter* v. *Maclean* (1879), L. R. 13 Ch. D. 574, a witness produced a copy of a letter which he said he had made, and swore that he should in the ordinary course of business have posted the original, and it was held that this was evidence of the posting, and that the original not being produced the copy was good secondary evidence. Sect. 81.

The latter part of the old section is now incorporated in the Rules, which also provide that any document sent by post shall be deemed to have been delivered at the time when it would arrive in the ordinary course of post (Rule 9).

Excluded days.

82. Where the last day fixed by this Act for doing anything under this Act falls on any day specified in rules under this Act[1] as an excluded day,[2] the rules may provide for the thing being done on the next following day not being an excluded day.

> **98.** *Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the Patent Office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days, if two or more of them occur consecutively.*

[1] *Rules under the Act.*—The Rules to be referred to are Rules 64 and 65. Power is also given generally to the Comptroller to enlarge the time for any proceedings by Rule 64.

[2] *Excluded days.*—These are all Saturdays and Sundays, the King's birthday, Christmas Day, Good Friday and the Bank holidays, *i.e.*, Easter Monday, Whit Monday, the first Monday in August and the 26th December if a week day or the 27th when the 26th is a Sunday.

Declaration by infant, lunatic, &c.

83.—(1.) If any person is, by reason of infancy, lunacy, or other disability,[1] incapable of making any declaration or doing anything required or permitted by or under this Act,[2] the guardian or committee (if any) of the person subject to the disability, or, if there be none, any person appointed by any Court possessing jurisdiction in respect of his property, may make such declaration or a declaration as nearly corresponding thereto

Sect. 83. as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(2.) An appointment may be made by the Court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the declaration or the doing of the thing.

(*This section repeats substantially sect.* 99 *of the* 1883 *Act.*)

[1] *Infancy, lunacy or other disability.*—So long as the necessary documents are prepared in the prescribed manner there is nothing to prevent the registration of a design by an infant, and the age, sanity or coverture of an applicant is in no way inquired into by the office or referred to in any of the proceedings to obtain registration.

In the case of an inventor of a design becoming insane before applying for registration, the application might be made for him under this section, and any other steps might, under the section, be taken for him in the event of insanity after application.

[2] *Permitted by the Act.*—See Rule 62, *post*, as to the power of the Comptroller to dispense with the production of any documentary or other evidence where from any reasonable cause the person required by the Act to supply it is unable to do so.

Register of Patent Agents.

84. (*Refers to agents for obtaining patents only.*)

Agents for patents.

85.—(1.) Rules under this Act may authorise[1] the comptroller to refuse to recognise as agent in respect of any business under this Act any person whose name has been erased from the register of patent agents, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, and may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any company which, if it had been an individual, the comptroller could refuse to recognise as such agent.

(2.) Where a company or firm acts as agents, such

Sect. 85.

rules as aforesaid may authorise the comptroller to refuse to recognise the company or firm as agent if any person whom the comptroller could refuse to recognise as an agent acts as director or manager[2] of the company or is a partner in the firm.

(3.) The comptroller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man.

[1] *Rules may authorise.*—This is a new statutory provision introduced by sect. 48 of the Amendment Act, 1907. A somewhat similar provision was made by Rule 2 of 1898, but this was limited to persons who had been removed from the register of patent agents, and the powers of control are now largely extended. (See Rule 12, *post.*)

[2] *Acts as director or manager.*—This would cover the case of a person acting in either of these capacities, although he may not have been formally appointed to either office.

Powers, &c. of Board of Trade.

Power for Board of Trade to make general rules.

86.—(1.) The Board of Trade may make such general rules and do such things as they think expedient, subject to the provisions of this Act[1]—

(a) For regulating the practice of registration under this Act:

(b) For classifying goods for the purposes of designs:

(c) For making or requiring duplicates of specifications, drawings, and other documents:

(d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, and other documents:

(e) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents:

(f) For regulating (with the approval of the Treasury)

Sect. 86.

the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad:

(g) For regulating the keeping of the register of patent agents under this Act:

(h) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2.) General rules shall whilst in force be of the same effect as if they were contained in this Act.[2]

(3.) Any rules made in pursuance of this section shall be advertised[3] twice in the official journal to be issued by the comptroller, and shall be laid before both Houses of Parliament as soon as practicable after they are made, and if either House of Parliament, within the next forty days after any rules have been so laid before that House, resolves that the rules or any of them ought to be annulled, the rules or those to which the resolution applies shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under the rules or to the making of any new rules.

(*This section repeats sect.* 101 *of the* 1883 *Act.*)

[1] *Subject to the provisions of this Act.*—General Rules have been issued by the Board of Trade under this section, which are to be cited as The Designs Rules, 1908, and came into operation from and immediately after the 31st December, 1907 (Rule 1). The previous General Rules then in force were thereby repealed without prejudice to anything already done under those Rules, or to any application or other matter then pending (Rule 98). For a discussion of the question whether the Court has power to declare the Rules *ultra vires*, see *Institute of Patent Agents* v. *Lockwood*, [1894] A. C. 347.

[2] *Of same effect as if contained in this Act.*—The requirements in the Forms are part of the Rules, but these and any of the provisions contained in the Rules will not be taken to import any additional conditions limiting the effect of registration under the statute unless such conditions are made "in clear and unmistakeable terms." Per Lord Herschell in *Re Rollason's Design* (1898), 15 R. P. C. 441.

[3] *Shall also be advertised.*—See the Rules Publication Act, 56 & 57 Vict. c. 66. Sect. 86.

Proceedings of the Board of Trade.

87.—(1.) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

(*This section repeats sect.* 25 *of the Act of* 1888, *incorporated as sect.* 102 (*a*) *in the* 1883 *Act.*)

Provision as to Order in Council.

88. An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if it had been contained in this Act; but may be revoked or varied by a subsequent Order.

(*This section repeats sect.* 104 (2) *of the* 1883 *Act.*)

Offences.

Offences.

89.—(1.) If any person makes or causes to be made a false entry [1] in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.[2]

Sect. 89.

(2.) If any person falsely[3] represents that any article sold by him is a patented article, or falsely describes any design applied to any article sold by him as registered, he shall be liable for every offence,[4] on conviction under the Summary Jurisdiction Acts, to a fine not exceeding five pounds.

(3.) If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word "patent," "patented," "registered," or any other word expressing or implying[5] that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design applied thereto is a registered design.

(4.) Any person who, after the copyright in a design has expired,[6] puts or causes to be put on any article to which the design has been applied the word "registered," or any word or words implying that there is a subsisting copyright in the design, shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding five pounds.

(5.) If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

[Act of 1883, sect. 93.]

93. *If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.*

[Act of 1883, sect. 105.]

105.—(1.) *Any person who represents that any article sold by him is a patented article, when no patent has been granted for*

Sect. 89.

the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2.) *A person shall be deemed, for the purpose of this enactment, to represent that an article is patented or a design or a trade mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.*

[1] *False entry.*—This does not extend to a case of an entry which is merely ambiguous, although the registered owner might thereby be enabled to misrepresent the nature of the protection to which he is entitled. But whether an ambiguity of this nature would entitle an aggrieved person to expunge under sect. 72, *query*. (See *In re Bayer's Design* (1906), 23 R. P. C. 553.)

[2] *Misdemeanor.*—For the treatment of this subject generally, see Chap. XII., "Offences," *ante*. As to punishment of misdemeanors in Isle of Man, see sect. 96, *post*.

[3] *Falsely.*—*I.e.*, whether the mark is used before registration has been effected, or after the copyright term has expired.

A person cannot mark an article "registered" until he has obtained his certificate of registration: *Reg.* v. *Crampton* (1886), 3 R. P. C. 367.

And this would apply equally to a case of false representation of an expired registration as still subsisting: *Cheavin* v. *Walker* (1877), L. R. 5 Ch. D. 863.

[4] *For every offence.*—A separate fine is incurred for each copy sold: *Reg.* v. *Crampton*, *supra*; cf. *Ex parte Beale* (1868), L. R. 3 Q. B. 357 (a copyright case).

[5] *Expressing or implying.*—Where there is no misrepresentation in fact, *e g.* where goods have from long usage acquired the designation in the trade generally of "patent," though not in fact patented, there will be no offence: *Marshall* v. *Ross* (1869), L. R. 18 Eq. 651; *Sen-Sen Co.* v. *Britten* (1899), 16 R. P. C. 137. But see sub-sect. 4 of this section.

[6] *After the copyright has expired.*—This is a reversion to the provisions of the 1842 and 1843 Acts (sects. 11 and 4 respectively), which had been omitted in the subsequent Acts.

Unauthorised assumption of Royal Arms.

90.—(1.) The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms or to place the Royal Arms on any patented article.

(2.) If any person, without the authority of His Majesty, uses in connection with any business, trade,

Sect. 90.

calling, or profession the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such arms to continue to use such trade mark.

(*Sub-sect.* (2) *repeats substantially sect.* 108 *of the* 1883 *Act. Sub-sect.* (1) *and the proviso at end are new.*)

International and Colonial Arrangements.

International and Colonial arrangements.

91.—(1.) If His Majesty is pleased to make any arrangement with the government of any foreign state[1] for mutual protection of inventions, or designs, or trade marks,[2] then any person[3] who has applied for protection for any invention, design, or trade mark in that state shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or the Trade Marks Act, 1905, in priority to other applicants;[4] and the patent or registration shall have the same date as the date of the application[5] in the foreign state.

Provided that—

(a) The application is made, in the case of a patent within twelve months, and in the case of a design or trade mark within four months,[6] from the application for protection in the foreign state; and

(b) Nothing in this section shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his complete specification is accepted, or his design or trade mark is registered, in this country.

Sect. 91.

(2.) The patent granted for the invention or the registration of a design or trade mark shall not be invalidated—

(a) in the case of a patent, by reason only of the publication of a description of, or use of, the invention; or

(b) in the case of a design, by reason only of the exhibition or use of, or the publication [7] of a description or representation of, the design; or

(c) in the case of a trade mark, by reason only of the use of the trade mark,

in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(3.) The application for the grant of a patent, or the registration of a design or the registration of a trade mark under this section, must be made in the same manner as an ordinary application [8] under this Act or the Trade Marks Act, 1905: Provided that—

(a) In the case of patents the application shall be accompanied by a complete specification, which, if it is not accepted within the twelve months from the application for protection in the foreign state, shall with the drawings (if any) be open to public inspection at the expiration of that period; and

(b) In the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under the Trade Marks Act, 1905.

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which His Majesty by Order in Council [9] declares them to be applicable, and so long only in the case of each state as

Sect. 91. the Order in Council continues in force with respect to that state.

(5.) Where it is made to appear to His Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that possession, with such variations or additions, if any, as may be stated in the Order.

(*This section repeats substantially sects.* 103 *and* 104 *of the* 1883 *Act, but sub-sect.* (2) *is so important that the terms of the repealed sect.* 103 (2) *are here set out.*)

[Act of 1883, sect. 103.]

103.—(2.) *The publication, in the United Kingdom, or the Isle of Man, during the respective periods aforesaid, of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark.*

[1] *Arrangements with foreign States.*—For a complete list of the States with which such arrangements have been made, see *post*, p. 414.

[2] *Mutual protection of inventions, designs, and trade marks.*—The terms of the International Convention contemplate a wider scope, but its operation in Great Britain appears to be limited to the subjects above mentioned, except in so far as the ordinary legal remedies are equally available to foreigners and British subjects. A special arrangement was made with Greece on 27 July, 1894.

[3] *Any person.*—*Semble*, a corporation is a "person," and can claim rights under this section: *Re Carez* (1889), per Webster, A.-G., 6 R. P. C. at p. 552.

A patent under the International Convention and sect. 91 can be granted only to the person who has made the foreign application: *S. C., ubi supra.*

"Person" includes citizen and foreigner alike: *Re Shallenberger* (1889), 6 R. P. C. 550.

[4] *In priority to other applicants.*—*Query* whether registration of a design would be obtainable under this where the copyright has already been secured by another person: see *In re Mann's Patent*, 7 R. P. C. 13.

[6] *Date of the application.*—Those words were, at the instance of Lord Herschell, substituted by sect. 6 of the Act of 1885 for the words "date of the protection obtained" used in the 1883 Act. They point to the requirement that applications under this section shall be made within the time allowed dating from the *first* foreign application, and this was the practice under the old Rule. Sect. 91.

[6] *Within four months.*—Strict compliance with the Act and Rules is a condition precedent to obtaining the benefits of the Convention, and the Comptroller may refuse to grant priority where there has been an error in the document submitted involving delay which extends beyond the time allowed for the application: *In the matter of an Application, etc.*, 23 R. P. C. 288. (See the International Convention, Art. 4, *post*, p. 323.)

[7] *By reason of use, exhibition or publication.*—See the International Convention, Art. 4. As to the effect of user abroad after registration here, see sect. 58, *ante*. Under the corresponding section in the old Act it was held that the sale of unmarked articles before the application for priority avoided the copyright under sect. 57, but the new provisions (sect. 54) do not attach this penalty to the failure to mark copies, and only stop the remedy which is not available until the registration has been completed.

[8] *As an ordinary application.*—See sect. 49, *ante*, for the regulations applying to applications.

[9] *Orders in Council.*—For complete table of these Orders in Council, see *post*, p. 414.

Definitions.

Provisions as to "the Court."

92.—(1.) In this Act, unless the context otherwise requires, "the Court"[1] means, subject to the provisions as to Scotland, Ireland, and the Isle of Man, the High Court in England.

(2.) Where by virtue of this Act a decision of the comptroller is subject to an appeal[2] to the Court, or a petition may be referred or presented to the Court, the appeal shall, subject to and in accordance with Rules of the Supreme Court, be made and the petition referred or presented to such judge of the High Court as the Lord Chancellor may select for the purpose, and the decision of that judge shall be final, except in the case of an appeal from a decision of the comptroller revoking

Sect. 92. a patent on any ground on which the grant of such patent might have been opposed.

(*Sub-sect.* (1) *repeats substantially the corresponding part of sect.* 117 *of the* 1883 *Act. Sub-sect.* (2) *is new.*)

[1] *The Court.*—It was decided in *Proctor* v. *Sutton Lodge Chemical Co.* (1888), 5 R. P. C. 184, that *the Court* does not include the Court of Chancery of the County Palatine of Lancaster. But now, by 53 & 54 Vict. c. 23, the County Palatine Court has, as regards all persons and property within its jurisdiction, the same jurisdiction and powers as the Chancery Division of the High Court.

The jurisdiction of the County Courts was held to be ousted by the Act of 1883, and this decision still applies: *Reg.* v. *County Court of Halifax*, 8 R. P. C. 338; *Bow* v. *Hart* (1905), 21 T. L. R. 251. The repealed Act of 1858 (21 & 22 Vict. c. 70) provided expressly for the institution of proceedings for the recovery of damages in the County Court, but there was nothing similar in the 1883 Act, nor is there in the new Act, unless the power given by sect. 60 (2) to recover a penalty as a simple contract debt may be taken to confer jurisdiction in such cases. (See § 169, and note [12] to sect. 60, *ante*.)

[2] *Decision of Comptroller subject to appeal.*—This sub-section is new, and was introduced by sect. 28 of the Amendment Act, 1907. It was apparently intended to apply to appeals in the new matters brought under the jurisdiction of the Comptroller by that Act, but by its inclusion in the present consolidating Act it is made to apply to every appeal from any decision of the Comptroller which is subject to appeal to the High Court.

As to appeals from the Comptroller in matters relating to designs, see sect. 49 (3) (refusal to register), sect. 58 (1) (cancellation of registration), and notes thereon, *ante*.

Judgments in actions for infringement and motions for expunging, etc. under sect. 72 are not affected by this provision, and appeals thereon will be to the Court of Appeal and House of Lords as with other proceedings in the High Court.

Definitions.

93. In this Act, unless the context otherwise requires,—

"Law officer" means the Attorney-General or Solicitor-General for England:

"Prescribed" means prescribed by general rules under this Act:

"British possession" does not include the Isle of Man or the Channel Islands:

"Patent" means letters patent for an invention:

"Patentee" means the person for the time being entitled to the benefit of a patent:

Sect. 93.

"Invention" means any manner of new manufacture the subject of letters patent and grant of privilege within section twenty-six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled "An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof"), and includes an alleged invention:

"Inventor" and "applicant" shall, subject to the provisions of this Act, include the legal representative of a deceased inventor or applicant:

"Design" means any design[1] (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act, 1814)[2] applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable,[3] whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined:

54 Geo. 3, c. 56.

"Article" means (as respects designs) any article of manufacture[4] and any substance artificial or natural, or partly artificial and partly natural:

"Copyright" means the exclusive right to apply[5] a design to any article in any class in which the design is registered:

"Proprietor of a new and original design,"—

(a) Where the author of the design, for good consideration, executes the work for

Sect. 93.

some other person, means the person[6] for whom the design is so executed,[7] and

(b) Where any person acquires the design or the right to apply the design[8] to any article, either exclusively of any other person or otherwise,[9] means, in the respect and to the extent in and to which the design or right has been so acquired,[10] the person by whom the design or right is so acquired; and

(c) In any other case, means the author[11] of the design;

and where the property in, or the right to apply, the design has devolved[12] from the original proprietor upon any other person, includes that other person.

(*The definitions of "design," "article," and "copyright" repeat sect.* 60 *of the* 1883 *Act.*) *The definition of "proprietor of a new and original design" is taken from the repealed sect.* 61, *which was in the following terms:—*

[Act of 1883, sect. 61.]

61. *The author of any new and original design shall be considered the "proprietor" thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every person on whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise.*

[1] *Any design.*—By this "definition" the limits of the operation of the Act are described, but no real definition of the meaning of design is given. For the subject generally see *ante*, Chap. II. on "The Meaning of Design," p. 17 *et seq.*

The wording is the same as that in the Act of 1883 (sect. 60), which, again, was taken from sect. 3 of the Act of 1842, made wider by the omission of the words "for the ornamentation of" before "any article

of manufacture," so as to cover designs for purposes of utility, which was formerly dealt with by the Act of 1843.

An ornamented design under the Act of 1842 was judicially defined as something in the nature of a drawing, picture, or diagram applicable to the ornamentation of some article of manufacture; and as the representation of something which a draughtsman had for the first time produced: *Harrison* v. *Taylor* (1859), 29 L. J. Ex. 3.

In *Holdsworth* v. *McCrea* (1867), L. R. 2 H. L. 380, it was said that a design is a thing in which the merit of the invention lies in the drawing or in forms that can be copied: *Holdsworth* v. *McCrea* (1867), L. R. 2 H. L. 380—388.

The novelty is not required in the idea of the design itself, but in the application of the design to some article of manufacture: *Saunders* v. *Wiel* (No. 2), 10 R. P. C. 29; *Hothersall* v. *Moore*, 9 R. P. C. 27; and see *Hanfstaengl* v. *W. H. Smith and Sons* (a copyright case) (1905), 21 T. L. R. 291.

[3] *The Sculpture Copyright Act*, 1814.—This Act applies to every new and original sculpture, model, copy, or cast of the human figure, or any part of it, clothed in drapery or otherwise, or of any animal, or the two in combination, or of "any subject being matter of invention in sculpture," or of any relief representing any such matters or things, and it is obvious that many "designs" may be brought within this "sculptures" Act and *vice versâ;* but the protection is uncertain and defective.

[3] *By whatever means it is applicable.*—The object of this clause is to make the word "design" throughout "as extensive as it reasonably ought to be." The object in introducing the words "whether applicable for the pattern, or for the shape or configuration, or for the ornament thereof," was to use words which "would include everything which would ordinarily fall within the term 'design,' and to show that the word 'design' was not intended to be used in any technical sense as excluding anything that would ordinarily fall within it." Per Lord Herschell, *In re Rollason's Design* (1898), 15 R. P. C. 441.

[4] *Article of manufacture.*—A process of manufacture cannot be a design: *Moody* v. *Tree* (1892), 9 R. P. C. 333; *Cooper* v. *Symington* (1893), 10 R. P. C. 264; *In re Bayer's Design* (1907), 24 R. P. C. 65. But the fact that the design incidentally describes a mode of manufacture does not make it any the less a design.

And the fact that an article would be a good subject-matter of a patent does not necessarily mean that it is not a design: *Hecla Foundry Co.* v. *Walker* (1889), 6 R. P. C. 554; *Werner Motors* v. *Gamages* (1903), 21 R. P. C. 137, 627.

A design applied to an article made in two parts (*e.g.*, butter dish and cover) forms one design: *Fielding* v. *Hawley*, 48 L. T. N. S. 639. But see *In re Morton's Design* (1899), 17 R. P. C. 117.

A design may be a complete design though only applied to a part of an article: *Hecla Foundry Co.* v. *Walker*, *supra*.

An effect is not a design, but only the combination which produces the effect: *Grafton* v. *Watson* (1884), 50 L. T. N. S. 420. So the Act does not apply to the things to which a design is applied, but to the design applied to them. But when the design is for the shape of a thing, the distinction is reduced to "the difference between the shape

Sect. 93.

of a thing and a thing of that shape." Per Lindley, L.J., in *Re Clarke's Design* (1896), 13 R. P. C. 351.

No mechanical principle or contrivance can be a design, nor is protection given to the object or purpose sought to be attained. If advantages, such as attend a mechanical contrivance, are obtained, it is only because no shape not substantially the same, and which is therefore not an infringement, will achieve the same end: *Heela Foundry Co.* v. *Walker*, *supra*; *Walker* v. *Falkirk Iron Co.* (1887), 4 R. P. C. 390; *Gillard* v. *Worrall* (1904), 22 R. P. C. 76; and see *Re Bayer's Design*, *supra*.

[5] *The exclusive right to apply.*—All that is protected by copyright in a design is the particular design and not any idea underlying it: *Saunders* v. *Wiel* (No. 1), 9 R. P. C. 469. Preparing rollers or dies to print a registered design has been held not to be an application of such a design to an article in the class in which it is registered: *Potter* v. *Braco de Prata Printing Co.* (1891), 8 R. P. C. 218. But this would probably now be held to be an infringement within the new wording introduced in sect. 60, declaring it to be unlawful "to do anything with a view to enable the design to be so applied."

[6] *Executes the work for some other person.*—The wording of this definition is taken generally, with the exception hereafter noted (note [3] *infra*), from sect. 5 of the Act of 1842. For the general treatment of the subject, see Chap. VII. on "Proprietor," *ante*, p. 115 *et seq.*

The master of a workman employed to make a design, or of a workman employed in a business, who makes a design for use in that business, is the proprietor of such a design and can register it.

The question of employment on behalf of another person is one of fact, and the onus of proof is on the person who claims to be author or proprietor of the design: *Hothersall* v. *Moore* (1892), 9 R. P. C. 27; *Re Heinrich's Design* (1892), 9 R. P. C. 73; *Re Grocott's Design* (1899), 17 R. P. C. 139.

Where registration of proprietorship is effected on behalf of an employer under this section, it is important that the name of the actual employer, and not of any person acting as agent on his behalf (*e.g.*, the managing director of a limited company), be inserted, or the registration may be invalidated: *Petty* v. *Taylor* (1896), 75 L. T. N. S. 545.

[7] *Means the person for whom the design is executed.*—The section in the old Act of 1842 (sect. 5) contained here the words "and shall be entitled to be registered in the place of the author," and it is doubtful whether, in the absence of similar words from this definition, a subsequent proprietor may not avail himself of an original registration by the author. (See *Ihlee* v. *Henshaw* (1886), 31 Ch. D. 323.)

[8] *Acquires the design or the right to apply.*—The assignee of a design, whether of the whole right or of a part, is a proprietor.

The purchaser abroad of an article to which a new and original design has been applied does not acquire a design within the meaning of the Act by bringing the article purchased to this country: *Lazarus* v. *Charles*, L. R. (1873) 16 Eq. 117; 42 L. J. Ch. 507. If a design thus imported be registered, it can be expunged under sect. 72, on

the ground that the person in whose name it is registered is not the proprietor: *Re Guiterman's Design* (1885), 55 L. J. Ch. 309. "For a man to be a proprietor within the Act he must have some right, either general or limited, to apply the design . . . . Acquiring a new and original design, or a right to apply the same, are the same thing for the purpose of the Act." Per Jessel, M.R., in *Jewitt* v. *Eckhardt* (1878), 8 Ch. D. at p. 408.

Where an American manufacturer sold to the plaintiff the exclusive right to sell in England an article newly designed and then about to be manufactured, and the exclusive right also to obtain such protection for the same as he could do under English law, it being stipulated that the plaintiff should obtain the articles exclusively from the manufacturer, it was held that the plaintiff had not acquired, under the contract, the right to apply the design to a manufactured article, so as to entitle him to register in his own name under the Act: *Jewitt* v. *Eckhardt*, *supra*. See also *Lazarus* v. *Charles* (1873), L. R. 16 Eq. 117; *Re Guiterman's Design* (1885), 55 L. J. Ch. 309; and *Woolley* v. *Broad* (1892), 9 R. P. C. 208. For other cases bearing on this question, see *Betts* v. *Willmott* (1871), 6 Ch. App. 259; *Pitts* v. *George*, [1896] 2 Ch. 866; and *Landeker and Brown* v. *Wolff* (1908), Law Journal, 1908, p. 37.

[9] *Either exclusively or otherwise.*—A license may be given to apply the design to certain articles and not to others, and a license may be either exclusive or non-exclusive. Such a licensee is a proprietor to the extent of his interest, and acquires the same rights in the design as a partial assignee: *Jewitt* v. *Eckhardt*, *supra*.

A licensee may register himself as a proprietor, but not until the author or sole proprietor has done so (see sect. 56 and note [4] thereon); and a licensee who has thus registered himself has, under the terms of sect. 60, a right to sue for infringement of the design. As to registration of partial interests, see sect. 72 (2).

[10] *To the extent.*—Any one or more co-proprietors may assign his or their interests in the copyright, and the assignee may maintain an action for infringement in respect of the interest so acquired without the concurrence of the other partners: *Lauri* v. *Renad* (1892), L. R. 3 Ch. 402.

[11] *The author.*—A person who merely suggests the idea of a design is not the author: *Shepheard* v. *Conquest* (1856), 17 C. B. 427. But the case may be different if he has a share in the execution of the work: *Hatton* v. *Kean* (1859), 8 W. R. 7; and see *Springfield* v. *Thame* (1903), 19 T. L. R. 650.

A person who draws a rough sketch of a design, and gives verbal instructions sufficient for a workman to work by so as to produce the article, is an author: *Pearson* v. *Wilkinson* (1906), 23 R. P. C. 738. See also *Nevill* v. *Bennett* (1898), 15 R. P. C. 412.

[12] *Has devolved.*—A design is personal property (see sect. 71 (1)), and devolves like any other personal property.

In case of bankruptcy the property in the design passes to the trustee. A document which creates an equitable proprietorship, though not amounting to a legal assignment, may also be entered on the register so as to give the rights of a registered proprietor: *Stewar:*

Sect. 93. v. *Casey* (1892), 9 R. P. C. 9; and see the new provisions contained in sect. 71 (4) as to the registration of mortgages, licenses and other interests.

Application to Scotland, Ireland, and the Isle of Man.

Application to Scotland.

94. In the application of this Act to Scotland—

(1.) (*Deals with actions for infringement of a patent.*)

(2.) Any offence[1] under this Act declared to be punishable on conviction under the Summary Jurisdiction Acts may be prosecuted in the sheriff court:

(3.) (*Refers to proceedings for revocation of a patent.*)

(4.) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends,[2] affect the jurisdiction of any Court in Scotland[3] in any proceedings relating to patents or to designs; and with reference to any such proceedings, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of that Court:

(5.) (*Refers to petitions for compulsory licenses, etc.*)

(6.) The expression "Rules of the Supreme Court" shall, except in section ninety-two of this Act, mean act of sederunt:

(7.) If any rectification of a register under this Act is required[4] in pursuance of any proceeding in a Court, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly:

(8.) The expression "injunction" means "interdict."

(*The portions of this section referring to Designs repeat sects.* 108 *and* 111 *of the* 1883 *Act.*)

[1] *Any offence.*—For the provisions as to offences, see sects. 89 and 90, *ante.*

[2] *Except so far as the jurisdiction extends.*—The register is an English one, and any proceedings for expunging or varying entries come within the special jurisdiction created by the Act: *Bayer* v. *Connell* (1897), 14 R. P. C. 275. But for Scotland see *Cowie* v. *Herbert* (1896), 14 R. P. C. 436; *Dewars, Ltd.* v. *J. T. Dewar* (1899), 17 R. P. C. 341, and *Reid* v. *Thompson* (1905), 22 R. P. C. 250 and 376.

[3] *Jurisdiction of any Court in Scotland.*—This jurisdiction is concurrent only. The section does not confer an exclusive jurisdiction on the Scotch Courts, though the registered proprietor be resident in Scotland: *Re King & Co.'s Trade Mark* (1892), 10 R. P. C. 350; *Bayer* v. *Connell, supra.*

[4] *Rectification of a register . . . . is required.*—This does not confer any power to rectify by Order of the Court, but refers only to the result of any proceeding in which the title to the copyright may come in question. In *Bayer* v. *Connell, supra*, the Master of the Rolls said: "Whatever ambiguity there may be in the section of the Act of 1883 as to the meaning which must be given to that word ('jurisdiction'), it is perfectly plain that under the Act of 1875 (38 & 39 Vict. c. 91) there can be no such ambiguity. 'The provisions of this Act conferring a special jurisdiction on the Court, as above defined, shall not, except so far as such jurisdiction extends (*i.e.*, the special jurisdiction), affect the jurisdiction of any Court in Scotland or Ireland in causes, actions or proceedings relating to Trade Marks.' There was no power given to any Court in Scotland or Ireland to alter or rectify the register . . . and it is impossible to suppose that the Act of 1883 intended to confer any such jurisdiction." See Chap. VI. on "The Register," § 107, *ante*, and notes to sect. 72.

95. In the application of this Act to Ireland[1]— Application to Ireland.

(1.) (*Refers to patents.*)

(2.) The provisions of this Act conferring a special jurisdiction on the Court, as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Ireland in any proceedings relating to patents or to designs; and with reference to any such proceedings the term "the Court" means the High Court in Ireland:

(3.) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court, a copy of the order, decree, or other authority for the rectification shall be served

Sect. 95.

on the comptroller, and he shall rectify the registor accordingly.

(*The portions of this section referring to designs repeat sect.* 111 *of the* 1883 *Act.*)

[1] *Application of Act to Ireland.*—See the notes to the last section, Nos. [1] to [4], as to the nature and extent of the jurisdiction, which apply equally to Ireland and the Irish Courts.

Isle of Man.

96. This Act shall extend to the Isle of Man, subject to the following modifications:—

(1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man in proceedings for infringement, or in any action or proceeding respecting a patent or design competent to those Courts:[1]

(2.) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court:

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction[2] may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

(*This section repeats sect.* 112 *of the* 1883 *Act.*)

[1] *Any proceeding competent to those Courts.*—This does not extend to a motion to rectify the register which is not within the jurisdiction of the Courts of the Isle of Man. Cf. *Bayer* v. *Connell*, *supra*.

[2] *Punishable on summary conviction.*—See *ante*, sects. 89 and 90.

Repeal, Savings, and Short Title.

97. (*Saving for prerogative in letters patent.*) Sect. 97.

Repeal and savings.

98.—(1.) The enactments mentioned in the Second Schedule to this Act are hereby repealed[1] to the extent specified in the third column of that schedule—

(a) As respects the enactments mentioned in Part I.[2] of that Schedule, as from the commencement of this Act;

(b) As respects the enactments mentioned in Part II.[3] of that Schedule, as from the date when Rules of the Supreme Court regulating the matters dealt with in those enactments come into operation;

(c) As respects the enactments mentioned in Part III.[4] of that Schedule, as from the date when rules under this Act regulating the matters dealt with in those enactments come into operation;

and the enactments mentioned in Part II. and Part III. of that Schedule shall, until so repealed,[5] have effect as if they formed part of this Act:

Provided that this repeal shall not affect any convention, Order in Council, rule, or table of fees having effect under any enactment so repealed, but any such convention, Order in Council, rule, or table of fees in force at the commencement of this Act shall continue in force,[6] and may be repealed, altered or amended, as if it had been made under this Act.

(2.) Except where otherwise expressly provided, this Act shall extend to all patents granted and all designs registered before the commencement of this Act,[7] and to applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

113. *The enactments described in the Third Schedule to this*

Sect. 98.

[Act of 1883, sect. 113.]

Act are hereby repealed. But this repeal of enactments shall not—

(*a*) *Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or*

(*b*) *Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or*

(*c*) *Take away or abridge any protection or benefit in relation to any such action or proceeding.*

[Act of 1888, sect. 27.]

The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act.

[1] *Acts repealed.*—The old Acts were all repealed by the Act of 1883. Those relating to designs now repealed are the Act of 1883 (46 & 47 Vict. c. 57), with the small temporary exceptions noted in note [4] below; the Act of 1885 (48 & 49 Vict. c. 63); the Act of 1888 (51 & 52 Vict. c. 50); and the Amendment Act of 1907 (7 Edw. VII. c. 28). See the detailed Schedule of all repealed Acts with full titles, *post*, p. 333.

[2] *The enactments in Part I.*—These are all the above statutes with the exception, so far as concerns designs, of sub-sects. 2 and 3 of sect. 47 and sect. 48 of the 1883 Act, as to which, see note [4] below. The repeal takes effect as from the commencement of the Act, *i.e*, the 1st of January, 1908.

[3] *The enactments in Part II.*—These are sub-sects. 5, 6 and 7 of sect. 26 and sect. 29 of the 1883 Act, which relate to patents.

[4] *The enactments in Part III.*—These are sub-sects. 2 and 3 of sect. 47 of the Act of 1883 (specifying the form of application for registration, its contents and how to be lodged), and sect. 48 of the same Act containing the requirements as to drawings, etc. to be furnished on the application, and the powers of the Comptroller in connection therewith. They were to remain in force only until the new Rules came into operation, but the Rules of 1908 were promulgated before the 1st January, 1908, and came into effect on that date.

[5] *Until so repealed.*—By the provisions of the new Rules 1 and 98, the excepted enactments are now actually repealed.

[6] *Continue in force.*—For a full list of the Conventions and Orders in Council which have been made under the old Act and are continued by the present Act, see *post*, p. 414.

[7] *Extend to all designs registered.*—This extends the period of copyright now subsisting in designs on the register subject to compliance with the new Rules, as to which see Rules 37—42. But it cannot revive any lapsed rights or affect any designs which have already fallen into the public domain through any provisions in the old Acts, *e.g.*, non-marking, which involved forfeiture under the Act of 1883 (sect. 51).

The repealing section under the 1883 Act (sect. 113) contained provisions in the opposite sense, and declared that the enactment of the new Act should not affect any design registered before the commencement of the Act.

Short title and commencement.

99. This Act may be cited[1] as the Patents and Designs Act, 1907, and shall, save as otherwise expressly provided, come into operation[2] on the first day of January one thousand nine hundred and eight.

[1] *Cited.*—By the Act of 1888, s. 29, the principal Act of 1883, and the Amending Acts of 1885, 1886, and 1888, were to be cited collectively as the Patents, Designs and Trade Marks Acts, 1883 to 1888.

[2] *Come into operation.*—By sect. 3 of the Act of 1883, that Act, except where otherwise expressed, commenced from and immediately after the 31st Dec. 1883.

By sect. 28 of the Act of 1888, that Act, except as thereby otherwise provided, commenced and came into operation on the 1st Jan. 1889.

There were no special provisions as to time of commencement of the Acts of 1885 and 1886, so that they commenced from the dates of those Acts, viz., the 14th Aug. 1885, and the 25th June, 1886, respectively.

SCHEDULES.

FIRST SCHEDULE.

Fees on Instruments for obtaining Patents and Renewal.

Schedule.

SECOND SCHEDULE.

ENACTMENTS REPEALED.

PART I.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	The whole Act, except sub-sections (5), (6), and (7) of section twenty-six, section twenty-nine, sub-sections (2) and (3) of section forty-seven, and section forty-eight.
48 & 49 Vict. c. 63.	The Patents, Designs, and Trade Marks (Amendment) Act, 1885.	The whole Act.
49 & 50 Vict. c. 37.	The Patents Act, 1886	The whole Act.
51 & 52 Vict. c. 50.	The Patents, Designs, and Trade Marks Act, 1888.	The whole Act.
1 Edw. VII. c. 18.	The Patents Act, 1901	The whole Act.
2 Edw. VII. c. 34.	The Patents Act, 1902	The whole Act.
7 Edw. VII. c. 28.	The Patents and Designs (Amendment) Act, 1907.	The whole Act.

PART II.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sub-sections (5), (6), and (7) of section twenty-six, and section twenty-nine.

PART III.

Session and Chapter.	Short Title.	Extent of Repeal.
46 & 47 Vict. c. 57.	The Patents, Designs, and Trade Marks Act, 1883.	Sub-sections (2) and (3) of section forty-seven and section forty-eight.

THE DESIGNS RULES, 1908.

Dated December 17, 1907.

By virtue of the provisions of the Patents and Designs Act, 1907, hereinafter referred to as "the Act," the Board of Trade do hereby make the following Rules:—

The provisions of the Act referred to are those in sect. 86, for which, and the notes thereon, see *ante*, p. 267. In *Re Rollason's Design*, 15 R. P. C. 441, the Lord Chancellor (Halsbury) said, "The Rules are practically part of the Act of Parliament."

Preliminary.

1. These Rules may be cited as the Designs Rules, 1908, and shall come into operation from and immediately after the 31st day of December, 1907.

This Rule repeats Rule 1 of 1890 with alteration of the dates. The 1890 Rules came into operation on the 31st March, 1890.

The coming into operation of the present Rules completes the repeal of all the provisions in the previous Acts relating to designs. The repealing section of the Act (sect. 98) preserved the provisions of sect. 47 (2) and (3) and sect. 48 of the Act of 1883 (see Schedule III. to the Act, *ante*, p. 288) which related to the formalities to be observed on applications for the registration of designs until new Rules were made, and the present Rules fulfil these conditions.

Interpretation.

2. In the construction of these Rules any words herein used, the meaning of which is defined by the Act, shall have the meanings thereby assigned to them respectively. Interpretation.

"Agent" means an agent resident or having a place of business in the United Kingdom or the Isle of Man, duly authorised to the satisfaction of the Comptroller.

"Office" means the Patent Office, Designs Branch, 25, Southampton Buildings, London, W.C.

"Journal" means the Illustrated Official Journal (Patents).

"Specimen" means an article of manufacture or a substance with the design applied to it.

"Lodged" means left at the Office or sent through the post by a prepaid letter addressed to the Comptroller at the Office.

The first paragraph of this Rule repeats Rule 2 and the last Rule 7 of 1890, the remainder is new.

For the definitions under the Act, see sects. 92, 93, *ante*, pp. 278—281.

As to "lodging" by sending through the post, see Rule 9, *infra*.

Fees.

Fees.

3. The fees to be paid in pursuance of the Act, so far as it relates to designs, shall be the fees specified in the First Schedule hereto.

This corresponds with the old Rule 3. For scale of fees, see *post*, pp. 318—320.

Forms.

Forms.

4. The forms herein referred to are the forms contained in the Second Schedule hereto, and such forms shall be used in all cases to which they are applicable and shall be modified as directed by the Comptroller to meet other cases.

This corresponds with the old Rule 4. For the list of Forms and corresponding fees payable on them, see *post*, p. 373. The Forms and the instructions marked on them are part of the Rules. (Per Lindley, L.J., in *Re Clarke's Design* (1896), 13 R. P. C. 351.)

Sets of Articles.

Sets of articles.

5. "Set" means a number of articles of the same general character ordinarily on sale together, or intended to be used together, all bearing the same design with or

without modifications not sufficient to alter the character or not substantially affecting the identity thereof.

Where there is any doubt whether given articles do or do not constitute a set, the doubt shall be determined by the Comptroller.

Provisions for registration of a "set" were first made by Rule 4 of 1890.

The definition of "set" is now.

Classification of Goods.

Classification of goods.

6. For the purposes of the registration of designs and of these Rules, goods are classified in the manner appearing in the Third Schedule hereto.

If any doubt arises as to the class to which any particular description of goods belongs, it shall be determined by the Comptroller.

For the full list of Classes in Schedule III., see *ante*, p. 29.

Classes 13, 14 and 15 (textile goods) have a separate registor provided for them at Manchester (see Rule 85, *post*), and are throughout this work distinguished as the "Manchester Classes."

Documents.

Size, &c. of documents.

7. Subject to any other directions that may be given by the Comptroller, all applications, notices, papers having representations affixed, and other documents required by the Act or by these Rules to be lodged shall be upon strong paper, and, except where otherwise required, on one side only, of a size of approximately 13 inches by 8 inches, and having on the left-hand part thereof a margin of approximately two inches.

This repeats substantially the old Rule 8.

Signature of documents.

8. A document lodged by a firm or partnership may be signed in the firm's name or for and on behalf of the firm or partnership by any one or more members thereof. A document lodged by a body corporate may be signed

by a director or by the secretary or other principal officer of such body corporate.

This extends the provisions of the old Rule 22.

Service of documents.

9. Any application, statement, notice or other document authorised or required to be lodged or to be left, made or given with or to any person under the Act or these Rules may be sent through the post by a prepaid or official paid letter; any document so sent shall be deemed to have been delivered at the time when the letter containing the same would be delivered in the ordinary course of post, and in proving such service or sending it shall be sufficient to prove that the letter was properly addressed and put into the post.

This repeats substantially the old Rule 11. The provision as to service by post is also contained in the Act (sect. 81, *ante*, p. 264). As to computation of time and payment of fees by persons living at a distance, see Rules 65 and 66, *infra*.

Address.

Address.

10. Where any person is by the Act or these Rules bound to furnish the Comptroller with an address, the following provisions shall apply:—

The address given shall in all cases be as full as possible, for the purpose of enabling any person easily to find the place of business of the person whose address is given.

When a person does not reside in a town with streets, the Comptroller may require the address to include all indications which he thinks necessary for such purpose as far as it can be attained.

When an applicant resides in a town where there are streets, the address given shall include the name of the street and the number in the street or name of premises, if any.

Address for service.

11. Where a registered proprietor of a design lives out of the United Kingdom or the Isle of Man, he may

furnish the Comptroller on Form Designs No. 6 with an address for service within the United Kingdom, which shall be entered in the Register.

All notices and documents, which under these Rules are required to be sent to the registered proprietor, shall be deemed duly sent if sent to him at his registered address if that address be within the United Kingdom or the Isle of Man, or where the registered proprietor lives outside the United Kingdom or the Isle of Man, to his address for service, if any, on the Register.

Where a registered proprietor lives out of the United Kingdom or the Isle of Man and has not furnished such address for service, the Comptroller need not send to him any notice which under these Rules the Comptroller is required to send.

Where an applicant lives out of the United Kingdom or the Isle of Man, he shall furnish the Comptroller with an address for service within the United Kingdom, and until he does so the Comptroller need not proceed with the examination of his application.

When such address for service is furnished, it shall, on the registration of the design, be entered in the Register as the address for service of the proprietor.

The provisions of Rules 10 and 11 are new. They apply to proprietors already on the Register as well as new proprietors, and make necessary the provision of an address for service within the United Kingdom by every registered proprietor to ensure notices being sent to them as provided by the Act.

In particular, see the provisions as to applications for cancellation of entries on the Register under sect. 58 (*ante*, p. 238), and the Rules, on the same subject, Nos. 70 to 75 (*post*, p. 310).

Notice must also be given of every change of address of a registered proprietor. (See Rule 50, *infra*.)

Agents.

Agency.

12. An application for registration and all other communications between an applicant and the Comptroller, or the Board of Trade, and between the registered proprietor of a design and the Comptroller, or the Board

of Trade, or any other person, may be made by or through an agent.

Any such applicant or proprietor may appoint an agent to represent him in the matter of the design by signing and sending to the Comptroller an authority in writing to that effect in the Form Designs No. 1, or in such other form as the Comptroller may deem sufficient. In case any registered proprietor of a design shall appoint such an agent, service upon such agent of any document relating to such design shall be deemed to be service upon the person so appointing him, and all communications directed to be made to such person in respect of such design may be addressed to such agent.

The Comptroller shall not be bound to recognise as an agent, or to receive further communications in respect of any business under the Act relating to designs from, any person whose name, by reason of his having been adjudged guilty of disgraceful professional conduct, has been erased from the register of patent agents kept under the provisions of the Act, and not since restored, or any person who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, or any company, which if it had been an individual, the Comptroller could refuse to recognise as agent, or any company or firm, if any person whom the Comptroller could refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm. In any particular case, the Comptroller may, if he think fit, require the personal signature or presence of an applicant or other person.

This Rule extends the provisions of Rule 6 of 1890 as amended by Rule 2 of 1898. (See sect. 85 and notes thereon, *ante*, p. 266.)

APPLICATION FOR REGISTRATION.

Signature of application.

13. An application for registration of a design shall be signed by the applicant for registration or by his agent.

Form of application.

14. Except as regards applications in Classes 13, 14, and 15, an application for registration of a design shall be lodged at the office, and (except as regards applications for lace designs in Class 9) shall be on Form Designs No. 2, or in the case of a set on Form Designs No. 3.

The Forms Nos. 2 and 3 correspond with Forms E. and O. respectively under the old Rules, but they omit the formerly important requirement of "statement of nature of design, such as whether it is applicable for the pattern or the shape," and only require a statement of the article to which the design is to be applied. As to this, see Rule 18, *infra*. The Comptroller has also power to require a statement of the novelty claimed to be added. (See Rule 19, *infra*.)

Lace designs.

15. An application for registration of a lace design in Class 9 shall be on Form Designs No. 4, or in the case of a set on Form Designs No. 5.

Forms Nos. 4 and 5 correspond with the old Forms E¹. and O¹. respectively under the old Rules; but the statement of "nature of design" included in the old forms, viz., the pattern, is now omitted.

Acknowledgment of application.

16. On or after receipt of an application the Comptroller shall furnish the applicant with an acknowledgment thereof.

Class.

17. An application shall state the class in which the design is to be registered, and where it is desired to register the same design in more than one class, a separate application shall be made in each class. In that case each application shall be numbered separately and shall be treated as a separate and distinct application.

This repeats substantially the provisions formerly included in the Act itself (1883), s. 47 (3).

Application of design.

18. Every application shall state the article or articles to which the design is to be applied, and where the Comptroller so requires, the applicant shall further state for what purpose the article to which the design is to be applied is used and the material or the predominating material of which the article is made.

This replaces the old Rule 9 and the provision of the Act (1883), s. 47 (3), which required the applicant, in describing the nature of the design, to state whether it was applicable "for the pattern or for the shape or configuration of the design," and the means by which it was applicable.

The discussion as to claims for "totality" (*Harper* v. *Wright and Butler* (1895), 12 R. P. C. 483, and *In re Clarke's Design* (1896), 13 R. P. C. 351), and as to what is included in a description of a design as "applicable for the pattern" (*In re Rollason's Design* (1897), 14 R. P. C. 909), are rendered obsolete by these new provisions so far as regards registrations under the Act of 1907, but they may still affect designs registered under the old Act.

Statement of novelty.

19. The applicant may, and shall if required by the Comptroller in any case so to do, indorse on the application a brief statement of the novelty he claims for his design, and where representations are furnished shall indorse each with such statement, if any.

This provision is new. As to the effect of such an endorsement, see the discussion in *Re Bayer's Design*, before Warrington, J. (1906), 23 R. P. C. at p. 558.

Representations.

20. Except as regards applications in Classes 13, 14, and 15, there shall be furnished in connection with an application for the registration of a design to be applied to a single article, three exactly similar drawings, photographs, tracings or other representations of the design, or three specimens.

This repeats (except as to the Manchester Classes) the old Rule 9.

Representations for set, and in Classes 13, 14, and 15.

21. There shall be furnished in connection with an application for the registration of a design to be applied to a set, four exactly similar drawings, photographs, tracings or other representations of the design, or four specimens: in connection with an application in any one

of the Classes 13, 14, and 15, there shall be furnished six such representations, or six specimens.

This Rule is now, both as to the Manchester Classes and the requirement of an extra copy in the case of a "set." As to applications for goods in the Manchester Classes, see Rules 80 to 88, *infra*.

Nature of representations.

22. Each representation of the design, or set of designs, must be upon paper of the prescribed size and not on cardboard, and must appear on one side only of the paper The figure or figures must be placed in an upright position on the sheet. When more figures than one are shown, these should where possible be on one and the same sheet, and each should be designated on the sheet (*e.g.*, front view, side view).

The provisions of this and the following Rules, Nos. 23 to 27, were formerly not included in Rules, but were covered by the "Instructions to persons who wish to register" issued by the Comptroller.

Drawings, &c. must be in ink.

23. When drawings or tracings are furnished, they must be in ink, and if on tracing cloth or tracing paper must be mounted on paper of the prescribed size.

Representations for set.

24. When the design is to be applied to a set, each of the representations accompanying the application should show all the various arrangements in which it is proposed to apply the design to the articles included in the set.

Special representations.

25. When the specimens are not, in the Comptroller's opinion, of a kind which can be conveniently pasted into books, representations shall be furnished for insertion in the Register and for official purposes.

Words, &c. on designs.

26. Where words, letters or numerals are not of the essence of the design, they shall be removed from the representations or specimens.

Repeat of pattern.

27. Each representation of a design which consists of a repeating surface pattern must show the complete pattern and a sufficient portion of the repeat in length and width, and ought not to be of less size than 7 inches by 5 inches.

Specimens of designs.

28. Where representations are supplied, the Comptroller shall also be supplied, if in any case he so requires, with a specimen.

Additional representations or specimens.

29. The Comptroller shall be furnished with more representations or more specimens of any design if he requires them.

Representations of living persons or persons recently dead.

30. Where the names or representations of living persons appear on a design, the Comptroller shall, if he so require, be furnished with consents from such persons before proceeding to register the design. In the case of persons recently dead the Comptroller may call for consents from their legal representatives before proceeding with registration of a design on which their names or representations appear.

This provision is new. The requirements are optional on the part of the Comptroller.

Procedure on Receipt of Application.

Acceptance.

31. Upon receipt of an application for registration, the Comptroller shall consider it, and if he thinks there is no objection to the design being registered, he may accept it.

Objections.

32. If after consideration of the application any objections appear, a statement of these objections shall be sent to the applicant in writing, and unless within one month the applicant applies for a hearing, he shall be deemed to have withdrawn his application.

This extends the provisions of the old Rules 12 and 13. The Comptroller has power to enlarge the times under Rule 64, *infra*.

Decision of Comptroller.

33. The decision of the Comptroller at such hearing as aforesaid shall be communicated to the applicant in writing, and if he objects to such decision, he may within one month, should he consider it necessary for the purpose of appeal, apply upon Form Designs No. 7

requiring the Comptroller to state in writing the grounds of his decision and the materials used by him in arriving at the same.

This extends the provisions of the old Rule 14. The power to call on the Comptroller to state the grounds of his refusal is now. For the Form No. 7, see *post*, p. 377.

Date for appeal.

34. Upon receipt of such form the Comptroller shall send to the applicant such statement as aforesaid in writing, and the date when such statement is sent shall be deemed to be the date of the Comptroller's decision for the purpose of appeal; but if the applicant does not apply for the grounds of the Comptroller's decision, appeal shall be lodged within one month from the date of the decision.

The latter part of this Rule corresponds with the old Rule 15. As to the proceedings to be taken on appeal, see Rules 89 to 93, *infra*. As to obtaining an extension of time for appealing, see Rule 94.

Non-Completion.

Non-completion within 12 months.

35. Where an application for registration of a design is not completed within twelve months from the date of the application by reason of default on the part of the applicant, the Comptroller shall give notice to the applicant in writing of such non-completion, and if the applicant has an agent, shall send a duplicate of such notice to such agent. If after fourteen days from the date when such notice was sent, the application is not completed, the application shall be deemed to be abandoned, but the Comptroller may with such notice, where the applicant lives at such distance from the Office that he cannot reasonably be expected to do what is necessary within such fourteen days, give a further time after such fourteen days for the completion of such application.

The provisions of this Rule are new. See sect. 49 (4) and the notes thereon, *ante*, p. 218. The Comptroller has power to enlarge the time under Rule 64, *infra*.

Death of Applicant.

Death of appliant before registration.

36. In case of the death of any applicant for the registration of a design after the date of his application, and before the design applied for has been entered in the Register, the Comptroller may, on being satisfied of the applicant's death, enter in the Register, in place of the name of such deceased applicant, the name, address and description of the person owning the design, on such ownership being proved to the satisfaction of the Comptroller.

This Rule is new. As to the person "owning" the design, see sect. 93, definition of "proprietor," and notes thereon, *ante*, p. 277.

Extension of Period of Copyright.

Extension of period of copyright.

37. At any time after the registration of a design, the period of copyright therein may be extended for a second period of five years if Form Designs No. 8 be lodged; but no period of copyright shall be extended unless an application for extension be lodged at least one week before the expiration of the original period of five years. Where a proprietor has more than one design copyright in which ceases at the same date, he may, in place of using a separate Form Designs No. 8 for each design, include all the designs in one form, stamped with the total amount of the prescribed fees for such designs and so modified as to meet the circumstances of the case. Form Designs No. 8 shall be indorsed with the name and address of the person lodging the same.

The wording of sect. 53 (2), to which this Rule has reference, confers an absolute right to the extension (see *ante*, p. 229). And this applies to existing copyrights in designs registered under the old Act. See sect. 98 (2) and the notes thereon, *ante*, p. 287. For the Form No. 8 required to be lodged, see *post*, p. 378.

Notice of extension.

38. On receipt of Form Designs No. 8 an entry of the extension of the period of copyright shall be made in

the Registor, and the Comptroller shall send to the registered proprietor at his registered address or his address for service, a notice that the period of copyright has been extended for a further period of five years.

As to the meaning of "registered proprietor," see sect. 93 and notes thereon, *ante*, p. 277. As there may be various persons with varying interests registered as "proprietors" of the same design, the operation of the Act (sect. 53 (2)) and these Rules would seem to extend the copyright for the benefit of all on the lodgment of Form No. 8 by any of the persons whose names appear on the Registor.

Second extension.

39. At any time not less than six months and not more than twelve months before the expiration of the second period of five years mentioned in sub-section 3 of section 53 of the Act, application may be made to the Comptroller for a further extension of the period of copyright by lodging Form Designs No. 9.

This second extension is apparently optional, at the discretion of the Comptroller. (See sect. 53 (3) and notes thereon, *ante*, p. 229.) No grounds are stated on which the discretion is to be exercised; but as to the exercise of discretionary powers by the Comptroller generally, see sect. 73 and notes thereon, *ante*, p 261, and Rules 53 to 58, *infra*. For the Form No. 9, see *post*, p. 378.

Payment of extension fee.

40. If the Comptroller grants the application he shall send notice to the registered proprietor, who shall, at least one week before the expiration of the second period of five years, pay the prescribed fee by lodging Form Designs No. 10.

As to the persons affected by this notice, see note to Rule 38, *ante*.

Notice of second extension.

41. Form Designs No. 10 shall be indorsed with the name and address of the person lodging the same, and on receipt thereof an entry of the further extension of the period of copyright shall be made in the Register, and a notice of such extension, as prescribed by Rule 38, shall be sent.

Advertisement of extension.

42. Upon an extension of the period of copyright, the extension shall be advertised in the Journal.

Assignment, &c.

Joint request for entry of assignment, &c.

43. Where a person becomes entitled as assignee, mortgagee, licensee, or otherwise to any interest in the copyright of a design, he may, conjointly with the registered proprietor, apply on Form Designs No. 11 to have an entry of the fact made in the Register, and on receipt of such form the Comptroller may make a note in the Register of such interest.

The provisions of this Rule are new, and appear to contemplate the entry of proprietorship or other interest on the Register without further evidence, wherever the registered proprietor (as to whom, see sect. 93 and notes thereon, *ante*, p. 277) joins in the application.

For the Form No. 11, see *post*, p. 379. There is a special Form (No. 12, *post*, p. 380) for designs in Class 9 (lace), which requires only the statement that the design has been sold to and acquired by the proposed assignee, and this clearly suggests that no further evidence is necessary in such cases. (See sect. 71 and notes thereon, *ante*, p. 256.)

Application for entry of assignment by subsequent proprietor.

44. Where no such joint application is made, any person who has become entitled to an interest in the copyright of a design by assignment, mortgage, license, or otherwise, may apply for the entry of his name in the Register as proprietor of such interest in such copyright. The application shall be on Form Designs No. 13, and such application shall contain the name, address, and description of the person claiming to be entitled (hereinafter called the claimant).

This corresponds with the old Rules 21 and 22. For the Form No. 13, see *post*, p. 380. A person is entitled to be entered and to sue as proprietor, though he may only have acquired the interest of one of several co-owners: *Lauri* v. *Renad*, [1892] 3 Ch. 402.

Case accompanying application.

45. Together with such application the claimant shall leave a case stating full particulars of the assignment, mortgage, license, instrument, or other mode of transfer by virtue of which he claims to be entitled to be entered in the Register, so as to show the manner in which, and

the person or persons through whom, such interest has been acquired.

This corresponds with the old Rule 23, but the requirement of a separate case setting out full particulars of the title is new.

Statutory declaration in support of such request.

46. Where the Comptroller shall determine that the case sets out particulars such as entitle the claimant to be entered in the Register, he may call upon the claimant to furnish a statutory declaration on Form Designs No. 14, verifying the several statements in the case and declaring that the particulars given comprise every material fact and document affecting the matter.

Under the old Rule 24, every request for entry of assignment, &c. had to be accompanied by a statutory declaration, but in future this will only be required where the Comptroller asks for it. For the Form No. 14, see *post*, p. 381. As to the form and manner in which statutory declarations are to be taken and made, see Rules 77 and 78, *infra*.

Proof of title.

47. In any case, the Comptroller may call on any person who desires his name to be entered in the Register for such proof or additional proof of title as the Comptroller may require for his satisfaction.

Entry in the Register.

48. When the Comptroller is satisfied that the claimant is entitled to the entry of his name, he shall make a note in the Register of such interest.

As to the power to dispense with or accept less than legal evidence in any particular case, see Rule 62, *infra*.

Removal of name.

49. Where the name of a person is entered on the register as mortgagee or licensee, such person may on lodging Form Designs No. 15 have a note entered in the Register that he no longer claims to be mortgagee or licensee, as the case may be.

This provision is new. See sect. 71 (2) and notes thereon, *ante*, p. 256. For the Form No. 15, see *post*, p. 381.

Alteration of Address.

Alteration of address in Register.

50. Every registered proprietor of a design who alters his address or his address for service, shall forthwith apply to the Comptroller on Form Designs No. 16, and the Comptroller shall alter the Register accordingly.

For the provisions as to entry of address, or address for service in the case of proprietors resident abroad, see Rules 10 and 11, *supra*. For the Form No. 16, see *post*, p. 382.

Correction of Clerical Errors.

Correction by applicant.

51. Where an applicant desires to correct a clerical error in his application, he shall lodge a Form Designs No. 17.

The power to correct clerical errors in the application was formerly contained in the Act itself (sect. 91 of 1883). The present Rule is under the general powers conferred on the Board of Trade by sect. 86 (1) (a) (see *ante*, p. 267). Clerical errors in the representation of a design are specially provided for by sect. 70 (c), *ante*, p. 255. See also the general power of amendment given by Rule 63, *infra*.

Correction by proprietor.

52. Where the registered proprietor of a design desires to correct a clerical error under section 70 of the Act, he shall lodge a Form Designs No. 17.

This applies to clerical errors generally. For the Form No. 17, see *post*, p. 382.

Cancellations.

Cancellation of design.

53. Where the registered proprietor of a design desires to cancel his registration either wholly or in respect of any particular goods in connexion with which the design is registered, he shall lodge a Form Designs No. 18.

Cancellation by trustee in bankruptcy, &c.

54. Cancellation may also be effected by the trustee in bankruptcy of the registered proprietor, or where the registered proprietor is a company in liquidation by the liquidator, or in any other case where the request is made by a person whom the Comptroller may decide to be entitled to act in the name of the registered proprietor.

In such cases Form Designs No. 18 shall be lodged, modified as the Comptroller directs.

These are new provisions. (See sect. 70 (b) and notes thereon, *ante*, p. 255. For the Form No. 18, see *post*, p. 383.)

Discretionary Power.

Hearing.

55. Before exercising any discretionary power given to the Comptroller by the Act adversely to any person, the Comptroller shall, if so required, hear the person who will be affected by the exercise of such power.

Application for hearing.

56. An application for a hearing shall be made within one month from the date when the matter on which the Comptroller is called on to exercise discretionary power has arisen.

This and the preceding Rule correspond with the old Rule 12. (See sect. 73 and notes thereon, *ante*, p. 261.)

Notice of hearing.

57. Upon receiving such application, the Comptroller shall give the person applying ten days' notice of a time when he may be heard by himself or his agent.

Within five days from the date when such notice would be delivered in the ordinary course of post, the person applying shall notify the Comptroller whether or not he intends to be heard on the matter.

This corresponds with the old Rule 13.

Notification of decision.

58. The decision of the Comptroller in the exercise of any such discretionary power, as aforesaid, shall be notified to the person affected.

The Comptroller may, in any case of doubt or difficulty, apply to a law officer for directions in the matter; but he is not compelled to exercise this power. (See sect. 74 and notes thereon, *ante*, p. 261.)

Searches.

Search under sect. 57.

59. Where any person desires to obtain the information which he is entitled to obtain under section 57 of

the Act, and can furnish the registration number of the design, he shall lodge Form Designs No. 19, and the Comptroller will thereafter furnish him with the information aforesaid.

Where the applicant is unable to furnish the registration number of the design, he shall lodge Form Designs No. 20 together with such information as he is in possession of, and the Comptroller will thereupon make such search in the class indicated as may be possible on the information supplied, and will furnish such information as can be afforded. Where Form Designs No. 20 is accompanied by a representation or specimen of the design, such representation or specimen shall be furnished in duplicate.

This refers to information required as to the existence of registration of a design. (See sect. 57 and the notes thereon, *ante*, p. 237. For the Forms Nos. 19 and 20, see *post*, pp. 383, 384.)

Search among registered designs.

60. The Comptroller may, if Form Designs No. 21 be lodged, cause a search to be made among the registered designs and state whether, in his opinion, any design accompanying such form and to be applied to goods in any particular class is or is not identical with or an obvious imitation of any registered design applied to such goods of which the copyright is still existing. The design accompanying Form Designs No. 21 shall be furnished in duplicate.

This corresponds with the old Rule 35. The information given by the Comptroller is not a certificate within the meaning of sect. 78 (*ante*, p. 263) or Rule 67, *infra*, and is not evidence: *Smith* v. *Hope* (1889), 6 R. P. C. 204.

Hours of Inspection.

Hours of inspection.

61. The Office shall be open to the public every week day, except Saturday, between the hours of ten and four, and on Saturday between the hours of ten and one, except on the days following:—

Christmas Day, Good Friday, the day observed as His

Majesty's Birthday, the days observed as days of public fast or thanksgiving, or as holidays at the Bank of England, and days which may from time to time be notified by a placard posted in a conspicuous place at the Office.

The Bank holidays are Easter Monday, Whit Monday, the first Monday in August, and the 26th December, if a week-day, or the next day when the 26th falls on a Sunday.

Power to Dispense with Evidence.

Dispensing with evidence.

62. Where under these Rules any person is required to do any act or thing, or to sign any document, or to make any declaration on behalf of himself or any body corporate, or any document or evidence is required to be produced to or left with the Comptroller, or at the Office, and it is shown to the satisfaction of the Comptroller that from any reasonable cause such person is unable to do such act or thing, or to sign such document, or make such declaration, or that such document or evidence cannot be produced or left as aforesaid, it shall be lawful for the Comptroller, and upon the production of such other evidence and subject to such terms as he may think fit, to dispense with any such act or thing, document, declaration, or evidence

This corresponds with the old Rule 29. The Act itself provides for cases of infancy or other disability. (See sect. 83, *ante*, p. 266.)

Amendments.

Amendment of documents.

63. Any document or drawing or other representation of a design may be amended, and any irregularity in procedure, which in the opinion of the Comptroller may be obviated without detriment to the interests of any person, may be corrected, if the Comptroller think fit, and on such terms as he may direct.

This repeats the old Rule 30. The Act contains provisions for certain specific cases of error. (See sect. 70 (b) and (c), *ante*, p. 255, and Rules 51 and 52, *supra*.)

Enlargement of Time.

Enlargement of time.

64. The time prescribed by these Rules for doing any act, or taking any proceeding thereunder, may be enlarged by the Comptroller if he think fit, and upon such notice to other parties, and proceedings thereon, and upon such terms, as he may direct, and such enlargement may be granted though the time has expired for doing such act or taking such proceeding.

This extends the provisions of the old Rule 31. For extension of time for appealing to the Board of Trade, see the special provision in Rule 94, *infra*.

Excluded days.

65. Whenever the last day fixed by the Act or by these Rules for doing any thing shall fall on a day when the Office is not open, or on a Saturday, which days shall be excluded days for the purposes of the Act and these Rules, it shall be lawful to do any such act or thing on the day next following such excluded day, or days if two or more of them occur consecutively.

This provision was formerly included in the Act itself (sect. 98 of 1883). As to the days on which the Office is not open, see Rule 61, *supra*. As to the computation of time where a lodgment of documents or service is made by post, see Rule 9, *supra*. (See also sects. 81 and 82, and the notes thereon, *ante*, p. 265.)

Fees paid late by persons living at distances from Office.

66. Where a time for paying a fee is limited by these Rules, and the person who is bound to pay such fee resides at such distance from the Office that he cannot reasonably be expected to pay the fee on the date limited by the Rule, the Comptroller, if satisfied that the omission to pay the fee has not been from any want of diligence on the part of the person whose business it is to pay it, may accept the fee even though the date for paying the fee has passed, and treat it as if received on the correct date, provided always that the fee is actually paid with such promptitude as can be expected in the circumstances.

CERTIFICATE BY COMPTROLLER.

Certificate for use in legal proceedings or other purpose.

67. Where a certificate is required for the purpose of any legal proceeding, or other special purpose, as to any entry, matter, or thing which the Comptroller is authorised by the Act or these Rules to make or do, the Comptroller may, on the lodging of a Form Designs No. 22, give such certificate, which shall also specify on the face of it the purpose for which it has been issued as aforesaid.

This repeats the old Rule 34. The certificate is *prima facie* evidence of the facts stated therein (sect. 78, *ante*, p. 263). For Form No. 22, see *post*, p. 385.

MARKING OF ARTICLES.

Registration mark.

68. Before delivery on sale of any article to which a registered design has been applied, the proprietor of such design shall cause each such article to be marked with the word REGISTERED or with the abbreviation REGD or with the abbreviation RD, as he may choose, and also (except in the case of articles to which have been applied designs registered in Classes 9, 13, 14, and 15) with the number appearing on the certificate of registration.

This corresponds with the old Rule 39. The excepted classes are lace and textile goods. The Rule laid down in *Heinrich* v. *Basterndorff*, 10 R. P. C. 160, as to articles required to be marked R[d]. being sufficiently marked if Reg[d]. was used is now extended to all cases. An error in the number will not necessarily invalidate the marking: *Re Rollason's Design* (1897), 14 R. P. C. 893; see sect. 54 (b) and notes thereon, *ante*, p. 231. It is an offence to use the registration mark after the copyright has expired. (See sect. 89 (4), *ante*, p. 270.)

REGISTER OF DESIGNS AND INSPECTION OF REGISTERED DESIGNS.

Registering design.

69. When a design is accepted, there shall be entered in the Register a representation or specimen of the design, the calling or description of the proprietor, the

date of the application, and such other particulars as the Comptroller may deem necessary.

Inspection of registered designs.

The period under section 56 of the Act during which a design shall not be open to inspection, except as provided in that section, shall be, as regards designs in Classes 13, 14, and 15, five years, and, as regards designs in other classes, two years from the date of the original registration thereof.

Cancellation of Designs used for Manufacture outside the United Kingdom.

Cancellation of designs used for manufacture outside the United Kingdom.

70. An application for the cancellation of the registration of a design under section 58 of the Act shall be made on Form Designs No. 23, which shall, if so required by the Comptroller, contain an address for service in the United Kingdom. The applicant shall simultaneously with, or as soon as may be after, the leaving of such application at the Office deliver, or cause to be delivered, to the registered proprietor of the design (hereinafter called the proprietor) or his agent a copy of such application, and furnish the Comptroller with evidence of such delivery.

Procedure.

71. The proprietor shall within fourteen days from the delivery of such copy, or within such further time as the Comptroller may allow, leave at the Office evidence, by way of statutory declaration, stating whether or not the allegations contained in the application are correct; and, if they are incorrect, to what extent, and in what place the design is used for manufacture in the United Kingdom; and setting out in the event of the design not being used for manufacture in the United Kingdom to an adequate extent the reasons why it is not so used for manufacture.

Copies of evidence.

72. The proprietor shall deliver, or cause to be

delivered, copies of such evidence to the applicant, and furnish the Comptroller with evidence of such delivery.

Evidence in answer.

73. Within fourteen days from the delivery of such copies, or within such further time as the Comptroller may allow, the applicant shall, if he decides to proceed with his application, leave at the Office statutory declarations in answer, and on so leaving shall deliver to the proprietor or his agent copies thereof, and furnish the Comptroller with evidence of such delivery.

Closing of evidence.

74. No further evidence shall be left at the Office on either side except by leave, or on the requisition of the Comptroller, and upon such terms, if any, as the Comptroller may think fit.

Hearing.

75. On completion of the evidence, or at such other time as he may see fit, the Comptroller shall appoint a time for the hearing of the case, and give the parties ten days' notice at least of such appointment, and in the event of his deciding to take evidence *viva voce* in lieu of, or in addition to, the evidence by declaration, or to allow any declarant to be cross-examined on his declaration, he may require the attendance of any declarant or other person whose evidence he may consider desirable.

The whole of these provisions are new. See sect. 58 and notes thereon, *ante*, p. 238 *et seq*. Any person may apparently make the application, and, without making out any sort of case against a registered proprietor, compel him to give substantive evidence in support of his registration. The only check is the 1*l*. fee payable on the application, and the liability to costs which is reserved by the section. (See Form 23, *post*, p. 385, and Schedule of Fees, No. 20, *post*, p. 319.)

The Rule applies to all designs now on the Register as well as to any which may be registered under the new Act. See sect. 98 (2) and notes thereon, *ante*, pp. 285, 286.

There is no appeal from the decision of the Comptroller on any such applications. As to the powers of the Comptroller on taking evidence, see sect. 77 and notes thereon, *ante*, p. 262. For the provisions as to the statutory declarations to be used in these cases, see Rules 77 to 79, *infra*.

Industrial and International Exhibitions.

Notice of exhibition.

70. Any person desirous of exhibiting a design or any article to which a design has been applied, at an industrial or international exhibition, which has been duly certified as such by the Board of Trade, or of publishing a description of a design during the period of the holding of such an exhibition, shall give the Comptroller notice, on Form Designs No. 24, of his intention to exhibit the design or article or to publish a description of the design, as the case may be. For the purpose of identifying the design in the event of an application to register the same being subsequently made, the person lodging Form Designs No. 24 shall supply a brief description of the nature thereof, accompanied by a sketch, drawing, or specimen, and shall supply such other information as the Comptroller may in each case require.

This repeats the old Rule 36. The Rule applies to all exhibitions at home or abroad which have been certified as such by the Board of Trade. (See sect. 59 and notes thereon, *ante*, p. 242. For the Form No. 24, see *post*, p. 386.)

Statutory Declarations.

Form, etc. of statutory declaration.

77. The statutory declarations required by these Rules, or used in any proceedings thereunder, shall be headed in the matter or matters to which they relate, and shall be drawn up in the first person, and shall be divided into paragraphs consecutively numbered, and each paragraph shall, so far as possible, be confined to one subject. Every statutory declaration shall state the description and true place of abode of the person making the same, and shall bear the name and address of the person leaving it, and shall state on whose behalf it is left.

Manner in which, and person before whom, declaration is to be taken.

78. Statutory declarations shall be made and subscribed as follows:—

(a) In the United Kingdom, before any justice of the peace, or any commissioner or other officer

authorised by law in any part of the United Kingdom to administer an oath for the purpose of any legal proceeding;

(b) In any other part of His Majesty's dominions, before any Court, judge, justice of the peace, or any officer authorised by law to administer an oath there for the purpose of a legal proceeding; and

(c) If made out of His Majesty's dominions before a British Minister, or person exercising the functions of a British Minister, or a consul, vice-consul, or other person exercising the functions of a British consul, or a notary public, or before a judge or magistrate.

Notice of seal of officer taking declaration to prove itself.

79. Any document purporting to have affixed, impressed, or subscribed thereto or thereon the seal or signature of any person hereby authorised to take such declaration in testimony of such declaration having been made and subscribed before him, may be admitted by the Comptroller without proof of the genuineness of any such seal or signature, or of the official character of such person or his authority to take such declaration.

Statutory declarations may, in the case of an appeal, be used in lieu of evidence by affidavit, and if so used they have all the incidents and consequences of evidence by affidavit. Any declarant may be cross-examined (by leave of the Comptroller) on his declaration. (See sect. 77 (1) and notes thereon, *ante*, p. 262.)

Designs in Classes 13, 14, and 15.

Application at Manchester.

80. All applications for registration of designs in Classes 13, 14, and 15 shall be lodged at the Office or left at or sent to the Manchester Branch Office, at the option of the applicant.

Manchester Office.

81. Until the Board of Trade shall otherwise direct, the Manchester Branch Office (hereinafter called the Manchester Office) shall be the Manchester Branch of

the Trade Marks Registry of the Patent Office, 48, Royal Exchange, Manchester, and applications for registration of designs in Classes 13, 14 and 15 and all communications intended to be made at or sent to the Manchester Office shall be addressed to the Keeper of Cotton Marks (hereinafter called the Keeper), at 48, Royal Exchange, Manchester.

Applications in duplicate.

82. All applications for registration of designs in Classes 13, 14 and 15 shall be in duplicate, and if the application be lodged at the Office, one copy shall forthwith be sent by the Comptroller to the Keeper; if the application be addressed to the Keeper, he shall forthwith send one copy to the Comptroller. One of the Forms of application shall be stamped and the other unstamped.

Form of application for checks or stripes.

83. Applications in Class 15 for registration of designs consisting substantially of checks or stripes only, shall be made on Form Designs (Manchester) No. 2. If any doubt arises as to whether a design presented for registration on Form Designs (Manchester) No. 2 is a design consisting substantially of checks or stripes only, that doubt shall be determined by the Comptroller.

Form of application for designs other than checks or stripes.

84. Applications in Classes 13 and 14 for registration of designs shall be made on Form Designs (Manchester) No. 1.

Manchester Register.

85. There shall be kept at the Manchester Office a Register, to be called the Manchester Register, wherein the entries made shall be duplicates of the entries in the Register at the Office relating to designs registered in Classes 13 and 14 in the Third Schedule to the Designs Rules, 1906, of which the copyright shall be existing on the 1st January, 1908, and of those which shall be made on that date and thereafter relating to designs registered in Classes 13, 14 and 15.

Alteration of Register.

86. When any alteration or addition is made at the

Office of or to an entry in the Register relating to a design included in those mentioned in Rule 85, the Comptroller shall forthwith give notice thereof to the Keeper, who shall alter the Manchester Register accordingly.

Notice of dispute.

87. Where a dispute arises with reference to a design entered in the Manchester Register, the parties thereto may give notice (in duplicate) to the Keeper on the Form Designs (Manchester) No. 3, and he shall make a note in the Manchester Register of such request and shall send a copy of the note to the Comptroller together with one copy of the notice. One copy of the Form Designs (Manchester) No. 3 shall be stamped and the other unstamped.

Procedure at Manchester.

88. All documents under these Rules shall, when they relate to designs in Classes 13, 14 and 15, be in duplicate, and may be lodged at the Office or left at or sent to the Manchester Office, at the option of the applicant or other person lodging or leaving or sending the same. All documents which the Comptroller is directed to send may be sent from the Manchester Office by the Keeper when they relate to designs in Classes 13, 14 and 15. When any document bears a fee stamp, the duplicate may be unstamped.

The whole of these provisions are new, and arise under sect. 62 (4), as to which see *ante*, p. 252. The powers and authorities of the Comptroller over all registrations are not affected by these provisions. As to the keeping of the Register and the inspection of deposited designs and entries, see sects. 52 and 67, *ante*, p. 227 and p. 254 respectively. For the Forms (Manchester Nos. 1, 2 and 3), see *post*, pp. 386—388. The special Form Manchester No. 3, referred to in Rule 87, relates to disputes which are referred to the Manchester Chamber of Commerce, and as to which all legal proceedings are excluded by consent of the parties, without power of appeal.

Appeals to the Board of Trade.

Appeal to Board of Trade.

89. When any person intends to appeal to the Board of Trade he shall, before doing so, apply to the Comp-

troller for a hearing, and may, if he considers it necessary, obtain the grounds of the Comptroller's decision. Within one month from the date of such decision, or from the date of the issue of the grounds thereof, if such have been issued, he shall, if he is advised to appeal to the Board of Trade, lodge a notice of such his intention on Form Designs No. 25, accompanied by a copy of the form of application and six representations of the design applied for and a copy of the grounds of the Comptroller's decision, if any grounds have been issued.

The provisions as to obtaining a statement of the grounds of the Comptroller's decision are new, and are contained in Rules 33 and 34, *supra*. The rest of the Rule corresponds with the old Rule 15. For the Form No. 25, see *post*, p. 388.

There is no appeal from the decision of the Board of Trade: *In re Clarke's Design*, 13 R. P. C. at p. 357. As to proceedings before the Board, see sect. 87 and notes thereon, *ante*, p. 269.

Grounds of appeal to be stated.

90. Such notice shall also be accompanied by a statement in writing of the grounds of appeal, and of the appellant's case in support thereof.

This and the following three Rules repeat the old Rules 16 to 19. See sect. 87, *ante*, p. 269.

Transmission of notice.

91. A copy of the notice and all the accompanying documents shall also be forthwith sent by the appellant to the Secretary of the Board of Trade, No. 7, Whitehall Gardens, London.

Directions by Board.

92. The Board of Trade may thereupon give such directions (if any) as they may think fit with respect to parties and evidence, or otherwise, for the purpose of the hearing of the appeal by the Board of Trade.

Hearing of appeal.

93. Seven days' notice, or such shorter notice as the Board of Trade may in any particular case direct, of the time and place appointed for the hearing shall be given by the Board of Trade to the Comptroller and to the appellant.

94. No appeal shall be entertained of which notice has not been given within one month from the date of the decision appealed against, or such further time as the Comptroller may allow, except by special leave of the Board of Trade. No appeal unless notice duly given.

This provision is new. As to the computation of time and powers of the Comptroller to enlarge time generally, see Rules 64 and 65, *supra*.

Applications to and Orders of the Court.

95. Four clear days' notice of every application to the Court under section 72 of the Act for rectification of the Register of Designs shall be given to the Comptroller. Notice to Comptroller of application to rectify Register.

See sect. 72 and the notes thereon, *ante*, p. 258.

96. Where an Order has been made by the Court in any case under the Act, the person in whose favour such Order has been made, or such one of them, if more than one, as the Comptroller may direct, shall forthwith serve on the Comptroller an office copy of such Order, together with Form Designs No. 26, if required. The Register may, if necessary, thereupon be rectified or altered by the Comptroller. Order of Court.

For the special provisions in the case of goods in the Manchester Classes, see Rules 85 to 88, *supra*.
For the Form No. 26, see *post*, p. 389.

97. Whenever an Order is made by the Court under the Act, the Comptroller may, if he thinks that the effect of such Order should be made public, advertise a notice thereof in the Journal. Publication of Order of Court.

Repeal.

98. All general rules relative to designs heretofore made by the Board of Trade under the Patents, Designs, and Trade Marks Acts, 1883 to 1902, and in force on the Repeal.

31st day of December, 1907, shall be and they are hereby repealed as from that date, without prejudice, nevertheless, to anything done under such Rules, or to any application or other matter then pending.

This corresponds with the old Rule 37, which repealed all previous General Rules.

Dated this 17th day of December, 1907.

D. LLOYD GEORGE,
President of the Board of Trade.

SCHEDULES.

FIRST SCHEDULE.

FEES.

The following fees shall be paid under the Act, so far as it relates to designs. Such fees must in all cases be paid before or at the time of the doing of the matter in respect of which they are to be paid :—

Subject or Proceeding.	Amount.			Corresponding Form.
	£	s.	d.	
1. On application to register one design to be applied to a single article in a class, not being lace, and except articles in Classes 13 to 15	0	5	0	Designs No. 2
2. On application to register one design to be applied to a set of articles in a class, not being lace.....	0	10	0	Designs No. 3
3. On application to register one design to be applied to lace or to register one design in Class 15	0	1	0	Designs No. 4, or Designs (Manchester) No. 2.
4. On application to register one design to be applied to a set of lace articles.....	0	2	0	Designs No. 5
5. On application to register one design in Class 13 or Class 14	0	2	6	Designs (Manchester) No. 1.

FIRST SCHEDULE—*continued.*

Subject or Proceeding.	Amount.	Corresponding Form.
	£ s. d.	
6. On application to Comptroller to state grounds of decision and materials used under Rule 33	0 5 0	Designs No. 7
7. On extension of period of copyright under section 53 (2)	1 0 0	Designs No. 8
8. On application for extension of period of copyright under section 53 (3)	0 10 0	Designs No. 9
9. On extension of period of copyright under section 53 (3)	1 10 0	Designs No. 10
10. On joint application to enter name of subsequent proprietor, &c.	Same as registration fee.	Designs No. 11 or 12.
11. On application to enter name of subsequent proprietor, &c., under Rule 44, for each design	0 10 0	Designs No. 13
12. On application of mortgagee, licensee, or other person having registered interest, for removal of his name	0 1 0	Designs No. 15
13. On application for entry of address for service or of new address	0 1 0	Designs No. 6 or 16.
14. On application to correct clerical error	0 1 0	Designs No. 17
15. On application by proprietor or his representative for cancellation	0 1 0	Designs No. 18
16. On application for search under section 57 when registration number is supplied	0 1 0	Designs No. 19
17. On application for search under section 57 when registration number is not supplied	0 2 6	Designs No. 20
18. On application for search under Rule 60	0 2 6	Designs No. 21
19. On application for Certificate of Comptroller for legal proceedings or other special purpose	0 5 0	Designs No. 22
20. On application for cancellation under section 58	1 0 0	Designs No. 23
21. On notice to Comptroller of intended exhibition of an unregistered design	0 5 0	Designs No. 24
22. On notice to Keeper under Rule 87	0 2 6	Designs (Manchester) No. 3.
23. On appeal from Comptroller to Board of Trade, in respect of each decision appealed against	0 5 0	Designs No. 25
24. For each entry in the Register of an alteration in pursuance of an Order of Court	0 5 0	Designs No. 26
25. Copy of Certificate of Registration, each copy	0 1 0	Designs No. 27
26. Inspection of Register or design where inspection is permitted, except inspection under the second paragraph of *section 56 (1) of the Act, for each quarter* of an hour	0 1 0	—

FIRST SCHEDULE—*continued.*

Subject or Proceeding.	Amount.	Corresponding Form.
27. Office copy of design.....	£ s. d. cost according to agreement.	—
28. For Office copy of documents, every 100 words	0 0 4 (but never less than 1s.)	—
29. For certifying Office copies, MSS. or printed	0 1 0	—

The fees to be paid on any proceeding at the Manchester Office shall be the same as for the similar proceeding at the London Office.

Dated this 17th day of December, 1907.

D. LLOYD GEORGE,
President of the Board of Trade.

Approved,

JOSEPH A. PEASE,
J. H. WHITLEY,
Lords Commissioners of His Majesty's Treasury.

SECOND SCHEDULE.

FORMS.

(*See list of these Forms with corresponding fees, post, p.* 373.)

THE INTERNATIONAL CONVENTION

FOR THE PROTECTION OF

INDUSTRIAL PROPERTY (*a*).

Signed at Paris, March 20, 1883.

With the Amendments introduced by THE BRUSSELS ACT of Dec. 14, 1900.

[*Came into operation September* 14, 1902.]

[The amendments introduced by the Brussels Act of 1900 are inserted in italics; clauses in the original Convention which are now omitted under that Act being marked by square brackets.]

INTERNATIONAL CONVENTION (*b*).

His Majesty the King of the Belgians, His Majesty the Emperor of Brazil, His Majesty the King of Spain, the President of the French Republic, the President of the Republic of Guatemala, His Majesty the King of Italy, His Majesty the King of the Netherlands, His Majesty the King of Portugal and the Algarves, the President of the Republic of Salvador, His Majesty the King of Servia, and the Federal Council of the Swiss Confederation.

Being equally animated with the desire to secure, by mutual agreement, complete and effectual protection for the industry and commerce of their respective subjects and citizens, and to provide a guarantee for the rights of inventors, and for the loyalty of commercial transactions, have resolved to conclude a Convention to that effect, and have named as their plenipotentiaries, that is to say [*here follow the names of the Plenipotentiaries*]:— Recital of objects of Convention.

Who, having communicated to each other their respective full powers, found in good and due form, have agreed upon the following Articles:— Articles agreed upon.

ARTICLE I.

The Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland, constitute themselves into a Union for the Protection of Industrial Property. Union for protection of industrial property.

Les Gouvernements de la Belgique, du Brésil, de l'Espagne, de la France, du Guatemala, de l'Italie, des Pays-Bas, du Portugal, du Salvador, de la Serbie et de la Suisse sont constitués à l'état d'Union pour la protection de la *Propriété Industrielle*.

(*a*) "Industrial property" includes patents, industrial designs and models, trade marks and trade names. See, however, Clause I. of the Protocol.

We are here concerned with the Convention only in so far as it deals with designs, although the text is given in full.

(*b*) The original Convention was published in French, which, under Art. 6 of the Final Protocol, is the official language of the International Office. The authorised English translation has been given here; but, except in the formal parts, the French version of each article has been printed immediately below the paragraph to which it refers. The terms of the Convention, both in the original and in the English translation, are often vague. In such cases a reference to the original French text is of assistance.

The necessary ratifications were exchanged by the plenipotentiaries of the High Contracting Parties on June 6, 1884, and as Article XVIII. provides that the Convention should come into operation one month after the exchange of ratifications, the date from which it applies to the countries named in Article I. is July 6, 1884.

The words "industrial property" are to be understood in their broadest sense; they are not to apply simply to "industrial products," properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters, &c.). (See Final Protocol.)

In addition to the original members of the Union the following countries have since given in their adhesion to the Convention and become members:—

Name of Country.	*Date of Entry.*
Norway	1st July, 1885.
Sweden	1st July, 1885.
United States of America	30th May, 1887.
Dutch Indies	1st October, 1888.
Surinam and Curaçoa	1st July, 1890.
Dominican Republic	11th July, 1890.
New Zealand	7th September, 1891.
Denmark	1st October, 1894.
Japan	15th July, 1899.
Germany	1st May, 1903.
Mexico	7th September, 1903.
Cuba	17th November, 1903.

The additional Act of Brussels has been adopted by all the members of the Union with the exception of Servia and the Dominican Republic.

Similar arrangements for the mutual protection of Designs have been made between Great Britain and Ecuador, Greece, Honduras, Paraguay, Uruguay and Roumania.

Article II.

The subjects or citizens of each of the Contracting States shall, in all the other States of the Union, as regards patents, industrial designs or models, trade marks and trade names, enjoy the advantages that their respective laws now grant, or shall hereafter grant, to their own subjects or citizens.

Legal remedies.

Consequently, they shall have the same protection as the latter, and the same legal remedy against any infringement of their rights, provided they observe the formalities and conditions imposed on subjects or citizens by the internal legislation of each State.

Les sujets ou citoyens de chacun des Etats Contractants jouiront, dans tous les autres Etats de l'Union, en ce qui concerne les brevets d'invention, les dessins ou modèles industriels, les marques de fabrique ou de commerce et le nom commercial, des avantages que les lois respectives accordent actuellement ou accorderont par la suite aux nationaux.

En conséquence, ils auront la même protection que ceux-ci et le même recours légal contre toute atteinte portée à leurs droits, sous réserve de l'accomplissement des formalités et des conditions imposées aux nationaux par la législation intérieure de chaque Etat.

Under the word "patents" are comprised the various kinds of industrial patents, recognised by the legislation of each of the Contracting States, such as importation patents, and improvements patents. (See Final Protocol, 2.)

The last paragraph of this Article does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the tribunals and the competence of those tribunals. (Final Protocol, 3.)

The provisions of this Article have been extended by Article XII. introduced by the Brussels Act. (See *post*.)

ARTICLE III.

Rights of subjects of States not within Union established in countries within Union.

Subjects or citizens of States not forming part of the Union, who are domiciled or have *real and effective* industrial or commercial establishments in the territory of any of the States of the Union, shall be assimilated to the subjects or citizens of the Contracting States.

Sont assimilés aux sujets ou citoyens des Etats Contractants les sujets ou citoyens des Etats ne faisant pas partie de l'Union qui sont domiciliés ou ont des établissements industriels ou commerciaux *effectifs et sérieux* sur le territoire de l'un des Etats de l'Union.

By this Article subjects or citizens of non-contracting States who are domiciled or have establishments in Contracting States are placed on a better footing than their compatriots at home. The difficult questions arising upon the meaning of the words "*domiciled or have industrial or commercial establishments*" in the original Convention, were attempted to be settled by the addition of "*real and effective*" by the Brussels Act.

ARTICLE IV.

Right of priority.

Any person who has duly applied for a patent, industrial design or model, or trade mark in one of the Contracting States, shall enjoy, as regards registration in the other States, and reserving the rights of third parties, a right of priority during the periods hereinafter stated.

Consequently, subsequent registration in any of the other States of the Union before expiry of these periods shall not be invalidated through any acts accomplished in the interval, either, for instance, by another registration, by publication of the invention, or by the working of it [by a third party], by the sale of copies of the design or model, or by use of the trade mark.

The above-mentioned terms of priority shall be *twelve* months for patents, and *four* months for industrial designs and models and trade marks. [A month longer is allowed for countries beyond sea.]

Celui qui aura régulièrement fait le dépôt d'une demande de brevet d'invention, d'un dessin ou modèle industriel, d'une marque de fabrique ou de commerce, dans l'un des Etats Contractants, jouira, pour effectuer de dépôt dans les autres Etats, et sous réserve des droits des tiers, d'un droit de priorité pendant les délais déterminés ci-après.

En conséquence, le dépôt ultérieurement opéré dans l'un des autres Etats de l'Union avant l'expiration de ces délais ne pourra être invalidé par des faits accomplis dans l'intervalle, soit, notamment, par un autre dépôt, par la publication de l'*invention ou son exploitation par un tiers, par la mise en vente* d'exemplaires du dessin ou du modèle, par l'emploi de la marque.

Les délais de priorité mentionnés ci-dessus seront de *douze* mois pour les brevets d'invention, et de *quatre* mois pour les dessins ou modèles industriels, ainsi que pour les marques de fabrique ou de commerce. [Ils seront augmentés d'un mois pour les pays d'outremer.]

The original terms of priority specified in the Convention were six months for patents and three months for designs, with an additional month for "countries beyond the sea," but these terms were altered to twelve and four months respectively by the Brussels Act. These terms are adopted by the Patents and Designs Act, 1907. (See sect. 91 (1) (a), *ante*, p. 272.)

When first this Article came into operation, some doubt existed whether the period allowed was to be computed from the date of deposit of the application for a patent, or from the date on which the patent was actually sealed in Great Britain, or signed

in the other Contracting States. The Act of 1885, s. 6, substituted "*date of application*" for "*date of the protection obtained*," and this is continued by the new Act (1907), sect. 91 (1) (a).

It appears that *one of the Contracting States* means the first State where application was made.

An additional Article (IVbis.) was introduced by the Brussels Act, but this relates only to patents.

The provisions of the Article have been extended by Article XII. of the Brussels Act. (See *post*.)

Article V.

Importation and forfeiture.

The introduction by the patentee into the country where the patent has been granted of objects manufactured in any of the States of the Union shall not entail forfeiture.

Nevertheless, the patentee shall remain bound to work his patent in conformity with the laws of the country into which he introduces the patented objects.

L'introduction par le breveté, dans le pays où le brevet a été délivré, d'objets fabriqués dans l'un ou l'autre des États de l'Union, n'entraînera pas la déchéance.

Toutefois le breveté restera soumis à l'obligation d'exploiter son brevet conformément aux lois du pays où il introduit les objets brevetés.

The first conference of delegates of the Contracting States was held at Rome in April and May, 1886, when the following addition to Article V. was recommended:—

Each country shall determine the sense in which the word *exploiter* (work) is to be interpreted by the law of that country.

Article VI.

Registration of trade marks.

Every trade mark duly registered in the country of origin shall be admitted for registration, and protected in the form originally registered in all the other countries of the Union.

That country shall be deemed the country of origin where the applicant has his chief seat of business.

If this chief seat of business is not situated in one of the countries of the Union, the country to which the applicant belongs shall be deemed the country of origin.

Registration may be refused if the object for which it is solicited is considered contrary to morality or public order.

Toute marque de fabrique ou de commerce régulièrement déposée dans le pays d'origine sera admise au dépôt et protégée telle quelle dans les autres pays de l'Union.

Sera considéré comme pays d'origine le pays où le déposant a son principal établissement.

Si ce principal établissement n'est point situé dans un des pays de l'Union, sera considéré comme pays d'origine celui auquel appartient le déposant.

Le dépôt pourra être refusé, si l'objet pour lequel il est demandé est considéré comme contraire à la morale ou à l'ordre public.

Article VII.

Nature of goods to be no obstacle to registration of trade mark.

The nature of the goods on which the trade mark is to be used can, in no case, be an obstacle to the registration of the trade mark.

La nature du produit sur lequel la marque de fabrique ou de commerce doit être apposée ne peut, dans aucun cas, faire obstacle au dépôt de la marque.

ARTICLE VIII.

A trade name shall be protected in all the countries of the Union, without necessity of registration, whether it form part or not of a trade mark. Protection of trade names.

Le nom commercial sera protégé dans tous les pays de l'Union sans obligation de dépôt, qu'il fasse ou non partie d'une marque de fabrique ou de commerce.

ARTICLE IX.

All goods illegally bearing a trade mark or trade name may be seized on importation into those States of the Union where this mark or name has a right to legal protection. Seizure of goods bearing illegal trade mark or name.

The seizure shall be effected at the request of either the proper Public Department or of the interested party, pursuant to the internal legislation of each country.

In States the laws of which do not admit of seizure upon importation, prohibition of importation may take the place of such seizure.

The authorities shall not be compelled to effect the seizure in the case of goods in transit.

Tout produit portant illicitement une marque de fabrique ou de commerce, ou un nom commercial, pourra être saisi à l'importation dans ceux des Etats de l'Union dans lesquels cette marque ou ce nom commercial ont droit à la protection légale.

La saisie aura lieu à la requête soit du Ministère Public, soit de la partie intéressée, conformément à la législation intérieure de chaque Etat.

Dans les Etats dont la législation n'admet pas la saisie à l'importation, cette saisie pourra être remplacée par la prohibition d'importation.

Les autorités ne seront pas tenues d'effectuer la saisie en cas de transit.

ARTICLE X.

The provisions of the preceding article shall apply to all goods falsely bearing the name of any locality as indication of the place of origin, when such indication is associated with a trade name of a fictitious character or assumed with a fraudulent intention. Goods falsely bearing name of a locality.

Any *producer*, manufacturer of, or trader in, such goods, established *either* in the locality falsely designated as the place of origin, *or in the region in which such place is situate*, shall be deemed an interested party.

Les dispositions de l'Article précédent seront applicables à tout produit portant faussement, comme indication de provenance, le nom d'une localité déterminée, lorsque cette indication sera jointe à un nom commercial fictif ou emprunté dans une intention frauduleuse.

Est réputé partie intéressée tout producteur, fabricant ou commerçant, engagé dans la production, la fabrication ou le commerce de ce produit, et établi soit dans la localité faussement indiquée comme lieu de provenance, soit dans la région où cette localité est située.

ARTICLE Xb.

Persons resorting to the countries referred to in the Convention (Articles II. and III.) shall enjoy in the States of the Union the protection accorded to nationals against dishonest competition (concurrence déloyale).

Les ressortissants de la Convention (Articles II. et III.) jouiront, dans tous les États de l'Union, de la protection accordée aux nationaux contre la concurrence déloyale.

Article XI.

Protection at exhibitions.

The High Contracting Parties agree to grant, *in conformity with the legislation of each country*, temporary protection to patentable inventions, to industrial designs or models, and trade marks, for articles exhibited at official or officially recognised International Exhibitions *held in the territory of one of them*.

Les Hautes Parties Contractantes *accorderont conformément à la législation de chaque pays* une protection temporaire aux inventions brevetables, aux dessins ou modèles industriels, ainsi qu'aux marques de fabrique ou de commerce, pour les produits qui figureront aux Expositions Internationales officielles ou officiellement reconnues, *organisées sur le territoire de l'une d'elles*.

Temporary protection is provided for in the United Kingdom by sect. 69 of the Act of 1907.

Article XII.

Government Office.

Each of the High Contracting Parties agree to establish a special Government Department for industrial property, and a central office for communication to the public of patents, industrial designs or models, and trade marks.

Chacune des Hautes Parties Contractantes s'engage à établir un service spécial de la Propriété industrielle et un dépôt central, pour la communication au public des brevets d'invention, des dessins ou modèles industriels et des marques de fabrique ou de commerce.

In this country the Patent Office fulfils this obligation.

Article XIII.

International Bureau.

An international office shall be organized under the name of "Bureau International de l'Union pour la Protection de la Propriété Industrielle" (International Office of the Union for the Protection of Industrial Property).

This office, the expense of which shall be defrayed by the Governments of all the Contracting States, shall be placed under the high authority of the Central Administration of the Swiss Confederation, and shall work under its supervision. Its functions shall be determined by agreement between the States of the Union.

Un office international sera organisé sous le titre de "Bureau International de l'Union pour la Protection de la Propriété Industrielle."

Ce bureau, dont les frais seront supportés par les Administrations de tous les États Contractants, sera placé sous la haute autorité de l'Administration Supérieure de la Confédération Suisse, et fonctionnera sous sa surveillance. Les attributions en seront déterminées d'un commun accord entre les États de l'Union.

See the Final Protocol, §§ 5 and 6.

An international office, &c.—This office has been established at Berne (14 Kanonenweg). A monthly periodical, entitled *La Propriété Industrielle*, is published under its supervision.

Article XIV.

Conferences.

The present Convention shall be submitted to periodical revisions, with a view to introducing improvements calculated to perfect the system of the Union.

To this end Conferences shall be successively held in one of the Contracting States by Delegates of the said States. [The next meeting shall take place in 1885 at Rome.]

La présente Convention sera soumise à des révisions périodiques en vue d'y introduire les améliorations de nature à perfectionner le système de l'Union.

A cet effet, des Conférences auront lieu successivement, dans l'un des Etats Contractants, entre les Délégués des dits Etats.

[La prochaine réunion aura lieu en 1885, à Rome.]

The first meeting was held at Rome in April and May, 1886. The Act of Brussels is the outcome of the meeting held at that place in 1900.

ARTICLE XV.

It is agreed that the High Contracting Parties respectively reserve to themselves the right to make separately, as between themselves, special arrangements for the protection of Industrial Property, in so far as such arrangements do not contravene the provisions of the present Convention. *Special arrangements between contracting parties.*

Il est entendu que les Hautes Parties Contractantes se réservent respectivement le droit de prendre séparément, entre elles, des arrangements particuliers pour la protection de la Propriété Industrielle, en tant que ces arrangements ne contreviendraient point aux dispositions de la présente Convention.

ARTICLE XVI.

States which have not taken part in the present Convention shall be permitted to adhere to it at their request. *Adherence of other States.*

Such adhesion shall be notified officially through the diplomatic channel to the Government of the Swiss Confederation, and by the latter to all the others. It shall imply complete accession to all the clauses, and admission to all the advantages stipulated by the present Convention, *and shall take effect one month after the despatch of the notification sent by the Swiss Government to the other States of the Union, unless a subsequent date have been indicated by the adhering State.*

Les Etats qui n'ont point pris part à la présente Convention seront admis à y adhérer sur leur demande.

Cette adhésion sera notifiée par la voie diplomatique au Gouvernement de la Confédération Suisse, *et par celui-ci à tous les autres.*

Elle importera, de plein droit, accession à toutes les clauses et admission à tous les avantages stipulés par la présente Convention, *et produira ses effets un mois après l'envoi de la notification faite par le Gouvernement Suisse aux autres États unionistes, à moins qu'une date postérieure n'ait été indiquée par l'État adhérent.*

See the Note to Art. I. A list of the States belonging to this International Union, and the dates at which the Convention commenced its effective operation, will be found at p. 322.

The original parties to the Convention are all bound from the same date, July 6th, 1884.

As regards any two countries subsequently joining the Convention, the date of adhesion of the country which last joined the Convention will regulate the date of commencement of the operation of the Convention between the two countries. The provisions of sect. 103 of Patents Act, 1883 (continued by sect. 91 of the 1907 Act), were extended to applications under the International Convention, by Order in Council dated 26th June, 1884. (See *post*, p. 331.)

Article XVII.

Convention subordinate to laws of contracting countries.

The execution of the reciprocal engagements contained in the present Convention is subordinated, in so far as necessary, to the observance of the formalities and rules established by the Constitutional laws of those of the High Contracting Parties who are bound to procure the application of the same, which they engage to do with as little delay as possible.

L'exécution des engagements réciproques contenus dans la présente Convention est subordonnée, en tant que de besoin, à l'accomplissement des formalités et règles établies par les lois constitutionnelles de celles des Hautes Parties Contractantes qui sont tenues d'en provoquer l'application, ce qu'elles s'obligent à faire dans le plus bref délai possible.

The International Convention is valid in this country only in so far as its provisions are authorised by the Patents Acts, or by any other law, whether statute or common law, affecting the subjects dealt with in the Convention.

Article XVIII.

Commencement of operation of Convention.

The present Convention shall come into operation one month after the exchange of ratifications, and shall remain in force for an unlimited time, till the expiry of one year from the date of its denunciation. This denunciation shall be addressed to the Government commissioned to receive adhesions. It shall only affect the denouncing State, the Convention remaining in operation as regards the other Contracting Parties.

La présente Convention sera mise à exécution dans le délai d'un mois à partir de l'échange des ratifications et demeurera en vigueur pendant un temps indéterminé, jusqu'à l'expiration d'une année à partir du jour où la dénonciation en sera faite.

Cette dénonciation sera adressée au Gouvernement chargé de recevoir les adhésions. Elle ne produira son effet qu'à l'égard de l'Etat qui l'aura faite, la Convention restant exécutoire pour les autres Parties Contractantes.

The ratifications were exchanged on June 6th, 1884, so that the date from which the Convention operates is July 6th, 1884. Great Britain joined the Convention July 7th, 1884.

Article XIX.

Ratification.

The present Convention shall be ratified and the ratifications exchanged in Paris, within one year at the latest.

La présente Convention sera ratifiée, et les ratifications en seront échangées à Paris, dans le délai d'un an au plus tard.

In witness whereof the respective Plenipotentiaries have signed the same, and have affixed thereto their seals.

Done at Paris the 20th March, 1883.

II.

FINAL PROTOCOL.

On proceeding to the signature of the Convention concluded this day between the Governments of Belgium, Brazil, Spain, France, Guatemala, Italy, the Netherlands, Portugal, Salvador, Servia, and Switzerland, for the protection of Industrial Property, the undersigned Plenipotentiaries have agreed as follows:—

"Industrial property."

1. The words "Industrial Property" are to be understood in their broadest

sense; they are not to apply simply to industrial products properly so called, but also to agricultural products (wines, corn, fruits, cattle, &c.), and to mineral products employed in commerce (mineral waters, &c.).

2. Under the word "patents" are comprised the various kinds of industrial patents recognised by the legislation of each of the Contracting States, such as importation patents, improvement patents, &c. "Patents."

3. The last paragraph of Article II. does not affect the legislation of each of the Contracting States as regards the procedure to be followed before the Tribunals, and the competence of those Tribunals.

3*b*. *The patent, in each country, shall not be liable to forfeiture on account of failure to utilize it, until after the expiration of at least three years from the date of the deposit of the application in the country concerned, and only provided the patentee cannot show reasonable cause for his inaction.*

4. Paragraph 1 of Article VI. is to be understood as meaning that no trade mark shall be excluded from protection in any State of the Union, from the fact alone that it does not satisfy, in regard to the signs composing it, the conditions of the legislation of that State; provided that on this point it comply with the legislation of the country of origin, and that it had been properly registered in said country of origin. With this exception, which relates only to the form of the mark, and under reserve of the provisions of the other Articles of the Convention, the internal legislation of each State remains in force.

To avoid misconstruction, it is agreed that the use of public armorial bearings and decorations may be considered as being contrary to public order in the sense of the last paragraph of Article VI.

5. The organization of the special Department for Industrial Property mentioned in Article XII. shall comprise, so far as possible, the publication in each State of a periodical official paper.

6. The common expenses of the International Office, instituted by virtue of Article XIII., are in no case to exceed for a single year a total sum representing an average of 2,000 fr. for each Contracting State. Expenses of International Office.

* * * * * * *

The official language of the International Office will be French.

7. The present Final Protocol, which shall be ratified together with the Convention concluded this day, shall be considered as forming an integral part of, and shall have the same force, validity, and duration as the said Convention. Final Protocol to be read with Conven-tion.

Au moment de procéder à la signature de la Convention conclue, à la date de ce jour, entre les Gouvernements de la Belgique, du Brésil, de l'Espagne de la France, du Guatemala, de l'Italie, des Pays-Bas, du Portugal, du Salvador, de la Serbie, et de la Suisse, pour la protection de la Propriété Industrielle, les Plénipotentiaires soussignés sont convenus de ce qui suit:

1. Les mots "Propriété Industrielle" doivent être entendus dans leur acception la plus large, en ce sens qu'ils s'appliquent non seulement aux produits de l'industrie proprement dite, mais également aux produits de l'agriculture (vins, grains, fruits, bestiaux, &c.), et aux produits minéraux livrés au commerce (eaux minérales, &c.).

2. Sous le nom de "Brevets d'Invention" sont comprises les diverses espèces de brevets industriels admises par les législations des États Contractants, telles que brevets d'importation, brevets de perfectionnement, &c.

3. Il est entendu que la disposition finale de l'Article II. de la Convention ne porte aucune atteinte à la législation de chacun des États Contractants, en ce qui concerne la procédure suivie devant les Tribunaux et la compétence de ces Tribunaux.

3*b*. *Le breveté, dans chaque pays, ne pourra être frappé de déchéance pour cause de non-exploitation qu'après un délai minimum de trois ans, à dater du dépôt de la demande dans le pays dont il s'agit, et dans le cas où le breveté ne justifierait pas des causes de son inaction.*

4. Le paragraphe 1er de l'Article VI. doit être entendu en ce sens qu'aucune marque de fabrique ou de commerce ne pourra être exclue de la protection dans

l'un des États de l'Union par le fait seul qu'elle ne satisferait pas, au point de vue des signes qui la composent, aux conditions de la législation de cet État, pourvu qu'elle satisfasse, sur ce point, à la législation du pays d'origine et qu'elle ait été, dans ce dernier pays, l'objet d'un dépôt régulier. Sauf cette exception, qui ne concerne que la forme de la marque, et sous réserve des dispositions des autres Articles de la Convention, la législation intérieure de chacun des États recevra son application.

Pour éviter toute fausse interprétation, il est entendu que l'usage des armoiries publiques et des décorations peut être considéré comme contraire à l'ordre public, dans le sens du paragraphe final de l'Article VI.

5. L'organisation du service spécial de la Propriété Industrielle mentionné à l'Article XII. comprendra, autant que possible, la publication, dans chaque État, d'une feuille officielle périodique.

6. Les frais communs du Bureau International institué par l'Article XIII. ne pourront, en aucun cas, dépasser, par année, une somme totale représentant une moyenne de 2,000 fr. par chaque État Contractant.

* * * * * * *

La langue officielle du Bureau International sera la langue Française.

7. Le présent Protocole de Clôture qui sera ratifié en même temps que la Convention conclue à la date de ce jour sera considéré comme faisant partie intégrante de cette Convention, et aura mêmes force, valeur et durée.

III.

ACCESSION OF HER MAJESTY'S GOVERNMENT TO THE CONVENTION SIGNED AT PARIS, MARCH 20TH, 1883.

Accession of Her Britannic Majesty to the Convention.

The undersigned, Ambassador Extraordinary and Plenipotentiary of Her Majesty the Queen of the United Kingdom of Great Britain and Ireland to the French Republic, declares that Her Britannic Majesty, having had the International Convention for the Protection of Industrial Property, concluded at Paris on the 20th March, 1883, and the Protocol relating thereto, signed on the same date, laid before her, and availing herself of the right reserved by Article XVI. of that Convention to States not parties to the original Convention, accedes, on behalf of the United Kingdom of Great Britain and Ireland, to the said International Convention for the Protection of Industrial Property, and to the said Protocol, which are to be considered as inserted word for word in the present Declaration, and formally engages, as far as regards the President of the French Republic and the other High Contracting Parties, to co-operate on her part in the execution of the stipulations contained in the Convention and Protocol aforesaid.

Reservation of right to accede on behalf of the Channel Islands and Isle of Man.

The undersigned makes this declaration on the part of Her Britannic Majesty with the express understanding that power is reserved to Her Britannic Majesty to accede to the Convention on behalf of the Isle of Man and the Channel Islands, and any of Her Majesty's possessions, on due notice to that effect being given through Her Majesty's Government.

In witness whereof the undersigned, duly authorised, has signed the present Declaration of Accession, and has affixed thereto the seal of his arms.

Done at Paris on the 17th day of March, 1884.

(L.S.) (Signed) LYONS.

IV.

DECLARATION OF ACCEPTANCE OF ACCESSION.

Her Majesty the Queen of the United Kingdom of Great Britain and Ireland, having acceded to the International Convention relative to the Protection of Industrial Property, concluded at Paris, March 20th, 1883, together with a Protocol dated the same day, by the Declaration of Accession delivered by Her Ambassador Extraordinary and Plenipotentiary to the Government of the French Republic; the text of which declaration is word for word as follows:—

(Here is inserted the text of No. III. in English.)

Accession of Her Britannic Majesty, with its reservations accepted.

The President of the French Republic has authorised the undersigned, President of the Council, Minister for Foreign Affairs, to formally accept the said Accession, together with the reserves which are contained in it concerning the Isle of Man, the Channel Islands, and all other possessions of Her Britannic Majesty, engaging as well in his own name as in that of the other High Contracting Parties to assist in the accomplishment of the obligations stipulated in the Convention and the Protocol thereto annexed, which may concern the United Kingdom of Great Britain and Ireland.

In witness whereof the undersigned, duly authorised, has drawn up the present Declaration of Acceptance and has affixed thereto his seal.

Done at Paris, the 2nd April, 1884.

(L.S.) (Signed) JULES FERRY.

ORDER IN COUNCIL APPLYING SECTION 103 OF THE ACT OF 1883 TO THE SIGNATORIES TO THE INTERNATIONAL CONVENTION (*a*).

At the Court at Windsor, the 26th day of June, 1884: Present—The Queen's most Excellent Majesty in Council.

WHEREAS by the provisions of the Patents, Designs and Trade Marks Act, 1883, it is among other things provided:

Recital of Act of 1883, s. 103.

That if Her Majesty is pleased to make any arrangement with the Government or Governments of any foreign State or States for mutual protection of inventions, designs, and trade-marks, or any of them, then any person who has applied for protection for any invention, design, or trade-mark, in any such State, shall, subject to the conditions further provided and set forth in the said Act, be entitled to a patent for his invention, or to registration of his design or trade mark (as the case may be) under the said Act in priority to other applicants, and such patent or registration shall have the same date as the date of the protection obtained in such foreign State.

Recital of accession of Great Britain to International Convention.

And whereas it has pleased Her Majesty to make an arrangement of the nature contemplated by the said Act, by and in virtue of a declaration signed and sealed by Her Majesty's Ambassador at Paris on the 17th March, 1884, duly conveying the accession of Great Britain to the International Convention and Protocol for the Protection of Industrial Property, signed by the representatives of certain powers on the 20th day of March, 1883, and duly

(*a*) Published in *London Gazette* of July 1st, 1884. For the other Orders in Council which have been made, see Table at p. 414.

ratified on the 6th day of June, 1884, power being reserved to Her Majesty to hereafter accede to the provisions of the said Convention and Protocol on behalf of the Isle of Man, the Channel Islands, and any of Her Majesty's possessions, which declaration or accession was duly accepted by the French Government on behalf of the Signatory Powers, by and in virtue of a declaration dated the 2nd of April, 1884.

Section 103 applied.

Now, therefore, Her Majesty, by and with the advice and consent of her Privy Council, and by virtue of the authority committed to her by the said Act, doth declare, and it is hereby declared, that the provisions of the said Act hereinbefore specified shall apply to the following countries, viz. :—

Belgium.	Salvador.
Brazil.	Servia.
France.	Spain.
Guatemala.	Switzerland.
Italy.	Ecuador, and
Netherlands.	Tunis.
Portugal.	

Order, when order takes effect.

And it is hereby further ordered and declared that this Order shall take effect from the 7th day of July, 1884.

C. L. PEEL.

PART III.

APPENDIX A.—STATUTES.

[The Statutes in force prior to 1883 are not set out here, as they were entirely replaced by the Consolidation Act of that year. The Acts of 1883—1888, under which most of the decisions arose, and which still affect the validity of Designs registered before the 1st January, 1908, are here set out in full for reference, so far as they relate to Designs.]

The following is a complete list of the earlier repealed Acts :—

Date of Acts.	Title.
27 Geo. III. c. 38. (1787.)	An Act for the Encouragement of the Arts of designing and printing Linens, Cottons, Calicoes, and Muslins, by vesting the Properties thereof in the Designers, Printers, and Proprietors for a limited Time.
29 Geo. III. c. 19. (1789.)	An Act for continuing an Act for the Encouragement of the Arts of designing and printing Linens, Cottons, Calicoes, and Muslins, by vesting the Properties thereof in the Designers, Printers, and Proprietors for a limited Time.
34 Geo. III. c. 23. (1794.)	An Act for amending and making perpetual an Act for the Encouragement of the Arts of designing and printing Linens, Cottons, Calicoes, and Muslins, by vesting the Properties thereof in the Designers, Printers, and Proprietors for a limited Time.
38 Geo. III. c. 71. (1798.)	An Act for encouraging the Art of making new Models and Casts of Busts and other Things therein mentioned.
54 Geo. III. c. 56. (1814.)	An Act to amend and render more effectual an Act for encouraging the Art of making new Models and Casts of Busts and other Things therein mentioned, and for giving further Encouragement to such Arts.
2 Vict. c. 13. (1839.)	An Act for extending the Copyright of Designs for Calico Printing to Designs for printing other woven Fabrics.
2 Vict. c. 17. (1839.)	An Act to secure to Proprietors of Designs for Articles of Manufacture the Copyright of such Designs for a limited Time.

Session and Chapter.	Title.
5 & 6 Vict. c. 100 ..	An Act to consolidate and amend the laws relating to the Copyright of Designs for ornamenting Articles of Manufacture.
6 & 7 Vict. c. 65	An Act to amend the laws relating to the Copyright of Designs.
13 & 14 Vict. c. 104..	An Act to extend and amend the Acts relating to the Copyright of Designs.
21 & 22 Vict. c. 70 ..	An Act to amend the Act of the fifth and sixth years of Her present Majesty to consolidate and amend the laws relating to the Copyright of Designs for ornamenting Articles of Manufacture.
24 & 25 Vict. c. 73 ..	An Act to amend the law relating to the Copyright of Designs.
38 & 39 Vict. c. 93 ..	An Act to amend the Copyright of Designs Acts.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1883.

(46 & 47 Vict. c. 57.)

An Act to amend and consolidate the Law relating to Patents for Inventions, Registration of Designs, and of Trade Marks.

[25th August, 1883.]

Be it enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

PART I.

Preliminary.

Short title.

1. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1883.

Division of Act into parts.

2. This Act is divided into parts, as follows:—

Part I.—Preliminary.
Part II.—Patents.
Part III.—Designs.
Part IV.—Trade Marks.
Part V.—General.

3. This Act, except where it is otherwise expressed, shall commence from and immediately after the thirty-first day of December, one thousand eight hundred and eighty-three. Commencement of Act.

PART II.

Patents.

PART III.

Designs.

Registration of Designs.

47.—(1.) The comptroller may, on application by or on behalf of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this part of this Act. Application for registration of designs.

(2.) The application must be made in the form set forth in the First Schedule to this Act, or in such other form as may be from time to time prescribed, and must be left at, or sent by post to, the Patent Office in the prescribed manner.

(3.) The application must contain a statement of the nature of the design, and the class or classes of goods in which the applicant desires that the design be registered.

(4.) The same design may be registered in more than one class.

(5.) In case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.

(6.) The comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal therefrom to the Board of Trade.

(7.) The Board of Trade shall, if required, hear the applicant and the comptroller, and may make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

48.—(1.) On application for registration of a design the applicant shall furnish to the comptroller the prescribed number of copies of drawings, photographs or tracings of the design sufficient, in the opinion of the comptroller, for enabling him to identify the design; or the applicant may, instead of such copies, furnish exact representations or specimens of the design. Drawings, &c. to be furnished on application.

(2.) The comptroller may, if he thinks fit, refuse any drawing, photograph, tracing, representation, or specimen which is not, in his opinion, suitable for the official records.

49.—(1.) The comptroller shall grant a certificate of registration to the proprietor of the design when registered. Certificate of registration.

(2.) The comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, grant a copy or copies of the certificate.

Copyright in Registered Designs.

Copyright on registration.

50.—(1.) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration.

(2.) Before delivery on sale of any articles to which a registered design has been applied, the proprietor must (if exact representations or specimens were not furnished on the application for registration), furnish to the comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the comptroller may erase his name from the register, and thereupon his copyright in the design shall cease.

Marking registered designs.

51. Before delivery on sale of any articles to which a registered design has been applied, the proprietor of the design shall cause each such article to be marked with the prescribed mark, or with the prescribed word or words or figures, denoting that the design is registered; and if he fails to do so the copyright in the design shall cease, unless the proprietor shows that he took all proper steps to ensure the marking of the article.

Inspection of registered designs.

52.—(1.) During the existence of copyright in a design, the design shall not be open to inspection except by the proprietor, or a person authorised in writing by the proprietor, or a person authorised by the comptroller or by the Court, and furnishing such information as may enable the comptroller to identify the design, nor except in the presence of the comptroller, or of an officer acting under him, nor except on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof.

(2.) When the copyright in a design has ceased, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

Information as to existence of copyright.

53. On the request of any person producing a particular design, together with its mark of registration, or producing only its mark of registration, or furnishing such information as may enable the comptroller to identify the design, and on payment of the prescribed fee, it shall be the duty of the comptroller to inform such person whether the registration still exists in respect of such design, and if so, in respect of what class or classes of goods, and stating also the date of registration, and the name and address of the registered proprietor.

Cesser of copyright

54. If the registered design is used in manufacture in any foreign

country and is not used in this country within six months of its registration in this country, the copyright in the design shall cease. In certain events.

Register of Designs.

55.—(1.) There shall be kept at the patent office a book called the register of designs, wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may be from time to time prescribed. Register of designs.

(2.) The register of designs shall be *prima facie* evidence of any matters by this Act directed or authorised to be entered therein.

Fees.

56. There shall be paid in respect of applications and registration and other matters under this part of this Act such fees as may be from time to time, with the sanction of the Treasury, prescribed by the Board of Trade; and such fees shall be levied and paid to the account of Her Majesty's Exchequer in such manner as the Treasury shall from time to time direct. Fees on registration, &c.

Industrial and International Exhibitions.

57. The exhibition at an industrial or international exhibition certified as such by the Board of Trade, or the exhibition elsewhere during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof, provided that both the following conditions are complied with; namely,— Exhibition at industrial or international exhibition not to prevent or invalidate registration.

(a) The exhibitor must, before exhibiting the design or article, or publishing a description of the design, give the comptroller the prescribed notice of his intention to do so; and

(b) The application for registration must be made before or within six months from the date of the opening of the exhibition.

Legal Proceedings.

58. During the existence of copyright in any design—

(a) It shall not be lawful for any person without the license or written consent of the registered proprietor to apply such design or any fraudulent or obvious imitation thereof, in the class or classes of goods in which such design is registered, for purposes of sale to any article of manufacture or to any substance artificial or natural or partly artificial and partly natural; and Penalty on piracy of registered design.

(b) It shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing that the same has been so applied without the consent of the registered proprietor.

Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any Court of competent jurisdiction.

Action for damages.

59. Notwithstanding the remedy given by this Act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or of any fraudulent or obvious imitation thereof for the purpose of sale, to any article of manufacture or substance, or from the publication, sale or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor had not given his consent to such application.

Definitions.

Definition of "design," "copyright."

60. In and for the purposes of this Act —

"Design" means any design applicable to any article of manufacture, or to any substance artificial or natural, or partly artificial and partly natural, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined, not being a design for a sculpture, or other thing within the protection of the Sculpture Copyright Act of the year 1814 (fifty-fourth George the Third, chapter fifty-six).

"Copyright" means the exclusive right to apply a design to any article of manufacture or to any such substance as aforesaid in the class or classes in which the design is registered.

Definition of proprietor.

61. The author of any new and original design shall be considered the proprietor thereof, unless he executed the work on behalf of another person for a good or valuable consideration, in which case such person shall be considered the proprietor, and every person acquiring for a good or valuable consideration a new and original design, or the right to apply the same to any such article or substance as aforesaid, either exclusively of any other person or otherwise, and also every

person on whom the property in such design or such right to the application thereof shall devolve, shall be considered the proprietor of the design in the respect in which the same may have been so acquired, and to that extent, but not otherwise.

PART IV.

Trade Marks.

PART V.

General.

Patent Office and Proceedings thereat.

Patent Office.

82.—(1.) The Treasury may provide for the purposes of this Act an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2.) Until a new patent office is provided, the offices of the Commissioners of Patents for inventions and for the registration of designs and trade marks existing at the commencement of this Act shall be the patent office within the meaning of this Act.

(3.) The patent office shall be under the immediate control of an officer called the comptroller-general of patents, designs, and trade marks, who shall act under the superintendence and direction of the Board of Trade.

(4.) Any act or thing directed to be done by or to the comptroller may, in his absence, be done by or to any officer for the time being in that behalf authorised by the Board of Trade.

Officers and clerks.

83.—(1.) The Board of Trade may at any time after the passing of this Act, and from time to time, subject to the approval of the Treasury, appoint the comptroller-general of patents, designs, and trade marks, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may from time to time remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and the same and the other expenses of the execution of this Act shall be paid out of money provided by Parliament.

Seal of patent office.

84. There shall be a seal for the patent office, and impressions thereof shall be judicially noticed and admitted in evidence.

Trust not to be entered in registers,

85. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed, implied or constructive.

Refusal to grant patent, &c. in certain cases.

86. The comptroller may refuse to grant a patent for an invention, or to register a design or trade mark, of which the use would, in his opinion, be contrary to law or morality.

Entry of assignments and transmissions in registers.

87. Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a registered design, or to a registered trade mark, the comptroller shall on request and on proof of title to his satisfaction, cause the name of such person to be entered as proprietor of the patent, copyright in the design, or trade mark, in the register of patents, designs, or trade marks, as the case may be. The person for the time being entered in the register of patents, designs, or trade marks, as proprietor of a patent, copyright in a design or trade mark as the case may be, shall, subject to any rights appearing from such register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the same and to give effectual receipts for any consideration for such assignment, license, or dealing. Provided that any equities in respect of such patent, design, or trade mark may be enforced in like manner as in respect of any other personal property.

Inspection of and extracts from registers.

88. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to such regulations as may be prescribed; and certified copies, sealed with the seal of the patent office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Sealed copies to be received in evidence.

89. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the patent office, of or from patents, specifications, disclaimers and other documents in the patent office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in Her Majesty's dominions, and in all proceedings, without further proof or production of the originals.

Rectification of registers by Court.

90.—(1.) The Court may on the application of any person aggrieved by the omission without sufficient cause of the name of any person from any register kept under this Act, or by any entry made without sufficient cause in any such register, make such order for making, expunging, or varying the entry, as the Court thinks fit; or the Court may refuse the application; and in either case may make such order with respect to the costs of the proceedings as the Court thinks fit.

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide for the rectification of a register, and may direct an issue to be tried for the decision of any question of fact, and may award damages to the party aggrieved.

(3.) Any order of the Court rectifying a register shall direct that due notice of the rectification be given to the comptroller.

Power for comptroller to correct clerical errors.

91. The comptroller may, on request in writing accompanied by the prescribed fee—

(a) Correct any clerical error in or in connection with an application for a patent, or for registration of a design or trade mark; or

(b) Correct any clerical error in the name, style, or address of the registered proprietor of a patent, design, or trade mark.

(c) Cancel the entry or part of the entry of a trade mark on the register: provided that the applicant accompanies his request by a statutory declaration made by himself, stating his name, address, and calling, and that he is the person whose name appears on the register as the proprietor of the said trade mark.

Alteration of registered mark.

92.—(1.) The registered proprietor of any registered trade mark may apply to the Court for leave to add to or alter such mark in any particular, not being an essential particular within the meaning of this Act, and the Court may refuse or grant leave on such terms as it may think fit.

(2.) Notice of any intended application to the Court under this section shall be given to the comptroller by the applicant; and the comptroller shall be entitled to be heard on the application.

(3.) If the Court grants leave, the comptroller shall, on proof thereof and on payment of the prescribed fee, cause the register to be altered in conformity with the order of leave.

Falsification of entries in registers.

93. If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

Exercise of discretionary power by comptroller.

94. Where any discretionary power is by this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a trade mark or design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard personally or by his agent.

Power of comptroller to take directions of law officers.

95. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to either of the law officers for directions in the matter.

Certificate of comptroller to be evidence.

96. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *primâ facie*

evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone.

Applications and notices by post.

97.—(1.) Any application, notice, or other document authorised or required to be left, made or given at the patent office or to the comptroller, or to any other person under this Act, may be sent by a prepaid letter through the post; and if so sent shall be deemed to have been left, made or given respectively at the time when the letter containing the same would be delivered in the ordinary course of post.

(2.) In proving such service or sending, it shall be sufficient to prove that the letter was properly addressed and put into the post.

Provision as to days for leaving documents at office.

98. Whenever the last day fixed by this Act, or by any rule for the time being in force, for leaving any document or paying any fee at the patent office shall fall on Christmas Day, Good Friday, or on a Saturday or Sunday, or any day observed as a holiday at the Bank of England, or any day observed as a day of public fast or thanksgiving, herein referred to as excluded days, it shall be lawful to leave such document or to pay such fee on the day next following such excluded day, or days if two or more of them occur consecutively.

Declaration by infant, lunatic, &c.

99. If any person is, by reason of infancy, lunacy or other inability, incapable of making any declaration or doing anything required or permitted by this Act or by any rules made under the authority of this Act, then the guardian or committee (if any) of such incapable person, or if there be none, any person appointed by any Court or judge possessing jurisdiction in respect of the property of incapable persons, upon the petition of any person on behalf of such incapable person, or of any other person interested in the making such declaration or doing such thing, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of such incapable person, and all acts done by such substitute shall for the purposes of this Act be as effectual as if done by the person for whom he is substituted.

Transmission of certified printed copies of specifications, &c.

100. Copies of all specifications, drawings, and amendments left at the patent office after the commencement of this Act, printed for and sealed with the seal of the patent office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after the same shall respectively have been accepted or allowed at the patent office; and certified copies of or extracts from any such documents shall be given to any person requiring the same on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Power for Board of Trade to make general rules for classifying goods and regulating business of patent office.

101.—(1.) The Board of Trade may from time to time make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(a) For regulating the practice of registration under this Act:

(b) For classifying goods for the purposes of designs and trade marks:

(c) For making or requiring duplicates of specifications, amendments, drawings, and other documents:

(d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, amendments and other documents:

(e) For securing and regulating the making, printing, publishing and selling of indexes to, and abridgments of, specifications and other documents in the patent office; and providing for the inspection of indexes and abridgments and other documents:

(f) For regulating (with the approval of the Treasury) the presentation of copies of patent office publications to patentees and to public authorities, bodies, and institutions at home and abroad:

(g) Generally for regulating the business of the patent office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2.) Any of the forms in the First Schedule to this Act may be altered or amended by rules made by the Board as aforesaid.

(3.) General rules may be made under this section at any time after the passing of this Act, but not so as to take effect before the commencement of this Act, and shall (subject as hereinafter mentioned) be of the same effect as if they were contained in this Act, and shall be judicially noticed.

(4.) Any rules made in pursuance of this section shall be laid before both Houses of Parliament, if Parliament be in session at the time of making thereof, or, if not, then as soon as practicable after the beginning of the then next session of Parliament, and they shall also be advertised twice in the official journal to be issued by the comptroller.

(5.) If either House of Parliament, within the next forty days after any rules have been so laid before such House, resolve that such rules or any of them ought to be annulled, the same shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under such rules or rule or to the making of any new rules or rule.

Annual reports of comptroller.

102. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which each report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act.

International and Colonial Arrangements.

International arrangements for protection of inventions, designs, and trade marks.

103.—(1.) If Her Majesty is pleased to make any arrangement with the government or governments of any foreign state or states for mutual protection of inventions, designs, and trade marks, or any of them, then any person who has applied for protection for any invention, design, or trade mark in any such state, shall be entitled to a patent for his invention or to registration of his design or trade mark (as the case may be) under this Act, in priority to other applicants; and such patent or registration shall have the same date as the date of the protection obtained in such foreign state.

Provided that his application is made, in the case of a patent within seven months, and in the case of a design or trade mark within four months, from his applying for protection in the foreign state with which the arrangement is in force.

Provided that nothing in this section contained shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the date of the actual acceptance of his complete specification, or the actual registration of his design or trade mark in this country, as the case may be.

(2.) The publication in the United Kingdom, or the Isle of Man during the respective periods aforesaid of any description of the invention, or the use therein during such periods of the invention, or the exhibition or use therein during such periods of the design, or the publication therein during such periods of a description or representation of the design, or the use therein during such periods of the trade mark, shall not invalidate the patent which may be granted for the invention, or the registration of the design or trade mark:

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act: Provided that, in the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under this Act:

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which Her Majesty shall from

time to time by Order in Council declare them to be applicable, and so long only in the case of each state as the Order in Council shall continue in force with respect to that state.

Provision for colonies and India.

104.—(1.) Where it is made to appear to Her Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for Her Majesty from time to time, by Order in Council, to apply the provisions of the last preceding section, with such variations or additions, if any, as to Her Majesty in Council may seem fit, to such British possession.

(2.) An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if its provisions had been contained in this Act; but it shall be lawful for Her Majesty in Council to revoke any Order in Council made under this Act.

Offences.

Penalty on falsely representing articles to be patented.

105.—(1.) Any person who represents that any article sold by him is a patented article, when no patent has been granted for the same, or describes any design or trade mark applied to any article sold by him as registered which is not so, shall be liable for every offence on summary conviction to a fine not exceeding five pounds.

(2.) A person shall be deemed, for the purposes of this enactment, to represent that an article is patented or a design or trade mark is registered, if he sells the article with the word "patent," "patented," "registered," or any word or words expressing or implying that a patent or registration has been obtained for the article stamped, engraved, or impressed on, or otherwise applied to, the article.

Penalty on unauthorised assumption of Royal Arms.

106. Any person who, without the authority of Her Majesty, or any of the Royal Family, or of any Government Department, assumes or uses in connection with any trade, business, calling, or profession, the Royal Arms, or arms so nearly resembling the same as to be calculated to deceive, in such a manner as to be calculated to lead other persons to believe that he is carrying on his trade, business, calling, or profession by or under such authority as aforesaid, shall be liable on summary conviction to a fine not exceeding twenty pounds.

Scotland; Ireland; &c.

107. [Relates only to patents.]

Summary proceedings in Scotland.

108. In Scotland any offence under this Act declared to be punishable on summary conviction may be prosecuted in the Sheriff Court.

109.—(1.) [Relates only to patents.]

(2.) Service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act.

110. [Relates only to patents.]

General saving for jurisdiction of Courts.

111.—(1.) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any Court in Scotland or Ireland in any proceedings relating to patents or to designs or to trade marks; and with reference to any such proceedings in Scotland, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of the said Court; and with reference to any such proceedings in Ireland, the terms "the Court" and "the Court of Appeal" respectively mean the High Court of Justice in Ireland and Her Majesty's Court of Appeal in Ireland.

(2.) If any rectification of a register under this Act is required in pursuance of any proceeding in a Court in Scotland or Ireland, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly.

Isle of Man.

112. This Act shall extend to the Isle of Man, and—

(1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man, in proceedings for infringement or in any action or proceeding respecting a patent, design, or trade mark competent to those Courts;

(2.) The punishment for a misdemeanor under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court;

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal; Transitional Provisions; Savings.

Repeal and saving for past operation of repealed enactments, &c.

113. The enactments described in the Third Schedule to this Act are hereby repealed. But this repeal of enactments shall not—

(a) Affect the past operation of any of those enactments, or any patent or copyright or right to use a trade mark granted or acquired, or application pending, or appointment made, or compensation granted, or order or direction made or given, or right, privilege, obligation, or liability acquired, accrued, or incurred, or anything duly done or suffered under or by any of those enactments before or at the commencement of this Act; or

(b) Interfere with the institution or prosecution of any action or proceeding, civil or criminal, in respect thereof, and any such proceeding may be carried on as if this Act had not been passed; or

(c) Take away or abridge any protection or benefit in relation to any such action or proceeding.

114.—(1.) [Relates only to patents.]

(2.) The registers of designs and of trade marks kept under any enactment repealed by this Act shall respectively be deemed parts of the same book as the register of designs and the register of trade marks kept under this Act. Former registers to be deemed continued.

115. All general rules made by the Lord Chancellor or by any other authority under any enactment repealed by this Act, and in force at the commencement of this Act, may at any time after the passing of this Act be repealed, altered or amended by the Board of Trade, as if they had been made by the Board under this Act, but so that no such repeal, alteration or amendment shall take effect before the commencement of this Act; and, subject as aforesaid, such general rules shall, so far as they are consistent with and are not superseded by this Act, continue in force as if they had been made by the Board of Trade under this Act. Saving for existing rules.

116. Nothing in this Act shall take away, abridge or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof. Saving for prerogative.

General Definitions.

117.—(1.) In and for the purposes of this Act, unless the context otherwise requires,— General definitions.

"Person" includes a body corporate:

"The Court" means (subject to the provisions for Scotland, Ireland, and the Isle of Man) Her Majesty's High Court of Justice in England:

"Law Officer" means Her Majesty's Attorney-General or Solicitor-General for England:

"The Treasury" means the Commissioners of Her Majesty's Treasury:

"Comptroller" means the Comptroller-General of Patents, Designs, and Trade Marks:

"Prescribed" means prescribed by any of the Schedules to this Act, or by general rules under or within the meaning of this Act:

"British possession" means any territory or place situate within Her Majesty's dominions, and not being or forming part of the United Kingdom, or of the Channel Islands, or of the Isle of Man, and all

territories and places under one legislature, as hereinafter defined, are deemed to be one British possession for the purposes of this Act:

"Legislature" includes any person or persons who exercise legislative authority in the British possession; and where there are local legislatures as well as a central legislature, means the central legislature only.

In the application of this Act to Ireland, "summary conviction" means a conviction under the Summary Jurisdiction Acts, that is to say, with reference to the Dublin Metropolitan Police District the Acts regulating the duties of justices of the peace and of the police for such district, and elsewhere in Ireland the Petty Sessions (Ireland) Act, 1851, and any Act amending it.

SCHEDULES.

The First Schedule.

[Relates only to patents.]

The Third Schedule.

[Contains the Statute 5 & 6 Vict. c. 100, and subsequent Statutes included in list of repealed Statutes, *ante*, p. 333.]

THE PATENTS, DESIGNS, AND TRADE MARKS (AMENDMENT) ACT, 1885.

(48 & 49 Vict. c. 63.)

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

[14th August, 1885.]

Be it enacted by the Queen's most excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Construction and short title.

1. This Act shall be construed as one with the Patents, Designs, and Trade Marks Act, 1883 (in this Act referred to as the principal Act).

This Act may be cited as the Patents, Designs, and Trade Marks (Amendment) Act, 1885, and this Act and the principal Act may be cited together as the Patents, Designs, and Trade Marks Acts, 1883 and 1885.

Amendment of s. 103 of 46 & 47 Vict. c. 57.

6. In sub-section one of section one hundred and three of the principal Act, the words "date of the application" shall be substituted for the words "date of the protection obtained."

PATENTS ACT, 1886.

(49 & 50 Vict. c. 37.)

An Act to remove certain doubts respecting the construction of the Patents, Designs, and Trade Marks Act, 1883, *so far as respects the drawings by which specifications are required to be accompanied, and as respects exhibitions.* [25th June, 1886.]

Short title and construction. 46 & 47 Vict. c. 57. 48 & 49 Vict., c. 63.

1. This Act may be cited as the Patents Act, 1886, and shall be construed as one with the Patents, Designs, and Trade Marks Acts, 1883 and 1885, and, together with those Acts, may be cited as the Patents, Designs, and Trade Marks Acts, 1883 to 1886.

Protection of patents and designs exhibited at international exhibitions.

3. Whereas by section thirty-nine of the Patents, Designs, and Trade Marks Act, 1883, as respects patents, and by section fifty-seven of the same Act as respects designs, provision is made that the exhibition of an invention or design at an industrial or international exhibition, certified as such by the Board of Trade, shall not prejudice the rights of the inventor or proprietor thereof, subject to the conditions therein mentioned, one of which is that the exhibitor must, before exhibiting the invention, design or article, or publishing a description of the design, give the controller the prescribed notice of his intention to do so:

And whereas it is expedient to provide for the extension of the said sections to industrial and international exhibitions held out of the United Kingdom, be it therefore enacted as follows:

It shall be lawful for her Majesty, by Order in Council, from time to time to declare that sections thirty-nine and fifty-seven of the Patents, Designs, and Trade Marks Act, 1883, or either of those sections, shall apply to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified by the Board of Trade, and to provide that the exhibitor shall be relieved from the conditions, specified in the said sections, of giving notice to the controller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as to her Majesty in Council may seem fit.

PATENTS, DESIGNS, AND TRADE MARKS ACT, 1888.

(51 & 52 Vict. c. 50.)

An Act to amend the Patents, Designs, and Trade Marks Act, 1883.

[24th December, 1888.]

46 & 47 Vict. c. 57.

WHEREAS it is expedient to amend the Patents, Designs, and Trade Marks Act, 1883, herein-after referred to as the principal Act:

Be it therefore enacted by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:

Register of patent agents

1.—(1.) After the first day of July one thousand eight hundred and eighty-nine a person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act.

(2.) The Board of Trade shall, as soon as may be after the passing of this Act, and may from time to time make such general rules as are in the opinion of the Board required for giving effect to this section, and the provisions of section one hundred and one of the principal Act shall apply to all rules so made as if they were made in pursuance of that section.

(3.) Provided that every person who proves to the satisfaction of the Board of Trade that prior to the passing of this Act he had been bonâ fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(4.) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on summary conviction to a fine not exceeding twenty pounds.

(5.) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

Sect. 52, as to inspection of designs.

6. After sub-section one of section fifty-two of the principal Act the following words shall be added; namely,

"Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered."

Sect. 58, as to piracy of registered designs.

7.—(1.) In section fifty-eight of the principal Act the words "or cause to be applied" shall be added after the word "apply."

(2.) To the same section the following words shall be added: "Provided that the total sum forfeited in respect of any one design shall not exceed one hundred pounds."

Sect. 87, as to entry of

21. In section eighty-seven of the principal Act, after the words

"subject to," shall be added the words "the provisions of this Act and to." assignments, &c.

22. In section eighty-eight of the principal Act, after the words "subject to," shall be added the words "the provisions of this Act and to." Sect. 88, as to inspection.

23. In section ninety of the principal Act, after the words "of the name of any person," shall be added the words "or of any other particulars." Sect. 90, as to rectification of register.

24. To section ninety-one of the principal Act the following subsection shall be added; namely, Sect. 91, as to correction of errors.

"(1) Permit an applicant for registration of a design or trade mark to amend his application by omitting any particular goods or classes of goods in connexion with which he has desired the design or trade mark to be registered."

25. After section one hundred and two of the principal Act the following section shall be added and numbered 102A; namely, Proceedings of Board of Trade.

"(1.) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the president or a secretary or an assistant secretary of the Board.

"(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the president of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

"(3.) A certificate, signed by the president of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified."

27. The principal Act shall, as from the commencement of this Act, take effect subject to the additions, omissions, and substitutions required by this Act, but nothing in this Act shall affect the validity of any act done, right acquired, or liability incurred before the commencement of this Act. Construction of principal Act.

28. This Act shall, except so far as is by this Act otherwise specially provided, commence and come into operation on the first day of January one thousand eight hundred and eighty-nine. Commencement of Act.

29. This Act may be cited as the Patents, Designs, and Trade Marks Act, 1888, and this Act and the Patents, Designs, and Trade Marks Acts, 1883 to 1886, may be cited collectively as the Patents, Designs, and Trade Marks Acts, 1883 to 1888. Short title.

PATENTS AND DESIGNS ACT, 1907.

(7 Edw. VII. c. 20.)

PART I.

Patents.

Revocation of patents worked outside the United Kingdom.

27.—(1.) At any time not less than four years after the date of a patent and not less than one year after the passing of this Act, any person may apply to the comptroller for the revocation of the patent on the ground that the patented article or process is manufactured or carried on exclusively or mainly outside the United Kingdom.

(2.) The comptroller shall consider the application, and, if after enquiry he is satisfied that the allegations contained therein are correct, then, subject to the provisions of this section, and unless the patentee proves that the patented article or process is manufactured or carried on to an adequate extent in the United Kingdom, or gives satisfactory reasons why the article or process is not so manufactured or carried on, the comptroller may make an order revoking the patent either—

(a) forthwith; or

(b) after such reasonable interval as may be specified in the order, unless in the meantime it is shown to his satisfaction that the patented article or process is manufactured or carried on within the United Kingdom to an adequate extent:

Provided that no such order shall be made which is at variance with any treaty, convention, arrangement, or engagement with any foreign country or British possession.

(3.) If within the time limited in the order the patented article or process is not manufactured or carried on within the United Kingdom to an adequate extent, but the patentee gives satisfactory reasons why it is not so manufactured or carried on, the comptroller may extend the period mentioned in the previous order for such period not exceeding twelve months as may be specified in the subsequent order.

(4.) Any decision of the comptroller under this section shall be subject to appeal to the Court, and on any such appeal the law officer or such other counsel as he may appoint shall be entitled to appear and be heard.

Certificate of validity questioned and costs thereon.

35. In an action for infringement of a patent, the Court may certify that the validity of the patent came in question; and, if the Court so certifies, then in any subsequent action for infringement the plaintiff in that action on obtaining a final order or judgment in his favour shall, unless the Court trying the action otherwise directs, have his full costs, charges, and expenses as between solicitor and client.

Remedy in case of groundless threats of legal proceedings.

38. 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 infringement of the patent, any person 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 he has sustained thereby, if the alleged infringement 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.

Costs and security for costs.

39.—(1.) The comptroller shall, in proceedings relating to an opposition to the grant of a patent or to an application for the amendment of a specification or the revocation of a patent, have power by order to award to any party such costs as he may consider reasonable, and to direct how and by what parties they are to be paid, and any such order may be made a rule of the Court.

(2.) If a party giving notice of opposition to the grant of a patent or to the amendment of a specification, or applying to the comptroller for the revocation of a patent, or giving notice of appeal from any decision of the comptroller, neither resides nor carries on business in the United Kingdom or the Isle of Man, the comptroller, or, in case of appeal to the law officer, the law officer may require such party to give security for costs of the proceedings or appeal, and in default of such security being given may treat the proceedings or appeal as abandoned.

PART II.

DESIGNS.

Registration of Designs.

Application for registration of designs.

49.—(1.) The comptroller may, on the application made in the prescribed form and manner of any person claiming to be the proprietor of any new or original design not previously published in the United Kingdom, register the design under this Part of this Act.

(2.) The same design may be registered in more than one class, and, in case of doubt as to the class in which a design ought to be registered, the comptroller may decide the question.

(3.) The comptroller may, if he thinks fit, refuse to register any design presented to him for registration, but any person aggrieved by any such refusal may appeal to the Board of Trade, and the Board shall, after hearing the applicant and the comptroller, if so required, make an order determining whether, and subject to what conditions, if any, registration is to be permitted.

(4.) An application which, owing to any default or neglect on the part of the applicant, has not been completed so as to enable registration to be effected within the prescribed time shall be deemed to be abandoned.

(5.) A design when registered shall be registered as of the date of the application for registration.

Registration of designs in new classes.

50. Where a design has been registered in one or more classes of goods the application of the proprietor of the design to register it in some one or more other classes shall not be refused, nor shall the registration thereof be invalidated—

(a) on the ground of the design not being a new and original design, by reason only that it was so previously registered; or

(b) on the ground of the design having been previously published in the United Kingdom, by reason only that it has been applied to goods of any class in which it was so previously registered.

Certificate of registration.

51.—(1.) The comptroller shall grant a certificate of registration to the proprietor of the design when registered.

(2.) The comptroller may, in case of loss of the original certificate, or in any other case in which he deems it expedient, furnish one or more copies of the certificate.

Register of designs.

52.—(1.) There shall be kept at the Patent Office a book called the Register of Designs wherein shall be entered the names and addresses of proprietors of registered designs, notifications of assignments and of transmissions of registered designs, and such other matters as may be prescribed.

(2.) The register of designs existing at the commencement of this Act shall be incorporated with and form part of the register of designs under this Act.

(3.) The register of designs shall be primâ facie evidence of any matters by this Act directed or authorised to be entered therein.

Copyright in Registered Designs.

Copyright on registration.

53.—(1.) When a design is registered, the registered proprietor of the design shall, subject to the provisions of this Act, have copyright in the design during five years from the date of registration.

(2.) If within the prescribed time before the expiration of the said five years application for the extension of the period of copyright is made to the comptroller in the prescribed manner, the comptroller shall on payment of the prescribed fee extend the period of copyright for a second period of five years from the expiration of the original period of five years.

(3.) If within the prescribed time before the expiration of such second period of five years application for the extension of the period of copyright is made to the comptroller in the prescribed manner, the comptroller may, subject to any rules under this Act, on payment of the prescribed fee, extend the period of copyright for a third period of five years from the expiration of the second period of five years.

Requirements before delivery on sale.

54.—(1.) Before delivery on sale of any articles to which a registered design has been applied, the proprietor shall—

(a) (if exact representations or specimens were not furnished on the application for registration), furnish to the comptroller the prescribed number of exact representations or specimens of the design; and if he fails to do so, the comptroller may erase his name from the register, and thereupon the copyright in the design shall cease; and

(b) cause each such article to be marked with the prescribed mark, or with the prescribed words or figures, denoting that the design is registered; and if he fails to do so the proprietor shall not be entitled to recover any penalty or damages in respect of any infringement of his copyright in the design unless he shows that he took all proper steps to ensure the marking of the article, or unless he shows that the infringement took place after the person guilty thereof knew or had received notice of the existence of the copyright in the design.

(2.) Where a representation is made to the Board of Trade by or on behalf of any trade or industry that in the interests of the trade or industry it is expedient to dispense with or modify as regards any class or description of articles any of the requirements of this section as to marking, the Board may, if they think fit, by rule under this Act dispense with or modify such requirements as regards any such class or description of articles to such extent and subject to such conditions as they think fit.

Effect of disclosure on copyright.

55. The disclosure of a design by the proprietor to any other person, in such circumstances as would make it contrary to good faith for that other person to use or publish the design, and the disclosure of a design in breach of good faith by any person other than the proprietor of the design, and the acceptance of a first and confidential order for

goods bearing a new or original textile design intended for registration, shall not be deemed to be a publication of the design sufficient to invalidate the copyright thereof if registration thereof is obtained subsequently to the disclosure or acceptance.

Inspection of registered designs.

56.—(1.) During the existence of copyright in a design, or such shorter period not being less than two years from the registration of the design as may be prescribed, the design shall not be open to inspection except by the proprietor or a person authorised in writing by him, or a person authorised by the comptroller or by the Court, and furnishing such information as may enable the comptroller to identify the design, and shall not be open to the inspection of any person except in the presence of the comptroller, or of an officer acting under him, and on payment of the prescribed fee; and the person making the inspection shall not be entitled to take any copy of the design, or of any part thereof:

Provided that where registration of a design is refused on the ground of identity with a design already registered, the applicant for registration shall be entitled to inspect the design so registered.

(2.) After the expiration of the copyright in a design, or such shorter period as aforesaid, the design shall be open to inspection, and copies thereof may be taken by any person on payment of the prescribed fee.

(3.) Different periods may be prescribed under this section for different classes of goods.

Information as to existence of copyright.

57. On the request of any person furnishing such information as may enable the comptroller to identify the design, and on payment of the prescribed fee, the comptroller shall inform such person whether the registration still exists in respect of the design, and if so, in respect of what classes of goods, and shall state the date of registration, and the name and address of the registered proprietor.

Cancellation of registration of designs used wholly or mainly abroad.

58.—(1.) At any time after the registration of a design any person may apply to the comptroller for the cancellation of the registration on the ground that the design is used for manufacture exclusively or mainly outside the United Kingdom, and where such an application is made the provisions of this Act with respect to the revocation of patents worked outside the United Kingdom (including those relating to costs) shall apply with the necessary modifications, except that there shall be no appeal from the decision of the comptroller.

(2.) Such ground as aforesaid shall be available by way of a defence to an action for infringement of the copyright in the design.

Industrial and International Exhibitions.

Provisions as to exhibitions.

59.—(1.) The exhibition at an industrial or international exhibition certified as such by the Board of Trade, or the exhibition elsewhere

during the period of the holding of the exhibition, without the privity or consent of the proprietor, of a design, or of any article to which a design is applied, or the publication, during the holding of any such exhibition, of a description of a design, shall not prevent the design from being registered, or invalidate the registration thereof: Provided that—

(a) The exhibitor, before exhibiting the design or article, or publishing a description of the design, gives the comptroller the prescribed notice of his intention to do so; and

(b) The application for registration is made before or within six months from the date of the opening of the exhibition.

(2.) His Majesty may, by Order in Council, apply this section to any exhibition mentioned in the Order in like manner as if it were an industrial or international exhibition certified as such by the Board of Trade, and any such Order may provide that the exhibitor shall be relieved from the condition of giving notice to the comptroller of his intention to exhibit, and shall be so relieved either absolutely or upon such terms and conditions as may be stated in the order.

Legal Proceedings.

Piracy of registered design.

60.—(1.) During the existence of copyright in any design it shall not be lawful for any person—

(a) For the purposes of sale to apply or cause to be applied to any article in any class of goods in which the design is registered the design or any fraudulent or obvious imitation thereof, except with the license or written consent of the registered proprietor, or to do anything with a view to enable the design to be so applied; or

(b) Knowing that the design or any fraudulent or obvious imitation thereof has been applied to any article without the consent of the registered proprietor to publish or expose or cause to be published or exposed for sale that article.

(2.) If any person acts in contravention of this section he shall be liable for every contravention to pay to the registered proprietor of the design a sum not exceeding fifty pounds, recoverable as a simple contract debt, or if the proprietor elects to bring an action for the recovery of damages for such contravention, and for an injunction against the repetition thereof, he shall be liable to pay such damages as may be awarded and to be restrained by injunction accordingly:

Provided that the total sum recoverable as a simple contract debt in respect of any one design shall not exceed one hundred pounds.

Application of certain provisions of

61. The provisions of this Act with regard to certificates of the validity of a patent, and to the remedy in case of groundless threats of

the Act as to patents to designs.

legal proceedings by a patentee shall apply in the case of registered designs in like manner as they apply in the case of patents, with the substitution of references to the copyright in a design for references to a patent, and of references to the proprietor of a design for references to the patentee, and of references to the design for references to the invention.

PART III.

GENERAL.

Patent Office and Proceedings thereat.

Patent Office. 5 Edw. 7, c. 15.

62.—(1.) The Treasury may continue to provide for the purposes of this Act and the Trade Marks Act, 1905, an office with all requisite buildings and conveniences, which shall be called, and is in this Act referred to as, the Patent Office.

(2.) The Patent Office shall be under the immediate control of the comptroller, who shall act under the superintendence and direction of the Board of Trade.

(3.) Any act or thing directed to be done by or to the comptroller may be done by or to any officer authorised by the Board of Trade.

(4.) Rules under this Act may provide for the establishment of branch offices for designs at Manchester or elsewhere, and for any document or thing required by this Act to be sent to or done at the Patent Office being sent to or done at any branch office which may be established.

Officers and clerks.

63.—(1.) There shall continue to be a comptroller-general of patents, designs, and trade marks, and the Board of Trade may, subject to the approval of the Treasury, appoint the comptroller, and so many examiners and other officers and clerks, with such designations and duties as the Board of Trade think fit, and may remove any of those officers and clerks.

(2.) The salaries of those officers and clerks shall be appointed by the Board of Trade, with the concurrence of the Treasury, and those salaries and the other expenses of the execution of this Act and the Trade Marks Act, 1905, shall continue to be paid out of money provided by Parliament.

Seal of Patent Office.

64. Impressions of the seal of the Patent Office shall be judicially noticed and admitted in evidence.

Fees.

Fees.

65. There shall be paid in respect of the grant of patents and the registration of designs, and applications therefor, and in respect of other matters with relation to patents and designs under this Act, such fees as may be, with the sanction of the Treasury, prescribed by the

Board of Trade, so however that the fees prescribed in respect of the instruments and matters mentioned in the First Schedule to this Act shall not exceed those specified in that Schedule.

Provisions as to Registers and other Documents in Patent Office.

Trust not to be entered in registers.

66. There shall not be entered in any register kept under this Act, or be receivable by the comptroller, any notice of any trust expressed implied or constructive.

Inspection of and extracts from registers.

67. Every register kept under this Act shall at all convenient times be open to the inspection of the public, subject to the provisions of this Act and to such regulations as may be prescribed; and certified copies, sealed with the seal of the Patent Office, of any entry in any such register shall be given to any person requiring the same on payment of the prescribed fee.

Privilege of reports of examiners.

68. Reports of examiners made under this Act 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 certifies that such production or inspection is desirable in the interests of justice, and ought to be allowed.

Prohibition of publication of specification, drawings, &c. where *application* abandoned, &c.

69.—(1.) Where an application for a patent has been abandoned, or become void, the specifications and drawings (if any) accompanying or left in connexion with such application, shall not, save as otherwise expressly provided by this Act, at any time be open to public inspection or be published by the comptroller.

(2.) Where an application for a design has been abandoned or refused the application and any drawings, photographs, tracings, representations, or specimens left in connexion with the application shall not at any time be open to public inspection or be published by the comptroller.

Power for comptroller to correct clerical errors.

70. The comptroller may, on request in writing accompanied by the prescribed fee,—

(a) correct any clerical error in or in connexion with an application for a patent or in any patent or any specification;

(b) cancel the registration of a design either wholly or in respect of any particular goods in connexion with which the design is registered;

(c) correct any clerical error in the representation of a design or in the name or address of the proprietor of any patent or design, or in any other matter which is entered upon the register of patents or the register of designs.

Entry of assignments and trans-

71.—(1.) Where a person becomes entitled by assignment, transmission, or other operation of law to a patent, or to the copyright in a

missions in registers.

registered design, the comptroller shall, on request and on proof of title to his satisfaction, register him as the proprietor of a patent or design.

(2.) Where any person becomes entitled as mortgagee, licensee, or otherwise to any interest in a patent or design, the comptroller shall, on request and on proof of title to his satisfaction, cause notice of the interest to be entered in the prescribed manner in the register of patents or designs, as the case may be.

(3.) The person registered as the proprietor of a patent or design shall, subject to the provisions of this Act and to any rights appearing from the register to be vested in any other person, have power absolutely to assign, grant licenses as to, or otherwise deal with, the patent or design and to give effectual receipts for any consideration for any such assignment, license, or dealing: Provided that any equities in respect of the patent or design may be enforced in like manner as in respect of any other personal property.

Rectification of registers by Court.

72.—(1.) The Court may, on the application in the prescribed manner of any person aggrieved by the non-insertion in or omission from the register of patents or designs of any entry, or by any entry made in either such register without sufficient cause, or by any entry wrongly remaining on either such register, or by an error or defect in any entry in either such register, make such order for making, expunging, or varying such entry as it may think fit.

(2.) The Court may in any proceeding under this section decide any question that it may be necessary or expedient to decide in connexion with the rectification of a register.

(3.) The prescribed notice of any application under this section shall be given to the comptroller, who shall have the right to appear and be heard thereon, and shall appear if so directed by the Court.

(4.) Any order of the Court rectifying a register shall direct that notice of the rectification be served on the comptroller in the prescribed manner, who shall upon the receipt of such notice rectify the register accordingly.

Powers and Duties of Comptroller.

Exercise of discretionary power by comptroller.

73. Where any discretionary power is by or under this Act given to the comptroller, he shall not exercise that power adversely to the applicant for a patent, or for amendment of a specification, or for registration of a design, without (if so required within the prescribed time by the applicant) giving the applicant an opportunity of being heard.

Power of comptroller to take directions of law officers.

74. The comptroller may, in any case of doubt or difficulty arising in the administration of any of the provisions of this Act, apply to a law officer for directions in the matter.

75. The comptroller may refuse to grant a patent for an invention, or to register a design, of which the use would, in his opinion, be contrary to law or morality. Refusal to grant patent, &c. in certain cases.

76. The comptroller shall, before the first day of June in every year, cause a report respecting the execution by or under him of this Act to be laid before both Houses of Parliament, and therein shall include for the year to which the report relates all general rules made in that year under or for the purposes of this Act, and an account of all fees, salaries, and allowances, and other money received and paid under this Act. Annual reports of comptroller.

Evidence, &c.

77.—(1.) Subject to rules under this Act in any proceeding under this Act before the comptroller the evidence shall be given by statutory declaration in the absence of directions to the contrary; but in any case in which the comptroller thinks it right so to do, he may take evidence *viva voce* in lieu of or in addition to evidence by declaration or allow any declarant to be cross-examined on his declaration. Any such statutory declaration may in the case of appeal be used before the Court in lieu of evidence of affidavit, but if so used shall have all the incidents and consequences of evidence by affidavit. Evidence before comptroller.

(2.) In case any part of the evidence is taken *viva voce*, the comptroller shall, in respect of requiring the attendance of witnesses and taking evidence on oath, be in the same position in all respects as an official referee of the Supreme Court.

78. A certificate purporting to be under the hand of the comptroller as to any entry, matter, or thing which he is authorised by this Act, or any general rules made thereunder, to make or do, shall be *primâ facie* evidence of the entry having been made, and of the contents thereof, and of the matter or thing having been done or left undone. Certificate of comptroller to be evidence.

79. Printed or written copies or extracts, purporting to be certified by the comptroller and sealed with the seal of the Patent Office, of or from patents, specifications, and other documents in the Patent Office, and of or from registers and other books kept there, shall be admitted in evidence in all Courts in His Majesty's dominions, and in all proceedings, without further proof or production of the originals. Evidence of documents in Patent Office.

80.—(1.) Copies of all specifications, drawings, and amendments left at the Patent Office after the commencement of this Act, printed for and sealed with the seal of the Patent Office, shall be transmitted to the Edinburgh Museum of Science and Art, and to the Enrolments Office of the Chancery Division in Ireland, and to the Rolls Office in the Isle of Man, within twenty-one days after they have been accepted or allowed at the Patent Office. Transmission of certified printed copies of specifications, &c.

(2.) Certified copies of or extracts from any such documents and of any documents so transmitted in pursuance of any enactment repealed by this Act shall be given to any person on payment of the prescribed fee; and any such copy or extract shall be admitted in evidence in all Courts in Scotland and Ireland and in the Isle of Man without further proof or production of the originals.

Applications and notices by post.

81. Any application, notice, or other document authorised or required to be left, made, or given at the Patent Office or to the comptroller, or to any other person under this Act, may be sent by post.

Excluded days.

82. Where the last day fixed by this Act for doing anything under this Act falls on any day specified in rules under this Act as an excluded day, the rules may provide for the thing being done on the next following day not being an excluded day.

Declaration by infant, lunatic, &c.

83.—(1.) If any person is, by reason of infancy, lunacy, or other disability, incapable of making any declaration or doing anything required or permitted by or under this Act, the guardian or committee (if any) of the person subject to the disability, or, if there be none, any person appointed by any Court possessing jurisdiction in respect of his property, may make such declaration or a declaration as nearly corresponding thereto as circumstances permit, and do such thing in the name and on behalf of the person subject to the disability.

(2.) An appointment may be made by the Court for the purposes of this section upon the petition of any person acting on behalf of the person subject to the disability or of any other person interested in the making of the declaration or the doing of the thing.

Register of Patent Agents.

Register of patent agents.

84.—(1.) A person shall not be entitled to describe himself as a patent agent, whether by advertisement, by description on his place of business, by any document issued by him, or otherwise, unless he is registered as a patent agent in pursuance of this Act or an Act repealed by this Act.

(2.) Every person who proves to the satisfaction of the Board of Trade that prior to the twenty-fourth day of December, one thousand eight hundred and eighty-eight, he had been bonâ fide practising as a patent agent shall be entitled to be registered as a patent agent in pursuance of this Act.

(3.) If any person knowingly describes himself as a patent agent in contravention of this section he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

(4.) In this section "patent agent" means exclusively an agent for obtaining patents in the United Kingdom.

Agents for patents.

85.—(1.) Rules under this Act may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any person whose name has been erased from the register of patent agents, or who is proved to the satisfaction of the Board of Trade, after being given an opportunity of being heard, to have been convicted of such an offence or to have been guilty of such misconduct as would have rendered him liable, if his name had been on the register of patent agents, to have his name erased therefrom, and may authorise the comptroller to refuse to recognise as agent in respect of any business under this Act any company which, if it had been an individual, the comptroller could refuse to recognise as such agent.

(2.) Where a company or firm acts as agents, such rules as aforesaid may authorise the comptroller to refuse to recognise the company or firm as agent if any person whom the comptroller could refuse to recognise as an agent acts as director or manager of the company or is a partner in the firm.

(3.) The comptroller shall refuse to recognise as agent in respect of any business under this Act any person who neither resides nor has a place of business in the United Kingdom or the Isle of Man.

Powers, &c. of Board of Trade.

Power for Board of Trade to make general rules.

86.—(1.) The Board of Trade may make such general rules and do such things as they think expedient, subject to the provisions of this Act—

(a) For regulating the practice of registration under this Act:

(b) For classifying goods for the purposes of designs:

(c) For making or requiring duplicates of specifications, drawings, and other documents:

(d) For securing and regulating the publishing and selling of copies, at such prices and in such manner as the Board of Trade think fit, of specifications, drawings, and other documents:

(e) For securing and regulating the making, printing, publishing, and selling of indexes to, and abridgments of, specifications and other documents in the Patent Office; and providing for the inspection of indexes and abridgments and other documents:

(f) For regulating (with the approval of the Treasury) the presentation of copies of Patent Office publications to patentees and to public authorities, bodies, and institutions at home and abroad:

(g) For regulating the keeping of the register of patent agents under this Act:

(h) Generally for regulating the business of the Patent Office, and all things by this Act placed under the direction or control of the comptroller, or of the Board of Trade.

(2.) General rules shall whilst in force be of the same effect as if they were contained in this Act.

(3.) Any rules made in pursuance of this section shall be advertised twice in the official journal to be issued by the comptroller, and shall be laid before both Houses of Parliament as soon as practicable after they are made, and if either House of Parliament, within the next forty days after any rules have been so laid before that House, resolves that the rules or any of them ought to be annulled, the rules or those to which the resolution applies shall after the date of such resolution be of no effect, without prejudice to the validity of anything done in the meantime under the rules or to the making of any new rules.

Proceedings of the Board of Trade.

87.—(1.) All things required or authorised under this Act to be done by, to, or before the Board of Trade, may be done by, to, or before the President or a secretary or an assistant secretary of the Board.

(2.) All documents purporting to be orders made by the Board of Trade and to be sealed with the seal of the Board, or to be signed by a secretary or assistant secretary of the Board, or by any person authorised in that behalf by the President of the Board, shall be received in evidence, and shall be deemed to be such orders without further proof, unless the contrary is shown.

(3.) A certificate, signed by the President of the Board of Trade, that any order made or act done is the order or act of the Board, shall be conclusive evidence of the fact so certified.

Provision as to Order in Council.

88. An Order in Council under this Act shall, from a date to be mentioned for the purpose in the Order, take effect as if it had been contained in this Act; but may be revoked or varied by a subsequent Order.

Offences.

Offences.

89.—(1.) If any person makes or causes to be made a false entry in any register kept under this Act, or a writing falsely purporting to be a copy of an entry in any such register, or produces or tenders or causes to be produced or tendered in evidence any such writing, knowing the entry or writing to be false, he shall be guilty of a misdemeanor.

(2.) If any person falsely represents that any article sold by him is a patented article, or falsely describes any design applied to any article sold by him as registered he shall be liable for every offence,

on conviction under the Summary Jurisdiction Acts, to a fine not exceeding five pounds.

(3.) If any person sells an article having stamped, engraved, or impressed thereon or otherwise applied thereto the word "patent," "patented," "registered," or any other word expressing or implying that the article is patented or that the design applied thereto is registered, he shall be deemed for the purposes of this section to represent that the article is a patented article or that the design applied thereto is a registered design.

(4.) Any person who, after the copyright in a design has expired, puts or causes to be put on any article to which the design has been applied the word "registered," or any word or words implying that there is a subsisting copyright in the design, shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding five pounds.

(5.) If any person uses on his place of business, or on any document issued by him, or otherwise, the words "Patent Office," or any other words suggesting that his place of business is officially connected with, or is, the Patent Office, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

90.—(1.) The grant of a patent under this Act shall not be deemed to authorise the patentee to use the Royal Arms or to place the Royal Arms on any patented article.

Unauthorised assumption of Royal Arms.

(2.) If any person, without the authority of His Majesty, uses in connection with any business, trade, calling or profession the Royal Arms (or arms so nearly resembling them as to be calculated to deceive) in such manner as to be calculated to lead to the belief that he is duly authorised to use the Royal Arms, he shall be liable on conviction under the Summary Jurisdiction Acts to a fine not exceeding twenty pounds.

Provided that nothing in this section shall be construed as affecting the right, if any, of the proprietor of a trade mark containing such arms to continue to use such trade mark.

International and Colonial Arrangements.

International and Colonial arrangements.

91.—(1.) If His Majesty is pleased to make any arrangement with the government of any foreign state for mutual protection of inventions, or designs, or trade marks, then any person who has applied for protection for any invention, design, or trade mark in that state shall be entitled to a patent for his invention or to registration of his design or trade mark under this Act or the Trade Marks Act, 1905, in priority to other applicants; and the patent or registration shall have the same date as the date of the application in the foreign state.

Provided that—

(a) The application is made, in the case of a patent within twelve months, and in the case of a design or trade mark within four months from the application for protection in the foreign state; and

(b) Nothing in this section shall entitle the patentee or proprietor of the design or trade mark to recover damages for infringements happening prior to the actual date on which his complete specification is accepted, or his design or trade mark is registered, in this country.

(2.) The patent granted for the invention or the registration of a design or trade mark shall not be invalidated—

(a) in the case of a patent, by reason only of the publication of a description of, or use of, the invention; or

(b) in the case of a design, by reason only of the exhibition or use of, or the publication of a description or representation of, the design; or

(c) in the case of a trade mark, by reason only of the use of the trade mark,

in the United Kingdom or the Isle of Man during the period specified in this section as that within which the application may be made.

(3.) The application for the grant of a patent, or the registration of a design, or the registration of a trade mark under this section, must be made in the same manner as an ordinary application under this Act or the Trade Marks Act, 1905: Provided that—

(a) In the case of patents the application shall be accompanied by a complete specification, which, if it is not accepted within the twelve months from the application for protection in the foreign state, shall with the drawings (if any) be open to public inspection at the expiration of that period; and

(b) In the case of trade marks, any trade mark the registration of which has been duly applied for in the country of origin may be registered under the Trade Marks Act, 1905.

(4.) The provisions of this section shall apply only in the case of those foreign states with respect to which His Majesty by Order in Council declares them to be applicable, and so long only in the case of each state as the Order in Council continues in force with respect to that state.

(5.) Where it is made to appear to His Majesty that the legislature of any British possession has made satisfactory provision for the protection of inventions, designs, and trade marks, patented or registered in this country, it shall be lawful for His Majesty, by Order in Council, to apply the provisions of this section to that possession,

with such variations or additions, if any, as may be stated in the Order.

Definitions.

Provisions as to "the Court."

92.—(1.) In this Act, unless the context otherwise requires, "the Court" means, subject to the provisions as to Scotland, Ireland, and the Isle of Man, the High Court in England.

(2.) Where by virtue of this Act a decision of the comptroller is subject to an appeal to the Court, or a petition may be referred or presented to the Court, the appeal shall, subject to and in accordance with Rules of the Supreme Court, be made and the petition referred or presented to such judge of the High Court as the Lord Chancellor may select for the purpose, and the decision of that judge shall be final, except in the case of an appeal from a decision of the comptroller revoking a patent on any ground on which the grant of such patent might have been opposed.

Definitions.

93. In this Act, unless the context otherwise requires,—

"Law officer" means the Attorney-General or Solicitor-General for England:

"Prescribed" means prescribed by general rules under this Act;

"British possession" does not include the Isle of Man or the Channel Islands:

"Patent" means letters patent for an invention:

"Patentee" means the person for the time being entitled to the benefit of a patent:

"Invention" means any manner of new manufacture the subject of letters patent and grant of privileges within section six of the Statute of Monopolies (that is, the Act of the twenty-first year of the reign of King James the First, chapter three, intituled "An Act concerning monopolies and dispensations with penal laws and the forfeiture thereof"), and includes an alleged invention:

"Inventor" and "applicant" shall, subject to the provisions of this Act, include the legal representative of a deceased inventor or applicant:

"Design" means any design (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act, 1814) applicable to any article, whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means

54 Geo. 3, c. 56.

whatever, manual, mechanical, or chemical, separate or combined:

"Article" means (as respects designs) any article of manufacture and any substance artificial or natural, or partly artificial and partly natural:

"Copyright" means the exclusive right to apply a design to any article in any class in which the design is registered:

"Proprietor of a new and original design,"—

(a) Where the author of the design, for good consideration, executes the work for some other person, means the person for whom the design is so executed; and

(b) Where any person acquires the design or the right to apply the design to any article, either exclusively of any other person or otherwise, means, in the respect and to the extent in and to which the design or right has been so acquired, the person by whom the design or right is so acquired; and

(c) In any other case, means the author of the design;

and where the property in, or the right to apply, the design has devolved from the original proprietor upon any other person, includes that other person.

Application to Scotland, Ireland, and the Isle of Man.

Application to Scotland.

94. In the application of this Act to Scotland—

(1.) In any action for infringement of a patent in Scotland the provisions of this Act with respect to calling in the aid of an assessor shall apply, and the action shall be tried without a jury, unless the Court otherwise direct, but otherwise nothing shall affect the jurisdiction and forms of process of the courts in Scotland in such an action or in any action or proceeding respecting a patent hitherto competent to those courts; and for the purposes of the provisions so applied "court of appeal" shall mean any court to which such action is appealed:

(2.) Any offence under this Act declared to be punishable on conviction under the Summary Jurisdiction Acts may be prosecuted in the sheriff court:

(3.) Proceedings 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 service of all writs and summonses in that action shall be made according to the forms and practice existing at the commencement of this Act:

(4.) The provisions of this Act conferring a special jurisdiction on the Court as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Scotland in any proceedings relating to patents or to designs; and with reference to any such proceedings, the term "the Court" shall mean any Lord Ordinary of the Court of Session, and the term "Court of Appeal" shall mean either Division of that Court:

(5.) Notwithstanding anything in this Act, the expression "the Court" shall, as respects petitions for compulsory licenses or revocation which are referred by the Board of Trade to the Court in Scotland, mean any Lord Ordinary of the Court of Session, and shall in reference to proceedings in Scotland for the extension of the term of a patent mean such Lord Ordinary:

(6.) The expression "Rules of the Supreme Court" shall, except in section ninety-two of this Act, mean act of sederunt:

(7.) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for the rectification, shall be served on the comptroller, and he shall rectify the register accordingly:

(8.) The expression "injunction" means "interdict."

95. In the application of this Act to Ireland— *Application to Ireland.*

(1.) 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:

(2.) The provisions of this Act conferring a special jurisdiction on the Court, as defined by this Act, shall not, except so far as the jurisdiction extends, affect the jurisdiction of any court in Ireland in any proceedings relating to patents or to designs; and with reference to any such proceedings the term "the Court" means the High Court in Ireland:

(3.) If any rectification of a register under this Act is required in pursuance of any proceeding in a court, a copy of the order, decree, or other authority for the rectification shall be served on the comptroller, and he shall rectify the register accordingly.

96. This Act shall extend to the Isle of Man, subject to the following modifications: — Isle of Man.

(1.) Nothing in this Act shall affect the jurisdiction of the Courts in the Isle of Man in proceedings for infringement, or in any action or proceeding respecting a patent or design competent to those Courts:

(2.) The punishment for a misdemeanour under this Act in the Isle of Man shall be imprisonment for any term not exceeding two years, with or without hard labour, and with or without a fine not exceeding one hundred pounds, at the discretion of the Court:

(3.) Any offence under this Act committed in the Isle of Man which would in England be punishable on summary conviction may be prosecuted, and any fine in respect thereof recovered, at the instance of any person aggrieved, in the manner in which offences punishable on summary conviction may for the time being be prosecuted.

Repeal, Savings, and Short Title.

Saving for prerogative.

97. Nothing in this Act shall take away, abridge, or prejudicially affect the prerogative of the Crown in relation to the granting of any letters patent or to the withholding of a grant thereof.

Repeal and savings.

98.— (1.) The enactments mentioned in the Second Schedule to this Act are hereby repealed to the extent specified in the third column of that schedule—

(a) As respects the enactments mentioned in Part I. of that Schedule, as from the commencement of this Act;

(b) As respects the enactments mentioned in Part II. of that Schedule, as from the date when Rules of the Supreme Court regulating the matters dealt with in those enactments come into operation;

(c) As respects the enactments mentioned in Part III. of that Schedule, as from the date when rules under this Act regulating the matters dealt with in those enactments come into operation;

and the enactments mentioned in Part II. and Part III. of that Schedule shall, until so repealed, have effect as if they formed part of this Act:

Provided that this repeal shall not affect any convention, Order in Council, rule, or table of fees having effect under any enactment so repealed, but any such convention, Order in Council, rule, or table of fees in force at the commencement of this Act shall continue in force, and may be repealed, altered or amended, as if it had been made under this Act.

(2.) Except where otherwise expressly provided, this Act shall extend to all patents granted and all designs registered before the commencement of this Act, and to applications then pending, in substitution for such enactments as would have applied thereto if this Act had not been passed.

Short title and commencement.

99. This Act may be cited as the Patents and Designs Act, 1907, and shall, save as otherwise expressly provided, come into operation on the first day of January one thousand nine hundred and eight.

FIRST SCHEDULE. (Fees on obtaining Patents and Renewals.)

SECOND SCHEDULE. (Enactments repealed. See *ante*, p. 288.)

INTERPRETATION ACT, 1889.

(52 & 53 Vict. c. 63.)

An Act for consolidating enactments relating to the Construction of Acts of Parliament and for further shortening the Language used in Acts of Parliament. [30th August, 1889.]

Rules as to gender and number.

1.—(1.) In this Act and in every Act passed after the year one thousand eight hundred and fifty, whether before or after the commencement of this Act, unless the contrary intention appears,—

(a) words importing the masculine gender shall include females; and

(b) words in the singular shall include the plural, and words in the plural shall include the singular.

Application of penal Acts to bodies corporate.

2.—(1.) In the construction of every enactment relating to an offence punishable on indictment or on summary conviction, whether contained in an Act passed before or after the commencement of this Act, the expression "person" shall, unless the contrary intention appears, include a body corporate.

(2.) Where under any Act, whether passed before or after the commencement of this Act, any forfeiture or penalty is payable to a party aggrieved, it shall be payable to a body corporate in every case where that body is the party aggrieved.

Meanings of certain words in Acts since 1850.

3. The expression "month" shall mean calendar month.

The expression "land" shall include messuages, tenements, and hereditaments, houses, and buildings of any tenure.

The expressions "oath" and "affidavit" shall, in the case of persons for the time being allowed by law to affirm or declare instead of swearing, include affirmation and declaration, and the expression "swear" shall, in the like case, include affirm and declare.

Judicial definitions in past and future Acts.

13. In this Act and in every other Act whether passed before or after the commencement of this Act, the following expressions shall, unless the contrary intention appears, have the meanings hereby respectively assigned to them, namely:—

(10.) The expression "the Summary Jurisdiction Acts" when used in relation to England or Wales shall mean the Summary Jurisdiction (England) Acts, and when used in relation to Scotland the Summary Jurisdiction (Scotland) Acts, and when used in relation to Ireland the Summary Jurisdiction (Ireland) Acts.

(11.) The expression "Court of summary jurisdiction" shall mean any justice or justices of the peace, or other magistrate, by whatever name called, to whom jurisdiction is given by, or who is authorised to act under, the Summary Jurisdiction Acts, whether in England, Wales, or Ireland, and whether acting under the Summary Jurisdiction Acts or any of them, or under any other Act, or by virtue of his commission, or under the common law.

Geographical and colonial definitions in future Acts.

18. In this Act, and in every Act passed after the commencement of this Act, the following expressions shall, unless the contrary intention appears, have the meanings hereby respectively assigned to them, namely:—

(1.) The expression "British Islands" shall mean the United Kingdom, the Channel Islands, and the Isle of Man.

(2.) The expression "British possession" shall mean any part of Her Majesty's dominions exclusive of the United Kingdom, and where parts of such dominions are under both a central and a local legislature, all parts under the central legislature shall, for the purposes of this definition, be deemed to be one British possession.

(3.) The expression "colony" shall mean any part of Her Majesty's dominions exclusive of the British Islands, and of British India, and where parts of such dominions are under both a central and a local legislature, all parts under the central legislature shall, for the purposes of this definition, be deemed to be one colony.

Meaning of "person" in future Acts.

19. In this Act and in every Act passed after the commencement of this Act the expression "person" shall, unless the contrary intention appears, include any body of persons corporate or unincorporate.

Construction of statutory rules, &c.

31. Where any Act, whether passed before or after the commencement of this Act, confers power to make, grant, or issue any instrument, that is to say, any Order in Council, order, warrant, scheme, letters patent, rules, regulations, or byelaws, expressions used in the instrument, if it is made after the commencement of this Act, shall, unless the contrary intention appears, have the same respective meanings as in the Act conferring the power.

Effect of repeal in future Acts.

38.—(1.) Where this Act or any Act passed after the commencement of this Act repeals and re-enacts, with or without modification, any provisions of a former Act, references in any other Act to the provisions so repealed, shall, unless the contrary intention appears, be construed as references to the provisions so re-enacted.

(2.) Where this Act or any Act passed after the commencement of this Act repeals any other enactment, then, unless the contrary intention appears, the repeal shall not—

(a) revive anything not in force or existing at the time at which the repeal takes effect; or,

(b) affect the previous operation of any enactment so repealed or anything duly done or suffered under any enactment so repealed; or

(c) affect any right, privilege, obligation, or liability acquired, accrued, or incurred under any enactment so repealed; or

(d) affect any penalty, forfeiture, or punishment incurred in respect of any offence committed against any enactment so repealed; or

(e) affect any investigation, legal proceeding, or remedy in respect of any such right, privilege, obligation, liability, penalty, forfeiture, or punishment as aforesaid;

and any such investigation, legal proceeding, or remedy may be instituted, continued, or enforced, and any such penalty, forfeiture, or punishment may be imposed, as if the repealing Act had not been passed.

APPENDIX B.—FORMS.

I. Those prescribed by the Designs Rules, 1908.

No. of Form.	Subject.	Page.	No. of Fee in Sched. I. (*ante*, pp. 818—820).
1	Authorisation	374	—
2	Application for registration of design, not being lace and except articles in Classes 13 to 15	374	1
3	Application for registration of set of designs, not being lace	375	2
4	Application for registration of a design to be applied to lace	375	3
5	Application for registration of design to be applied to a set of lace articles	376	4
6	Application for entry of address for service in Register	376	13
7	Request for statement of grounds of decision under Rule 33	377	6
D. C. No. 1	Certificate of registration	377	—
8	Extension of copyright for second period	378	7
9	Application for extension of copyright for third period	378	8
10	Extension of copyright for third period	379	9
11	Joint request by registered proprietor and assignee, &c., to enter the name of assignee, &c. in the Register	379	10
12	Joint request by registered proprietor and assignee of design in Class 9 to enter the name of assignee in the Register	380	10
13	Request to enter name of subsequent proprietor, &c. in the Register under Rule 44	380	11
14	Form of declaration in support of statement of case accompanying Form Designs No. 13	381	—
15	Form of application under Rule 49 to vacate entry of name of mortgagee or licensee in Register	381	12
16	Form of application for alteration of address or address for service in Register	382	13
17	Form of request for correction of clerical error in application to register, or for correction of clerical error under section 70	382	14
18	Form of application by registered proprietor to cancel entry in Register	383	15
19	Request for search under section 57 when registration number is supplied	383	16
20	Request for search under section 57 when registration number is not supplied	384	17
21	Request for search under Rule 60	384	18
22	Request for certificate for use in legal proceedings or other special purpose	385	19
23	Request for cancellation of registration under section 58.	385	20
24	Notice of intended exhibition of an unregistered design	386	21
Man'ster, No. 1	Application for registration of design in Class 13 or Class 14	386	5
,, No. 2	Application for registration of a design in Class 15	387	3
,, No. 3	Notice to Keeper under Rule 87	388	22
25	Appeal from Comptroller to the Board of Trade	388	23
26	Request for the Register to be altered in pursuance of an Order of the Court	389	24
27	Application for copy of certificate of registration	389	25

FORM DESIGNS No. 1.

PATENTS AND DESIGNS ACT, 1907.

FORM of AUTHORISATION.

I have appointed (*a*) —— of —— to act as my agent for (*b*) ——.

(*c*) ——.

Address ——.

Dated this —— day of —— 19—.

To the Comptroller,
The Patent Office, Designs Branch,
25, Southampton Buildings, Chancery Lane,
London, W.C.

(*a*) Here insert name and address of agent.
(*b*) Here state the particular purpose for which the agent is appointed.
(*c*) To be signed by the person appointing the agent.

FORM DESIGNS No. 2.

PATENTS AND DESIGNS ACT, 1907.

[DESIGNS. 5s.]

APPLICATION FOR REGISTRATION OF DESIGN (NOT BEING LACE AND EXCEPT ARTICLES IN CLASSES 13 TO 15).

You are hereby requested to register the accompanying design in Class ——, in the name of (*a*) —— of —— who claims to be the proprietor thereof.

The design is to be applied to ——.

(Signed) ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form No. 1).

N.B.—THREE exactly similar representations or specimens of the design should accompany this Form.

This corresponds with the Form E. under the old Rules, but omits the important requirement therein, "Statement of nature of design," with the accompanying note running, "such as whether it is applicable for the pattern or for the shape." All that is now required is a description of the article to which the design is to be applied. (See Rule 18.)

The Comptroller may also require the applicant to state for what purpose the article to which the design is to be applied is used, and the material of which it is made. (*Ibid.*) The Comptroller may further require the applicant to endorse on the application a brief statement of the novelty he claims for the design (Rule 19).

For the Forms for Designs in the Manchester Classes, see *post*, pp. 383—388.

(*a*) Here insert legibly the name, address, and calling of the individual, firm, or company.

FORM DESIGNS No. 3.

PATENTS AND DESIGNS ACT, 1907.

APPLICATION FOR REGISTRATION OF DESIGN TO BE APPLIED TO A SET (NOT BEING LACE). [DESIGNS. 10*s.*]

You are hereby requested to register the accompanying design for (*a*) —— being a set of articles in Class —— in the name of (*b*) —— of —— who claims to be the proprietor thereof.

The design is to be applied to ——.

(Signed) ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form 1).

N.B.—FOUR exactly similar representations or specimens of the design should accompany this Form.

This corresponds with the old Form O., with the variation noted in Form 2, *supra*.

(*a*) Here set out the trade description of the articles in the set, as "A toilet set."
(*b*) Here insert legibly the name, address, and calling of the individual, firm, or company.

FORM DESIGNS No. 4.

PATENTS AND DESIGNS ACT, 1907.

APPLICATION FOR REGISTRATION OF A LACE DESIGN IN CLASS 9. [DESIGNS. 1*s.*]

You are hereby requested to register the accompanying lace design (without search) in Class 9, in the name of (*a*) —— of —— who claims to be the proprietor thereof.

(Signed) ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form 1).

N.B.—THREE exactly similar representations or specimens of the design should accompany this Form.

This corresponds with the old Form E[1]., except that the formerly important words, "the nature of the design is the pattern," are now left out.

(*a*) Here insert legibly the name, address, and calling of the individual firm or company.

FORM DESIGNS No. 5.

PATENTS AND DESIGNS ACT, 1907.

[DESIGNS. 2s.]

APPLICATION FOR REGISTRATION OF A LACE DESIGN IN CLASS 9 TO BE APPLIED TO A SET.

You are hereby requested to register (without search) the accompanying design for a set of lace articles in Class 9, in the name of (*a*) —— of —— who claims to be the proprietor thereof.

(Signed) ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form 1).

N.B.—Four exactly similar representations or specimens of the design should accompany this Form.

This corresponds with the old Form O[1]., with the variation noted on Form 4, *supra*.

(*a*) Here insert legibly the name, address, and calling of the individual, firm, or company.

FORM DESIGNS No. 6.

PATENTS AND DESIGNS ACT, 1907.

[DESIGNS. 1s.]

APPLICATION FOR ENTRY OF ADDRESS FOR SERVICE.

Design No. —— registered in Class ——.

I —— of —— the registered proprietor of the design numbered as above, apply that my address for service may be entered in the Register of Designs as ——.

Dated this —— day of —— 19—.

* ——.

To the Comptroller, &c. (as in Form 1).

* Signature of proprietor.

FORM DESIGNS No. 7.

PATENTS AND DESIGNS ACT, 1907.

REQUEST FOR STATEMENT OF GROUNDS OF DECISION UNDER RULE 33. [DESIGNS. 6s.]

Application for Design No. —— in Class ——.

You are hereby requested under Rule 33 of the Designs Rules, 1908, to state in writing the grounds of your decision and the materials used by you in arriving at such decision.

(Signed) ——.
(Address) ——.

Dated this —— day of —— 10—.

To the Comptroller, &c. (as in Form 1).

FORM D.O. No. 1.

PATENTS AND DESIGNS ACT, 1907.

CERTIFICATE OF REGISTRATION OF DESIGN. [SEAL OF PATENT OFFICE.]

Rd. No. ——

The Patent Office, Designs Branch,
25, Southampton Buildings,
Chancery Lane,
London, W.C.

This is to certify that the design, of which a copy is annexed, has been registered as of the —— day of ——, in respect of the application of such design to articles comprised in Class ——, in pursuance of and subject to the provisions of the Patents and Designs Act, 1907, and the Designs Rules, 1908.

Comptroller-General of Patents,
Designs, and Trade Marks.

FORM DESIGNS No. 8.

PATENTS AND DESIGNS ACT, 1907.

[DESIGNS. 1*l.*]

EXTENSION OF COPYRIGHT IN DESIGN FOR THE SECOND PERIOD OF FIVE YEARS.

In accordance with the provisions of section 53 (2) of the Patents and Designs Act, 1907, the prescribed fee of 1*l.* for the extension of the copyright in the design No. —— in Class —— is hereby lodged.

Dated this —— day of ·· —— 19—.

To the Comptroller, &c. (as in Form 1).

N.B.—This Form must be indorsed with the name and address of the person lodging the same.

FORM DESIGNS No. 9.

PATENTS AND DESIGNS ACT, 1907.

[DESIGNS. 10*s.*]

APPLICATION FOR EXTENSION OF COPYRIGHT FOR THE THIRD PERIOD OF FIVE YEARS.

I —— the registered proprietor of design No. —— in Class —— hereby apply that the copyright in the design in question may be extended for a third period of five years in accordance with the provisions of section 53 (3) of the Patents and Designs Act, 1907.

(Signature) ——.
(Address) ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form 1).

FORM DESIGNS No. 10.

PATENTS AND DESIGNS ACT, 1907.

EXTENSION OF COPYRIGHT IN DESIGN FOR THE THIRD PERIOD OF FIVE YEARS. [DESIGNS. 1*l.* 10*s.*]

In accordance with your notice of the —— the prescribed fee of 1*l.* 10*s.* for the extension of the copyright in the design No. —— in Class —— for a third period of five years is hereby lodged.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form 1).

N.B.—This form must be indorsed with the name and address of the person lodging the same.

FORM DESIGNS No. 11.

PATENTS AND DESIGNS ACT, 1907.

JOINT REQUEST BY REGISTERED PROPRIETOR AND ASSIGNEE OR MORTGAGEE OR LICENSEE, &C. TO ENTER THE NAME OF ASSIGNEE, &C. IN THE REGISTER OF DESIGNS UNDER RULE 43. [DESIGNS. Fee: item 10.]

We (*a*) —— of (*b*) —— and (*c*) —— of (*d*) —— hereby request under Rule 43 of the Designs Rules, 1908, that the name of (*e*) —— carrying on business as (*f*) —— at (*g*) —— may be entered in the Register of Designs as proprietor (*or* mortgagee, *or* licensee, *or as the case may be*) of the design No. —— in Class ——.

Dated this —— day of —— 19—.

(*h*) ——.
(*i*) ——.

To the Comptroller, &c. (as in Form 1).

(*a*) Name of registered proprietor.
(*b*) Address of registered proprietor.
(*c*) Name of assignee, &c.
(*d*) Address of assignee, &c.
(*e*) Name of assignee, &c.
(*f*) Trade or business of assignee, &c.
(*g*) Business address of assignee, &c.
(*h*) Signature of registered proprietor.
(*i*) Signature of assignee, &c.

FORM DESIGNS No. 12.

PATENTS AND DESIGNS ACT, 1907.

[DESIGNS. Fee: Item 10.]

JOINT REQUEST BY REGISTERED PROPRIETOR AND ASSIGNEE OF DESIGN IN CLASS 9 TO ENTER NAME OF ASSIGNEE IN THE REGISTER OF DESIGNS.

I [*or* We] the undersigned registered proprietor[s] of design No. —— in Class 9, do hereby inform you that the proprietorship in the said design has been sold to and acquired by * —— of † —— and I [*or* We] request the Comptroller to enter the name of the said —— as registered proprietors[s] in place of my [*or* our] name at present appearing in the Register.

(Signed) ——.

Dated this —— day of —— 19—.

And I [*or* We] the said —— hereby confirm the above statement, and concur in the said request.

(Signed) ——.

To the Comptroller, &c. (as in Form 1).

* Name of assignee. † Address and calling of assignee.

FORM DESIGNS No. 13.

PATENTS AND DESIGNS ACT, 1907.

[DESIGNS. 10*s.*]

REQUEST TO ENTER NAME OF SUBSEQUENT PROPRIETOR, OR OF MORTGAGEE OR OF LICENSEE, &C. OF DESIGN, IN THE REGISTER UNDER RULE 44.

I, (*a*) —— hereby request that you will enter (*b*) —— name (*c*) in the Register of Designs as proprietor (*or* mortgagee, *or* licensee, *or as the case may be*) of the design No. —— in Class ——.

(*d*) —— entitled to the said design.

Accompanying this request is a statement of (*e*) —— case.

* ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form 1).

This corresponds with the old Form K., omitting the form of statutory declaration appended to that Form. See notes to Rule 44, *supra*.

(*a*) *Or* We (*here insert name, address, and calling*).
(*b*) My *or* our. (*c*) *Or* names.
(*d*) I am *or* We are. (*e*) My *or* our.
* Signature.

FORM DESIGNS No. 14.

PATENTS AND DESIGNS ACT, 1907.

FORM OF DECLARATION (ONLY TO BE FURNISHED WHEN REQUESTED BY COMPTROLLER) IN SUPPORT OF STATEMENT OF CASE ACCOMPANYING FORM DESIGNS No. 13.

I —— of —— do hereby solemnly and sincerely declare that the particulars set out in the statement of case, exhibit marked —— and left by me in connection with my request to be registered as —— of the design No. —— in Class —— are true, and comprise every material fact and document affecting the above claim.

And I make this solemn declaration conscientiously believing the same to be true, and by virtue of the provisions of the Statutory Declarations Act, 1835.

(*a*) ——.

Declared at —— this —— day of —— 19—.

Before me,

(*b*) ——.

To the Comptroller, &c. (as in Form 1).

This corresponds to the statutory declaration attached to the old Form K., which was required on every request to register a transfer.

(*a*) To be signed here by the person making the declaration.
(*b*) Signature and title of the authority before whom the declaration is made.

FORM DESIGNS No. 15.

PATENTS AND DESIGNS ACT, 1907.

FORM OF APPLICATION UNDER RULE 49 TO VACATE ENTRY OF NAME OF MORTGAGEE OR LICENSEE IN REGISTER. [DESIGNS. 1*s.*]

Design No. —— Class ——.
Name of registered proprietor ——.
Place of business ——.
Description ——.

I the undersigned —— of —— [*or* I, the undersigned —— a member of the firm of —— of —— on behalf of my said firm ——] apply that the entry of my [*or* our] name in the Register of Designs as —— of the design No. —— in Class —— may be vacated.

* ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form 1).

* Signature.

FORM DESIGNS No. 16.

PATENTS AND DESIGNS ACT, 1907.

[DESIGNS. 1s.] APPLICATION FOR ALTERATION OF ADDRESS OR ADDRESS FOR SERVICE IN REGISTER OF DESIGNS.

Design No. —— registered in Class ——.

I —— of —— the registered proprietor of the design numbered as above apply that my address [*or* my address for service] in the Register of Designs may be altered to ——.

Dated this —— day of —— 19—.

* ——.

To the Comptroller, &c. (as in Form 1).

* Signature of proprietor.

FORM DESIGNS No. 17.

PATENTS AND DESIGNS ACT, 1907.

[DESIGNS. 1s.] FORM OF REQUEST FOR CORRECTION OF CLERICAL ERROR IN AN APPLICATION TO REGISTER, OR FOR CORRECTION OF CLERICAL ERROR UNDER SECTION 70.

I hereby request that ——

* ——.

† ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form 1).

* Signature. † Address.

FORM DESIGNS No. 18.

PATENTS AND DESIGNS ACT, 1907.

FORM OF APPLICATION BY REGISTERED PROPRIETOR OF DESIGN TO CANCEL ENTRY IN REGISTER. [DESIGNS. 1s.]

Design No. ——. Class ——.
Name of registered proprietor ——.
Place of business ——.
Description ——.

I, the undersigned —— of —— [*or* I, the undersigned —— a member of the firm of —— of —— on behalf of my said firm ——] apply that the entry in the Register of Designs of the design No. —— in Class —— may be cancelled [*or* cancelled in respect of ——].

* ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. [as in Form 1].

* Signature.

FORM DESIGNS No. 19.

PATENTS AND DESIGNS ACT, 1907.

REQUEST FOR SEARCH UNDER SECTION 57 WHEN REGISTRATION NUMBER IS SUPPLIED. [DESIGNS. 1s.]

I hereby request that I may be given such information as I may be entitled to under section 57 of the Patents and Designs Act, 1907, with respect to the design registered under the No. ——.

(Signed) ——.
(Address) ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form 1).

FORM DESIGNS No. 20.

PATENTS AND DESIGNS ACT, 1907.

[DESIGNS. 2s. 0d.]

REQUEST FOR SEARCH UNDER SECTION 57 WHEN REGISTRATION NUMBER IS NOT SUPPLIED.

I hereby request that a search may be made in Class —— in respect of the design (annexed hereto in duplicate) and that I may be given such information as I may be entitled to under section 57 of the Patents and Designs Act, 1907.

(Signed) ——.
(Address) ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form 1).

FORM DESIGNS No. 21.

PATENTS AND DESIGNS ACT, 1907.

[DESIGNS. 2s. 6d.]

REQUEST FOR SEARCH UNDER RULE 60.

I hereby request that a search may be made in Class —— and that I may be informed whether the design (annexed hereto in duplicate) to be applied to —— is or is not, in the Comptroller's opinion, identical with or an obvious imitation of any registered design applied to such goods of which the copyright is still existing.

(Signed) ——.
(Address) ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form 1).

FORM DESIGNS No. 22.

PATENTS AND DESIGNS ACT, 1907.

REQUEST FOR CERTIFICATE FOR USE IN LEGAL PROCEEDINGS OR OTHER SPECIAL PURPOSE. [DESIGNS. 5a.]

Design No. —— registered in Class ——
in the name of ——.

I —— of —— the registered proprietor of the above design, hereby request you to furnish me with your certificate for use in * ——.

† ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form 1).

This corresponds with the old Form I.

* Here state the purpose for which the certificate is required, *i.e.*, whether for use in legal proceedings (if so, state title of proceedings) or for what other purpose.

† Signature.

FORM DESIGNS No. 23.

PATENTS AND DESIGNS ACT, 1907.

REQUEST FOR CANCELLATION OF THE REGISTRATION OF A DESIGN UNDER SECTION 58. [DESIGNS 17.]

Design No. —— in Class ——.

I —— of —— hereby apply that the registration of design No. —— in Class —— may be cancelled on the ground that it is used for manufacture exclusively or mainly outside the United Kingdom.

My address for service in the United Kingdom is ——.

(Signed) ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form 1).

FORM DESIGNS No. 24.

PATENTS AND DESIGNS ACT, 1907.

[DESIGNS. 5s.]

NOTICE OF INTENDED EXHIBITION OF AN UNREGISTERED DESIGN.

(*a*) —— hereby give notice of my intention to exhibit a —— of —— at the —— Exhibition (which (*b*) —— on —— 19—), under the provisions of the Patents and Designs Act, 1907.

(*c*) —— herewith enclose a ——

(Signed) ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. [as in Form 1].

This corresponds with the old Form L.

(*a*) Here state name and address of applicant.
(*b*) State "opened" *or* "is to open."
(*c*) Insert brief description of design, with drawings if necessary.

FORM DESIGNS (MANCHESTER) No. 1.

PATENTS AND DESIGNS ACT, 1907.

[DESIGNS. 2s. 6d.]

APPLICATION FOR REGISTRATION OF DESIGN IN CLASS 13 OR CLASS 14.

(*This application must be accompanied by an unstamped duplicate.*)

You are hereby requested to register the accompanying design in Class —— in the name of (*a*) —— of —— who claims to be the proprietor thereof.

The design is to be applied to (*b*) ——.

(Signed) ——.

Dated this —— day of —— 19—.

* *To the Comptroller, &c.* (as in Form 1),

or

* *To the Keeper of Cotton Marks,*
48, *Royal Exchange,*
Manchester.

N.B.—SIX exactly similar representations or specimens of the design should accompany this Form.

(*a*) Here insert legibly the name, address, and calling of the individual, firm, or company.

(*b*) Here state the kind of goods, *i.e.*, "*piece goods*" or "*handkerchiefs and shawls.*"

* Strike out one of these addresses.

FORM DESIGNS (MANCHESTER) No. 2.

PATENTS AND DESIGNS ACT, 1907.

APPLICATION FOR REGISTRATION OF DESIGN IN CLASS 15. [DESIGNS. 1s.]

(*This application must be accompanied by an unstamped duplicate.*)

You are hereby requested to register the accompanying design (without search) in Class 15, in the name of (*a*) —— of —— who claims to be the proprietor thereof.

This design consists substantially of the checks or stripes only.

(Signed) ——.

Dated this —— day of —— 19—.

* *To the Comptroller, &c.* (as in Form 1),

or

* *To the Keeper of Cotton Marks, &c.* (as in Form Manchester No. 1).

N.B.—Six exactly similar representations or specimens of the design should accompany this Form.

(*a*) Here insert legibly the name, address, and calling of the individual, firm, or company.

* Strike out one of these addresses.

FORM DESIGNS (MANCHESTER) No. 3.

PATENTS AND DESIGNS ACT, 1907.

[DESIGNS. 2s. 6d.]

NOTICE TO KEEPER UNDER RULE 87.

(*This notice must be accompanied by an unstamped duplicate.*)

We —— of —— and —— of —— hereby give you notice that a dispute has arisen between us about the design (or designs) numbered —— in Class —— and that we have made a joint request to the Manchester Chamber of Commerce to appoint a single arbitrator (*or as the case may be*) to decide and make an award upon the merits of that dispute, inclusive of an award as to any damages or costs to be paid by one party to the other, and we have consented, and as evidence thereof we have signed this notice, that such award, when made, shall be final and binding upon us, and that, except for the purpose of enforcing such award, we shall have no right to appeal, and none of us will make any application to any Court of law or other authority in respect of the subject-matter of such award or of anything contained in it, and that no Court of law or other authority shall entertain or be asked to entertain any such appeal or application.

(Signed) { ——.
——.

Dated this —— day of —— 19—.

To the Keeper of Cotton Marks, &c. (as in Form Manchester No. 1).

FORM DESIGNS No. 25.

PATENTS AND DESIGNS ACT, 1907.

[DESIGNS. 5s.]

APPEAL FROM COMPTROLLER TO THE BOARD OF TRADE.

I HEREBY appeal against your decision in connection with my application to register —— and beg to submit my case (*a*) for the decision of the Board of Trade.

(Signed) ——.
(Address) ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form 1).

N.B.—An unstamped copy of this notice and of all the accompanying documents must be sent forthwith by the appellant to the Secretary of the Board of Trade, No. 7, Whitehall Gardens, London.

This corresponds with the old Form F.

(*a*) The statement of the case to be written upon foolscap paper (on one side only), with a margin of approximately two inches on the left hand side thereof.

FORM DESIGNS No. 26.

PATENTS AND DESIGNS ACT, 1907.

REQUEST FOR THE REGISTER TO BE ALTERED IN PURSUANCE OF AN ORDER OF THE COURT. [DESIGNS. 5s.]

Design No. —— in Class ——.

I HEREBY request you to alter the entry in the Register of Designs in accordance with the terms of the order of the Court dated ——, an office copy of which is sent herewith.

(Signed) ——.
(Address) ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form 1).

FORM DESIGNS No. 27.

PATENTS AND DESIGNS ACT, 1907.

APPLICATION FOR COPY OF CERTIFICATE OF REGISTRATION OF DESIGN. [DESIGNS. 1s.]

I HEREBY request you to furnish me with a copy certificate of registration of design No. —— in Class ——.

(Signed) ——.
(Address) ——.

Dated this —— day of —— 19—.

To the Comptroller, &c. (as in Form 1).

This corresponds with the old Form H.

Dated this 17th day of December, 1907.

D. LLOYD GEORGE,
President of the Board of Trade.

II. Pleadings and other Proceedings in Actions.

FORM NO.		PAGE
1.	Indorsement on Writ	300
2.	Statement of Claim	300
2a.	Statement of Claim (another Form)	301
2aa.	Particulars of Breaches	301
2b.	Statement of Claim (another Form)	302
3.	Defence (to Claim No. 2)	303
3a.	Defence (to Claim No. 2a)	303
3aa.	Particulars of Objections	303
3b.	Defence (to Claim No. 2b)	304
4.	Reply	306
5.	Particulars	306
6.	Order on Summons for Directions (including Inspection)	307
6a.	Order on Summons for Directions (where Action commenced in County Court)	397
7.	Notice of Motion for Injunction	308
8.	Order on Application for Injunction	308
9.	Order for Injunction, Delivery up of Copies, &c.	308
10.	Order (on Appeal) for Injunction and Inquiry	309
11.	Order on Inquiry as to Damages	400
11a.	Order on Appeal as to Inquiry	400
12.	Notice of Motion to Rectify Register	401
13.	Order Expunging Entry	401
14.	Order to vary Entry	402
15.	Interrogatories for Examination of a Defendant	402

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1. Indorsement on the Writ.

For damages or account :—

The plaintiff's claim is for damages, or, at plaintiff's option, an account of profits for the infringement of the plaintiff's registered design No. ——.

For penalties :—

The plaintiff claims penalties against the defendant for infringement by the defendant of the plaintiff's registered design No. ——.

For injunction :—

An injunction to restrain the defendant, his servants and agents, from infringing the plaintiff's registered design No. ——.

For delivery up of infringing designs :—

Delivery up on oath to the plaintiff of all articles in the possession of the defendant made in infringement of the plaintiff's said design.

2. Statement of Claim.

1. The plaintiff is the owner and registered proprietor of a certain design of the pattern of a —— to be used for ——. The said design was registered on the —— day of —— 19— in Class No. ——. The number of the said design is No. ——.

2. The defendant has since the date of the said registration, viz., on the —— 19—, wrongfully applied [or caused to be applied], for

the purposes of sale, such design, or a fraudulent or obvious imitation thereof, to goods of the class in which the said design was registered.

3. The defendant has, since the date of registration, viz., on the —— 19—, wrongfully exposed for sale and has sold articles of manufacture to which the said design, or a fraudulent or obvious imitation thereof, has been applied, the defendant at the time knowing that the said design had been so applied without the consent of the plaintiff.

4. The defendant has in his possession or power articles of manufacture within the said classes to which the said design, or a fraudulent or obvious imitation thereof, has been applied.

The plaintiff claims—

(1) £—— damages [or penalties], or, at plaintiff's option, an account of profits.

(2) An injunction.

(3) Delivery up of the articles referred to in paragraph 4.

Place of trial. (Signed) ——.

2a. Statement of Claim (*another Form*).

1. The plaintiffs are the proprietors of a registered design No. ——, which was duly registered on the —— of ——.

2. The defendants have infringed the said registered design in manner by the particulars of breaches delivered herewith appearing.

The plaintiffs claim—

(1) An injunction to restrain the defendants, their servants or agents, from infringing the said registered design.

(2) 100*l.* as penalties.

(3) Destruction or delivery up of all articles made in infringement of the said registered design.

(4) Costs. (Signed) ——.

2aa. Particulars of Breaches (*to accompany 2a*).

Delivered with the statement of claim on the —— day of ——.

The following are the particulars of the breaches complained of by the plaintiffs.

1. The defendants have made, offered for sale and sold —— machines furnished with —— made in accordance with, or being obvious or fraudulent imitations of, the plaintiffs' said registered design No. ——.

2. The plaintiffs complain in particular of a machine bought by the plaintiff —— on —— at the shop of ——, which was furnished with a —— made in accordance with the said registered design. Such machine was one of about —— such machines of the defendants' manufacture exposed for sale at the said shop.

3. The precise number and dates of the infringements by the defendants of the said registered design are not at present known to

the plaintiffs, but the plaintiffs will claim to recover penalties in respect of all such infringements.

Yours, &c.,
——
Plaintiffs' Solicitor.

To the defendants.

2b. Statement of Claim (*another Form*).

1. The plaintiffs are the proprietors of the following registered designs for ——, viz., No. ——, registered on the ——, and No. ——, on the ——.

2. The defendants have, without the license or written consent of the plaintiffs, applied or caused to be applied such designs or fraudulent or obvious imitations thereof to —— manufactured by the defendants for the purpose of sale. In particular the plaintiffs complain of the application by or at the direction of the defendants of the said registered designs to —— sold by the defendants to Messrs. —— of —— on the ——. The plaintiffs believe that the defendants have applied or have caused to be applied the said registered designs to large quantities of the said ——, but are unable at present to give further particulars of the said infringements. Nevertheless the plaintiffs will claim to recover damages in respect of all such —— when they shall have had discovery from the defendants.

3. The defendants have published and exposed for sale at their show rooms at —— and elsewhere —— to which the plaintiffs' said registered designs, or fraudulent or obvious imitations thereof, have been applied well knowing that the same had been so applied without the consent of the plaintiffs.

4. By reason of the said wrongful acts on the part of the defendants the plaintiffs have been greatly injured in the sale of —— to which they have applied their said registered designs, and have been greatly damaged thereby.

The plaintiffs claim—

(1) An injunction to restrain the defendants, their servants, agents, or workmen, from manufacturing, selling, offering for sale, or in any manner dealing with —— to which either of the said plaintiffs' registered designs or any part thereof, or any obvious or colorable imitation thereof, has been applied, and generally from infringing the rights of the plaintiffs in the said designs.

(2) Damages or, at plaintiffs' option, an account of profits.

(3) That the defendants may be ordered to deliver up to the plaintiffs to be destroyed all —— in the defendants' possession made in infringement of the said registered designs.

(4) Costs.

(5) Such further and other relief as to the Court may in the circumstances of the case seem requisite and fit.

3. Defence (*to Statement of Claim in Form* 2, *ante*).

1. The plaintiff is not and never has been proprietor of the said design, and was not entitled to register the said design in the class in which he had purported to register the same.

2. The design registered was not proper subject-matter for registration.

3. The design was not duly registered according to the Patents, &c. Act, 1883 [or the Patents and Designs Act, 1907].

4. The design was not, at the date of registration, new and original.

5. The design had been published prior to the date of registration.

6. The plaintiff, if he ever had any copyright in the said design (which is not admitted), has lost the same by reason of the sale of articles to which the said design had been applied without having the said articles marked as prescribed by the Patents, &c. Act, 1883, s. 51.

7. The defendant has not infringed the plaintiff's copyright in the said design. He did not offer the article for sale as alleged in the statement of claim, nor at all.

8. If the defendant has published or exposed for sale any article to which the plaintiff's registered design has been applied, he did so innocently and without knowledge that the consent of the plaintiff had not been obtained to the said application.

(Signed) ——.

3a. Defence (*to Statement of Claim in Form* 2*a*, *ante*).

The defendants say that—

1. They do not admit the facts alleged in paragraph 1 of the statement of claim.

2. They have not infringed the said registered design as alleged or at all.

3. The said alleged design is not proper subject-matter for registration.

4. The said alleged design was not, at the date of registration, new nor original.

5. The said alleged design had, prior to the date of the alleged registration thereof, been published in the United Kingdom.

Particulars of the prior publication upon which the defendants intend to rely are delivered herewith.

3aa. Particulars of Objections (*to accompany* 3*a*).

The following are particulars of the objections to the validity of the plaintiffs' alleged registered design relied upon by the defendants.

1. The plaintiffs' alleged design had been published in the United

Kingdom prior to the date of the plaintiffs' alleged registration by the manufacture and sale of —— for —— machines

(a) By —— at their —— works situate at —— about the year ——.

(b) By the defendants at their works at —— for the last ten years.

(c) By the plaintiffs at their —— works —— for the last ten years.

2. The plaintiffs' alleged design had also been published in this realm prior to the date of the alleged registration in—

(d) The "Illustrated Catalogue," No. ——, dated ——, published by —— of ——. The illustration relied upon is on page ——.

(e) The specification of letters patent No. —— of —— granted to ——. The illustrations relied on are figures —— of the sheet of drawings attached to such specification and referred to therein.

3. The defendants also allege that there was no subject-matter or novelty in the plaintiffs' alleged registered design by reason of the public general use in all classes of machinery for many years prior to the date of the plaintiffs' alleged registration of —— similar to those forming the subject-matter of the plaintiffs' alleged registered design.

4. Samples of the —— referred to in paragraphs (a) to (e), and copies of the circulars referred to in paragraph (d), can be inspected at the offices of the defendants' solicitors at ——.

To the plaintiffs.

3b. Defence (*to Statement of Claim* 2*b*, *ante*).

The defendants say that—

1. The defendants do not admit that the plaintiffs are the proprietors within the meaning of the Patents and Designs Acts of the alleged designs No. —— and No. —— in the Statement of claim mentioned, or either of them, or that the said designs, or either of them, have or has been duly registered as required by the said Acts.

2. Both the said designs are intended not for ——, as stated in the statement of claim, but for the cases or frames in which —— are placed. Circular, square and polygonal —— frames, having in their sides openings or windows fitted with glass arranged in some instances in a pattern, were well known at the date of the registration of the first-mentioned design ——, and when fitted with —— were known as and publicly sold under the name of "——." Moreover, —— frames, similar to that shown in the sketch or photograph furnished to the Comptroller-General of Patents, Designs and Trade Marks on the application for the registration of the last-mentioned design, had at the date of such application been made and publicly sold in Germany and elsewhere abroad.

3. Having regard to the public knowledge aforesaid, the alleged

design No. —— was not new or original within the meaning of said Acts at the date of the registration thereof.

4. The last-mentioned alleged design was, previously to the registration thereof, published in the United Kingdom by the public sale of the aforesaid —— frames made in Germany and elsewhere abroad and imported into this country, and designs of which —— frames are now in the possession of the defendants.

5. The alleged design No. —— is an obvious application of the alleged design No. —— to a —— frame of a shape slightly different from the shape of the —— frame shown in the sketch or photograph furnished to the Comptroller-General of Patents, Designs, and Trade Marks on the application for the registration of the last-mentioned design, and is not new or original within the meaning of the said Acts.

6. The alleged design No. —— was, previously to the registration thereof, published in the United Kingdom by the registration of the said alleged design No. ——, and by the sale of —— frames made according to the last-mentioned alleged design.

7. For the reasons aforesaid there is no copyright in either of the said designs.

8. The defendants deny that they have, without the license or written consent of the plaintiffs, or in fact applied or caused to be applied the said designs or either of them, or fraudulent or obvious imitations of them or either of them, to —— or —— frames manufactured by the defendants for the purpose of sale, or in particular to the —— sold by the defendants to Messrs. ——, as mentioned in the statement of claim, or that the defendants have published or exposed for sale at their show rooms at —— or elsewhere —— or —— frames to which the said alleged registered designs or either of them, or fraudulent or obvious imitations of them or either of them, have been applied, and the defendants deny that they have infringed any alleged copyright in the said alleged designs or either of them.

9. The defendants deny that by reason of any such alleged wrongful acts on the part of the defendants the plaintiffs have been greatly or at all injured in the sale of —— to which they have applied the said alleged designs, or have been greatly or at all damaged thereby.

10. The plaintiffs not only sell —— frames made according to the drawing deposited at the Patent Office on the application for registration of the alleged design No. ——, and marked on the several parts thereof with the number last aforesaid, but they also sell —— frames corresponding in some particulars with but differing in others from the said drawing, and marked on such part of the same —— frames as agrees with the said drawing with the number last aforesaid, and on other parts thereof with the numbers ——.and ——. The

three numbers last aforesaid are the numbers of alleged designs registered in the name of the plaintiffs. And the alleged design No. —— is only registered as "applicable for the pattern, shape, ornament and configuration of a —— or other —— use."

11. The marking aforesaid of the last-mentioned —— frames is calculated to mislead the public, and is not a proper compliance with the provisions as to marking contained in the Patents, Designs and Trade Marks Acts. Under the circumstances aforesaid the copyright in the alleged design No. —— has ceased.

4. Reply.

The plaintiff joins issue with the defendant on his defence.

(Signed) ——.

5. Particulars.

(*a*) *Particulars of Infringement.*

The defendant at various times and particularly on or about the ——, applied the design by the manufacture and sale of —— made according to the said design, and in particular, and by way of illustration, the plaintiff says that on the —— the defendant sold a lot of the —— to one John Smith of ——.

(*b*) *Particulars of prior Publication.*

The defendant had in his possession a sample of a similar design to the —— claimed by the plaintiff anterior to the date of registration, such sample being in the defendant's show-room and shown to his customers in the ordinary way of business. This sample was obtained from a wire-worker named H. W. in ——, who, anterior to ——, disposed of other —— such as those of the plaintiff's design to other customers, and in the way of his business. The defendant relies on these facts, and on others not at present known to them which they may elicit in cross-examination, as showing that the plaintiff's design had been published prior to the day on which the said design was registered.

(*c*) *Particulars of non-compliance with sect.* 51, 1883, *or sect.* 54 (1*b*), 1907.

The plaintiff sold certain articles to Messrs. H. & Co., of Birmingham. The said articles were not marked as prescribed by the Act, and certain of the said articles, viz. ——, were not marked at all.

6. Order on Summons for Directions (including Inspection).

Upon hearing the solicitors on both sides the following directions are hereby given, and it is ordered:

That there be pleadings in the action.

That the plaintiff and defendants do respectively, after delivery of defence, and within ten days after service of copy receipt for deposit in Court, answer on affidavit stating what documents are or have been in their possession or power relating to the matters in question in this action.

That the plaintiff be at liberty to deliver to the defendants, after delivery of defence, and that the defendants be at liberty to deliver to the plaintiff, after delivery of defence, interrogatories in writing as approved by the district registrar, and that the said interrogatories be answered as prescribed by Ord. XXXI. rr. 8 and 26, of the Rules of the Supreme Court.

That after delivery of defence the plaintiff be at liberty by himself, his solicitor and witnesses, at all reasonable times, on forty-eight hours' notice, to enter the defendants' premises and inspect the defendants' —— alleged to be an infringement of the plaintiff's copyrighted design, and to make measurements, take photographs, drawings or models of the same, and that the defendants give all reasonable facilities for the inspection and other matters aforesaid.

That the action be tried at ——.

That the action be tried by a judge.

With liberty to apply. (*Holden* v. *Hodgkinson* (1904), 22 R. P. C. 102.)

6a. Another Form (where Action commenced in County Court).

Upon motion this day made unto this Court by counsel for Messrs. —— of No. —— that the Register of Designs kept pursuant to the above-mentioned Acts might be rectified by expunging therefrom the entry relating to the above-mentioned design No. —— of the above-named ——, and upon hearing counsel for —— and the Comptroller-General of Patents, Designs and Trade Marks.

This Court doth order that the said motion be entered in the list of actions for trial with witnesses.

And it is ordered that the action of —— against ——, attached to the County Court of ——, holden at ——, be stayed until after the said motion is disposed of, and that no further anticipation of design be alleged. And the parties are to give notice on or before the —— as to which of the persons who have filed affidavits in this matter they respectively desire to cross-examine upon the hearing of the said motion.

And either party is to be at liberty upon such hearing to use any of the affidavits already filed in this matter, and of which no notice to cross-examine has been given. (*Re Morton's Design, Morton* v. *Emanuel* (1899), 17 R. P. C. 117.)

7. Notice of Motion for an Injunction.

Take notice that this Honourable Court will be moved before his lordship Mr. Justice ——, on the —— day of —— 18—, or so soon thereafter as counsel can be heard, by Mr. —— of counsel on behalf of the above-named plaintiff, that the defendant, his servants and agents, may be restrained until the trial of this action, or until further order during the continuance of the plaintiff's copyright in the design registered the —— day of —— 19—, and numbered ——, from applying the said design to any article, and from making or selling any article to which the design has been applied, and in particular [. . .] and that such further order may be made as to this Honourable Court shall seem meet.

8. Order on Application for an Injunction.

Upon motion by counsel for the plaintiff, and upon hearing counsel for the defendant. Let the defendant, his servants and agents, be restrained until after the expiration of the plaintiff's copyright in the registered design No. —— from selling the said design and from applying the same or any colourable imitation thereof to any article of manufacture for the purposes of sale, and from selling or exposing or offering for sale any substance or article of manufacture to which the said design has been applied.

9. Order for Injunction, Delivery up of Copies and Costs.

Order that the injunction awarded on the —— day of —— 18— against the defendants restraining them and each of them, their workmen, servants and agents, from selling or disposing of any of the articles of manufacture to which the plaintiffs' design in the statement of claim mentioned, or a fraudulent imitation thereof, had been applied, and from applying the plaintiffs' said design, or any fraudulent imitation thereof, to any woven fabrics or articles of manufacture, be continued until after the —— day of —— 18—, then next. And it is ordered, that the defendants shall forthwith deliver up to the plaintiffs, for the purpose of being destroyed, the drawing, point paper, and the several cards used in applying the said design; and also the articles manufactured by the defendants to which the said plaintiffs' design has been applied; the same to be verified by affidavit; and

that it should be referred to the Taxing Master to tax the reasonable and proper costs of the plaintiffs as between party and party, and to certify the amount thereof, and that such costs when taxed be paid by the defendants; and on payment thereof that all further proceedings in this suit be stayed unless the defendants commit any breach of injunction already awarded; and any of the parties are to be at liberty to apply to the Court, as there should be occasion. (*McCrea v. Holdsworth* (1848), 2 De G. & Sm. 496.)

10. Order (on Appeal) for Injunction and Inquiry as to Damages.

Upon motion by way of appeal on the —— day of —— made unto this Court by counsel for the plaintiffs from the judgment of Mr. Justice —— dated the ——, and upon hearing counsel for the defendants and upon reading the said judgment and upon production by the defendants of the further evidence mentioned in the schedule hereto.

This Court doth order that the said judgment be discharged.

And this Court doth order that the defendants the —— Company, Limited, their servants, agents and workmen, be perpetually restrained from manufacturing, selling, offering for sale, or in any manner dealing with stoves to which either of the plaintiffs' registered designs numbered —— and dated the ——, and numbered —— and dated the ——, has been applied, and generally from infringing the rights of the plaintiffs in the said designs.

And it is ordered that the following inquiry be made, that is to say:

1. An inquiry what sum of money is fit to be awarded to the plaintiffs to be paid by the defendants as damages for the infringement by the defendants of the said registered designs of the plaintiffs.

And it is ordered that the defendants —— do pay to the plaintiffs —— such sum of money as upon such inquiry shall be found fit to be awarded to the plaintiffs for such damages as aforesaid within twenty-one days after the filing of the chief clerk's certificate of the result of the said inquiry.

And it is ordered that the defendants —— do within twenty-one days after service of this order deliver up upon oath to the plaintiffs to be destroyed all stoves in the defendants' possession or under their control made in infringement of the said registered designs of the plaintiffs.

And it is ordered that the defendants do repay to the plaintiffs —— the sum of £——, being the amount of the taxed costs of the defendants paid by the plaintiffs to the defendants pursuant to the said judgment dated the ——.

And it is ordered that the defendants —— do pay to the plaintiffs

—— their costs of this action and of and occasioned by this appeal, such costs to be taxed by the Taxing Master.

And it is ordered that the costs of the said inquiry be reserved, with liberty for either party to apply in chambers in reference to such costs when the said inquiry shall have been completed. (*Harper* v. *Wright and Butler* (1895), 12 R. P. C. 483.)

11. Order on Inquiry as to Damages.

Upon the application of the plaintiffs by summons dated the ——, that in pursuance of the judgment in this action dated the ——, the defendants might be ordered within seven days after the service of the order to be made upon the application to make and file an affidavit or affidavits stating the names and addresses of the persons to and by whom the £—— worth of —— purchased by the defendant company respectively has been sold or used or for whom the same has been purchased, and that the liquidator of the defendant company —— might be ordered to make and file within seven days from the date of the order to be made upon the said application a full and complete affidavit of all invoices, papers, writings, books of account, and other documents which were delivered by the defendant company to him as liquidator, and which now are or have been in his possession and accounting for the same accordingly, and that the same be produced for the inspection of the plaintiffs at the offices of the defendants' solicitor, and that the costs of and incidental to the application be costs of taking the account of profits directed by the judgment herein of the ——, and upon hearing counsel for the applicants and for the defendants, and upon reading the judgment dated the ——, an order dated the ——, an affidavit of —— filed the ——, and the exhibit therein referred to, and the defendants having offered to the plaintiffs inspection of the defendants' invoices and sales ledger, having previously sealed up the names of customers, and the plaintiffs admitting that they have had inspection accordingly.

The judge doth not think fit to order production of names or addresses of the customers, and it is ordered that the said application be dismissed with costs to be taxed and set off against the costs directed by the judgment dated the ——, to be paid by the defendants to the plaintiffs. (*Saccharin Corporation* v. *Chemicals and Drugs Co.* (1900), 17 R. P. C. 612.)

11a. Order on Appeal as to Inquiry.

Upon motion by way of appeal this day made unto this Court by counsel for the plaintiffs from the order dated ——, and upon hearing counsel for the appellants and for the defendants, and upon reading the order dated ——.

This Court doth order that the said order dated —— be discharged.

And it is ordered that the defendants do, within twenty-eight days from the date of this order, make and file an affidavit or affidavits stating the names and addresses of the persons to and by whom the £—— worth of —— purchased by the defendant company respectively has been sold or used or for whom the same has been purchased, and the dates when the —— was sold and the amounts sold, and it is ordered that the costs of and occasioned by this appeal be costs of the inquiry. (*Saccharin Corporation* v. *Chemicals and Drugs Co.* (1900), 17 R. P. C. 612.)

12. Notice of Motion to Rectify the Register (*a*).

In the High Court of Justice,
Chancery Division.

Mr. Justice ——.

In the Matter of copyright in a design granted to A. B. registered the —— day of —— No. ——

and

In the Matter of the Patents, Designs, and Trade Marks Acts, 1883—1888 [or the Patents and Designs Act, 1907].

Take notice that the Court will be moved before his lordship Mr. Justice —— on —— the —— day of ——, or so soon thereafter as counsel can be heard, by Mr. ——, of counsel on behalf of C. D. of ——, that the Register of Designs kept pursuant to the above-mentioned Acts may be rectified by expunging the entry relating to the above-mentioned design made in the Register of Designs on the —— day of —— by or on behalf of the said A. B., or that such further and other order may be made for the rectification of the said register as to this Court shall seem just, and that the said A. B. do pay to the applicant his costs of this application to be taxed by the Taxing Master.

Dated the —— day of ——.

(*Signed*) —— *of* ——
Solicitor for the above-named C. D.

To Mr. A. B. and to Messrs. —— his solicitors [and the Comptroller-General of Patents, Designs and Trade Marks].

13. Order Expunging Entry in the Register.

Upon motion, &c., this Court doth order that the entry relating to

(*a*) See the Form in *In re Compagnie Générale d'Eaux Minérales Trade Mark*, 8 R. P. C. 446. For amendment of the notice, see *Re King's Trade Mark* (1892), 19 R. P. C. 350.

the above-mentioned registered design made in the Registor of Designs of the Patent Office on the —— day of —— by or on behalf of the said A. B. be expunged from such registor, and it is ordered that A. B. do pay to the applicant his costs of this application, such costs to be taxed by the Taxing Master, and it is ordered that an office copy of this order be served upon the Comptroller-General of Patents.

14. Order to vary Entry.

Upon motion this day made unto this Court by counsel for —— of —— in ——. No one appearing for the respondent —— although duly served with notice of this motion, as by affidavit appears, and upon hearing counsel for the Comptroller-General of Patents, Designs and Trade Marks, and upon reading an affidavit of —— filed —— and the exhibits therein referred to, and it appearing to the satisfaction of the Court that the registration of the design No. —— was made inadvertently and by mistake in the name of the said —— this Court doth order that the Register of Designs be varied by removing therefrom the name of the above-mentioned —— as the proprietor of the said design, and substituting therefor the name of the said ——.

And it is ordered that the applicant —— do pay to the said Comptroller his costs of this motion, to be taxed by the Taxing Master. And it is ordered that due notice of the said rectification is to be given to the said Comptroller. (*Re Crocott's Design* (1899), 17 R. P. C. 139.)

15. Interrogatories for Examination of a Defendant.

1. Did not the defendant, in or about the month of —— or at some other and what date or dates, manufacture —— to which he applied or caused to be applied the design in the statement of claim mentioned or a design similar thereto, and did he not, in or about the same month or at some other and what date or dates, sell the said lace, and if so, what quantities thereof, to —— of —— or to some other and what persons?

2. State where and the name and address of the person by whom the order for the manufacture of the said ——, alleged in paragraph —— of the defence, was given to the defendant, and whether verbally or in writing, and if in writing identify the document or documents.

3. State where and to what description of —— the design mentioned in the defendant's particulars of objections was applied, and the names and addresses of the persons whom the defendant alleges to have been the designer and draftsman of the said design, and whether the design and the draft of the said design are in existence, and if so,

the name and address of the person in whose possession they are, and whether the said design was ever registered, and if so, in whose name and when.

4. State where and the name and address of the person by whom the said design is alleged to have been shown to ——, and whether the alleged employment of the defendant by the said —— was by verbal or written instructions, and if written, identify the document or documents.

5. State the quantity and description of the —— alleged to have been manufactured for and sold by the said ——, and whether there is any book containing a record of such manufacture and deliveries, and the name and address of the person in whose possession it now is.

6. State the names and addresses of the —— merchants referred to in the said particulars of objections, and the dates of the several alleged sales to them respectively.

The defendant is required to answer all the above interrogatories. (*Titus Astle, Ltd.* v. *Mansfield* (1905), 22 R. P. C. 356.)

III. Conveyancing Forms.

1. Assignment of a Design.

THIS INDENTURE, made the —— day of ——, between A. B. of ——, of the first part, and C. D. of ——, of the other part.

WHEREAS the said A. B. registered a design for the United Kingdom on the —— day of ——, and numbered ——, for —— [*Title*].

NOW THIS INDENTURE WITNESSETH, that in consideration of the sum of £—— paid to the said A. B. (the receipt whereof he doth hereby acknowledge), the said A. B., as beneficial owner, doth hereby assign unto the said C. D., his executors, administrators, and assigns, all his interest in the said registered design, and advantages belonging thereto, to hold the same unto the said C. D., his executors, administrators, and assigns absolutely: And the said A. B. doth hereby covenant with the said C. D., his executors, administrators, and assigns, that he, the said A. B., hath not at any time done or knowingly been party or privy to any act, deed, or thing whereby his copyright in the design has been in any way forfeited, or whereby he is prevented from assigning the said registered design in manner aforesaid, or whereby the same is or may be in anywise encumbered. IN WITNESS whereof the said parties to these presents have hereunto set their hands and seals the day and year first above written.

2. License.

AN INDENTURE made the —— day of ——, between A. B. of, &c. (hereinafter called the licensor), of the one part, and C. D. of, &c. (hereinafter called the licensee), of the other part. WHEREAS the said licensor is the registered proprietor of a design for ——, registered No. ——, the —— day of ——. AND WHEREAS the licensor has agreed to grant the licensee a license to use the said design [so far as relates to its application to the manufacture of —— for the purposes of sale in the district of ——]. NOW THIS INDENTURE WITNESSETH that in pursuance of the said agreement, and in consideration of the royalties hereby agreed to be paid to the licensor by the licensee, and of the covenants on the part of the licensee hereinafter contained, the licensor doth hereby grant unto the licensee full leave to apply the said design to —— manufactured for the purpose of sale within the district of ——, being a radius of —— miles from the shirehall of the town of ——, and further the licensor doth hereby grant unto the licensee full leave to sell within the said limits articles to which the said design has been applied during the term of —— years [*or*, during the residue of the unexpired term for which the copyright in the said design has been granted to the licensor]; YIELDING AND PAYING unto the licensor on the 1st day of every October and on the 1st day of every April for every —— manufactured by the licensee to which the registered design shall have been applied the sum of £——. And the licensee doth hereby covenant with the licensor and his assigns that he the licensee will during the term hereby granted pay to the licensor, his executors, administrators, or assigns, on the 1st days of October and April respectively, the royalties on all articles manufactured and to which the design shall have been applied by the licensee during the preceding six months, AND ALSO that he will during the said term keep all proper books of account, and make such true entries therein of all particulars necessary or convenient for the purposes, showing the amount which may be or become due by way of royalty to the licensor hereunder, and will produce the said books at all reasonable times to the licensor, his executors, administrators, or assigns, or to his agent or agents duly appointed for this purpose in writing, for the purpose that the said licensor, his executors, administrators, assigns, or agents, may inspect and take copies and extracts from the said books, and will at his own expense obtain and give all reasonable information as to any item in the said books of account as may reasonably be required. AND ALSO that he will at the end of each half year on the dates aforesaid deliver or send to the licensor, his executors, administrators, or assigns, a statement in writing of the particulars of the manufacture and sale of articles within the last half

year to which the said design has been applied. AND THE LICENSEE FURTHER COVENANTS that he will neither do nor omit to do anything whereby the copyright in the said design may be lost, and for any breach of this covenant the licensee shall pay to the licensor, his executors, administrators, and assigns, the sum of £—— to be paid as liquidated damages.

In witness, &c.

[Amongst other clauses which may be inserted in a license agreement are the following: (a) licensor to defend the design at the cost of the licensee; (b) power for either party to determine the license on giving notice; (c) licensee not to assign or charge the license without the licensor's consent; (d) licensor not to grant license to any person other than the licensee.]

Forms of license for designs may be adapted from the forms of license for patents, which are given in great variety in Morris's Patents Conveyancing.

APPENDIX C.

Instructions to Persons who wish to Register Designs.

1.—General.

It is advisable in the first instance for a person who desires to register a design to buy a copy of the Designs Rules, 1908, and of the Patents and Designs Act, 1907.

2.—Sale of Act and Rules.

Copies of the Act and of the Rules can be purchased at the Sale Branch of the Patent Office. The price of the Act is 5½*d.*, by post, 7*d.*; and of the Rules, 4*d.*, by post, 5*d.* Sums exceeding 5*d.* should be remitted by postal order or post office order.

3.—Who may apply for Registration of a Design.

Any person, whether a British subject or not, claiming to be the proprietor of any new or original design not previously published in the United Kingdom, may make an application for the registration of a design in the United Kingdom.

The term "person" includes firm, partnership, and body corporate.

Any person who has made a previous application for registration of a design, which is registrable under the Act, either in any of the foreign States or in any of the British possessions (see paragraph 17), with which certain arrangements for mutual protection of designs have been made, may obtain priority of date in the United Kingdom, provided that the application is made within four months from the date of the application in such foreign State or British possession.

4.—What may be Registered as a Design.

Section 93 of the Act defines a design as follows:—

"Design" means any design (not being a design for a sculpture or other thing within the protection of the Sculpture Copyright Act, 1814) applicable to any article, whether the design is applic-

able for the pattern, or for the shape, or configuration, or for the ornament thereof, or for any two or more of such purposes, and by whatever means it is applicable, whether by printing, painting, embroidering, weaving, sewing, modelling, casting, embossing, engraving, staining, or any other means whatever, manual, mechanical, or chemical, separate or combined.

"Article" means (as respects designs) any article of manufacture and any substance artificial or natural, or partly artificial and partly natural.

Section 60 of the Act restricts the protection afforded by a registered design to the particular class of goods in which the design is registered; but under section 49 (2) the same design may be registered in more than one class; see paragraph 9 (clause 7).

Mechanical inventions cannot be protected by registration as designs. Improvements in the construction, arrangement, or application of machinery should be protected by a patent.

5.—Manner of applying for Registration of a Design.

All applications and communications must be made in the English language.

Applications relating to designs, other than those in Classes 13, 14, and 15, must be left at the Patent Office by hand or sent by post addressed to the Comptroller, the Patent Office, Designs Branch, 25, Southampton Buildings, London, W.C.

In the case of Designs in Classes 13, 14 and 15, applications must be in duplicate, and may be addressed either to the Comptroller as above, or to the Keeper of Cotton Marks, Manchester Branch of the Trade Marks Registry, 48, Royal Exchange, Manchester, at the option of the applicant.

6.—Sets of Articles.

A "Set" is a number of articles of the same general character ordinarily on sale together, or intended to be used together, all bearing the same design, with or without modifications not sufficient to alter the character or not substantially affecting the identity thereof.

7.—Classification of Goods.

Under the Rules goods are classified as follows. (*See list at p.* 29, *ante.*)

8.—Designs Forms and Fees.

The following is a list of the Designs Forms and of the Fees. (*See lists of Forms, ante, p.* 373, and of *Fees, ante, pp.* 318—320.)

The Stamped Forms can be obtained on personal application at the Inland Revenue Office (Room No. 32), in the Patent Office, 25, Southampton Buildings, Chancery Lane, London, W.C., or, at a few days' notice and upon pre-payment of the value of the stamp, at any Money Order Office in the United Kingdom.

Forms Designs No. 2, Designs No. 3, Designs (Manchester) No. 1, and Designs (Manchester) No. 2, are kept in stock at the following Post Offices in London:—The London Chief Office; Lombard Street Branch Office, E.C.; Eastern District Office, 206, Whitechapel Road, E.; South-Eastern District Office, 230, Borough High Street, S.E.; Charing Cross Branch Office, W.C.; North-Western District Office, 28, Eversholt Street, Camden Town, N.W.; Post Office, 44, Parliament Street, S.W., and at the Chief Post Office of the undermentioned cities and towns:—

In England and Wales.

(*Here follows list of over* 100 *principal towns.*)

In Scotland.

Aberdeen.	Glasgow.	Leith.
Dundee.	Greenock.	Perth.
Edinburgh.	Inverness.	

In Ireland.

Belfast.	Galway.	Waterford.
Dublin.	Limerick.	Wexford.

Forms Designs No. 4 and Designs No. 5 are specially kept in stock at the Chief Post Office at Nottingham.

If it should not be convenient to apply in either of the ways above specified, the stamped forms can be ordered by post from the Controller of Stamps (Room No. 5), Inland Revenue Office, Somerset House, London, W.C. In this case a bankers' draft or a money or postal order payable to the Commissioners of Inland Revenue and crossed Bank of England, to cover the value of the stamp and the cost of transmitting the form in a registered envelope by post, must be forwarded to Somerset House with the application for the form. Cheques will not be accepted.

9.—Documents, &c. Required on Application for Registration of a Design.

An application for the registration of a design must be made on the appropriate application form, impressed with the proper stamp. (See paragraph 8.)

If the design be the property of a firm, the application form should be signed either in the firm's name or by some one or more members of such firm or partnership, who should add after his or their signature "a member of the firm" or "members of the firm" (as the case may be); if of a body corporate, by a director or by the secretary or other principal officer, who should add after his signature and designation "for the company."

Applications may be made in the names of and on behalf of applicants by agents resident or having a place of business in the United Kingdom or the Isle of Man, duly authorised to the satisfaction of the Comptroller. The agent must be authorised in writing (see Form Designs No. 1) by the applicant or applicants; the authority to an agent should be signed by the applicant or applicants; in the case of a firm, partnership, or body corporate, the authority should be signed in the manner indicated in the preceding paragraph.

An application made by an agent should have, after the signature of the agent, the description "agent."

The applicant's full address must be given in the application.

When an applicant for the registration of a design resides out of the United Kingdom or the Isle of Man, an address for service in the United Kingdom must be given in the application; if the design be registered, such address will be entered in the register of designs as the address for service of the proprietor of the design.

The class in which the design is to be registered must be given in the application, and, if the design is to be registered in more than one class, a separate application is necessary in each class.

The article or articles to which the design is to be applied must be stated, and, if required, the purpose for which the article is used and the material or predominating material must be specified.

A brief statement of the novelty claimed for the design may, if the applicant so desires, be indorsed on the application and representations, and such statement must be so indorsed, if required.

Three exactly similar drawings, photographs, tracings, or other representations or three specimens, are required in the case of an application for a design to be applied to a single article (except in the case of a design in any one of the Classes 13, 14 and 15). When the design is to be applied to a set, four such representations or four specimens are required; in the case of a design applied for in any one of the three above-mentioned classes, six representations or six specimens are required.

Rough sketches cannot be accepted, but if it is inconvenient to supply the proper number of representations when the application is made, and it is desired to secure a date of registration, one sketch

(or in the case of an application in any one of the Classes 13, 14 and 15, two sketches) of the design (sufficiently definite to identify it) may accompany the application. In such a case the design, if accepted, will eventually be registered as of the date on which the sketch was received, but no certificate can be issued until the proper number of correct representations has been supplied.

Each representation must be upon paper of a size of approximately 13 inches by 8 inches, and must appear upon one side only of the paper; the figure or figures must be placed in an upright position on the sheet, and when one or more figures are shown, these should, if possible, be on one and the same sheet, and each should be designated on the sheet (*e.g.*, front view, side view).

Drawings or tracings must be in ink, and tracings must be mounted on paper of the size above mentioned.

Representations must not be on cardboard.

In the case of a set, each representation should show all the various arrangements in which it is proposed to apply the design to the articles included in the set.

When a design bears a repeating surface pattern, the complete pattern and a sufficient portion of the repeat in length and width (not of less size than 7 inches by 5 inches) should be shown on the representation.

Specimens should not accompany an application for a design unless they are of a kind which can conveniently be pasted into books.

Letters or numerals not of the essence of the design must not be shown on the representations or specimens. When the names or representations of living persons appear on a design, the consent of such persons should be furnished. In the case of persons recently dead, the consent of their legal representatives may be required.

10.—Applications in Classes 13, 14 and 15.

An application in any one of the Classes 13, 14 and 15 may be made either to the Comptroller in London or to the Keeper of Cotton Marks in Manchester (see paragraph 5, clause 3). Such an application must be in duplicate, but the duplicate form of application need not be stamped.

An application in Class 13 or Class 14 should be made on Form Designs (Manchester) No. 1, and an application in Class 15 on Form Designs (Manchester) No. 2. Class 15 is restricted to designs consisting substantially of checks or stripes only.

11.—Non-Completion of Registration of a Design.

When registration is not completed within twelve months from the date of the application by reason of default on the part of the applicant,

the application may, after due notice, be treated as abandoned, unless it be completed by the time specified in such notice.

12.—Duration and Extension of Registration.

Registration of a design is for a period of five years from the date of the original application, but may be extended for two further periods, each of five years, on application and payment of the prescribed fees: the registered proprietor can claim the first extension; the second is subject to the allowance of the Comptroller. See Forms Designs Nos. 8, 9, and 10 (paragraph 8).

13.—Marking of Articles.

Before delivery on sale of any article to which a registered design has been applied, the proprietor of such design must cause each such article to be marked with the word REGISTERED or with the abbreviation REGD. or with the abbreviation RD., as he may choose, and also (except in the case of articles to which have been applied designs registered in Classes 9, 13, 14, and 15) with the number appearing on the certificate of registration.

14.—Searches.

Any person who desires to ascertain whether the registration of a design still exists and to obtain the other information mentioned in section 57 of the Act, and can furnish the registration number of the design, should lodge Form Designs No. 19. If the registration number cannot be furnished, Form Designs No. 20 should be lodged with such information as is available. If Form Designs No. 20 is accompanied by a representation or specimen of the design, it must be furnished in duplicate.

If Form Designs No. 21 be lodged, a search will be made, and the person lodging such form will be informed whether the design sent in is identical with or, in the Comptroller's opinion, an obvious imitation of any registered design applied to the same goods for which the copyright is still existing. The design furnished with Form Designs No. 21 must be in duplicate.

15.—Registration of Subsequent Proprietors of Registered Designs.

The request to be made by a subsequent proprietor on application for the entry of his name in the register as subsequent proprietor of a registered design must be made on Form Designs No. 11, Form Designs No. 12, or Form Designs No. 13 (see paragraph 8), as the case may be. In the case of a firm or partnership, the request may be

made by one member of the firm or partnership. In the case of a body corporate, the request should be made by a director or by the secretary or a principal officer of such body corporate.

If the Comptroller considers it necessary he may require a declaration on Form Designs No. 14 to be furnished in support of the request.

Where a person becomes entitled to registered designs, he should, at the earliest possible moment, have them transferred into his name in the register. The mere possession of the certificates of registration is insufficient.

16.—Miscellaneous Matters relating to Designs and the Patent Office.

(a) *Advice on Design Matters, &c.*—The Patent Office does not undertake to give legal advice or opinions on questions of infringement or on any subject connected with designs law which, like other laws, is left to the interpretation of professional men.

(b) *Agency.*—The Comptroller cannot recommend any particular agent for employment by applicants. A list of registered patent agents who, as a rule, also transact design business, may be obtained from Messrs. Wyman & Sons, Limited, Fetter Lane, London, E.C., or through any bookseller. Price (including postage) 1*s.* 1*d.*

(c) *Application for Reduction of Fees.*—It is not within the power of the Comptroller to comply with any request for the reduction or remission of any of the fees required by the Designs Rules.

(d) *Use of the word "Registered."*—Under section 89 of the Act, any person who falsely describes any design applied to any article sold by him as registered is liable for every offence on summary conviction to a fine not exceeding five pounds.

A person who sells an article having applied thereto the word "registered," or any other word expressing or implying that the design applied thereto is registered, is deemed for the purpose of section 89 of the Act to represent that the design is registered.

A person who, after the copyright in a design has expired, puts or causes to be put, on an article to which the design has been applied, the word "registered," or any word or words implying that there is a subsisting copyright, is liable on summary conviction to a fine not exceeding five pounds.

17.—International and Colonial Arrangements.

An International Convention for the protection of industrial property exists between the following States:—Belgium; Brazil; Cuba; Denmark with the Faröe Islands; France with Algeria and colonies; Germany; Great Britain with Australia, Ceylon, New Zealand, and

Trinidad and Tobago; Italy; Japan; Mexico; Netherlands with the Dutch East Indies, Surinam, and Curaçon; Norway; Portugal with the Azores and Madeira; Santo Domingo; Servia; Spain; Sweden; Switzerland; Tunis; United States of America.

Copies of the text of the Convention and of the additional Act modifying the Convention, may be purchased for 2*d.* and 1*d.* respectively, from Messrs. Wyman & Sons, Limited, Fetter Lane, London, E.C., or through any bookseller.

Under this Convention, an applicant for a design in any one of the contracting States may obtain priority of date in any of the other States.

Similar arrangements, for the mutual protection of designs, have been made between Great Britain on the one side, and each of the following States and Colonies on the other:—Ecuador; Greece; Honduras; Paraguay; Roumania; Uruguay.

18.—Applications for the Registration of Designs in the British Colonies and Foreign States.

Applications for the registration of designs in the Colonies and foreign States *must be made to the Government of the Colony or* foreign State in which protection is desired. A collection of colonial and foreign laws and rules relating to the subject may be seen in the free library of the Patent Office.

19.—Patent Office Library.

The free public library of the Patent Office, 25, Southampton Buildings, Chancery Lane, London, W.C., is open daily, from 10 a.m. to 10 p.m., except on Sundays, Christmas Day, Good Friday, and Bank holidays. On the day observed as His Majesty's birthday, Christmas eve, Easter eve, and Whitsun eve, the library is closed at 4 p.m.

January, 1908.

APPENDIX D.

Orders in Council applying the Provisions of the Patents, &c. Act, 1883, ss. 103—4 (continued by sect. 91 of the Act of 1907), to Foreign States and British Colonies.

Foreign State or Colony.	Date of Order in Council.
Australia	26 March, 1907.
Austria-Hungary	—
Belgium	26 June, 1884.
Brazil	26 June, 1884.
Ceylon	7 Aug., 1905.
Cuba	—
Denmark (including the Faroe Islands)	20 Nov., 1894.
Dominican Republic	21 Oct., 1890.
Ecuador*	16 May, 1893.
France (with Algeria and Colonies)	26 June, 1884.
Germany	9 Oct., 1903.
Greece*	15 Oct., 1894.
Honduras	26 Sept., 1901.
Italy	26 June, 1884.
Japan	7 Oct., 1899.
Mexico	28 May, 1889.
Netherlands	26 June, 1884.
Netherlands (East Indian Colonies)	17 Nov., 1888.
Netherlands (Curaçao and Surinam)	17 May, 1890.
New Zealand	8 Feb., 1890.
Norway	See below (Sweden).
Paraguay	24 Sept., 1886.
Portugal (with the Azores and Madeira)	26 June, 1884.
Roumania*	5 Aug., 1892.
Servia	26 June, 1884.
Spain	26 June, 1884.
Sweden and Norway	9 July, 1885.
Switzerland	26 June, 1884.
Trinidad and Tobago	12 Aug., 1907.
Tunis	26 June, 1884.
United States	12 July, 1887.
Uruguay	24 Sept., 1886.

* These countries are not parties to the International Convention. The provisions of sect. 91 apply to them in respect of Designs and Trade Marks only. Paraguay and Uruguay have not joined the Convention, but there are separate treaties with them to which the provisions of sect. 91 will apply.

APPENDIX E.

SELECT BIBLIOGRAPHY

Of the Literature of Copyright in Designs

Arranged Chronologically and according to Countries.

UNITED KINGDOM.

1823. GODSON (Richard). *Practical Treatise on the Law of Patents for Inventions and of Copyright.* London. 8vo. pp. ix., 452.

This work, which is one of the earliest authorities on the subject of patent law, contains in pages 302—4 a short account of the protection granted to proprietors of original patterns for printing fabrics. The work was re-edited by Peter Burke in 1851.

1840. THOMSON (James). *Letter to the Vice-President of the Board of Trade on Protection to Original Designs and Patterns printed on Woven Fabrics.* Clitheroe. 8vo. pp. ii., 29.

Illustrated with fifteen copper plates of original patterns.

1840. THOMSON (James). *Letter to the Right Hon. Sir Robert Peel, Bart., on Copyright in Original Designs and Patterns for Printing Fabrics.* Clitheroe. pp. 54, and App. VI.

1841. TENNENT (J. Emerson), M.P. *Treatise on the Copyright of Designs for Printed Fabrics; with consideration of the necessity of its extension.*

London. 8vo. pp. xv., 283; 6 pattern plates.

1842. BRACE (George). *Observations on the Extension of Protection of Copyright of Designs, with a view to the Improvement of British Taste.* London. 12mo. pp. vii., 128.

1845. BILLING (Sidney), and Alexander PRINCE. *The Law and Practice of Patents and Registration of Designs.*

London. pp. vi., 227.

Chapter XIV. deals with securing property by registration.

1846. CARPMAEL (William). *Registration of Designs to secure Copyright.* Third Edition. London. 8vo. pp. 28.

1846. NORMAN (John Panton). *Law and Practice relating to Useful and Ornamental Designs.* London. 12mo. pp. xii., 185.

1847. SPENCE (William). *Copyright of Designs, as distinguished from Patentable Invention.* London. 8vo. pp. 32.

1848. WEBSTER (Thomas). *On the Subject-matter, &c. of Letters Patent for Inventions and Copyright of Designs for Articles of Manufacture.* London. 8vo. pp. iv., 100.

The original edition of this work in 1841, which was issued as a Supplement to Webster's "Law and Practice of Letters Patent," contained nothing relating to Designs. A third edition of the above work appeared in 1851.

1849. TURNER (T.). *On Copyright in Design in Art and Manufactures.* London. 8vo. pp. viii., 114.

1853. WEBSTER (Thomas). *On Property in Designs and Inventions in the Arts and Manufactures.* London. 8vo. pp. 64.

The work is almost entirely devoted to the subject of patent right.

1854. *First Report of the Science and Art Department.* London. 8vo.

Appendix N. to the above Report, pp. 463—642, contains a report of the proceedings of the Designs Office from 1st July, 1839, to 31st December, 1852, including a copy of the register of non-ornamental Designs from September 1, 1843, to December 31, 1853.

1862. PHILLIPS (C. P.). *Law of Copyright in Works of Literature and Art, and in the Application of Designs.* London. 8vo. pp. cxiii., 261, xvi.

Chapter XI. deals with copyright in the application of Designs.

1879. CRAIG (A.). *Patents, Designs and Trade Marks: A Practical Guide.* (Chap. II. The Patent Office. . . . Curiosities of Patent Law.) London. 8vo. pp. 56.

1884. ASTON (Th.). *The Patents, Designs and Trade Marks Act,* 1883. London. 8vo. pp. xiii., 255.

1884. BOUSFIELD (W. R.). *The Patents, &c. Act,* 1883, *and the Rules thereunder.* London. 8vo. pp. xv., 257.

1884. SHORTT (J.). *The Law relating to Works of Literature and Art* (*including Designs*). Second edition. London. 8vo. pp. xlvi., 840.

1884. SLATER (J. H.). *The Law relating to Copyright and Trade Marks with reference to Infringement.* (A Digest of English and American decisions.) London. 8vo. pp. xvii., 166.

1885—7. LAKE (H. H.). *Patent Law Primers*, I.—III. (England, United States, Canada). Patents, Trade Marks and Designs. London. 3 parts. 8vo.

1889. GRAHAM (J. C.). *Designs and Trade Marks.* (With a Chapter on Misrepresentation on the Sale of Goods.) London. 8vo. pp. xv., 179.

1889. WINSLOW (R.). *Law of Artistic Copyright.* (With a Chapter on Designs.) London. 8vo. pp. xv., 215.

1891. WOODWARD (Parker). *Handbook to the Law of Copyright in Designs.* (With special application to Class IX. (Lace).) Nottingham. 8vo. pp. 92.

1895. EDMUNDS (Lewis). *The Law of Copyright in Designs.* (With the Practice in the Courts and the Patent Office.) London. 8vo. pp. xviii., 291.

1898. LAWSON (W. N.). *Law and Practice of Patents, Designs and Trade Marks.* London. Third edition. 8vo. pp. lxxx., 636.

1904. COPINGER (W. A.). *Law of Copyright in Works of Literature and Art.* (With a Chapter on Designs.) Fourth edition. London. 8vo. pp. xxii., 266, cxlix.

1905. FULTON (D.). *A Practical Treatise on Patents, Trade Marks and Designs.* Third edition. London. 8vo. pp. 672.

1905. HADDAN (R.). *The Inventor's Adviser and Manufacturer's Handbook to Patents, Designs and Trade Marks.* Third edition. London. 8vo. pp. 471.

1884—1907. PATENT OFFICE. Digests of Patent, Designs and Trade Mark Cases included in the "Reports." Vols. I. to X. (1884—93), Vols. XI. to XVI. (1894—9), Vols. XVII. to XXII. (1900—5), Vols. XXIII. and XXIV. (1906—7).

AUSTRIA.

1859. STUBENRAUCH (M. von). *Das Oesterreichische Marken- und Muster-schutz Gesetz.* Vienna. 8vo. pp. 68.

1873. *Privilegiengesetz, Marken-und-Muster-Gesetz, Hausirpatent, &c.* Fifth edition. Vienna. 8vo. pp. iv., 129.

A reprint of the Laws and Regulations dealing with Patents, Trade Marks and Designs.

1804. HANDELS MINISTERIUM. *Gutachten über die . . Entwürfe eines Patent-Gesetzes und eines Gebrauchs-Muster-schutz-Gesetzes.* Vienna. 4to. pp. v., 500.

BELGIUM.

1884. *Ministère de l'Agriculture. Convention du 20 Mars*, 1883, *pour la Protection de la Propriété Industrielle.* Text of the Belgian Laws, with Circulars, &c. Brussels. 8vo. pp. 52.

1886. *Ministère de l'Agriculture, &c. Dessins et Modèles industriels. Loi du 18 Mars*, 1806, *et Arrêtés d'Execution.* Brussels. 8vo. pp. 7.

CANADA.

1879. *Circular of the Department of Agriculture containing the "Trade Mark and Design Act," and the "Act respecting the marking of Timber," with Rules, &c.* Ottawa. 8vo. pp. 51.

FRANCE.

1867. SCHMOLL (J.). *Traité pratique des Brevets, Dessins, Modèles et Marques de Fabrique comprenant la Legislation Étrangère et les Traités Internationaux.* Paris. 8vo. pp. iii., 671.

1868. POUILLET (E.). *Traité theorique et pratique des Dessins de Fabrique.* Paris. 12mo. pp. 185.

A useful work divided into: (a) Legislation Française; (b) Traités Internationaux; (c) Resumé des Legislations Étrangères; (d) Doctrine et Jurisprudence. A later edition appeared in 1884.

1879. PARIS EXHIBITION, 1878. *Congrès International de la Propriété industrielle, No. 24 de la Série.* Paris. 8vo. pp. 752.

This work contains in pp. 65—83 a report by J. Bozérian on the existing legislation on Designs and Models, with a proposed new law on the subject.

1880. PHILIPON (E.). *Traité de la Propriété des Dessins et Modèles industriels.* (Histoire, Legislation, Jurisprudence.) Paris. 8vo. pp. 226.

1889. BARCLAY (T.). *Law of France relating to Industrial Property.* (Patents, Trade Marks and Designs.) London. 8vo. pp. xvi., 244.

The author devotes a chapter to Designs and Models, and non-industrial Drawings, pp. 109—117.

1893. PELLETIER (M.). *Droit industriel, Brevets d'Invention, Marques de Fabrique, Modèles et Dessins.*
Paris. 8vo. pp. vii., 607.

1894—8. COUHIN (C.). *La Propriété industrielle, artistique et littéraire.* Paris. 3 vols. 8vo.

1898. VAUNOIS (A.). *Les Dessins et Modèles de Fabrique.* (Including a Chapter on Foreign Laws.)
Paris. 8vo. pp. xxiv., 362.

1898. BERT (É.). *Brevets d'Invention, Marques, Modèles et Dessins de Fabrique.* (Jubilee volume of the Société des Ingénieurs Civils de France, 1848—98.) Paris. 8vo. pp. 771—782.

1899. ANNUAIRE FARJAS. Containing an Abridgment of the Laws relating to Industrial Property. Paris. 8vo.

1899. PICARD'S PATENT JOURNAL. *Reports of French Legal Decisions on Patents, Designs and Trade Marks.* (With an English Translation.) Paris. 4to. Yearly.

GERMAN EMPIRE.

1875. LANDGRAF (Josef). *Musterrecht und Musterschutz. Eine historisch-dogmatische Studie, nebst einem Gesetz-Entwurf für das Deutsche Reich.* Leipzig. 8vo. pp. xv., 188.

Contains a useful bibliography upon Foreign Design Law and Jurisprudence.

1878. MORILLOT (André). *De la Protection accordée aux Œuvres d'Art, aux Photographes, aux Dessins et Modèles industriels et aux Brevets d'Invention dans l'Empire d'Allemagne.*
Paris. 8vo. pp. vii., 164.

1891. SOCIÉTÉ INDUSTRIELLE DE MULHOUSE. *Lois Allemandes sur les Brevets d'Invention* (7 *Avril*, 1891), *et sur les Modèles de Fabrication* (1 *Juin*, 1891), *mises en vigueur le* 1 *Oct.*, 1891. Mulhouse. 8vo. pp. 16.

1896. GAREIS (E.). *Die patentamtlichen und gerichtlichen Entscheidungen in Patent-, Muster- und Marken-schutzsachen systematisch zusammengestellt.* Berlin. 8vo. (*In progress.*)

1899. STEPHAN (R.) und SCHMID (P.). *Der Schutz des gewerblichen Urheber-rechte des In-und-Auslandes.* (Bibliography by F. Lippert.) Leipzig. 8vo. pp. xviii., 531.

1899. SCHANZE (O.). *Das Recht der Erfindungen und der Muster.*
Leipzig. 8vo. pp. v., 518.

1903. ISAY (H.). *Patent-gesetz und Gesetz betreffend den Schutz von Gebrauchs-mustern.* Berlin. 8vo. pp. viii., 488.

1907. DIETRICH. *Die Geheimhaltung der Geschmacksmuster und die Zentralisierung der Musterhinterlegung Eine Untersuchung über den Musterschutz.* Plauen. 8vo. pp. 1,101.

INDIA.

1897. FRENCH (H. H.). *Indian Patentee's Guide.* Second edition. Calcutta. 12mo. pp. x., 80.

Chapter VIII. treats of Designs.

1907. PATENT OFFICE. The Inventions and Designs Act, 1888. *With . . . memorandum and directions.* Calcutta. 8vo. pp. 87.

JAPAN.

1897. JAPAN AGRICULTURAL, &c. DEPARTMENT. *Regulations respecting Patents, Trade Marks and Designs.* (With Translation.) Tokio. 2 pts. 8vo.

1898. HALL (W. S.). *A Review of the Japanese Patent Laws.* (Including the Regulations relating to Trade Marks and Designs.) London. 16mo. pp. viii., 31.

1901. HALL (W. S.). *A Manual of the Japanese Laws and Rules relating to Patents, Trade Marks and Designs.* London. 8vo. pp. 33.

RUSSIA.

1898. OSSOWSKI (C. von). *Rules of Practice relating to Patents, Trade Marks and Designs in Russia.* Berlin. Sm. 8vo. pp. 40.

SPAIN AND PORTUGAL.

1882. CUNHA FERREIRA (J. A.). *Renseignements sur les Patentes d'Invention et Marques de Fabrique, &c. Portugaises.* Lisbonne. 8vo. pp. 28.

1892. CALLEJA Y MADRID. *La Propriedad Industrial.* Legislacion Española sobre Patentes y Marcas de Fabrica, &c. en la Peninsular y Ultramar. Madrid. 8vo. pp. ix., 153.

1895. PORTUGAL: MIN. DES OBRAS PUBLICAS. *Propriedade industrial.* Decreto de 15 Dez 1894, e Regulamento de 28 Mar. 1895. Lisbon. 8vo. pp. 149.

SWEDEN AND NORWAY.

1886. SUÈDE ET NORVÈGE. *Lois de la Propriété industrielle, Brevets, et Marques de Fabrique*, &c.
Stockholm. 8vo. pp. 60.

SWITZERLAND.

1886. GANS (H.). *Étude sur la Protection legale des Inventions et des Dessins et Modèles industriels.* Genova. 8vo. pp. 150.
This work was written after the rejection of proposed legislation in 1882. The first Swiss Designs Act was not passed until 21st December, 1888.

1893. RAVIZZA (V.). *La Protezzione della Proprieta industriella nella Svizzera.* Milan. 8vo. pp. 23.

UNITED STATES.

1866. LAW (S. D.). *Digest of American Cases relating to Patents for Inventions and Copyrights*, 1789—1862.
New York. 8vo. pp. 697.

1870. LAW (S. D.). *Copyright and Patent Laws of the United States*, 1790—1870, *with Notes of Decisions, Forms*, &c. Third edition.
New York. 8vo. pp. xxxvi., 264.

1874. SIMONDS (W. E.). *Law of Design Patents.*
New York. 8vo. pp. viii., 216.

1880. FICE (D. H.) and (L. C.). *Digest of the Decisions of Law and Practice in the Patent Office from* 1869—1880.
Boston. 8vo. pp. 475.

1890. BEACH (E. S.). *Digest of the Decisions of Law and Practice in the Patent Office from* 1880—1890. Boston. 8vo. pp. 203.

1894. KNIGHT (G. H.). *Patent Office Manual.* (Including an Appendix of Copyright Decisions (Designs, Patents, Trade Marks, Labels, &c.).) Boston (Mass.). 8vo. pp. iv., 655.

1897. PATENT OFFICE. *Patent Laws and Laws relating to the Registration of Trade Marks and Labels, with Rules in Force February*, 1897. Washington. 8vo. pp. 144.

1898. HART (A. W.). *Digest of Decisions of Law and Practice in the Patent Office and the U.S. and States Courts in Patents, Trade Marks, Copyrights*, &c., 1886—98.
Chicago. 8vo. pp. xxvi., 385.

1898, &c. SANDERS (L. M.). *Annual Digest of the Decisions of the Supreme Court . . . the Federal Courts, and of the Commissioner of Patents in Matters relating to Patents, Trade Marks, Designs, Labels and Copyrights.*

Washington, 1899, &c. 8vo. (*In progress.*)

1890. GREELEY (A. P.). *Foreign Patent and Trade Mark Laws.* (A Comparative Study, with Tabular Statements and essential Features, Conventions and Statistics.)

Washington. 8vo. pp. 319.

1900. RICE (L. H.). *Digest of Decisions of Law and Practice in the Patent Office*, 1890—1900.

Boston (Mass.). 8vo. pp. xlix., 404.

COLLECTIONS.

1877. THIRION (Ch.). *Dessins et Modèles de Fabrique en France et à l'Étranger, Legislations comparées.* Paris. 8vo. pp. 144.

1886. EICHMANN (A.). *Traités de Commerce et d'Établissement. Conventions concernant la Propriété industrielle, artistique et littéraire. Tables Générales des Annales de la Propriété industrielle.* Paris. 2 vols. 8vo. pp. ix., 356.

1904. UNION POUR LA PROTECTION DE LA PROPRIÉTÉ INDUSTRIELLE. *Recueil des Traités, Conventions, &c., conclus entre les différents états en matière de Propriété Industrielle.*

Berne. 8vo. pp. 918.

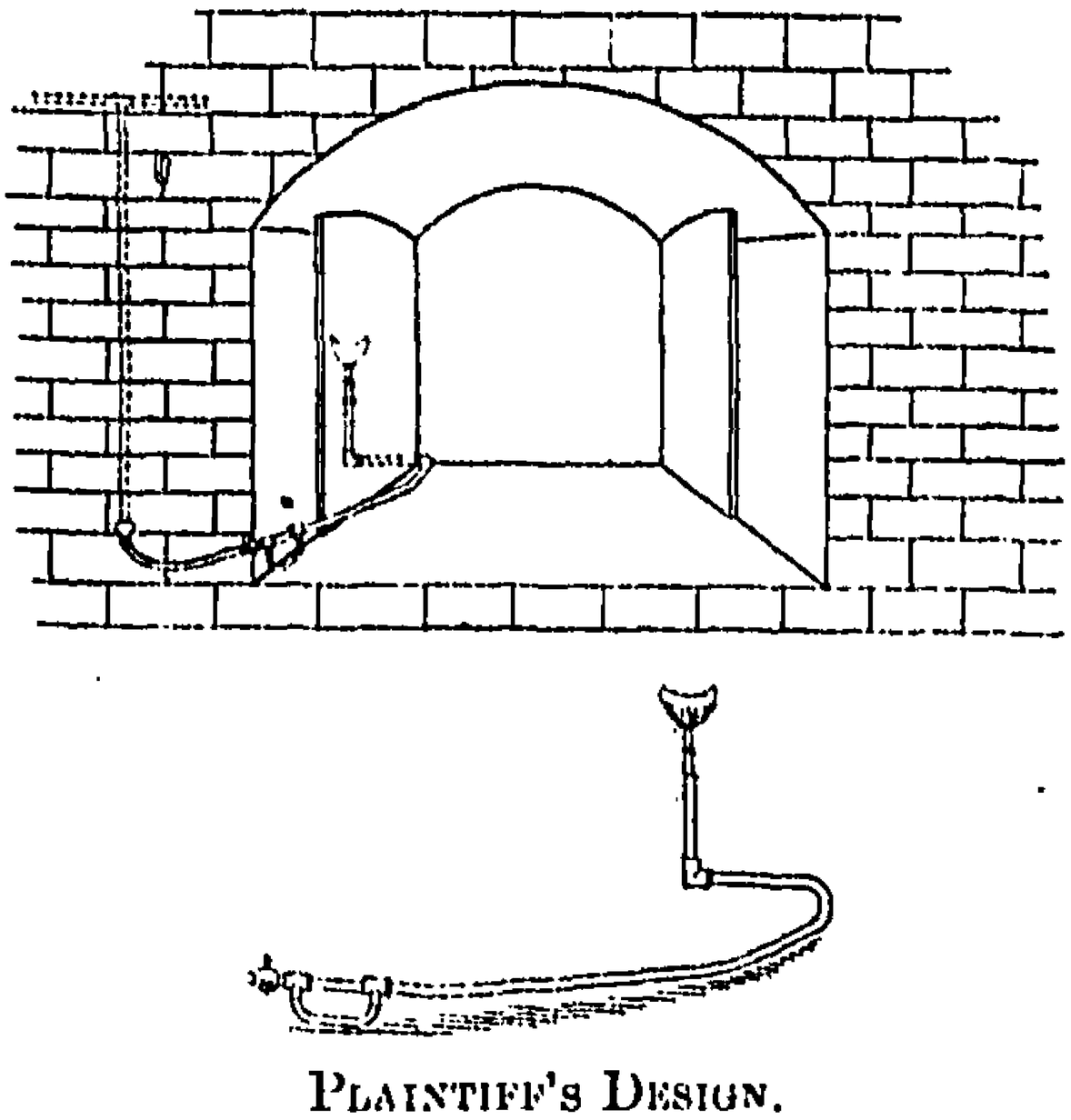
1905. CHAMBRE DE COMMERCE—PARIS. *De la protection des dessins et modèles appliqués à l'industrie en France et aux Etats-Unis.* Paris. 8vo. pp. 71, pl. 6.

APPENDIX F.—ILLUSTRATIONS.

(SHEET 1.)

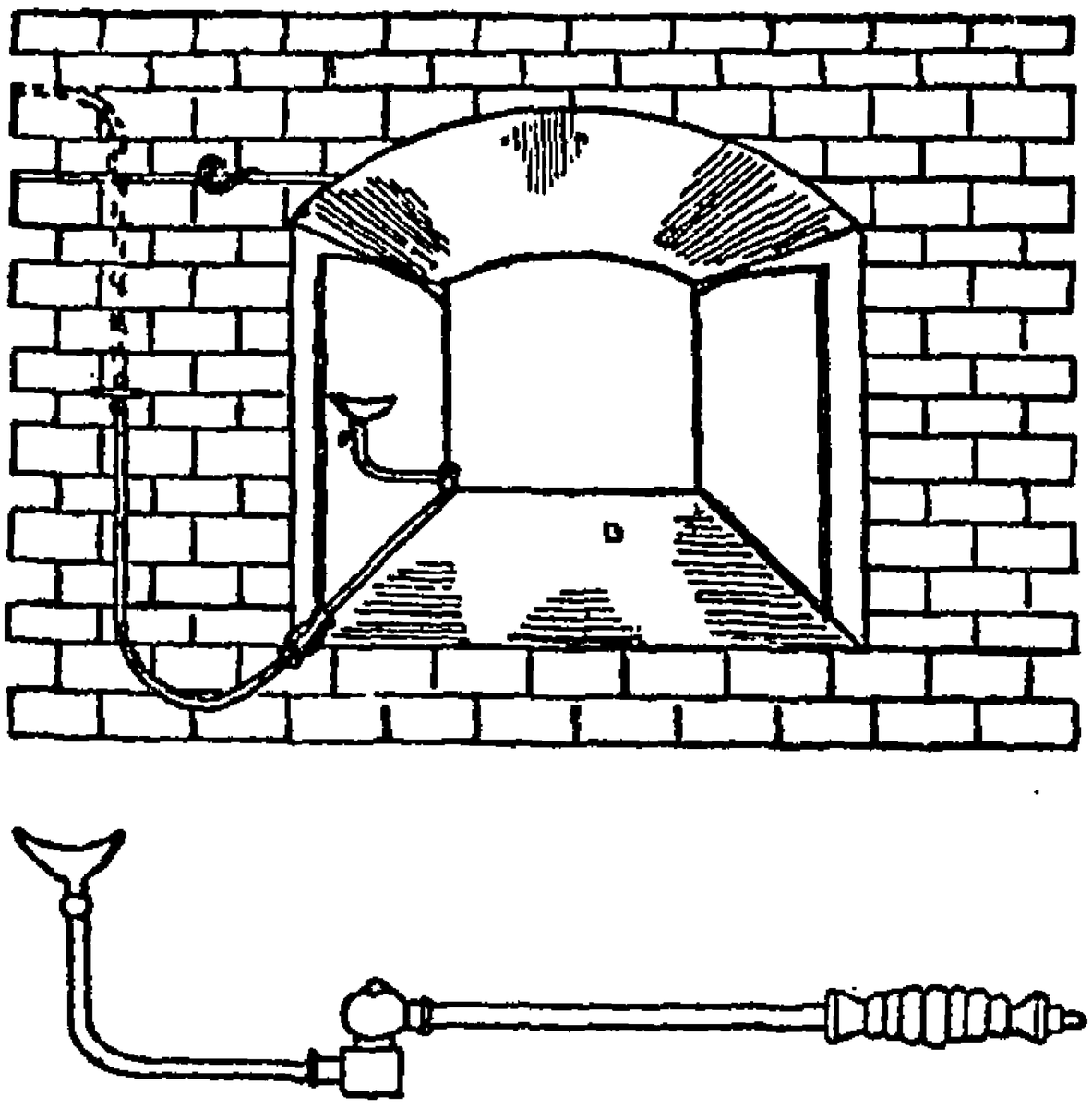
Gillard v. *Worrall* (1904), 22 R. P. C. 78.

FIG. 1.



PLAINTIFF'S DESIGN.

FIG. 2.



ALLEGED INFRINGEMENT.

Holden v. *Hodgkinson* (1904), 22 R. P. C. 102.

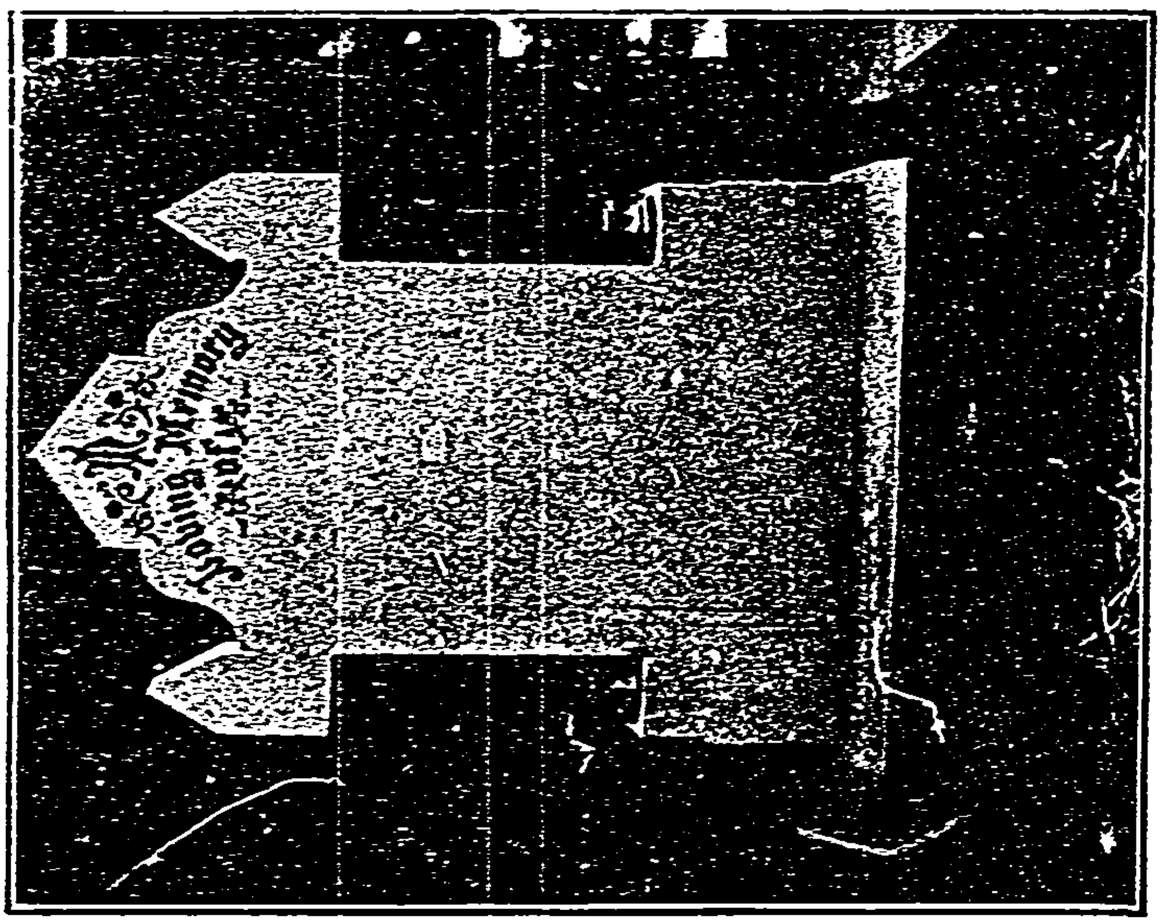


FIG. 2. ALLEGED INFRINGEMENT.

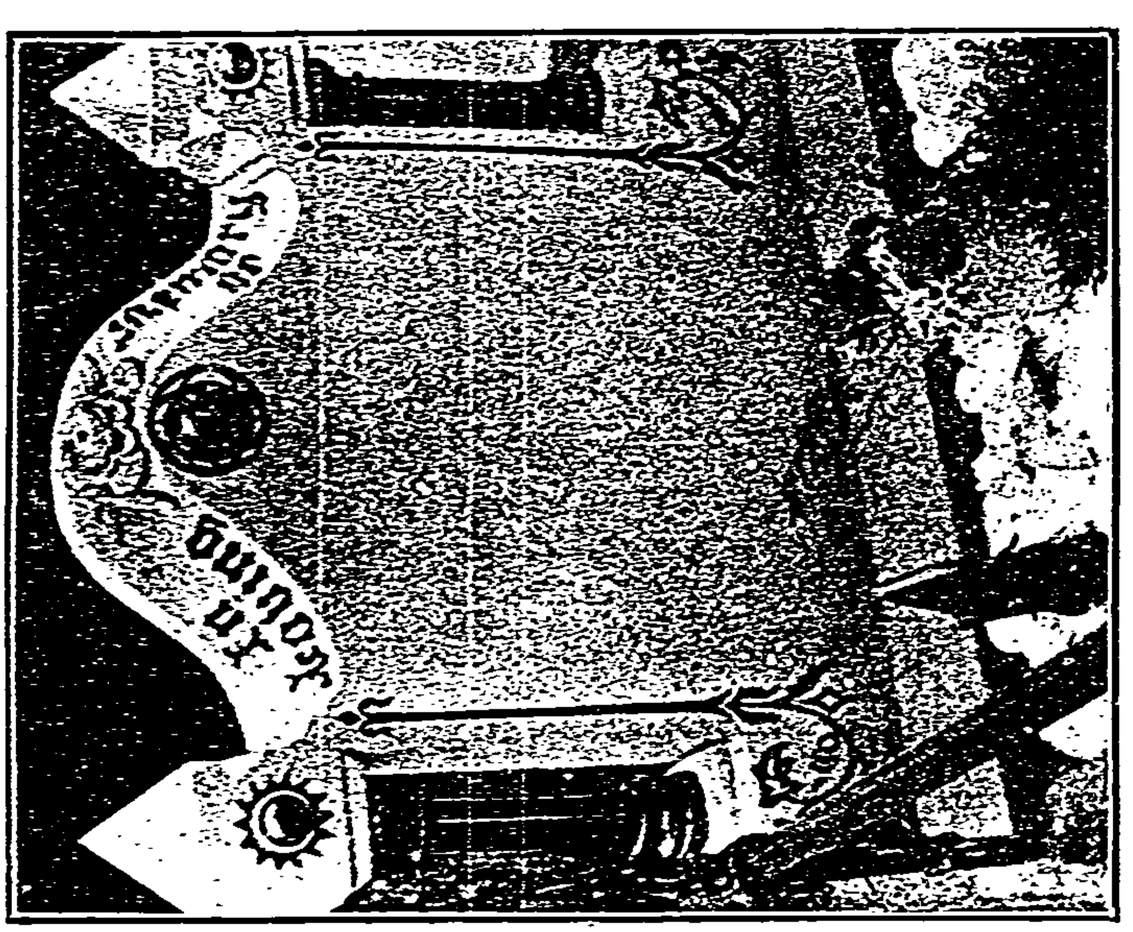


FIG. 1. PLAINTIFF'S DESIGN.

Staples v. *Warwick* (1906), 23 R. P. C. 609.

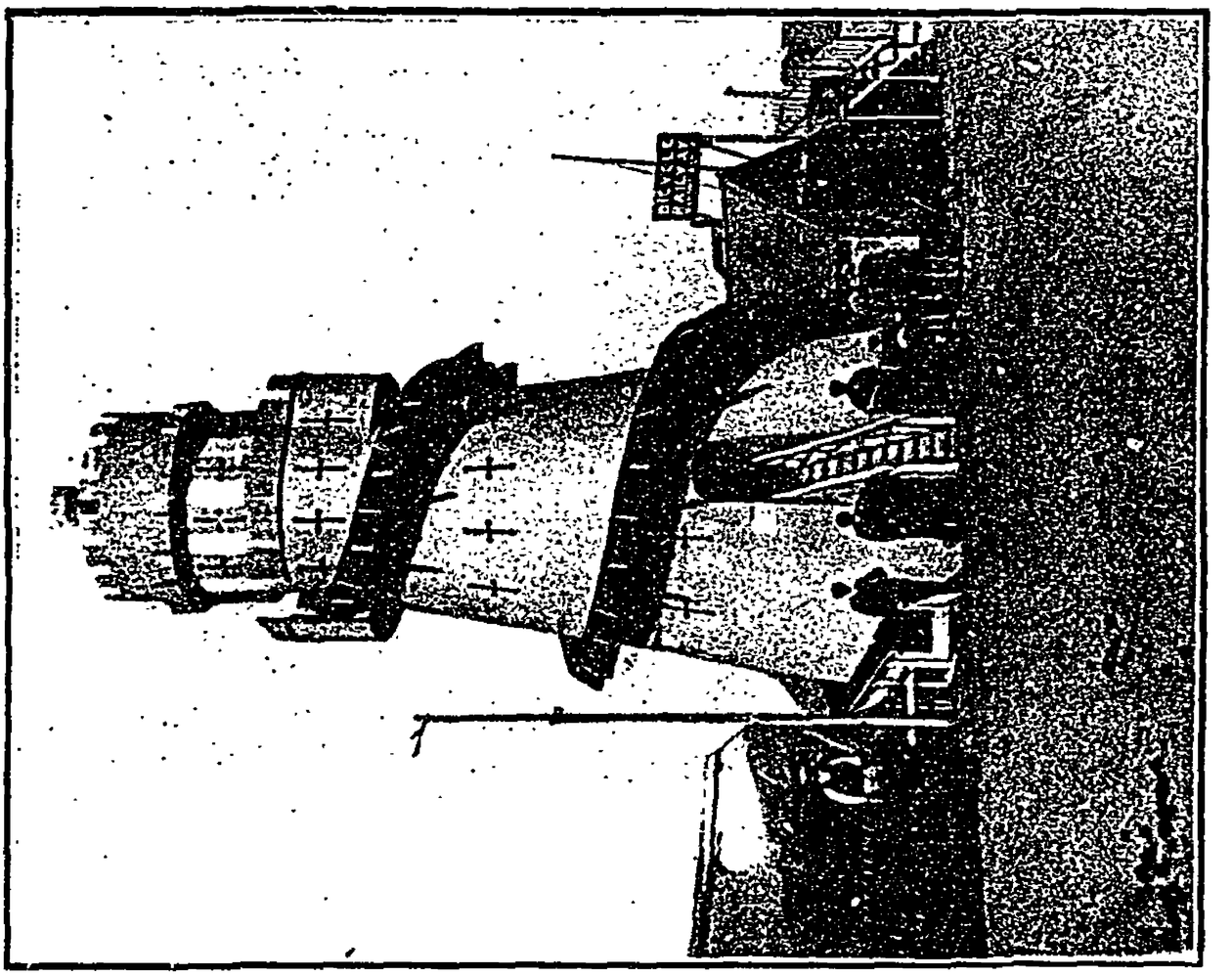


FIG. 2. ALLEGED INFRINGEMENT.

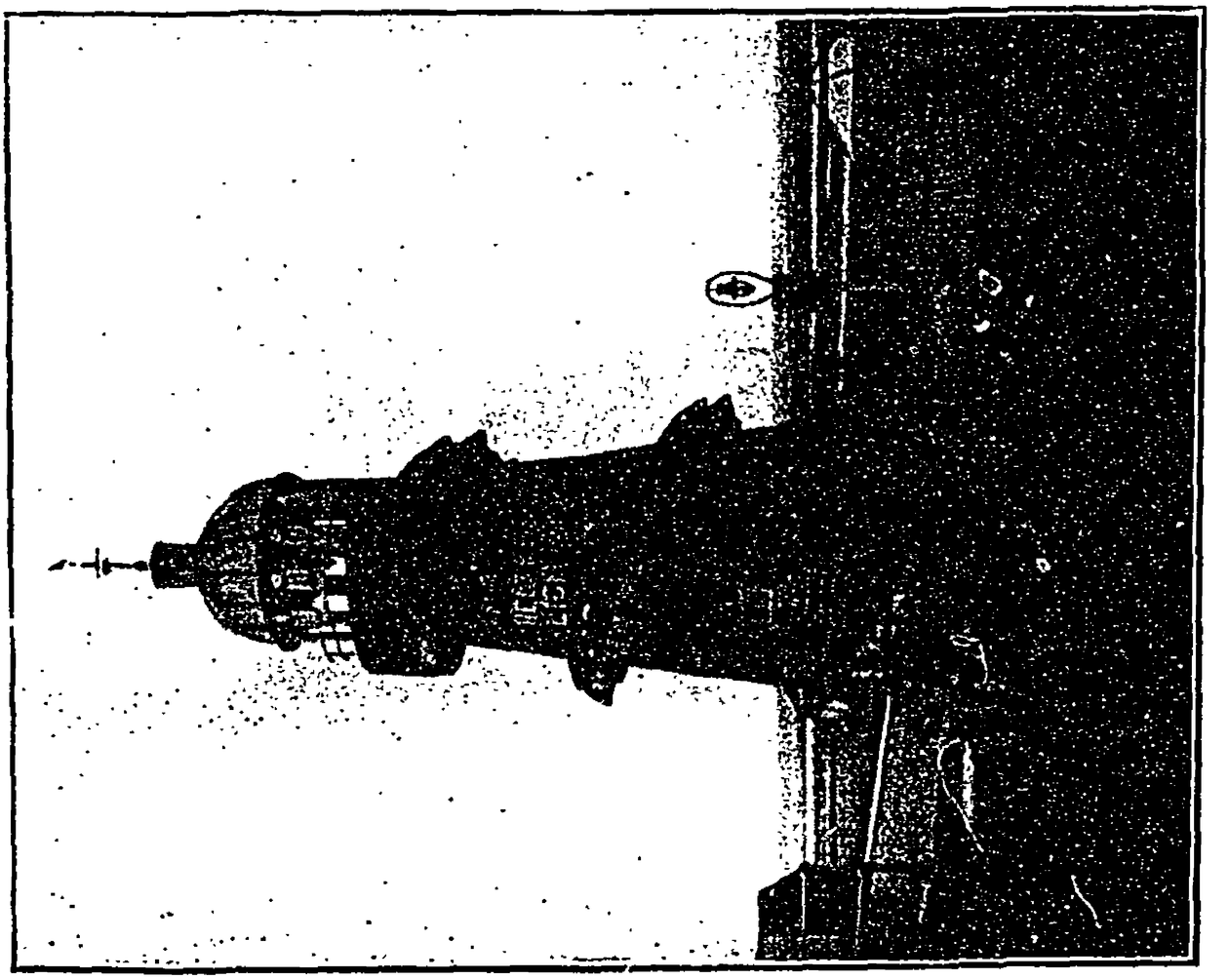
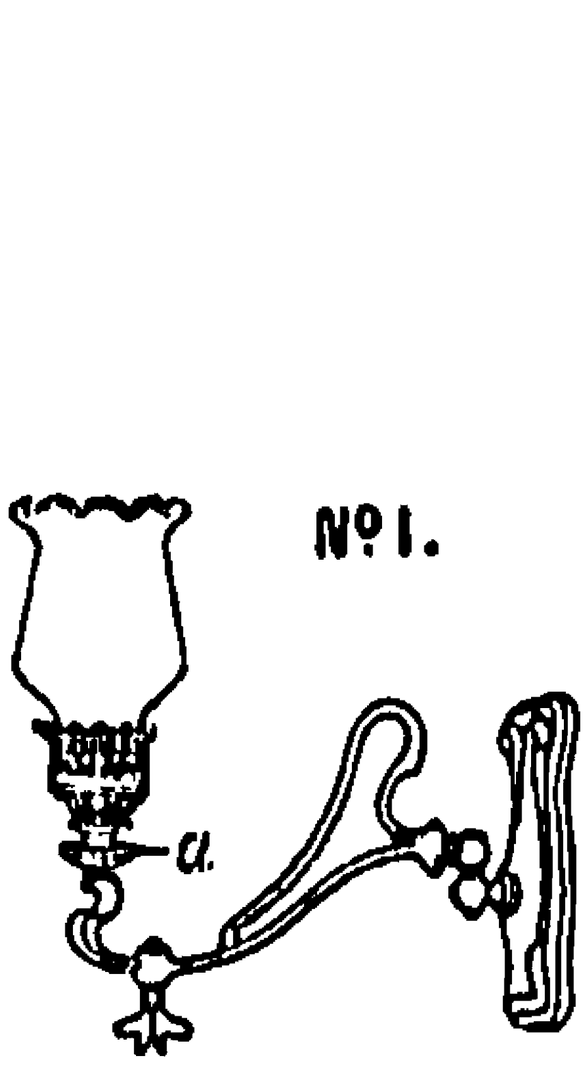


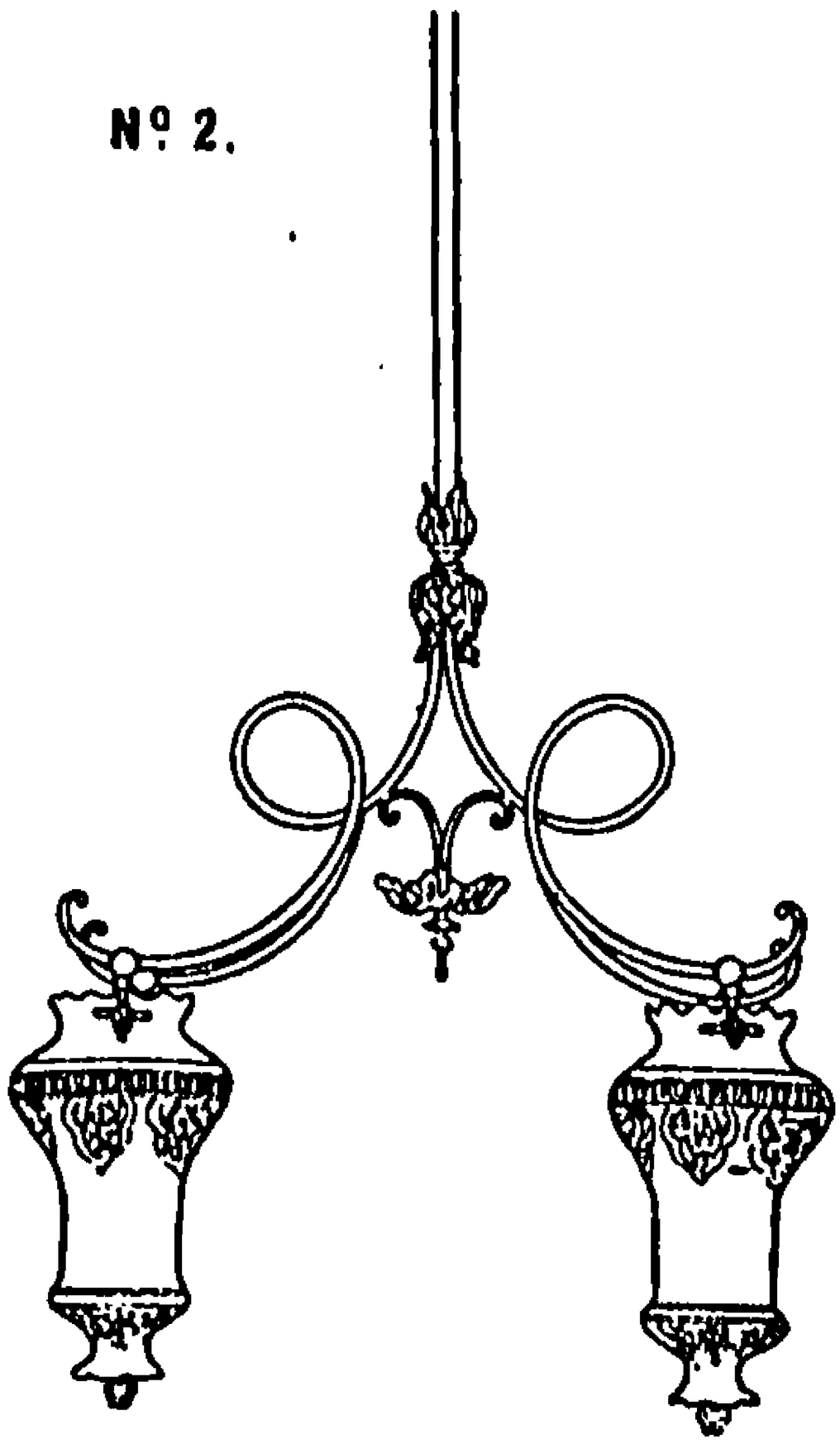
FIG. 1. PLAINTIFF'S DESIGN.

Ingram and Kemp v. *Edwards* (1904), 21 R. P. C. 463.

FIG. 1.

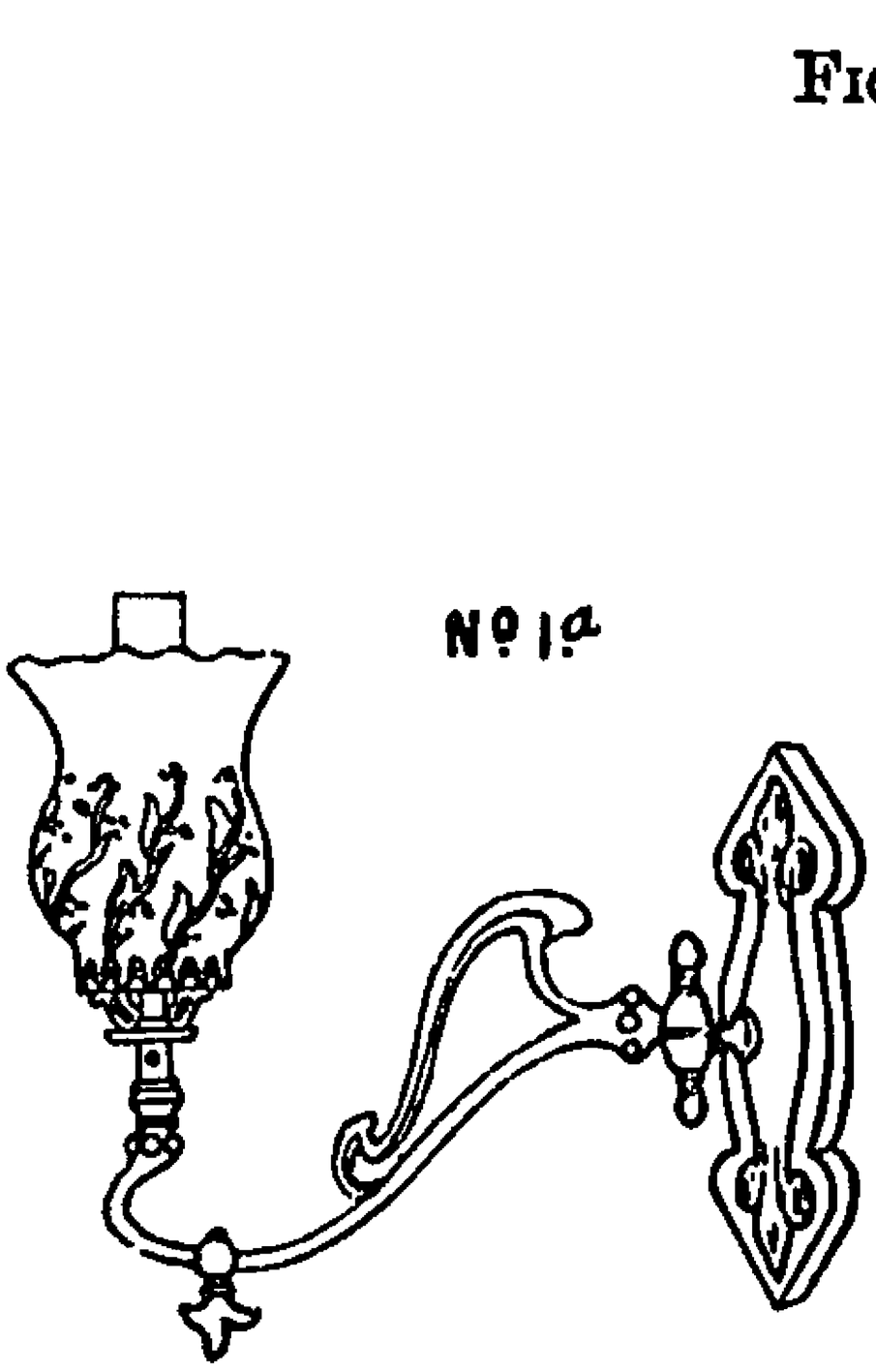


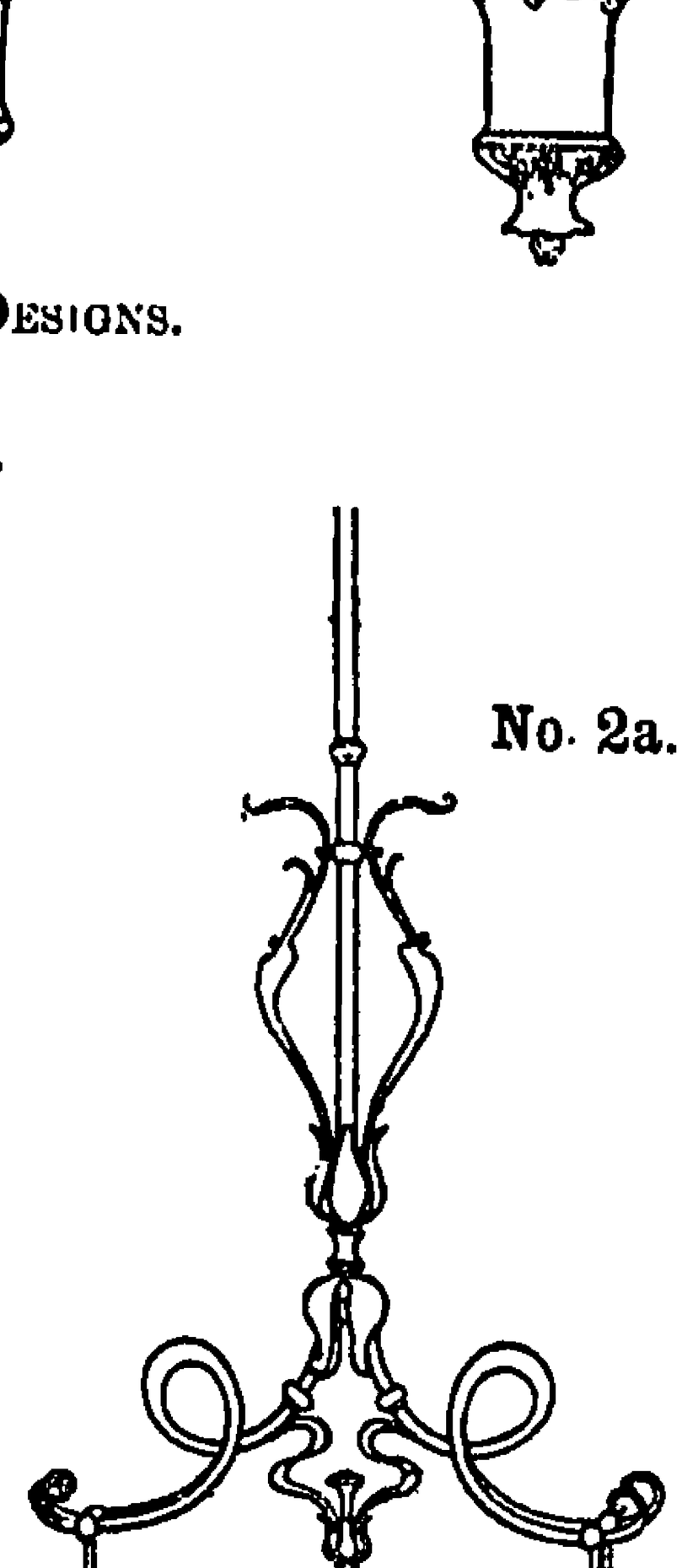
(*a*) Registration number and mark affixed here.



PLAINTIFFS' DESIGNS.

FIG. 2.

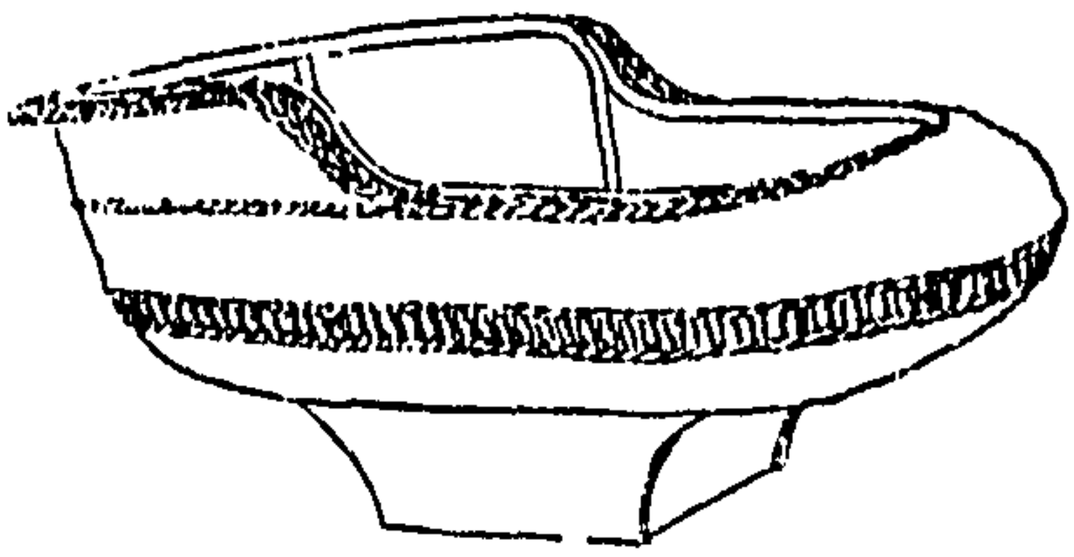




ALLEGED INFRINGEMENTS.

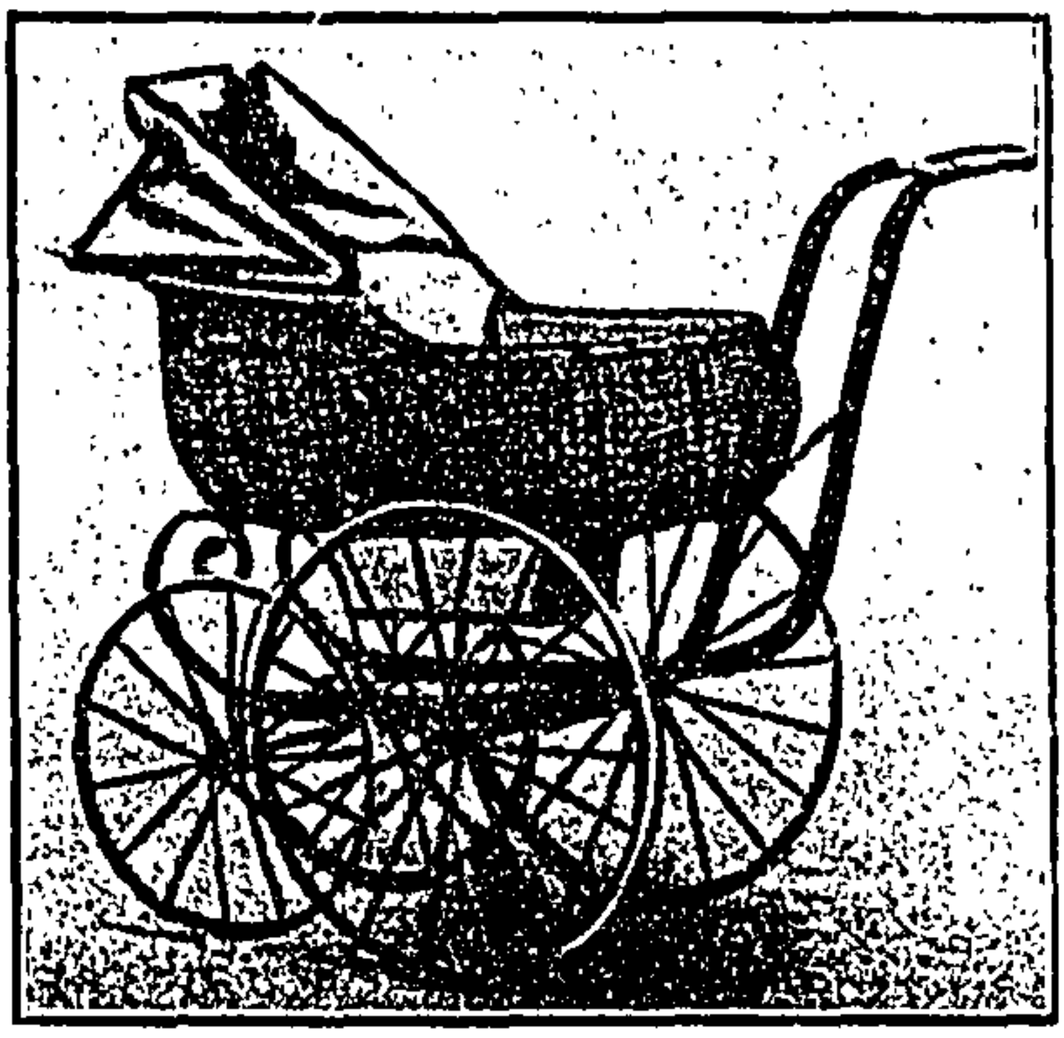
Re Pearson's Design (*Pearson* v. *Wilkinson*) (1906), 23 R. P. C. 738.

FIG. 1.



PLAINTIFF'S DESIGN.

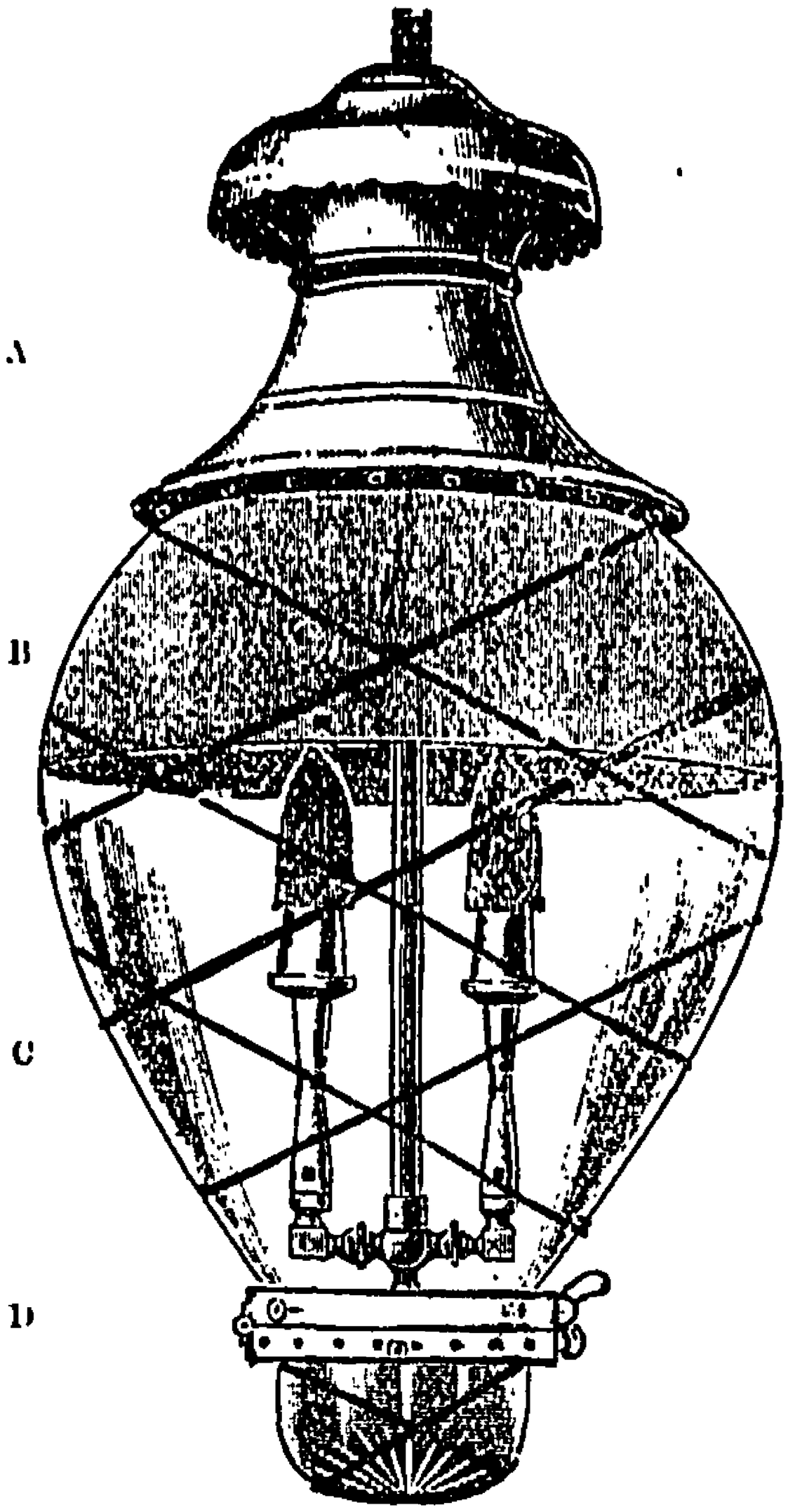
FIG. 2.



ALLEGED INFRINGEMENT.

Lea and Perrins v. *Price* (1901), 22 R. P. C. 123.

FIG. 1.



(A) Lamp-head constituting the registered design, as in Fig. 2.

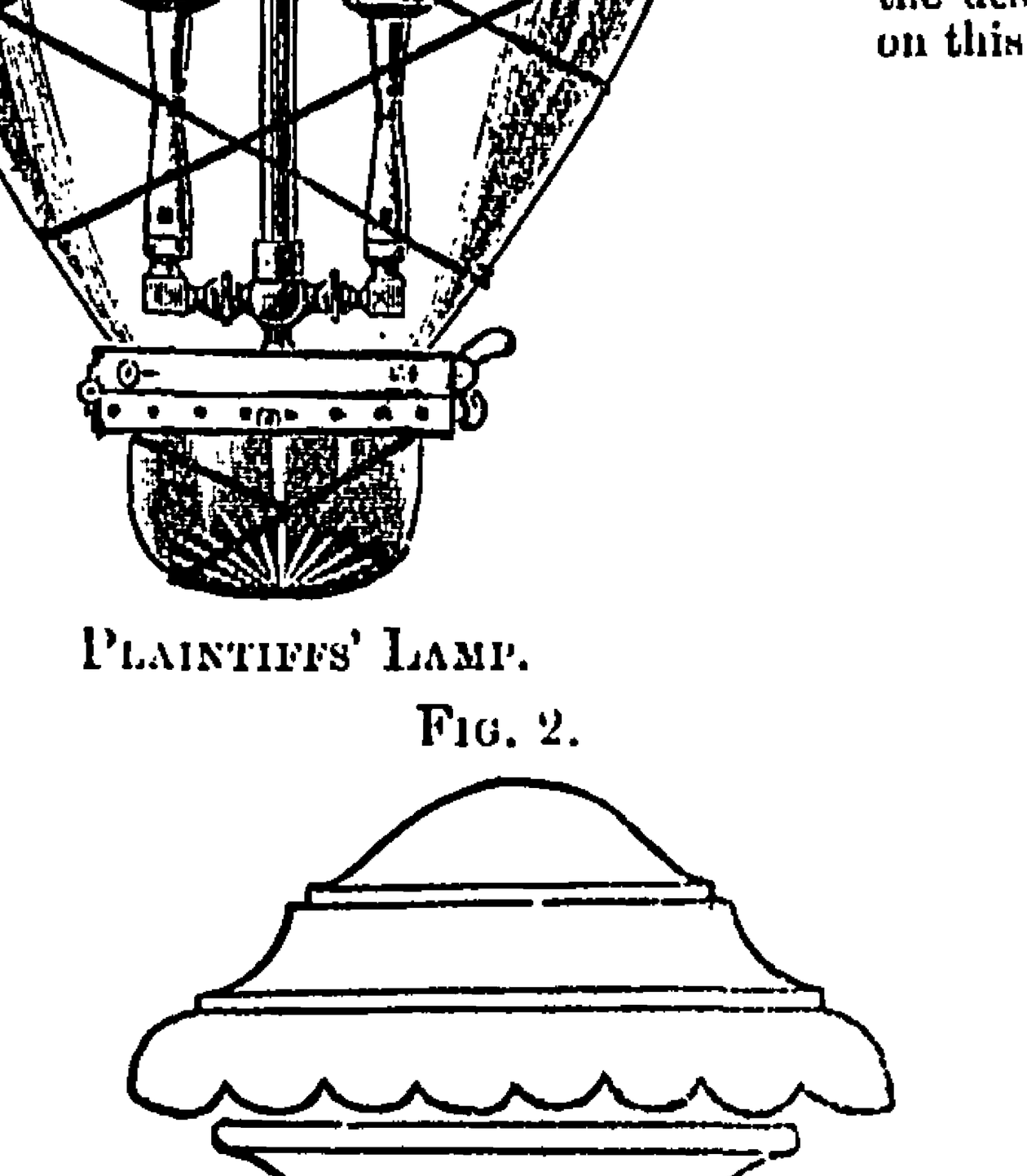
(B) Glass globe.

(C) Gas-piping fixed to the lamp-head (A), and attached by screws to the metal ring (D).

(D) Metal ring by means of which globe attached to the lamp-head (A). The registered number of the design was marked on this only.

PLAINTIFFS' LAMP.

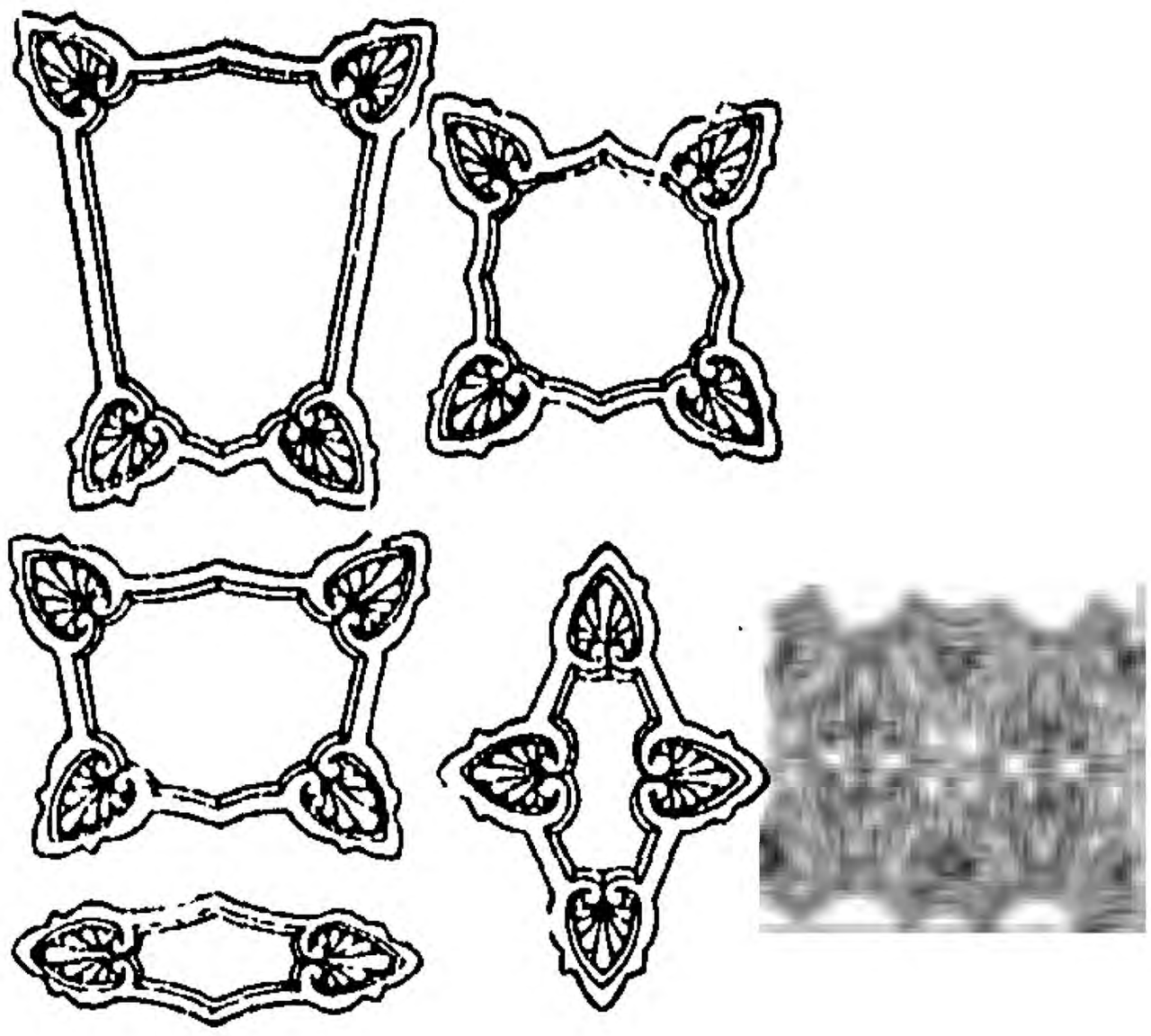
FIG. 2.



PLAINTIFFS' DESIGN AS REGISTERED.

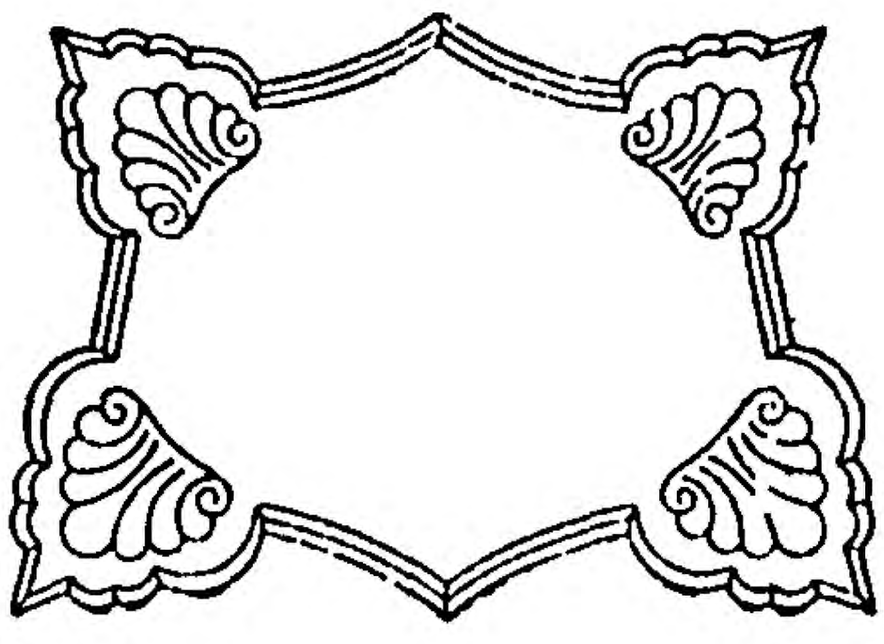
Re Rollason's Design (*Rollason* v. *Heath*) (1897), 14 R. P. C. 891.

FIG. 1.



PLAINTIFF'S DESIGNS.

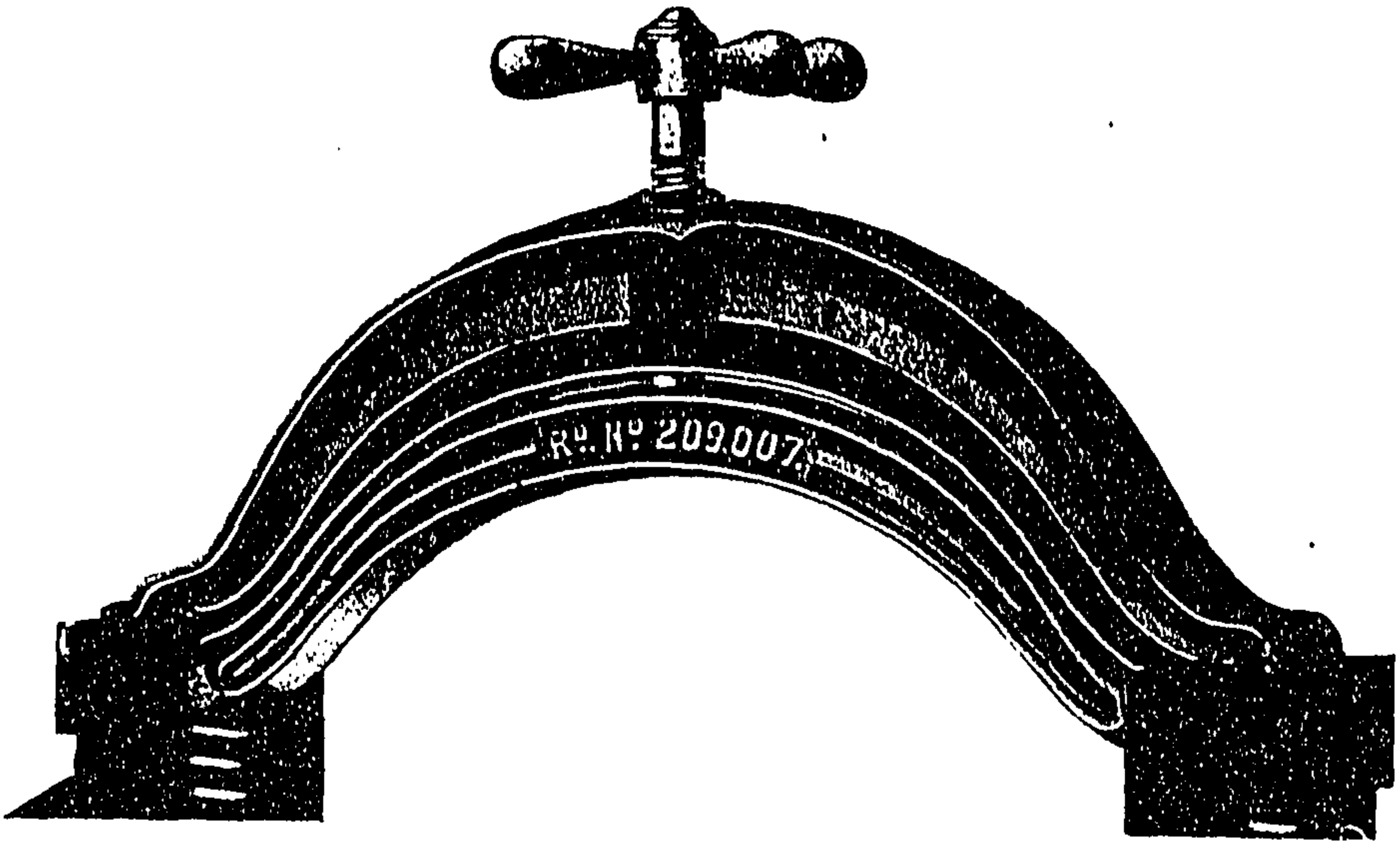
FIG. 2.



ALLEGED ANTICIPATION.

Varley v. *Keighley Ironworks* (1897), 14 R. P. C. 170.

FIG. 1.



PLAINTIFF'S DESIGN.

FIG. 3.

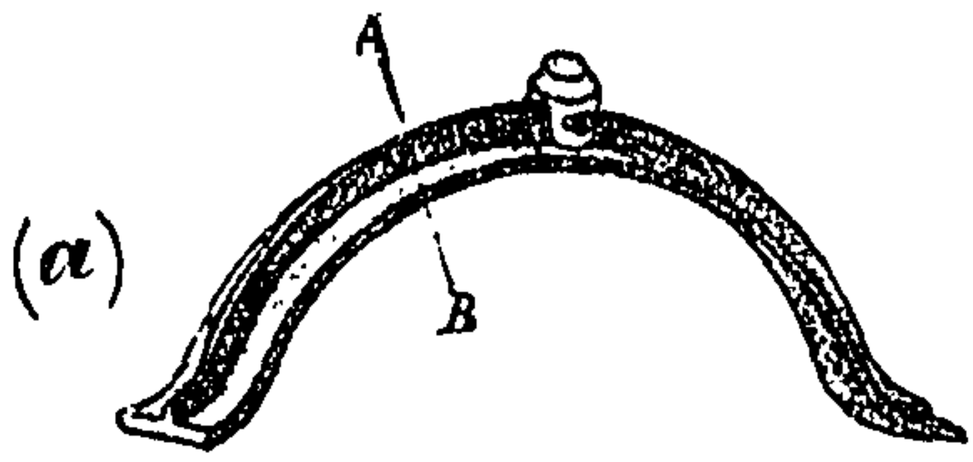
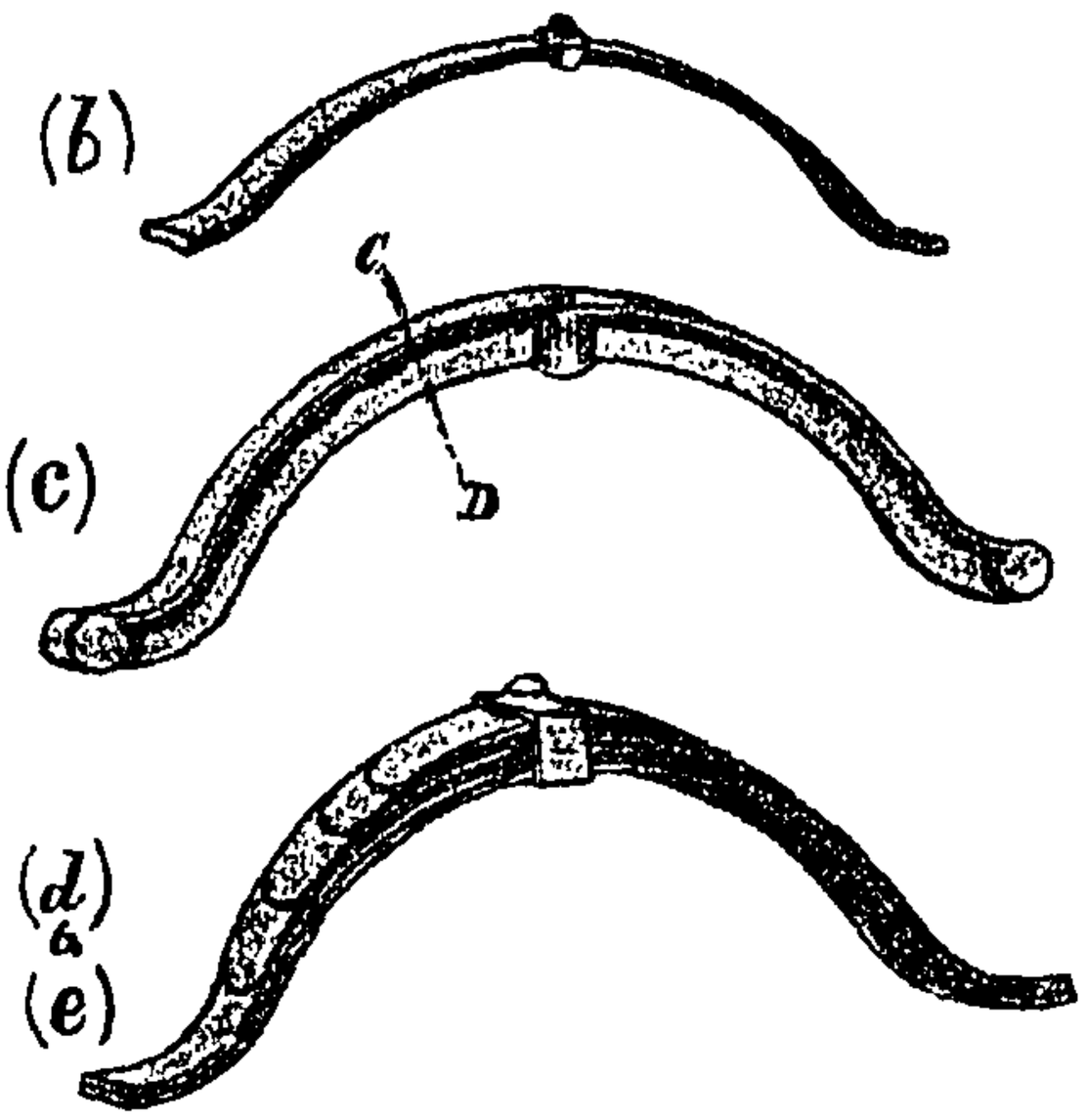


FIG. 2.



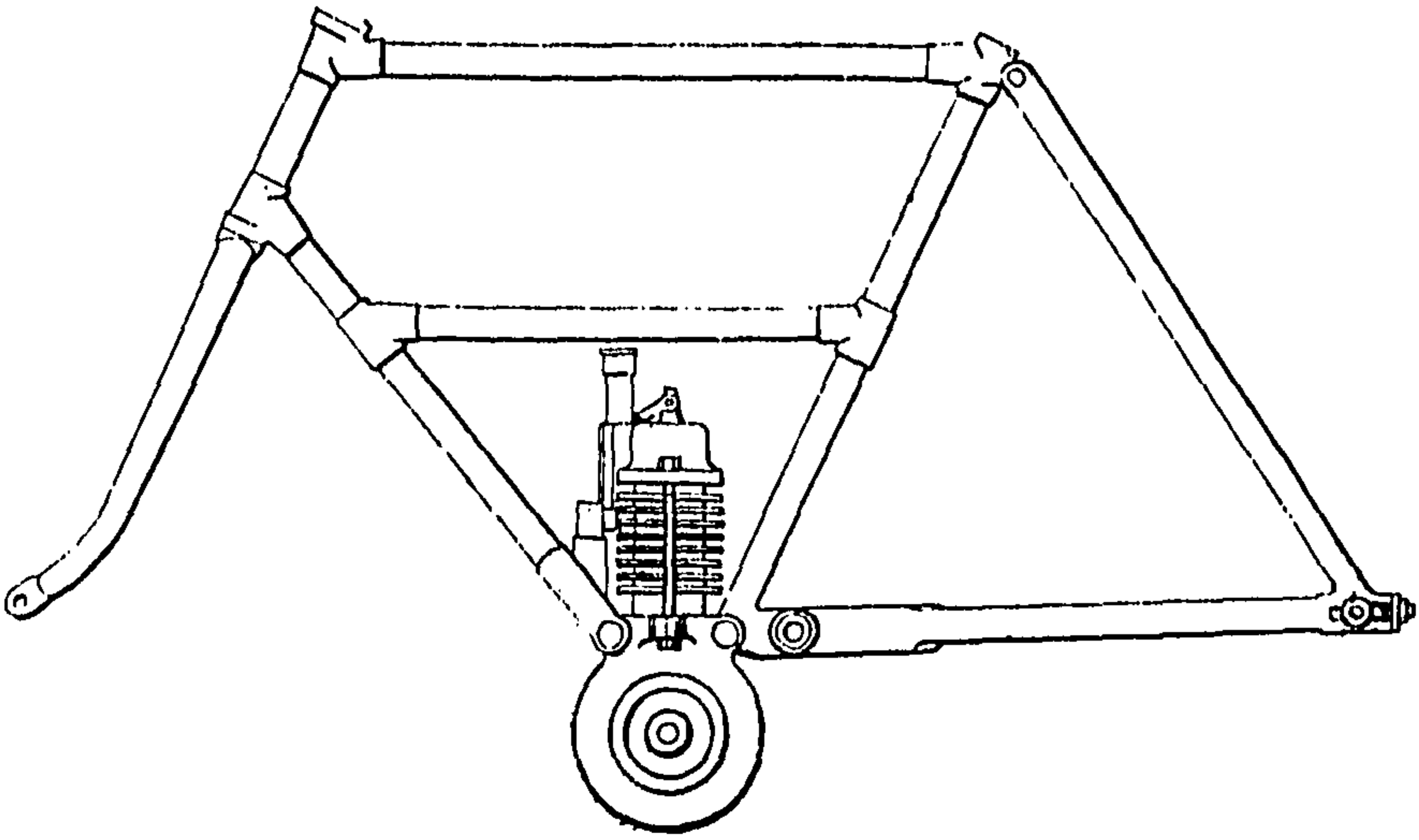
ALLEGED INFRINGEMENT.



ALLEGED ANTICIPATIONS.

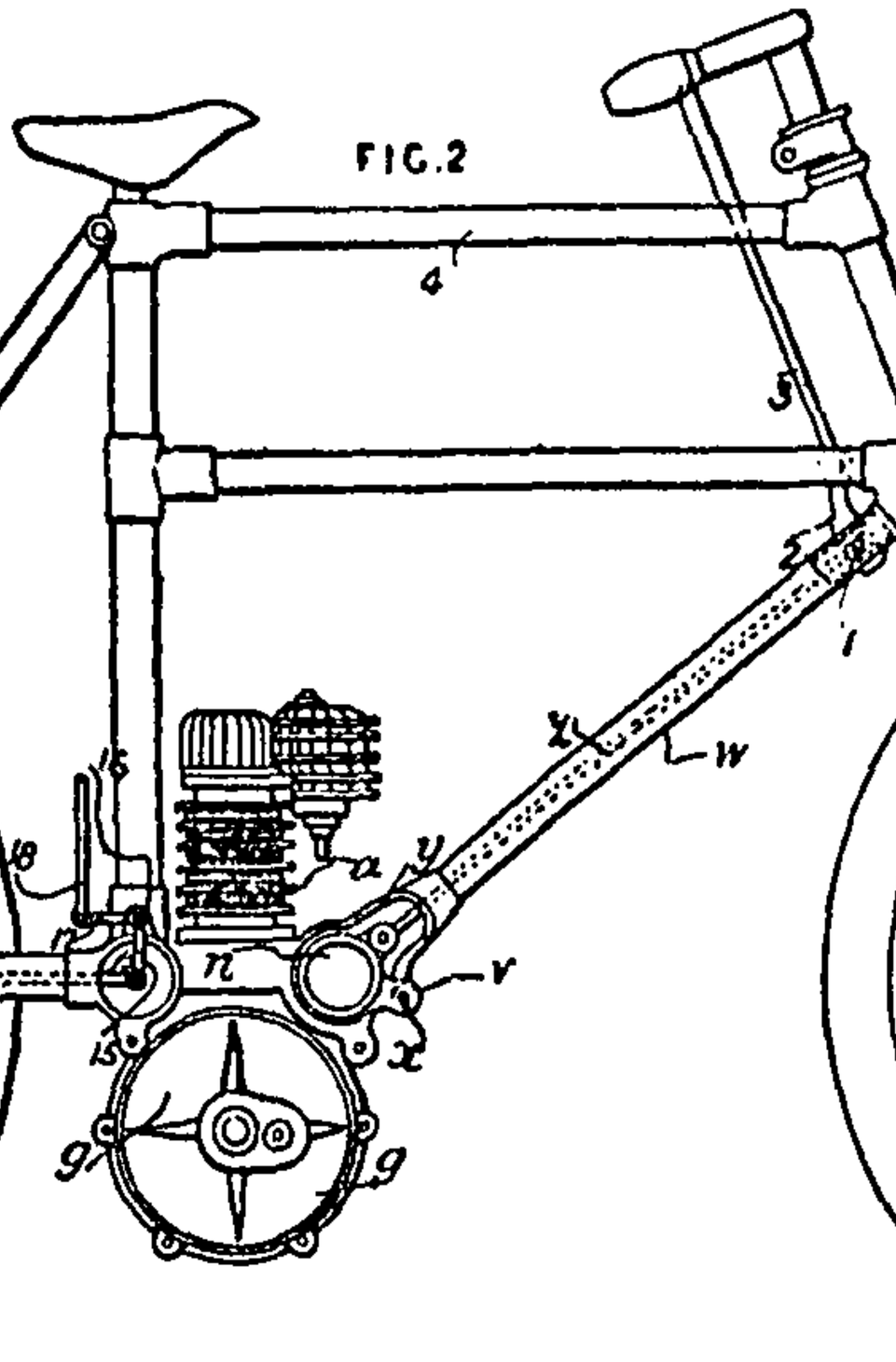
Warner Motors v. *Gamage's* (1904), 21 R. P. C. 621.

FIG. 1.



PLAINTIFFS' DESIGN.

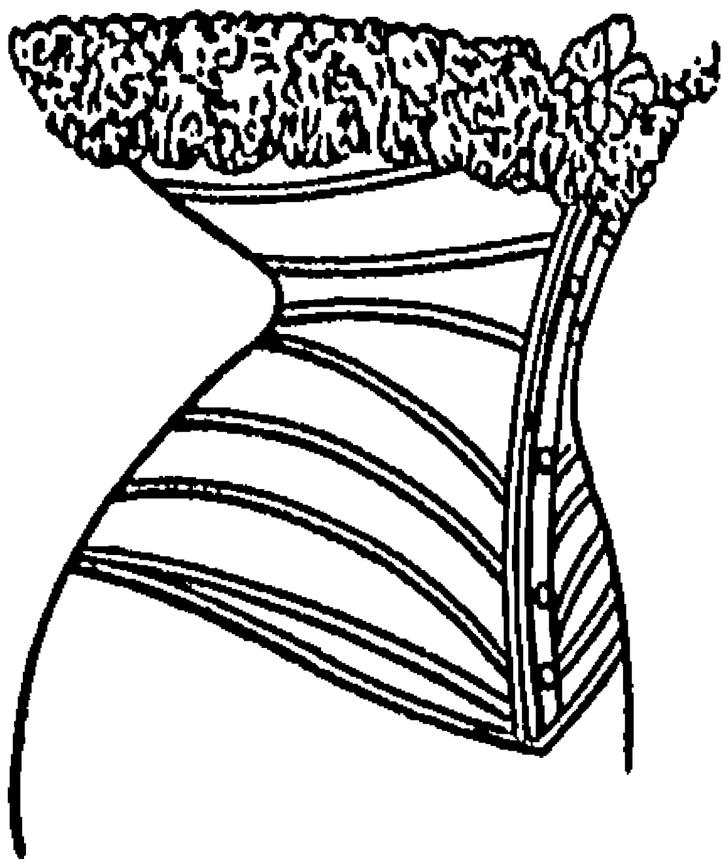
FIG. 2.



ALLEGED ANTICIPATION.

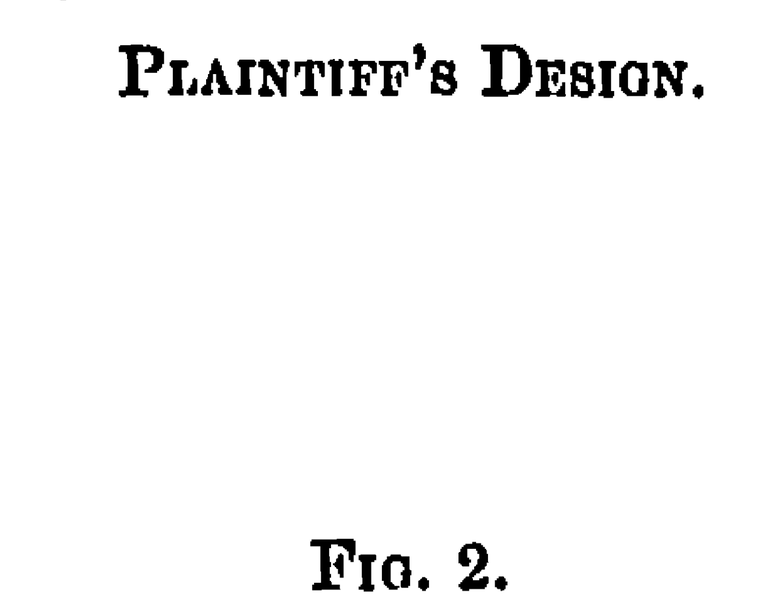
Re Bayer's Design (*Bayer* v. *Symington*) (1906), 23 R. P. C. 553.

FIG. 1.



PLAINTIFF'S DESIGN.

FIG. 2.



ALLEGED ANTICIPATION.

Oliver v. *Thornley* (1896), 13 R. P. C. 490.

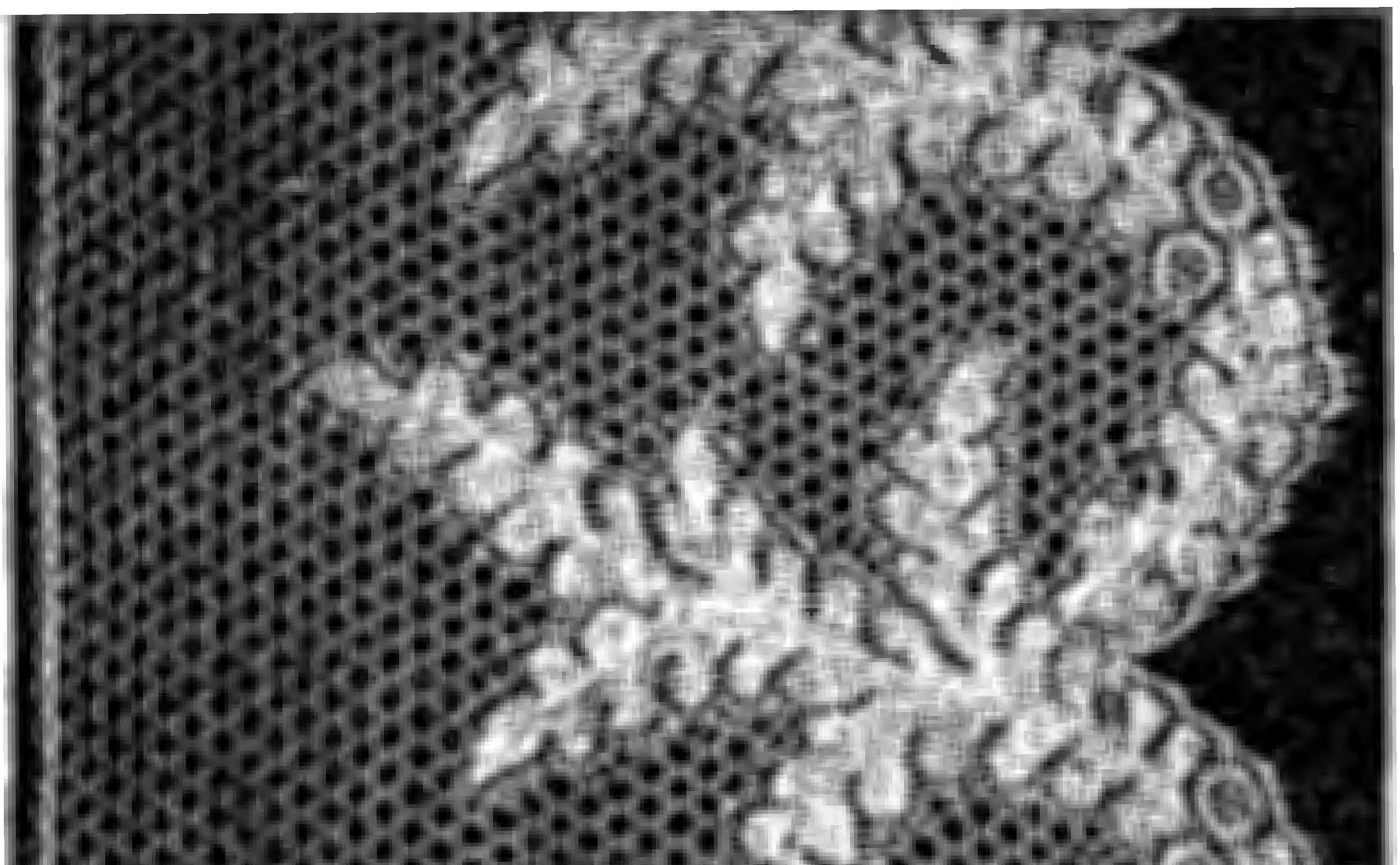


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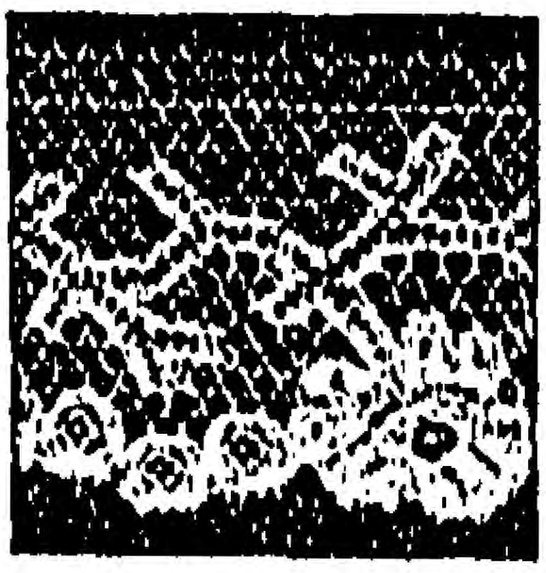
ALLEGED INFRINGEMENT.



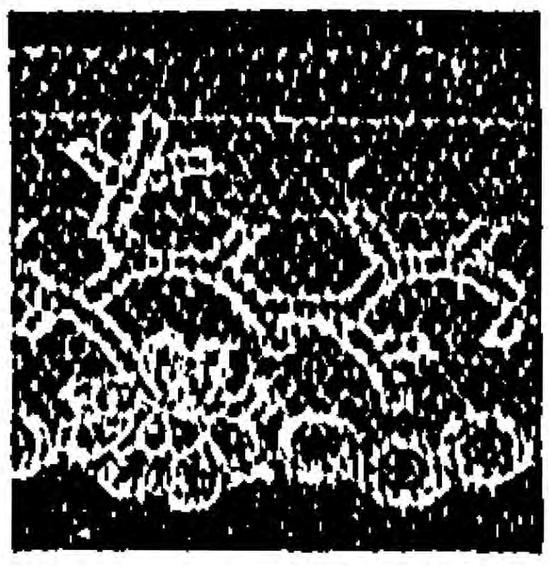
FIG. 1.

PLAINTIFF'S DESIGN.

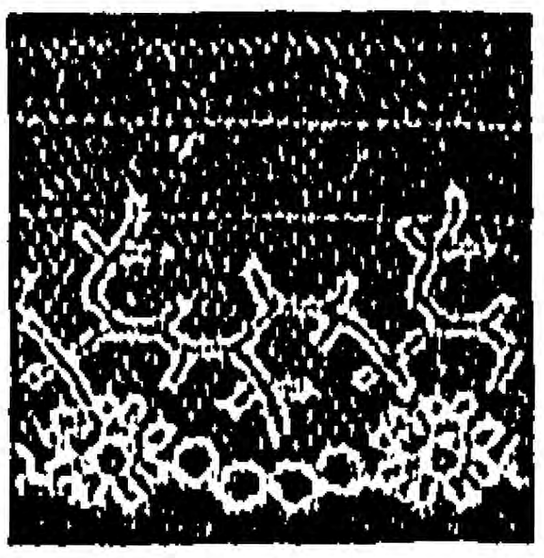
Birkin v. *Pratt* (1895), 12 R. P. C. 371.



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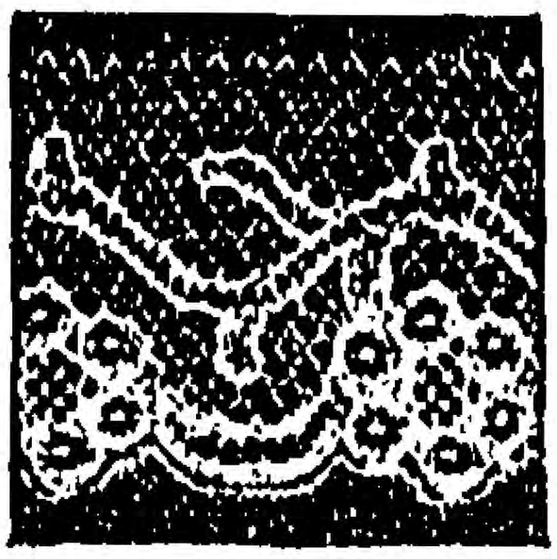


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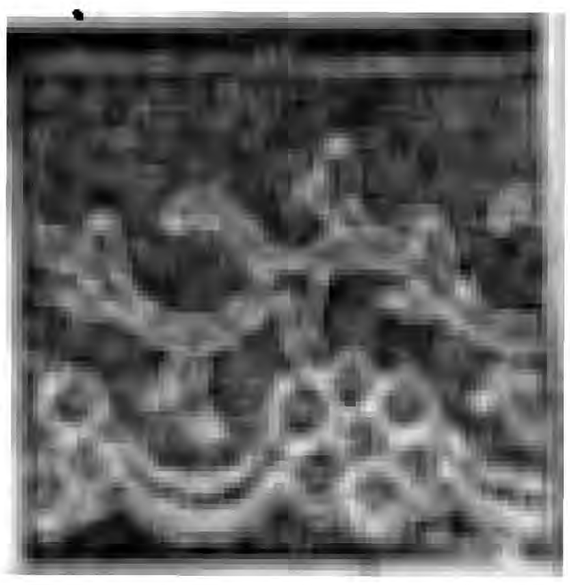


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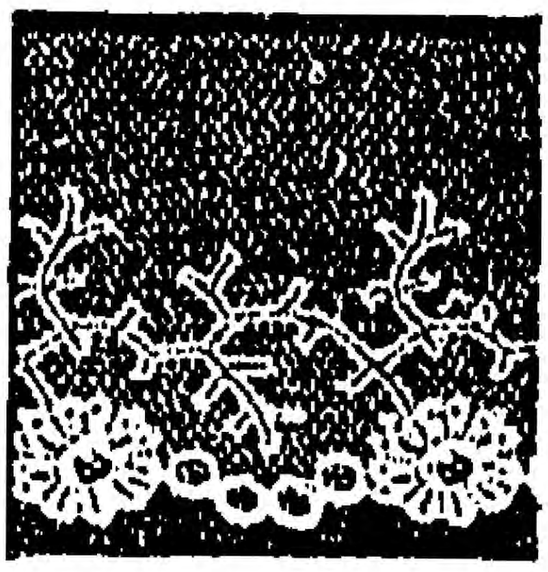
PLAINTIFF'S DESIGNS.



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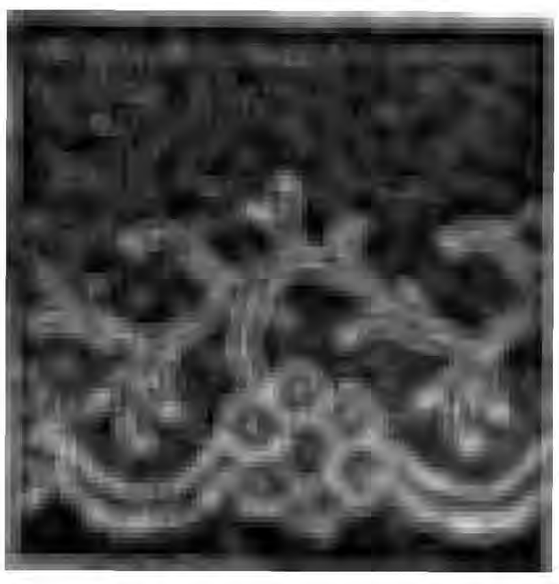


2A

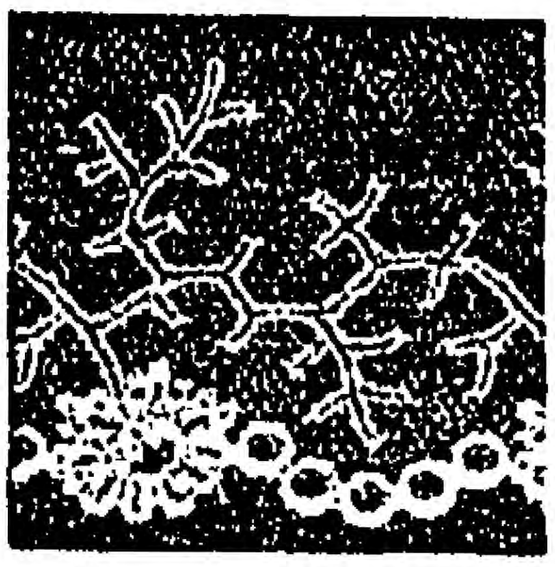


3A

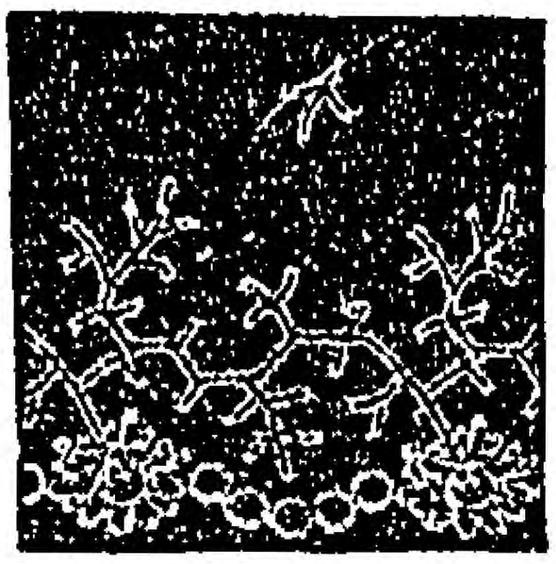
ALLEGED INFRINGEMENTS.



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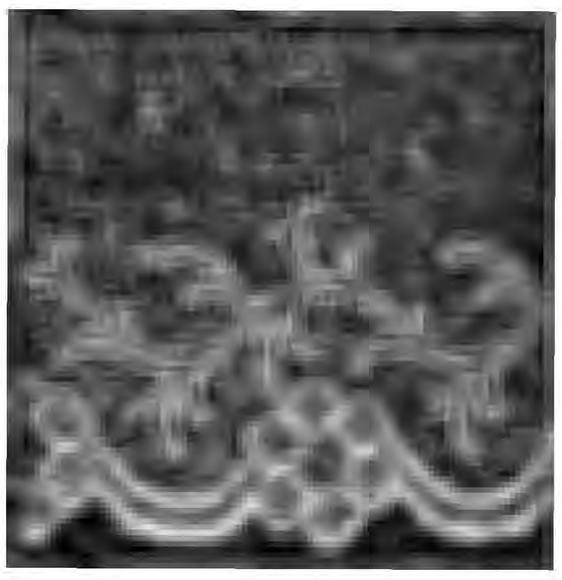


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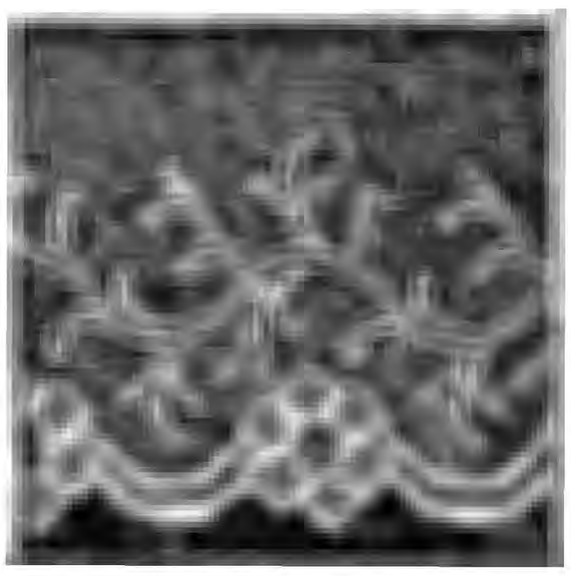


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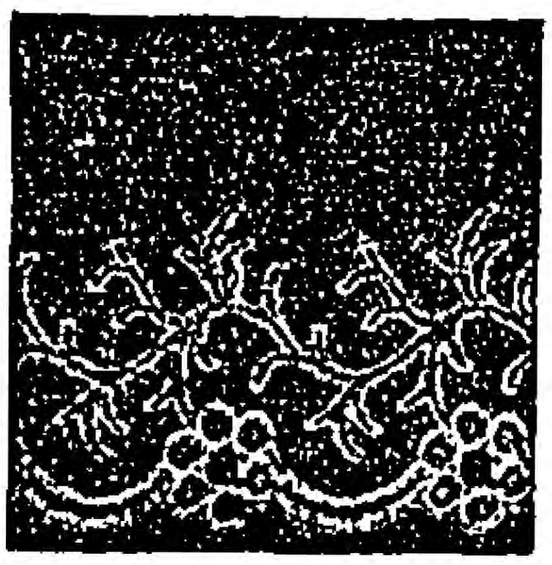
PLAINTIFF'S DESIGNS.



4A



5A



6A

ALLEGED INFRINGEMENTS.

INDEX.

[The more important References are in **heavier type.**]

ABANDONMENT
of application through non-completion, 74, 83, **225**, 255.
notice to be given before, 74, **299**.

ACCEPTANCE OF APPLICATION
by Comptroller, powers of, **298**.
to be entered on register, **309**.

ACTION
for infringement, **179**. (And see ACTION FOR INFRINGEMENT.)
for rectification of the register, no action allowed, **109**.
for threats of legal proceedings, **211**.

ACTION FOR INFRINGEMENT (CHAPTER XI.), **175**. And see INFRINGEMENT.
parties, 179.
plaintiffs, **179—182**.
mortgagor, 180.
registered proprietor, **179**.
assignees and licensees, 126, **179**, 281.
trustee, 180.
agents as, **181**.
unregistered proprietors as, **182**, 245.
defendants, **182**.
where several infringers, 183.
agents as, **183**.
purchaser from licensee, **188**.
principals liable as, **183**.
notice before action, **184**, 248.
writ, **184**, 185.
form of indorsement, **390**.
pleadings, **185**.
statement of claim, **185**, 390 *et seq.*
defence, **186—189**, 393 *et seq.*
reply, **186**, 399.

ACTION FOR INFRINGEMENT—*continued.*
particulars of breaches and objections in, **189**, 190.
amendment, 190, 191.
effect of, 190.
where common knowledge alleged, 192.
forms of, **392**, **396**.
defences open to party sued, **186**—189.
inspection and discovery, **192**, **195**.
samples, **192**.
interrogatories, **195**, 240.
in action for penalties, **198**.
mode of trial, **198** *et seq.*
Court in which should be brought, **176**, **178**, 198, 249.
place of trial, 178, 182.
costs, 174, **201** *et seq.*
of motions, 203.
of distinct issues, 201, 202.
injunctions, **166**—**169**.
interlocutory injunctions, 170—173.
notice of motion for, **398**.
forms, **398**, 399.
damages, **163**—**166**, 249.
amount to be proved, 164.
form of inquiry as to, **400**.
penalties, recovery of, **160**—**163**, **243**.
principle on which the amount is fixed, **162**, 249.
election between, and damages, 185.
delivery up of articles to which design improperly applied, 172.
form of order for, **398**.
limitation of action, 196.
judgment only valid as between parties to the action, 188.
evidence in. (See EVIDENCE.)
grounds for. (See INFRINGEMENT.)
burden of proof in. (See PROOF.)
issues for judge and jury, **200**.
of law in, triable separately, 200.
power to direct, **192**.
tribunal, choice of, **178**.
Comptroller's certificate no answer to, **235**.
consolidation where several, 172, **180**.
failure of, through defect in registration, 180, 181, 245.
appeals in, tribunal for, **276**.
application to rectify, in answer to, **110**.
for cancellation, pending, **186**.
jurisdiction of County Court in, **176**.
jurisdiction in Scotch and Irish cases, **177**.
where sale or delivery abroad, **186**.

ACTS. See TABLE OF STATUTES, p. xxxvii. *et seq.*
comparative table of sections in Acts of 1883 and 1907...xx. *et seq.*

ADDRESS,
nature of, to be given, **292.**
where registered proprietor lives abroad, **15**, 292.
form for, **376.**
alteration of, to be registered, **293**, 304.
form for, **382.**
of proprietor to be entered in register, **93.**
of assignee, etc. to be entered in register, **95**, 96.
error in, to be corrected by Comptroller, **91.**

AGENT,
applications and other communications by, **73**, **95**, 220, 294.
may be heard before refusal to register, **225.**
may be liable for infringement, **145**, **183**, 245.
for sale, no right to registration as proprietor, **121.**
persons who cannot be recognised as, 73, **266.**
definition of, **289.**
improper use of name of owner by, rectification where, 101.
as plaintiff in action for infringement, 181.

AGGRIEVED PERSON
may appeal from refusal to register, 88 *et seq.*
rectification at suit of, **104** *et seq.*, 259.
who is an, 104, **107**, 259.
costs on application by, 260.

AMBIGUITY
in application for registration, **81.**

AMENDMENTS,
power of Comptroller as to, 15, 86, **255**, 307.
copies of, to be sent to Scotland, Ireland, and Isle of Man, 92, **264.**
fees on, 319.
form for, **382.**

ANTICIPATION. (See NEW AND ORIGINAL.)
eye the judge of, **43**, 44, 222.
expert evidence as to, **43**, 223.

APPEAL
from Comptroller on refusal to register, 9, 14, 89, 218, **225**, 261, 316.
grounds of, to be stated, 89, 316.
notice of, **316.**
fees, 89, 319.
from Comptroller or Board of Trade to Court, **99**, 225, 259.

APPEAL—*continued.*
from Comptroller on cancellation for manufacture abroad, **113**, 311.
on questions of renewal of copyright, **230**.
on question of costs, 245.
on application for rectification of register, **111**, 259, 270.
indirect, as "person aggrieved" on refusal to register, **99**, 259.
evidence available for, 112, **263**.
general right of, from decision of Comptroller, 270, 299.
form of notice of, **388**.
form of order for injunction and inquiry on, **399**.
form of order as to inquiry on, **400**.

APPLICANT. (And see APPLICATION and APPLICATION FOR REGISTRATION.)
must state nature of design, 219, 295.
must state class in which design to be registered, **84**, 220, 295.
must state purpose of design, **74**, 220, 296.
must state novelty he claims, **74**, 220, 296.
living abroad, treatment of Comptroller with application, 220.
must pay costs in appeals, **90**, 225.
notice to, before cancellation, 113, 225.
priority of, in protection under international arrangements, 274.
may appoint agent to represent him, **73**, 294.
responsible for service on agent, 183, 294.
to have notice of objections to application for registration, **89**, 298.
may require Comptroller to state his objections in writing, **89**, 299.
death of, 300.
power to correct clerical error in application, 304.
form of notice to, of decision of Comptroller, **377**.

APPLICATION
for hearing against exercise of discretion by Comptroller, **305**.
for cancellation of design used for manufacture abroad, **310**.
fee for, 239, **311**.
for extension to be made within prescribed time, **142**, 230.
by whom to be made, **230**.

APPLICATION FOR REGISTRATION, **72** *et seq.*, **219**. (And see REGISTRATION.)
by whom to be made, **73**. 115, 220, 221, 293.
description of nature of design under 1883 Act, **74**, 220, 297.
not now necessary, **75**, 77.
classes to be stated, **72**, 74, 84, 220, 295.
how to be sent, **72**, 73, 264.
size of papers and other conditions, 82, **297**.
filing of representations of design. **73**. 297.
sufficiency of claim or description on, **76–81**.

APPLICATION FOR REGISTRATION—*continued.*
by sample, limits claim, **75**, 78.
list of places where forms can be got, 408.
drawings to be sent, 72, **83**, 206, 470.
one drawing or sketch sufficient for, **83**.
documents, etc. required on, 82, 219, **408**.
applicant entitled to be heard before decision given against, **88**, **260**, **298**.
amendment of, **91**, 220, 255, 307.
when design first published abroad, 273, **275**.
rules as to, **295** *et seq.*
fees on, **319**.
Patent Office Instructions as to, **406** *et seq.*
non-completion of, deemed to be abandoned, **74**, 218, 299, **410**.
registration as on date of, **74**, 90, 218, 225.
under Act of 1883...**218**.
contents of, **74**, 217, **219**, 295.
signature of, by applicant or agent, **220**, 295.
time prescribed for completion, **74**, 89, 225, 227.
by post, **72**, 264, 292.
by agent, **73**, 294.
where to be lodged, 72, 295.
of lace design, 295.
of goods in Manchester Classes, **92**, 313.
separate, for each class, 85, 295.
Comptroller may refuse, **88**, 225, 295.
decision of Comptroller on, to be communicated, 89, 298.
appeal from, 88, **89**, 299.
correction of clerical error in, 304.
statement of purpose or novelty to accompany, 74, 76, 220.
reference to, for definition of subject-matter, **79**.
ambiguity in, rule of construction where, 81.
exhibition of design after, **84**.
grant of patents after, **84**.
where doubt as to class, **85**.
omission of goods from, **86**.
by persons under disability, **91**.
in British colonies and foreign States, **413**.
excluded days for, 265.
form for, **374**.
for lace, **374**.
for textile goods, **386**, 387.

APPLICATION OF DESIGN
to different materials or to goods in different classes, **39**, **44**, 87, 222.
to different goods sometimes a novelty, **32**, 40, 222.
of old designs, previously used separately, **34**, 222.

APPLICATION OF DESIGN—*continued.*
to any goods not in class registered as affording registration, 226.
abroad not unlawful, **240.**
to part of an article, **24**, 26.

ARRANGEMENT
of old materials, test of novelty in, **32**, 39, 222.

ART COPYRIGHT,
protection of, under the Hogarth Act, 2.
common law principles and, 230.
analogy between, and copyright for design, **12**, 16, 31, 234.
"persons aggrieved," and powers for expunging from register, **107.**

ARTICLE,
definition of, **277.**
design applied to part of, **24**, 26, 279.
design may be made up of two, **77**, 279.
of manufacture not a design, **22** *et seq.*

ASSIGNEE. (See ASSIGNMENT.)
may be plaintiff in action for infringement, **179**, 281.
as proprietor, **95**, 122, 123, **228**, 280, 302.
may not register before author, **97**, 228.
may apply for extension of copyright, **230.**
not registered, remedy for infringement, **248.**
title obtained by assignment, 257.
of bankrupt proprietor, unregistered, **257.**

ASSIGNMENT,
old law, 6.
assignee entitled to be registered, 6, **228**, 302.
entry on register, **95**, 254, 256, **302**, 303.
procedure for, 96.
proof required before registration, **96**, 257, 262, **303.**
Comptroller may decide evidence as to, 96.
by person registered as proprietor, **257.**
forms for registration of, **379** *et seq.*
conveyancing, 463.
writing required for, 97, **122**, 228, **257.**
original registration should be complete before, **97**, 125, 228.
entry of, at local branch offices, 15, **92**, 315.
parol, under the common law, validity of, **122.**
by part proprietor, **126.**
of equitable interests, 94, 95.
of British rights in foreign designs, **239.**
of unregistered designs, 122.
of partial interests, **95** *et seq.*, 281.
of rights after lodging application, **84.**

AUTHOR. (See PROPRIETOR.)
as proprietor of design, **116**, 278.
what amounts to authorship, 116, **117**, 281.
disputed authorship, **118**, 119.
person who merely suggests idea, not, **116**, 281.
independent, no copyright where novelty already published, **30**.
person commissioning work as, **118**, 281.
employment of, for good consideration, as affecting proprietorship, **118**, 278.

BANK HOLIDAYS, 306.

BANKRUPTCY,
devolution of copyright on, **97**, 128, 281.
where design not registered, **128**, 257.
trustee in, right to demand cancellation of registration, **304**.

BASKET,
mode of manufacture of, not a design, **25**.
combination of old designs in, 41.

BIBLIOGRAPHY OF DESIGNS,
English literature, **415** *et seq.*
Foreign and Colonial, **417** *et seq.*

BLOCK,
sale of, not a license, 249.

BOARD OF TRADE,
under old Acts, 6, 9, 10, 11.
Board may act through certain officers, 269.
appeals to, on *refusal of Comptroller to register*, 14, **89**, 225, 233, 316.
costs on, 90.
procedure regulated by Board, 316.
evidence in, **263**.
enlargement of time for, 317.
general superintendence over Patent Office and Comptroller, **89**, 252, **268**.
power to make rules, **267**.
to alter practice of registration, 267.
to fix the fees, 253.
to establish branch offices, **252**.
certificates of exhibitions as industrial or international, 69, **243**, 244.
procedure for obtaining, **312**.
appoints and removes Comptroller and officers, 253.
salaries to be fixed by the, 253.

BOARD OF TRADE—*continued.*
orders or certificates sealed by the Board or signed by certain officials to be evidence, 269.
repeal of Rules made under former Acts by, 317.
no appeal to, from Comptroller on questions of doubt as to class, 85.
power to dispense or modify requirements as to marking, 130.
appeals from, 225.

BONÂ FIDE,
intention to use, absence of, makes registration voidable, 100, 260.

BOOKS,
publication in, 57 *et seq.*, 223.

BRANCH OFFICES,
establishment of, 92, 252.
rules of Patent Office to apply to, 92.
separate register to be kept at, 92, 227.
changes in register at head office to be notified to, 92.
procedure at Manchester, 315.
inspection of entries and deposited designs at, 254.
forms for entries in registers at, 386 *et seq.*

CANCELLATION OF REGISTRATION,
powers of Comptroller as to, 113, 238.
procedure before Comptroller, 112, 310.
right to apply for, 112, 238.
vexatious use of right to apply for, protection from, 239.
costs on, 113.
considerations to be applied on, 241.
powers of Court as to, 242.
application for, pending action, 186 n.
statutory declarations on application for, 113, 262.
form of request on application for, 385.
on bankruptcy, right to demand, 304.
on application of registered proprietor, 256, 304.
form for, 383.

CERTIFICATE
as to identity or imitation, no evidence, 263.
issue of, where sketch only accompanies application, 83.

CERTIFICATES
of existence of copyright in a design, 237, 309.
of registration, 6, 15, 83, 90, 227, 377.
none till all drawings sent in, 83, 227.
to be sent as soon as may be after complete registration, 90, 227.

CERTIFICATES—*continued.*
of registration, to be sealed, 90, 95, 200.
fee for copy, 91, 227.
form, **377.**
loss of, 91, **227.**
form of application for copy of, **389.**
prima facie evidence of entry on register, 227.
Comptroller's, to be evidence, 114, 203.
of Comptroller for purposes of legal proceedings, 309.
form of request for, **385.**
fee for, 319.
of Board of Trade as to exhibitions, **69**, 242.
of validity of design, grant of, **173**, 200, **251.**
where plaintiff entitled to, **174**, 251.
effect of, **174.**
not necessary to secure High Court scale of costs, 201.

CIRCULAR,
as threat of legal proceedings, to found action, **212**, 251.
proceedings against issue of, 15, **211.**

CLAIM
for pattern, shape or configuration, effect of, 76.
construction of, where ambiguity, **81.**
statement of, in action for infringement, 185.
forms for, **390, 391, 392.**

CLAIMANT,
who may register as, **221.**
proof of title to be furnished by, **96.**

CLASSES,
goods to be classified by Board of Trade, **267**, 291.
to be mentioned in application for registration, 72, 74, **84**, 220, 295.
if doubt Comptroller decides, **85**, 218, 314.
power to register in several classes, **85**, 218, 224.
separate application for each, **85**, 295.
list of, **29.**
under the older Acts, 7, 12, **29** n.
under Acts of 1883 and 1907 compared, 29.
application to goods in different, not a novelty, 39, 44, **86**, 87, **222**, 224.
protection limited to the class in which registered, **85**, 141, 224.
proprietor may disclaim application to any particular class, **91**, 255.
registration in wrong class, **187.**
infringement limited to goods in same class, **243**, 246.
of infringements, **147.**
of proprietors, **116.**
13, 14 and 15. (See MANCHESTER CLASSES.)

CLASSES—*continued.*
difference between Classes 13 and 14...**84.**
subsequent registration by proprietors on register in different classes, 44, **86**, 221, 226.
design may apply to set of articles in one class, 82, 224.
application of old design to other, creating novelty, 32.
registration in one class excludes subsequent registration in other, **44.**

COFFIN PLATES,
pattern for, distinguished from mode of making, 28.
small differences sufficient to create novelty, **37.**

COLLAR,
design for out of, not registrable, 38.

COLONIAL ARRANGEMENTS, **274** *et seq.*, **414.** (See INTERNATIONAL AND COLONIAL ARRANGEMENTS.)

COLOUR
not a design, **24.**
variations in, where registration by sample, 77.

COMBINATION
may be a design, 24, 33, **41**, 42, 222.
originality of parts, not necessary if combination novel, **41** *et seq.*, 222.
producing new effect is a design, **279.**
included in meaning of design, **19.**
of ornament and shape in design, 21.
of colour and effect a design, **24.**
of old materials may be a design, **24**, 41, 222.
of several old designs may be new and original, 33, **41**, 222.
calculated to produce a particular end, **34.**
registration of, does not protect separate parts, **77.**

COMMENCEMENT
of Act of 1907...287.
of statutory protection of design, **74**, 90, 218, 220.

COMMON LAW RIGHTS,
analogy of, in designs, with Art Copyright, 230.
to prevent publication, **53**, 55, 71.
when lost, 53.
extend to all industrial property, 54.
before publication, **55**, **229.**
on parol assignments, **122.**
in malicious libel cases, 213.

COMPTROLLER, THE,
definition, 219.
appointed and removable by Board of Trade, 219, 225.
appeal from, to Board of Trade, 14, 89, 261, 315.
procedure on, 89, 305.
costs on, 90.
notices to, 90, 317.
to Court on refusal to register, 259, 276.
amendment, powers of, 15, 91, 255, 307.
costs of, 91, 102.
notice of application to rectify to be given to, 110, 255.
notice of order on application to rectify, 111, 260.
notice of intention to exhibit at exhibition, 69, 242, 312.
application to register to be made to, 72, 73, 290.
registration of designs, powers and duties as to, 72, 217, 291 *et seq.*, 298.
inspection of designs, duties as to, 98, 236, 310.
searches, power to make, 235, 306.
information relating to designs to be given by, 70, 74, 220, 238, 306.
certificate of, on complete registration, 90, 227.
none till all drawings sent in, 83, 227.
refusal to register, 9, 88, 218, 221, 255, 298.
decision to be notified to applicant, 89, 225, 298.
design contrary to morality, 9, 88, 225, 261.
design identical with another, 88, 225, 226.
procedure on, 88, 305.
loss of certificate, may give copy on, 91, 227.
drawings, may refuse unsuitable, 88.
certificate for use in legal proceedings to be given by, 309.
certificate of, as evidence, 114, 263.
sealed copies certified by, evidence, 114, 263.
party decided against by, must be heard, 88, 260, 305.
procedure on, 89, 90, 305, 307.
service of notices and documents on, 264, 292.
power to dispense with evidence, 96, 266, 307.
to correct errors, 15, 91, 225, 255, 307.
to enlarge time, 83, 91, 113, 225, 265, 299, 308.
to allow disclaimer, 91, 255.
to dispense with signatures, 74, 220.
to adjudicate between rival claimants, 221.
to refuse to recognise agents, 73, 267.
to decide class where doubtful, 85, 218, 291, 314.
to correct irregularities in procedure, 91, 225, 307.
to extend term of copyright, 230, 301.
to erase from register, 83, 84, 225, 233.
to award or order security for costs on applications, 113, 241.
to modify forms, 290.
to require personal signature or presence of applicant, 294.

COMPTROLLER, THE—*continued.*
discretionary powers, exercise of, 225, 261.
marking, no power to exempt from, 235.
entry of particulars on register, duties as to, 95, 309.
notice of rectification, duties on, 110, 317.
law officers may be consulted by, 85, 261.
duties to be performed by nominee of Board of Trade, 252.
annual report to be made by, 261.
cancellation of registration by, application for, 112, 113, 238.
at instance of registered proprietor, 250.
appeals from decision on, 311.
considerations to be applied, 241.
powers on registration of assignments, 96, 97, 257, 262, 303.
rectification of register, right to appear on, 110.
evidence before, discretionary powers as to, 96, 263, 303.

CONFIDENTIAL COMMUNICATION
of design, not publication, 63, 64, 223.
for purposes of sale, 64, 223.
marking of goods, on, 132.

CONSIDERATION,
questions of, between author and proprietor, 118.

CONVENTION, 274, 321. (See INTERNATIONAL CONVENTION.)

COPIES
of entries, certified, 114, 254.
to be sent to Scotland, Ireland, and Isle of Man, 92, 264.
of registration certificate, when original lost, 91, 227.
sealed copies to be evidence of certain matters, 114, 263.
to be given on payment of fee, 254.
to be evidence in Scotch, etc. Courts, 92, 264.
of drawings and documents, selling of, regulated by the Rules, 267.
of rectification order by Scotch or Irish Court to be sent to Comptroller, 111, 282.
of notice of appeal to be sent to Secretary of Board of Trade, 316.
fees for, 98, 319.
of design, none to be taken during special inspection, 98.
may be taken after expiration of copyright, 98.
in books, etc., need not bear registration marks, 233.
of entry in register, making of false, an offence, 207.

CO-PROPRIETOR. (See JOINT PROPRIETOR.)

COPYRIGHT. (See HISTORY AND DEVELOPMENT, Chap. I.)
under older Acts, 2, 3, 7, 9, 12.
conditional copyright, 9, 10.
meaning of, **141**, 230, **277**, 280.
proprietor of, **115** *et seq.* (And see PROPRIETOR.)
length of, **142**, 220, 230.
cannot be extended by claiming trade mane, **188**.
subject-matter of. (See SUBJECT-MATTER.)
not limited to registered designs, **71**, 230.
loss of,
non-marking of goods, **129** *et seq.*, **231** *et seq.*
non-user in United Kingdom under old Acts, **112—114**.
not sending drawings, 83, **84**, 231.
by expunging from register, **107**, 250.
limited to application to articles in the class registered, **85**, 243, **246**.
information relating to continuance of, 188, **237**, 305.
remedies for infringement of, **160** *et seq.*, 243.
statutory protection dependant upon registration, 229.
inspection of design during continuance of, **97**, 236.
infringement of, **243**. (And see INFRINGEMENT.)
conditions on which the existence of, depends, **245**.
under previous statutes, **245**.
not a grant but statutory, **23**, 230.
before and after publication, 47, 52, 54, **71**.
analogy between designs and art copyright in questions of publication and authorship, **52**, **116**, 117.
in questions of marking, **234**.
with law as to inventions, 33, 54, 57.
certificate of validity of, where challenged, **174**.
common law principles as to, apply to unpublished works, **53**, 230.
extension of, 142, 230, 300, **411**. (See EXTENSION.)
date from which it runs, **83**.
use of registration mark after expiration of, **208**.
bonâ fide sale after expiration of, **210**.
bibliography of literature of, in designs, **415**.

COPYRIGHT BEFORE PUBLICATION. (See COMMON LAW RIGHTS.)

CORPORATE BODY,
"person" includes, **220**.
application for registration by, **95**, 220, 291.

CORSETS,
design for, as mode of manufacture, **24**, 25, 26, 36.

COSTS,
in action for infringement, **201**.
on appeal to Board of Trade on refusal to register, of, **90**, 225.
apportionment of, where distinct issues, **201**.

COSTS—*continued.*
discretion of Court as to, 103, 201.
higher scale, on, **203.**
of motions, 203.
of rectification of register, **102**, 260.
when defendant submits to injunction, **203—206.**
on applications for amendment or cancellation, **113**, 241, 311.
security for, on application for cancellation, 241.
where certificate of validity granted, **174.**

COUNTERCLAIM
on question of cancellation of registration, **242.**
for rectification of register, **109.**

COUNTY COURT,
jurisdiction of, in action for infringement, **176.**
jurisdiction in penalty claims, **176**, 177, **249**, 276.
under old Acts, 10.
form of order for directions where action commenced in, **397.**

COURT,
definition of, **176**, 275.
in which, action for infringement should be brought, **176**, 178, 249.
in Scotland, Ireland, and Isle of Man, **282**, 283.
to which, application should be made to rectify the register, **108**, 259.
rectification of register by the, **99** *et seq.*, 259.
applications by persons aggrieved to, **105**, 108.
appeal to, none from refusal to register, **99**, 225, 259.
inspection, power to order, **193**, 237.
of register and designs, **98**, 236.
of County Palatine of Lancaster, 176, 276.
special, for hearing of certain specified cases, **110.**
jurisdiction where proprietor resident in Scotland and Ireland, **177.**
powers of, to consolidate proceedings, **179.**
to determine amount of penalty, **160.**
to order trial by jury, **200**, 290.
to order cancellation, **242.**
over regulations of Board of Trade, **268.**
to grant injunction, **170**, 213, 251.
as to costs, 103, **201**, 260.
as to delivery up of pirated articles,, **172.**
amendment or correction, 99, **191.**

CYCLE,
pattern of, as design, **23.**
patent and statutory right to design coincident, 33.
expert evidence to prove anticipation and infringement, 43.

DAMAGES,
action for, **163—166**, 249.
under old Acts, 3, 8.
inquiry as to, **163**, 249.
on rectification of register, 102, 260.
undertaking as to, in cases of interlocutory injunction, **170**.
in threats action or for malicious libel, **212—213**.
recoverable on registration after infringement, **236**.
where licenses have been granted, 249.
plaintiff to elect between penalty and action for, **163**, **185**, 197.
basis on which awarded, 163.
inquiry, form of order for, **400**.
account of profits in lieu of, 166.

DATE,
of registration from day of application, **74**, 90, **218**, 225.
for appeal from refusal of application, 299.

DEATH,
procedure for registration on, **97**.
as affecting applications for registration, **82**, 97.
devolution of proprietorship on, 127.

DECLARATIONS. (See STATUTORY DECLARATIONS.)

DEFENCES,
in actions for infringement, **186** *et seq.*
open to party sued, 189.
on application for injunction in threats action or for malicious libel, 212.
forms for, in actions for infringement, **393**, **394**.

DEFENDANTS,
burden on, in cases of false description, 208.
in actions for infringement, **182**.
procedure where several infringers, 183.
agents as, 183.
purchasers from, licensee as, **188**.
challenge of title by, in actions for infringement, **245**.

DEFINITIONS,
design, 7, **17**, 19, 277.
set of designs, **290**.
copyright, 141, **277**.
person, 372.
proprietor, **115**, 277.
Court, The, 275, 276.
Law officer, 276.
British possession, 372.

DEFINITIONS—*continued.*
person aggrieved, 104, **107**, 259.
Comptroller, 219.
Colony, 372.
summary conviction, **276**, 371.
of terms in the Rules, 280.
under Interpretation Act, 1889...**371.**
article as respects design, 20, **277.**
ornamental design, 20.
"prescribed," 276.
Office, **290.**
specimen, 290.
"lodged," **290.**
agent, 289.
Journal, 290.

DELIVERY ON SALE. (See SALE.)

DELIVERY UP
of goods manufactured for sale after expiry of copyright, **148.**
order for, as part of equitable relief, **172.**
form for, on grant of injunction, **398.**

DEMURRER,
proceedings where, defence in nature of, **200.**

DESCRIPTION,
of design, what is, **74**, 296.
under old Acts, 14, **75.**
of purpose or novelty to accompany application, 74, 75.
where registration by sample, **77.**
for register, where supplied, must be exact, 220.
false description as registered design an offence, **207.**

DESIGN. (See Chap. II. p. 17.)
meaning of, 7, **17**, 20, 21, **277.**
result of cases relating to, **29.**
process of manufacture not a, **23**, 25, 28, 279.
what is applied to the article, not the article itself, 22, 23, **25**, 279.
mechanical contrivance not a, **23**, 280.
effect not a, 24, 279.
classes of article to which applied, **29**, 85.
combinations as, 24, **33**, 41, 42, 279.
portion of an article, application of, to, **24**, 26, 279.
restriction of, to articles of manufacture, etc., 20.
scope of protection given by the Act, **20.**
object of, immaterial, **27**, 278.
and article to which applied inseparable, **24**, 26, 279.
and trade mark, not exclusive, **34.**

DESIGN—*continued.*
protection given under name of, **29.**
can be registered whether "patentable" or not, **23, 25,** 222.
registration, conditions of, **30** *et seq.* (And see NOVELTY.)
method of, **72** *et seq.* (And see REGISTRATION.)
for shape and configuration, 18, 20, **21,** 22, 23, **279.**
copyright in, information as to continuance of, 237.
ornament and utility in, 22, 26.
infringement of, **142.** (And see INFRINGEMENT.)
inspection of, 97, 98, 310.
assignment of, **95.** (And see ASSIGNMENT.)
license to use, **121** *et seq.* (And see LICENSE.)
equities in respect of, enforcement of, **257.**
marking of, **129** *et seq.* (And see MARKING.)
sale of, before registration complete, **83.**
set of, **82,** 290.
history of, **2** *et seq.* (See HISTORY AND DEVELOPMENT OF LAW.)
exhibition of, **68,** 242, 312.
law relating to, not completely analogous to patent law, 33, 88, 222.
immoral or illegal, not to be registered, **88,** 225.
made or used abroad, **112—114, 238.**
as sculpture, 17, **279.**
false representation as to, 209, **271.**
proprietor may register old, in new classes, 31, 44.
totality of, where claimed, **79—80,** 296.
author of, **116** *et seq.* (See AUTHOR.)
foreign, license to English manufacturer to use, 239.
assigned but not registered, rights in, **122,** 257.
is personal property, **94,** 281.
words, etc., to be removed from, 297.

DESIGNS RULES, 1908...**289** *et seq.* (See RULES.)

DEVICE, ARTISTIC,
included in meaning of design, 19.

DIAGRAMS
need not bear registration mark, **233.**
included in design, 20.

DISCLAIMER
of portion of design as registered, 220.
of application to particular classes of goods, **91,** 255.
by explanatory note accompanying representation, 76.
must be expressed in application, if whole not claimed, **79.**

DISCLOSURE
contrary to good faith not a publication, **52**, 64.
of trade secrets on inspection, protection against, **194**.

DISCOVERY, **195** *et seq.* (See DISCLOSURE.)
in actions for infringement, 195.
limitations of plaintiffs' and defendants' rights to, **196**.
limited in actions for penalties, 197.
extended right of defendant, **198**.
in aid of account of profits, 167.

DRAWINGS
to be deposited on application for registration, 75, 82, **296** *et seq.*
specimen instead of, 75, 297, 298.
must be fixed when sent, 297.
Comptroller may refuse if unsuitable, **88**.
articles not to be sold until all drawings sent, **83**, 232.
certified copies of, to be sent to Scotland, etc., 72, 92, 264.
sketch may be sent in first instance to secure registration, **233**.
amendment of, **91**, 307.
Patent Office Instructions as to, **406** *et seq.*

EFFECT
not a design, **24**, 279.
novelty, test of, by, **32**, 223.
imitation, test of, by, 247.

ELECTION
between claim for damages or penalties compellable, **163**, 249.

EMPLOYERS AND EMPLOYÉS,
as "authors" of designs, **116**, 119.
disputes by, as to proprietorship, **118—120**, 280.
consideration to, a matter of fact, 118, **120**.
registration of, as proprietors, **280**.

EQUITIES AND EQUITABLE INTERESTS,
may be enforced like other personal property, 94, 128, **257**, 258.
in actions for infringement of unregistered designs, 182, 245.
entry of, on register of assignments, **94**, 95, 127, 254.
proprietorship, **127**.

ERASURE FROM REGISTER,
power of Comptroller to make, for non-completion of registration, **83**, 233.
notice of intention to make, for non-completion, **84**.

EVIDENCE
of proprietorship, burden of proof on person claiming, **127.**
certificate of Comptroller is, **114,** 263.
of expert witnesses as to novelty, **43.**
of title, to be given on assignment or devolution, **96,** 122, 202.
particulars, matters in, not, **190.**
of service by post, **73,** 264, 292.
seal of Patent Office judicially noted, 263.
sealed and certified copies to be, **114,** 220.
register *prima facie*, of matters entered, **114,** 263.
copies certified, in Scotland, etc., 264.
of orders of Board of Trade, 260.
right of Comptroller to waive, 96, **262,** 266, 307.
explanatory notes in application form, as, **75,** 79.
Comptroller's information or reply on inquiry as, **235,** 238, 263.
viva voce, how and when taken, **263.**
on appeals to Board of Trade, 263.
as to non-manufacture in United Kingdom, **113,** 262, 311.
written, how far necessary on assignment, **97.**
fresh, on appeal to Court of Appeal, 112.

EXCLUDED DAYS
for applications to Comptroller, &c., 73, **265,** 308.
meaning of, 73.

EXCLUSIVE
right to sell, how far protected, **281.**
license, nature and effect of, **281.**
importer from foreign countries, how far protected, **119,** 120, 280.

EXHIBITION
for sale, invalidates subsequent registration, **47.**
examples of, 48, 50.
exceptions to the rule, **55.**
of design, after lodging application, effect of, 84.

EXHIBITIONS (INDUSTRIAL OR INTERNATIONAL),
statutory provisions as to, **242** *et seq.*
publication at, **68,** 242.
Order in Council may give the requisite exemptions with regard to, **68,** 243.
conditions on which design may be registered after publication at, **69,** 242, 312.
certificate of Board of Trade as to, 69, 242.
list of, certified, to be kept at Patent Office, 243.
protection of, under International Convention, **326.**
exhibition of a design without proprietor's privity during, 69, 242.
notice of, to be given to Comptroller, 312.
form of notice of intended, **386.**
fees on, 319.

EXPERT
evidence to prove imitation, **154**, 247.
admissible to prove novelty, 43.
knowledge in relation to infringement, **153**, 154 n.

EXPIRATION OF COPYRIGHT,
penalty for marking after, 10, 210, 271.
manufacture with intention to sell on, **148**, 168, 245.

EXPUNGING. (See also RECTIFICATION.)
of designs registered by mere importers, 280.
for misrepresentation, or misconduct, **260**.
applications for, first introduced, 13.
by whom to be made, **99**.
grounds for, **99**, 100.
appeals on, tribunal for, 108, 276.
where entry irregular, 100.
motion for and action for infringement, difference between proceedings, **159**.
analogy to proceedings under Literary and Art Copyright Acts, 107, 259.
jurisdiction in Scotch and Irish cases, **177**, 283.
form of order on, 401.

EXTENSION
of protection under old Acts, 10 *et seq.*
of time by Comptroller, 91.
for completion of application, **299**.
of term of copyright,
under old Acts, 3, 4, 12, 230.
under Act of 1907...14, **142**, **230**, 300, **411**.
to be put on register, 301.
by whom application to be made, **230**.
to be advertised, 142, 301.
in designs now on register, **287**.
fees for, 142, **301**.
form for application for extension of copyright, **378**.
extension of copyright period, **379**.

EYE,
the judge of anticipation, **43**, 44, 222.
as judge of imitations, **153**, 247.
impression through, essence of design, 19.
the test of novelty, **25**, 43.
the expert eye necessary to decide, **43**.

FAIR USE,
in production of imitation, **148**, 240.

FALSE ENTRY OR MARK. (See OFFENCE.)
entry, a misdemeanour under the Act, **207**, 269.
marking, an offence, **208**, 269, 270.
description of design, an offence, **207**.
representation of design as registered, what amounts to, **209**, 270.
use of the word "registered," 412.

FEES,
general list, **318—320**.
on registration, 74, 91, **318**.
on renewal of certificate of registration on loss, 91, 142, 229.
on correction of errors, 91, **319**.
for certificate, 91, **227**.
on application for cancellation, 239, 311.
for extension of copyright, **142**, 301.
for certified copies, 114, 320.
for inspection, 98, 237, 319.
fixed by the Board of Trade, 253.
on appeal to Board of Trade, **319**.
for certificate of Comptroller for legal purposes, 319.
on notice of exhibition, 319.
payment of, after time expired, 308.
application for reduction of, **412**.

FINES
for false descriptions, 207, **208**.
payable for each offence, **208**, 271.

FIRM. (See JOINT PROPRIETORS.)
application for registration by, signature of, **95**, 220, 291.
foreign, security for costs by, **113**, 241.
partners in, in actions for infringement, 179, 281.

FOREIGN COUNTRY,
design used in, and not used here, **112—114**, 275.
application of a design not unlawful in a, **246**.
importer from a foreign country not proprietor, **280**.
registration after protection obtained in a, **272**.
copyright to be cancelled if design used mainly in, **112**, 131, 239.
grounds of exemption, **113**, 240.
designs of, licenses to use by English manufacturer, 239.
manufacture or sale in, infringement by, **186**, 239.
offences in, **210**, 211.

FOREIGNERS,
rights to registration, 220.
to register address for service in the United Kingdom, 292.
not exempted from marking, 131, 239.

FOREIGN JURISDICTION ACTS,
offences under, 210, 211.

FOREIGN STATES (CONVENTION WITH). (See INTERNATIONAL ARRANGEMENTS.)

FORFEITURE OF COPYRIGHT,
under old Acts, for non-marking, 129, 234.
none under Act of 1907...130.
exemptions from, for non-marking, 132, 234.
on non-user in United Kingdom, when first used abroad, 13, 112—114, 239.
for not sending drawings, 83, 84.

FORMS,
in Schedule II. to the Rules to be followed, 290.
list of those prescribed by the Designs Rules, 373.
of appeal to Board of Trade from refusal to register, 388.
of application for copy of certificate of registration, 389.
for registration, 374.
of design to be applied to a set, 375.
of application to cancel entry in register, 383.
for registration of lace designs, 375, 376.
of designs in classes 13, 14 or 15... 386, 387.
to vacate entry of name of mortgagee or licensee in register, 381.
for entry of address for service in register, 376.
for extension of copyright period, 378, 379.
for alteration of address, 382.
of certificate of registration, 377.
for use in legal proceedings, 385.
of notice of intended exhibition of an unregistered design, 386.
of request for certificate for use in legal proceedings, 385.
for correction of clerical error or for entry of new address, 382.
to enter name of subsequent proprietor, 379.
of lace design, 380.

FORMS—*continued*.
of request for search under sect. 57...383.
under Rule 60...384.
of request for statement of grounds of decision under Rule 33...377.
of application for cancellation of registration under sect. 58...385.
of notice of dispute to Keeper of Cotton Marks, 388.
of request for alteration of register in pursuance of an order of the Court, 389.
list of forms of pleadings, etc., in actions for infringement, **390**.
of notice of motion for an injunction, 398.
to rectify the register, 401.
of order for delivery up of pirated articles, 398.
injunction, 399.
expunging entry in register, 401, 402.
of particulars in action, **392**, 393, 396.
of pleadings,
statement of claim, 390, 391, 392.
defence, 393, 394.
reply, 396.
of writ, 390.
order on summons for direction (including inspection), **397**.
(where action commenced in County Court), 397.
inquiry as to damages, 400.
interrogatories for examination of a defendant, 402.
conveyancing,
assignment of a design, 403.
license of a design, 404.
of application, to be stamped, 220.
where stamped forms can be obtained, **220**.
to be modified, as directed by Comptroller, **290**.
part of Rules under new Act, **73**, 268, 290.
notes to, have force of statute, **73**.

FRAUDULENT IMITATION. (See IMITATION.)
meaning of, **151**, 247.
examples of, 151, 152.
distinction between, and obvious, **149**, 246.

GOLF BALL,
novel design for, good though not original, **36**, 40.

HEARING,
of application, cancellation for registration, **114**, 311.
attendance of declarant, etc. at, 114, **311**.
of appeal from Comptroller, **110**, 310.
of applicant on refusal of registration, **88**, 201, 305.
notice for, **89**, 305.

HIGH COURT OF JUSTICE,
special jurisdiction in case for rectification of register, **177**, 250.

HISTORY OF THE LAW RELATING TO DESIGNS (Chap. I. p. 1).
prior to 1787. 1, 2.
effect of the Statute of 1787...2, 3.
Act made perpetual, 1794...4.
registration introduced, 1839...4—7.
Act of 1842, ornamental designs...7 *et seq.*
Act of 1843, designs for utility, 9.
Act of 1850, extension to sculptures, 9.
Act of 1858, proceedings in County Courts, **10** *et seq.*
Act of 1861, foreigners and designs abroad, **11**, 12.
Act of 1875, Office of Commissioners of Patents, etc. formed, 11.
Act of 1883, Consolidating and Amending Act, **12**.
Acts of 1885, 1886, 1888, amending Acts, 13.
Act of 1907, Amendment Act, 14.
Consolidating Act, **14**.

HOGARTH ACT, 2.

HOLIDAYS,
when office closed, 73, **307**.

IDEA,
artistic, included in meaning of design, 19.
novelty in, **34**.
application of, from books, will not invalidate registration, 63.
suggestion of, as affecting authorship, **116**.

IDENTITY,
inspection, when design refused on grounds of, **98**, 237.
Comptroller's reply as to, no evidence, 263.
refusal to register on grounds of, **88**.

IMITATION. (And see INFRINGEMENT.)
distinction between "obvious" and "fraudulent," **149**, 246.
"fair use" in, allowed, **148**, 246.
variation may still be, 150, 246.
colourable, meaning of, 149.
"fraudulent," meaning of, **151**, 247.

IMITATION—*continued.*
"obvious," meaning of, **150**, 247.
eye the judge of, **153**, 247.
expert evidence on, **154**, 247.
state of knowledge at time to be taken into account, **153**, 247.
Comptroller's reply as to, no evidence, 203.
as evidence of novelty, **42**.
of utility in an article, no infringement, **158**.

IMPORTER
from foreign country not a proprietor, **119**, 120, 280.

INDUSTRIAL DESIGNS,
protection given to all, **20**.
meaning of, under International Convention, 321.

INFANT,
method of proof for, 265, 266.
application for registration on behalf of, **91**.

INFRINGEMENT (Chap. IX. p. 141),
old law, 5, 6, 8, 10, 13.
what amounts to, **142**, **146** *et seq.*, 245, **246**, 249.
obvious imitation, **149**, 150, 246.
fraudulent imitation, 142, **151**, 152, 246.
intention of infringer immaterial, **143**, 157.
a question of fact, **153**.
ignorance of seller as a defence, **143**, 145, 248.
position of manufacturer and seller different as to, **143**, 245.
substantial variation necessary to avoid, 38, **154**, 157, 246.
onus where design made as near as possible to registered design, 156.
eye the judge of, **44**, 150, **151**, 153, 154, **247**.
by servants and agents, **148**, 245.
by manufacturer, **245**.
with intent to sell after expiration of copyright, **148**, 168, 245.
by retailer, **142** *et seq.*, 246, 249.
by other persons, **143**, 245.
sale or manufacture of, abroad not unlawful, **186**, 242, 246.
remedies for, 160. (See ACTION FOR INFRINGEMENT, Chap. X. p. 160.)
statutory remedies, **160**.
damages, **163**—166, 249.
penalty, **160** *et seq.*, 249.
injunction, **166**—169.
delivery up of infringing articles, **172**—184.
equitable relief in addition to other remedies, 64, 145, 166.
interlocutory injunction to restrain, 170.
misrepresentation of claim as affecting right of relief, **172**.

INFRINGEMENT—*continued.*
certificates of validity, **173**, 251.
registration after, effect of, **236.**
none if design applied to goods in another class, **85**, 86, 224.
of design though patent rights not touched, 33.
of unregistered proprietor's rights, **123**—125, 230.
notice required to affect a vendor, **145.** (See NOTICE.)
clauses of, **147.**
dependent on sole purpose, 148, 246.
fair imitation of original nature, no, 148, 246.
expert evidence as to, **43**, 154, 247.
attempt to imitate without, 156.
imitation of "utility" no, **158.**
novelty and, **38**, 158.
method of manufacture immaterial to, 246.
where registration by sample, **75.**
statutory provisions as to, **142.**
persons enabling, liability of, for, **146.**
in cases of limited license, **146.**
state of knowledge in relation to, **153**, **155**, 245.
expert knowledge as to, **153** n., 154, 247.
burden of proof, in cases of, **156.**
action for, proceedings in. (See ACTION FOR INFRINGEMENT.)

INFRINGER. (See INFRINGEMENT.)

INJUNCTION, **166** *et seq.*
costs where defendant submits, 203.
costs on higher scale, where, 203.
intention to infringe sufficient for, 168.
to restrain sale as soon as copyright expired, **168**, 245.
interlocutory, grounds for, **167** *et seq.*, **170.**
in threats action, **212**, 251.
equitable jurisdiction and, 249.
where no sale threatened or intended, **148.**
grant of, in addition to other remedies, **166.**
not necessary to show damage for, **168**, 250.
undertaking in lieu of, **168.**
form of notice of motion for, **398.**
order for, **398.**
order (on appeal) for, and inquiry, **399.**

INQUIRY,
as to damages or profits, **163**, 166.
form of order for injunction and, **399.**
as to damages, 400.
on appeal, **400.**

INSPECTION
of register at proper times, **97**, 254, 300.
of design during existence of copyright, **68**, 97, 230, 310.
when design refused registration on ground of identity, **98**, 237.
when copyright has ceased, **98**, 230.
in action for infringement, **192**, 193, 237.
fee for, 98, **237**.
of designs that have been abandoned, **98**, 255.
notice for, to be given, 194.
disclosure of trade secrets, protection against, 195.
evidence required to obtain order for, **194**.
form of order in summons for directions, including, **397**.

INSTRUCTIONS TO THOSE ABOUT TO REGISTER DESIGNS, 72, **406** *et seq.*

INTEREST. (See JOINT PROPRIETORS.)
partial, power to restrain infringement, **126**, 229.
entry of, in register, **94**, 254, 302.
form for, 380.
licensee, proprietor to extent of his, **126**, 281.
affected by extension of copyright, 301.
may sue as proprietor, 302.
assignment by, of, **95** *et seq.*

INTERNATIONAL AND COLONIAL ARRANGEMENTS,
Order applying Act to signatories of Convention, **331** *et seq.*
power to make arrangements with foreign States, **274**.
international convention, 274, **321**. (See *infra*.)
final protocol, 328.
accession to, 330.
effect of, 273 *et seq.*
limitation of operation in Great Britain, 274.
Orders applying Act to foreign States and British Colonies, **414**.
colonial arrangements, **272**.
effect of, on right to register, **274**.
publication after application for protection abroad, 274.
method of application on registration in England in such cases, 275.
protection of designs exhibited at exhibitions, **69**, 326.
registration after exhibition, 242.
priority of applicants under, 274.

INTERNATIONAL CONVENTION, **321** *et seq.* (See *supra*.)
operation in Great Britain, 274.
conditions for benefits from, 275.
objects of, 321.
countries united under, 322, **412**.

INTERNATIONAL CONVENTION—*continued.*
Act of Brussels, 322.
legal remedies under, 322.
rights of subjects of non-Union States, **323.**
right of priority under, 323.
importation and forfeiture, 324.
protection of subjects of Union States under, 325.
protection at exhibitions, 326.
subordinate to laws of contracting countries, **328.**

INTERROGATORIES,
in applications for rectification, **110.**
in actions for infringement, provisions as to, **195, 196,** 249.
against corporation or company, **197.**
in actions for penalties, **197.**
form of, for examination of a defendant, **402.**

INVENTION,
artistic, included in meaning of design, **19.**
analogy of law of, and copyright, 12, **47,** 54.
of subject of artistic design as affecting authorship, **116.**

IRELAND,
copies of drawings, etc. to be sent to, **92,** 264.
extension of designs copyright to, 4.
rectification of register, jurisdiction of Courts in, **108,** 109, **177,** 259.
Court in which offences prosecuted, 210.
application of Act of 1907 to, 283.
jurisdiction of Courts of, in actions for infringement, **177, 259.**

IRREGULARITIES IN PROCEDURE,
Comptroller may correct, **225,** 307.

ISLE OF MAN,
copies of drawings, etc. to be sent to, **92,** 264.
jurisdiction, **177,** 284.
rectification of register, no jurisdiction in, **177,** 284.
punishment in, for misdemeanour, **207,** 284.
Court in which offences prosecuted, **210.**
application of Act of 1907 to, 284.
jurisdiction of Courts in actions for infringement, **177, 284.**

ISSUE,
power to direct, in actions for infringement, **192.**
proceedings where, directed, **200.**
costs of separate, in action for infringement, **201,** 202.

JOINT PROPRIETORS. (See INTEREST.)
assignment of separate interests of, **126**, 228, 382.
may restrain infringements, 126, 228.
license by one as affecting the rights of others, **126**.
no defence in action for infringement, **188**.
failure to mark, in case of, **134**.

JOURNAL (OFFICIAL),
advertisement of rectification of register in, 111.

JURISDICTION,
in actions for infringement, **176**.
in County Courts, **176**.
in Ireland, Scotland, and the Isle of Man, **177**—178.
foreign, in case of offences, **210**, 211.
equitable, to restrain infringements of unregistered designs, **182**, 245, 249.
where registered proprietors domiciled in Scotland and Ireland, 177, **259**.
in applications for rectification of register, **99**, 108, 259.

JURY,
right to, in action for infringement, **200**.
issues for, on trial of action for infringement, **200**.

KNOWLEDGE
of existence of copyright in cases of non-marking, 130.
want of, not a defence in cases of manufacture, **143**, 145, 247.
in the trade in relation to infringement, **153**, **155**, 248.

LABEL
may be affixed instead of mark, **136**, 234.

LACE,
under old Acts, 4, 5, 8.
evidence of experts to decide novelty or infringement, **43**.
acceptance of order to manufacture, publication, 65.
marking of, 130 n., **132**, 235.
application for registration of, **295**.
special form for entry of assignments, **302**.
form for registration of design in, 375.
set of designs in, 376.
joint request of registered proprietor and assignee to enter assignment, **380**.

LAMP,
new shape as applied to sources of light necessary, **32**; 39.
shade registered in one class, excluding subsequent registration, 44.

LANCASTER (PALATINE COURT OF), **176**, 276.

LAW OFFICERS,
definition, 276.
Comptroller may consult, **241**, 261.

LEGAL REPRESENTATIVE,
consent of, to name of deceased person appearing in pattern, 82, **298**.

LIBEL. (See THREATS.)
malicious, action for, **211**.

LICENSE. (See LICENSEE.)
estops contesting validity of registration, **189**.
publication of book containing designs not a, **248**.
sale of unmarked articles under a, 135.
grant of, by person on the register, 257.
after lodging application, **84**.
necessity of writing for, 122, **125**, 228, 248.
registration of, before original proprietorship registered, 125.
by part proprietor, **126**, 248.
infringement of rights under, 146—147.
application to register, particulars required, 96.
sale of articles by vendee under, **146**.
effect of limited, **146**.
defence of, in actions for infringement, **188**.
by one of two joint owners no defence, **188**.
in foreign designs, grant of British rights, **239**.
sale of blocks not a, 249.
damages where license granted, 249.
may be given exclusively or otherwise, 126, 281.
conveyancing form for, 404.

LICENSEE,
as plaintiff in actions for infringement, **179**, 180, 281.
as proprietor, **121**, 228, 247, 281.
may not register till after author registered, 97, 125, 228, 281.
application for extension of copyright by, 230.
rights of, **121**, 180, 281.
may be put on register, **94**, 228, 302.
removal of name from register, **96**, 303.
form for, **303**.
unregistered verbal, joining in action for infringement, 97.
failure to mark by, effect of, **135**.
buyers from, not liable for infringement, **146**.

LIMITATION OF ACTIONS,
old law as to, 3, **6**.
no special provisions as to, under present law, **189**.

LIMITATIONS (STATUTE OF),
defence under, in action for infringement, 189.

LOCAL OFFICERS,
powers, how regulated, 252.

LODGED,
meaning of, 290.
where applications for registration, &c. to be, 295.

LOSS OF COPYRIGHT. (See FORFEITURE.)

LUNATICS,
declaration on behalf of, 265.
by whom application to be made for, 91, 266.

MANCHESTER BRANCH OFFICE,
provision of, 92, 252.
applications for registration to be sent to, 92, 313.
procedure at, 315.
separate register to be kept at, 15, 92, 314.
alterations in entries, 92, 315.
notice of dispute, 315.

MANCHESTER CLASSES (13, 14 and 15),
additional drawings or specimens to be sent for goods in, 82, 296.
marking of goods in, 130, 138, 234.
special provisions as to publication of goods in, 64, 235.
period of exclusion of designs in, from inspection, 98, 237.
applications for registration in, 314.
entry of goods in, at Manchester, 315.
where copyright subsisting under old Acts, 314.
forms of application for registration of goods in, 386–387.

MANUFACTURE,
cancellation of registration where mainly abroad, 15, 16, 112, 239.
in foreign countries of British design, 239.
of foreign design under licenses to English manufacturers, 239.
distinction between, and sale, &c. in questions of infringement, 143, 245.
for sale after copyright expired, 148, 168, 245.
by agents, 183, 245.
method of, immaterial, 246.
method or process of, not a design, 23 *et seq.*, 28, 36, 279.

MANUFACTURE—*continued.*
article of, not a design, 22.
mode of, distinguished from pattern, **28.**
in workshop, amounting to publication, 51.

MARKS AND MARKING (Chap. VIII. p. 120),
prescribed mark, **131, 231,** 309.
excuses for not marking, **129,** 132, 133, 234.
honest intention no excuse, **132.**
wearing off of, 134, **135,** 232.
illegibility of mark, effect of, **133,** 232.
part of article to be marked, **136** *et seq.*
intentional non-marking and recovery of damages, **234.**
removal of, by stranger or purchaser, **135,** 232.
effect of not marking, 104, **129,** 130, 232, 233.
by licensee or co-proprietor, **134,** 135, **233.**
under Act of 1883...129, 232.
1907...130, 232.
method of marking, **129** *et seq.*, **135—139,** 233, 234, 309, 411.
book of designs, **136,** 233.
paper hangings, 137.
samples, 137.
trimmings, 137.
dusters, 138, 234.
cuff links, 138.
gas brackets, 138, 139.
modifications under new Act, 15, **130,** 132, 232.
analogy to patents, 130.
statutory remedies stopped for want of, **131.**
to be before delivery on sale, 131, **132,** 232.
additions of other marks affecting, **133,** 234.
before certificate obtained, 200.
after copyright expired, **210,** 271.
on articles sold abroad, **131,** 232.
manufactured abroad, **131,** 232, 239.
onus of proof in case of non-, 130.
power of Board of Trade to modify provisions, 130, 233.

MATERIAL,
statement of, in application for registration, 296.

MECHANICAL CONTRIVANCE,
advantages of, may be secured by design, **22,** 27.
not a design, **23.**

MERIT,
artistic, not material, 36.

MISDEMEANOUR. (See OFFENCES.)
what amounts to, 260.
falsification of registar a, **114.**
false entry a, **207.**
punishment for, in Isle of Man, 207.

MISDESCRIPTION. (And see MISREPRESENTATION.)
as affecting rights of equitable relief, **172.**
of design, an offence, 207.

MISREPRESENTATION,
in registration, invalidation through, 220.
entries through, as ground for expunging entries, 100, 260.
of rights, no ground for rectification, **104.**
by addition of other marks, effect of, **139**, 172.
as affecting right to equitable relief, **172.**
of design as registered, what amounts to, **209.**
facts to be taken into account on, 291.

MORALITY,
designs contrary to, refusal to register, 9, **88**, 225, 261.

MORTGAGE AND MORTGAGEES,
entry of, on register, 94, **96**, 97, **254**, 257, 302.
removal of name from register, 96, **303.**
form for, 381.
in actions for infringement, **180.**

MOTION,
applications for rectification of register to be made by original, **110**, 259.
form of notice of, for injunction, **398.**

NAMES
of living persons, consent required on registration of design, **82**, 298.
substitution of, as registered proprietor, **101.**
change of, of owners, 102, 257.
removal from register, procedure for, 111.

NATURE OF DESIGN,
applicable for pattern, shape, or configuration, 219.
statement of, by applicant, **219**, 295.

NEW AND ORIGINAL. (Chap. III. p. 30.) (See also NOVELTY.)
meaning of, **30**, 31, 30.
difference between want of novelty and prior publication, **32**.
"new" and "original," **32**, 33, 221.
a question of evidence and fact, **42**, 222.
mainly for the eye, **43**, **44**, 222.
experts to be heard on, **43**, 223.
no valid registration unless design is, **30** *et seq.*, **86**, 87, 221.
novelty must be in pattern, shape, or configuration, 32, **36**, 221.
in application to the article, 32, **34**, 36, 221, 279.
in idea, how far necessary, **34**, 221.
if taken from source common to mankind, **35**, 221.
new use as novelty in a design, 28, **36**, 45, 221.
artistic merit no test, **36**.
standard of novelty need not be high, **38**, 40, 42, 222.
substantial difference from prior designs requisite, **37** *et seq.*, 48, 222.
combinations, 24, **32** *et seq.*, 39, **41**, 42, 222.
application to different material not, **39**, 44, 222.
alteration of proportions may be, **222**.
application to goods in different classes, **32**, 40, **44**, 87, 222.
want of novelty as a ground of rectification of register, **100**.
patent cases and their analogy to designs, as to what is, **31**, 33.

NOTICE. (See NOTICES.)
of infringing where goods not marked, **234**.
from proprietor as evidence of infringement, 248.
where registered proprietor lives abroad, 293.
of non-completion of registration to be given, **74**, 299.
of dispute in Manchester Register, **315**.
form for, **388**.
of rectification to be made in official journal, 111.
to sellers in case of infringement, **143**, **144**.
before issue of writ, in cases of infringement, **183**, 248.

NOTICES,
service of, **264**, 292.
when deemed to have been served, 265, 292.
proof of service, 265, 292.
of appeal to Board of Trade, **315**, 316, 317.
to Comptroller of time and place of appeal, 316.
of decision of Comptroller to be given, 305.
of objection to registration by Comptroller, **89**.
of desire to be heard before Comptroller, **305**.
of hearing before Comptroller, 305, 311.
to Comptroller of application for rectification, 110, **260**, 317.
form for, **401**.
of intention to exhibit at an exhibition, 312.

NOVELTY. (Chap. III. p. 30.) (See also NEW AND ORIGINAL.)
statement of, in application for registration, **74**, 75, 296.
eye test of, **25**, **43**, 222.
prior publication, as affecting, **30**, 31.
required in application of design, **34**, 221.
where design taken from common source, 35.
originality not necessary as well as, 36.
and infringement, principles applying to, **38**, 158.
evidence of, from imitation, **42**.
question of fact, **43**, 222.
expert evidence to decide, **43**, 223.

NUMBER,
lace and goods in Manchester classes not required to be marked with, 130, 235.
to be on mark generally, **130**, 309.

OBJECTIONS. (See REFUSAL TO REGISTER.)
to registration to be sent to applicant, **89**, 298.
to be stated in writing by Comptroller if required, **89**, 298.
on ground of morality, designs contrary to, **88**, 225, 261.
on ground of identity, 88.
on application for rectification, particulars of, **110**.
form of, **393**.

OBVIOUS IMITATION, **142**, 149, 150. (And see INFRINGEMENT and IMITATION.)
distinction between, and fraudulent imitation, **246**.
meaning of, **150**, **247**.
eye the judge, 153, 247.
expert evidence on, 154, 247.

OFFENCES. (Chap. XII. p. 207.)
punishable by criminal process, 207.
fine imposed for each, **208**, 249, 271.
by misrepresentation by use of registration mark, **271**, 208.
by false description, **207**, 208, 269.
by false entry, **114**, **207**, 271.
by false copies, **114**, **207**, 269.
by unauthorised use of royal arms, **210**, 271.
prosecution of, in Scotland, Ireland, and Isle of Man, 207, **210**, 284.
abroad, prosecutions for, **210**, 211.

OFFICE,
meaning of, 290.
when closed, **307**.

OFFICERS,
local, for branch offices, **252.**
appointed by Board of Trade, 253.
salaries of, 253.

OLD DESIGNS,
combination of, may be "new and original," **33**, 39, 222.
in one class may be original in another, **32**, 222.

OMISSIONS,
remedies for, from entry in register, **99**, 250.

ORDER FOR GOODS,
acceptance of, a publication, **64.**
exceptions in favour of textile fabrics, 64.
obtaining, after lodging application, **84.**

ORDERS IN COUNCIL. (See INTERNATIONAL CONVENTION.)
foreign jurisdiction, under, for offences, 210.
continue in force under new Act, **211.**
statutory provisions as to, 269.
list of, **414.**

ORDERS OF COURT
to be served on Comptroller, **317.**
publication of, in official journal, 317.
form of request for, **389.**

ORIGINALITY. (See NOVELTY.)
not necessary if design novel, 36, 221.
utility some evidence of, **36**, 221.
standard of, required, **36**, 222.
in application of design to new goods protected, **40**, 223.

ORNAMENT,
included in meaning of design, **18**, 20.
application to article of manufacture, protection first introduced, 7.
distinction between, and utility of design, 21.

OWNER,
on death, proof of title, 127, **300.**
rectification of name of, 101.
change of name of, not ownership, **102**, 267.
rights of equitable, to be protected, 127.

PART
of article may be a design, **24**, 26.
registration of, combination does not protect separate, **77.**
proprietor, assignment by, **126.**

PARTICULARS
of breaches and objections in action for infringement, 189, 190.
amendment of, 190, 191.
in applications to expunge, 190.
where common knowledge alleged, 192.
form for, of breaches, 392, 396.
of objections, 393, 396.
of case, in support of assignment, 302.
form for, 381.

PARTNERSHIP OR FIRM. (See JOINT PROPRIETORS.)
application for registration, signature of, 220, 291.

PATENT OFFICE,
Treasury to provide, 252.
designs business transferred to, 12.
under immediate control of Comptroller, 252.
application for registration to be made at, 72.
documents to be left at, on application, 72.
seal of, 253.
seal to be affixed to certificate of registration, 90.
register of designs to be kept at, 93, 254.
office copy of order to rectify register to be left at, 111.
instructions to those intending to register, issued by the office, 72, 406.
list of certified exhibitions to be kept at the, 243.
rules for regulation of, to be made by Board of Trade, 267.

PATENTS,
analogy of, with designs copyright, 33.
prior application for, not a publication, 66.
difference between law as to marking in designs and, 130.
design may be subject of, 23, 222.
exhibition of, before registration of design, 49, 50.
differences from, in applications to register designs, 88.
analogy with design in case of threats or malicious libel, 211.
revocation of, analogy with cancellation of registration, 112.
as subject-matter of designs, 23, 25, 27.
analogy with, in question of publication and novelty, 31.

PATENTS, DESIGNS AND TRADE MARKS ACTS,
consolidated (so far as relates to designs), 14, 217 *et seq.*
designs portion not construed as strictly as patents part, 33.
commencement of Act of 1907...12, 217, 289.
repealed Acts, 285, 286, 317.
saving clauses as to, 285.
where copies can be purchased, 406.
distinction between patents and designs under, 25, 27.

PATTERN,
under old law, 4.
distinguished from mode of making, 28.
included in definition of design, 18, 21.
combination of old designs may constitute new, 41, 222.
novelty in, as applied, 45.
registration of, does not protect separate parts, 77.
includes shape and ornamentation, 80.
issue of, after lodging application, 84.
need not be marked, if not sold, 232.

PENALTIES. (And see INFRINGEMENT; ACTION FOR INFRINGEMENT.)
under old law, 6, 13, 14.
assessment of, 160 *et seq.*
separate, incurred for each offence, 161, 271.
may be lump sum, 162.
for marking after copyright expired, 10, 210.
recoverable for infringement after subsequent registration, 236.
statutory provisions as to, 160.
plaintiff to elect between, and damages, 163, 185, 249.
interrogatories, in action for, 197.

PERSON,
includes a foreigner, 220.
a body corporate, 220, 274.
entitled to notice on rectification of register, 110.
acquiring the design or right to apply as proprietor, 116.
under incapacity, application or proof for, 265, 266.

PERSON AGGRIEVED,
may appeal from refusal to register, 89.
rectification of register at suit of a, 104 *et seq.*, 259.
who is a, 104, 107, 259.

PICTURE,
included in design, 20.

PIRACY. (See INFRINGEMENT.)

PLAINTIFF,
in action for threats or malicious libel, onus of proof as to non-infringement, 212.
in actions for infringement, 178—182.
registered proprietor as, 179.
assignee or licensee as, 179.
trustee as, 180.
choice of tribunal by, 178.
power to consolidate, 179, 180.

PLAINTIFF—*continued.*
in actions for infringement—*continued.*
unregistered owner as, 182.
agent as, 181.
mortgagor as, 80.

PLAN,
included in design, **19**, 20.

PLEADINGS,
in action for infringement, 185.
statement of claim, **185**, **390** *et seq.*
defence, **186—189**, **393** *et seq.*
reply, 186, **399**.

POST,
application for registration may be sent by, 72, **264**, 292.
how posting proved, 292.
when documents deemed to be delivered by, 265.

PRESCRIBED,
definition of, **276**.
time for completion of registration, **74**, 225.
renewal of copyright, **142**, 230.
answer to Comptroller's objections, **89**, **261**.
mark to be affixed to each article, **131**, 232, 234.
fee for inspection, **98**, 237.
manner for application for rectification, 259, 260.

PRIORITY,
order of, in protection of foreign goods, **274**.
sale of unmarked articles and application for, 275.
rights of, under International Convention, 323.

PRIOR USER. (See NEW AND ORIGINAL.)
meaning of, **46**.
by exhibition for sale, 47.
what sufficient to avoid subsequent registration, **48**.

PROCEDURE. (See REGISTRATION and ACTION FOR INFRINGEMENT.)
irregularities in, Comptroller may correct, **225**, 307.

PRODUCTION, PRIOR. (See NEW AND ORIGINAL.)
bar to novelty, 31.

PROFITS,
account of, in lieu of damages, **166**.
discovery in aid of account of, **167**.

PROOF,
burden of, in cases of infringement, **156.**
where registration mark used after expiration of copyright, **208.**
in *threats actions*, **212.**
in claim of proprietorship, **127**, 280.
in cases of non-marking, **130.**
sealed copies of entries to be, **114**, 220.
of knowledge of application of design in action for infringement, **248.**
power of Comptroller to dispense with, **262.**
of title on assignments, 96, **257**, 303.
of statutory declaration, **313.**
of documents sent by post, **72.**
of proprietorship, on death, **127**, 300.

PROPERTY IN A DESIGN. (See PROPRIETOR.)

PROPRIETOR,
under the old Acts, 3, 4, 8, 9.
assignee as, **122**, 123, 228, 280.
application for registration by self or agent, 73.
decision of Comptroller to be notified to, 84.
classes of, 116.
copyright and right to extensions given to registered, **142.**
entitled to certificate on registration, 227, 309.
definition, **115**, 277.
erasure of name if drawings not sent in, 84.
publication at exhibition without consent of, 69.
devolution on death of, 97, 127, 281, 300.
entry of, on register, **93**, 254, 281.
importer as, **119**—120, 280.
applier of design as, 120.
master of workman as, **118**, 280.
person with right to apply the design as, 120, 281.
acquiring unregistered design as, 122, 228.
body corporate as, 220.
licensee as, **121**, 228, **247**, 281.
inspection of the design under authority of, **98**, 236.
damages, action for, **163** *et seq.*
election to sue for damages or penalty, 163, 249.
none unless registered, 163.
marking, duty as to, **130**, **232** *et seq.*, 369.
penalty payable to, on infringement, **86**, 160, 161, 249.
proof, burden on person claiming to be, 127, 280.
purchaser for value may be, **119.**
subsequent proprietors, registration of, **95**, **121**, 122, 302.
form of application, 380.
formalities of registration, 302, 303.
proof of title required, 303.

PROPRIETOR—*continued.*
exception in favour of registered proprietor on subsequent application to another class, **86**, 226.
registration of name of original, 95.
exclusive agent for sale, not, 121.
equitable, entry of, on the register, **127**, 281.
bankruptcy of, **128**, 281.
co-proprietors. (See JOINT PROPRIETORS.)
living abroad, treatment of, by Comptroller, **220**.
application for extension of copyright by, 142, 230.
protection of, against omission to mark by assignee or licensee, **135**, 233.
facts relating to, to be inserted in the register, **259**.
defence of, against cancellation or manufacture outside United Kingdom, **113**, 310.
"good consideration" as between author and, **118**, 119.
unregistered, rights to relief, **123**, 124, **182**, 245.

PROTECTION. (See INFRINGEMENT.)
history, 1—4.
provisional, under old Act, 10, 13.
of mechanical contrivances, 23.
granted not to the article, but to the application of the design to it, **25**.
utility not included in, **22**, 36.
process of manufacture not included in, **23**, 25.
patent or mechanical contrivance may incidentally be included in, **23**, **24**, 222.
shape, pattern, configuration, the object of, **20** *et seq.*
of combinations, 24, **79**—80.
of portion of article, 24, **76**—77, 80.
lost if publication prior to registration, **46** *et seq.*, 57.
if drawings not sent, **83**, 219.
if article not marked, **104**, 232.
if not used in England after user abroad, 239.
by registration in the wrong class, **187**.
of design exhibited at exhibitions, 242.
limited to application to articles in the particular class, 86, 246.
under International and Colonial arrangements, **321** *et seq.*
remedies to enforce, **166** *et seq.*
of innocent infringers, **143**.
commencement of, 56.
from vexatious applications for cancellation, **239**.
of designs, under Sculpture Copyright Act, **279**.
not given to purpose or object to be attained by design, **280**.
extent of copyright in a design, **280**.
of rights of exclusive sale, **281**.
of subjects belonging to States under International Convention, **325**.

PROVISIONAL REGISTRATION,
first introduced, 9, 10.
abolished under Act of 1883...13.

PUBLICATION,
rights, apart from statute, to prevent, 53.
unlicensed use by third person, not, 53, 235.
authors' rights before, 53, 55, 71.
of substance, notwithstanding alteration, invalidating registration, 64.

PUBLICATION (PRIOR). (See PUBLICATION IN BOOKS.)
a bar to registration, 30, 46 *et seq.*, 217.
unless published outside United Kingdom, 67.
difference between want of novelty and, 30, 48.
by prior user, 46.
definition and examples, 46 *et seq.*
offering for sale, 48.
experimental user, 50, 51, 223.
user in workshop, 51, 223, 235.
exception in favour of registered proprietors, 47.
modifications under Act of 1907...52, 64, 235.
to individuals, 63 *et seq.*
dealing commercially with design, 64, 223.
exception in favour of textile fabrics, 64.
disclosure to person not bound to secrecy, 64, 223, 235.
disclosure to person who breaks confidence, 52, 64, 65.
examples, 64—67.
registration and publication, 30, 67, 224, 228.
in United Kingdom after protection in colony or foreign State, 275.
application for patent and, 66, 68.
publication abroad, 67, 224.
at exhibition, 48, 50, 68.
as a ground for rectification, 100.
of design as infringement, 243.
publications of the Patent Office, 267.
analogy from art copyright, 47, 52 *et seq.*
analogy with sculptures, 55 *et seq.*
literary copyright, 54, 57.
of abandoned designs, 98.

PUBLICATION IN BOOKS. (See PUBLICATION (PRIOR).)
in foreign books, 57, 58, 60 *et seq.*, 224.
in libraries, 61, 224.
by offer for sale in shop, 59.
and application of design, 233.
of registered designs does not give license to copy, 248.

PURPOSE,
in question of infringement, how far considered, **247.**
Comptroller's certificate in legal proceedings to state, 263.
of a design not protected, 280.
important on question of novelty, **38.**
application of old design to new, registrable, **45.**
statement of, to accompany application if required, 74, 296.
description of, on application, 74.
application may be referred to, to show, **79.**
difference of, as affecting right to registration, **87.**

RANGE. (See STOVE.)

RECTIFICATION OF THE REGISTER. (See also EXPUNGING.)
person aggrieved may apply, **99,** 104, 258 *et seq.*
grounds for, **99,** 260.
procedure, 110, 111.
notice of application to be sent to the Comptroller, **110,** 111, 260.
office copy of order to be left at the Patent Office, **111,** 259, 317.
Court in which application to be made, 108, **110,** 259.
powers of, as to, **99,** 111, **258,** 259.
method of rectification, **99** *et seq.*, 111, 260.
appeal, **99,** 111, 259.
costs, **102,** 260.
damages on rectification, **102,** 260.
for the purpose of substituting one name for another, **100,** 102, 260.
as a means of appeal from refusal to register, **99,** 259.
forms, **382.**
of notice of motion for, **401.**
legal grievance must be ground of application for, **105,** 259, 317.
rules for cancellation, **113,** 304, 310.
jurisdiction of Scotch and Irish Courts, **108.**
method of procedure when order made by Court of Scotland or Ireland, **111.**

REFUSAL TO REGISTER. (And see REGISTER and REGISTRATION.)
under old Acts, 9, 13.
on grounds of morality, **88,** 225.
identity, **88,** 225, 226.
mode of manufacture, **23,** 25.
mechanical contrivance, 23.
when claim neither for pattern nor ornament, 36.
procedure before Comptroller on, **88** *et seq.*, 255.
applicant entitled to be heard, **88,** 261, 305.
discretion of Comptroller, 88, 225.
statement of objections to accompany notice of, 89, 298.
appeal from Comptroller on, **89,** 225.

REGISTER, THE. (Chap. V. p. **93.**) (And see REGISTRATION.)
to be kept at the Patent Office, **93**, 254.
contents, **93**, 254.
trusts not to be entered on, **94**, 254.
equitable assignments on, **94**, 95, 254, 281.
assignments and transfers, **95**, 256, 302, 303.
inspection of, **97** *et seq.*, 228, 254.
of design itself, 97, **98**, 310.
entries on death or bankruptcy of proprietor, **97**, 257.
erasure of name of proprietor if drawings not sent, **83**.
correction of errors, **91**.
sealed copies of, evidence of registration, 114.
prima facie evidence of matters entered, **114**, 263.
falsification of, **114**, 207, 271.
rectification of, **97** *et seq.* (And see RECTIFICATION OF THE REGISTER.)
grounds, **97** *et seq.*, 107, 260.
who may apply for, **104, 258** *et seq.*
procedure, **110**, 111, 304.
appeal, **99**, 259.
old, incorporated under new Act, **94**.
remedies for non-insertion, or omission from, **99**.
application for cancellation for manufacture abroad, 112.
false copy of entry a misdemeanour, 207, 271.
entry not made in, till certificate sealed, 121, 227.
facts relating to proprietorship to be inserted in, **94**, 259.
variation of entry made by mistake, **99**, 260.
extension of copyright to be entered in, **301**.
removal of name from, **111**, 303.
alteration of address to be notified in, 304.
application of new rules to designs now on, **311**.
separate, to be kept at Manchester, 314.

REGISTERED PROPRIETORS. (See PROPRIETOR.)
exceptions in favour of,
in new and original designs, 31, **44**, 226.
on questions of publication, 47.
in subsequent application to another class, **31**, 86, 226.
power of, to extend registration to other class, **86**.
to correct clerical errors, 304.
joint request of assignee and, to enter assignment, 95.
form for, **379**.
form for, in case of lace design, **380**.
substitution of name of, power of Court, 100.
improper conduct of, as affecting relief, **103**.
assignees and licensees as, **122**, 123, 228, 280.
living outside United Kingdom, address of, **292**, 293.
notices and documents sent to, 293.
application for registration by, **86**, 293.

REGISTERED PROPRIETORS—*continued.*
to have notice of extension of copyright, **301.**
steps by, on application for cancellation of registration, **304.**

REGISTRAR,
officer under the earlier Acts, 6.
office transferred to Commissioner of Patents, 12.
of Designs and Trade Marks acts for Comptroller, **252.**

REGISTRATION. (And see REGISTER.)
practice of, to be regulated by Board of Trade, 163.
under old Acts, 4, 6.
analogy between designs and trade marks in, 34.
suggestion in books no bar to subsequent, 63.
conditions attached to, **72.**
of old design for new purpose, **45**, 87, 226.
not affected by prior application for patent, **66.**
necessary to give protection of statute after publication, **71.**
of combination does not protect separate parts, **77.**
application for, **72**, 73, 219, 296. (See APPLICATION FOR REGISTRATION.)
by whom, may be made, **73**, 115, 220, 293, 406.
nature of design as part of description, **74**, 75, 77, 229, 297.
class to be stated, **72**, 74, 84, 220, 295.
drawings, &c. to accompany, 72, **83**, 296, 297.
how documents and letters to be sent, 72, **73**, 264.
hearing by Comptroller of, **88.**
amendments, **91**, 220, 307.
fees on, **72**, 91, **318.**
body corporate may be registered in corporate name, **291.**
particulars to be entered on register, **309.**
specimens, by, **74** *et seq.*, 219, 298.
not to be refused because article and design may be patentable, **25**, 134, 222.
design contrary to law or morality cannot be subject of, **88**, 225, 261.
certificate of, **83**, 90, **227**, 377.
to be sent by Comptroller, **309.**
forms, **377.**
loss of, 91, **227.**
dates from application, **74**, 90, 209, 225.
rectification, **99** *et seq.* (See RECTIFICATION.)
effect of, **71**, 141.
no statutory copyright conferred without, **71.**
evidence of, **114**, 174, 229.
information as to existing, to be given by Comptroller, **237.**
after exhibiting at authorized exhibitions, **69**, 242.
provisional, under old Acts, **9**, 10.

REGISTRATION—*continued.*
subject matter of, what can be. (See Chap. II., and DESIGN and SUBJECT MATTER.)
under international and colonial arrangements, **324.**
refusal of, **88** *et seq.*, 255. (See REFUSAL TO REGISTER.)
class, registration in more than one, **86**, 218, 224.
is registration publication? **87**, 224.
opposition to, not provided for, **88.**
of subsequent proprietors, **95**, 280, 302.
of assignments, **95**, 96, 302, 303.
of name on notice of intention to exhibit, **242.**
false representation as to, **269.**
Patent Office Instructions as to, **406.**
of design as a whole, **220.**
invalidation of, through misrepresentation, 220.
through previous, 221.
through application to goods not in registered class, 86, 226.
by registered proprietor, in other classes, **31**, 44, 86, 226.
as affecting remedies, 141, 280.
after infringement, effect of, **236.**
without *bonâ fide* intention to use, **260.**
in name of employer, 280.
death of applicant before, **97**, 300.
powers of Comptroller, where similar design registered, 86.
completed upon sealing of certificate, **86**, 227.
completion of original, before assignment registrable, **97.**

REGISTRATION NUMBER,
must appear on marking, 5, 131, 309.
error in, as invalidating copyright, **133**, 309.
on lace and goods in Manchester Classes, 130, 235.

REGULATIONS. (See RULES.)
of Patent Office, on applications to register, **406.**

REMEDIES FOR PIRACY. (See INFRINGEMENT; ACTION FOR INFRINGEMENT.)
penalties, **160**, 249.
damages, **163**, 249.
injunction, **124.**
delivery-up of pirated articles, 124.
where subsequent registration, **230.**
under International Convention, 322.
stoppage of, for non-marking, 134.
misrepresentation or misdescription as affecting, **172.**
equitable, of unregistered proprietors, **182.**

RENEWALS,
optional, of copyright under Act of 1907...14, 230.
to be advertised, 14, **142.**

REPEALS,
repeal of old Acts, **286**, 318.
exceptions from Act of 1883...286.
as affecting designs on existing register, **287.**
of old Designs Rules, 280, 317.

REPLY,
form of, **396.**

REPORT OF COMPTROLLER (ANNUAL), 201.

REPRESENTATIONS,
nature of, to be supplied, **82**, 297.
effect of explanatory notes accompanying, **76.**
description to accompany application, where registration by, **77.**
reference to, on application, effect of, **81.**
of living persons on design, consent required, **82**, 298.
additional, to be sent to Comptroller if required, 82, 298.

REQUEST,
for entry of assignments, etc. to be made to Comptroller, 95.
by whom to be signed, **95.**
application for cancellation to be commenced by lodgment of, 113.

RES JUDICATA,
defence of, in actions for infringement, **188.**

RETROSPECTIVE OPERATION,
as to marking, **130**, 287.
of Act of 1907, to old designs, **285**, 300.
does not affect lapsed copyrights, **287.**

ROYAL ARMS,
unauthorized use of, an offence, 210, 271.

RULES. (See TABLE OF RULES, p. xlii. *et seq.*)
Comparative Table of the Rules of 1890 and 1908, p. xxi. *et seq.*
under the old Acts, 12, 13, 15.
general, to be made by Board of Trade, 268.
the Designs Rules, 1908...**289** *et seq.*
forms, part of, 15, 290.
sale of, **406.**
repeal of old, 285, 317.

SALE
of marked goods, after expiry of copyright, exempted from penalty if *bonâ fide*, **210**, 271.
marking to be before delivery on, **131**, **132**, 232.
marking of unfinished goods if for, 132, 232.
not necessary to prove, for infringement, **188**, 245.
exposure for, an infringement, 245.
of each copy a separate offence, **208**, 240.
of unmarked articles before application for priority avoids copyright, 275.
exclusive right of, how far protected, **120**, 281.
exhibition for, invalidates subsequent registration, 47.
for purpose of, a general condition of infringement, **147**.
abroad, action *for* infringement in case of, **188**.
of Acts and Rules, **406**.
non-supply of drawings or specimens before delivery on, may avoid registration, **83**.

SAMPLE,
registration by, limits claim for infringement, **75**.
distribution of unmarked, no forfeiture, **131**.
taking of, in actions for infringement, **192**.

SCARVES,
design for cut of, not protected, **39**.

SCOPE
of protection to designs given by the Act, **20**.

SCOTLAND,
copies of drawings to be sent to, 92, 264.
offences in, 282.
Court in which offence may be prosecuted, **210**.
application of Act of 1907 to, 282.
jurisdiction of Courts of, in actions for infringement, **177**, **283**.
on applications to expunge, **108**, **259**, **283**.

SCREEN,
pattern of, anticipation of, **47**.

SCULPTURE,
under the old Acts, 7, 9, 13.
extension of designs protection to, 9.
not a design under 1907 Act, **17**.
analogy of designs with works of, 55.
designs brought within Act, 279.
rules as to publication of, applied to designs, **56**.

SEAL
of Patent Office, **253**.

SEARCH
for information regarding registration, **235**, 306, **411**.
form for, 383.
as to imitation of design, **305**.
form for, 384.
Comptroller to make, 238, 306.
fee, 318.

SECURITY
for costs from foreign firms, **113**, 241.

SELLER. (See INFRINGEMENT; INJUNCTIONS.)
withdrawal of infringing articles by, as affecting action for infringement, **248**.

SERVANT,
publication by, as affecting registration, **51**.
as proprietor of copyright, **280**.

SET,
meaning of, 224, 290, **407**.
Comptroller to settle any doubt as to, 291.
representation for, to accompany application, 82, **297**.
form for application for, 375.
in lace, 376.
registration of, provisions for, **84**.

SHAPE OR CONFIGURATION,
included in definition of design, **18**, 21.
claim for, under the old Acts, **76**.
distinction between, and article to which design applied, **23**, 28.
infringement of registered design for, **23**.

SHAWL,
registration by deposit of, effect of, 76.

SIGNING
of application for registration, **295**.
of request for entry of assignment, etc., **95**.
in case of individuals, firms or bodies corporate, **95**.
on behalf of infant or person under incapacity, **265**, 266.

SKETCH
included in *meaning of design*, 19.

SPECIMEN,
meaning of, **290**.
as identifying a design, 21.
regulations as to, where lodged on application, **82**, 297.

SPOON HANDLES,
protection of design for, **28.**
novelty and originality in combination, 34.

STAMP. (See FEES.)
on registration of an assignment, 257.

STATEMENT OF CLAIM. (See CLAIM.)

STATUTES. (See TABLE OF STATUTES, p. xxxvii. *et seq.*)
comparative table of sections in Acts of 1883 and 1907, p. xx. *et seq.*

STATUTORY COPYRIGHT (Chap. IX. p. 141),
depends on registration, **229.**
extension of term of, **142.**

STATUTORY DECLARATIONS,
on entry of assignments, **96**, 262, 303.
form of, 312.
before whom to be made, **262**, 312.
seal to be taken in proof of, **312.**
right to cross-examine on, **96**, 262.
evidence by, in answer to application for cancellation of registration, **113**, 262.

STOVE,
shape of fire-door for design, **26**, 37.
application of old design to, registrable, **45.**
pattern of, anticipation of, **48.**
state of previous knowledge as to, 155.

SUBJECT MATTER FOR DESIGN. (See DESIGN; NEW AND ORIGINAL; PUBLICATION.)
under old Acts, 1—6.
sculpture, 9, **56**, 279.
new and original, **28**, 39, 222.
useful purpose not considered, **21**, **25**, 224, 247.
universality of objects to which Act applies, **29.**
not previously published, **46.**
applicable to pattern, shape, or configuration, or ornament, **17** *et seq.*, **23.**
method by which designs made immaterial, **221**, 246.
combinations as, **24**, 41, 44.
may be, though patentable, **23**, 24.
effect not, 22.
process of manufacture not, **23.**
mechanical contrivance not, **23.**
portion of an article may be, 15, **24.**

SUGGESTION
of idea does not constitute authorship, 116, **281.**
mere, in books, no bar to subsequent registration, **63.**

SUMMARY PROCEEDINGS
for infringement under the old laws only, 6.
punishment of offences by, 270.
in the Isle of Man, 284.

SUMMONS,
method of procedure, for rectification of register, 110.
for directions, form of order on, 397.
where action commenced in County Court, 397.

TERM
of copyright, extensions of, 142, 229, 300.
under old Acts, 7—10, 12, 13.
for non-inspection of designs, 97, 310.
conditions for renewal of, 142, 230.
of priority under International Convention, 323.

TEXTILE GOODS. (See MANCHESTER CLASSES.)
combination of old materials for design of, 24.
exception in favour of, as to publication, 64, 235.
marking of, 235.

THREATS,
action for, statutory provisions as to, 211.
what amounts to, 212, 251.
burden of proof in, 212.
grant of injunction in, 212, 251.
defences to, 212.
dissolution of injunction in action for, 212, 251.
award of damages in, 213.

TILES,
ornamental, question whether new and original, 32.
combination of old designs in, protected, 42.

TIME,
enlargement of, by Comptroller, 91, 225, 265, 308.
whence registration deemed to date, 73, 83, 90, 225.
excluded days, 73, 265, 308.
for giving notice of desire to be heard, 89, 261, 305.
hearing by Comptroller, 89, 261.
for appeal from Comptroller's decision, 260, 299.
to Board of Trade from refusal to register, 89, 90.
when notice, etc. deemed to have arrived at the Patent Office, 72, 265.
within which design must be registered after exhibiting, 242.
within which design must be registered after application for foreign protection, 272.

TIME—*continued.*
within which must be used here if used abroad, 240.
within which drawings, etc. must be sent to Scotland, etc., 264.
of notice of application to rectify, **110.**
within which Rules come into force, 289.
computation of, **73.**
for completion of application for registration, **74**, 225, 299.
for rectification of default in completion, **74.**
within which proprietor must answer application for cancellation, **113**, 310.

TITLE,
devolution on death or bankruptcy of proprietor, **97.**
must be proved to satisfaction of Comptroller, **303.**
necessity of writing to prove, **97.**
legal evidence not necessary, 97.
evidence of, on licenses and assignments, 97.
defective, should be varied, **257.**
proof of, on assignment, 96, 257, 303.
disputed, jurisdiction in Scotland as to, 283.
lack of, ground for expunging from register, **100.**
full, of Comptroller, 219.
short, of Act of 1907. .287.

TOTALITY,
claims for, in application, **79**, 296.
registration of, does not protect separate parts, **77**, 78.

TRADE-MARK LAW,
in relation to refusal to register, **88.**
rectification of register, **100** *et seq.*
compared with law relating to designs, 68, 88.
false description and, 208—209.
registration under, and as design, not exclusive, 34.
and substitution of name of registered proprietors, 100, 101.

TRANSFERS AND TRANSMISSIONS. (See ASSIGNMENT.)
treated as if personal property, 228.
entry on register of, **93**, 256.
of copies, etc. from Patent Office, **264.**
of title, evidence as to, **96**, 257.

TREASURY
to sanction scale of fees, 253.

TRIAL,
method of, in action for infringement, **198.**
functions of judge and jury on, **199.**
place of, in action for infringement, **178.**

TRUSTEE
as plaintiff in action for infringement, **180.**
rights, if design assigned but not registered, 257.
in bankruptcy may register, **27**, 257.

TRUSTS
not to be entered on the register, **94**, 254.

ULTRA VIRES,
powers of Court where regulations of Board of Trade are, **268.**

UNITED KINGDOM,
publication outside, no bar to registration, 11, **67.**
exhibitions outside, **69**, 326.
protection, when first applied for outside, 273.
publication within, when protection applied for outside, **274**, 275.
cancellation of registration for non-manufacture in, **112**, **310.**
evidence for, 113, 310.
entry of address of registered proprietor outside, 15, **292.**

UNREGISTERED PROPRIETORS. (See PROPRIETOR.)
may be plaintiffs in action for infringements, 182.
right of trustee in bankruptcy, where, **257.**
remedies of, **123**, 124, **182**, 245.

USER. (See PUBLICATION.)
prior or public, meaning of, **46.**
in workshop, amounting to publication, 51.

UTILITY,
not *per se* protected by Designs Act, **21**, 22.
extension of copyright to designs of, 9.
under the old Acts, **9**, 13.
in question of infringement, how far considered, 247.
immaterial, in subject matter of design, **21**, 25, 36.
may be some evidence of originality, **36.**
imitation of, no infringement, **158.**

VALIDITY,
grant of certificates of, **173**, 251.
effect of, **174.**
where plaintiff entitled to, **174.**
not determined by prior action without certificate, **188.**

VARIATION OF ENTRIES. (See RECTIFICATION.)
application for, by whom to be made, 99.
grounds for, 99.
form of order for, **402.**
of title, if defective, 257.

WITHDRAWAL
of infringing article by seller as affecting right to injunction, 248.
of application, if hearing not applied for on objections to registration, 298.

WITNESSES,
attendance before Comptroller for examination, 283.

WORKMAN,
master of, as proprietor of design, 280.
publication by, avoiding registration, 51.

WRIT
in actions for infringement, 184, 185.
form of indorsement on, 185, 390.

WRITING,
how far necessary on assignments, 122.
on license, 122, 125.

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